

**THE BUSINESS OF SCHOOL SPIRIT™ :  
COLLEGE SPORTS AND THE COLLEGIATE  
TRADEMARK JUGGERNAUT**

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## INTRODUCTION

“Hook ‘em Horns!” “Boomer Sooner!” “Gator Bait!” “Rock Chalk Jayhawk!” “Hotty Toddy!” “Go Dawgs!” School spirit is nothing new in the United States. Even before these popular collegiate chants were first uttered—and long before the advent of intercollegiate sports—such sentiment has long been a facet of American culture. Since the founding of colleges<sup>1</sup> around the country, the academic and social prestige of being a “Harvard man” or a “Michigan man” would evoke a sense of pride, and often an air of sophistication, in students and alumni. Today, such pride often manifests itself through college athletics, embraced not only by the immediate university community, but also by an ever-increasing and diversifying fan base who strongly identify with and support their teams with a fanatical zeal.

The humble beginnings of intercollegiate sport in the mid-1800s—when students from Harvard and Yale first met in a rowing competition<sup>2</sup>—marked a turning point in the way Americans expressed pride in their universities. While academic prestige and reputation still served as points of pride, the excitement in competition and the glory of victory would soon push school spirit into taking on a life of its own. Over the next century and beyond, such sentiment would extend outside the exclusive circle of the university community itself.<sup>3</sup>

While the school spirit of the old days is still featured prominently on college campuses, collegiate pride has gained new life in a gold mine within the modern market that has given rise to a multibillion-dollar industry.<sup>4</sup> Beginning in the 20th century, college sports teams—especially within the National Collegiate

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<sup>1</sup> To avoid redundancy, this paper will use the terms “college” and “university” synonymously to refer to a four-year institution of higher learning.

<sup>2</sup> Following in the Ivy League schools’ footsteps, university students all over the country fielded baseball, track and field, soccer, and rugby teams during the late 19<sup>th</sup> century. The first known intercollegiate American football game took place in 1869, and the first intercollegiate basketball game occurred in 1896.

<sup>3</sup> See *infra* Part I-A, briefly discussing how goods bearing university emblems were typically only available to college students and student-athletes during the late 19<sup>th</sup> and early 20<sup>th</sup> centuries.

<sup>4</sup> C. Knox Withers, *Sine Qua Non: Trademark Infringement, Likelihood of Confusion, and the Business of Collegiate Licensing*, 11 J. INTEL. PROP. L. 421, 434 (2004).

Athletic Association (“NCAA”)—have attracted a growing fan base who personally identify with university-sponsored clubs, despite a lack of obvious ties to the university. Spurred by an exponential growth in the popularity of college sports due to the “television boom” of the 1980s,<sup>5</sup> universities began to realize the potential of branding efforts and taking advantage of intellectual property rights, specifically through trademark licensing.

While trademarks traditionally serve as source identifiers of a good or service, they have evolved into elements that often become part of the goods and services themselves.<sup>6</sup> This is especially apparent in the realm of college sports, where marks owned by universities can be found on a variety of products, including: apparel, home furnishings, novelty food items, and beyond.<sup>7</sup>

This essay examines the growth of the collegiate licensing industry and the legal developments that followed, specifically the evolution of trademark law and emerging issues relating to university marks. As college sports grow in popularity and profitability, colleges and universities must take great care not only in protecting their marks, but also in choosing when to enforce those protections. As such, a university must determine how to respond to issues such as: small-scale commercial activities involving unlicensed merchandise; freelance artists using collegiate color schemes or logos in the depiction of university sports teams; high schools using modified versions of collegiate logos to represent their own athletic program; or local businesses

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<sup>5</sup> In 1984, the Supreme Court reached a landmark decision in *National Collegiate Athletic Ass’n v. Bd. of Regents of Univ. of Oklahoma*, 104 S.Ct. 2948 (1984), ruling that the NCAA’s television policy, limiting national broadcasts to one football game per week, violated § 1 of the Sherman Antitrust Act. The Court’s decision effectively opened the door for individual universities and conferences to negotiate their own television contracts, which in turn led to a drastic increase in nationally-televised college football games. The resulting national exposure would prompt many institutions to realize their brand potential and eventually implement their own trademark licensing programs.

<sup>6</sup> Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993).

<sup>7</sup> Not even generic hot sauces are out of reach for the collegiate licensing industry. For instance, an Ole Miss fan can buy officially licensed hot sauce featuring the University of Mississippi’s name, wordmarks, and its “Colonel Rebel” mascot on the bottle. See <http://www.hotsauce.com/Ole-Miss-Rebels-p/1031.htm> (last visited Apr. 23, 2016).

engaging in promotional activities that implicitly advertise an affiliation to the university and its athletic programs.

Briefly, to what extent does a university have exclusive rights to its name, identifying marks, and even color schemes, and how far should it go in policing those marks?

Part I of this paper explores the emergence of the collegiate licensing industry and the increasing efforts by institutions to protect their brands by invoking their intellectual property rights. Part II provides an overview of American trademark law and discusses the enforcement of trademark rights, as well as affirmative defenses available to alleged infringers. Part III outlines the case law that has shaped the way institutions protect their trademarks, and finally, Part IV analyzes the issues and trends in collegiate licensing that have emerged as a result.

## I. DEVELOPMENT OF THE COLLEGIATE LICENSING INDUSTRY

### *A. Beginnings of Branding*

While the inception of intercollegiate athletics can be largely attributed to the Ivy League schools, branding efforts and the emergence of the collegiate licensing industry can also be traced to several universities widely viewed as “traditional powerhouses” that have enjoyed significant athletic success over the last century.<sup>8</sup> The first known licensing deal was executed in the 1930s, but collegiate trademark licensing truly originated during the 1970s, flourished in the 1980s and exploded into a billion-dollar business model in the decades that followed.

Prior to the 1930s, it was not uncommon for college students to own products bearing their alma mater’s name. These items—including notepads, pencils, folders, and other school supplies—could typically be found at the local campus store.<sup>9</sup> On the other hand, branded apparel was only available in the form of team wear for varsity athletes. The major supplier of team uniforms at

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<sup>8</sup> The University of California, Los Angeles (“UCLA”) and Ohio State University were among the first to venture into licensing, along with Alabama, Michigan State, Texas, and Southern California (“USC”). Jack Revoyr, *Non-Definitive History of Collegiate Licensing*, 88 TRADEMARK REP. 370 (1998).

<sup>9</sup> Revoyr, *supra* note 8, at 371; Jacob H. Rooksby, *University™: Trademark Rights Accretion in Higher Education*, 27 HARV. J.L. & TECH. 349, 360 (2014).

the time, Champion Products,<sup>10</sup> would soon seize upon a prime opportunity. In addition to producing team uniforms, Champion began printing clothing bearing college names and insignia to be sold at campus bookstores, which proved wildly popular among students.<sup>11</sup> During the pre- and post-World War II eras, campuses all over the country adopted mascots and began forming their own traditions. As a result, various depictions of university names, mascots, and insignia were printed onto clothing, pennants, pin back buttons, and other types of merchandise by unlicensed vendors seeking to capitalize on these tangible symbols of school spirit.<sup>12</sup>

While colleges and universities gradually became aware of the growing commercial use of their names and began considering the ramifications of allowing such use to go largely unchecked,<sup>13</sup> decades passed before schools began implementing trademark licensing programs in the 1970s.<sup>14</sup> As the number of national telecasts of NCAA events increased, so too did national interest in

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<sup>10</sup> A reasonable analogy can be made that Champion was the “Nike” of the early days of college sports. The company has claimed that it “developed the first garment printing process in the United States” and that it was the sole producer and supplier of team uniforms for varsity athletes during much of the 1930s. Revoyr, *supra* note 8, at 371.

<sup>11</sup> *Id.* The 1930s saw the first known licensing arrangement—albeit a primitive one—when the soft goods buyer for the UCLA bookstore asked Champion to print two-dozen t-shirts bearing UCLA’s name (much to the ire of the store manager, who viewed the decision as extravagant). On the day of arrival, the shirts sold out within a matter of hours. (The manager proceeded to scold the middleman for not ordering enough shirts. “Thus, the first recorded skirmish occurred between college book store management and licensing management, and the tensions continue today.”) *Id.*

<sup>12</sup> For instance, in the NCAA’s Southeastern Conference (“SEC”), most schools adopted their team nicknames (e.g. Rebels, Bulldogs, and Gators) and their cheers and songs largely during the pre-war era. See Scott Allen, *How the SEC Schools Got Their Nicknames*, MENTAL FLOSS, INC. (Sept. 24, 2010), <http://mentalfloss.com/article/25887/how-sec-schools-got-their-nicknames>. While bulldogs, tigers, and elephants, for example, were often depicted on merchandise and promotional materials during the early years of those athletic programs, teams’ specific mascots (e.g. Uga, Aubie, and Big Al) and logos often debuted during the 1950s or later. *Id.*

<sup>13</sup> The University of California System, for instance, asked the State of California to enact legislation protecting its name (and the name of its individual campuses) from possible misuse. Revoyr, *supra* note 8, at 373.

<sup>14</sup> Ohio State was the first known school to file trademark applications for its name and the “Buckeye” mascot. It also implemented one of the first collegiate licensing programs in 1974. *Id.* at 372-73.

universities' brands and in merchandise featuring the universities' identifying marks. In 1973, UCLA proved to be a trailblazer once again, as the school entered into a formal licensing agreement with a watchmaker, authorizing the company to manufacture watches featuring the university's "Bruin" mascot and setting a four-percent royalty rate for any watches sold outside the campus bookstore.<sup>15</sup>

As UCLA and other schools with fledgling licensing programs began reaping the benefits of royalty revenue, others schools soon took notice. Still, questions remained: how could NCAA institutions "sell licenses, manage the licensees, make sure they get paid, and enforce the program" against unlicensed products?<sup>16</sup> While schools such as UCLA and Ohio State laid the foundation for licensing opportunities during the 1970s, the stage would soon be set in the heart of the Deep South for the emergence of a new concept that would bring unprecedented and explosive growth within the realm of the collegiate sports industry.

### *B. The Modern Business Model*

In 1981, Bill Battle, a University of Alabama alumnus and ex-Crimson Tide football player, founded the Collegiate Licensing Company ("CLC") in Selma, Alabama.<sup>17</sup> Recognizing a need for universities to establish licensing programs, Battle first approached his former coach and mentor, the legendary Paul "Bear" Bryant, who agreed to a personal licensing deal with CLC.<sup>18</sup> Shortly thereafter, the University of Alabama signed a licensing agreement of its own, effectively becoming the CLC's first collegiate client.<sup>19</sup>

One of the biggest benefits of dealing with a company like the CLC was that it provided a "one-stop-shop" of sorts for universities seeking to conduct business with companies that

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<sup>15</sup> *Id.* at 374.

<sup>16</sup> Michael Smith, *Champions: Bill Battle, Licensing Icon*, SPORTS BUSINESS DAILY (Mar. 26, 2012), <http://www.sportsbusinessdaily.com/Journal/Issues/2012/03/26/Champions/Battle.aspx>.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* At that time, Coach Bryant was nearing college football's all-time wins record and was receiving an avalanche of requests to license his name, image, and likeness on memorabilia.

<sup>19</sup> *Id.*

produce high-quality products.<sup>20</sup> Interestingly, universities were initially hesitant to enter into the domain of licensing, often unsure or unaware of their ownership rights in their identifying marks. According to Battle, one of the biggest hurdles the company faced was in persuading the schools that they did possess those ownership rights and that they could share in the revenue stream generated by the sale of such emblematic merchandise.<sup>21</sup>

After convincing universities of their rights to those identifying marks, Battle's next challenge was to persuade commercial enterprises to chip in to this proposed business model. Initially, retailers were loath to participate.<sup>22</sup> Still, according to Battle, one key selling point was exhibited by defeating the argument that state names could not be trademarked. In response, he countered, for instance, "[i]nteresting that you're putting . . . Alabama in crimson and white [on merchandise]. Why don't you put it in purple and green and we probably won't bother you."<sup>23</sup> Another benefit he pitched to potential licensees was the prospect that they need only "sign one contract" to acquire licensing rights of all of CLC's clients.<sup>24</sup>

In large part due to Battle's vision and persistence, collegiate trademark licensing evolved from a \$100 million enterprise in 1981 to a nearly \$5 billion industry in 2012.<sup>25</sup> As of 2015, three major players in the private sector manage most collegiate licensing programs: CLC, Learfield Licensing, and Fermata.

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<sup>20</sup> See Dave Zimmermann, *College Athletes as Trademarks: How Did We Get Here, and What Happens Next?*, 17 DUQ. BUS. L.J. 229, 248 (2015).

<sup>21</sup> John Grady & Steve McKelvey, *Trademark Protection of School Colors: Smack Apparel and Sinks Decisions Trigger Color-ful Legal Debate for the Collegiate Licensing Industry*, 18 J. LEGAL ASPECTS SPORT 207, 208 (2008).

After convincing university officials of their rights in their various marks, Battle's next challenge was to persuade commercial enterprises to participate. According to Battle, one key selling point was defeating the argument that state names could not be trademarked. In response, Battle would tell manufacturers and retailers something along the lines of, "Interesting that you're putting . . . Alabama in crimson and white. Why don't you put it in purple and green and we probably won't bother you." *Id.*

<sup>22</sup> For an interesting anecdote about one such retailer, Champion, see Revoyr, *supra* note 8, at 378-79.

<sup>23</sup> Grady & McKelvey, *supra* note 21, at 208.

<sup>24</sup> Revoyr, *supra* note 8, at 387.

<sup>25</sup> Rooksby, *supra* note 9, at 359.

To date, CLC provides trademark and brand management services to more than 200 colleges and universities,<sup>26</sup> several athletic conferences,<sup>27</sup> most football bowl games, the Heisman Trophy, and the NCAA itself.<sup>28</sup> Even those college sports fans unfamiliar with collegiate licensing would likely recognize the iconic holographic tag on officially licensed merchandise featuring CLC's clients' trademarks, a testament to the company's track record in trailblazing and innovation within the industry.

As to CLC's competitors, Learfield Licensing Partners acquired two of CLC's rivals in 2014—one being the Licensing Resource Group—and became the second-largest license management provider in the business. It represents schools and athletic conferences in all NCAA divisions, as well as the National Association of Intercollegiate Athletics (“NAIA”) and the National Junior College Athletic Association (“NJCAA”).<sup>29</sup> Additionally, in recent years, a third power player has emerged—Fermata Partners. What Fermata lacks in quantity, it certainly makes up for in quality; Fermata exclusively manages the trademark rights for five major universities—Georgia, Kentucky, Miami, Notre Dame, and Oregon.<sup>30</sup>

While these companies now bring in millions of dollars in revenue for their collegiate clients, the slow growth and relatively recent emergence of the industry can be attributed to universities' initial reticence to entering the licensing business. The schools' reluctance can be explained by three major factors: (1) they historically have regarded their athletic programs as part of the universities' “overall educational mission” and as an antithesis to professional sports leagues; (2) they historically lacked the

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<sup>26</sup> Among the so-called “Power Five” athletic conferences, the CLC represents 11 of 14 SEC members, 12 of 14 Atlantic Coast Conference (“ACC”) members, 8 of 11 Big XII members, 10 of 12 Pacific-12 (“Pac-12”) members, and 11 of 14 Big Ten members.

<sup>27</sup> In addition to representing a majority of the “Power Five” universities, CLC also represents three of the five conferences themselves—the SEC, ACC, and Big XII.

<sup>28</sup> COLLEGIATE LICENSING COMPANY, *Clients*, <http://clc.com/Clients.aspx> (last visited Apr. 24, 2016).

<sup>29</sup> LEARFIELD LICENSING PARTNERS, *Clients*, <http://learfieldlicensing.com/clients/> (last visited Apr. 24, 2016).

<sup>30</sup> FERMATA PARTNERS, *Universities*, <http://fermatacollege.com/universities/> (last visited Apr. 24, 2016). As of April 2016, the University of Wisconsin, currently represented by CLC, is scheduled to assign its trademark management activities to Fermata on July 1, 2016.



knowledge and resources necessary to prioritize protection of their intellectual property interests; and (3) they have only been incentivized to capitalize on their trademark rights in the last few decades, as collegiate licensing has only recently gained a reputation as “big business” and revenue-maker.<sup>31</sup>

Today, however, due in large part to the contributions of collegiate licensing and brand consulting services, universities have a much deeper understanding of their ownership rights under American trademark law, allowing them to maximize and capitalize on the benefits that accompany those rights.

## II. TRADEMARK LAW

Unlike other types of intellectual property—whose protections are derived from the Copyright Clause of the Constitution<sup>32</sup>—American trademark rights are derived from the Commerce Clause<sup>33</sup> and are protectable at the state and federal level, at common law and by statute.<sup>34</sup> Specifically, a trademark is defined as “any word, name, symbol, or device, or any combination thereof, used to identify and distinguish the goods or services of one entity from those of others.”<sup>35</sup> Additionally, trademarks cannot be deceptive, geographic in nature, functional, scandalous or disparaging, or likely to cause consumer confusion.<sup>36</sup>

At the heart of trademark law is the Federal Trademark Act of 1946—also known as the “Lanham Act”—which is intended to protect consumers from being deceived or confused as to the source or origin of goods and services and to provide remedies for trademark infringement and unfair competition.<sup>37</sup>

In the case of an infringement suit, a plaintiff must demonstrate ownership of a valid and legally protectable mark

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<sup>31</sup> Grady & McKelvey, *supra* note 21, at 208-09.

<sup>32</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>33</sup> U.S. CONST. art. I, § 8, cl. 3.

<sup>34</sup> Rooksby, *supra* note 9, at 356.

<sup>35</sup> Scott Bearby & Bruce Siegal, *From the Stadium Parking Lot to the Information Superhighway: How to Protect Your Trademarks from Infringement*, 28 J.C. & U.L. 633, 634 (2002).

<sup>36</sup> 15 U.S.C. § 1052(a) (2006).

<sup>37</sup> Bearby & Siegal, *supra* note 35, at 635.

and establish that the alleged infringer's use of the mark in commerce is likely to cause consumer confusion.<sup>38</sup>

To prove ownership, a plaintiff must show that it has engaged in prior use of the mark, that the mark is not functional, and that the mark is distinctive.<sup>39</sup> The distinctiveness of a mark is key, as it demonstrates the mark's strength—a key component in a court's evaluation of what degree of protection is afforded. In trademark law, courts recognize four categories of mark distinctiveness,<sup>40</sup> where an "arbitrary" mark is the strongest kind of mark and "generic" is the weakest—unprotectable as a matter of law. If the mark at issue is found to be merely descriptive in nature within this hierarchy, the plaintiff must also establish "secondary meaning" to gain protection of that mark.<sup>41</sup>

Courts have defined secondary meaning as an "association," "the basic element of . . . [which] is a mental recognition in buyers' and potential buyers' minds that products connected with the symbol or device . . . are associated with the same source."<sup>42</sup> In the context of college sports, for example, the name "Oklahoma" (which, as a geographic designation, is descriptive on its own) on a replica jersey is only protectable if that jersey features a crimson-and-cream color scheme, suggesting an association—secondary meaning—with the University of Oklahoma or Sooner athletics.

After proving validity and ownership of the mark, a plaintiff then must establish that the defendant's unauthorized use of that mark is likely to cause consumer confusion as to the origin<sup>43</sup> of the

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<sup>38</sup> Steven N. Geise, *A Whole New Ballgame: The Application of Trademark Law to Sports Mark Litigation*, 5 SETON HALL J. SPORT L. 553, 558 (1995).

<sup>39</sup> Michael C. Shull, *Biting the Hand that Feeds: How Trademark Protection Might Threaten School Spirit*, 21 MARQ. SPORTS L. REV. 641, 644 (2011).

<sup>40</sup> *Id.* at 645-646.

<sup>41</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 (1995). However, if the trademark in question is registered, then the plaintiff does not have to prove secondary meaning. Geise, *supra* note 39, at 558.

<sup>42</sup> Nat'l Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 658 (W.D. Wash. 1982) (citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 208 U.S.P.Q. 713, 716 (9th Cir. 1980)).

<sup>43</sup> While the likelihood-of-confusion test has historically turned on whether the consumer would be confused as to the *origin* (i.e. source of manufacture) of a product, the Third Circuit effectively expanded this concept to include confusion as to a product's sponsorship or affiliation. *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 713 (W.D. Pa. 1983). For further analysis of the landmark *Pitt* decision, see *infra* Part III.

goods. To determine likelihood of confusion, courts often employ a “digits of confusion” test, a series of factors guiding the analysis of the issue.<sup>44</sup> A plaintiff need not, however, produce “evidence of actual confusion” to prove a “likelihood of confusion.”<sup>45</sup>

For universities seeking to simultaneously capitalize upon and defend their brand and marks, the expansion of trademark law to protect consumers from confusion as to sponsorship and affiliation adds an even stronger layer of protection.<sup>46</sup> Under both legislative and judicial authority, universities can find broad protection for their trademarks, as trademark law has expanded beyond words and logos to include slogans, graphic designs, characters, pictures, and other variations of source-identifiers.<sup>47</sup>

### *A. Importance of Enforcement*

In an industry that generates billions of dollars in merchandise sales, it is easy to see what motivates universities to become more aggressive in protecting their trademarks.<sup>48</sup> First, because they are afforded such broad protection under trademark law, colleges stand to generate enormous revenue streams based on the sale of officially licensed merchandise.<sup>49</sup> Coupled with declining state appropriations and tuition revenue, licensing presents an economic and financial opportunity that these institutions simply cannot ignore.<sup>50</sup>

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<sup>44</sup> Bd. of Supervisors of La. State Univ. v. Smack Apparel Co., 438 F. Supp. 2d 653, 659 (E.D. La. 2006), *aff'd sub nom.* Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465 (5th Cir. 2008) (This test often includes (but is not limited to) 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>45</sup> Celeste L. Geier, *Protection of University Symbols*, 38 BAYLOR L. REV. 661, 679 (1986).

<sup>46</sup> This is especially important, given that universities are not the source of most goods bearing their trademarks (e.g. universities do not manufacture t-shirts or golf bags featuring their logos).

<sup>47</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9, cmt. g (1995).

<sup>48</sup> Humorously, in retrospect, colleges were reportedly “ecstatic” at the prospect of making \$100,000 a year in licensing royalties in 1981. Grady & McKelvey, *supra* note 21, at 207.

<sup>49</sup> Among major sports organizations, college athletics trails only the National Football League (“NFL”) and Major League Baseball (“MLB”) in merchandise sales. *Id.*

<sup>50</sup> Rooksby, *supra* note 9, at 350.

Secondly, schools must protect their marks from consumer confusion or dilution. From a branding and reputational perspective, such protection is of the utmost priority under the “negative goodwill” theory—the idea that if unauthorized products are of subpar quality or portray the university in an unfavorable light, they directly harm the university’s goodwill in the eyes of the consumer.<sup>51</sup> As to quality, if a consumer draws an association between a poorly made product and the university that product is infringing upon, that consumer may be misled into believing that the university’s genuine licensed products are also of poor quality.<sup>52</sup> Products projecting the school in an unflattering light, however, pose a more ubiquitous threat to a university’s goodwill. For instance, several unlicensed vendors produce t-shirts referencing alcohol or sexual connotations in conjunction with university marks and color schemes; these sellers are often targeted through cease-and-desist letters or threat of litigation in an effort to remove the university’s image from the profanity or obscenity associated with such merchandise.<sup>53</sup>

Lastly, and perhaps most importantly, universities must actively use their marks in commerce to retain protection and ownership rights in those marks—the “use it or lose it” principle of abandonment.<sup>54</sup> If such marks were to fall out of a university’s ownership, anyone could use those marks without fear of legal consequence.<sup>55</sup>

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<sup>51</sup> Kozinski, *supra* note 6, at 971-972.

<sup>52</sup> *Id.*

<sup>53</sup> One such case involved a duo of University of Delaware students who produced homecoming t-shirts with the phrase “U can suck our D” and featuring the school’s colors. Sean O’Sullivan, *Pair Sues Del. College Over ‘U Can Suck Our D’ T-shirts*, USA TODAY (Dec. 14, 2012) <http://www.usatoday.com/story/news/nation/2012/12/14/tshirts-free-speech-lawsuit/1769195/>; see also *Univ. of Kansas v. Sinks*, 565 F. Supp. 2d 1216 (D. Kan. 2008) (involving several irreverent t-shirt designs implying an association with the University of Kansas).

<sup>54</sup> David E. Armendariz, Note, *Picking on the Little Guy? Asserting Trademark Rights Against Fans, Emulators, and Enthusiasts*, 90 TEX. L. REV. 1259, 1267 (2012).

<sup>55</sup> For universities who wish to limit certain marks, barring a finding by the Patent and Trademark Office that a mark is invalid under the law, they must continue to use such marks in commerce to retain ownership. This is a perpetual “catch-22” for schools such as the University of Mississippi and the University of Illinois at Urbana-Champaign, whose “Colonel Rebel” and “Chief Illiniwek” logos, respectively, have come under scrutiny in recent years. Both universities have tried to distance themselves from these marks, but they still must license goods featuring the marks so they can

Universities must also weigh the potential costs of enforcement. While some unlicensed merchandise is of poor quality or disparaging to a school's goodwill, there are many instances, in contrast, in which unlicensed merchandise is high quality and even beneficial to that school's goodwill.<sup>56</sup> If universities choose to take a hardline stance against those sellers, they risk potential backlash from fans believing that policing school trademarks in particular situations is unwarranted. More often than not, however, in an industry where marks represent nearly \$3 billion in annual sales,<sup>57</sup> colleges will actively seek out and attempt to remedy instances of infringement.

### *B. Affirmative Defenses*

While the Lanham Act provides plaintiffs an array of remedies to protect against trademark infringement, it also allows for several affirmative defenses available to a defendant: abandonment, zone of expansion, and functionality. Additionally, a defendant may also argue fair use or assert First Amendment protections.

A finding of abandonment requires a showing of intentional non-use of a mark in the ordinary course of trade.<sup>58</sup> A school must have discontinued a mark with the intent not to resume use in commerce, or it must have allowed the mark in question to enter

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control the rights to those images. For a brief discussion on both situations, see Errol Castens, *Ole Miss to Retire Colonel Reb Merchandise*, NORTHEAST MISSISSIPPI DAILY JOURNAL (Mar. 16, 2010), <http://djournal.com/news/ole-miss-to-retire-colonel-reb-merchandise/>; Danny Ecker, *Here Are U of I's New 'Chief Illiniwek' Rules*, CRAIN'S CHICAGO BUSINESS (Oct. 22, 2013), <http://www.chicagobusiness.com/article/20131022/BLOGS04/131029943/here-are-u-of-is-new-chief-illiniwek-rules>; see also 15 U.S.C. § 1127 (2000).

<sup>56</sup> Creative works often fall under this category. Highly regarded illustrators such as Jack Davis (Georgia), Phil Neel (Auburn, Clemson), and John Churchill Chase (Tulane, Texas, LSU, and others) incorporated a variety of collegiate marks in their work. See generally C.J. Schexnayder, *Like Everything Else About College Football, Game Program Cover Art Has Evolved Over the Years*, SB NATION (Oct. 25, 2011), <http://www.footballstudyhall.com/2011/10/25/2512776/like-everything-else-about-college-football-game-program-cover-art>; see also Univ. of Alabama Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

<sup>57</sup> Gerald T. Tschura, *Likelihood of Confusion and Expressive Functionality: A Fresh Look at the Ornamental Use of Institutional Colors, Names and Emblems on Apparel and Other Goods*, 53 WAYNE L. REV. 873, 875 (2007).

<sup>58</sup> Withers, *supra* note 4, at 431.

into the public domain.<sup>59</sup> Strict proof is required; evidence of naked licensing—the uncontrolled use of a mark by unauthorized third parties—is insufficient.<sup>60</sup> Historically speaking, defendants find it difficult to meet such a high burden of proof, especially when facing a university plaintiff in litigation.<sup>61</sup>

If a defendant asserts a zone of expansion defense, the court must analyze the scope of the plaintiff's mark in relation to that of the unauthorized defendant's use of that mark.<sup>62</sup> Essentially, the court seeks to determine whether (1) the plaintiff and defendant's use of a mark operate within "two sufficiently distinct and geographically separate markets" and (2) that there is no likelihood that the plaintiff will enter into the defendant's market, which would potentially cause a likelihood of consumer confusion.<sup>63</sup>

While functionality may be argued at the outset to prevent a mark from gaining any protection under trademark law, it may also be asserted as an affirmative defense. A mark that is "merely functional" cannot receive protection,<sup>64</sup> where functionality describes those features that constitute the benefit of a product—including the "aesthetically pleasing elements of those product[s]."<sup>65</sup> Finally, a defendant may argue a fair use defense—e.g. use for scholarship, criticism, parody, etc. To prove fair use, the defendant must establish that: (1) the product "must not be readily identifiable without the use" of the mark; (2) only "so much of the mark may be used as is reasonably necessary" to identify the product; and (3) "the user must do nothing that would, in

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<sup>59</sup> *Id.*

<sup>60</sup> *Bd. of Regents of the Univ. Sys. of Georgia v. Buzas Baseball, Inc.*, 176 F. Supp. 2d 1338, 1349 (N.D. Ga. 2001).

<sup>61</sup> Defendants raised the abandonment defense in *Bd. of Governors of Univ. of N. Carolina v. Helpingstine*, 714 F. Supp. 167 (M.D.N.C. 1989) (arguing that UNC abandoned its marks by allowing extensive uncontrolled use of those marks); Robert Lattinville, *Logo Cops: The Law and Business of Collegiate Licensing*, 5 KAN. J.L. & PUB. POL'Y 81, 87 (1996) (The *Helpingstine* court noted that despite the uncontrolled use, the "marks did not lose all significance as indications of origin.").

<sup>62</sup> Lattinville, *supra* note 62, at 86.

<sup>63</sup> *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), vacated pursuant to settlement, 859 F. Supp. 80 (S.D.N.Y. 1994).

<sup>64</sup> It may gain protection, however, if it obtains secondary meaning. Withers, *supra* note 4, at 426.

<sup>65</sup> *Id.*

conjunction with the mark,” suggest an affiliation with or endorsement by the mark holder.<sup>66</sup> A court may also find itself performing a balancing act when evaluating a First Amendment defense, weighing the protection of consumers from confusion versus the protection of the free flow of communication and expression of ideas.<sup>67</sup>

### III. COLLEGE TRADEMARKS IN COURT

With a deeper understanding of their trademark rights and the guidance of collegiate licensing and consulting organizations, universities today have finally prioritized the enforcement of their intellectual property protections. They also have become much more aggressive in policing against infringement—sending out several cease-and-desist letters to unauthorized users of marks and bringing those users who ignore their warnings to court. The most highly publicized lawsuits within the realm of collegiate licensing demonstrate the broadening scope of universities’ enforcement efforts; for example, schools have recently brought trademark actions over slogans,<sup>68</sup> mark dilution through parody use,<sup>69</sup> use of modified marks,<sup>70</sup> use of trademarks—including school colors—in artwork,<sup>71</sup> use of team nicknames and colors,<sup>72</sup> and even the unlicensed use of color schemes alone.<sup>73</sup>

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<sup>66</sup> John Grady & Steve McKelvey, *Trademark Protection of School Colors: Smack Apparel and Sinks Decisions Trigger Color-ful Legal Debate for the Collegiate Licensing Industry*, 18 J. LEGAL ASPECTS SPORT 207, 216 (2008).

<sup>67</sup> Derik T. Sanders, *Out of Bounds: Defining the Boundaries of Trademark and Artistic Expression in University of Alabama v. New Life Art*, 16 SMU SCI. & TECH. L. REV. 227, 232 (2013).

<sup>68</sup> See Grady & McKelvey, *supra* note 67, at 209; *Seahawks, A&M Resolve ‘12<sup>th</sup> Man’ Dispute*, ESPN.COM (May 8, 2006), <http://sports.espn.go.com/nfl/news/story?id=2437992>.

<sup>69</sup> See Mark Babineck, *Compromise Reached in UT ‘Saw ‘Em Off’ Suit*, HOUSTON CHRONICLE (June 26, 2007, 5:30 A.M.), <http://www.chron.com/news/houston-texas/article/Compromise-reached-in-UT-Saw-Em-Off-suit-1821277.php>.

<sup>70</sup> Board of Regents, Univ. of Texas Sys. v. KST Elec., Ltd., 550 F. Supp. 2d 657 (W.D. Tex. 2008); see also Rebecca Tushnet, *Longhorn Is Longshot for Federal Fame* (Mar. 9, 2008), <http://tushnet.blogspot.com/2008/03/longhorn-is-long-shot-for-federal-fame.html> (discussing a trademark dispute between the University of Texas and an electrical company over use of a longhorn silhouette mark).

<sup>71</sup> See Univ. of Alabama Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

During the 1980s and 1990s, case law regarding collegiate trademarks diverged into two major families of cases as a result of the courts' differing analyses of the likelihood of confusion standard. One line of cases features courts holding that the defendant's unauthorized use of a mark violated a plaintiff's trademark rights, while courts in the second line of cases held that such use created no likelihood of confusion.<sup>74</sup> In the first line of cases,<sup>75</sup> courts examined whether a consumer would logically assume that "the mark originates in the trademark owner" without requiring the belief that "the trademark owner was responsible for the product's manufacture."<sup>76</sup> Courts in the second line of cases,<sup>77</sup> however, seemed to suggest that as long as the consumer did not falsely believe that the trademark holder was the source of a product, an unauthorized user can capitalize on the market opportunity that the mark holder has created, even if only using those trademarks.<sup>78</sup> Simply put, where courts in the first line of cases assume that consumers desired goods because of an association with the trademark owner, courts in the other line of cases reject that notion, contending instead that consumers do not necessarily purchase products simply due to such a perceived association.<sup>79</sup>

Major developments in the law regarding collegiate trademarks began with the landmark case *University of*

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<sup>72</sup> See *UGA Guards Its Dog*, ONLINEATHENS: ATHENS BANNER-HERALD (Feb. 4, 2007), [http://onlineathens.com/stories/020407/uganews\\_20070204065.shtml#.Vw3HcmMWyf4](http://onlineathens.com/stories/020407/uganews_20070204065.shtml#.Vw3HcmMWyf4) (discussing a dispute between the University of Georgia and "Bulldog Movers").

<sup>73</sup> Bd. of Supervisors of La. State Univ. v. Smack Apparel Co., 438 F. Supp. 2d 653, 659 (E.D. La. 2006); see *infra* Part IV-A for a more in-depth discussion about the *LSU v. Smack* case.

<sup>74</sup> C. Knox Withers, *supra* note 65, at 439.

<sup>75</sup> This group includes cases such as *University of Georgia Athletic Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985); and *Board of Trustees of Univ. of Arkansas v. Prof'l Therapy Servs., Inc.*, 873 F. Supp. 1280 (W.D. Ark. 1995).

<sup>76</sup> C. Knox Withers, *supra* note 65, at 444.

<sup>77</sup> This group includes cases such as *Univ. of Pittsburgh v. Champion Products, Inc.*, 686 F.2d 1040 (1982); and *Bd. of Governors of Univ. of North Carolina v. Helpingstine*, 714 F. Supp. 167 (M.D.N.C. 1989); see also C. Knox Withers, *supra* note 65, at 445.

<sup>78</sup> C. Knox Withers, *supra* note 65, at 446.

<sup>79</sup> *Id.*



*Pittsburgh v. Champion Products, Inc.*<sup>80</sup> in 1983—the first major legal dispute in collegiate licensing. While the court ruled in Champion’s favor that it could sell apparel bearing University of Pittsburgh (“Pitt”) logos, the court effectively legitimized more expansive trademark protection for universities by stating that consumers can be confused as to a product’s sponsorship, affiliation, or approval—not solely its source of manufacture.<sup>81</sup>

Universities notched another legal victory after *University of Georgia Athletic Association v. Laite*,<sup>82</sup> a case in which Georgia sued a wholesaler of novelty beers for depicting a white bulldog wearing a red sweater on cans of beer, asserting trademark infringement and consumer confusion—specifically that consumers might falsely believe that Georgia licensed or sponsored the product.<sup>83</sup> The court evaluated the strength of Georgia’s mark, the similarity between the bulldog marks, and the “potential intent” that “Battlin’ Bulldog Beer” would confuse consumers as to whether it was affiliated with the University of Georgia.<sup>84</sup> While Georgia’s bulldog mark and the beer can bulldog were not identical, the court found that the key selling point of the beer was not for taste, but to “catch the attention” of Georgia fans and subsequently upheld injunctive relief for Georgia.<sup>85</sup> This decision suggests that courts may be willing to find infringement when an unlicensed product evokes just enough similarity to cause a likelihood of confusion for affiliation with that school.

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<sup>80</sup> *Univ. of Pittsburgh v. Champion Prods., Inc.*, 686 F.2d 1040, 1043 (1982). In the wake of the 1977 Sugar Bowl, Pitt registered twenty-nine marks and implemented a licensing program; Pitt subsequently engaged in a dispute with Champion Products over its refusal to participate within its licensing program.

<sup>81</sup> Jacob H. Rooksby, *University™: Trademark Rights Accretion in Higher Education*, 27 HARV. J.L. & TECH. 349, 361 (2014). This decision was a legal victory for colleges, opening the door for them to capitalize further on their marks by allowing them to license their marks for use by manufacturers and retailers in channels unrelated to their primary uses. *Id.* at 363.

<sup>82</sup> *Univ. of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535 (11th Cir. 1985).

<sup>83</sup> David Franklin, *League Parity: Bringing Back Unlicensed Competition in the Sports Fan Apparel Market*, 86 CHI.-KENT L. REV. 987, 1011 (2011); *see also Laite*, 756 F.2d at 1546 n.28.

<sup>84</sup> Randall L. Newsom, Note, *Cease and Desist: Finding an Equitable Solution in Trademark Disputes Between High Schools and Colleges*, 52 B.C. L. REV. 1833, 1851 & n.138 (2011).

<sup>85</sup> *Laite*, 756 F.2d at 1545, 1547.

The next significant case to come down the legal pipeline for collegiate licensing took place in 1989 and involved a dispute between the University of North Carolina (“UNC”) and a local t-shirt retailer. Like Pitt in *Pitt v. Champion*, UNC implemented its own licensing program in the early 1980s and began soliciting retailers that were selling goods featuring its marks.<sup>86</sup> Helpingstine, the owner of a local t-shirt store, declined to participate in the licensing program but continued to sell merchandise featuring UNC’s name and symbols anyway, asserting that UNC had abandoned its marks through allowing uncontrolled use before it instituted its licensing program.<sup>87</sup> The court soundly rejected this argument and found for UNC<sup>88</sup>—further fueling a perception that courts would heavily favor universities in matters of trademark protection and licensing, regardless of previous uncontrolled use by third party sellers.<sup>89</sup>

One other early case had a major impact on the development of the collegiate licensing industry—in *Board of Trustees of University of Arkansas v. Professional Therapy Services, Inc.*,<sup>90</sup> Arkansas sued for infringement after a local clinic added the word “RAZORBACK” to its name and adopted a red running hog—similar to the one Arkansas used—as its logo.<sup>91</sup> Following the trend, the court notably ruled that Arkansas had acquired a strong mark and that “if there was even the smallest likelihood of confusion” about an association between a business and the plaintiff university, the university should prevail.<sup>92</sup> This decision, coupled with the 1995 *Qualitex* decision allowing for trademark

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<sup>86</sup> Bd. of Governors of Univ. of N.C. v. Helpingstine, 714 F. Supp. 167, 169 (M.D.N.C. 1989).

<sup>87</sup> *Id.* at 169-70.

<sup>88</sup> *Id.* at 177. This holding would be reaffirmed by the Trademark Trial and Appeal Board in 1994 when the University of Wisconsin attempted to register variations of its “Bucky Badger” mascot logo that largely fell into disuse. Local stores that did use those variations on merchandise attempted to block the registration, asserting abandonment, but these efforts failed. *Univ. Book Store v. Univ. of Wis. Bd. Of Regents*, 33 U.S.P.Q.2d 1385 (T.T.A.B. 1994); see also Newsom, *supra* note 85, at 1852 & n.143.

<sup>89</sup> Newsom, *supra* note 85, at 1852.

<sup>90</sup> *Id.*; Bd. of Trs. of Univ. of Ark. v. Prof'l Therapy Servs., Inc., 873 F. Supp. 1280 (W.D. Ark. 1995).

<sup>91</sup> *Prof'l Therapy Servs., Inc.*, 873 F. Supp. at 1284-85.

<sup>92</sup> Newsom, *supra* note 85, at 1853.

protection of color schemes,<sup>93</sup> served as a catalyst for colleges to significantly step up their efforts in policing their marks.<sup>94</sup>

The cumulative effect of these early cases demonstrates two key trends that emerged early in collegiate trademark litigation: (1) courts tend to favor college plaintiffs in trademark and licensing disputes; and (2) in granting schools broader protections over their trademarks, these decisions set the stage for more litigation, as colleges became emboldened to test the limits of their ownership rights.

#### IV. TRENDS AND EMERGING ISSUES

##### *A. Expansion of Trademark Protections*

The above cases illustrate a gradual expansion of legal protections for university marks, which simultaneously shaped the development of collegiate licensing over the course of the 1980s and 1990s. Originally, infringement cases merely required a trademark owner to prove there was a likelihood of consumer confusion as to the origin or source of a product.<sup>95</sup> *Pitt* broadened the likelihood-of-confusion standard to include the likelihood of confusion as to a product's affiliation or sponsorship.<sup>96</sup> *Georgia v. Laite* demonstrated that courts are willing to find infringement when a plaintiff's mark and a defendant's mark are sufficiently similar enough to meet the likelihood-of-confusion standard established in *Pitt*.<sup>97</sup> The *UNC v. Helpingstine* case indicated that, even if a school previously allowed uncontrolled use of its marks by merchants, courts would likely favor the plaintiff university.<sup>98</sup> Finally, the *Arkansas* case established that if there were even the "smallest likelihood of confusion" as to the affiliation between the alleged infringer and the university, courts should rule in favor of the university.<sup>99</sup>

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<sup>93</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>94</sup> Newsom, *supra* note 85, at 1853.

<sup>95</sup> *See supra* note 43.

<sup>96</sup> *See supra* note 80.

<sup>97</sup> *See supra* note 82.

<sup>98</sup> *See supra* note 86.

<sup>99</sup> *See supra* note 90.

With the massive popularity of college sports today, even more complicated issues have arisen as a result. For example, can colleges establish secondary meaning in their colors, and if those color schemes alone are used on unlicensed apparel, are they deserving of protection if they are non-functional? One of two major precursors to those questions, *Qualitex*, established that color can be a source identifier just as shapes, sounds, and scents can.<sup>100</sup> The Supreme Court further clarified its position in *Walmart v. Samara Bros.*, stating that color can be protected as a trademark, but only upon proof of secondary meaning.<sup>101</sup>

These cases set the stage for a landmark case involving Louisiana State University (“LSU”) and Smack Apparel, a retailer that produces t-shirts for fans of several college teams, often using no obvious university trademarks but incorporating those schools’ color schemes. In anticipation of the 2004 Sugar Bowl, Smack produced purple-and-gold t-shirts reading “Bourbon Street or Bust: January 4, 2004-New Orleans, Louisiana”—without actually using LSU’s name, marks, or the “Tigers” nickname. LSU brought suit, essentially arguing that by using LSU’s colors, Smack was illicitly profiting upon LSU’s goodwill.<sup>102</sup> Upon a finding of both secondary meaning and likelihood of confusion, the court agreed and held that LSU’s purple-and-gold were protectable under trademark law,<sup>103</sup> thus causing the pendulum of trademark protection to swing mightily—and even more favorably—for universities.

A few years later, the University of Kansas sued a local t-shirt retailer on similar grounds.<sup>104</sup> The seller sold a variety of humorous and irreverent t-shirts featuring Kansas’s school colors and slogans including “Fighting Manginos,” “Muck Fizzou,” and “KSU Sucks and Missouri Blows.”<sup>105</sup> Finally, some balance in collegiate trademark protection was restored, as the court ruled

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<sup>100</sup> *Qualitex*, 514 U.S. at 173.

<sup>101</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

<sup>102</sup> *Bd. of Supervisors of La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 655-56 (E.D. La. 2006).

<sup>103</sup> *Id.* at 656-60.

<sup>104</sup> *Univ. of Kan. v. Sinks*, 565 F. Supp. 2d 1216 (D. Kan. 2008).

<sup>105</sup> *See id.* at 1231. Mark Mangino was the Jayhawks’ head football coach at the time of this dispute. Kansas State (“KSU”) and Missouri (“Mizzou”) are Kansas’s two biggest rivals.

that so long the marks in question are not similar to those officially licensed by universities, alleged infringers using collegiate color schemes on merchandise can at least get past summary judgment to determine whether likelihood of confusion exists, as a question of fact.<sup>106</sup> A jury then evaluated each t-shirt in question to determine whether each actually infringed on Kansas's trademark rights.<sup>107</sup>

While the *Kansas v. Sinks* decision brought some balance back into the court for those accused of unauthorized use of university marks, LSU's success in the *Smack* case opened the door for infringement to be found in many different contexts. However, with college sports' popularity and revenue potential continuing to grow at a rapid pace, and the increasingly creative ways that third parties attempt to capitalize upon universities' goodwill, the only logical option for schools is to actively police the use of any and all of their identifying marks.

### *B. Ambush Marketing and Freeloading*

One major issue facing universities today is the practice of ambush marketing, defined as "the set of activities that companies use to create the impression of an association" with a school's team or athletics program.<sup>108</sup> More specifically, the companies often attempt to create the impression that they are sponsors or official partners with that school.<sup>109</sup> Examples of such practices include printing and distributing game schedules, using school game tickets as prizes for promotional events, and placing congratulatory messages for the university's teams in local advertising.<sup>110</sup> Such tactics are not illegal per se, and ambush marketers often either purposely avoid the use of registered school marks or use protections under the First Amendment to avoid legal repercussions.<sup>111</sup>

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<sup>106</sup> Grady & McKelvey, *supra* note 67, at 237.

<sup>107</sup> *Sinks*, 565 F. Supp. 2d at 1263.

<sup>108</sup> Steve McKelvey et al, *Caught in the Web?: The Communication of Trademark Rights and Licensing Policy on University Official Athletic Websites*, 20 J. LEGAL ASPECTS SPORT 1, 22-23 (2010).

<sup>109</sup> *Id.* at 23.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.*

A more specific type of ambush marketing is known as “freeloading” or “free riding”—that is, those activities by local businesses who “attempt to gain the benefit of an association” with the college’s athletics programs without having to become a paying sponsor and with the willingness of university administrators to “tolerate these activities on the basis of the publicity that these activities create.”<sup>112</sup> Examples of freeloading include displaying banners or posters in shop windows, painting mascots on storefronts, or decorating local stores in that school’s color schemes.<sup>113</sup>

As college sports have exploded in popularity and advertising platforms have evolved beyond traditional media, opportunities to engage in ambush marketing have skyrocketed and now take countless numbers of forms, presenting an issue that is becoming increasingly complicated for universities to deal with as they seek to control and protect their marks and goodwill.

### *C. Trademark Bullying*

In recent years, several universities have found themselves receiving negative media attention in response to their efforts to police their marks. For instance, the University of Alabama has gained somewhat of a reputation for aggressiveness in enforcing its trademark rights in recent years.<sup>114</sup> For example, in 2012, Alabama sent a cease-and-desist letter to a local bakery that decorated some of its cakes and cookies by writing the famous script “A” logo on them in icing.<sup>115</sup> After facing widespread criticism for its perceived over-aggressiveness, Alabama issued an apology and withdrew its threat.<sup>116</sup> Colleges must tread a fine line in policing their trademark rights: while active enforcement is prudent and necessary to ensure protection, schools must take care so as to not engage in what has been called “trademark

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<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> Between 2004 and 2014, Alabama sent more than 150 cease-and-desist letters to potential infringers. Rooksby, *supra* note 82, at 375.

<sup>115</sup> *Id.*; see also Ben Flanagan, *Northport Bakery Gets Cease-and-Desist to Stop Making Desserts with University of Alabama Logos*, AL.COM (Aug. 23, 2012, 1:15 PM) [http://blog.al.com/tuscaloosa/2012/08/bakery\\_gets\\_ua\\_cease-and-desist.html](http://blog.al.com/tuscaloosa/2012/08/bakery_gets_ua_cease-and-desist.html).

<sup>116</sup> Rooksby, *supra* note 82, at 375. Alabama would ultimately offer the baker a \$10 licensing deal instead. *Id.*

bullying”—in other words, engaging in heavy-handed and over-reaching tactics in enforcing their trademark rights against small entities.<sup>117</sup>

While there appears to be a pick-and-choose mentality with regard to enforcing trademark rights against small businesses and individuals, schools have increasingly come under fire for threatening such small-scale enterprises. For example, critics might argue that in cases such as *Auburn University v. Moody*,<sup>118</sup> in which an individual was selling six-finger foam hands—featuring the wordmarks “AUBURN” and “WAR EAGLE”—to make just enough money to “buy some beer,” such aggressiveness by schools is unwarranted and should be resolved out of court.<sup>119</sup>

A similar situation occurred at West Virginia University, where the school filed suit against a company for producing blue-and-gold shirts bearing the slogan “Let’s! Go! Drink Some Beers!”—a humorous spin on the cheer “Let’s Go Mountaineers”—and alleged that the company violated both its common law rights in the chant and that the use of blue-and-gold would likely cause consumer confusion.<sup>120</sup>

When an enterprising student duo at the University of Delaware announced plans to sell homecoming t-shirts emblazoned with the words “U can suck our D”, the school issued a cease-and-desist letter, asserting protectable rights in the initials “U.D.,” regardless of the font used.<sup>121</sup> While this case might be cause for a debate as to tastefulness, taste has no place in trademark enforcement; as one commentator notes, some colleges now “seek to control entire market references to their institution[s].”<sup>122</sup>

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<sup>117</sup> Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 642.

<sup>118</sup> *Auburn Univ. v. Moody*, No. 3:08cv796-CSC, 2008 WL 4877542, at \*1 (M.D. Ala. Nov. 4, 2008).

<sup>119</sup> *Id.* at \*4. In a case where defendant Moody had sold just fourteen of these foam hands, mostly to friends and family, Auburn successfully obtained an injunction against him. *Id.* at 9.

<sup>120</sup> Rooksby, *supra* note 82, at 378. Noteworthy in this situation is that blue and gold also serve as the official colors of the State of West Virginia, raising questions of whether the university actually could assert protection over the color scheme in this case. *Id.*

<sup>121</sup> *Id.* at 379.

<sup>122</sup> *Id.* at 378.

Aside from small-scale commercial activities, universities have also faced criticism for attempting to enforce their trademark rights against artists that depict school marks or references in their works. Among the most notable of these cases involved a situation where the University of Alabama filed suit against painter Daniel Moore, who made his living by painting famous Crimson Tide football scenes.<sup>123</sup> An Alabama alumnus, Moore had previously entered into a licensing arrangement with the university that lasted several years; when Alabama requested a renewal of the agreement, Moore refused, arguing that his use of Alabama symbols depicting historical events as part of his artwork did not violate the school's trademark rights.<sup>124</sup> The issue presented in this case boiled down to balancing the right to expression afforded under the First Amendment and the protections provided under the Lanham Act.<sup>125</sup> The Eleventh Circuit ultimately ruled that "First Amendment interests in artistic expression so clearly outweigh whatever consumer confusion that might exist on these facts that we must necessarily conclude that there has been no violation of the Lanham Act,"<sup>126</sup> effectively reinforcing the strength of constitutional protections under the First Amendment and the idea that important cultural symbols should be shared and enjoyed—an important victory in the eyes of those who believe that universities are granted too broad of protections in their marks.<sup>127</sup>

Another frequent target of trademark policing efforts are American high schools.<sup>128</sup> This comes almost exclusively in the form of cease-and-desist demands or licensing offers; interestingly, despite universities' significant success in enforcing their marks against small-scale commercial ventures, they have never filed

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<sup>123</sup> Univ. of Ala. Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266, 1269 (11th Cir. 2012).

<sup>124</sup> *Id.* at 1270.

<sup>125</sup> Sanders, *supra* note 68, at 234.

<sup>126</sup> *New Life Art*, 683 F.3d at 1276.

<sup>127</sup> Sanders, *supra* note 68, at 234-35.

<sup>128</sup> See TraytonRM, *A Deep Dive into the Weird World of Stolen CFB Logos*, IMGUR (July 11, 2015, 5:00 AM), <http://imgur.com/gallery/oN6jo> (featuring an interesting compilation of high school logos potentially infringing upon collegiate marks).



suit against a high school.<sup>129</sup> In the context of the concept of trademark bullying, high schools are faced with three choices when a university sends a cease-and-desist: (1) change the mark,<sup>130</sup> (2) settle, or (3) fight the lawsuit. As of this writing, no high school has yet pursued the third option.

Also interesting to note is that universities have wildly differing policies with regard to high schools using their marks.<sup>131</sup> Some, like the University of Florida and the University of Wisconsin, refuse to allow any use of their marks and will not even enter into licensing arrangements for high schools to use those marks.<sup>132</sup> Others, such as Kansas State and Western Michigan, actively seek out instances of infringement, but will offer reasonable licensing arrangements to infringers.<sup>133</sup>

In the crusade to protect their marks, colleges must choose their battles wisely, especially in instances of small-scale infringers, as the perception of being overly aggressive in policing marks can easily cause more harm—from a public relations standpoint especially—than the infringer’s use ever would. While heavy-handed tactics may still work against small-scale commercial activities, universities should take care as to not suppress artistic expression or threaten high schools; instead, universities should work with artists and high schools to create licensing opportunities that can benefit both sides.

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<sup>129</sup> Newsom, *supra* note 85. There actually is a question as to whether colleges can prevail in such a suit, perhaps underscoring the hesitation by colleges to take high schools to court.

<sup>130</sup> Changing the mark can prove costly, as Glades Day High School in Florida would discover. After the University of Florida threatened legal action over Glades Day’s use of its “gator head” logo, the high school opted to spend \$60,000 to phase out the mark instead of going to court. Adam Himmelsbach, *We’re the Gators. So Are We. Can’t Look Alike, Colleges Say.*, N.Y. TIMES, Nov. 27, 2010, at A1, [http://www.nytimes.com/2010/11/27/sports/football/27logos.html?\\_r=0](http://www.nytimes.com/2010/11/27/sports/football/27logos.html?_r=0).

<sup>131</sup> Compare this to the NFL, which seems to encourage high schools’ use of NFL team names and logos. David E. Armendariz, Note, *Picking on the Little Guy? Asserting Trademark Rights Against Fans, Emulators, and Enthusiasts*, 90 TEX. L. REV. 1259, 1262-63 (2012).

<sup>132</sup> *Id.* at 1261-62.

<sup>133</sup> *Id.* at 1262.

## CONCLUSION

As Professor Jacob H. Rooksby notes, “In a higher education environment increasingly challenged by dwindling state appropriations and stagnant or declining tuition revenue,” universities are pressured to “generate revenue via new channels.”<sup>134</sup> The explosive popularity of college sports and the growth of the collegiate licensing industry provided the perfect opportunity for universities to capitalize upon a new revenue stream.

However, as collegiate trademark licensing has evolved into a billion-dollar industry, a number of legal and practical issues have arisen as a result. First and foremost, the popularity of college teams has influenced infringers and ambush marketers alike to attempt to benefit from the university’s goodwill through use of names, marks, slogans, and even color schemes. Another issue is that of enforcement: while necessary to retaining protection and ownership rights over a mark, when should universities step in to enforce their marks, and how should it respond to instances of infringement? Also in regards to enforcement, a university must take care as to not create a reputation of being overeager and overly litigious—or, in other words, being trademark bullies—in asserting its trademark rights, especially against artists, high schools, and parties in other low stakes instances of infringement.

Interestingly, as colleges grapple with the separate issue of balancing its very profitable sports programs with the concept of amateurism and the colleges’ educational mission, so too must these schools balance their commercial interests (e.g., capitalizing on their trademarks) with their core educational mission. As Professor Rooksby also so astutely noted, “the history of modern higher education is a story of higher education’s gradual embrace of the market and the weakening grip of faculty over issues of governance and decision making.”<sup>135</sup> As business continues to boom, fans continue to fill the stadium, and more opportunities arise to capitalize upon collegiate names, logos, and insignia, universities will have to continue to perform this delicate

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<sup>134</sup> Rooksby, *supra* note 82, at 350.

<sup>135</sup> *Id.* at 352 (footnote omitted).

balancing act, as trademark issues are sure to increase and potentially become more complicated a dance in the future.