

This Is Our Super Bowl Blog Post. Now Come and Get Us, NFL!

By [Ken Basin](#) on February 3, 2012



Unless you live [here](#), I'm assuming you're aware of a little football game taking place this weekend between the [New York Giants](#) and the [New England Patriots](#). (Hey, wait a minute, that sounds [awfully familiar](#)...)

I'm as excited as anyone for the game, which is why, this Sunday, I might try to find a local bar hosting a Super Bowl party. But I'll probably be out of luck, unless I'm willing to go to a ["Big Game" party](#) instead. And if I'm feeling spendthrift — the always-confusing word that sounds like "thrifty" but [actually means "profligate"](#) — I might try to pick up a new flat-screen TV at a Super Bowl sale. But unless I'm willing to settle for one of those ubiquitous "Big Game" sales, I'll probably be forced to stick with [what I've got](#).

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Every year, while every sports yak in America is obsessing over Super Bowl scouting reports, every business in America is trying to capitalize on the game. But most of them aren't using the words "Super Bowl" to do so, and the reason is fairly obvious: the phrase "Super Bowl" is trademarked by the NFL, which is famously protective of its intellectual property. Moreover, the privilege of using the phrase "Super Bowl" in advertising is one of the valuable rights bestowed by the NFL upon its advertisers and promotional partners — which gives the NFL extra incentive to keep freeloaders from poaching the phrase (thereby diminishing its value to potential paying promotional partners).

But what if the NFL is wrong? What if I really could check out the *Super Bowl party* at my favorite watering hole without them being subjected to the threat of legal doom?

Guess what, kiddies: I can.

The Legal Doctrine the NFL Doesn't Want You to Know About

Unless you went to law school, you've probably never heard the phrase "nominative fair use" — and the NFL likes it that way (which is why I will probably have received a cease-and-desist letter from the NFL's lawyers by the time you finish reading this post).

Most people have a general understanding of what a trademark is, even if they can't put it into words. "Microsoft" is a trademark. "Mercedes Benz" is a trademark. "Fresca" is a trademark. (Let me help: a trademark is a limited property right in a particular word, phrase, or symbol that is used to identify an individual or company as the source of a given product or service.) And most people realize that companies have the power to block others from using their trademarks without permission. (For example, I probably can't sell you a "Dell" computer that isn't actually manufactured by Dell.) But that power, while broad, is not boundless.

Courts recognize that it's virtually impossible to refer to particular products or services without using protected trademarks — how can I review the new Apple iPad without using the words "Apple" or "iPad"? That's why the law allows the public to freely use a protected trademark *nominatively*, i.e., to *describe* the product or service underlying the mark, often in the only way that makes any sense. We lawyers call this idea the "nominative fair use" doctrine. And it applies even where the speaker's goal in using the mark is to describe and promote *its own* products or services.

The Ninth Circuit (which covers California and much of the western United States) uses a three-part test for nominative fair use: (1) the product or service in question must be one not readily identifiable without use of the trademark; (2) only so much of the mark may be used as is reasonably necessary to identify the product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. And while the particular facts are always vital in any intellectual property dispute, most of our beleaguered "Big Game" companies could probably pass this test.

The Super Bowl is the Super Bowl. Sure, you could call it the "NFL Championship Game," but the law doesn't require you to go out of your way to make some oblique reference to something that is principally readily identifiable only by its trademarked name. For example, former Playboy Playmate Terri Welles [successfully fended off a lawsuit](#) brought by Playboy, which sought to block her from referring to herself on her website as a former "Playboy Playmate of the Year" (*two* trademarks in that phrase). Why? Because she was a former Playboy Playmate of the Year, and the law didn't require her to refer to herself as "the Erstwhile Most Prominent Model for a Certain Well-Known Men's Publication Featuring Highly Airbrushed Disrobed Ladies." Similarly, generic boy band version 1.0 New Kids on the Block [could not stop a group of newspapers](#) from conducting surveys about which NKOTB member was the best and most popular (I vote Joey Mac!), because the newspapers were using the NKOTB trademark to describe *the band's services* rather than their own, and because they couldn't even ask the question in any meaningful way without using the "New Kids on the Block" mark. For the same reason, if a business wants to throw an event or a promotion that is themed around and coincides with the Super Bowl, it shouldn't have to avoid using the only term that will clearly refer to the occasion. (After all, what if your idea of a big game party involves water buffalo?)



Which means that, as long as companies are careful in their advertising to respect factors 2 and 3 of the Ninth Circuit’s nominative fair use test — not using words like “official” that suggest NFL sponsorship or endorsement, avoiding the use of prominent logos or other NFL regalia, not making the words “Super Bowl” dwarf the name of their own product/service in size and/or prominence, and probably including a few decently prominent disclaimers (“this program/promotion is not in any way affiliated with or endorsed by the NFL or its teams”) for good measure — they can probably pass the nominative fair use test. In other words, throw a Super Bowl party, hold a Super Bowl sale, and dispense with this *wink wink nudge nudge* nonsense. And the case is even stronger for those who don’t want to go as far as tagging their event or promotion with the words “Super Bowl,” but simply convey factual information like, “We guarantee your new TV will arrive before the Super Bowl.” (At present, many retailers are too scared to say even that.)

So If It’s That Easy, Why Doesn’t Everybody Do It?

You may now be saying to yourself, “Unless this blogger is some kind of genius with never-before-heard-of legal insight [*I’m not, but thank you*], why isn’t everyone using the phrase ‘Super Bowl’ just like he says instead of cowering behind these ‘Big Game’ euphemisms?” Because sometimes, [being legally right only matters if you can afford to prove it](#).

By most accounts, the NFL’s annual “Super Bowl” enforcement campaign doesn’t discriminate among business big and small, national and local, or even for-profit and non-profit. (Case in point: the Internet features [several “how to” guides](#) for *churches* that want to throw [not-calling-them-Super Bowl parties](#) without getting sued. But before you think the NFL is uniquely evil in this regard, remember that, in 1996, [performing rights organization ASCAP sued the Girl Scouts for unlicensed jamboree sing-alongs](#). Which is to say, the NFL is *non-uniquely* evil.) And when it sends out its annual volley of aggressive cease-and-desist letters claiming egregious trademark infringement and irreparable harm, the NFL isn’t worried about nominative fair use doctrine because, at least to date, it hasn’t been worth anybody’s time and money to fight them on it.

If you’re a small business owner, you don’t have the time, the resources, or the inclination (especially the resources) to be the legal test case/martyr and fight the good fight for harassed business owners everywhere. It’s just easier to use some “Big Game”-like euphemism and spare yourself the headache. That’s no less true for the big guys who could afford to fight the NFL on the battleground of nominative fair use — it’s just cheaper and easier to use some phrase that, at least in the weeks immediately before the Super Bowl, consumers have been effectively trained to decipher well enough for the company to get its point across.



Of course, if the NFL had its way, these companies would even be denied the refuge of the “Big Game.” In 2006, the NFL tried to trademark the phrase “Big Game” too, [finally dropping the effort](#) only after [Cal and Stanford politely reminded the NFL](#) that the schools’ annual rivalry football game had borne that moniker for more than 100 years. That, and the fact that *they were trying to trademark the phrase “Big Game,” for crying out loud.*

(Analysis of whether the NFL would be effectively shooting itself in the foot by stamping out the free publicity and widespread excitement generated for their marquee event by all this ancillary corporate advertising is a topic for a business blog, not a legal blog. But for what it’s worth, my answer would be, “You’re damn right, they would be.”)

The Law Is What It Is...Unless It Is What I Say It Is

I could end the discussion there, and you would probably leave this post properly indignant about the NFL’s overreaching legal posture. But as I often say, if the law were that simple, I wouldn’t have a job.

Remember, consumer understanding (and confusion) are the core concern of trademark law — the test for trademark infringement is whether consumers are likely to be confused as to the source of a good or service bearing an allegedly infringing mark. And the NFL’s aggressive protection of its “Super Bowl” trademark is no secret. Because the NFL is so notoriously overprotective of that phrase, the general public may have been trained to believe that anything remotely commercial that actually uses the words “Super Bowl” is NFL-sponsored, sanctioned, or affiliated. In other words, because people’s assumptions and understandings have adapted to the NFL’s practices (even if those practices don’t reflect the actual law), the law *may have functionally changed* to match the NFL’s position because people who see “Super Bowl” in commercial settings *might actually be confused* about NFL affiliation (exactly the harm that trademark law is intended to prevent).

Did I just hear the distant sound of your mind being blown?

This fascinating paradox isn’t specific to the Super Bowl context. The same argument is sometimes raised with respect to the “culture of clearance” around major movie studios and networks. Studios and networks are known to clear (that is, get a license for) virtually everything that appears on screen, even things they probably don’t need to clear (particularly on the trademark side, which is, for reasons that don’t warrant discussion here, arguably less demanding in this context than copyright law). But many people *know* that studios and networks clear everything, so if they see a recognizable brand on screen, they might assume that it was cleared, or even that it was a paid product placement. So again, we have a potential risk of consumer confusion, which means the law may have functionally changed as a result of the major players’ widely-known business practices.



Of course, this is all purely theoretical — as far as I know, no one has ever tested these arguments in court, or even verified whether the type of consumer confusion I’m postulating here is real. But even if such confusion exists, there are compelling reasons why these arguments should not carry the day. Nominative fair use doctrine is rooted in First Amendment free speech principles. As a matter of policy, we probably don’t want to open the door to major corporations effectively undermining one of our holiest constitutional provisions by flexing their muscle via overzealous and arguably abusive demand letters that are (at least initially) contrary to the law. But the legal geek in me would love to see what would happen if these theories were ever actually tested in court.

Don’t Believe Everything You Read

Unfortunately, sloppy reporting (especially in the seemingly editor-less wilderness of the Internet) only perpetuates the confusion around these legal issues. It seems like every year, just as the airwaves are flooded with “championship game”-themed advertisements, the newswires are flooded with people trying to explain the proliferation of those oblique Super Bowl non-references. For instance, this time last year, [Yahoo! Sports blog “Shutdown Corner”](#) explained that retailers are wary of referencing the Super Bowl by name because “[t]he NFL is vigilant in protecting its copyrighted phrases,” but “blogs like Shutdown Corner [can] refer to the Super Bowl without penalty” because “[n]ews organizations are protected from copyright laws.”

Did you know that every time a reporter grossly misrepresents the law, somewhere, an overzealous lawyer gets a bonus? This reminds me of a game my fellow blogger Rachel Wilkes Barchie plays called [“How many gross misstatements of the law can you find in one paragraph?”](#) Let’s try to unwind this disaster in 5 sentences or less (advance warning: lawyers invariably use every page, every minute, every word they’re allowed):

Copyright law protects creative works of expression, not commercial names or pithy slogans, and the phrase “Super Bowl” is not — and cannot be — copyrighted. Trademark law protects commercial brand names, logos, slogans, and other elements that serve a source-identifying function in commerce, and *you better believe* the phrase “Super Bowl” is trademarked. News organizations *are* subject to copyright law (trademark law, too) but get somewhat extra latitude to use material subject to intellectual property protection thanks to the First Amendment. But for the reasons stated above, pretty much everyone else who follows certain common sense guidelines should probably be able use the phrase “Super Bowl” just as freely as dilettante bloggers. And finally, a pro-tip: if you’re looking for quality reporting on legal issues from non-legal outlets, look for [the ones that quote me](#).

So this Sunday, enjoy your Super Bowl party — not your “Big Game” party — without fear or shame. I know I will.