

# Biting the Hand that Feeds: How Trademark Protection Might Threaten School Spirit

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# BITING THE HAND THAT FEEDS: HOW TRADEMARK PROTECTION MIGHT THREATEN SCHOOL SPIRIT

## I. INTRODUCTION

There is money to be made in collegiate athletics, both by the National Collegiate Athletic Association (NCAA) and by member schools. The NCAA and member schools can, and do, take in billions of dollars annually from the sale of merchandise bearing their names and logos.<sup>1</sup> Millions of students, alumni, and fans follow college sports. They flock to stadiums on game day and congregate to watch games on television. Most of these fans will adorn themselves in school spirit—T-shirts, hats, and just about anything else bearing the school colors and logos—to show their support of their school.

Merchandising companies know about the potential profits to be made from NCAA and university logos as well. NCAA universities have long had to deal with merchandising companies using school logos and color schemes without authorization. For probably just as long, students at these universities have made T-shirts and other memorabilia using school slogans, logos, and color schemes to show their school pride or provide social commentary. What happens if these students begin selling these items, either to the general public, students on campus, or within student organizations? Student organizations from the University of Texas<sup>2</sup> and the University of Kansas<sup>3</sup> have recently come under scrutiny for unauthorized use of university trademarks. A painter, an alumnus of the University of Alabama, was brought to court for depicting the Alabama football team in game scenarios, complete with the Crimson Tide's signature colors and logo.<sup>4</sup> As NCAA universities grow increasingly more protective over their trademarked property, these universities may begin taking a closer look at this practice.

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1. 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).

2. Lauren Reinlie, *Longhorn Logo Policy Under Review*, DAILY TEXAN (Univ. Tex.-Austin) via U-Wire, Sept. 26, 2002, available at <http://www.dailytexanonline.com/2.8480/longhorn-logo-policy-under-review-1.1261255>.

3. *Obama T-shirt Concerns KU*, TOPEKA CAPITAL-JOURNAL, July 22, 2008, at 1.

4. David Magee, *Calling Foul on Alabama Lawsuit*, CHATTANOOGA TIMES FREE PRESS, Nov. 15, 2006, at B2.

This Comment will examine the potential liability that may arise when students or student groups use university trademarks for their own purposes. Part II will discuss the background of trademark law to lay a foundation for the analysis that will follow. It will focus on what can be trademarked under the Lanham Act, what causes of action exist for universities under the Lanham Act, and what defenses exist for potential infringers. Part III will explore the application of trademark law to NCAA university trademarks. Part IV will explore the tendencies of NCAA universities to sue over the infringing use of their marks. Part V will explore the possibility of universities bringing legal action against students and student-made merchandise, along with the potential success of these actions, and part VI will examine possible defenses for these students. Finally, part VII will conclude that, although universities may very well succeed should they choose to bring claims, there are viable defenses available and public policy seems to favor the students.

## II. THE LANHAM ACT AND THE BACKGROUND OF TRADEMARK LAW

Before examining NCAA trademarks and the potential liability for student uses, this section will explore the foundations of trademark law. Trademarks are integral to commerce in the United States.<sup>5</sup> By giving certain marks protection from use by others, trademark law protects consumers by allowing them to choose goods in the marketplace with a reasonable confidence in knowing where the product originated.<sup>6</sup> The mark identifies the product's source for the consumer.<sup>7</sup> In turn, trademark owners receive the benefit of the prevention of unauthorized use, which protects the mark holder's reputation in the marketplace and protects the holder from potential economic loss from goods purporting to be theirs.<sup>8</sup> Hence, underlying trademark law is the symbiotic protection of both the consumer and the trademark holder.<sup>9</sup>

This section will explore the building blocks of trademark law, which will lay the groundwork for the protectability of university trademarks. This section's analysis will include (a) protectability and infringement; (b) third party liability for infringement in the form of vicarious or contributory liability;<sup>10</sup> (c) the elements of protectable trade dress; (d) the ability to

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5. Patrick E. Boland, *Wrongful Assault on the Trademark System*, 1987 COLUM. BUS. L. REV. 153, 164 n.40 (1987).

6. Jeremiah Kline, *Black and Blue: An Examination of Trademarking University Color Schemes*, 16 SPORTS LAW. J. 47, 49 (2009).

7. *Id.*

8. Tschura, *supra* note 1, at 875.

9. *Id.* at 876.

10. Deborah F. Buckman, *Liability as Vicarious or Contributory Infringer Under the Lanham*

trademark colors; and (e) available defenses to trademark infringement.

### *A. Protection and Infringement*

Federal trademark protection is provided by the Lanham Act, which states

[a]ny person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol . . . or any combination thereof . . . which [i]s likely to cause confusion . . . or to deceive as to the affiliation, connection . . . or as to the origin, sponsorship or approval of his or her goods . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.<sup>11</sup>

To receive protection under the Lanham Act, a mark must be used in interstate commerce, it must be distinctive, and it cannot be barred from federal trademark registration under section 1052 of the Lanham Act.<sup>12</sup> These requirements must be present whether the mark is federally registered or not because, to pursue an infringement action, the mark holder must show that “the trademark is valid . . . by showing either that the mark is registered at the federal level or that the mark has been used in interstate commerce and is distinctive.”<sup>13</sup> Further, to prove infringement, the trademark owner must show three things: (1) that the mark is distinctive, (2) that the “infring[ing] use will likely cause consumer confusion,” and (3) the mark owner must overcome the functionality doctrine by showing the use is not infringing on a functional feature.<sup>14</sup>

#### 1. Distinctiveness and Types of Marks.

Initially, a court must determine whether the mark is distinctive.<sup>15</sup> In determining a mark’s distinctiveness, a court will first have to decide which

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*Act—Modern Cases*, 152 A.L.R. Fed. 573 (2009).

11. Lanham Act, 15 U.S.C.S. § 1125(a) (2010).

12. SHUBHA GHOSH ET AL., *INTELLECTUAL PROPERTY: PRIVATE RIGHTS, THE PUBLIC INTEREST, AND THE REGULATION OF CREATIVE ACTIVITY* 463 (2007). Section 1052 of the Lanham Act lists various marks that cannot be registered, such as marks that are immoral or deceptive, depict a living person without his or her consent, etc. Lanham Act, 15 U.S.C.S. § 1052 (2010).

13. GHOSH, *supra* note 12, at 464.

14. Kline, *supra* note 6, at 50.

15. *Id.*

category of distinctiveness the mark fits.<sup>16</sup> There are four categories of marks: (1) generic, (2) arbitrary or fanciful, (3) suggestive, and (4) descriptive.<sup>17</sup>

*a. Generic Marks.*<sup>18</sup>

Generic marks are afforded the least protection because they merely “refer[] to the genus or class of which a particular product is a member and [therefore] can never be protected.”<sup>19</sup> A generic mark does not distinguish a particular product and, therefore, does not merit protection.<sup>20</sup> An example is the term “Aspirin,” which was originally a mark held by the Bayer Corporation but was held to be a generic term because it merely referred to a class of pain relievers.<sup>21</sup>

*b. Arbitrary or Fanciful Marks*

On the opposite end of the spectrum from generic marks are arbitrary or fanciful marks, which are inherently distinctive and, therefore, entitled to protection.<sup>22</sup> No additional proof is needed to establish the distinctiveness of these marks.<sup>23</sup> Arbitrary and fanciful marks are similar in that they are both entirely unrelated to the product, but “the two differ, however, in that a mark qualifies as arbitrary if it is well-known in a different context, and fanciful if it is newly invented.”<sup>24</sup> Arbitrary or fanciful marks are always protected because they intrinsically identify a particular source.<sup>25</sup> An example of an arbitrary mark is “Apple,” referring to a brand of computer, because it applies a word that has no particular relation to computers. An example of a fanciful mark is “Kodak,” referring to a brand of film or camera, because the term was created for the product.

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16. *Id.* at 51.

17. *Alderman v. Iditarod Props.*, 32 P.3d 373, 382 (Alaska 2001); *see also* *Kline*, *supra* note 6, at 51.

18. This Comment will not look at generic marks because university color schemes and logos are generally going to be seen as at least descriptive marks. A university’s name or logo likely will not refer to the genus or class of product that it is a part of.

19. *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999).

20. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 531 n.7 (1987).

21. *Bayer Co. v. United Drug Co.*, 272 F. 505, 510-11 (S.D.N.Y. 1921).

22. *Ashley Furniture*, 187 F.3d at 369 (*quoting* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

23. *Kline*, *supra* note 6, at 51.

24. *Ashley Furniture*, 187 F.3d at 369.

25. *Id.*

*c. Suggestive Marks*

Suggestive marks are also inherently distinctive.<sup>26</sup> These marks do not describe the product but instead imply or suggest the product.<sup>27</sup> Suggestive marks “require[] imagination, thought and perception to reach a conclusion as to the nature of the goods.”<sup>28</sup> A three-part test has been laid out to differentiate a suggestive mark from a descriptive mark: “(i) whether the purchaser must use some imagination to connect the mark to some characteristic of the product; (ii) whether competitors have used the term descriptively or rather as a trademark; and (iii) whether the proposed use would deprive competitors of a way to describe their goods.”<sup>29</sup> An example of a suggestive mark is the term “Gleem” for a brand of toothpaste because the term requires the consumer to cognitively connect the toothpaste to the image of clean, “gleaming” teeth.<sup>30</sup>

*d. Descriptive Marks*

On the spectrum of protection, arbitrary or fanciful marks and suggestive marks are inherently distinctive, while generic marks are not distinctive.<sup>31</sup> Between the marks that are inherently distinctive and the marks that are generic lie descriptive marks.<sup>32</sup> Descriptive marks are characterized by the fact that they describe a feature of the product.<sup>33</sup> Descriptive marks are not inherently distinctive and, as a result, do not gain automatic protection.<sup>34</sup> To be protectable under the Lanham Act, a descriptive mark must acquire secondary meaning.<sup>35</sup> University logos or other indicia, along with their color schemes, will likely be placed in this category, which will then necessitate a finding of secondary meaning.<sup>36</sup>

Secondary meaning is a meaning that a mark takes on through time or, put

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26. Kline, *supra* note 6, at 52.

27. Alderman v. Iditarod Props., 32 P.3d 373, 383 (Alaska 2001).

28. Kline, *supra* note 6, at 52 (*quoting* Stix Prods. v. United Merchs. & Mfrs., 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

29. Menashe v. V Secret Catalogue, Inc., 409 F. Supp. 2d 412, 423 (S.D.N.Y. 2006).

30. B&B Hardware, Inc. v. Hargis Indus., 252 F.3d 1010, 1012 (8th Cir. 2001).

31. Kline, *supra* note 6, at 51.

32. *Id.*

33. Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd., 187 F.3d 363, 369 (4th Cir. 1999).

34. *See id.*

35. *Id.*

36. *See* Bd. of Supervisors for La. State Univ. v. Smack Apparel Co., 550 F.3d 465, 475 (5th Cir. 2008).

another way, when a merely descriptive term takes on a meaning identifiable with the product over time.<sup>37</sup> Secondary meaning is achieved when consumers in the marketplace correlate the mark with a single source or origin.<sup>38</sup> A mark achieves secondary meaning when a consumer can see a product on the shelf and immediately recognize where it came from.<sup>39</sup> When a descriptive mark obtains secondary meaning, it is protected.<sup>40</sup> In other words, although arbitrary or fanciful marks and suggestive marks receive protection because they are inherently distinctive, secondary meaning is what makes a descriptive mark distinctive and, therefore, is what gives a merely descriptive mark the requisite distinctiveness to be protected by trademark law.<sup>41</sup>

## 2. Likelihood of Confusion.

After determining the distinctiveness of a mark, the trademark holder also must show that “the infringed use will likely cause consumer confusion.”<sup>42</sup> There is no single test for likelihood of confusion.<sup>43</sup> However, although courts use different tests, there is a common ground of similar elements.<sup>44</sup> *Alderman v. Iditarod Properties, Inc.* set out a clear likelihood of confusion analysis.<sup>45</sup> Although the court was analyzing state law, it noted that “[s]tate statutes modeled after the Lanham Act also use the same likelihood-of-confusion test.”<sup>46</sup> The test was put forth as follows: “An appreciable number of reasonable buyers must be likely to be confused by the names for trade name [or trademark] infringement or unfair trade practice liability.”<sup>47</sup> “Appreciable number” was loosely described, but it does not appear that a majority of confused customers is necessary.<sup>48</sup> “Likely” is understood to mean probable, not just possible.<sup>49</sup> “Confusion” is said to include confusion

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37. *Alderman v. Iditarod Props.*, 32 P.3d 373, 386 (Alaska 2001).

38. Kline, *supra* note 6, at 52.

39. *Id.* at 53.

40. *Id.*

41. *See id.*

42. *Id.* at 50.

43. *Id.* at 53-54.

44. *Id.* at 54.

45. *Alderman v. Iditarod Props.*, 32 P.3d 373, 390 (Alaska 2001).

46. *Id.*

47. *Id.*

48. *Id.*

49. *Id.*

at the point of sale, post-sale, pre-sale, and reverse confusion.<sup>50</sup> This encompasses confusion as to origin and also to “affiliation, connection, or association.”<sup>51</sup> Among the ways to show a likelihood of confusion, other than evidence of actual consumer confusion, are survey evidence and an “argument based on a clear inference arising from a comparison of the conflicting marks and the context of their use.”<sup>52</sup>

There are several tests that different courts use, but the factors used by the United States Court of Appeals for the Ninth Circuit are similar to what many courts use.<sup>53</sup> These factors, none of which is determinative by itself, are derived from the Restatement of Torts:

1. strength of the mark;
2. proximity of the goods;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. type of goods and the degree of care likely to be exercised by the purchaser;
7. defendant’s intent in selecting the mark; and
8. likelihood of expansion of the product lines.<sup>54</sup>

Evidence of actual confusion is, of course, a strong indicator of likelihood of confusion.<sup>55</sup>

### 3. Functionality.

Third, a mark holder must overcome the functionality doctrine by showing the use is not infringing on a functional feature.<sup>56</sup> A trademark cannot be protected if the mark consists of a functional aspect of the product or part of what makes the product work.<sup>57</sup> By creating this bar, the Lanham Act ensures that a producer of a product cannot gain a monopoly over a product’s useful feature, which may only be done under patent law.<sup>58</sup> Two main purposes of

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50. *Id.*

51. *Id.*

52. *Id.* at 391.

53. *Id.* See *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 478 (5th Cir. 2008); *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 224 (3d Cir. 2005); *Rust Env’t & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210, 1216 (7th Cir. 1997); *S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1242 (6th Cir. 1991); *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

54. *Alderman*, 32 P.3d at 391.

55. *Id.* at 392.

56. *Kline*, *supra* note 6, at 50.

57. *Id.* at 54.

58. *Id.*

the functionality doctrine have been put forth.<sup>59</sup> The first is to promote competition by allowing a product's useful features to be copied to allow for advancement of products.<sup>60</sup> The second is that the functionality doctrine prevents trademark law from interfering with patent law by not allowing a person to gain a longer monopoly over a product's useful features than what patent law would allow.<sup>61</sup>

If the mark holder satisfies all the requirements to get protection under the Lanham Act, the protection will last "as long as the owner continually uses the mark and the mark retains its secondary meaning."<sup>62</sup> If the mark holder can show that the mark is distinctive, that the infringing use will likely cause confusion, and that the use is not infringing on a functional feature, the owner will likely be able to get a court to find an infringement of the trademark.<sup>63</sup>

### *B. Vicarious and Contributory Liability*

If the mark holder can establish the mark's validity, liability for trademark infringement can extend to other parties in the form of contributory liability or vicarious liability.<sup>64</sup> Contributory liability occurs when a party intentionally assists another in infringing but does not actually have power over the party who is directly infringing.<sup>65</sup> The United States Supreme Court has described contributory liability as follows:

[I]f a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorily responsible for any harm done as a result of the deceit.<sup>66</sup>

As a result, there may potentially be contributory liability when a party has been warned of its infringing activities but continues them anyway.<sup>67</sup>

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59. *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1207 (11th Cir. 1999).

60. *Id.*

61. *Id.*

62. *Kline*, *supra* note 6, at 55.

63. *Id.* at 50.

64. *Buckman*, *supra* note 10.

65. *Id.* at 586-87.

66. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 (1982).

67. *Id.*

Vicarious liability is an indirect liability.<sup>68</sup> It differs from contributory liability in that “[i]t is the attribution of a wrongdoer’s actions to an innocent third party by virtue of their relationship.”<sup>69</sup> Vicarious liability for trademark infringement grew out of vicarious liability in torts, which is based on the relationship between joint tortfeasors who are thought to be in such a relationship that the actions of one bind the other to the same action.<sup>70</sup> Because of the relationship between the parties, one party who may have no direct involvement with the infringement of the mark may be held liable for a “partner’s” infringement.<sup>71</sup> Also, vicarious liability may arise under the tort theory of *respondeat superior*, where an employer or principal may be held vicariously liable for infringement by an employee or agent acting on the behalf of the employer or principal.<sup>72</sup> Under these two theories, if the relationships between parties are sufficient, a court may find infringement by a party who either did not directly infringe on the mark or who knowingly assisted another party in infringement.<sup>73</sup>

Both of these secondary liability theories are well illustrated by *Microsoft Corp. v. Ram Distribution, LLC*, which involved a corporation that sold computer hardware and software over the Internet.<sup>74</sup> The corporation had purchased several Microsoft software programs, both from Microsoft authorized resellers and from “gray market” sellers.<sup>75</sup> Ram did not inspect the purchased programs to determine if they were counterfeit.<sup>76</sup> Even after receiving notice that they might be selling counterfeit programs, Ram continued to sell the software.<sup>77</sup> Although the court focused on Microsoft’s motion for summary judgment, which was denied, the court stated that the owner of Ram could be held liable for both vicarious and contributory trademark infringement if Microsoft could prove that Ram had infringed Microsoft’s trademarks.<sup>78</sup> The court stated that the owner “had the ability to supervise the infringing activity” and, as owner, stood to profit from the sale

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68. Buckman, *supra* note 10, at 589.

69. *Id.* at 589-90.

70. *Id.* at 590.

71. *Id.*

72. *Id.*

73. *Id.*

74. *Microsoft Corp. v. Ram Distribution, LLC*, 625 F. Supp. 2d 674, 678 (E.D. Wis. 2008).

75. *Id.*

76. *Id.*

77. *Id.* at 679.

78. *Id.* at 682, 684.

of the software.<sup>79</sup> The court also made a point of noting that the owner had knowingly directed the company toward selling software purchased in a market that ran a high risk of counterfeiting.<sup>80</sup>

### C. Trade Dress

It could be argued that university color schemes, and possibly logos, are trade dress. Like trademarks, trade dress is also protected under the Lanham Act.<sup>81</sup> Trade dress is a product's packaging or design, which may be protectable under the Lanham Act if it achieves secondary meaning and meets other requirements.<sup>82</sup> The requirements for trade dress to gain protection are basically the same as the requirements for trademarks because both theories of protection are borne out of the same provision of the Lanham Act.<sup>83</sup>

Importantly, a party asserting trade dress infringement will have to show that the use is not infringing on a functional feature of the product.<sup>84</sup> This can be difficult because courts have been wary about over-extending the protection of trade dress.<sup>85</sup> Because the design of a product "almost invariably serves purposes other than source identification," it can be difficult to differentiate not only functional features but also the distinctiveness of the trade dress.<sup>86</sup>

### D. Trademarking Colors

Not only has the Lanham Act extended protection to trade dress, but colors have also been found to be protectable under trademark law.<sup>87</sup> In *Qualitex Co. v. Jacobson Products Co.*, the United States Supreme Court determined that colors can satisfy an important element of a protectable trademark, namely that the colors are intended to be used "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."<sup>88</sup> The *Qualitex* Court found that there was no

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79. *Id.* at 684.

80. *Id.* at 684-85.

81. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001). *See* 15 U.S.C.S. § 1125(a)(1)(A) (2010).

82. *Traffix Devices*, 532 U.S. at 28.

83. *Id.* at 28-29.

84. *Id.* at 29.

85. *Id.*

86. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000).

87. *Kline*, *supra* note 6, at 55.

88. Lanham Act, 15 U.S.C.S. § 1127 (2010); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159,

“obvious theoretical objection to the use of color alone as a trademark.”<sup>89</sup> Colors are not inherently distinctive and, consequently, will have to attain secondary meaning in order to be protectable.<sup>90</sup> If a color or combination of colors can attain secondary meaning, it would seem to be in keeping with the underlying policy of trademark law to limit consumer confusion because, if a consumer identifies a particular color scheme with a particular source, then the requisite recognition for distinctiveness is met.<sup>91</sup>

The *Qualitex* Court similarly could not find an objection to colors being protectable under trademark law in respect to the functionality doctrine.<sup>92</sup> The Court stated that

[a]lthough sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not. And, this latter fact—the fact that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality—indicates that the doctrine of “functionality” does not create an absolute bar to the use of color alone as a mark.<sup>93</sup>

Colors then can sometimes meet the requirements to be protected by trademark law, which had generally been regarded to protect words or symbols.<sup>94</sup> The Court broke down the requirements for a word or symbol to be qualified as a trademark as “(1) a ‘symbol,’ (2) ‘use[d] . . . as a mark,’ (3) ‘to identify and distinguish the seller’s goods from goods made or sold by others,’ but that it not be ‘functional.’”<sup>95</sup> Four arguments were presented in *Qualitex* against allowing trademark law to cover colors.<sup>96</sup> The first was that trademarking colors would cause confusion in the courts about shades of colors, which would basically create a line drawing problem as to what shades of particular colors competitors could or could not use.<sup>97</sup> The Court responded to this argument by pointing out that courts frequently have to make

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162 (1995).

89. *Qualitex*, 514 U.S. at 163.

90. *Id.* at 162-63.

91. *Id.* at 163-64.

92. *Id.* at 164.

93. *Id.* at 165.

94. *Id.* at 166.

95. *Id.*

96. Kline, *supra* note 6, at 56-57.

97. *Id.* at 56.

decisions like this and could use “existing legal standards” to make decisions on a case-by-case basis.<sup>98</sup>

The second argument against allowing trademark law to cover colors was that protection would “deplete the available color supply.”<sup>99</sup> The Court responded to this argument by stating that this probably would not come up, but if it did, the functionality doctrine would act to prevent further protection in that area.<sup>100</sup>

The third argument was that precedent would not allow for the trademark protection of colors.<sup>101</sup> However, the Court found that this argument was based on cases that analyzed trademark law that predated the Lanham Act and that the subsequent “amendments to the Act clearly changed its intent.”<sup>102</sup>

The last argument raised was that color, by itself, did not need Lanham Act protection.<sup>103</sup> The Court found that “though certain types of trade dress already obtain protection, companies may want to indicate the source of their product by only using a color.”<sup>104</sup> In the end, the Court found that “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes [to be covered by the Lanham Act].”<sup>105</sup> Further, the Court stated that, because trademark law allowed protection to a descriptive word with secondary meaning, the law should allow a color protection if it too acquired secondary meaning.<sup>106</sup> In the end, the Court held colors to be protectable but only when they had acquired secondary meaning.<sup>107</sup>

### *E. Defenses*

The most important defense to trademark infringement is probably the doctrine of fair use.<sup>108</sup> There are two types of fair use: classic fair use and nominative fair use.<sup>109</sup> Classic fair use applies when a “defendant uses the

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98. *Id.*

99. *Id.* at 57.

100. *Id.*

101. *Id.*

102. *Id.*

103. *Id.*

104. *Id.*

105. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

106. *Id.* at 163.

107. *Id.* at 166.

108. See generally William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 51-53 (2008).

109. *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036, 1040 (9th Cir. 2003).

plaintiff's mark to describe the defendant's own product."<sup>110</sup> Nominative fair use occurs when the defendant references the plaintiff's mark to describe the defendant's product.<sup>111</sup> To have a classic fair use defense, a defendant must be able to show that the mark was used descriptively, not as a mark, fairly, and in good faith.<sup>112</sup>

A test for nominative fair use was set out in *Century 21 Real Estate Corp. v. Lendingtree, Inc.*<sup>113</sup> First, the court determined the likelihood of confusion and then applied a three-prong test to determine nominative fair use:

- (1) Is the use of the plaintiff's mark necessary to describe both plaintiff's product or service and defendant's product or service?
- (2) Is only so much of the plaintiff's mark used as is necessary to describe plaintiff's products or services?
- (3) Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services?<sup>114</sup>

If the answer to all three questions is "yes," then there is nominative fair use and no infringement.<sup>115</sup> The United States Court of Appeals for the Fifth Circuit has since stated that the nominative fair use defense is available when two criteria, similar to the three listed above, are met: "[T]he defendant (1) may only use so much of the mark as necessary to identify the product or service and (2) may not do anything that suggests affiliation, sponsorship, or endorsement by the markholder."<sup>116</sup>

A defendant may also avoid infringement by showing expressive use, although there has been some conflict in this area of the law.<sup>117</sup> An expressive use of a trademark "convey[s] an articulable message rather than, or in addition to, the traditional function of source identification."<sup>118</sup> Allowing expressive use seems to also conform with First Amendment freedom of speech because expressive uses are often meant to criticize or put

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110. *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 214 (3d Cir. 2005).

111. *Id.*

112. Lanham Act, 15 U.S.C.S. § 1115(b)(4) (2010).

113. *Century 21*, 425 F.3d at 232.

114. *Id.*

115. *Id.*

116. *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 489 (5th Cir. 2008) (quoting *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 (5th Cir. 1998)).

117. See generally *McGeeveran*, *supra* note 108, at 56-59.

118. *Id.* at 54.

forth a new idea.<sup>119</sup>

Expressive functionality may be a fair use, but there is also an argument that all “ornamental use of institutional names and insignia[s] on many products, apparel products in particular, is a functional use of the mark, and therefore, cannot be protected in that context [under trademark law].”<sup>120</sup> Further, the argument asserts that enjoining others from using these names and insignias would be “the equivalent of an unwarranted monopoly.”<sup>121</sup>

### III. BOARD OF SUPERVISORS FOR LOUISIANA STATE UNIVERSITY V. SMACK APPAREL CO.: THE LANHAM ACT APPLIED TO NCAA TRADEMARKS

With the foundation of trademark law in place, this Comment will now turn to the application of trademark law to NCAA trademarks. Universities have been able to garner protection for combinations of color schemes and logos under the Lanham Act.<sup>122</sup> In *Board of Supervisors for Louisiana State University v. Smack Apparel Co.*, the United States Court of Appeals for the Fifth Circuit held that university color schemes and logos are protectable under the Lanham Act because “team colors and logos are, in the minds of fans and other consumers, source indicators of team-related apparel.”<sup>123</sup> Several NCAA universities brought this case to sue an apparel manufacturer.<sup>124</sup> The apparel manufacturer manufactured T-shirts using the colors and logos from several NCAA universities that were participating in college football post-season bowl games.<sup>125</sup> The T-shirts used the logos and colors from these schools with text pertaining to the bowl game that the school was participating in.<sup>126</sup> The T-shirts were sold online and to vendors, which led to the merchandise being sold right next to officially licensed merchandise.<sup>127</sup>

The court adopted a seven-factor test to determine if the university color schemes and logos had obtained secondary meaning.<sup>128</sup> The factors were as follows:

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119. *See generally id.* at 56-59.

120. Tschura, *supra* note 1, at 887.

121. *Id.* at 889.

122. *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 488-89 (5th Cir. 2008); Kline, *supra* note 6, at 50.

123. *Smack*, 550 F.3d at 478.

124. *Id.* at 471-72.

125. *Id.* at 472.

126. *Id.* at 472-73.

127. *Id.* at 472.

128. *Id.* at 476.

(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant's intent in copying the trade dress.<sup>129</sup>

The court found that the university color schemes and logos had acquired secondary meaning because the universities had used the colors for over a century, had used them on "all manner of materials, including brochures, media guides, and alumni materials," and had sold merchandise using their colors and logos that brought in tens of millions of dollars per year.<sup>130</sup>

The court then used a seven-factor inquiry to determine the likelihood of confusion.<sup>131</sup> The factors were as follows:

(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 the 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>132</sup>

In this case, the plaintiff universities' marks were very strong because they had been used for a long period of time and were readily identifiable, the defendant admitted it intended to use the colors and logos to identify its products with a particular school, the defendant's products were very similar to the universities' products, and the products were sold directly in areas where officially licensed merchandise was sold.<sup>133</sup>

*Smack Apparel* also seemed to eliminate the argument that university logos and colors are functional and, therefore, not protectable under the Lanham Act.<sup>134</sup> The apparel manufacturer argued that university logos and color schemes were functional because they were used in ways not solely intended to identify the school as the source, such as encouraging loyalty to

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129. *Id.*

130. *Id.* at 476-77.

131. *Id.* at 478.

132. *Id.* (quoting *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 (5th Cir. 1998)).

133. *Id.* at 479-82.

134. *See id.* at 485-88.

the school and allowing students to bond.<sup>135</sup> The court, however, found this to be merely the idea of “aesthetic functionality,” which the court had consistently rejected.<sup>136</sup> The Fifth Circuit agreed with the district court that the logos and color schemes did nothing other than identify with the school.<sup>137</sup> What made the colors and logos valuable on the T-shirts was the fact that it allowed the consumer to identify the product with the school.<sup>138</sup>

After *Smack Apparel*, universities can now protect their logos and color schemes if they can show secondary meaning under the Lanham Act.<sup>139</sup> Universities have taken notice and are not afraid to bring legal action if their trademarked property is used without authorization.<sup>140</sup>

#### IV. A BRIEF OVERVIEW OF UNIVERSITY TRADEMARK CASES ILLUSTRATING A TREND TOWARD LITIGATION

Universities have taken a hard line stance in protecting their trademarks because “collegiate logos represent[] an estimated licensed retail business volume of nearly three billion dollars annually.”<sup>141</sup> It has been speculated that more universities will not hesitate to take action to protect intellectual property rights.<sup>142</sup> The following cases show that the rights universities hold in their intellectual property (e.g., names, color schemes, logos, and combinations thereof) have expanded and now protect more than ever.<sup>143</sup>

Even before *Qualitex* held colors to be potentially under the umbrella of copyright law and before *Smack Apparel* held university color schemes to be protectable under trademark law, universities had filed suit to protect their intellectual property rights as early as 1983.<sup>144</sup> In *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, the University of Notre Dame (ND) sued a food importer over imported French cheese that bore the name “Notre Dame.”<sup>145</sup> Although the court recognized that the name “Notre

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135. *Id.* at 486.

136. *Id.* at 487.

137. *Id.* at 486.

138. *Id.*

139. Kline, *supra* note 6, at 59-60.

140. See Tschura, *supra* note 1, at 875.

141. *Id.*

142. Jeremy Kahn, *School Spirit; Rah, Rah, Rah (It's Protected)*, N.Y. TIMES, Jan. 7, 2007, at 4A.

143. *Id.*

144. See *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imp. Co.*, 703 F.2d 1372, 1373-74 (Fed. Cir. 1983).

145. *Id.* at 1373.

Dame” was a famous mark identifying the university and also that ND marketed a wide variety of products bearing its name, an imported French cheese bearing that name would not cause a likelihood of confusion in consumers.<sup>146</sup> Further, ND argued that the defendant could not register the name “Notre Dame” because it falsely identified the cheese with the university.<sup>147</sup> This argument failed, largely because “Notre Dame” was not a name solely identifying ND but rather first identifies a religious figure and ND could not show that the defendant had used the term with the intent to identify the cheese with ND.<sup>148</sup>

In 1985, the University of Georgia (Georgia) brought suit against a novelty beer wholesaler in Georgia.<sup>149</sup> The wholesaler had begun marketing a beer that featured a picture of an English bulldog dressed in a red sweater with a black “G” on the chest and holding a football, very similar to Georgia’s logo.<sup>150</sup> The beer can also featured the school’s colors.<sup>151</sup> The United States Court of Appeals for the Eleventh Circuit held that Georgia’s logo, an English bulldog wearing a sweater, was at least a suggestive mark, if not an arbitrary mark, and, thus, did not require a showing of secondary meaning.<sup>152</sup> Although the bulldog depicted on the cans was not exactly the same as Georgia’s logo,<sup>153</sup> the court stated that “the differences between the two [were] so minor as to be legally, if not factually, nonexistent.”<sup>154</sup> This case may indicate that some courts will be willing to find trademark infringement when the allegedly infringing item is not exactly the same but, in essence, conjures up enough similarity in the consumer to cause a likelihood of confusion. Interestingly, it did not seem to matter that the can did contain the words, albeit in small lettering, “[n]ot associated with the University of Georgia.”<sup>155</sup>

In 2000, the United States District Court for the Eastern District of Pennsylvania decided a case between Villanova University (Villanova) and a

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146. *Id.* at 1374.

147. *Id.* at 1375.

148. *Id.* at 1377.

149. *Univ. of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535, 1536-37 (11th Cir. 1985).

150. *Id.* at 1537.

151. *Id.* at 1544.

152. *Id.* at 1541.

153. The depiction of the bulldog on the can had a longer tail and a “different kind of sweater.” *Id.* at 1545 n.21. It also held a beer stein, unlike the University’s bulldog. *Id.* at 1544.

154. *Id.* at 1545.

155. *See id.* at 1537.

Villanova alumni association.<sup>156</sup> This dispute arose when the Villanova Alumni Educational Foundation, made up mostly of Villanova alumni, was unable to renew an affiliation agreement with Villanova and Villanova decided to terminate the affiliation.<sup>157</sup> The alumni association had been in existence first to raise money for the Villanova athletic department and later to provide financial assistance to non-athlete students.<sup>158</sup> After disaffiliation, the alumni association continued to use the name of the school, as well as its nickname, the Wildcats, in attempting to raise money over the Internet, through mailings, and in person at Villanova football games.<sup>159</sup> Villanova sought a preliminary injunction against the alumni association's use of the school's names and logos, and the court granted the preliminary injunction.<sup>160</sup> Again, the court found the marks "Villanova," "Wildcats," and combinations thereof were either inherently distinctive or, even if not inherently distinctive, they had acquired secondary meaning.<sup>161</sup> Here again, it seemed to be of no consequence that the alumni association included language on their scholarship applications stating that the association was not affiliated with Villanova.<sup>162</sup> The court also held that using Villanova's name and nickname was not fair use because the use was not merely descriptive.<sup>163</sup> The court stated that it would have been fair use had the association used the term "Villanova" as a description or identification of club members; however, the use here was found not to be used descriptively but in a way deceiving to the public and, consequently, was not fair use.<sup>164</sup>

Lastly, in 2008, the University of Kansas (KU) was involved in a dispute over T-shirts using the marks "Phog," "Fighting Manginos," "Kivisto Field," "Rock Chalk Jayhawk," and others.<sup>165</sup> In denying the defendant T-shirt maker's motion for a judgment as a matter of law, the court stated that each of these marks had potentially gained secondary meaning.<sup>166</sup> The court found that the term "The Phog" had been used in media guides since the late 1980s

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156. Villanova Univ. v. Villanova Alumni Educ. Found., Inc., 123 F. Supp. 2d 293, 295-97 (E.D. Pa. 2000).

157. *Id.* at 299-300.

158. *Id.* at 296-97, 300.

159. *Id.* at 300.

160. *Id.* at 301.

161. *Id.* at 302-03.

162. *See id.* at 300.

163. *Id.* at 303.

164. *Id.* at 304.

165. Univ. of Kan. v. Sinks, 644 F. Supp. 2d 1287, 1296 (D. Kan. 2008).

166. *Id.* at 1296-97.

and the term “Rock Chalk Jayhawk” had been used since the 1880s.<sup>167</sup> “Kivisto Field,” the name of KU’s football field, was named after the couple that donated the money to upgrade the field with permission to use their name, and as such, there was enough evidence for a jury to find either inherent distinctiveness or secondary meaning.<sup>168</sup> Finally, in regard to the term “Fighting Manginos,” the court found that the use of KU’s football coach’s name with the school colors conveyed the message of affiliation with the football team, which could potentially have gained secondary meaning and could cause confusion among consumers.<sup>169</sup> This more recent case seems to indicate that universities will not hesitate to bring suit over any merchandise that may suggest any sort of affiliation with the university. Not only will merchandise containing the school’s name or logo be attacked but also anything that relates to the school, potentially even phrases originally used by students, like “Rock Chalk Jayhawk.”<sup>170</sup> It is also important to note when examining these cases that it appears that merely one school color alone, like the University of North Carolina’s signature blue,<sup>171</sup> will not be enough to create the requisite likelihood of confusion for a finding of infringement, although it may be theoretically possible if a sufficient showing of acquired secondary meaning could be produced. Rather, for a student’s use of a university mark to be found as infringing, a combination of color schemes or colors and logos will be necessary.

#### V. THE POTENTIAL FOR INFRINGEMENT IN STUDENT USE OF UNIVERSITY MARKS

Students could potentially be held liable for trademark infringement when they make apparel or anything else that uses a school’s color scheme, insignias, or logos. As the cases laid out above illustrate, universities have not hesitated to bring suit over varying uses of school colors, insignias, etc. Student use, and use by student groups, of university marks is prevalent, and given the aggressiveness of many universities in protecting their intellectual property rights, an interesting dilemma arises surrounding potential conflict between a university and its students.

At some universities, student organizations have to obtain university

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167. *Id.* at 1296.

168. *Id.*

169. *Id.* at 1297.

170. *Id.* at 1296.

171. *See generally* *University of North Carolina Official Athletic Site*, <http://tarheelblue.cstv.com/> (last visited Feb. 27, 2010). It is everywhere on their website. *Id.*

authorization for T-shirt designs if the organizations plan to use the university's logo.<sup>172</sup> For example, in 2002, student groups at the University of Texas (UT) sought equal use of the UT logo.<sup>173</sup> A group had to be backed by either the Dean or a UT department to gain use of the logo, and not all groups were able to achieve this backing.<sup>174</sup> There appeared to be frustration among students, as one student was quoted as saying, "[the UT logo is] an identity and an identifier for everyone who goes to school here, on or off the field[.] One person shouldn't be able to be a Longhorn more than another."<sup>175</sup>

In 2005, the University of Alabama (Alabama) initiated a lawsuit against an alumnus who painted depictions of football games and sold them at a substantial profit.<sup>176</sup> Alumnus Daniel A. Moore reportedly made millions of dollars selling prints of the football portraits he painted.<sup>177</sup> Alabama contended that this was an infringing use of its trademarks, including the well-known Alabama color scheme of crimson and white.<sup>178</sup> A fair amount of publicity followed as many people were upset over Alabama's filing of the lawsuit.<sup>179</sup> The Chattanooga Times Free Press may have summed it up best in asking, "[h]ow much control should a university have over a game that is played completely in the public domain?"<sup>180</sup> The article goes on to point out that Alabama, among others, often seeks press coverage to gain publicity for its athletic programs, press coverage that will include game day photos and the like.<sup>181</sup> Could this be so different from Moore's paintings? Recently, the United States District Court for the Northern District of Alabama held that Moore's paintings did not infringe upon Alabama's marks because of "defenses premised on Artistic Expression, *First Amendment* and Fair Use."<sup>182</sup> In an addendum to the opinion, the court stated that "in an analysis of the Artistic Expression and *First Amendment* defenses there has to be a balancing of likelihood of confusion with the public interest."<sup>183</sup>

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172. Reinlie, *supra* note 2.

173. *Id.*

174. *Id.*

175. *Id.*

176. Magee, *supra* note 4, at B2.

177. *Id.*

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.*

182. Univ. of Ala. Bd. of Trs. v. New Life Art Inc., 677 F. Supp. 2d. 1238, 1259 (N.D. Ala. 2009) (emphasis added).

183. *Id.* at 1241.

In 2007, hundreds of bootleg T-shirts and a substantial amount of cash were seized at West Virginia University (WV).<sup>184</sup> University police apprehended three individuals from out of state, who were not students, who allegedly worked for the same company.<sup>185</sup> WV considered taking legal action.<sup>186</sup> Also in 2007, Virginia Tech (VT) was faced with unauthorized vendors selling unauthorized merchandise in the wake of the shootings suffered on their campus.<sup>187</sup> In 2008, political expression came into play at KU when a Democratic group on the campus made several T-shirts in support of presidential candidate Barack Obama, which read, “Barack Chalk Jayhawk.”<sup>188</sup> Permission was given by KU for T-shirts to be distributed only among members of the group, but controversy arose when a photograph emerged of the Kansas governor with one of the T-shirts.<sup>189</sup> The athletic department went on to forbid any more T-shirts from being made, as there was concern it would look like KU was supporting Barack Obama, and representatives of KU expressed regret for authorizing the T-shirts in the first place.<sup>190</sup> This case illustrates an interesting issue of political speech using university marks.

Student-made T-shirts and the like may not have the exact color scheme, but together with insignias and logos, it appears much of student-made memorabilia would pass the tests for likelihood of confusion and infringement when looked at in the light of recent case law.<sup>191</sup> It seems that any use of phraseology, colors, or insignias need only be enough to invoke a university’s marks to be infringing; they need not be exact copies or replicas.<sup>192</sup> Like the bulldog on a beer can, it seems that a small degree of difference between the marks will not preclude a finding of infringement.<sup>193</sup>

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184. Kellen Henry, *DPS Seizes T-shirts From Unauthorized Vendors*, DAILY ATHENAEUM (Univ. of W.V.) via U-Wire, Oct. 2, 2007, available at <http://www.thedaonline.com/dps-seizes-t-shirts-from-unauthorized-vendors-1.691371>.

185. *Id.*

186. *Id.*

187. Angela Manese-Lee, *Licensing Office Fights Use of Unauthorized Logos; Virginia*, ROANOKE TIMES, Apr. 26, 2007, at A11.

188. *Obama T-shirt*, *supra* note 3, at 1.

189. *Id.*

190. *Id.*

191. See *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 488-89 (5th Cir. 2008); *Univ. of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535, 1537 (11th Cir. 1985); *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imp. Co.*, 703 F.2d 1372, 1373-74 (Fed. Cir. 1983); *Univ. of Kan. v. Sinks*, 644 F. Supp. 2d, 1287, 1296 (D. Kan. 2008); *Villanova Univ. v. Villanova Alumni Educ. Found.*, 123 F. Supp. 2d 293, 299-301 (E.D. Pa. 2000).

192. See *Laite*, 756 F.2d at 1544-45.

193. *Id.*

If a university were to bring an action against a student or group of students, it does not appear that vicarious liability would be a viable theory for the university to recover under. It is difficult to see how a university would be able to prove that one person had the “right and ability to supervise the activity.”<sup>194</sup> It seems that it would be difficult to show that any one student had any supervisory authority over any other student. Similarly, it is hard to see how the theory of *respondeat superior* would apply, as it is not likely that any student involved in the production of infringing materials would be considered an employee.<sup>195</sup> However, if a group of students were ambitious enough to produce and sell memorabilia on a grander scale, then it seems feasible that one or more students may take on a role akin to a manager in a business, thereby opening the door to potential vicarious liability.<sup>196</sup> Also, the students involved may come closer to fitting into an employer/employee relationship—not with the university but, rather, among one another. This would potentially bring a larger group of students into the realm of potential liability.

Students may also face contributory liability for assisting other students who are directly infringing.<sup>197</sup> An easy example to imagine would be a student working at a screen-printing facility or with access to the materials needed, printing university trademarks on T-shirts for students he or she knows will be selling for a profit. In this case, the screen-printing student would be intentionally assisting another in infringing, assuming he or she knew what was going on, and the student would not have any power over the party who is directly infringing. A showing of these two elements may be enough to hold that student liable for contributory infringement.<sup>198</sup> Again, if a group of students began producing on a grander scale, more doors to contributory liability may open, especially if they were to continue after a university was to take notice and give them warning.<sup>199</sup>

Finally, a university may be less likely to pursue an infringement action against a single student or smaller number of students, but universities have shown an aggressive stance on combating infringement.<sup>200</sup> It may be that we

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194. *Microsoft Corp. v. Ram Distribution, LLC*, 625 F. Supp. 2d 674, 684 (E.D. Wis. 2008).

195. *See* Buckman, *supra* note 10, at 590.

196. *See Microsoft Corp.*, 625 F. Supp. 2d at 684.

197. *See id.*

198. *Id.*

199. *See Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 (1982).

200. *See Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 488-89 (5th Cir. 2008); *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1536-37 (11th Cir. 1985); *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imp. Co.*, 703 F.2d 1372, 1373-74 (Fed. Cir. 1983); *Univ.*

have not yet seen what number of students or infringing items will be necessary for a university to take notice. Likely, it will differ from case to case and particular circumstances of each use. Alabama went after a single alumnus, but in that case, the alumnus had profited to the tune of over a million dollars by painting and selling depictions of university football games.<sup>201</sup> It seems that a student painting his or her skin in school colors will not draw the ire of a school's watchdogs, but as we have seen, a group of students printing up some T-shirts to show school spirit, or to make a point, without authorization, may provoke legal action by the university.

#### VI. POSSIBLE DEFENSES FOR STUDENT USES OF UNIVERSITY MARKS

If a university were to bring suit, the offending students may have a strong defense. Students may be able to claim fair use as a defense, either classic fair use,<sup>202</sup> nominative fair use,<sup>203</sup> or expressive use.<sup>204</sup> As discussed earlier, classic fair use requires that the mark be used descriptively, not as a mark, fairly, and in good faith.<sup>205</sup> In the case of student use of university trademarks, the mark would be used as a mark because it would likely be intended to identify the particular university. In determining if the mark was used fairly, the high potential for confusion would likely weigh against a finding that the mark was indeed used fairly.<sup>206</sup>

As for nominative fair use, the student's use of the university's mark will not be necessary to describe both the student's product and the university's product, as both will be virtually identical in that they will be using the same colors, names, and logos. Student use will likely be using university trademarks in the same way the university uses them, simply to identify the university. Because of this, both classic and nominative fair use will likely not apply.<sup>207</sup>

A broad interpretation of the expressive use defense might make any student-made product a mere expression, rather than an infringing use.<sup>208</sup>

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of *Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1296 (D. Kan. 2008); *Villanova Univ. v. Villanova Alumni Educ. Found.*, 123 F. Supp. 2d 293, 299-301 (E.D.Pa. 2000).

201. Magee, *supra* note 4, at B2.

202. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 609 (9th Cir. 2005).

203. *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 217-18 (3d Cir. 2005).

204. *See Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 335-39 (S.D.N.Y. 2000).

205. Lanham Act, 15 U.S.C.S. § 1115(b)(4) (2010).

206. *See KP Permanent Make-Up*, 408 F.3d at 609.

207. *See Century 21 Real Estate Corp.*, 425 F.3d at 217-18.

208. *See McGeveran, supra* note 108, at 56-59.

Expressive use would seem to apply to cases where the use is intended to convey a message, as in the example of the “Barack Chalk Jayhawk” T-shirts at KU.<sup>209</sup> It would seem that expressive use would not apply if a student made T-shirts or anything else that simply contained the university’s name or logo because this would not convey anything in addition to merely source identification, which is what a school’s name and logo are intended to do. Also, this sort of use does not seem to conform with ideals of First Amendment free speech because there is no criticism or putting forth of new ideas.<sup>210</sup> However, there seems to be a grey area between a use that delves into politics, for example, and a use that criticizes something within the university. A use like inserting a presidential candidate’s name into a school slogan seems to articulate something beyond simply identifying the university as a source, but what about a T-shirt criticizing the school’s football coach? Another example from KU, namely the “Fighting Manginos,” seems to say no expressive use.<sup>211</sup> If a student were to make a T-shirt criticizing another university’s team or coach it would likely find the same fate.<sup>212</sup> Also, an expressive use defense will likely not work for student made items “celebrating” a team’s participation in a Bowl Game, the Final Four, or any other similar event.<sup>213</sup> It seems that there is a continuum of expressive use here with what may be called purely expressive use, like the Obama T-shirt example, at one end and pure indication of origin at the other end. It seems unclear at what point on that continuum an indication of origin sufficiently passes into expressive use so that the use is no longer infringing.

Public policy would seem to favor giving students some leeway on this continuum. Given the increasing costs of tuition that students are paying to attend these universities,<sup>214</sup> it seems reasonable to allow these students some room to express themselves and their passions by using the university’s marks, to a degree. After all, it is the students who are fervently supporting their school and packing the arenas and stadiums.<sup>215</sup> It might be possible that, if a student came up with a clever idea using a university mark, the university and student could work together, possibly by allowing the student a license to use

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209. See *Obama T-shirt*, *supra* note 3, at 1.

210. See *Univ. of Ala. Bd. of Trs. v. New Life Art Inc.*, 677 F. Supp. 2d 1238, 1259 (N.D. Ala. 2009).

211. *Univ. of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1297 (D. Kan. 2008).

212. See *id.*

213. See *Brockum Co. v. Blaylock*, 729 F. Supp. 438, 444 (E.D. Pa. 1990).

214. Jonathan D. Glater, *Tuition Again Rises Faster than Inflation, Board Finds*, N.Y. TIMES, Oct. 24, 2006, at A12.

215. See *Kline*, *supra* note 6, at 47.

the mark. Of course, if the use was offensive to the school, the university should be able to deny the license, and expressive use likely would not apply because a simply offensive use probably will not articulate a message. If the use did convey a message, then expressive use may come into play.<sup>216</sup>

## VII. CONCLUSION

Trademark law protects university color schemes and insignias from infringement. Student-made memorabilia would likely be considered infringing, based on the tests used to determine infringement. If a university were to pursue an action against a student or group of students for trademark infringement, it is likely that the use will be an infringement unless the student can find a viable defense.

As demonstrated, in a case like this, should a university decide to bring an action, the student's best defense will likely be to argue for expressive use. This argument will also potentially be forced to incorporate public policy arguments that, in most cases, it would be unreasonable for a school to pursue an action against a student for a use of a trademark. Universities have a right to protect their intellectual property rights but maybe not at the expense of relatively minor uses by the universities' own students.

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216. McGeeveran, *supra* note 108, at 54.

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