

# Who Owns Dat?

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## I. INTRODUCTION

When the New Orleans Saints made it to Super Bowl XLIV, a hot issue reappeared: who owns the phrase “Who Dat”? During the following months, an uproar over vendors making money off of the “Who Dat” phrase ensued. The phrase “Who Dat” has been used for many years by proud Saints fans. The National Football League (NFL) executed cease and desist letters to stop vendors in the area from using the phrase on merchandise, claiming its use infringes on the New Orleans Saints trademark and causes consumer confusion that the NFL is affiliated with the merchandise.<sup>1</sup> This Comment focuses on the NFL’s potential claim to “Who Dat.”

First, this Comment will discuss the history behind the “Who Dat” controversy including: the phrase’s origin, the timeline of the NFL’s claims to the phrase and the distribution of cease and desist letters, and the NFL’s subsequent backing off of the claim. Although the NFL is not currently asserting claims against those merchandisers using the phrase, this Comment will address the NFL’s potential claims and rights to the phrase with regards to legal precedent in trademark and sport merchandising. Next, this Comment will address equitable concerns regarding the benefits and costs to consumers, small business merchandisers, and the NFL. This Comment will conclude by

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1. *NFL Claims Trademark Infringement*, ESPN, Jan. 30, 2010, <http://sports.espn.go.com/nfl/playoffs/2009/news/story?id=4871697>.

demonstrating that the NFL has a high likelihood of success in ownership claims to the phrase “Who Dat,” but is unlikely to bring any causes of action or file any complaints against vendors or merchandisers using the phrase.

## II. HISTORY OF “WHO DAT”

America is often referred to as a melting pot; a diverse country full of rich and colorful histories that blend together in distinct geographical regions to create very different cultures, ethnic compositions, and dialects. It is no surprise to Americans that someone from Fargo, North Dakota, speaks with a different accent than someone living in the Deep South.

The phrase “Who Dat” is as much a geographic indicator as it is a recently popularized sports chant. It is likely that the first use of “Who Dat” was in common vernacular among certain people in the Deep South; “dat” being the locals’ pronunciation of the word “that.” The phrase probably became more commonplace when distributed throughout the region in the late 1800s because of its use in skits in minstrel shows.<sup>2</sup> Black performers would speak in local dialect to arouse humor and enhance comedy.<sup>3</sup> Black poets and song writers also popularized the phrase through their written works.<sup>4</sup> “Who Dat” was a product of black southern dialect, which still has strong roots in Louisiana and the rest of the Deep South.

Minstrel shows and Vaudeville acts remained a source of entertainment until the 1930s.<sup>5</sup> Following this period, a newer generation of comedians retained the phrase.<sup>6</sup> The Marx Brothers performed a number called “Who’s Dat Man” in blackface in the 1937 film “A Day at the Races.”<sup>7</sup>

The phrase “Who Dat,” although used in general vernacular, began to gain a reputation as a sports chant in the 1980s.<sup>8</sup> The exact event is unclear, but several sporting events are cited as the birthplace of the “Who Dat” sports chant. Some claim that St. Augustine High School in

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2. Jacqui Goddard, *Who Dat? America’s National Football League Causes Outrage over Catchphrase Ban*, THE TIMES (London), Feb. 3, 2010, at 35.

3. *See id.*

4. Patrick Generose, *New Orleans Saints: Much Ado About “Who Dat?”*, BLEACHER REPORT, Jan. 30, 2010, <http://bleacherreport.com/articles/335886-much-ado-about-who-dat>.

5. Alan Sayre, *‘Who Dat’ Got the Rights to Famous Saints Cheer?*, ASSOCIATED PRESS, Jan. 29, 2010, <http://abcnews.go.com/Sports/wireStory?id=9701026>.

6. *Id.*

7. *Id.*

8. *See* Generose, *supra* note 4.

New Orleans first associated the phrase with a sporting event when players chanted “Who dat? Who dat? Who dat talk about beat St. Aug?” on the team bus.<sup>9</sup> Others attribute the phrase as a spin-off of the Cincinnati Bengals chant “Who Dey?”<sup>10</sup>

Another possible origin of the phrase is through actual registered trademarks from the 1980s.<sup>11</sup> In 1983, two brothers, Sal and Steve Monistere collaborated with Aaron Neville and several Saints players to record “Who Dat Say They Gonna Beat Dem Saints” over a track of “When the Saints Go Marching In.”<sup>12</sup> This venture created Who Dat, Inc., which registered the Who Dat trademark in 1983 but never took the proper steps to renew the trademark; protection has since expired.<sup>13</sup> In 1983, Who Dat, Inc., unsuccessfully sued Tee’s Unlimited for printing shirts that said “Who Dat say dey gonna beat dem Saints.”<sup>14</sup> The judge ruled that neither party had exclusive rights to the phrase; thus both parties could print it on merchandise.<sup>15</sup>

Who Dat, Inc., is currently involved in a Federal trademark litigation against NFL Properties and the New Orleans Saints.<sup>16</sup> Those organizations have filed counterclaims against Who Dat, Inc., alleging that the company is attempting to cash in on the enormous goodwill associated with the brand after the Saints recent Super Bowl victory.<sup>17</sup> Litigation is ongoing and the Federal District Court for the Eastern District of Louisiana has yet to make a final ruling on the matter.

In spite of the competing claims to the phrase’s origin, the NFL might lay claims to the phrase in a number of different ways. As Professor Glynn Lunney of Tulane University Law School explained, trademarks are different from copyrights or patents and do not have to be truly original.<sup>18</sup> Thus, even though the “Who Dat” phrase is a linguistic identifier of the Deep South, that may not necessarily preclude the NFL

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9. Dave Walker, ‘Who Dat?’ Popularized by New Orleans Saints Fans When ‘Everybody Was Looking for the Sign,’ *TIMES-PICAYUNE* (New Orleans), Jan. 13, 2010, available at [http://www.nola.com/saints/index.ssf/2010/01/who\\_dat\\_popularized\\_when\\_every.html](http://www.nola.com/saints/index.ssf/2010/01/who_dat_popularized_when_every.html).

10. See Sayre, *supra* note 5.

11. Walker, *supra* note 9.

12. *Id.*

13. Interview with Glynn Lunney, McGlinchey Stafford Professor of Law, Tulane University Law School, in New Orleans, La. (Feb. 17, 2010).

14. Jacquetta White, *Who Knew Dat?: NFL Claims Ownership of Longtime Fan Phrase*, *TIMES-PICAYUNE* (New Orleans), Jan. 29, 2010, at A1.

15. *Id.*

16. *Who Dat?, Inc. v. NFL Props. LLC*, No. 2:10-CV-01333 (E.D. La. filed May 4, 2010).

17. Affirmative Defenses and Answer to Complaint at 4, *Who Dat?, Inc. v. NFL Props. LLC*, No. 2:10-CV-02296 (M.D. La. filed Apr. 21, 2010).

18. Interview with Glynn Lunney, *supra* note 13; see also Sayre, *supra* note 5.

from claiming a likelihood of confusion when the phrase is used in a way that establishes the Saints as the source identifier. For example, the NFL can assert that use of “Who Dat” with other trademarked material, such as the fleur-de-lis helmet design, is an infringement on the NFL’s trademark and may cause a likelihood of confusion that the Saints are endorsing the product, which would lead some to believe that the NFL is endorsing the product. Additionally, there is precedent that use of the Saints’ black and gold colors in connection with the phrase “Who Dat” undeniably relates to the Saints and infringes on the trademark because of a likelihood of confusion amongst consumers.<sup>19</sup> The same argument could apply to the black and gold colors themselves, which, although they existed before the Saints, are now commonly associated with the Saints.

NFL league spokesman Brian McCarthy is reported as saying that in the past year, the NFL has sent out several letters asking vendors to stop selling “Who Dat” merchandise because the unlicensed merchandise could lead Saints fans to mistakenly believe that the Saints were affiliated with the product.<sup>20</sup> This argument will be fleshed out later in this Comment and will address equity issues for licensed distributors, small unlicensed vendors, and consumers. Most noted in the press were the NFL’s cease and desist letters to Lauren Thom, owner of the Fleurty Girl T-shirt shop and the Storyville T-shirt shop in New Orleans, which shocked both New Orleans fans and vendors.<sup>21</sup>

Among the shocked members of the “Who Dat Nation” were junior U.S. Republican Senator David Vitter, from Louisiana, and Democratic U.S. House of Representative Congressman Charlie Melancon.<sup>22</sup> Senator Vitter called the NFL executives “obnoxious” and urged the NFL to either drop their ridiculous claims or to sue him.<sup>23</sup> According to *The Times*, Melancon collected “thousands of signatures on a petition entitled: ‘No one owns ‘Who Dat’ except for the Who Dat Nation.’”<sup>24</sup> As a result of this politically bipartisan and public outrage, the NFL backed down.<sup>25</sup> On February 3, 2010, *The Times* reported that the NFL had called the situation a “misunderstanding.”<sup>26</sup> Louisiana Attorney General

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19. Interview with Glynn Lunney, *supra* note 13.

20. Sayre, *supra* note 5.

21. White, *supra* note 14.

22. See Sayre, *supra* note 5. “Who Dat Nation” is the term used to describe the New Orleans Saints fan base.

23. *Id.*; Goddard, *supra* note 2, at 35.

24. Goddard, *supra* note 2, at 35.

25. *Id.*

26. *Id.*

Buddy Caldwell said, after a conference call with the NFL's counsel, that the NFL had no intention of claiming the phrase "Who Dat," which in his words would be "ridiculous."<sup>27</sup> Despite the NFL bowing to public pressure and thus foregoing claims to the popular Saints catchphrase, the issue still remains whether the NFL has a colorable claim to "Who Dat."

### III. TRADEMARK APPLICABLE LAW AND THE LANHAM ACT

Trademarks serve an important economic function in that "[t]hey enable sellers to develop reputations for quality, and they assure customers that products [and services] sold under the seller's brand will live up to that reputation."<sup>28</sup> To better serve this purpose, trademarks are awarded legal protection, most prominently under the Lanham Act.<sup>29</sup> Congress created the Lanham Act to provide "national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers."<sup>30</sup> Thus, trademark law often must balance the economic efficiency of ownership with consumer protection concerns.

To evaluate any trademark claim, it is pivotal to understand the Lanham Act's text governing trademark protection. Under the Lanham Act, "Any person who . . . uses in commerce any word, term, name, symbol, . . . or any combination thereof, . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."<sup>31</sup> One does not have to register a mark in order to have an infringement claim under the Lanham Act.<sup>32</sup> Accordingly, even in the absence of a claim based upon a registered mark per section 32 of the Lanham Act, there still may be a viable claim under section 43(a).<sup>33</sup>

Under section 43(a), an entity claiming trademark infringement must show that the defendant's use of the mark is so similar to that of the plaintiff's that the defendant's use causes a likelihood of confusion among consumers as to the origin or sponsorship of the product.<sup>34</sup> To make such a claim and to determine whether a mark is protectable, the

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27. *Id.*

28. Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 466 (2005).

29. 15 U.S.C. § 1051 (2006).

30. *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

31. 15 U.S.C. § 1125 (2006).

32. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767 (1992). However, for unregistered marks, secondary meaning (acquired distinctiveness of the mark) must be shown.

33. 15 U.S.C. § 1114; *see also id.* § 1125. Sections of the Lanham Act are often referred to by their original numbering, which was altered when Lanham became part of the United States Code.

34. *Id.* § 1051 (2005).

plaintiff must show that the mark in question is distinctive or that the mark has a secondary meaning.<sup>35</sup> Generally, a mark is distinctive when it is suggestive, arbitrary, or fanciful.<sup>36</sup> An arbitrary or fanciful mark is a mark that bears no logical relationship to the underlying product.<sup>37</sup> Arbitrary or fanciful marks are inherently distinctive, meaning they are capable of identifying an underlying product, and are given a high degree of protection.<sup>38</sup> A mark has secondary meaning when it is so closely associated with the plaintiff's goods or services that its use necessarily creates the assumption that the plaintiff is affiliated with or sponsors the product.<sup>39</sup> Thus, trademark claims involving secondary meaning revolve around who the public believes to be the source, not who actually is the source.<sup>40</sup>

Additionally, a protected mark cannot be functional.<sup>41</sup> Generally, the United States Supreme Court recognizes two tests for determining functionality.<sup>42</sup> In the traditional test, a court would determine if the feature is essential to the use or purpose of the product, or if it affects the cost or quality of the product.<sup>43</sup> Under the "competitive necessity" test, the mark is functional if the exclusive use of the feature puts competitors at a significant "non-reputation-related disadvantage."<sup>44</sup> If these factors are present, then the feature is aesthetically functional and it cannot be protected.<sup>45</sup>

To defend a section 43(a) claim, junior users of protected marks can attack a mark by asserting that the mark is not one that would be protected through lack of secondary meaning, functionality, or any of the other reasons not to protect a mark.<sup>46</sup> They can also attack a mark's

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35. See *Two Pesos*, 505 U.S. at 767 (holding that inherently distinctive trade dress need not have acquired a secondary meaning in order to be protectable under Lanham Act section 43, codified 15 U.S.C. § 1125).

36. *Id.* at 768 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (Cal. App. 1976)).

37. *Abercrombie*, 537 F.2d at 11 n.12.

38. *Two Pesos*, 505 U.S. at 768.

39. Interview with Glynn Lunney, *supra* note 13.

40. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995).

41. *Id.* at 169.

42. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33 (2001); see also *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485-86 (5th Cir. 2008).

43. *Smack*, 550 F.3d at 485-86.

44. *Id.* at 486.

45. But see *id.* at 488 (explaining how the standard of aesthetic functionality has been rejected in the Fifth Circuit).

46. Junior users are those who adopt the mark after someone else, known as the senior user, uses it first.

validity by proving that it is generic or descriptive and has no secondary meaning.<sup>47</sup>

#### IV. HISTORY OF MERCHANDISING

It was not until the 1970s that courts considered unlicensed products representing sport teams to be trademark violations. The United States Court of Appeals for the Fifth Circuit first legally established merchandising rights in *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Manufacturing, Inc.*<sup>48</sup> In that case, the National Hockey League (NHL) sought to enjoin a manufacturer from selling merchandise bearing member teams' trademarks.<sup>49</sup> The court held that for all NHL teams, "the team has an interest in its own individualized symbol" and that the manufacturer violated the individual teams' trademarks by making paraphernalia utilizing the teams' emblems.<sup>50</sup>

Scholars have said that the decision in *Boston Professional* "broke new theoretical ground and effectively wrote the confusion requirement out of the Lanham Act."<sup>51</sup> The confusion requirement was marginalized because the court in *Boston Professional* placed great emphasis on the "consumer's mental *association* between the trademark and the trademark holder."<sup>52</sup> This emphasis led the court to the presumption that confusion existed when the "trademark comprises 'the triggering mechanism' in the sale."<sup>53</sup> Notably, the *Boston Professional* analysis has been negatively reviewed, and "many, if not most, courts have required trademark holders to establish a genuine likelihood that the use will confuse consumers as to source, sponsorship, or affiliation."<sup>54</sup>

Despite the negative perception of the Fifth Circuit's analysis in *Boston Professional*, the court's decision changed the marketing reality of professional sport merchandising.<sup>55</sup> Affiliations like the National Hockey League and the National Football League own the right to control licensing of paraphernalia distinctive to their member teams.<sup>56</sup> In merchandising rights cases following *Boston Professional*, courts appear

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47. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995).

48. 510 F.2d 1004 (5th Cir. 1975).

49. *Id.* at 1008.

50. *Id.*

51. *Dogan & Lemley*, *supra* note 28, at 474.

52. *Id.* (emphasis added).

53. *Id.* By "triggering mechanism," the court was referring to situations where consumers purchased the product based on the presence of the trademark.

54. *Id.* at 475.

55. This case marked a shift away from actual confusion and toward mental association as the basis for bringing trademark infringement claims. *Id.* at 474.

56. Interview with Glynn Lunney, *supra* note 13.

to go beyond the belief that a mark confers additional value on the product itself, and now extend their reasoning to “protect[] marks that constitute (virtually) the entire product.”<sup>57</sup> With regards to the “Who Dat” controversy, the issue becomes whether consumers purchase “Who Dat” merchandise because they believe the New Orleans Saints endorsed, sponsored, or are affiliated with that product.

#### V. LEGAL PRECEDENT AND ANALYSIS

Recent decisions gravitate toward providing the rights in “Who Dat” to the NFL.<sup>58</sup> Most recently, the Supreme Court’s decision in *Qualitex* extended Lanham Act claims to protection of color schemes, which demonstrates the breadth with which the Court interprets the Lanham Act’s language.<sup>59</sup> In *Qualitex Co. v. Jacobson Products Co.*, the Court found that consumers could determine the source of a product from its distinctive color.<sup>60</sup> The *Qualitex* language lays the groundwork for the NFL claiming rights to “Who Dat” by analogizing use of the phrase to the team’s use of color, which is protectable.<sup>61</sup>

The United States District Court for the Eastern District of Louisiana relied heavily on *Qualitex* in its recent decision, *Board of Supervisors of the Louisiana State University & Agricultural & Mechanical College v. Smack Apparel Co.*<sup>62</sup> The *Smack* decision, later affirmed by the Fifth Circuit, extended Lanham Act protection to university color schemes.<sup>63</sup> To decide the trademark protection afforded to university color schemes, the Fifth Circuit in *Smack* analyzed whether the colors obtained secondary meaning and whether consumers experienced a likelihood of confusion as to the origin of the products.<sup>64</sup>

The Fifth Circuit had previously established a test to determine secondary meaning that consider the following factors: “(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant’s intent in copying the trade

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57. Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U.L. REV. 547, 615 (2006).

58. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 159 (1995); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008).

59. *Qualitex*, 514 U.S. at 174.

60. *Id.* at 162-63.

61. *See id.*

62. 438 F. Supp. 2d 653 (E.D. La. 2006).

63. *Smack*, 550 F.3d at 465.

64. *Id.* at 474.



dress.”<sup>65</sup> These factors are not dispositive of secondary meaning when present, but they do provide strong evidence that the mark serves as a source indicator.<sup>66</sup>

A court would most likely evaluate these factors in any NFL claim to “Who Dat.” The NFL, in attempting to demonstrate these factors, would have several arguments for “Who Dat” possessing secondary meaning when used in connection with the Saints. First, the NFL is a vast corporation with enough funding to accumulate consumer survey evidence and direct testimony, including those of high-priced experts needed to support the evidence and testimony favoring the NFL’s ownership claim. Also, because the “Who Dat” chant and phrase are heavily used after the Saints score touchdowns or after they win, the consumer logically associates the phrase with the Saints. Furthermore, people generally do not cheer “Who Dat” for other NFL teams. Despite the use of “Who Dey” by the Cincinnati Bengals, the use of the “Who Dat” chant has distinctly been used in conjunction with the New Orleans Saints.<sup>67</sup>

Other factors, however, work against the NFL’s potential claim. The NFL’s merchandise website contains products proclaiming “Believe Dat” but does not sell any merchandise on the website using the phrase “Who Dat.”<sup>68</sup> The NFL’s use of the phrase as a distinct mark is relatively limited, because the fans comprise the majority of usage. The phrase’s origin and association with the Saints is likely derived from a long-standing public association, and not anything the NFL did. However, the use of the phrase by the public does not preclude the NFL from having a claim to the phrase. For example, the use of the term “Coke” first originated with the consumers of Coca-Cola, and Koke, a competing soda manufacturer, was denied the right to use the name because of trademark infringement.<sup>69</sup> The Court held that the mark had an accepted meaning and indicated a single source for the product.<sup>70</sup> The Court found that the defendant’s use of “Koke” was for the purpose of capitalizing on Coca-

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65. *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998).

66. *Smack*, 550 F.3d at 476.

67. “Who Dey” would likely be considered a distinct trademark from “Who Dat” and would likely face the same ownership and infringement issues if the team were to become successful and others were to try to capitalize on the phrase.

68. *Search for “Who Dat,”* NFL SHOP, <http://www.nflshop.com/search/index.jsp?kwCatId=&kw=believe%20dat&origkw=believe%20dat&sr=1> (last visited Sept. 23, 2010). However, the NFL Shop currently posts seven items bearing the phrase “Believe Dat.” *Search for “Believe Dat,”* NFL SHOP, <http://www.nflshop.com/search/noResults.jsp?kw=who+dat> (last visited Sept. 23, 2010). A search for “Who Dat” on the NFL Shop Web site yields no results.

69. *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 145-46 (1920).

70. *Id.* at 146.

Cola's established good will.<sup>71</sup> In comparison, the NFL will likely succeed in its claim for "Who Dat" if a court finds that the phrase identifies the Saints as the particular source of the product.

Other cases also reveal that the origin of a term amongst consumers does not preclude a court from granting a remedy for trademark infringement to a company of an associated product. For example, the automaker Volkswagen manufactured a car that popularly became known as the "Bug."<sup>72</sup> The United States District Court for the Northern District of Texas held that a car servicing company infringed on Volkswagen's trademark rights, where "Bug" had retained a secondary meaning that was publically recognizable, and where its use by the car servicing company constituted unfair competition and consumer confusion as to the source or sponsorship of the service shop, which ultimately could damage Volkswagen's reputation.<sup>73</sup>

The "Coke" case and the "Bug" case represent avenues of court decision making in which the NFL can prevail over claims that the phrase "Who Dat" originated with the fans. The extension of the trademark right is not based on the origin of the mark, as it is in copyright claims. The key in this possible case is whether the phrase has developed a secondary meaning, leading consumers to automatically associate the product with the Saints and increasing the likelihood of consumer confusion when others who are not affiliated with the Saints use the mark.

In determining the likelihood of confusion, the court will most likely follow the "digits of confusion" test employed in *Smack*.<sup>74</sup> The digits test does not apply precisely to every case, but can shed light on whether "Who Dat" causes consumer confusion to affiliate the product with the NFL Saints. In applying the digits of confusion test, a court will look at the following factors: "(1) the type of mark allegedly infringed; (2) the similarity between the two marks; (3) the similarity of the products or services; (4) the identity of retail outlets and purchasers; (5) the identity of the advertising media used; (6) the defendant's intent; and (7) any evidence of actual confusion."<sup>75</sup> The court in *Smack* found that the defendant's use of the color schemes established a likelihood of

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71. *Id.* at 145.

72. Volkswagenwerk Aktiengesellschaft v. Rickard, 175 U.S.P.Q. (BNA) 563, 1972 WL 17728, at 564 (N.D. Tex. June 16, 1972).

73. *Id.* at 567.

74. Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 478 (5th Cir. 2008).

75. *Id.* (quoting Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658, 664 (5th Cir. 2000)).

confusion and that the colors had no value other than their association with the universities.<sup>76</sup>

The NFL's claim to "Who Dat" when used on memorabilia appears to satisfy certain factors of the "digits of confusion" test listed above, such as similarity between marks, similarity of products or services, identity of retailers and purchasers, and actual confusion. However, as previously noted, the NFL's actual use of "Who Dat" on memorabilia is not present on the company's merchandise Web site, but the phrase "Believe Dat" is used on paraphernalia that also uses the Saints' black and gold colors. The NFL's strongest arguments are most likely the last two "digits of confusion" factors: defendant intent and actual confusion. Merchandisers or vendors are selling the "Who Dat" paraphernalia with clear intent to make a representation of affiliation with the Saints and are targeting Saints fans with such paraphernalia. Additionally, the NFL could likely accumulate strong evidence of consumer confusion associating the phrase with the Saints through surveys. Just as the court in *Smack* found the color scheme has no value other than its association with the university, a court in this case would likely find the phrase and chant "Who Dat" has marginal, if any, value when viewed apart from its association with the Saints.<sup>77</sup>

The above cases and analogy to the *Smack* decision illustrate one aspect of the NFL's claim of trademark infringement against those using the phrase "Who Dat" on paraphernalia intended to represent an ethical connection with the Saints. Other jurisprudence focuses on another issue that would provide additional grounds for an NFL argument that it has the rights to the catchphrase in certain contexts. This issue is whether consumers are using the phrase as a trademark or just as a slogan, and the analysis demonstrates the importance of secondary meaning.

In *University Book Store v. University of Wisconsin Board of Regents*, the University of Wisconsin (University) met opposition during its registration of the "Bucky Badger" mark.<sup>78</sup> Local book stores (occasionally referred to as "the opposition") were selling merchandise with the mark on items such as clothing and other memorabilia.<sup>79</sup> The opposition to the registration of the marks argued that the letter 'W' and the name "WISCONSIN BADGERS" had been around for centuries.<sup>80</sup>

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76. *Id.* at 488.

77. *See* *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg.*, 510 F.2d 1004, 1011 (5th Cir. 1975).

78. 33 U.S.P.Q. 2d 1385 (T.T.A.B. 1994). "Bucky Badger" is the name of the University of Wisconsin mascot.

79. *Id.* at 1391-92.

80. *Id.* at 1387.

Additionally, they argued that the University did not begin to use any of the marks until the 1880s, and those individuals not affiliated with the University system had already been using the terms extensively, both prior to, and simultaneously with, University use since the 1880s.<sup>81</sup> In fact, internal documents within the University confirmed that it never claimed any ownership rights in the marks until 1988.<sup>82</sup> Accordingly, the local book stores insisted that the public did not associate the mark with the University, and the marks did not identify the University as a sponsor or endorser of the merchandise.<sup>83</sup>

The local book stores opposing the registration of the marks raised several defenses to the University's claim of the marks.<sup>84</sup> First, the opposition asserted that the University had abandoned the marks by not controlling their use.<sup>85</sup> The book stores also asserted that the mark "WISCONSIN BADGER" was "merely geographically descriptive."<sup>86</sup> Finally, the opposition argued that the marks did not actually function as marks, but instead, were an integral part of the function of the merchandise.<sup>87</sup>

The Administrative Trademark Judge (ATJ) did not agree with the book stores' assertions and allowed the University to register the marks.<sup>88</sup> Particularly, the ATJ found that the University was not required to police every infringement of the mark and that purchaser motivation was no longer the test for abandonment.<sup>89</sup> Further, the ATJ found that the marks were not geographically descriptive where, "the mark . . . would not be perceived as naming or specifying a particular geographic location and thus fails to signify a place generally known to the public."<sup>90</sup>

In disposing of the book stores' arguments, the ATJ noted that although the University was not the first to use the mark in the market, "[I]t is critical to keep in mind that none of the opposers, or any third party, has ever used such marks as its own mark to identify and distinguish the particular goods and services involved in these

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81. *Id.*

82. *Id.*

83. *See id.* at 1406.

84. It is important to point out that the defenses asserted are elaborated because the opposers to the registration enumerated them, and they are typically mentioned in trademark discussion, but these defenses "are just that—defenses—and are not grounds for opposing registration." *Id.* at 1401 n.39.

85. *Id.* at 1388.

86. *Id.*

87. *Id.*

88. *Id.* at 1406.

89. *Id.* at 1393.

90. *Id.* at 1404.

proceedings.”<sup>91</sup> The ATJ further found the marks not to be functional, and while some members of the public associated the marks with another source, the vast majority of the public would believe the University to be the source or sponsor of the mark.<sup>92</sup>

The details of *University Book Store*, explained above, provide a more complete basis for a “Who Dat” comparison than most other precedent. The NFL’s claim to the phrase hinges on three main issues: whether there is use of the mark, whether the mark is distinctive (through acquired secondary meaning) and whether the use of the mark is not geographical or functional.

First, the NFL must overcome the hurdle of utilizing the phrase in the marketplace. Unlike the University of Wisconsin’s utilization of the Badger marks, the NFL does not sell merchandised products with the phrase “Who Dat.” However, the NFL clearly utilizes the phrase in the promotion of the New Orleans Saints during games and in advertisements for the team. Indeed, the NFL may not be using the phrase on paraphernalia, because “Who Dat” did not originate within the NFL, but instead originated amongst the fans. As already established, the origin and usage by the fans does not preclude the NFL from having a claim. Like in *University Book Store*, where the marks were used in the public before the University’s adoption, the NFL would likely be able to register the mark if it were determined that the phrase was distinctive and had a secondary meaning, identifying the NFL as the source or sponsor of the merchandise.<sup>93</sup> Just as the ATJ articulated that policing was not required by the University, the NFL should not be required to police every form of potential infringement upon the mark. However, it is clear that the NFL has tried to police some uses by sending cease and desist letters to local vendors in the New Orleans area.<sup>94</sup>

In *Boston Professional*, Judge Roney began his opinion by stating, “Nearly everyone is familiar with the artistic symbols which designate the individual teams in various professional sports.”<sup>95</sup> Echoing Judge Roney’s sentiment, the ATJ in *University Book Store*, in spite of all the oppositions’ arguments, concluded that “the undisputed fact remains that a significant portion of the purchasing public associates the marks with

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91. *Id.* at 1396.

92. *Id.* at 1404-06.

93. *See id.* at 1395 (explaining that “Bucky Badger” was used by fans before the University appropriated it).

94. NFL Claims Trademark Infringement, *supra* note 1.

95. *Bos. Prof’l Hockey Ass’n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1008 (5th Cir. 1975).

[the University] as a particular source for the goods.”<sup>96</sup> For the NFL to have a claim to “Who Dat,” it would need to show that the phrase was either inherently distinctive or has a secondary meaning associated with the New Orleans Saints.<sup>97</sup> Thus, the use of the phrase on merchandise would need to be viewed as a trademark and not just a local slogan. Just like Judge Roney’s acknowledgement in *University Bookstore* of the public’s strong recognition of marks associated with professional sport teams, there is a strong affiliation between the phrase “Who Dat” and the Saints. When trying to determine whether a given term has acquired secondary meaning, courts will often look to the following factors: the amount and manner of advertising, the volume of sales, the length and manner of the term’s use, and results of consumer surveys.<sup>98</sup> To articulate these factors in the Fifth Circuit, the NFL would need to demonstrate that it utilizes the Who Dat phrase in the marketing and advertising of the Saints and the games. A court must also consider the use of the phrase in association with the Saints’ use since the 1980s. Additionally, the NFL has the resources to conduct surveys and procure testimony to demonstrate this strong affiliation. Indeed, upon such evidence, most courts would likely find that the use of the phrase on merchandise identifying the Saints as the source is a trademark violation.

Additionally, for the NFL to have a claim, the phrase “Who Dat” cannot be functional or geographic.<sup>99</sup> In *Smack*, where the Universities’ colors were used on T-shirts alluding to the Universities’ athletic programs, the Fifth Circuit articulated that the “presence of the plaintiffs’ marks serve no function unrelated to trademark.”<sup>100</sup> The court rejected the idea that the colors served another function (like camaraderie or loyalty) besides identifying the Universities as the source of the products.<sup>101</sup> With “Who Dat,” the same outcome is likely to result. The catchphrase, like the colors, serves no purpose other than the trademark purpose. In the words of the court, “other indicia used here do not make the t-shirts ‘work.’”<sup>102</sup> The argument that “Who Dat” represents loyalty or camaraderie to the City of New Orleans would not likely be successful. Since “Wisconsin Badgers” (a phrase comprised of an actual geographi-

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96. *Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 U.S.P.Q. 2d 1385, 1405 (T.T.A.B. 1994).

97. *Zatarain’s, Inc. v. Oak Grove Smokehouse*, 698 F.2d 786, 791 (5th Cir. 1983).

98. *Id.* at 795.

99. *Univ. Book Store*, 33 U.S.P.Q. 2d at 1402-06.

100. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 486 (5th Cir. 2008).

101. *Id.* at 486-87.

102. *Id.* at 486.

cal location) was not considered geographic and was allowed to be registered as a trademark, the “Who Dat” trademark at issue here would not be considered a geographical indicator.<sup>103</sup>

## VI. LEGAL AND EQUITABLE CONSIDERATIONS

Following the analysis of *Qualitex* and *Smack*, the NFL could bring suit against an infringer or a class of infringers for trademark violation.<sup>104</sup> The legal implications of a suit of this kind might result in a politically motivated decision. For a suit of this kind against a vendor, the NFL would most likely be required to sue in Louisiana in order for the court to have personal jurisdiction over the alleged infringers. Louisiana would not be a wise venue choice for the NFL because the issue faces the most controversy, and especially opposition, there. Politicians like Senator Vitter and Congressmen Melancon are vehemently opposed to the NFL’s claim to a phrase that has become popular amongst their constituents, both as a source of pride and as a source of revenue.<sup>105</sup> The political opposition would surely influence the federal judges who would be hearing the case. Though federal judges are appointed for life, personal political motivations, such as being appointed to the Fifth Circuit would make it tough for any local judge to grant remedy to the NFL.<sup>106</sup>

The NFL has not yet sued anyone in “Who Dat Nation” for trademark infringement.<sup>107</sup> Perhaps with its ability to send out cease-and-desist letters, which local vendors generally lack the finances to fight, it would not need to bring suit in order to effectively make the “Who Dat” phrase its own mark. Even though at least one of the recipients of the cease-and-desist letters, Lauren Thom of Fleurty Girl in New Orleans, has said her business has actually increased because of the NFL’s leniency in allowing her to sell her remaining “Who Dat” shirts, this revenue is most likely short-lived.<sup>108</sup> The NFL effectively may be exerting its force and financial power to bully smaller vendors and merchandisers into discontinuing use of the mark. Predictably, Thom has said that she does not plan to challenge the NFL.<sup>109</sup> Acquiescence is likely to be a common reaction among small businesses receiving cease-

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103. See *Univ. Book Store*, 33 U.S.P.Q. 2d at \*1402-04, 1406.

104. *Smack*, 550 F.3d at 465; see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

105. Sayre, *supra* note 5.

106. Interview with Glynn Lunney, *supra* note 13.

107. By “Who Dat Nation,” I am referring to Saints Fans (and the greater New Orleans area in particular).

108. White, *supra* note 14.

109. *Id.*

and-desist letters from the NFL, because of an inability to fight the NFL's deep pockets.

There are other sensible reasons to hold that the NFL does not retain "Who Dat" as a trademark. Granting the trademark to the NFL could potentially create a monopoly on the "Who Dat" product industry. With only one central merchandiser, prices for products would be higher—an effect most consumers seek to avoid. Additionally, there would be less variety because more sellers generally means more options and vice versa. For example, the Fleurty Girl shirt prompting the cease and desist letter was innovative in its design, "#WHODAT."<sup>110</sup> The design was based on a Twitter page which would group tweets that included "#WHODAT" with other tweets on pages dedicated to the Saints.<sup>111</sup> Specialized and creative designs, such as this one, would be unlikely to occur with a centralized owner, because decentralized decision making often leads to increased creativity. With no competition, there is no incentive to be innovative or to create the exact product the consumer wants.

These arguments, however, have been in the background of trademark law since its inception. The same argument could be made for Saints merchandise, which is clearly protectable under trademark law, such as production of "NFL SAINTS" on shirts utilizing the black and gold color scheme. The Fifth Circuit considered some of these issues in *Smack* and found them unpersuasive.<sup>112</sup> The *Smack* court recognized "the public's indisputable desire to associate with college sports teams by wearing team-related apparel."<sup>113</sup> Moreover the court noted, "Whether or not a consumer *cares* about official sponsorship is a different question from whether that consumer would likely *believe* the product is officially sponsored."<sup>114</sup> Another reason for granting the trademark is the protection of "local businesses that are selling legitimate Saints merchandise and also the local printers that are making the licensed Saints apparel."<sup>115</sup> The court's conclusion in *Smack* is indicative of trademark rationale (such as concerns over consumers being able to find what they are looking for) being present in the background of litigation.<sup>116</sup>

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110. *Id.*

111. *Id.* Twitter is a Web site where individuals post their thoughts in the form of 140-character-or-fewer messages. Individual messages are known as tweets.

112. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485 (5th Cir. 2008).

113. *Id.*

114. *Id.*

115. Sayre, *supra* note 5 (quoting Brian McCarthy, NFL Spokesman).

116. *See Smack*, 550 F.3d 465.



## VII. CONCLUSION

Legal precedent exists for the NFL to have a claim to the “Who Dat” catchphrase. The rights could be exerted either through claims against an individual or a class of unlicensed merchandisers profiting from the mark’s use when the Saints are suggestively affiliated with the product. The Fifth Circuit would most likely follow the reasoning and analysis in *Qualitex* and *Smack* and find that the phrase has developed a secondary meaning that clearly indicates the NFL Saints as the source, sponsor, or affiliate of the product, and that this will cause a likelihood of confusion amongst consumers.<sup>117</sup> In light of *University Book Store*, the NFL also has strong persuasive language from the Trademark Trial and Appeal Board that could easily support an action for registering the mark “Who Dat” and defeating any opposition to such registration.<sup>118</sup> The decisions and analysis presented here demonstrate the strong likelihood of success of an NFL claim.

Because the court in *Boston Professional* recognized merchandising rights in trademark infringement claims, the dominant trend has been to consider these rights during trial.<sup>119</sup> However, I believe that the equitable analysis behind trademark law, namely the protection of the consumer, is not as strong in merchandising cases as the consumer’s interest in lower pricing, competition, and innovation. Therefore, I believe that the likelihood of confusion amongst consumers would be marginalized. “Who Dat” and other sports chants among crazed fans should stay with the fans where they originated, in spite of the growth of legal precedents regarding secondary meaning and likelihood of consumer confusion.

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117. *Id.*; see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

118. See *Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 U.S.P.Q. 2d 1385, 1994 WL 747886 (Trademark Trial & App. Bd. 1994).

119. See *Bos. Prof’l Hockey Ass’n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (1975).