Puerto Rico: The Island of Infringement? An Analysis of The Intersectionality of Eleventh Amendment Sovereign Immunity and Federal False Endorsement Claims

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Puerto Rico: The Island of Infringement?
An Analysis of The Intersectionality of Eleventh Amendment Sovereign Immunity and Federal False Endorsement Claims

“The very essence of civil liberty certainly consists in the right of every individual to claim protection of the laws, whenever he receives an injury.” *Marbury v. Madison*

Robert Hilton*

*This Note delves into the complex legal landscape of Puerto Rico’s application of sovereign immunity in the context of federal false endorsement claims, focusing particularly on the recent case involving the unauthorized use of Hall of Fame baseball player Roberto Clemente’s name and likeness. It critically examines the intersectionality of Eleventh Amendment sovereign immunity with the Lanham Act’s Section 43(a), highlighting the challenges faced in enforcing intellectual property rights within unincorporated territories of the United States.*

*The analysis begins by exploring the historical basis of sovereign immunity and its evolution from common law to the*

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intricacies of the Eleventh Amendment. It then shifts to discuss the unique political and legal status of Puerto Rico, emphasizing its impact on the application of sovereign immunity in modern jurisprudence. The core of the Note addresses the litigation surrounding the misuse of Roberto Clemente’s name in government-promoted products, positing that Puerto Rico’s status and federal laws provide a unique legal framework that complicates the otherwise straight-forward application of sovereign immunity.

Further, the Note assesses the implications of recent judicial decisions that may influence the ongoing debate over Puerto Rico’s sovereign immunity and its capacity to engage in commerce that infringes upon intellectual property rights. It argues for a reevaluation of traditional sovereign immunity in the context of federal territories to better align with the realities of modern intellectual property law and commercial practices.

Ultimately, this Note advocates for a legislative and judicial reconsideration of how sovereign immunity is applied in territories like Puerto Rico, particularly in cases involving intellectual property. The Note concludes with recommendations for clearer guidelines that reconcile the need for sovereign immunity with the protection of intellectual property rights, suggesting potential judicial and legislative reforms to address these complex issues.

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I. INTRODUCTION

The island of Puerto Rico is a beautiful place known for its breathtaking beaches and vibrant culture. In recent years, the island has been a hotspot for destructive hurricanes that leave Puerto Ricans without basic resources for months on end. Although these natural disasters are catastrophic to the island, eventually, homes are rebuilt, power is restored, and life continues as normal. Unlike these natural disasters, little publicity is paid to the more subtle, but often equally destructive, actions of the Puerto Rican government against its people, such as trademark infringement, bribery, and public corruption.

The Puerto Rican government has benefitted from the legal fiction of sovereign immunity for over a century due to Puerto Rico’s status as an unincorporated territory of the United States. In its most basic sense, sovereign immunity is the idea that government entities are shielded from suits brought against them by individuals. In its latest scheme, the Puerto Rican government has used its “state-like” sovereign immunity to exploit the good name and likeness of Hall-

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2 Adrian Florido et al., In Puerto Rico, the arrests of elected officials worsen trust in government, NPR (May 12, 2022, 5:20 PM), https://www.npr.org/2022/05/12/1098585366/in-puerto-rico-the-arrests-of-elected-officials-worsen-trust-in-government (reporting the FBI and Justice Department charged six of Puerto Rico’s seventy-eight mayors “with public corruption,” a “ballooning scandal that” some feel “is endangering the public trust in a government that’s been steadily losing the confidence of many of its citizens”).
3 People of Porto Rico v. Rosaly y Castillo, 227 U.S. 270, 273 (1913) (declaring that Puerto Rico “is of such nature as to come within the general rule exempting a government sovereign in its attributes from being sued without its consent”).
of-Fame baseball player and Puerto Rico native, Roberto Clemente, and deceive the public into funding an untimely sports park.\(^5\)

This Note will discuss the origin of sovereign immunity in the United States, both from a common law standpoint and as it relates to the Eleventh Amendment. Additionally, this Note will address state sovereign immunity case law both generally and in intellectual property disputes, and how such case law shaped the U.S. judicial system’s conception of dual sovereignty. Part II will introduce Puerto Rico’s governmental transformation over the past century and examine case law regarding Puerto Rico’s common-law immunity status. Part III of the Note will discuss the two bodies of law that could potentially dictate the outcome of the Roberto Clemente case, namely § 43 of the Lanham Act and the common law right of publicity. Lastly, Part IV will break down both parties’ arguments in the Roberto Clemente intellectual property case, explain how the First Circuit should interpret the facts of this case, and argue why Puerto Rico should be stripped of its sovereign immunity in federal courts in cases involving trademark infringement. Ultimately, this Note will break down how a decision in favor of the plaintiffs in this case would affect the people of Puerto Rico and their economy.”

II. BACKGROUND

A. Origin of Sovereign Immunity

Sovereign immunity originates from English common law and embodies the belief that “the King can do no wrong.”\(^6\) This belief bled into the English courts as part of the theory that there is no legal right against the authorities that make the law and therefore lords would be sued only in courts of their superiors.\(^7\) The United States Constitution’s original draft did not mention sovereign immunity; however, the Supreme Court’s pivotal decision in \textit{Chisholm v.}\(^8\)

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\(^7\) See Kawananakoa v. Polyblank, 205 U.S. 349, 353 (1907).
Georgia brought the doctrine to the forefront of debates among the States. Anger over the prospect that states could be sued by citizens of other states led to the swift ratification of the Eleventh Amendment.

B. Differences between Common Law Immunity and Eleventh Amendment Sovereign Immunity

The Supreme Court affirms that common law sovereign immunity is a right afforded to states, not by the Constitution or any later ratified amendment, but an inherent characteristic of these entities before they joined the Union. Unlike Eleventh Amendment immunity, common law immunity only protects a state or territory from suit in its own courts regarding its own laws, and may leave states and territories vulnerable to suits “in federal court based on federal law.”

To add an additional layer of protection for states, Congress enacted the Eleventh Amendment, which reads, “[t]he Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State.” Courts have interpreted this language as not only protecting states from suits in federal court by citizens of other states but by its own citizens in its own courts, as well.

C. Exceptions to State Sovereign Immunity Protection

There are four main circumstances under which state sovereign immunity “cannot be invoked in federal court”: (1) Ex Parte Young exceptions, (2) application of the “Arm of the State” doctrine, (3)

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8 See Chisolm v. Georgia, 2 U.S. 419 (1793).
9 See generally Monaco v. Mississippi, 292 U.S. 313, 325 (1934).
12 U.S. CONST. amend. XI.
13 See Alden, 527 U.S. at 754.
when a state waves sovereign immunity, (4) and congressional abrogation.14

1. Ex Parte Young exception

The Supreme Court, in *Ex Parte Young*, explained that private actions may be brought against state officials who, within their official capacity, are enforcing a state law that violates the Federal Constitution.15

2. Arm of the State doctrine

Eleventh Amendment sovereign immunity only applies to entities that “the Court considers to be ‘arms’ or ‘instrumentalities’ of the state” itself.16 When determining whether an entity is an arm of the state, the Court reviews whether the entity is financially independent from the state and “whether any judgment [against the entity] must be satisfied out of the state treasury.”17 This doctrine—and thus, Eleventh Amendment sovereign immunity—typically does not apply to municipalities within the state.18

3. State Waiver of Sovereign Immunity

States have the option to forego immunity from suit. However, the Supreme Court found this waiver only applies when stated “by the most express language, or by such overwhelming implication from the text as would leave no room for any other reasonable construction.”19

4. Congressional Abrogation

In the landmark case *Fitzpatrick v. Blitzer*, the Supreme Court held that the Fourteenth Amendment grants Congress authority to,

15 Ex parte Young, 209 U.S. 123, 167 (1908) (“The state cannot . . . impart to the official immunity from responsibility to the supreme authority of the United States.”).
16 McCann, supra note 14.
“by appropriate legislation,” limit Eleventh Amendment state sovereign immunity. 20 Specifically, section 5 of the Fourteenth Amendment allows Congress to enforce the amendment’s “substantive provisions,” including equal protection for all under the law and prohibiting states from depriving citizens of “life, liberty, or property, without due process of law.” 21 In the recent case In re Coughlin, the First Circuit noted that the “Supreme Court has ‘never required that Congress use magic words’ to make its intent to abrogate clear.” 22 “To the contrary, it has explained that the requirement of unequivocal abrogation ‘is a tool for interpreting the law and that it does not displace the other traditional tools of statutory construction.’” 23 In fact, the Supreme Court has considered broad “‘any cause of action arising from’” statutory language as ‘unmistakably clear,’ signaling Congress’s intent to abrogate sovereign immunity from suit.” 24

D. The Trademark Clarification Act of 1992

Over the past several decades, Congress made attempts to abrogate state sovereign immunity relating to intellectual property rights as evidenced by the passing of the Trademark Clarification Act of 1992 (TRCA). 25 The TRCA amended § 43(a) of the Lanham Act to state that “any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity” may be held liable for “false representations regarding the origin or association of another’s distinctive mark.” 26 However, in College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board, the Supreme Court held that

20 Fitzpatrick v. Bitzer, 427 U.S. 445, 456 (1976) (“We think that Congress may, in determining what is ‘appropriate legislation’ for the purpose of enforcing the provisions of the Fourteenth Amendment, provide for suits against States or state officials which are constitutionally impermissible in other contexts.”).
21 U.S. CONST. amend. XI, § 1.
22 In re Coughlin, 33 F.4th 600, 605 (1st Cir. 2022) (quoting FAA v. Cooper, 566 U.S. 284, 291 (2012)).
23 Centro de Periodismo Investigativo, Inc. v. Fin. Oversight & Mgmt. Bd. for Puerto Rico, 35 F.4th 1, 17 (1st Cir.), cert. granted, 143 S. Ct. 82, 214 L. Ed. 2d 12 (2022), and rev’d and remanded, 598 U.S. 339, 143 (2023).
24 Id. (quoting Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 56-57 (1996)).
26 Id. (emphasis added).
Congress had no right to abrogate the state’s sovereign immunity based on Congress’ Article 1 power to “regulate interstate commerce;” there was no indication that the petitioner held any tangible property rights to which the petitioner could exclude the State of Florida under section 1 of the Fourteenth Amendment because the bank was suing the Florida Postsecondary Education Expense Board for false advertising of its own products and not those of the bank.27 This decision, while not explicitly condemning the abrogation of state sovereign immunity regarding trademark infringement, has been cited by multiple inferior courts to shield states from intellectual property suits.28 While such is the case for states, the TRCA does not mention the abrogation of sovereign immunity of U.S. territories in the area of trademark infringement.29 This begs the question of whether, by omitting information regarding sovereign immunity of U.S. territories, Congress implicitly disregarded the federal government’s recognition of territorial sovereignty in intellectual property disputes.

III. PUERTO RICO’S HISTORY AND STATUS AS AN UNINCORPORATED TERRITORY OF THE UNITED STATES

To better understand why Puerto Rican sovereign immunity has been so divisive among courts, it is necessary to analyze the development of the Commonwealth from its inception to the current day. This section will discuss the distinct differences between U.S. states and unincorporated territories, as well as the history of Puerto Rico’s complicated relationship with the United States and limited self-governance. This section will also explain how legal precedent and the U.S. Constitution abrogation of Puerto Rico’s sovereign immunity in federal courts.

27 See Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 673 (1999) (holding Florida did not commit illegal taking of petitioner’s property under Section 1 of Fourteenth Amendment for falsely advertising its own prepaid educational program because petitioner did not have “exclusive dominion” over said product).
28 See MARVEL ET AL., supra note 25, at 12.
A. Distinctions between U.S. States and Territories

Under the Tenth Amendment, “[t]he powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people.”30 In simple terms, when a dispute arises that falls outside of the purview of the federal government, states and their residents may construct their own laws and enforce such laws within their respective jurisdictions.31 Additionally, states are allocated representatives in Congress to help shape federal law.32

Each new state admitted to the union is afforded the same protections, powers, and level of sovereignty inherent to the original states under the Equal Footing Doctrine.33 Congress has yet to recognize Puerto Rico, or any other territory, as being included under the Equal Footing Doctrine.34 Moreover, territories do not benefit from the same level of autonomy as the states because article IV, section three of the Constitution grants Congress plenary power over decisions regarding territories.35 With one exception, all U.S. territories are considered unincorporated territories, meaning Congress determined the U.S. Constitution only applies to the territories in certain instances.36

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30 U.S. CONST. amend. X
31 See id.
33 U.S. CONST. art. IV, § 3, cl. 1 (Equal Footing Doctrine states: “New States may be admitted by the Congress into this Union; but no new State shall be formed or erected within the Jurisdiction of any other State; nor any State be formed by the Junction of two or more States, or Parts of States, without the Consent of the Legislatures of the States concerned as well as of the Congress.”); see also Pollard v. Hagan, 44 U.S. 212, 222 (1845).
34 Cf. The Legislative Branch, supra note 32.
35 U.S. CONST. amend. IV, § 3, cl. 2.
B. Puerto Rico’s Development as a U.S. Territory

In 1898, Spain surrendered Puerto Rico to the United States as part of the Treaty of Paris, ending the Spanish-American War. However, Puerto Ricans were not considered U.S. citizens until Congress passed the Jones-Shafroth Act in 1917, granting Puerto Rican people citizenship and individual civil rights similar to those found on the mainland. The Act also divided the executive, legislative, and judicial branch. However, the President of the United States still had veto power over any legislation enacted by the territory’s legislature. In 1952, after more than 50 years of strict adherence to congressional regulations, the U.S. Congress enacted Public Law 600 and granted Puerto Rico autonomy to establish its own constitution. Even though Puerto Rico enacted and ratified a Puerto Rican Constitution, Congress still reserved the right to deny or alter that constitution to its liking under its plenary power.

C. Puerto Rico and the Debate over Eleventh Amendment Sovereign Immunity

Since the 1913 Supreme Court case Porto Rico v. Rosaly y Castillo, the Court has acknowledged Puerto Rico’s common law sovereign immunity. The Court held that the Puerto Rico Commonwealth’s Organic Act bore a “striking similarity to the organic act of the Hawaiian Islands, which granted the island common law immunity, and therefore reasoned that Puerto Rico should be afforded the same immunity. This state-like immunity was reasoned to exist because Congress established a tripartite form of government in

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38 See Davis, supra note 37.  
39 See id.  
40 See id.  
42 Id. at 140.  
44 Id. at 273-74. See also Kawananakoa v. Polyblank, 205 U.S. 349, 353 (1907) (holding “there can be no legal right as against the authority that makes the law on which the right depends”).
Puerto Rico resembling that of the states, where one branch may not hold sufficient power to destroy another.\textsuperscript{45}

Although the Court has never deviated from this ruling, it has not ruled as to whether Puerto Rico should be afforded Eleventh Amendment sovereign immunity.\textsuperscript{46} The First Circuit recognized Puerto Rico’s Eleventh Amendment-like immunity in 1981.\textsuperscript{47} In the 1981 case \textit{Ezratty v. Commonwealth of Puerto Rico}, the First Circuit addressed whether Puerto Rico benefits from Eleventh Amendment state-like immunity from suit.\textsuperscript{48} Speaking for the majority, Justice Breyer stated “[t]he principles of the Eleventh Amendment, which protect a state from suit without its consent, are fully applicable to the Commonwealth of Puerto Rico.”\textsuperscript{49} The court justified its decision by referring to two previous opinions from the District Court of Puerto Rico in which the district court upheld Puerto Rico’s sovereign immunity.\textsuperscript{50} The First Circuit upheld the first case, \textit{Carreras Roena v. Camara de Comerciantes Mayoristas, Inc.}, without comment\textsuperscript{51} The second case, \textit{Ursulich v. Puerto Rico Nat’l Guard}, explains its ruling but refers to the Commonwealth’s common law immunity in its reasoning, not Eleventh Amendment immunity, evidenced by the opinion’s concluding citation to Porto Rico v. Rosaly y Castillo.\textsuperscript{52} In both instances, the First Circuit used inapplicable case law and non-binding precedent to support its ruling.

\textsuperscript{45} \textit{Rosaly y Castillo}, 227 U.S. at 277.
\textsuperscript{46} \textit{Grajales v. Puerto Rico Ports Auth.}, 831 F.3d 11, 15, 15 n.3 (1st Cir. 2016) (citing P.R. Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc., 506 U.S. 139, 141 n. 1 (1993) (acknowledging the First Circuit has consistently treated Puerto Rico like a state for Eleventh Amendment purposes but deciding not to rule on whether the purported defendant agency was granted immunity as a state entity because the Supreme Court had not decided on the issue)).
\textsuperscript{47} See \textit{Ezratty v. Commonwealth of Puerto Rico}, 648 F.2d 770, 776 n.7 (1st Cir. 1981).
\textsuperscript{48} See Chandler, supra note 11, at 2189, 2189 n.36.
\textsuperscript{49} \textit{Ezratty}, 648 F.2d at 776 n.7.
\textsuperscript{50} Id.
\textsuperscript{52} Id. at 2183. See Ursulich v. Puerto Rico Nat’l Guard, 384 F. Supp. 736, 737 (D.P.R. 1974) (“[T]he Commonwealth possesses many of the attributes of sovereignty, and has full power of local self-determination similar to the one the states of the Union have . . . Immunity from suit without its consent is one of those
D. Puerto Rico Case Law Relating to Sovereign Immunity

Since Ezratty, the First Circuit has consistently ruled in favor of Puerto Rico maintaining Eleventh Amendment immunity to suit. However, recent federal court cases may be weakening the Commonwealth’s argument in favor of sovereign immunity. In the pivotal case Puerto Rico v. Sanchez Valle, the Court held that although Puerto Rico could enact its own laws, its ultimate source of power to prosecute was a direct result of Congress’s delegation.\(^{53}\) Therefore, Puerto Rico was forbidden from prosecuting criminal charges separate from the federal government for double jeopardy purposes.\(^{54}\) This case, although not directly dealing with Puerto Rico’s sovereign immunity, confirms the judicial reliance of Puerto Rico on the federal government. While Puerto Rico is a self-governing territory with its own constitution and government, it is also subject to the authority of the U.S. Congress and the President.\(^{55}\) The Court’s decision suggests that Puerto Rico’s sovereignty is limited in certain respects—and its decision led some to argue Puerto Rico is not a true sovereign nation but instead its Constitution is “a creature of the federal government.”\(^{56}\)

Additionally, in the 2022 case Centro de Periodismo Investigativo, Inc. v. Fin. Oversight and Mgmt. Bd. for Puerto Rico, a local Puerto Rican news agency requested that the Financial Oversight and Management Board for Puerto Rico hand over sensitive and potentially incriminating financial documents pertaining to the Commonwealth.\(^{57}\) The Board was created by the federal government in attributes. Such was the state of the law even prior to the creation of the Commonwealth of Puerto Rico[.].\(^{53}\)


See id.

Cf. at 71-72.


See Centro de Periodismo Investigativo, Inc. v. Fin. Oversight & Mgmt. Bd. for Puerto Rico, 35 F.4th 1 (1st Cir. 2022); see also Alex Wolf, Puerto Rico Board Faces Test with Supreme Court Records Case, BLOOMBERG LAW (Oct. 12, 2022, 5:00 AM), https://www.bloomberglaw.com/bloomberglawnews/bankruptcy-law/X1HFKDH8000000?bna_news_filter=bankruptcy-law#jcit.
response to the overwhelming debt incurred by Puerto Rico. In a 2-1 decision, the U.S. Court of Appeals for the First Circuit held that the wording in Congress’ PROMESA legislation fully abrogated Puerto Rico of its alleged Eleventh Amendment sovereign immunity. The court reasoned that Congress intended to give creditors and other parties the ability to sue Puerto Rico in federal court to enforce their rights under PROMESA. This ruling is significant because it finds that even if the Eleventh Amendment applies to the government of Puerto Rico, Congress can abrogate the nation’s immunity through legislation. Furthermore, the court interpreted the clear statement test outlined in Dellmuth v. Muth as very broad, thus allowing for a permissible inference, as to Congress’s intentions in writing legislation to abrogate immunity regarding specific Puerto Rican government entities.

Notably, the Supreme Court granted certiorari for this case and provided a ruling on May 11, 2023. The Court ruled only on whether sovereign immunity was abrogated by PROMESA and did not make a firm ruling on whether Puerto Rico does, in fact, benefit from Eleventh Amendment immunity. In the majority’s words, “[t]he proceedings below did not examine those matters, and we agreed to tackle only the abrogation question.” Ultimately, the

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59 Id.
60 See Centro de Periodismo Investigativo, Inc., 35 F.4th at 17.
61 Wolf, supra note 57. The First Circuit found “Congress was ‘unmistakably clear’ in PROMESA that any legal action taken against the board can be brought in federal court and injunctive relief may be granted.” Id.
62 See generally Centro de Periodismo Investigativo, 35 F.4th at 15.
64 Id. at 342, 351. See also id. at 352 (Thomas, J., dissenting). Justice Thomas noted that while Centro argued Puerto Rico lacked “state sovereign immunity,” the majority avoided that argument, “‘assume[ing] without deciding that Puerto Rico is immune from suit in federal district court’—while also deciding that PROMESA does not abrogate that assumed immunity.” Id. Justice Thomas stated that whether Puerto Rico has state sovereign immunity is an issue “‘predicate to an intelligent resolution of the question presented,’” as it makes no sense to analyze whether PROMESA abrogates state sovereign immunity without first determining whether that immunity is implicated at all.” Id. at 353 (quoting United States v. Grubbs, 547 U.S. 90, 94, n. 1 (2006)).
65 Id. at 346 n.2.
majority decided that nothing in the PROMESA legislation made “Congress’s intent to abrogate the Board’s sovereign immunity ‘unmistakably clear.’”66 In his dissent, Justice Thomas made clear his objection to this ruling, explaining that since the Court determined in Sanchez Valle that Puerto Rico is not a state, and that the Board is an appendage of the Commonwealth, the respondent should establish its immunity from suit “as it makes no sense to analyze whether PROMESA abrogates state sovereign immunity without first determining whether that immunity is implicated at all.”67

Courts have been hesitant to adhere to a single bright-line rule or test in cases when an entity seeks relief against the Commonwealth.68 The District Court of Puerto Rico, in Marin v. University of Puerto Rico, held that injunctive relief sought against a Commonwealth entity—in this case, an institution of higher education—or public officials would be denied unless the allegedly harmed party could show that the acts committed were *ultra vires* and contrary to the Constitution of the United States.69 In Vaqueria Tres Monjitas, Inc v. Irizarry, the two main fresh milk producers on the island, sued the “Milk Industry Regulation Administration for the Commonwealth of Puerto Rico (‘ORIL’ by its Spanish acronym)” for employing anticompetitive pricing models to thwart private competitors.70 The First Circuit held that ORIL’s actions warranted both injunctive relief and monetary damages.71 The court reasoned that injunctive relief was appropriate after balancing the preliminary injunction test outlined in Waldron v. George Weston Bakeries Inc.72 Additionally, the court held that monetary damages were appropriate in this instance because the funds were not directly extracted from the state

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66 Id. at 351 (quoting Kimel v. Florida Bd. of Regents, 528 U.S. 62, 73 (2000)).
67 Id. at 353, 354 (Thomas, J., dissenting).
70 Vaqueria Tres Monjitas, Inc. v. Irizarry, 587 F.3d 464, 471 (1st Cir. 2009).
71 Id. at 480, 487-88.
72 Id. at 482. In Waldron, the First Circuit outlined a test that requires balancing four criteria to determine whether injunctive relief should be granted: (1) likelihood of success on the merits, (2) possibility “the moving party will suffer irreparable harm,” (3) balance of hardship “between the parties,” and (4) effect of the court’s holding “on the public interest.”
IV. FALSE ENDOSMENT AND THE RIGHT OF PUBLICITY OF CELEBRITIES

When well-known people or celebrities believe an entity has used their name, image, or likeness without their permission for financial benefit, they typically have two paths they can take to seek relief. The first path is through § 43(a) of the federally enacted Lanham Act, which was established to guard consumers against instances of false endorsement. The second is provided by the common law right of publicity enforced via state statutory law, which preserves a celebrity’s economic interest in their name, image, and likeness.

A. Lanham Act §43 and Likelihood of Confusion

To assert a false endorsement claim in federal court, a plaintiff must show “(1) that its mark is entitled to trademark protection, and (2) that the allegedly infringing use is likely to cause consumer confusion.” Specifically, § 43 of the Lanham Act specifies that:

Any person who, on or in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which [] is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or

73 Id. at 479. See generally Libby v. Marshall, 833 F.2d 402, 406 (1st Cir. 1987) (“Only if the state is forced to use funds from the state treasury to satisfy a compensatory judgment do the adverse consequences that the Eleventh Amendment prohibits occur.”).
77 Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 12 (1st Cir. 2008).
association of such person with another person, or as to the origin,
sponsorship, or approval of his or her goods, services or commercial
activities by another person. . . . . shall be liable in a civil action
by any person who believes that he or she is or is likely to be dam-
aged by such act.78

The Lanham Act goes on to clarify that the term “any person”
referred to in § 43(a)(1) “includes any State, instrumentality of a
State or employee of a State or instrumentality of a State acting in
his or her official capacity.”79 Additionally, multiple circuit courts,
including the Sixth and Ninth Circuits, have emphasized that any
unauthorized indicia of a celebrity that may lead the public to be-
lieve that the celebrity endorsed the defendant’s product or service
can be considered a trademark for unfair competition purposes.80

Lanham Act section 43(a)(1)(A) states only a likelihood of confu-
sion is required in these types of cases, and a plaintiff is not required
to prove that the public was actually misled or that the statement or
depiction was literally false, which is required for false advertising
claims under § 43(a)(1)(B).81

Each circuit has established its own multi-factor test to deter-
mine whether there is a likelihood of confusion among the target
population regarding two marks.82 For example, the First Circuit
adopted the eight-factor Pignon balancing test.83 While this test has
been useful in many traditional trademark infringement cases, it fails
to fully account for cases in which the trademark is an individual’s
persona.84

Since it has already been established that Puerto Rico should be
denied Eleventh Amendment state-like sovereign immunity and the

79 Id. at § 1125(a)(2).
80 See Parks v. LaFace Records, 329 F.3d 437, 445 (6th Cir. 2003); Waits v. Frito-
Lay, Inc., 978 F.2d 1093, 1110 (9th Cir. 1992). See also J. Thomas McCarthy,
82 See Trademark: Overview, Thomas Reuters Practical Law Intellectual
0511e28578f7ccc38debee/View/FullText.html?transitionType=Default&con-
textData=(sc.Default) (last visited Apr. 15, 2024).
83 See Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482,
487 (1st Cir. 1981).
84 See id. (listing eight factors, none of which relate to an individual’s persona).
First Circuit has yet to establish a definitive test for false endorsement claims, the Court should look to the Ninth Circuit for inspiration in dealing with this case and other similar cases. The Ninth Circuit treats false endorsement cases as “classic trademark” cases as opposed to false advertising cases and has tailored its eight-factor *Sleekcraft* test to better analyze false endorsement claims. The modified test, referred to as the *Downing* test, takes into consideration the following eight factors: “1. the level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended; 2. the relatedness of the fame or success of the plaintiff to the defendant’s product; 3. the similarity of the likeness used by the defendant to the actual plaintiff; 4. evidence of actual confusion; 5. marketing channels used; 6. likely degree of purchaser care; 7. defendant’s intent on selecting the plaintiff; and 8. likelihood of expansion of the product lines.” The factors are examined based on their totality, and proving that a majority of the factors tilt in favor of one party or the other is not dispositive of whether a likelihood of confusion has occurred. The factors carry different weight depending on the particular circumstances of each case— as the Ninth Circuit stated in a different decision, “courts do not merely count beans or tally points.” Therefore, based on their tailored fit for false endorsement claims, the eight factors described above will be key components in determining whether a claim against the Government of Puerto Rico for false endorsement using the Roberto Clemente mark will be successful.

### B. Right of Publicity

The main difference between false endorsement claims and right of publicity infringement claims centers on the falsity of the claim. A person’s use of a celebrity’s name or likeness in a manner that will likely cause the public to believe that the celebrity endorses that

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85 False Endorsement under Lanham Act § 43(a), 1 Rights of Publicity and Privacy § 5:31 (2d ed).
86 *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-08 (9th Cir. 2001).
87 See *id.* at 1008.
88 *Stone Creek, Inc. v. Omnia Italian Design, Inc.*, 875 F.3d 426, 431 (9th Cir. 2017).
89 *McCarthy*, supra note 80, § 28:14.
person’s product or service constitutes false endorsement. However, if that same person uses the likeness or “persona” of a celebrity to unjustly enrich themself at the expense of the celebrity, even when there is no confusion as to the source of the product or service, then this may provoke a right of publicity claim. There is no federally recognized right of publicity; therefore, celebrities must rely on state statutory law to bring a claim against an accused infringer. As of 2020, thirty-five states and the Commonwealth of Puerto Rico identify and uphold a right of publicity.

C. Puerto Rico Right of Publicity

Puerto Rican law allows celebrities and their estates to seek an injunction and monetary damages against a party who has used the individual’s “likeness for commercial, trade, or advertising.” Although this right of publicity extends beyond the death of the celebrity and is fully transferable, the right only lasts up to twenty-five years after the death of the individual. Public records indicate that Roberto Clemente passed away on December 31, 1972, and therefore his estate relinquished its right of publicity on December 31, 1997.

V. ANALYSIS

This section will describe the facts laid out in the docket. Although this case delves into the Takings Clause of the Fifth Amendment, constitutional takings will not be discussed and are considered outside of the scope of this Note. The Note will then argue that the

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90 Id. at § 28:14.
91 Id. at § 28:14.
92 Right of Publicity, supra note 76.
94 P.R. LAWS ANN. tit. 32, § 3152 (2019).
95 Id. at § 3154-55.
First Circuit should adopt a modified “trademark likelihood of confusion” test, similar to the Downing test created by the Ninth Circuit, to better handle false endorsement claims brought by celebrities against those using their persona without authorization. The facts of the Roberto Clemente case will then be analyzed through the lens of the Downing test. Lastly, this Note will discuss the defenses raised and how they ultimately should fail.

A. History of the Case

1. Plaintiff’s Allegations

Plaintiffs Roberto Clemente Jr., Luis Roberto Clemente, and Roberto Enrique Clemente, joint heirs and benefactors of the Roberto Clemente estate, allege that the Commonwealth of Puerto Rico engaged in trademark infringement, violated the estate’s right of publicity as it relates to Roberto Clemente, and participated in an illegal taking of the Plaintiffs’ intellectual property and physical assets.97 Plaintiffs allege that on August 5, 2021, the Puerto Rican Legislature enacted two resolutions aimed at extracting funds from the citizens of Puerto Rico to raise money for a public sports complex that would be constructed on the same land as Ciudad Deportiva, which is owned by the Roberto Clemente estate.98 The sports complex would be named the Roberto Clemente Sports District and would be managed by a public corporation, the “Puerto Rico Convention District Authority.”99 The two resolutions, formally known as Joint Resolutions No. 16 and 17, were ratified by the Puerto Rican legislature on August 5, 2021.100 Resolution 16 required that all individuals purchasing a license plate from the Puerto Rico Department of Transportation and Public Works be required to select a license plate designed by the Government of Puerto Rico commemorating the fiftieth anniversary of Roberto Clemente’s 3000th hit in Major League Baseball.101 The license plate displays a depiction of (1) Roberto Clemente at bat, (2) the word “Clemente” and his now-

98 Id. at 9, 12-13, 16, 19.
99 Id. at 8, 12.
100 Id. at 8-9.
101 Id. at 8-9.
retired Pittsburgh Pirate number “21,” (3) “the phrase “3000 hits,” and (4) “the number ‘50’ and word ‘anniversary.’”102 The Roberto Clemente license plate would be the only plate design sold in 2022 by the Department and would cost twenty-one dollars.103

In addition to the mandatory Roberto Clemente license plate, Resolution 17 requires that all individuals purchasing the license plate must also purchase a corresponding commemorative Roberto Clemente vehicle certificate tag.104 The tag provides the same depictions found on the license plate and costs five dollars.105 Next to the notice of the $5 charge in the license permit, the document lists the government fund where the proceeds will be sent, Fondo Roberto Clemente, or in English “the Roberto Clemente Fund.”106

Roberto Clemente dreamed of building a sports complex where children from the island could develop their athletic talents.107 However, Roberto tragically passed away in a plane crash off the coast of Nicaragua on December 31, 1972, while traveling to the earthquake-stricken country to provide aid and supplies.108 During the flight, the engine unexpectedly failed and the plane plunged into the ocean.109 Amidst this tragedy, and to further Roberto’s charitable legacy, Roberto’s wife, Vera Clemente, established “Ciudad Deportiva Roberto Clemente” in 1976 in Carolina, Puerto Rico, through a land donation by the Government of Puerto Rico.110 Over time, and with frequent occurrences of catastrophic hurricanes that plagued the island, the sports complex needed many repairs and upgrades.111

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102 Id.
103 Amended Complaint, supra note 97, at 8-9.
104 Id. at 9-10.
105 Id. at 10.
106 Id.
107 Id. at 19.
110 Minasian, supra note 108.
The Plaintiffs claim they introduced a plan to allow Ciudad Deportiva to use the trademark, name, and likeness of Roberto Clemente in relation to creating a similar commemorative license plate and presented it to Governor Pierluisi in February 2021.\textsuperscript{112} Plaintiffs thus allege Defendant was aware of this plan just shy of one month before the proposal of Joint Resolution 16 on March 10, 2021.\textsuperscript{113} Additionally, Plaintiffs argue that on March 30, 2022, Plaintiffs sent a notification “to Defendants through the Secretary of Justice regarding” Defendant’s trademark infringement of the Roberto Clemente mark.\textsuperscript{114} Luis Roberto Clemente also publicly denounced the Government’s use of the mark in relation to Joint Resolutions 16 and 17 multiple times leading up to the resolutions’ August 5, 2021 enactments.\textsuperscript{115}

On August 4, 2021, the Assistant Chief of Staff of the Governor reached out to Luis Roberto Clemente asking for his opinion regarding Joint Resolutions RCC0083 and 84 (later enacted as Joint Resolutions No. 16 and 17) and inviting him to the signing ceremony.\textsuperscript{116} Luis Roberto Clemente explicitly informed the Governor and his office that “the name Roberto Clemente and its image was a registered trademark and its use required prior authorization and that they had not received communication or design of the proposal license plate or tag for approval.”\textsuperscript{117}

2. Defense’s Position

The Defense contends that regardless of a court’s finding of infringement of the Roberto Clemente mark, the Commonwealth is immune to suit based on Eleventh Amendment sovereign immunity.\textsuperscript{118} The Defense further asserts that the use associated with selling license plates was merely a governmental use of the Roberto

\textsuperscript{112} Amended Complaint, \textit{supra} note 97, at 12.
\textsuperscript{113} \textit{Id.}
\textsuperscript{114} \textit{Id.} at 14.
\textsuperscript{115} See \textit{id.}
\textsuperscript{116} \textit{Id.} at 13.
\textsuperscript{117} \textit{Id.}
\textsuperscript{118} Motion to Dismiss Amended Complaint at 6, Clemente Properties v. Pierluisi, No. 22-1373, 2023 WL 6201397 (D.P.R. Sept. 22, 2023).
Clemente mark and therefore falls outside the scope of the Lanham Act’s commercial use requirement.\(^{119}\)

3. Recommendation: False Endorsement Claim

Although there are various legal avenues the Roberto Clemente estate can walk down, such as asserting a standard trademark infringement claim under § 32(1) of the Lanham Act, the estate is most likely to succeed if it pursues a false endorsement claim under Lanham Act § 43(a)(1)(A).\(^{120}\) Since the Roberto Clemente estate did not consent to the Government of Puerto Rico using the name, image, or likeness of Roberto Clemente concerning the license plates, license tags, or the naming of the anticipated sports facility, the Commonwealth should be found in direct violation of 15 U.S.C. § 1125(a)(1)(A) and should be held accountable the First Circuit applies the factors correctly.\(^{121}\) A court should analyze the case under the Ninth Circuit’s eight-factor *Downing* test. This section of the analysis will balance the various factors as they pertain to the facts of this case to decide whether the estate of Roberto Clemente receives both injunctive relief and monetary damages from the Government of Puerto Rico based on the Commonwealth’s false endorsement violation.

4. Standing in a Lanham Act False Endorsement Claim

To obtain standing under the Lanham Act, a plaintiff must first prove that he or she experienced an injury “within the zone of interest” protected by the statute. In the trademark context, this means the plaintiff must be a party who is likely to be injured by false endorsement.\(^{122}\) Second, the plaintiff must prove that the alleged statutory violation is the proximate cause of his injury.\(^{123}\) This means that the plaintiff must have suffered an injury that was actually caused by the defendant’s false endorsement and not merely an unfortunate *derivative* result of the defendant’s actions.\(^{124}\) The injury

\(^{119}\) See id. at 7.


\(^{121}\) See Amended Complaint, *supra* note 97, at 12-14, 26-27.


\(^{123}\) *Id.* at 132.

\(^{124}\) See *id.* at 133.
can be economic, such as lost sales, or non-economic, such as damage to reputation.\textsuperscript{125}

Past precedent explains that a celebrity’s estate may bring a false endorsement claim against a potential infringer of a celebrity’s persona.\textsuperscript{126} Therefore, the Plaintiffs in this case likely meet this first prong of the standing requirement. Regarding the second prong, the Plaintiffs, in their Amended Complaint, provide multiple accounts of backlash they received from the online press, television, and the public in the form of social media comments.\textsuperscript{127}

5. The \textit{Downing} Eight Factor Test Applied

a. Plaintiff’s Level of Recognition Has Among the Segment of the Society for Whom the Defendant’s Product is Intended.

In this case, Defendant’s products were made available for all individuals of proper driving age who were capable of purchasing a Puerto Rican license plate. Defendants made it clear that the charge for the commemorative license plate and tag was obligatory for anyone purchasing a license in Puerto Rico in 2022.\textsuperscript{128}

There is no question that the late Roberto Clemente is beloved by the people of Puerto Rico.\textsuperscript{129} His name is often used in songs and children learn about him in their history courses.\textsuperscript{130} Roberto Clemente is considered “one of the most revered figures in Puerto Rico and Latin America.”\textsuperscript{131} The Governor of Puerto Rico—and defendant in this lawsuit—Governor Pedro Pierluisi has been quoted as saying Clemente “represents us better than anybody else as to what Puerto Rico is all about.”\textsuperscript{132} As such, there is little doubt that most

\begin{itemize}
\item \textsuperscript{125} \textit{Id.} at 133.
\item \textsuperscript{126} Lanham Act Section 43(a) Claims, Practical Law Practice Note w-005-9404.
\item \textsuperscript{127} \textit{See Amended Complaint, supra note 97, at 11-12.}
\item \textsuperscript{129} \textit{Roberto Clemente remains Latino Legend 50 years after death, supra note 96.}
\item \textsuperscript{130} \textit{Id.}
\item \textsuperscript{131} \textit{Id.}
\item \textsuperscript{132} Nick Diunte, \textit{Puerto Rican Luminaries Uphold Roberto Clemente’s Global Legend Status During MLB Tributes}, FORBES (Sep. 22, 2022, 8:55 PM),
\end{itemize}
Puerto Rican citizens of driving age and capable of purchasing a Puerto Rican license plate would be familiar with Roberto Clemente in some way.

b. The Fame or Success of the Plaintiff in Relation to the Defendant’s Product.

When identifying a celebrity’s “goods or services,” courts such as the Ninth Circuit interpret this factor as the product or service that made the celebrity famous. In *Downing v. Abercrombie & Fitch*, seven professional surfers and “legends” in the sport brought a Lanham Act false endorsement claim against retailer, Abercrombie & Fitch, for the company’s use of the surfers’ images and names in conjunction with the company’s quarterly clothing catalog named the “Quarterly.” The theme of the clothing catalog was “surf-wear,” and therefore the court reasoned that because the plaintiffs were well-known for their surfing capabilities, the defendant’s surfing apparel advertised in the Quarterly could be perceived as highly correlated.

Regarding this case, Roberto Clemente is world famous for not only his extraordinary baseball career, but he is even more well known for being a compassionate, service-oriented individual and a symbol of the Puerto Rican people. Therefore, it could be argued that his fame as a Major League Baseball player and Puerto Rican philanthropist could be considered closely related to an official product of the Puerto Rican Commonwealth, such as a license plate.

The image displayed on both the license plate and tag is of Clemente swinging a baseball bat in his MLB uniform. Although license plates and license plate tags were never goods that made


134 See Downing v. Abercrombie & Fitch, 265 F.3d 994, 999-1002 (9th Cir. 2001).
135 See id. at 1008.
Clemente famous, the products were advertised to the public as items that could be purchased to fundraise for a project near and dear to the athlete’s heart, one involving youth sports and community building. The “services” that made him a household name were the game of baseball and, notably, his passion for community service. By associating the license plate and tags with Clemente’s name and image, the Puerto Rican Government had a much stronger ability to sell the public on “donating” to a government-run sports complex. Like in the oft-quoted Supreme Court case *International News Service v. Associated Press*, by not finding for the Plaintiffs, the Court would be allowing the Puerto Rican government a free ride on the efforts and goodwill of the Roberto Clemente name and “reap[ing] where it has not sown.”

c. The Similarity Between the Likeness Used by the Defendant and the Actual Plaintiff

Often celebrity “personas”–meaning their visual likeness, distinctive voice, or any other distinguishing quality they may possess–are considered by federal courts as enforceable trademarks for Lanham Act purposes. For example, in *White v. Samsung Electronics America, Inc.*, Vana White, a popular television personality associated with the long-running Wheel of Fortune game show, sued Samsung for impersonating her likeness using a robot with a blond wig, jewelry, and gown, standing next to a game board resembling the one used on the Wheel of Fortune set. The Court ruled that, although “clearly a robot, not a human,” the robot’s stance and appearance were similar enough to White’s actual features to conclude that

138 See Amended Complaint, supra note 97, at 19.
140 See Amended Complaint, supra note 97, at 19.
141 See *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 236, 239, 246 (1918) (holding plaintiff news organization held quasi-property rights in the news information it had put extensive time, money, and effort into publishing).
143 *White*, 971 F.2d at 1396.
consumers might falsely believe that she endorsed the products in the commercial.\textsuperscript{144}

Here, the case is even stronger for finding sufficient similarity because the Government of Puerto Rico used, in their license plate and license tag, an image of Roberto Clemente in his baseball uniform along with a depiction of his last name and uniform number “21” in signature Pittsburgh Pirate black and gold. Unlike the Vana White robot, the visual depiction of Roberto Clemente along with words and numbers representing his unique persona leaves no room for ambiguity. This case is more similar to that of \textit{Downing}, where an actual image of the athlete was displayed on the product. As such, the similarity of the likeness between the tag and license and Robert Clemente is not a similarity at all, but instead an exact rendering.\textsuperscript{145}

d. Evidence of Actual Confusion

As can be expected, here, Plaintiffs and Defendants do not agree over whether any actual confusion occurred.\textsuperscript{146} The Plaintiffs argued that since news of the initiative reached the public, the Plaintiffs have received unwarranted backlash and disdain from individuals in the community over their involvement in facilitating the “growing impoverishment of the People of Puerto Rico.”\textsuperscript{147} Regardless of whether these allegations are well founded, a false endorsement claim under the Lanham Act only requires a likelihood of confusion as to the celebrity’s endorsement of the product or service.\textsuperscript{148}

e. Marketing Channels Used

This factor is used to determine what marketing channels were exploited to potentially confuse the public as to the endorsement of the product or service in question.\textsuperscript{149} Based on the facts of the case, the only marketing channel used would be the actual license plates themselves and the document of permit for motor vehicles.\textsuperscript{150}

\textsuperscript{144} Id. at 1400-01.

\textsuperscript{145} Downing v. Abercrombie & Fitch, 265 F.3d 994, 1000 (9th Cir. 2001).

\textsuperscript{146} Motion to Dismiss Amended Complaint, supra note 118, at 4.

\textsuperscript{147} Amended Complaint, supra note 97, at 11-12.


\textsuperscript{149} For example, the marketing channel used in \textit{Downing v. Abercrombie & Fitch} was a catalog. See 265 F.3d 994, 1008 (9th Cir. 2001).

\textsuperscript{150} See Amended Complaint, supra note 97, at 8-10.
Therefore, this factor would most likely weigh in favor of the Commonwealth, as no major advertising channel was used in furtherance of the Commonwealth’s objective. Additionally, the Puerto Rican government, which has the authority to enact local laws and policies affecting its citizens and requiring them to purchase certain types of license plates, wouldn’t require strong marketing channels to further its objectives.

f. Likely Degree of Purchaser Care

Consumers are more likely to become confused as to whether a celebrity endorses a product when the product in question is relatively inexpensive and does not require a great deal of thought or analysis in deciding whether to purchase or not.151 In *Boston Athletic Association v. Sullivan*, the First Circuit held that a likelihood of confusion occurred when a T-shirt apparel company sold T-shirts displaying the plaintiff’s service mark, “Boston Marathon,” at a public event related to the race.152 The court reasoned that due to the relatively inexpensive price of the t-shirts, roughly $7 each, and the informal and hectic circumstances under which the t-shirts were sold, consumers were not likely to take considerable care in deciding between one event t-shirt and another.153 The consumers here, like the consumers in *Boston Athletic Association*, are the general public, or at least all individuals living in Puerto Rico and all those who own a vehicle. Additionally, like the shirts in *Boston Athletic Association*, the tags and commemorative license plates are moderately priced at $7 and $21, respectively. Therefore, consumers would be unlikely to put much thought into the purchase.154 Even less thought, perhaps, because, unlike the purchasers in *Boston Athletic Association*, purchasers of Puerto Rican license plates and license plate tags only had one mandatory option to select from.155

151 *See* Bos. Athletic Ass’n v. Sullivan, 867 F.2d 22, 30 (1st Cir. 1989).
152 *See id.* at 23, 25, 35.
153 *Id.* at 30.
154 *See id.* (“Inexpensive items, bought by the casual purchaser, are not likely to be bought with great care.”).
155 *See id.* at 31.
g. Defendant’s Intent on Selecting the Plaintiff

This factor analyzes whether the defendant intended to profit from customers’ confusion as to the celebrity endorsement of the product or service. In *Downing*, the defendant purchased photographs of the famous surfers from a professional photographer. After the purchase, the photographer hand wrote the names of each surfer depicted in the photographs so they could be identified. Even so, the defendant made the decision not to obtain permission to use the surfer’s likeness in Abercrombie’s Quarterly catalog. The defendant even went as far as selling apparel in the catalog that mimicked the clothes worn by the surfers. The court held that by using photographs of the well-known surfers in Abercrombie’s Quarterly catalog, which is its “largest advertising vehicle,” the defendant intended to deceive its target population into purchasing its surfer-themed apparel.

Here, like in *Downing*, the Puerto Rican government sought to deceive Puerto Ricans into purchasing the commemorative license plate and vehicle tag by displaying the Hall of Fame player’s name and image on the products without receiving permission by the Clemente estate. Additionally, the Defendant’s Motion to Dismiss, filed on January 9, 2023, does not refute Plaintiffs’ allegations that the Governor of Puerto Rico knew of the estate’s disapproval of the license plate and tag’s design and that the estate did not consent to the use of Roberto Clemente’s name and likeness.

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156 Downing v. Abercrombie & Fitch, 265 F.3d 994, 1008 (9th Cir. 2001).
157 Id. at 1000.
158 Id.
159 Id.
160 Id.
161 See id. at 999, 1008 (finding “[a] jury could reasonably find that Abercrombie intended to indicate to consumers that these legendary surfers were endorsing Abercrombie’s merchandise”).
163 Motion to Dismiss Amended Complaint, *supra* note 118, at 24-25.
h. Likelihood of Expansion of the Product Lines

There is no indication by either party that the Puerto Rican government intends to further use Roberto Clemente’s likeness in a similar campaign. However, both parties acknowledge that Joint Resolutions 16 and 17 were created to establish a revenue source to fund a new sports district, in place of Ciudad Deportiva, which will be known as the “Roberto Clemente Sports District.” Therefore, without a favorable decision for Plaintiffs, it is likely that the unauthorized use of the Roberto Clemente mark will continue because Defendants, as well as other groups, may use Clemente’s name, image, and likeness without permission.

i. Downing Factor Conclusion

No single factor in the Downing test is determinative of whether a likelihood of confusion has occurred in this instance. Further, the court should consider the factors in their totality and weigh each factor as to its importance relevant to the facts of the case at hand. That said, historically, factor one—“[t]he level of Recognition that the Plaintiff Has Among the Segment of the Society for Whom the Defendant’s Product is Intended”—has carried a disproportionate weight or relevance in false endorsement cases. Here, it is well established that Roberto Clemente is a beloved figure among Puerto Ricans and his name and image are memorialized throughout the island. Regarding popularity amongst Puerto Rican athletes, one writer put it best: “There’s Roberto Clemente, and then everyone else.”

Like factor one, factors two and three, which have also been relied on significantly by courts, strongly favor the Plaintiffs, as the Defendants used an actual image of Clemente playing the sport that made him famous while also displaying his name and professional

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164 See McPhaul, supra note 128.
165 See Downing, 265 F.3d at 1008.
uniform number.\textsuperscript{168} He was also a man known by all for his generosity and service, who ultimately died serving those in need; therefore, there is a high degree of correlation between Roberto’s persona and the product intended to accelerate funding for a community sports complex named on behalf of the philanthropist, intended to honor “the dream of Roberto Clemente.”\textsuperscript{169} Of the remaining five factors, all five either favor a likelihood of confusion as to the endorsement of the products—thus weighing in favor of Plaintiffs—or appear neutral.

6. Defenses Raised by the Puerto Rican Government

Even if the court decides there is a likelihood of confusion in favor of Plaintiffs, the court will assess all affirmative defenses the Commonwealth may raise.\textsuperscript{170} The three most common and impactful defenses in false endorsement claims are (1) nominative fair use, (2) use in an expressive work, and (3) parody.\textsuperscript{171} However, parody is defined by the Supreme Court as “the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.”\textsuperscript{172} Here, there is no indication that the Puerto Rican government is providing any unique

\textsuperscript{168} See Downing, 265 F.3d at 1008. Just as the surfers’ “success could be seen as closely-related to [the] [sic] Abercrombie’s surf-related clothing,” so could Clemente’s success be seen as closely related to Defendants’ license plate and tag. Id. See also Lemon v. Harlem Globetrotters Int’l, Inc., 437 F. Supp. 2d 1089, 1097 (D. Ariz. 2006). Like, in Lemon, the “similarity of the Marks to Plaintiffs is clear because the Marks include Plaintiffs’ names and likenesses,” so here is the similarity of the marks on the plate and tag clear because the marks include Clemente’s name and baseball number (“21”).

\textsuperscript{169} See Fontaine, supra note 111.

\textsuperscript{170} Lanham Act Section 43(a) Claims, Practical Law Practice Note W-005-9404.

\textsuperscript{171} See New Kids on the Block v. News Am. Publ’g, Inc., 971 F.2d 302, 308-09 (9th Cir. 1992) (holding that the unauthorized use of a trademark solely to describe associated goods or services does not constitute trademark infringement); Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1239, 1248 (9th Cir. 2013) (holding that a popular sports video game was entitled to use the name, image, and likeness of a famous professional football player in their game to realistically depict players and teams as part of an artistic expression); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 423 (S.D.N.Y. 2002) (finding tarnishment unlikely where defendant’s Timmy Holedigger pet perfume merely parodied or poked fun at plaintiff’s TOMMY HILFIGER mark).

commentary or criticism regarding the legacy of Roberto Clemente, as the rendering merely depicts the famed baseball player along with various facts attributed to his person and baseball career. Further, no defense of parody was raised by Defendants. Thus, this potential defense is inapplicable to this case, and only nominative fair use and use in an expressive work will be briefly analyzed.

a. Nominative Fair Use, Use in an Expressive Work, and the Rogers Test

Nominative fair use claims typically hinge on whether the alleged infringer used the likeness to compare its product or service to that of the plaintiff or uses the plaintiff’s mark to reference its own product. Here, there is no comparison between products endorsed by the Roberto Clemente estate and those of the Defendant nor are the depictions and name of Roberto Clemente necessary to describe license plates offered by the PRDMV.

In Rogers v. Grimaldi, the Second Circuit laid out a two-step process, known as the “Rogers” test, to decide whether a defendant’s use of the mark or likeness of another should be protected under the First Amendment’s Freedom of Speech clause or rejected to protect consumers against confusion. The test explains that the use of an expressive work should be permitted unless (1) the mark has “no artistic relevance to the” work or (2) the mark’s use in the work “explicitly misleads” consumers “as to the source or the content of the work.” The Rogers test specifically deals with expressive works and does not pertain to strictly commercial works. The Supreme Court has defined works that are strictly commercial as “[doing] no more than propose a commercial transaction.” Further, in the pivotal case of Jordan v. Jewel Food Stores, the Seventh Circuit held that a magazine advertisement created by a grocery store congratulating basketball legend Michael Jordan on his induction into the Basketball Hall of Fame was considered purely commercial as it

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173 See Amended Complaint, supra note 97, at 8-9.
175 See Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).
176 Id.
merely promoted brand loyalty to the store and did not mention a specific product.\textsuperscript{179} Here, like Jewel Food Stores in \textit{Jordan}, the Government of Puerto Rico does not reference a single product it is selling on the license plate or tag and instead merely uses the depiction of Roberto Clemente alongside the official emblem of the Government of Puerto Rico to induce a sense of loyalty to the Commonwealth.\textsuperscript{180} Since the rendering of Roberto Clemente on the government’s products provides no artistic relevance to the overall product, and Plaintiffs have provided compelling evidence that consumers have been explicitly misled as to Plaintiff’s endorsement of the government’s product, Defendant’s fair use defense based on artistic expression, if raised, should fail.

b. Government Use and Use in Interstate Commerce

Lastly, Defendant claims that even if false endorsement of Plaintiff’s mark is proven, Puerto Rico has the discretion to communicate its ideas to the public as it sees fit through its right of “government speech.”\textsuperscript{181} Defendant justifies its assertion by citing to the 2015 Supreme Court case \textit{Walker v. Texas Div., Sons of Confederate Veterans, Inc.}\textsuperscript{182} In this case, the Court held that a state may refuse to produce a specialty license plate designed and submitted by a private organization if the state does not endorse the message associated with the specialty license, because state license plates are considered “government speech.”\textsuperscript{183} While license plates may be government speech, nothing in the opinion asserts that a state’s government speech allows it to infringe on the use of a private party’s trademark. In fact, a state or commonwealth cannot compel a private party to express an opinion with which it disagrees under the First Amendment; for example, “Texas cannot require [Plaintiff] to convey ‘the State’s ideological message.’”\textsuperscript{184} Therefore, applying that reasoning here, the Defendant’s mention of \textit{Walker} is counterproductive in proving its defense of “government speech” because it strengthens

\textsuperscript{179} \textit{Jordan v. Jewel Food Stores, Inc.}, 743 F.3d 509, 512, 520, 522 (7th Cir. 2014).
\textsuperscript{180} \textit{Id.; see Amended Complaint, supra} note 97, at 8-10.
\textsuperscript{181} \textit{See Motion to Dismiss Amended Complaint, supra} note 118, at 29.
\textsuperscript{182} \textit{Id.}
\textsuperscript{184} \textit{Id.} at 219.
the Plaintiff’s case. By requiring Puerto Rican citizens to purchase license plates and tags displaying a celebrity’s likeness, the Puerto Rican government is unjustly forcing its ideologies on its citizens.\textsuperscript{185}

Regardless, Defendant still contests that here, no trademark infringement occurred since the government did not use the mark “in commerce” as required by the Lanham Act but instead merely as a “traditional government activit[y].”\textsuperscript{186} Congress has provided a broad interpretation of what constitutes “use in commerce,” explaining that a defendant’s use of a mark in interstate commerce includes “distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.”\textsuperscript{187} The language in the Lanham Act includes distributions by “the United States, [and] all agencies and instrumentalities thereof.”\textsuperscript{188} Generally, a defendant will not succeed in demonstrating its actions are outside of commerce if the defendant’s actions would cause “lost sales or wasted advertising” for the plaintiff or cause confusion among the plaintiff’s consumers as to the endorsement.\textsuperscript{189} Thus, if a plaintiff’s interstate business is affected by a defendant’s acts, the plaintiff does not have to prove that the defendant’s acts occurred across state lines.\textsuperscript{190} Courts have found that when a trademark’s interstate reputation is harmed by a defendant’s entirely local infringement, a substantial effect on interstate commerce has occurred.\textsuperscript{191}

Here, although Defendant’s use of the mark was in relation to products sold exclusively on the island of Puerto Rico by a government entity, sufficient evidence of confusion among citizens was provided by Plaintiffs. The government speech and commerce defenses are not consistent with the Lanham Act and therefore should ultimately fail.

\textsuperscript{185} See id. (“[W]e have recognized that the First Amendment stringently limits a State’s authority to compel a private party to express a view with which the private party disagrees.”).
\textsuperscript{186} See Motion to Dismiss Amended Complaint, supra note 118, at 29; see also 15 U.S. § 1114(1).
\textsuperscript{187} See 15 U.S. Code § 1114(1)(a).
\textsuperscript{188} 15 U.S. Code § 1114(1).
\textsuperscript{189} See 1A Anne Gilson Lalonde, Gilson on Trademarks § 3.03 (Matthew Bender, 2024).
\textsuperscript{190} See id.
\textsuperscript{191} See id.
VI. CONCLUSION AND WARRANTED RELIEF

Since the Commonwealth has already spent an entire year recklessly and intentionally infringing on the trademark rights of the Roberto Clemente estate, and the government’s commemorative license plate campaign has ended, the Commonwealth should first be stripped of its “state-like” immunity at least regarding trademark infringement. The Supreme Court has skirted this “delicate subject” for far too long, allowing the First Circuit to uphold its unsubstantiated precedent.192 Holding the Puerto Rican government accountable for its trademark infringements will help restore integrity to the Commonwealth and facilitate trust in the people it claims to serve. Second, on reliance of 15 U.S.C. § 1114, the First Circuit should direct the District Court of Puerto Rico to grant the Roberto Clemente estate a prohibitory injunction against the Puerto Rican government, enjoining the government from any further use of the Roberto Clemente name, image, or likeness, and an affirmative injunction requiring the government to destroy and recall all vehicle license plates and tags portraying the Roberto Clemente mark.

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192 See Chandler, supra note 11, at 2188-89.