

# ARTICLE

## OF MARKS AND MINORS

*Alexandra J. Roberts\**

### ABSTRACT

Celebrity parents and parents of celebrities are registering their children's names as federal trademarks with growing frequency. When an applicant applies to register a trademark that includes the name, signature, or portrait of a living individual, the Lanham Act requires that the individual's consent be made of record. If the individual is a minor, their parent or guardian must consent on their behalf. But what happens when the minor grows up and realizes she does not want to be the face of a brand of baked goods, or he does not want his parents profiting off a line of apparel that shares his name—without sharing their profits? No mechanism currently exists for an individual to terminate or revoke consent to the registration of a trademark that includes their name or image. This Article calls for reform and proposes several ways the law could enable minors to assert control over the registration of their name or likeness in order to better protect their autonomy, privacy, and rights of publicity while serving the goals of trademark law.

---

\* Professor of Law & Media, Northeastern University School of Law and Northeastern College of Arts, Media & Design; Faculty Director, Northeastern Center for Law, Information and Creativity (CLIC); Fellow, Yale Law School Information Society Project; Affiliated Faculty, University of New Hampshire School of Law. Earlier versions of this Article were presented at the 2024 M3 Intellectual Property Midlevel Scholars Workshop, the Suffolk University Sixth Annual IP and Innovation Law Conference, and the 2024 Houston Intellectual Property and Information Law (IPIL) National Conference; the Author thanks all participants in those conferences who provided feedback. The Author also extends her gratitude to Jennifer Rothman, Marty Schwimmer, and David Simon for their helpful suggestions, Preston Ossman for his excellent research support, and the members of the *Houston Law Review* for their stellar editing.

## TABLE OF CONTENTS

I. INTRODUCTION.....	308
II. TRADEMARK REGISTRATION REQUIREMENTS.....	312
III. NORMATIVE GOALS OF § 2(C).....	319
IV. MEANS TO CHALLENGE UNDESIRE REGISTRATIONS.....	322
V. PROPOSALS.....	329
VI. CONCLUSION.....	338

## I. INTRODUCTION

Lil Tay, born Claire Eileen Qi Hope, became an internet sensation at the age of nine when videos of her rapping about her lavish lifestyle—she called herself “the youngest flexer of the century”—went viral on YouTube and Instagram.<sup>1</sup> In the years that followed, her parents embarked on a bitter and public international custody battle while her brother managed her career<sup>2</sup> and rumors of abuse by various family members swirled.<sup>3</sup> Lil Tay was eleven when her mother applied to register her nickname as a federal trademark for entertainment-related services.<sup>4</sup>

1. Joel Yahu, *Who Is Lil Tay? The Rise and Mystique of the Youngest Flexer*, CITIMUZIK, <https://www.citimuzik.com/2023/10/lil-tay-bio.html> [<https://perma.cc/4YCV-DP32>] (last visited Sept. 4, 2024); Zoë Bernard, *The Youngest Flexer of the Century, 9-Year-Old Lil Tay, Has Abruptly Vanished from the Internet*, YAHOO FIN., <https://finance.yahoo.com/news/apos-youngest-flexer-century-apos-155204833.html> [<https://perma.cc/P38Y-FYES>] (last updated June 5, 2018).

2. Ethan Shanfeld, *Depite Reported Death, Lil Tay Allegedly Alive (Updated)*, VARIETY (Aug. 9, 2023, 10:13 AM), <https://variety.com/2023/music/news/lil-tay-dead-instagram-rapper-1235692008/> [<https://perma.cc/5WHW-NJN9>]; Remy Smidt, *What You Need To Know About Lil Tay, a 9-Year-Old Social Media Star Being Directed by Her Teenage Brother*, BUZZFEED NEWS (May 24, 2018, 5:28 PM), <https://www.buzzfeednews.com/article/remysmidt/who-is-lil-tay-instagram-youngest-flexer-brother-jason> [<https://perma.cc/TP99-GWS8>].

3. Mark Elibert, *Lil Tay Accuses Father and His Wife of Abuse and Sexually Inappropriate Behavior*, COMPLEX (Sept. 30, 2023), <https://www.complex.com/music/a/markelibr/lil-tay-accuses-father-and-his-wife-of-abuse-sexual-behavior> [<https://perma.cc/F2TY-X2XV>]; Asia Grace & Eric Hegedus, *Lil Tay Allegedly Abused by Family, Ex-Managers Question Death: Reports*, N.Y. POST, <https://nypost.com/2023/08/09/lil-tay-allegedly-abused-by-family-ex-managers-question-death-reports/> [<https://perma.cc/BPR6-V72Y>] (last updated Aug. 10, 2023, 2:23 PM).

4. U.S. Trademark Application Serial No. 88/222,081 (filed Dec. 8, 2018).

When an applicant applies to register a trademark that includes the name, signature, or portrait of a living individual, the Lanham Act’s “names clause” requires that the individual’s consent be made of record.<sup>5</sup> Lil Tay’s mom, Qi Tian, complied with that requirement, filing a declaration that granted consent to the registration of Lil Tay’s professional name.<sup>6</sup> The declaration was signed by both mother and daughter because a minor can neither own a trademark registration<sup>7</sup> nor give consent to someone else to do so; instead, her parent or guardian must consent on her behalf.<sup>8</sup>

At the time this Article is being published, Lil Tay is seventeen.<sup>9</sup> Given the cloud of drama around her family life—including widely-publicized reports of her death, later deemed a hoax—it seems likely that someday soon she will choose to manage her own career.<sup>10</sup> She may then desire to make different choices about whether and for what products to use and register her name as a trademark. Unfortunately, the United States Patent and Trademark Office (USPTO) has no mechanism in place for revoking or voiding the consent Lil Tay’s mother signed on Lil Tay’s behalf.<sup>11</sup> In fact, Lil Tay’s own application to register her name as a mark could be refused based on a likelihood of confusion with her mom’s LIL TAY registration. Basketball player Luka Dončić’s application to register his name was recently refused for exactly that reason—his mother was the prior registrant of trademark LUKA DONCIC 7, and Dončić’s desired mark was so similar that the USPTO determined it would create a likelihood of consumer confusion.<sup>12</sup>

5. Vidal v. Elster, 144 S. Ct. 1507, 1513 (2024).

6. U.S. Trademark Application Serial No. 88/222,081 (filed Dec. 8, 2018) (consent document showing the signatures of both Qi Tan and Claire).

7. TMEP § 803.01 (May 2024). However, “[i]f the minor can validly enter into binding legal obligations, and can sue or be sued, in the state in which he or she is domiciled, the application may be filed in the name of the minor.” *Id.*

8. *Id.* § 1206.04(a).

9. Gabrielle Chung, *Who Is Lil Tay? Everything to Know About the Teen Rapper at Center of Death Hoax*, E! NEWS (Aug. 10, 2023, 8:47 PM), <https://www.eonline.com/news/1382790/who-is-liltay-everything-to-know-about-the-teen-rapper-at-center-of-death-hoax> [https://perma.cc/2Z8E-V97F].

10. Yahu, *supra* note 1.

11. See 15 U.S.C. § 1052(c) (2018); Keegan Pearl, Comment, *Revoking Trademark Consent: Can It Be Done?*, 26 SMU SCI. & TECH. L. REV. 381, 399–400 (2023) (“Withdrawing or revoking [consent to use one’s name, image, or likeness] is something that section 1052(c) does not address.”).

12. Kyle Jahner, *Luka Doncic Bid to Get Trademark Back from Mom a Legal Jumpball*, BLOOMBERG L. NEWS (Sept. 19, 2022, 4:10 AM), <https://news.bloomberglaw.com/ip-law/luka-doncic-bid-to-get-trademark-back-from-mom-a-legal-jump-ball> [https://perma.cc/CZ2P-J6VA]. Dončić and his mother later resolved the dispute; Dončić is now the owner

Adults have only rarely attempted to revoke consent to the registration of their name by another. One court has ordered a registration canceled,<sup>13</sup> while another held that the registration remained valid because the statute only requires valid consent at the time of registration, rather than continuing consent.<sup>14</sup> But a child whose parent consents on their behalf to the commercial registration of a mark using their name, portrait, or signature might not have meaningfully consented, even if the consent technically complies with USPTO requirements. The USPTO's ethics rules include minors among those categories of clients with diminished capacity,<sup>15</sup> but the agency provides no avenue for minors to disaffirm or revoke a consent signed on their behalf. It is a basic tenet of contract law that contracts with minors are voidable by the minor.<sup>16</sup> While not every consent is a contract, the USPTO should incorporate a similar principle in the federal trademark registration and maintenance process to better protect and empower minors when it comes to registered trademarks that include their name or image.

There is no record to date of a minor seeking to revoke consent to register their name as a mark.<sup>17</sup> But as celebrity “selfmarks”<sup>18</sup> continue to proliferate, and as young actors, musicians, influencers,

---

or has applied for both the original and the new name mark registrations. Brad Townsend, *Mavericks Star Luka Doncic, Mom Have Quietly Settled Trademark Dispute*, DALL. MORNING NEWS, <https://www.dallasnews.com/sports/mavericks/2023/01/05/mavericks-star-luka-doncic-and-his-mother-have-quietly-settled-trademark-dispute/> [https://perma.cc/HE3H-EN4W] (last updated Jan. 5, 2023, 3:30 PM); LUKA DONCIC 7, Registration No. 5,953,034; U.S. Trademark Application Serial No. 90/768,512 (filed June 11, 2021) (owned or under application by Luka99, Inc.); U.S. Trademark Application Serial No. 97/349,601 (filed Apr. 6, 2022) (owned or under application by Luka99, Inc.); U.S. Trademark Application Serial No. 90/790,987 (filed June 23, 2021) (owned or under application by Luka99, Inc.).

13. *Warden v. Falk*, No. 11-2796, 2011 WL 4403033, at \*5 (E.D. Pa. Sept. 21, 2011) (because plaintiff had not assigned the mark, consent operated as a license; letter formally revoking consent to register and terminating license to use led court to cancel registration).

14. *Coscarelli v. ESquared Hosp. LLC*, No. 18-CV-5943 (JMF), 2021 WL 5507034, at \*10–11 (S.D.N.Y. Nov. 24, 2021) (rejecting a § 1052(a) argument because “any suggestion of connection with Coscarelli was not false when the By Chloe trademark was registered” and a § 1052(c) argument because “Coscarelli plainly consented in writing to the trademark’s registration” via the parties’ operating agreement).

15. USPTO Rules of Professional Conduct, 37 C.F.R. § 11.114 (2024).

16. 5 WILLISTON ON CONTRACTS § 9:13 (4th ed. 2024).

17. *But see Jackson v. Lynley Designs, Inc.*, 729 F. Supp. 498, 499–500 (E.D. La. 1990) (rejecting Lisa Jackson’s trademark challenge, which was premised on the claim that her parents had submitted consent on behalf of their minor daughter, Lisa’s half-sister Melissa Jackson, and fraudulently claimed the LISA JACKSON mark was Melissa’s nickname); *Petition for Cancellation at 2, 6, Gonzales v. Gonzales*, Registration No. 4,220,215 (T.T.A.B. July 21, 2015) [hereinafter *Gonzales Petition for Cancellation*] (seeking to cancel registration for CHACHI MOMMA where “Chachi” was the nickname of petitioner, a minor at the time of registration, but the USPTO had not required consent).

18. William McGeeveran, *Selfmarks*, 56 HOUS. L. REV. 333, 334 (2018).

and athletes—and their parents—find value in registering their names as trademarks, this issue is sure to come to a head in the near future. College athletes are newly free to enter into endorsement deals and monetize their name, image, and likeness, and some of them are under eighteen.<sup>19</sup> When parents apply to register the names of their celebrity children, teenagers like Justin Bieber or Bronny James may or may not be involved in the process and have a voice in how their name will be used. But when celebrity parents apply to register the names of their newborns or toddlers, as Kelly Clarkson did with River Rose and Kylie Jenner with Stormi, the children have no say in those plans and may be surprised to grow up and discover their name is a brand name for children’s books or cosmetics.<sup>20</sup> As Professor Mark McKenna writes of the right of publicity, every individual—celebrity or not—has an autonomy interest in the commercial use of their identity and suffers harm when their values as represented by others diverge from the values they hold.<sup>21</sup> Unauthorized use can wreak economic harms, of course, but noneconomic harms are also likely “in the form of shame or embarrassment, or simply discomfort at having been used for a purpose inconsistent with their values.”<sup>22</sup> What’s more, Professor Jennifer Rothman writes, “[a]llowing others to use another’s personal mark can also significantly interfere with that person’s future ability to work, earn a living, and meaningfully contribute to society.”<sup>23</sup>

19. Cole Claybourn, *Name, Image, Likeness: What College Athletes Should Know About NCAA Rules*, U.S. NEWS & WORLD REP. <https://www.usnews.com/education/best-colleges/articles/name-image-likeness-what-college-athletes-should-know-about-ncaa-rules> [https://perma.cc/Y8NV-JGAU] (last updated Feb. 8, 2024); Trey Wallace, *17-Year-Old Alabama WR Ryan Williams Torches Wisconsin for Touchdown, Should Be Enjoying High School*, OUTKICK, <https://www.outkick.com/sports/ryan-williams-alabama-jalen-milroe-wisconsin> [https://perma.cc/3KNQ-N3U9] (last updated Sept. 14, 2024, 1:09 PM).

20. Teresa Roca, *Just Like Mom Kelly Clarkson Files Trademark for Daughter River Rose, 9, to Create TV Shows, Films and Music After NYC Move*, U.S. SUN, <https://www.the-sun.com/entertainment/10140501/kelly-clarkson-trademark-daughter-riverrose-movies-shows-tv/> [https://perma.cc/Q52Z-N9H3] (last updated Jan. 23, 2024, 1:54 PM); STORMI, Registration No. 6,889,999 (owned by Kylie Jenner, Inc.). Commenting on DJ Khaled transferring his son’s rights of publicity to a corporate entity, Jennifer Rothman writes: “It is deeply troubling to turn people into trademarks at the time of birth, and to transfer the rights to their identities to corporations (potentially forever) before they can even walk or talk. These are chilling prospects that simply should not be allowed.” Jennifer E. Rothman, *DJ Khaled Sues Over Use of His Son’s Name*, ROTHMAN’S ROADMAP TO THE RIGHT OF PUBLICITY (June 12, 2018), [https://rightofpublicityroadmap.com/news\\_commentary/dj-khaled-sues-over-use-his-sons-name/](https://rightofpublicityroadmap.com/news_commentary/dj-khaled-sues-over-use-his-sons-name/) [https://perma.cc/K72N-2YK8].

21. Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 290 (2005).

22. *Id.* at 290–91.

23. Jennifer E. Rothman, *Navigating the Identity Thicket: Trademark’s Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 HARV. L. REV. 1271, 1330 (2022) [hereinafter *Identity Thicket*].

As the USPTO has acknowledged, § 2(c)'s consent requirement "recognizes the right of privacy and publicity that a living person has in his or her identity and protects consumers against source deception,"<sup>24</sup> as does § 2(a)'s prohibition on registering marks that create a false association with a person.<sup>25</sup> A child must not be deemed to have waived their rights of privacy and publicity and control of their name and identity in perpetuity just because their parent signed a form on their behalf. Nor should they be forced to sue or petition for cancellation to stop others from owning registrations for marks that comprise their name, portrait or signature without their true consent, or relegated to the status of junior user of their own name and likeness marks. And consumers should be protected from the deception that will ensue when products sold under a mark that references a minor neither benefits the minor nor reflects their endorsement. Instead, the USPTO should build in mechanisms for minors to disaffirm their consent and cancel or take ownership of registrations that exploit their rights.

## II. TRADEMARK REGISTRATION REQUIREMENTS

Section 2(c) of the Lanham Act prohibits registration of any mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent."<sup>26</sup> Consent is required if the individual named in the mark:

[W]ill be associated with the mark as used with the goods or services, because the person is either: (1) so well known that the public would reasonably assume a connection

24. TMEP § 1206 (May 2024) (citing *In re ADCO Indus.–Techs., L.P.*, 2020 U.S.P.Q.2d 53786, at \*10–11 (T.T.A.B. 2020)); *see also* *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 & n.8 (Fed. Cir. 1983) (noting that the drafters of § 2(c) intended to embrace concepts of the right to privacy found in § 2(a)); Joshua Beser, Comment, *False Endorsement or First Amendment?: An Analysis of Celebrity Trademark Rights and Artistic Expression*, 41 SAN DIEGO L. REV. 1787, 1794 (2004) ("Trademark and right of publicity claims are similar in that each grants the celebrity the right to protect an economic interest in his or her name.").

25. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:76 (5th ed. 2024) ("[T]he Trademark Board views § 2(a) as a statutory implementation of the rights of privacy and publicity . . .").

26. 15 U.S.C. § 1052(c) (2018). Other state and international trademark regimes include similar prohibitions. *See, e.g.*, Tom Scourfield et al., *Annual Review of EU Trademark Law*, 111 TRADEMARK REP. 549, 554, 579 (2021) (discussing Danish Trademark Act and Article 60 of the 2017 EUTM Regulation); ASS'N OF SE. ASIAN NATIONS [ASEAN], COMMON GUIDELINES FOR THE SUBSTANTIVE EXAMINATION OF TRADEMARKS 257, 268 (2d. 2020) (discussing trademark consent requirements for concurrent marks and marks depicting another's personal name, identity or likeness); BRENT A. OLSON, CALIFORNIA BUSINESS LAW DESKBOOK § 28:2 (2023) (California trademark registration exclusions); N.Y. GEN. BUS. LAW § 360-a (McKinney 2024) (New York registration exclusions).

between the person and the goods or services, or (2) publicly connected with the business in which the mark is used.<sup>27</sup>

If the applicant is the person named in the mark, though, or the individual named in the mark has signed the application, consent will be presumed.<sup>28</sup> If a mark “comprises a name, portrait, or signature that could *reasonably* be perceived as identifying a particular living individual,” and the applicant has not affirmatively stated whether it does, the examining attorney must inquire whether the mark names someone specific and advise that the person’s written consent is required.<sup>29</sup> But if there is already sufficient evidence that the mark identifies a particular living individual, the examining attorney may skip the inquiry and issue a § 2(c) refusal.<sup>30</sup>

A related but separate provision of the Lanham Act, § 2(a), bars registration of any mark that “[c]onsists of or comprises . . . matter which may . . . falsely suggest a connection with persons, living or dead.”<sup>31</sup> Sections 2(a) and 2(c) are often cited together in USPTO Office Actions responding to applications to register name marks. The Trademark Trial and Appeal Board (TTAB) and the Federal Circuit require that the following elements be shown to establish that a proposed mark falsely suggests a connection with a person:

(1) [T]he mark is the same as, or a close approximation of, the name or identity previously used by [the person]; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person . . . ; (3) the person . . . named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person . . . is such that, when the mark is used with the applicant’s goods or services, a connection with the person . . . would be presumed.<sup>32</sup>

27. TMEP § 1206.02 (citing *In re ADCO Indus.–Techs., L.P.*, 2020 U.S.P.Q.2d 53786, at \*8 (T.T.A.B. 2020)); see also *Zuppardi’s Apizza, Inc. v. Tony Zuppardi’s Apizza, LLC*, No. 3:10-CV-01363 (RNC), 2014 WL 4841085, at \*6 (D. Conn. Sept. 29, 2014) (“The first route to protection under § 1052(c) is to achieve general fame or notoriety. The second is to acquire a national reputation within a particular field. The set of persons who answer to the first description is not coextensive with the set of persons who answer to the second.”).

28. TMEP § 1206.04(b); *Alford Mfg. Co. v. Alfred Elecs.*, 137 U.S.P.Q. 250, 250 (T.T.A.B. 1963), *aff’d*, 333 F.2d 912 (C.C.P.A. 1964); *Ex parte Dallieux*, 83 U.S.P.Q. 262, 263 (Comm’r Pats. & Trademarks 1949).

29. TMEP § 1206.03.

30. *Id.*

31. 15 U.S.C. § 1052(a).

32. TMEP § 1203.03(b)(i); *In re Sauer*, 27 U.S.P.Q.2d 1073, 1073–74 (T.T.A.B. 1993); *Buffett v. Chi-Chi’s, Inc.*, 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985).

For § 2(a)'s prohibition to apply, the individual named in the mark need not have commercially exploited their name as a trademark,<sup>33</sup> although some level of fame or exploitation will both increase the likelihood that the mark would be recognized as a reference to that individual, as the test requires, and help alert the trademark examining attorney to the relevance of this basis for refusal. That the person named is a friend or family member of the applicant is not the kind of connection relevant to the test; rather, the third prong contemplates “a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services.”<sup>34</sup> While § 2(a) does not explicitly provide that consent of the individual eliminates the basis for refusal, in practice that is exactly how it works, because a perceived connection between a mark and an individual named in the mark who consents in writing to its registration cannot falsely suggest a connection—the connection it suggests is confirmed to be true by the consent. Applications to register marks that include an individual's name or image, then, often receive § 2(a) and § 2(c) refusals simultaneously and applicants often satisfy both bases for refusal with a signed consent.<sup>35</sup>

For both § 2(a) and § 2(c), a nickname or stage name can qualify as a person's name or identity,<sup>36</sup> as with JoJo Siwa, Lil Tay, or Ivanka—all nicknames or stage names of then-minors registered with their parents' consent. Likewise, registration of a phrase that references someone's name, pseudonym, or stage name, like HERE COMES HONEY BOO BOO or BIEBER FEVER, also requires consent.<sup>37</sup> An application to register BO BALL for a combination football/baseball, for example, was refused based on § 2(a) because “Bo” is the name of athlete Bo Jackson and would be recognized as such, the application was filed by someone unaffiliated with Jackson, and consumers would presume a connection because Jackson had played both football and baseball professionally.<sup>38</sup> Likewise, § 2(c) was also cited in the refusal, because BO BALL constituted a use of Jackson's name without his consent and he was so well-known and so connected with both sports that the public would expect the mark's

33. TMEP § 1203.03(b)(i).

34. *Id.* (citing *In re Sloppy Joe's Int'l Inc.*, 43 U.S.P.Q.2d 1350, 1353–54 (T.T.A.B. 1997)).

35. *See, e.g.*, *Coscarelli v. ESquared Hosp. LLC.*, No. 18-CV-5943 (JMF), 2021 WL 5507034, at \*11 (S.D.N.Y. Nov. 24, 2021).

36. *Vidal v. Elster*, 144 S. Ct. 1507, 1513 (2024); *Hornby v. TJX Cos.*, 87 U.S.P.Q.2d 1411, 2008 WL 1808555, at \*13 (T.T.A.B. 2008); TMEP § 1206.03.

37. *Written Consent*, U.S. Trademark Application Serial No. 85/770,288 (filed Nov. 2, 20213) (application for HERE COMES HONEY BOO BOO, Registration No. 4,602,081); *Declaration of Justin Bieber*, U.S. Trademark Application Serial No. 77/875,868 (filed Nov. 18, 2009).

38. *In re Sauer*, 27 U.S.P.Q.2d 1073, 1073–74 (T.T.A.B. 1993).

“Bo” to be Bo Jackson.<sup>39</sup> Similarly, when a corporate entity applied to register a set of trademarks referencing DJ Khaled’s infant son Asahd without authorization, the USPTO cited both § 2(a) and § 2(c) in its initial Office Actions.<sup>40</sup>

Even in cases in which the USPTO inquires about or identifies the need for consent of the individual named, it may sometimes (mistakenly) allow registration without the inclusion of a signed consent.<sup>41</sup> When a registration that issues without consent but should have required it is challenged by the individual it names, courts have taken different approaches. When WWE announcer Gene Okerlund challenged a licensee’s registrations of MEAN GENE’S BURGERS for restaurant and franchising services, a district court found that despite the existence of a valid license, § 2(c)’s written consent to register requirement applied but was not met, so immediate cancellation was warranted.<sup>42</sup> The court ordered the USPTO to cancel the registrations even though a separate agreement granted the licensee “the exclusive right to use the ‘Mean Gene’s name, personality, picture, portrait, likeness, voice and endorsement’ for the term of the agreement.”<sup>43</sup> The USPTO has likewise canceled registrations where consent of the individual referenced was absent, as where the named individual sold or granted rights to the use of a company name that was also a personal name but did not expressly authorize the corporate owner’s U.S. registration of the trademark that named them.<sup>44</sup>

But when vegan chef Chloe Coscarelli sought cancellation of the registration of BY CHLOE for restaurant services by a company to which she had previously licensed use of her name, a district court sided with the registrant, noting that “because Coscarelli plainly consented in writing to the trademark’s registration,” it was of no consequence that a specific consent to registration was not part of the

39. *Id.*

40. Office Action (June 4, 2018), U.S. Trademark Application Serial No. 87/867,012 (filed Apr. 6, 2018); Office Action (Apr. 16, 2018), U.S. Trademark Application Serial No. 87/529,960 (filed Apr. 6, 2018); Office Action (June 4, 2018), U.S. Trademark Application Serial No. 87/798,432 (filed Feb. 15, 2018). Note that this set of Office Actions appear to confuse Asahd Khaled with his father, describing the one-year-old as “a well-known DJ.” *Id.*

41. See Notice of Publication, RITA ANGEL TAYLOR, Registration No. 5,973,842, which does not appear to include Taylor’s consent despite inquiry by the USPTO in Office Action (Official Letter) About Applicant’s U.S. Trademark Application, Serial No. 88/171,688 (filed Oct. 26, 2018).

42. *Hot Stuff Foods, LLC v. Mean Gene’s Enters., Inc.*, 468 F. Supp. 2d 1078, 1086, 1090, 1093 (D.S.D. 2006).

43. *Id.* at 1092 (emphasis omitted).

44. *Krause v. Krause Publ’ns, Inc.*, 76 U.S.P.Q.2d 1904, 1906, 1913 (T.T.A.B. 2005); see *In re New John Nissen Mannequins*, 227 U.S.P.Q. 569 (T.T.A.B. 1985).

USPTO filewrapper.<sup>45</sup> Likewise, when Donald Kaplan objected to the registration of D.B. KAPLAN DELICATESSAN without his consent, the TTAB held that with the “buy out” agreement he entered into providing that the mark became “the property of D.B. Kaplan Delicatessen, Inc. (or any assignee),” he implicitly consented to the registration.<sup>46</sup> Decades earlier, after the USPTO refused registration of the mark LITTLE DEBBIE and a design including a portrait of the applicant’s daughter because it did not include her written consent, the TTAB reversed refusal because the mark owner had submitted that consent with a prior related application.<sup>47</sup> The Board did so even though the individual shown in the logo had been a minor at the time of the first registration and was no longer a minor at the time of the second.<sup>48</sup> The difference between these two lines of cases seems to rest on whether, as in the first set, the named individual had granted consent to use but not to register the mark, or whether, as in the second set, the named individual had assigned the mark or consented to the registration (explicitly or implicitly) even if their consent was not made of record with the USPTO for that particular registration. Courts have also considered equitable defenses like licensee estoppel in balancing parties’ rights in these disputes.<sup>49</sup>

When the person named in the mark is a minor, they cannot themselves consent to the inclusion of their name in a registered mark unless domiciled in a state in which they can enter into binding legal obligations and sue or be sued; in most states, that means they must be at least eighteen.<sup>50</sup> Instead, a parent or legal guardian must sign the consent, “clearly setting forth his or her status as a parent or legal guardian.”<sup>51</sup> There is no particular form a consent must take or

---

45. *Coscarelli v. ESquared*, No. 18-CV-5943 (JMF), 2021 WL 5507034, at \*1, \*11 (S.D.N.Y. Nov. 24, 2021).

46. *In re D.B. Kaplan Delicatessen*, 225 U.S.P.Q. 342, 342–43 (T.T.A.B. 1985).

47. *In re McKee Baking Co.*, 218 U.S.P.Q. 287, 287 (T.T.A.B. 1983).

48. *Id.*

49. *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemp. Dance, Inc.*, 43 F. App’x 408, 414 (2d Cir. 2002); *Butkus v. Downtown Athletic Club of Orlando, Inc.*, No. CV 07-2507 PA (JWJx), 2008 WL 2557427, at \*4, \*6 (C.D. Cal. Apr. 2, 2008); *Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 989 F.2d 985, 990 (8th Cir. 1993), *abrogated by Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014).

50. Just as the Trademark Examining Attorney may inquire as to whether a mark names a specific person, they may (but are not required to) also inquire as to whether the person named is a minor and, if so, where the minor is domiciled. *See, e.g.*, Office Action (Feb. 10, 2019), U.S. Trademark Application Serial No. 88/171,688 (filed Oct. 26, 2018) (application for RITA ANGEL TAYLOR, Registration No. 5,973,842) (inquiring whether Taylor is a minor, which state Taylor is domiciled in, and whether that state allows minors to enter into binding legal obligations).

51. TMEP § 1206.04(a) (May 2024).

language that it must include.<sup>52</sup> In practice that means the consent can vary from a single sentence to several pages long. Approaches are inconsistent: while some consents are signed only by a parent,<sup>53</sup> others include signatures of both the minor and a parent,<sup>54</sup> or the minor and both parents.<sup>55</sup> And sometimes the consent is simply signed by the minor, likely because the USPTO was unaware the individual named was a minor at the time.<sup>56</sup>

If the minor is domiciled in a state in which they *can* enter into binding legal obligations, they can also be the named applicant and owner of the mark,<sup>57</sup> obviating the need for a signed consent. But if the minor is supposed to be the owner but is unable to be listed as applicant or owner according to state law, the Trademark Manual of Examining Procedure (TMEP) specifies that “the application should be filed in the name of a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian.”<sup>58</sup> For example, the owner of the registration for NICOLETTE GRAY, the name of a YouTube influencer who was sixteen at the time of the application to register the mark, is listed as “Dr. Nina M. Gray, parent of Nicolette Gray.”<sup>59</sup> Here too, errors are not uncommon, as

52. The examining attorney may provide sample language, e.g.: “The following format is suggested: ‘I, LeBron James Jr., consent to the registration of my name, portrait, or signature, ‘BRONNY’, as a trademark and/or service mark with the USPTO.’” Final Office Action (Mar. 7, 2023), U.S. Trademark Application Serial No. 97/204,165 (filed Jan. 5, 2022).

53. *E.g.*, Written Consent to Registration, U.S. Trademark Application Serial No. 90/893,811 (filed Aug. 20, 2021) (application for RUMI CARTER trademark); Consent to Registration, U.S. Trademark Application Serial No. 86/880,938 (filed Jan. 20, 2016) (application for JOJO SIWA, Registration No. 5,324,515); Written Consent to Register Name of Individual, U.S. Trademark Application Serial No. 90/160,801 (filed Sept. 4, 2020) (application for RIVER ROSE trademark).

54. *E.g.*, Declaration of Nicolette Gray, U.S. Trademark Application Serial No. 88/039,887 (filed July 16, 2018) (application for NICOLETTE GRAY, Registration No. 5,686,154); Application by Ivana Trump to Register Name “Ivanka,” U.S. Trademark Application Serial No. 76/308,615 (filed Sept. 6, 2001) (application for IVANKA, Registration No. 2,658,736); Consent to Use Name or Likeness, U.S. Trademark Application Serial No. 85/909,665 (filed Apr. 19, 2013) (application for NICK ZIOBRO, Registration No. 4,461,524); Declaration Authorizing Use of Name of Living Individual, U.S. Trademark Application Serial No. 88/666,278 (filed Oct. 23, 2019) (application for BILLIE EILISH, Registration No. 6,063,610); Declaration of Justin Bieber, U.S. Trademark Application Serial No. 77/875,868 (filed Nov. 18, 2009) (application for BIEBER FEVER trademark).

55. *E.g.*, Written Consent, U.S. Trademark Application No. 85/770,288 (filed Nov. 2, 2012) (application for HERE COMES HONEY BOO BOO, Registration No. 4,602,081).

56. *See, e.g.*, Consent to Register, U.S. Trademark Application Serial No. 77/434,986 (filed Mar. 28, 2008) (consent signed by then-minor Miley Cyrus to register MILEY for nine different trademark/service mark applications).

57. TMEP § 803.01 (May 2024).

58. *Id.*

59. NICOLETTE GRAY, Registration No. 5,686,154; *Nicolette Gray: YouTube Star*, FAMOUS BIRTHDAYS, <https://www.famousbirthdays.com/people/nicolette-grey.html> [https://perma.cc/8HG9-6M2V] (last visited Oct. 24, 2024).

where a then-eleven-year-old Jamie Lynn Spears was listed as the owner of a registration for JAMIE LYNN SPEARS.<sup>60</sup>

The provision that “the application should be filed in the name of a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian” appears in the TMEP section entitled “Who May Apply,”<sup>61</sup> indicating that it addresses how the applicant should be listed when the real applicant is a minor, rather than requiring that *any* registration that includes a minor’s name must be owned by that minor. The USPTO does not require that parents registering children’s names as marks structure ownership in that way—the parents can choose to list themselves as owners *or* to make the children owners. The registration for actor Harrison Cone, sixteen at the time of the application to register his name as a mark, is simply owned by his parent, listed as Emory Cone.<sup>62</sup> Other parents who have registered their children’s names as marks have opted to do so through a corporate entity. When Beyoncé and Jay-Z applied to register RUMI CARTER, the name of their then-four-year-old daughter, in fifteen different classes of goods and services, they made the owner BGK Trademark Holdings, LLC.<sup>63</sup> And early registrations for KENDALL & KYLIE, the names of two of Kris Jenner’s daughters, then teenagers, are owned jointly by Kendall Jenner, Inc., and Kylie Jenner, Inc., with Kris consenting to the registrations on behalf of each child.<sup>64</sup> While the minor may have some current or future stake in the corporate entity or some separate agreement providing for partial ownership or a portion of profits, the USPTO neither requires such provision nor has the ability to ascertain whether it exists.

60. U.S. Trademark Application Serial No. 76/511,430 (filed Apr. 18, 2003) (application for JAMIE LYNN SPEARS trademark); *Jamie Lynn Spears*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Jamie\\_Lynn\\_Spears](https://en.wikipedia.org/wiki/Jamie_Lynn_Spears) [<https://perma.cc/B6ZL-5EAU>] (last visited Oct. 24, 2024).

61. TMEP § 803.01.

62. HARRISON CONE, Registration No. 5,972,164; HARRISON CONE, Registration No. 5,972,163; Consent to Register, HARRISON CONE, Registration No. 5,684,357 (initially filed with Harrison Cone’s signature on the consent; applicant then filed a new consent signed by Emory Cone as parent following USPTO inquiry); *see also* Response to Office Action, U.S. Trademark Application Serial No. 88/171,688 (filed Oct. 26, 2018) (application for RITA ANGEL TAYLOR, Registration No. 5,973,842) (application initially filed by minor Rita Angel Taylor; owner amended to John Richard Taylor following Office Action inquiry); *Harrison Cone*, FAMOUS BIRTHDAYS, <https://www.famousbirthdays.com/people/harrison-cone.html> [<https://perma.cc/U5GW-QA57>] (last visited Oct. 24, 2024).

63. U.S. Trademark Application Serial No. 90/893,811 (filed Aug. 20, 2021) (application for RUMI CARTER trademark); Caché McClay, *Beyoncé’s Twins Turn 7: A Look Back at the Pregnancy Announcement for Rumi and Sir Carter*, USA TODAY, <https://www.usatoday.com/story/entertainment/music/2024/06/13/beyonce-jay-z-twinssir-rumi-carter-birthday/73971607007/> [<https://perma.cc/NS74-HK7E>] (last updated June 13, 2024, 5:00 AM).

64. U.S. Trademark Application Serial No. 85/424,058 (filed Sept. 15, 2011) (application for KENDALL & KYLIE, Registration No. 4,455,503).

The TMEP contains no explicit mechanism by which an individual who has consented to the registration of their name, signature, or portrait can revoke consent, nor does it require any proof of ongoing consent. When registrants file maintenance documents attesting to continued use in commerce, a current consent is not part of the package. And if an applicant files additional applications for marks that name an individual for the same goods or services as the prior registration for which they obtained consent, they need not submit a new consent, but only inform the USPTO of the existence of the old one.<sup>65</sup>

### III. NORMATIVE GOALS OF § 2(C)

The goals of trademark law are often identified as protecting consumers against confusion or deception; incentivizing and rewarding producers' investment in brands and products; and promoting commercial efficiency. The prohibition on registering a mark that includes the name, portrait, or signature of a living individual without their consent serves all of these goals,<sup>66</sup> especially as consumers increasingly become accustomed to viewing famous individuals' names and nicknames—not just more traditional corporate brand names and logos—as marks. Conversely, marks based on an individual's name or identity but neither owned nor controlled by that individual are more likely to deceive consumers and gum up the information and efficiency functions of trademarks.<sup>67</sup> The Supreme Court in *Vidal v. Elster* recently upheld the constitutionality of the names clause, citing a long history and tradition of restricting trademarks containing names.<sup>68</sup>

In addition to serving broader trademark goals, the names clause protects individuals' right to use their own name in business, a notion the Supreme Court calls “deeply rooted in American mores,”<sup>69</sup> and enables them to safeguard their reputations.<sup>70</sup> Professor Rothman points out that the earliest justifications for extending trademark protections “focused on protecting a *person's*

65. TMEP § 1206.04(c) (citing *In re McKee Baking Co.*, 218 U.S.P.Q. 287, 288 (T.T.A.B. 1983)).

66. *Vidal v. Elster*, 144 S. Ct. 1507, 1521–22 (2024); *id.* at 1529, 1531 (Barrett, J., concurring).

67. *Identity Thicket*, *supra* note 23, at 1329–30.

68. *Elster*, 144 S. Ct. at 1519.

69. *Id.* (quoting B. PATTISHALL ET AL., TRADEMARKS & UNFAIR COMPETITION § 2.06 (2001)).

70. *Id.* at 1521–22; *see also* *Rick v. Buchansky*, 609 F. Supp. 1522, 1539 (S.D.N.Y. 1985) (noting that the consent requirement's purpose is “to protect one who, for valid reasons, could expect to suffer damage from another's trademark use of his name” (quoting *Martin v. Carter Hawley Hale Stores, Inc.*, 206 U.S.P.Q. (BNA) 931, 933 (T.T.A.B. 1979))).

good name and their reputation in a particular industry, rather than the reputation of a separate business entity,” concerns that remain a focus in the current federal statute and case law applying it.<sup>71</sup> The TMEP characterizes § 2(c)’s consent requirement as recognizing “the right of privacy and publicity that a living person has in his or her identity,” citing numerous TTAB decisions,<sup>72</sup> and the Federal Circuit has characterized § 2(a) as embracing the concepts of the rights of privacy and publicity<sup>73</sup> and furthering related goals. Professor Rothman has explored in depth the “identity thicket” where § 2(a), § 2(c), and right of publicity overlap and conflict, noting “the deeply rooted respect given in trademark and unfair competition laws to protecting individual autonomy and dignity” at their intersection.<sup>74</sup>

In *The Inalienable Right of Publicity*, Rothman argues that all of the traditional justifications for rights of publicity—including privacy, consumer protection, “autonomy, dignity, natural rights, labor-reward, and unjust enrichment”—are rooted in the rights and interests of the individual named (the “identity-holder”), not the third party who might license or be assigned those rights (the “publicity-holder”).<sup>75</sup> The interests of the identity-holder and publicity-holder are not always aligned: where athletes assign their publicity rights to the National Collegiate Athletics Association (NCAA), or singers to a record label, or children to their parents, the publicity-holder can act in ways that “significantly limit the future professional opportunities of the [identity-holders] and constrain their ability to develop and direct their own identities.”<sup>76</sup> What’s more, “[a] publicity-holder can limit what an identity-holder can say or do and can compel speech and associations” by the identity-holder.<sup>77</sup> What happens when a parent registers their child’s name

71. *Identity Thicket*, *supra* note 23, at 1294–95.

72. TMEP § 1206 (May 2024) (citing *In re ADCO Indus.–Techs., L.P.*, 2020 U.S.P.Q.2d 53786, at \*10–11 (T.T.A.B. 2020)).

73. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983); *see also In re Hoefflin*, 97 U.S.P.Q.2d (BNA) 1174, 1175–76 (T.T.A.B. 2010) (Section 2(c) was “intended to protect the intellectual property right of privacy and publicity that a living person has in his/her identity”); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (citing Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, in *ADVERTISING LAW IN THE NEW MEDIA AGE* 159, 170 (Practising L. Inst. 2000)).

74. *Identity Thicket*, *supra* note 23, at 1293–94.

75. Jennifer E. Rothman, *The Inalienable Right of Publicity*, 101 *GEO. L.J.* 185, 187 (2012) [hereinafter *Inalienable*].

76. *Id.* at 188.

77. *Id.* at 210; *see also Identity Thicket*, *supra* note 23, at 1328 (noting that the broad injunction issued in Hayley Paige Gutman litigation means that “JLM is able to compel Gutman’s speech and appearances by using her name, likeness, and social media feeds as if she is ‘speaking’”).

or image as a trademark for something that the child fundamentally opposes, such as guns, beauty pageants, or an anti-transgender website? Section 2(c) functions in part to protect individuals against others misappropriating their right of publicity by registering marks that comprise their names or images as federal trademarks. The same principles Rothman discusses apply equally to parents and third parties registering the names or images of minors as marks.

Section 2(c) and sister provision § 2(a) also protect consumers and help avoid confusion.<sup>78</sup> When a trademark comprises the name or image of a living individual, it not only violates that individual's rights, it also misleads consumers. Fans will expect, for example, when they see apparel bearing the mark JOJO SIWA, that musician Siwa is the source of those goods, is associated or affiliated with them, or has licensed the use of her name to the producer and thus approves of the goods and profits from their sale. In analyzing whether the right of publicity should be alienable, Rothman considers “separability”—whether it is possible to actually separate identity-holders from their identities and the ability to control those identities.<sup>79</sup> If it is not possible, as Rothman concludes is often the case,<sup>80</sup> then the right of publicity should not be alienable. And in fact, marks that reference specific individuals are and have long been transferable only on a “far more limited basis” than other kinds of marks.<sup>81</sup> As Dončić argued in his petition to cancel his mother's registrations, he was not affiliated or associated with the registrant, nor did he approve or sponsor the goods or services sold under the trademark that included his name, but due to his fame and reputation, consumers presumed a connection with him.<sup>82</sup> That is because it is somewhere between difficult and impossible for consumers to separate identity-holders from their identities.<sup>83</sup> Nike has been selling Air Jordans for forty years, using basketball star Michael Jordan's name and image in connection with the sale of sneakers, and

78. *Identity Thicket*, *supra* note 23, at 1307–08 (2022) (citing *Hornby v. Tjx Cos.*, 87 U.S.P.Q.2d 1411, 2008 WL 1808555, at \*13 (T.T.A.B. 2008); *In re ADCO Indus.–Techs., L.P.*, 2020 U.S.P.Q.2d 53786, at \*13 (T.T.A.B. 2020)).

79. *Inalienable*, *supra* note 75, at 225–28.

80. *Id.* at 228; *see also Identity Thicket*, *supra* note 23, at 1326.

81. *Identity Thicket*, *supra* note 23, at 1309.

82. Petition to Cancel at ¶¶ 18–19, *Luka99, Inc., v. Poterbin*, No. 92080484 (T.T.A.B. Sept. 6, 2022).

83. *See Identity Thicket*, *supra* note 23, at 1326 (“Marks should not be transferable when they . . . are inseparable from that person. When a personal mark indicates to the public that services or goods are provided by or made by a particular person, then no separation is possible.”).

consumers still (rightfully) associate those marks with both the sneaker brand (Nike) and the man the product is named for (Jordan).<sup>84</sup> So misappropriation of an individual's name—of the kind § 2(c) is designed to prevent—can cause both dignitary and commercial harms,<sup>85</sup> and the commercial harms affect both the individual and the public.<sup>86</sup>

#### IV. MEANS TO CHALLENGE UNDESIRE REGISTRATIONS

In the words of the Supreme Court, a “trademark’s ‘primary’ function” is a commercial one: to “tell[] the public who is responsible for a product.”<sup>87</sup> What happens if someone whose name was registered as a trademark when they were a minor decides that the existence of that registration is inconsistent with their wishes and values? It may be, in cases like those of Justin Bieber or JoJo Siwa, that they granted consent as a teenager or child without truly understanding to what they were consenting;<sup>88</sup> or it may be, in cases like those of River Rose Blackstock or Asahd Khaled, that their parents granted their consent to the registrations before the children could even read or write, let alone comprehend what the registrations would mean for them.<sup>89</sup> Minors may come to discover their parents or managers use their name marks in ways that they disapprove of or exploit their names for profit without sharing that profit with the

84. Michael Jordan earns 5% on all Jordan brand sales from his deal with Nike. See Owen Poindexter, *Nike, Jordan Score with Jordan Brand's Record Haul*, FRONT OFF. SPORTS, <https://frontofficesports.com/jordan-more-than-doubled-his-nba-career-earnings-in-2022-from-nike-deal/> [<https://perma.cc/T2QG-D7NT>] (last updated Feb. 3, 2023, 2:59 PM).

85. *Inalienable*, *supra* note 75, at 205–06 (“Misappropriation of one’s identity can cause both commercial *and* dignitary harms.”); see also Zachary R. Semancik, Comment, *Withdrawing Lanham Act Section 2(c) Consent: What Should Courts Do?*, 28 MARQ. INTELL. PROP. & INNOVATION L. REV. 91, 99–100 (2024) (estimating Dončić makes \$6–\$10 million a year on endorsements, which the inability to control his right of publicity would jeopardize); Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1352–53 (2009) (emphasizing the negative impact of dignitary harms on “the human spirit as a result of unauthorized uses of the [individual’s] persona deemed objectionable on moral grounds”).

86. *Inalienable*, *supra* note 75, at 230–31 (“The value of the endorsement is dependent on its voluntariness and accuracy as a reflection of the identity-holder’s preferences. It may work a significant injury to the consumer to allow publicity-holders to sponsor or endorse products without the identity-holders’ approval.”).

87. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1583 (2023).

88. See RESTATEMENT OF CHILD. & THE L. § 20.20 cmt. a (AM. L. INST., Tentative Draft No. 5, 2023) (noting two rationales underlying infancy doctrine: that “minors . . . are assumed to be improvident, impulsive, and inclined to undertake contractual obligations based on their short-term desires” and “minors are assumed to be susceptible to the overreaching of adults who may want to take advantage of their naiveté and impulsivity”).

89. See *supra* notes 20, 40 and accompanying text.

minors whom the marks reference.<sup>90</sup> Even worse, they may come to find—as did Dončić—that a parent registering their name as a mark means that their own later applications to register their name will be refused based on likelihood of confusion<sup>91</sup> because that registration gave their parent priority. How can they challenge registrations that reference them to which they no longer consent or never truly consented at all?

The very sections of the Lanham Act that triggered the consent requirement in the first place might give individuals bases to cancel the marks that reference them. Say, for example, that Stormi Webster, who was less than two years old when her mom, Kylie Jenner, applied to register her name as a trademark for cosmetics, realizes she does not want to sell or be associated with cosmetics. Perhaps she could petition to cancel the registration or sue the entity that owns it. The Lanham Act provides for a cancellation petition at any time on several bases, including § 2(a) and § 2(c).<sup>92</sup> Webster could likely also sue on these bases.<sup>93</sup>

Applying a § 2(a) analysis to Stormi Webster’s petition, it would appear the criteria are met: the mark STORMI is the same as her name; the mark, as one within the broader Jenner portfolio, would be recognized as pointing uniquely to her; she has chosen not to be connected with the goods sold under the mark; and her fame (and relationship to the rest of the Jenners) is such that, when the mark is used with cosmetics, consumers would presume a connection with Stormi. Supermodel Twiggy successfully petitioned to cancel TJX’s registration of TWIGGY as a trademark for children’s clothing on this basis, even though the USPTO was aware of the model at the time of the registration and did not require that TJX obtain her consent.<sup>94</sup>

90. See Andrew Gilden & Eva E. Subotnik, *Copyright’s Capacity Gap*, 57 U.C. DAVIS L. REV. 899, 950–51 (2023) (listing examples of minors in the entertainment industry “who have reported being overworked and exploited by family members who stood to receive substantial amounts of money through them”); Complaint at 7–8, *Gonzales v. Gonzales*, No. 2:15-cv-05498 (C.D. Cal. July 20, 2015) [hereinafter *Gonzales Complaint*] (alleging Chachi Gonzales “never received any portion of the [\$90,000.00] compensation and/or revenues resulting from the [licensing of her name mark], nor was any of the revenue put into trust on her behalf”).

91. U.S. Trademark Application Serial No. 90/768,512 (filed June 11, 2021) (application for LUKA DONCIC trademark); U.S. Trademark Application Serial No. 90/790,987 (application for ORIGINAL HOOPS OF LUKA DONCIC trademark); see also *Gonzales Complaint*, *supra* note 90, at 12 (alleging Chachi’s mother’s registration of Chachi’s name mark prevented her from registering her own CHACHI mark).

92. 15 U.S.C. § 1064(3).

93. 2 MCCARTHY, *supra* note 25, at § 13:37 (5th ed. 2024) (“Violation of § 2(c) can probably be raised in litigation as the basis for a challenge to the status or validity of the registration of a mark and even of a registered mark with incontestable status.”) (footnote omitted).

94. *Hornby v. TJX Cos.*, 87 U.S.P.Q2d 1411, 2008 WL 1808555, at \*13, \*17 (T.T.A.B. 2008).

The Board found that “Twiggy” had been petitioner’s personal and professional name for more than thirty years when Tjx’s registration issued, was uniquely associated with her, and was sufficiently famous that consumers would connect her with the mark.<sup>95</sup>

Meanwhile, § 2(c) prohibits registration of any mark that includes the name of a particular living individual without their consent.<sup>96</sup> If TRUMP TOO SMALL<sup>97</sup> and LEBRON LAMES<sup>98</sup> can be refused under § 2(c) despite their negative connotations and the unlikelihood consumers would perceive connection to or endorsement by Donald Trump or LeBron James, it follows that § 2(c) should also provide a basis for Stormi to cancel the STORMI mark. Courts have held that “[a]n individual who has not consented to registration of his name can raise violation of § 2(c) to bar or, possibly, revoke registration.”<sup>99</sup> Dončić, who revoked his consent by letter to his mother and then petitioned to cancel a trademark registration containing his name that was owned by her despite having previously granted consent when he was nineteen (i.e., of sufficient age), argued that he has no affiliation with his mother’s goods or services and no longer consents to them, so the registrations violated § 2(c) even if his consent was valid at the time of registration.<sup>100</sup>

Dončić and his mother settled their dispute, so the TTAB did not have an opportunity to weigh in on either his ability to revoke consent or his petition to cancel the registration based on false association, false endorsement, or likelihood of confusion.<sup>101</sup> But at least one court has held that once consent has been granted, the registration cannot be challenged on those bases. In Chloe Coscarelli’s challenge to the continued use of her name for restaurant services, a court noted that cancellation of a trademark is available if the mark “was obtained”

95. *Id.* at \*16.

96. 15 U.S.C. § 1052(c).

97. U.S. Trademark Application Serial No. 87/749,230 (filed Jan. 10, 2018) (application for TRUMP TOO SMALL trademark); *Vidal v. Elster*, 144 S. Ct. 1507, 1513 (2024) (affirming USPTO’s refusal to register).

98. U.S. Trademark Application Serial No. 85/553,386 (filed Feb. 27, 2012) (application for LEBRON LAMES trademark).

99. *Kemp v. Tysonfood Grp., Inc.*, No. 5-96-173 (JRT/RLE), 2004 WL 741590, at \*4 (D. Minn. Mar. 30, 2004) (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13:37 (4th ed. 1994)); *Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 989 F.2d 985, 989 (8th Cir. 1993).

100. Petition to Cancel at 8–9, *Luka99, Inc. v. Poterbin*, No. 92080484 (T.T.A.B. 2022); see also Pearl, *supra* note 11, at 394 (describing Dončić’s argument that he has no affiliation with his mother’s goods or services and withdrew consent for them).

101. Townsend, *supra* note 12.

contrary to § 2(c).<sup>102</sup> “By the statute’s plain terms, therefore, the relevant inquiry is whether the suggestion of a connection was false when the trademark was registered, not when the trademark cancellation claim is filed.”<sup>103</sup> The court concluded “any suggestion of connection with Coscarelli was not false when the By Chloe trademark was registered,” Coscarelli was an adult when she entered into an agreement that purportedly gave the hospitality company her consent to use her name as a trademark, but the Board applied the same principle in the Little Debbie case, even though the individual pictured in the trademark was a minor at the time of consent.<sup>104</sup> The same principle is technically true for Stormi: given her mother’s consent on her behalf to register STORMI as a trademark, a court could rule the registration was not obtained contrary to § 2(a) or § 2(c).

Fraud, however, is also a basis for cancellation under the Lanham Act. Fraud on the USPTO “occurs when an applicant . . . knowingly makes false, material representations of fact in connection with [an] application [to register a trademark].”<sup>105</sup> If Stormi were to argue that Kylie, in signing the consent, was not acting in Stormi’s best interest but was actually acting in breach of her fiduciary duty—because she planned to exploit Stormi’s name and keep the profits for herself—that could give the TTAB or a court a basis to treat the consent as fraudulent and invalidate the registration.<sup>106</sup> Unlike some of the other bases for invalidation discussed in this section, fraud is not susceptible to a laches defense.<sup>107</sup> The Lanham Act also includes broad provisions granting the USPTO and civil courts the right to “rectify the register”;<sup>108</sup> those provisions could provide courts or the Board other avenues to cancel

---

102. *Coscarelli v. ESquared Hosp. LLC*, No. 18-CV-5943 (JMF), 2021 WL 5507034, at \*11 (S.D.N.Y. Nov. 24, 2021). The court further highlights the use of past tense in this section of the statute in contrast to Congress’s choice “to use the present tense in other clauses of Section 1064(3).” *Id.*; see also Jahner, *supra* note 12 (quoting Professor Mary LaFrance, “the mark wouldn’t constitute false association even if Doncic disapproved, because the mark ‘truthfully conveys’ he consented in the past”).

103. *Coscarelli*, 2021 WL 5507034, at \*11.

104. *Id.*

105. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 47–48 (Fed. Cir. 1986); *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 U.S.P.Q.2d 1899, 2006 WL 936993, at \*6 (T.T.A.B. 2006).

106. *Gilden & Subotnik*, *supra* note 90, at 948–49 (“Whoever is named guardian, trustee, or custodian with respect to the child’s property takes that position subject to fiduciary obligations to act in the best interests of the child.”).

107. *Hornby v. TJX Cos.*, 87 U.S.P.Q.2d 1411, 2008 WL 1808555, at \*7 (T.T.A.B. 2008).

108. 15 U.S.C. § 1119 (2018); *Id.* § 1068.

the registration or perhaps transfer ownership to Stormi when she reached the age of majority.<sup>109</sup>

The Lanham Act also bars registration of matter that is deceptive. Marks will be refused as deceptive if (1) they misdescribe “the character, quality, function, composition or use of the goods”; (2) prospective purchasers are likely to believe the misdescription; and (3) the misdescription is material—it is “likely to affect a significant portion of the relevant consumers’ decision to purchase.”<sup>110</sup> A minor whose name or image is registered as a trademark for goods or services unrelated to them could conceivably seek to cancel the registration by arguing that it is unrelated to them. For example, STORMI misdescribes the character of the goods by implying that they are endorsed by or connected with her, prospective purchasers are likely to believe that misdescription, and the deception is material—consumers are buying the cosmetics in part because they’re fans of Stormi, and they might otherwise choose different cosmetics, especially if they knew Stormi was offended by and opposed to the registration’s existence.

In addition to those bases for challenge, Stormi might also argue that the registration infringes her common law trademark rights. If she begins selling related goods—for example, haircare products—using the mark STORMI, consumers will undoubtedly expect that STORMI cosmetics and STORMI haircare products share a common source. In fact, if her common law marks become famous, she might have a cause of action for dilution.<sup>111</sup> But these solutions suffer from a fatal flaw. Just as Dončić’s mother was deemed the prior user of his name mark and his applications were initially refused based on likelihood of confusion with it,<sup>112</sup> the corporate entity that holds the registration that includes Stormi’s name is the prior user of the STORMI mark. If anything, it is the registrant that can enjoin

109. *But see* Jackson v. Lynley Designs, Inc., 729 F. Supp. 498, 500–01 (E.D. La. 1990) (dismissing Jackson’s fraud claim because she did not exploit her name as a trademark and therefore, lacked standing to challenge the registration).

110. TMEP § 1203.02(b) (May 2024); *see also* *In re* Spirits Int’l, N.V., 563 F.3d 1347, 1356 (Fed. Cir. 2009) (stating that for a mark to be deceptive, “a significant portion of the relevant consuming public” must be deceived); *In re* Budge Mfg. Co., 857 F.2d 773, 775 (Fed. Cir. 1988) (presenting an earlier version of the standard later defined in TMEP § 1203.02(b)).

111. Federal registration is one of the factors courts will consider in determining whether a plaintiff’s mark is famous among the general consuming public, but it is not a requirement. 15 U.S.C. § 1125(c)(2); Walker Wear LLC v. Off-White LLC, 624 F. Supp. 3d 424, 429 (S.D.N.Y. 2022).

112. Office Action (Mar. 9, 2022), U.S. Trademark Application Serial No. 90/768,512 (filed June 11, 2021) (application for LUKA DONIC trademark); Office Action (Mar. 9, 2022), U.S. Trademark Application Serial No. 90/790,987 (filed June 23, 2021) (application for ORIGINAL HOOPS OF LUKA DONCIC trademark).

Stormi from using the mark on related goods, rather than the other way around. In *Okerlund*'s case, the court canceled the registrations for MEAN GENE'S BURGERS because they identified a living individual without his consent, but did not enjoin the licensee's use. In fact, it enjoined *Okerlund*—Mean Gene himself—under § 43(a) from competing with the exclusive licensee by using the Mean Gene's marks for related goods or services, citing actual confusion.<sup>113</sup>

Stormi could also bring a claim under state right of publicity law, which in most states requires only unauthorized commercial use of her identity regardless of whether consumers are confused. False endorsement, or even false advertising claims under Lanham Act § 43(a)(1)(B), might also be plausible if Stormi can demonstrate that consumers are likely to be deceived into believing that Stormi endorses the goods sold under the STORMI mark. When designer Joseph Abboud sold his label to JA Apparel and transferred the right to use his name marks, then announced plans to launch a new line using the trademark JAZ, JA Apparel sued Abboud for trademark infringement and dilution.<sup>114</sup> Abboud counterclaimed, alleging misappropriation of right of publicity, false endorsement, and false advertising, arguing that he had not transferred his rights of publicity along with his name marks.<sup>115</sup> The Second Circuit remanded the contract question to the district court,<sup>116</sup> which held Abboud had not transferred his right of publicity to JA Apparel,<sup>117</sup> but neither court ultimately addressed the question of whether Abboud could succeed on his counterclaims despite having sold his business and assigned his name rights to the company; as Rothman notes, the litigation “left most of the really thorny questions unanswered.”<sup>118</sup> In another dispute over whether a family that had sold its business and name marks to another entity had also transferred their rights of publicity, two different federal courts reached conflicting conclusions—one held that the family had not transferred their rights to the purchaser and so could not be enjoined from using their names to promote a competing product,<sup>119</sup> and the other held

---

113. *Hot Stuff Foods, LLC v. Mean Gene's Enters., Inc.*, 468 F. Supp. 2d 1078, 1091, 1093, 1098–99 (D.S.D. 2006).

114. *JA Apparel Corp. v. Abboud*, 568 F.3d 390, 393–94 (2d. Cir. 2009).

115. *Id.* at 390, 394–96.

116. *Id.* at 393.

117. *JA Apparel Corp. v. Abboud*, 682 F. Supp. 2d 294, 322 (S.D.N.Y. 2010).

118. *Identity Thicket*, *supra* note 23, at 1284.

119. *Traeger Pellet Grills LLC v. Traeger*, No. 8:19-cv-1714-AEP, 2019 WL 4305502, at \*1, \*6–7 (M.D. Fla. Sept. 11, 2019).

that the same family via the same agreement *had* transferred their publicity rights to the purchaser and therefore *could* be enjoined from promoting their new venture.<sup>120</sup>

A real-life counterpart to the Stormi hypothetical is the story of Olivia Gonzales Hildén, known widely as “Chachi.” Chachi is a dancer, choreographer, designer, and actress<sup>121</sup> with 1.5 million Instagram followers.<sup>122</sup> In 2011, at age fifteen, she was a member of the dance crew that won the 2011 season of competition show *America’s Best Dance Crew*.<sup>123</sup> While her dance career was taking off, Chachi designed and popularized a particular style of pants she called “Chachimomma” pants; she brought the idea and design to her mother, Guadalupe Gonzales, and the two began manufacturing and selling them together.<sup>124</sup> At the height of Chachi’s fame, Guadalupe successfully applied to register CHACHI MOMMA as a federal trademark for apparel without her minor daughter’s knowledge or permission; later she went on to register other CHACHI-formative marks.<sup>125</sup> She also entered into a licensing agreement with a company called Infusion, Inc., signing on behalf of her daughter without Chachi’s authorization.<sup>126</sup> Guadalupe did not set aside a penny of the \$90,000 she made from the licensing deal for Chachi.<sup>127</sup>

When Chachi became aware that her mother had registered her name as a trademark and was profiting off of her reputation, she confronted her. As a result, mother and daughter became estranged, and Chachi was adjudicated an emancipated minor shortly after.<sup>128</sup> Chachi sued her mother, alleging common law trademark infringement; unfair competition; passing off; misappropriation of right of publicity; violation of state deceptive

120. Traeger Pellet Grills, LLC v. Dansons US, LLC, 421 F. Supp. 3d 876, 887, 890–91 (D. Ariz. 2019).

121. Gonzales Petition for Cancellation, *supra* note 17, at 7.

122. Chachi Hilden (@chachigonzales), INSTAGRAM, <https://www.instagram.com/chachigonzales/?hl=en> [<https://perma.cc/5QVJ-Y3QH>] (last visited Aug. 27, 2024).

123. Gonzales Complaint, *supra* note 90, at 5.

124. *Id.* at 5–6.

125. CHACHI, Registration Nos. 5,184,220, 5,184,221; CHACHI MOMMA, Registration Nos. 4,220,215, 5,184,222, 5,184,223; CHACHIPANTS, Registration No. 4,782,005; Jennifer E. Rothman, *Child Star Chachi’s Lawsuit Against her Mother Is Dismissed*, ROTHMAN’S ROADMAP TO THE RIGHT OF PUBLICITY (Jan. 8, 2016), [https://rightofpublicityroadmap.com/news\\_commentary/child-star-chachis-lawsuit-against-her-mother-dismissed/](https://rightofpublicityroadmap.com/news_commentary/child-star-chachis-lawsuit-against-her-mother-dismissed/) [<https://perma.cc/5A88-JJ6V>].

126. Gonzales Complaint, *supra* note 90, at 7.

127. *Id.* at 7–8.

128. *Id.* at 8.

trade practices law; and false advertising.<sup>129</sup> She also alleged that her mother had failed to obtain approval of the licensing agreement from the California courts in violation of California law and failed to set aside required funds in trust for her benefit.<sup>130</sup> The relief Chachi requested included express abandonment or cancellation of six trademark applications or registrations.<sup>131</sup> At the same time, she filed a petition with the TTAB to cancel those name mark registrations on similar grounds, along with fraud on the USPTO,<sup>132</sup> false suggestion of a connection with a living individual,<sup>133</sup> and failure to obtain consent.<sup>134</sup> Because the USPTO had not identified CHACHI MOMMA as a reference to Chachi Gonzales at the time of registration, it had not required consent.<sup>135</sup> If it had, of course, Guadalupe would simply have consented on her daughter's behalf, as she did for the license agreement. The USPTO would have treated that consent as valid.

#### V. PROPOSALS

The principle that minors can disaffirm their contracts “has as its basis the public policy concern that minors should not be bound by mistakes resulting from their immaturity or the overbearance of unscrupulous adults.”<sup>136</sup> Whether or not a consent to register qualifies as a contract, there is good reason for trademark law to incorporate this principle.

Of course, there are countervailing principles protecting both the registration's owner and the public. If, for example, Kelly Clarkson invests resources and time into making RIVER ROSE a beloved brand of children's books, or Ivana Trump's IVANKA perfume becomes wildly successful after years of use, should Clarkson and Trump's daughters be able to cancel the registrations for the marks used on those products named in tribute to them? (If a parent gives a daughter and a brand the same name, does she cede

129. *Id.* at 1–2.

130. *Id.* at 8.

131. *Id.* at 21. The case has since been dismissed without prejudice for failure to prosecute. Order and Notice to Parties, *Gonzales v. Gonzales*, No. 2:15-cv-05498 (C.D. Jan. 1, 2016).

132. *Gonzales* Petition for Cancellation, *supra* note 17, at 4–5.

133. *Id.* at 10.

134. *Id.* at 9; Chachi withdrew cancellation proceedings and the TTAB dismissed with prejudice in 2017. *Chachi Gonzales Brands, LLC v. Gonzales, CHACHI MOMMA, Registration No. 4,220,215* (T.T.A.B. 2017). The CHACHI MOMMA registration was later abandoned. *CHACHI MOMMA, Registration No. 4,220,215*.

135. See filewrappers for Registration Nos. 5,184,223, 5,184,222, 4,220,215.

136. *Simmons ex rel. Grenell v. Parkette Nat'l Gymnastic Training Ctr.*, 670 F. Supp. 140, 144 (E.D. Pa. 1987).

control of the latter because it makes reference to the former?). Likewise, if the public becomes accustomed to seeking out RIVER ROSE books and IVANKA perfume, will a forced name change at their namesakes' behest undercut the efficiency-related goals of trademark law and constitute deadweight loss? Trademark law offers laches and acquiescence as defenses to infringement and other causes of action to protect both producers and the public.<sup>137</sup> And courts and lawmakers have long recognized rights to parental authority and family autonomy in other contexts—if parents are empowered to make decisions about their children's education, medical treatment, vaccination, social media use, and much more, shouldn't they also be entitled to make decisions about registering their children's names as marks?

Further, some celebrity parents have indicated that their registrations are at least partly defensive—they believe that if they wait eighteen years to register their high-profile kids' names as marks, someone else may beat them to the punch.<sup>138</sup> While trademark registration must be based on use, and anyone who applies to register the name of an individual will be required to get consent if the name will be recognized as referencing the individual, names like “Blue Ivy,” “River Rose,” and “Chicago West” make it possible and plausible for an unrelated applicant to persuade the USPTO that their mark is not a reference to a specific person. The same may be true of first names like Stormi or Asahd. When the Massachusetts wedding planner who owned a registration for BLUE IVY for event planning services opposed Beyoncé and Jay-Z's application to register their daughter's name, the couple ultimately succeeded in registering BLUE IVY CARTER, but only after a battle that lasted several years.<sup>139</sup> Lawyers and managers often encourage celebrity parents and parents of budding celebrities to file trademark applications to register marks that include their kids' names, highlighting commercial incentives to capitalize on the parents' or children's

---

137. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 31:1, 31:41 (5th ed. 2024).

138. See, e.g., Complaint at ¶¶ 1, 3, Khaled v. Bordenave, No. 1:18-cv-05187, 2018 WL 2761578 (S.D.N.Y. Apr. 29, 2019) [hereinafter Khaled Complaint] (“trademark pirates . . . have intentionally targeted Khaled and his son by using and applying to register” trademarks including ASAH D); STORMI COUTURE, Registration No. 5,584,893 (showing a third party filed an application to register STORMI COUTURE as a trademark a month after Stormi Webster was born).

139. *Beyoncé Wins Trademark Fight for Blue Ivy's Name*, NEWS 24 (July 17, 2020), <https://www.news24.com/life/arts-and-entertainment/music/beyonce-wins-trademark-fight-for-blue-ivy-s-name-20200717> [<https://perma.cc/334E-5GBH>].

renown.<sup>140</sup> And parents may see value in registration timed to coincide with viral moments or peak fame, as with BIEBER FEVER, CHACHI MOMMA, or HERE COMES HONEY BOO BOO. One celebrity parent has asserted in legal documents that their child “became instantly famous in his own right upon his birth,” leading “pirates” to apply to register his name and related catchphrases as trademarks;<sup>141</sup> another characterized their then-six-year-old as a “cultural icon.”<sup>142</sup>

To a certain extent, questions about the use of a minor’s name and likeness as trademarks extend beyond the reach of the USPTO—the USPTO can only register marks and cancel registrations; it has no power to condone or prohibit use in commerce.<sup>143</sup> And whether marks are or can be registered is a separate question from whether they can be used in commerce,<sup>144</sup> although registration bars may<sup>145</sup>

140. See FR Kelly, *Why Are Celebrities Trade Marking Their Children’s Names?*, LEXOLOGY (July 20, 2017), <https://www.lexology.com/library/detail.aspx?g=4f7b84bb-f84c-490e-bf92-9aad96a93f3a> [<https://perma.cc/2VZS-KS2H>]; Josh Gerben, *Celebrities File Trademarks to Protect Their Children’s Names – Should You?*, GERBEN IP, <https://www.gerbenlaw.com/blog/celebrities-attempt-to-protect-their-childrens-names-und-er-trademark-law/> [<https://perma.cc/SV8Q-5F4K>] (last visited Aug. 28, 2024); Rebecca Zilberman, Note, *“That’s Hot!” Celebrities Use Trademarks to Add to Their Wealth, but Is It Excessive?*, 42 LOY. L.A. ENT. L. REV. 273, 315 (2022).

141. Khaled Complaint, *supra* note 138, at ¶¶ 1, 2.

142. Dreu Dixon, *Celebmarks: The Battle of Trademarks Between Celebrities and Small Business Owners and How We Protect the Little Guys*, 45 T. MARSHALL L. REV. 21, 34 (2020); see also Expert Report of Bruce G. Silverman at ¶¶ 41, 46–47, *Blue Ivy v. BKG Trademark Holdings*, Opposition No. 91234467 (Aug. 13, 2018) (characterizing Blue Ivy as a “fashionable and famous young entertainer” and “fashionista” with “an enormous personal following”).

143. See *Vidal v. Elster*, 144 S. Ct. 1507, 1538 (2024) (Sotomayor, J., concurring) (“[D]enying a trademark holder these ancillary benefits [of registration] does not prevent him from using his mark in commerce or communicating any message incidental to the mark.” (citing *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177, 188 (2007)); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2316 (2019) (Sotomayor, J., concurring in part and dissenting in part).

144. *In re Tam*, 808 F.3d 1321, 1344 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *aff’d sub nom. Matal v. Tam*, 582 U.S. 218 (2017) (“Common law rights to a mark may . . . be limited to marks ‘entitled to registration.’ Whether a user of an unregistrable . . . mark has any enforceable common law rights is at best unclear.”); Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 884–85 (2017) (“[T]his seemingly basic . . . question—what are the protections available to an unregistrable term under federal law?—can easily be answered two different ways under current law.”).

145. *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776, 784 (1992) (Stevens, J., concurring) (“§ 43(a) is properly understood to provide protection in accordance with the standards for registration in § 2.”); Rebecca Tushnet, *Unregistrable Means Unprotectable by Sec. 43 as Well*, REBECCA TUSHNET’S 43(B)LOG (June 4, 2014, 10:02 AM), <https://tushnet.blogspot.com/2014/06/unregistrable-means-unprotectable-by.html> [<https://perma.cc/67XU-9TLC>] (discussing *Renna v. County of Union*, No. 2:11–3328, 2014 WL 2435775 (D.N.J. May 29, 2014), which held that marks barred from registration by § 2 are ineligible for federal enforcement under § 43(a)).

or may not<sup>146</sup> affect users' ability to enforce those marks and the Supreme Court has suggested that the bar on registration of someone's name without their consent reflects and formalizes common law tradition.<sup>147</sup> Federal registration also "confers important legal rights and benefits on trademark owners who register their marks,"<sup>148</sup> including constructive notice of the registrant's claim of ownership; prima facie evidence of ownership, validity, distinctiveness, and exclusive rights; the power to stop importation into the United States of infringing products; the right to use the ® symbol; and the option to use the registration as a basis for foreign trademark registration.<sup>149</sup>

Minors should not have to resort to lawsuits or cancellation petitions to reassert control of their name or image as registered trademarks, both because those processes are far too onerous and because—as discussed above—they might not win, especially if courts and the TTAB apply the same principles to disputes over name marks that reference minors that they have when adults have sought to revoke consent.<sup>150</sup> Instead, the USPTO can build in a mechanism that allows someone on whose behalf consent was granted as a minor to revoke it or requires the minor's ratification of consent in order to maintain the registration once the minor named in the mark reaches the age of majority. The agency is best positioned to address this problem and negate or reduce the need for burdensome administrative or federal litigation. It is within the USPTO's power to do so with one or more minor tweaks to the registration and maintenance processes, and arguably those tweaks will better reflect the goals of the Lanham Act's § 2 bars as well as time-honored contract principles protecting minors.

---

146. Jason Rantanen, *Guest Post by Prof. McKenna: The Implications of Blackhorse v. Pro-Football, Inc.*, PATENTLY-O (June 19, 2014), <https://patentlyo.com/patent/2014/06/implications-blackhorse-football.html> [<https://perma.cc/U2PT-STNC>] (arguing that cancellation does not make marks unenforceable under federal law); *In re Tam*, 808 F.3d at 1374–75 (Lourie, J., dissenting) (“[T]rademark rights . . . are not limited to those marks deemed registrable by the USPTO. Section 43(a) of the Lanham Act is available to protect all designations of origin, even—indeed, especially—those that cannot be registered under Section 2(a).”) (quotation and citation omitted).

147. See *Elster*, 144 S. Ct. at 1520, 1522. Contrast with Justice Barrett's concurrence, *Id.* at 1530–31 (Barrett, J., concurring) (asserting no historical rule exists that mirrors the modern names clause and citing pre-Lanham Act cases that conflict with the registration bar).

148. *Matal v. Tam*, 582 U.S. 218, 226 (2017) (citing *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015)).

149. *Why Register Your Trademark?*, USPTO, <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> [<https://perma.cc/7JXC-3D67>] (last visited Aug. 28, 2024).

150. See *supra* text accompanying notes 45–48.

The simplest solution would be to disallow the registration of marks that consist of or include a minor's name, signature, or portrait, given that such marks require written consent but the minor is legally incapable of consenting to the registration on their own behalf per the USPTO's current policy. That approach may be too drastic for some, though, especially in situations where children are actively pursuing careers in entertainment or sports and are involved in the decision-making process, and whose parents are sincerely acting in their best interest. Waiting eighteen years may also mean forfeiting the ability to register or use the mark, especially with common names like "Katy Perry" or ambiguous names like "Chicago West," though use in commerce without registration is always possible and can reserve rights and priority. Barring registration of this category of marks may also exceed the bounds of the USPTO's rulemaking authority, given that the Lanham Act does not explicitly bar them, and may run afoul of the First Amendment.

Alternatively, the USPTO can require consent by the minor at the registration stage and again when the child reaches the age of majority—the consent to register the individual's name would be deemed to expire once the individual is legally capable of consenting.<sup>151</sup> Under state law, minors can repudiate a contract before they reach the age of majority<sup>152</sup> or within a reasonable window after reaching it.<sup>153</sup> In addition, the USPTO can require that renewed consent accompany any standard registration renewals. Section 8 renewal is required for all registrations between the fifth and sixth anniversary of registration; after that, registrants must submit a declaration of use and application for renewal every ten years.<sup>154</sup> The trademark office already requires registrants submit a current specimen with each of those filings to

151. Rothman makes a similar point related to minor's rights of publicity: "When children are the relevant identity-holders, additional protections are needed. We may want to provide a right to reclaim waivers or licenses of publicity rights upon reaching an age of majority." *Inalienable*, *supra* note 75, at 235.

152. See 5 WILLISTON ON CONTRACTS, *supra* note 16, at § 9:5; see also *Halbman v. Lemke*, 298 N.W.2d 562, 564 (Wis. 1980) (infancy doctrine is designed to protect minors "from foolishly squandering their wealth through improvident contracts with crafty adults who would take advantage of them in the marketplace"); 2 THOMAS A. JACOBS & NATALIE C. JACOBS, CHILDREN & THE LAW: RIGHTS AND OBLIGATIONS § 11:12 (2024) ("Even where a minor has not 'contracted' for specific services or goods, it has been held that a release signed by a minor waiving future liability for injuries may be disaffirmed.") (footnote omitted).

153. The time period for repudiation after reaching the age of majority ranges and can depend on both state law and reasonableness given the specific facts at hand. See 5 WILLISTON ON CONTRACTS, *supra* note 16, at § 9:5 for examples.

154. 15 U.S.C. § 1058(a)(1)–(2) (2018); *Registration Maintenance/Renewal/Correction Forms*, USPTO, <https://www.uspto.gov/trademarks/maintain> [<https://perma.cc/8U3Q-XWXX>] (last visited Aug. 8, 2024).

maintain rights,<sup>155</sup> so requiring a current consent for those registrations that include the name or portrait of a minor would constitute a simple update to the process. If a celebrity applied to register their baby's name as a trademark shortly after the baby's birth, they would consent on the baby's behalf at application, consent again five to six years later when the child is seven or so, and consent a third time ten years after that. While the parent would still be empowered to consent on their child's behalf, they might be more open to input from their child as the child matures. If the parent renews consent against the child's will, the child should have the opportunity to disaffirm that consent when they reach the age of majority or within a reasonable window after that birthday. In the TTAB case about the "Little Debbie" logo that comprised a portrait of a living individual, the USPTO made a similar argument on appeal; the TTAB mentioned in dicta that "the Examining Attorney's implication that the Office should re-examine the proof of consent in view of the fact that the subject of the mark is no longer a minor is beyond the scope of the statute and the rules."<sup>156</sup> But perhaps it's time to revisit whether that is truly the case and should remain so.

Another approach would be for the USPTO to require that only the minor can apply to register their name, signature, or portrait—i.e., the minor must be the owner of the registration as outlined in the TMEP, where the parent is explicitly filing on the child's behalf, and the registration must be automatically assigned to the minor when they reach the age of majority. While adults can allow any third party, including a person or corporate entity, to register a mark that includes their name,<sup>157</sup> this different treatment of minors' name marks is justified because the minor's parent should not be able to consent in a way that binds the minor permanently, and a consent filed with the USPTO is treated as doing exactly that. Anyone who saw Hayley Paige weeping on Instagram over her lost ability to use her name as a trademark in the bridal industry<sup>158</sup> knows that such contracts are not to be taken lightly; many adults have come to regret

---

155. *Keeping Your Registration Alive*, USPTO, <https://www.uspto.gov/trademarks/maintain/keeping-your-registration-alive> [<https://perma.cc/87LE-N5EY>] (last visited Sept. 7, 2024).

156. *In re McKee Baking Co.*, 218 U.S.P.Q. 287, 1983 WL 51954, at \*1–2 (T.T.A.B. Apr. 15, 1983).

157. TMEP § 803.01 (May 2024) (stating that juristic persons, including corporations, can file a trademark application); 15 U.S.C. § 1052(c) (which prohibits applicant from receiving a trademark of another's likeness without written consent).

158. Rachel Hosie et al., *Wedding-Dress Designer Hayley Paige Got Her Name Back. Here's a Complete Timeline of Her Yearslong Legal Battle with JLM Couture*, BUS. INSIDER (May 28, 2024, 5:33 PM), <https://www.businessinsider.com/hayley-paige-gutman-jlm-couture-controversy-timeline-2021-1> [<https://perma.cc/4VWK-UGEX>].

entering into them, or publicly stated that they did not adequately understand them at the time.

Lastly, the USPTO could create a mechanism for the minor to revoke consent at any time before reaching the age of majority, just as minors can disaffirm contracts at any time. Various data protection laws, including the California Consumer Privacy Act and the European Union's General Data Protection Regulation (GDPR), offer models for revocable consent.<sup>159</sup> At the USPTO, the process could be as simple as filing a declaration or submitting a form, just as owners of registered marks who choose to abandon them can enact their decision with minimal paperwork. While this option runs somewhat counter to some of trademark law's goals by creating a pathway to cancel registration of distinctive marks that remain in use, it would be worth the trade-off to protect those who were minors when their name marks were registered because someone else consented on their behalf.

The USPTO should also add checkboxes to its standard application forms asking whether the applicant is eighteen or older (or is of the age of majority in the state in which they're domiciled); whether the trademark comprises the name, portrait, or signature of a living individual; and, if so, whether that individual is eighteen or older. This change would remove the onus from individual examining attorneys to affirmatively ask whether the mark referenced a specific person and whether the applicant and/or the individual named was a minor, reducing the likelihood that the registration would fail to comply with the TMEP. Those minor changes are well within the USPTO's power and their impact far smaller than the recent change requiring applicants to list their domicile, a change the Federal Circuit in *Chestek* ruled did not require notice and comment because it did not constitute a substantive change but only a procedural one.<sup>160</sup>

In fact, the Administrative Procedure Act requires that new regulations be subject to notice and comment, but explicitly excludes "interpretive rules, general statements of policy, or rules of agency organization, procedure, or practice."<sup>161</sup> Given the Federal Circuit's reasoning in *Chestek*, many of the changes I propose might constitute interpretive rules or rules of agency procedure that would not require

---

159. CAL. CIV. CODE § 1798.192 (2023); 2016 O.J. (L 119) 679; Eugenia Politou et al., *Forgetting Personal Data and Revoking Consent Under the GDPR: Challenges and Proposed Solutions*, 4 J. CYBERSECURITY 1, 7 (2018) <https://doi.org/10.1093/cybsec/tyy001> [<https://perma.cc/XT68-TKDU>] (discussing revoking consent under GDPR).

160. *In re Chestek PLLC*, 92 F.4th 1105, 1110 (Fed. Cir. 2024).

161. 5 U.S.C. § 553(b)(A).

notice and comment. On the other hand, the USPTO or a court could find that some or all of these changes alter substantive rights of applicants and would trigger notice and comment—which might not be a bad thing. Notice and comment would offer numerous benefits, including soliciting input from practitioners, celebrities, parents, and other stakeholders about which changes best serve the interests of minors and the goals of trademark law. The process itself creates opportunities for parties to share information and anecdotes that might not have occurred to the agency and can help determine best practices and garner buy-in from applicants.

Looking beyond the USPTO, while it is difficult to impose rules on contracts between parties, it is possible to put forth a set of best practices that might guide conscientious parents and companies partnering with young athletes, entertainers, and influencers. One way for parents to avoid a situation like the dispute between Dončić and his mother, Mirjam Poterbin, is for them to enter into a separate agreement at the time of the registration; if Dončić and Poterbin had agreed that his consent to register marks that include his name was revocable and revocation triggered Poterbin's cancellation of the registration, then revoking consent in accordance with the contract would have enabled the family to avoid litigating their disagreement in the press and (at least partially) at the TTAB.<sup>162</sup>

Parents might also consider committing in written agreements to protect and preserve the minor's interests, such as by setting aside for the minor a portion of all profits from the sale of goods or services using the mark, involving the minor in brand-related decision-making as they mature, or assigning the registration to the child when they reach the age of majority. Currently, laws in a number of states protect child actors and entertainers from exploitation by mandating, among other things, that 15% of a child performer's earnings be placed in trust for them and managed by a trustee.<sup>163</sup> In recent years, critics have increasingly argued that influencers, vloggers, reality television participants, and athletes who are minors deserve the same protections.<sup>164</sup> Abuse in the entertainment industry, particularly

---

162. See *supra* text accompanying notes 12, 82.

163. Gildea & Subotnik, *supra* note 90, at 951–52 (“These provisions [known as Coogan Laws] acknowledge that there can be a serious risk of self-dealing and wasteful depletion of the child's earnings, and ensure that at least a portion of these earnings be held in trust until they reach the age of majority.”).

164. See Marina A. Masterson, Comment, *When Play Becomes Work: Child Labor Laws in the Era of “Kidfluencers,”* 169 U. PA. L. REV. 577, 607 (2021) (arguing that rather

of minors, has recently received increased scrutiny.<sup>165</sup> If states or Congress enacts or expands protective laws for child performers, they could include children whose names or images are registered as trademarks among those for whom a portion of earnings must be set aside or other precautions taken.

Courts and the TTAB also have roles to play. While these questions remain mostly untested, it seems inevitable that they will soon come to a head. In considering an individual's objection to someone else's use or registration of a mark that references them, if the use or registration began when the individual was a minor, courts should take into account that any consent granted was in some respects illusory and should not bind the minor in perpetuity against their will. While the statute's requirement of consent at the time of registration, as well as principles of estoppel and detrimental reliance, might carry the day for an adult plaintiff, courts should consider how current USPTO practices may be used to exploit minors and deprive them of autonomy. When a trademark dispute involving existing registrations or pending applications is litigated, the Lanham Act permits district courts to "determine the right to registration, order the cancellation of registrations," and "rectify the register with respect to the registrations of any party to the action."<sup>166</sup> A similar statutory provision arms the Director of the USPTO with the power to modify a registration or rectify the register.<sup>167</sup>

Consumer protection principles should also carry the day. When someone is no longer associated with a brand that was named for them as a child, and consumers believe or expect that they are, the interests of the person whose name was registered without real consent and of the consumers who seek to understand source and endorsement should trump those of the registrant, whose use was once acceptable but has come to be infringing, deceptive, or violative of the minor's rights of publicity.

---

than simply expanding current child actor laws, lawmakers should tailor protective laws specifically to child influencers).

165. See, e.g., QUIET ON SET: THE DARK SIDE OF KIDS TV (Netflix 2024) (a documentary detailing abuses at Nickelodeon); *ID's 'Quiet On Set: The Dark Side of Kids TV' Exposes Toxic Working Environment on Dan Schneider's Popular Teen TV Series*, CRIMEFEED (Feb. 8, 2024), <https://www.investigationdiscovery.com/crimefeed/news/ids-quiet-on-set-the-dark-side-of-kids-tv-exposes-toxic-working-environment-on-dan-schneiders-popular-teen-tv-series> [<https://perma.cc/CC85-BUAE>].

166. 15 U.S.C. § 1119; *BBK Tobacco & Foods LLP v. Cent. Coast Agric., Inc.*, 97 F.4th 668, 670, 672 (9th Cir. 2024) (ordering cancellation of four pending trademark applications); *Hot Stuff Foods, LLC v. Mean Gene's Enters.*, 468 F. Supp. 2d 1078, 1089–90 (D.S.D. 2006) ("a district court has concurrent power under Section 37 of the Lanham Act to order cancellation so that an entire controversy may be expediently resolved in one forum.").

167. 15 U.S.C. § 1068.

This Article has focused on minors whose parent or guardian consents on their behalf to the registration of their name, portrait, or signature as a trademark, which seems to violate the spirit of the consent requirement and undermine a number of the goals of the very provisions that require that consent. But many of the arguments above also apply to adults who consent to the registration of *their* name, portrait, or signature as a trademark and later wish to revoke consent or terminate their relationship with the party to whom they consented. While adults can be assumed to have entered freely into such partnerships, their own inability to revoke consent may also undermine trademark and right of publicity goals like promoting efficiency, avoiding consumer confusion, and maintaining individuals' control of their identities. So while a policy change for minors seems most urgent and prompted this Article, there is also a broader case to be made that registration of someone else's name mark should always require ongoing consent.

## VI. CONCLUSION

Under the current system, a parent can unilaterally register their child's name as a trademark just as easily as they can register the name of their dog, cat, or hamster. But a child is not a pet. Professor McKenna has written that:

An individual's choices . . . can be viewed as the text of her identity, and unauthorized uses of a person's identity in connection with products or services threaten to recreate that text and affect the way the individual is perceived by others. The individual uniquely bears the costs of those perceptions, both emotional and economic, and she therefore has an interest in controlling the uses of her identity.<sup>168</sup>

Parents who register the name, portrait, or signature of their minor children as federal trademarks are wresting control of their children's identity in ways that may permanently harm them. Taking a cue from contract law principles to provide minors with opportunities to revoke their consent to register their names as marks, without the burden of filing a lawsuit or petition to cancel, best protects those minors' dignitary and economic interests while simultaneously protecting consumers.

---

168. McKenna, *supra* note 21, at 229.