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COMMENTS

LOOKALIKE LOGOS: IS A HIGH SCHOOL'S USE OF A LOGO OR INSIGNIA SIMILAR TO THAT OF A UNIVERSITY A VIOLATION UNDER THE LANHAM ACT

KEEGAN GIRODO*

I. INTRODUCTION

The Texas Longhorn logo. It is one of the most recognizable collegiate logos in the country. Most people see the longhorn head and immediately think Texas. But what about the Rancho Buena Vista High School Longhorns: a high school located in a different region of the country, California.¹ The school was founded in 1988 and for twenty-five years used a silhouetted Longhorn logo colored maroon and silver.² Then, they received a cease-and-desist letter from the University of Texas asking the school to change its logo because it looked too much like theirs.³ While the high school's intent was not to harm or compete with the University of Texas in any way, the high school was still forced into changing their logo.⁴ The University of Texas was "generous" and allowed the high school three years to phase out the Longhorn logo.⁵

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1. Gary Warth, *Univ. of Texas Says Rancho Buena Vista Can't be the Longhorns*, SAN DIEGO UNION-TRIB., Sep. 5, 2014, <http://www.sandiegouniontribune.com/news/education/sdut-vista-texas-longhorn-logo-2014sep05-story.html>.

2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.*

Similarly, the Notre Dame Fighting Irish is seen as a powerful brand in collegiate athletics, specifically in college football. People see the words “Fighting Irish” and almost immediately think Notre Dame. In El Paso, New Mexico, Cathedral High School had been known as the Fighting Irish in the community for eighty-six years.⁶ Eighty-six years! Now they will just be known as the Irish.⁷ Notre Dame sent the high school a cease-and-desist letter ordering the school to remove the fighting leprechaun logo, as well as the word “fighting” from in front of “Irish.”⁸ Cathedral’s Athletic Director Rudy Forti said, “I don’t think it would be wise for us to try and fight it. Notre Dame is very powerful. They’ve got a lot of money.”⁹ Discussing the Cathedral High School situation, a Notre Dame spokesman said, “Because of U.S. trademark law, to allow others to use our trademarks as their own would dilute . . . the university’s rights to its marks to the point where its proprietary claim could be at risk.”¹⁰ Both sides have credible arguments, but all of these situations end the same: a university sends a high school a cease-and-desist letter, and the high school gives in and complies with the order in fear of pending litigation by a more powerful and financially stronger side. “Actual litigation over sports logos . . . is uncommon.”¹¹ The universities have dealt these high schools a huge financial burden that is tough for a high school and school district to overcome.¹² Completely rebranding a high school can be expensive and time consuming.¹³

This Comment discusses the relationship between universities and high schools with similar logos and insignias. It examines the trademark rights owned by universities, and the power they hold over high schools. Specifically, this Comment will focus on the main elements of trademark infringement and trademark dilution. Further, this Comment will dive into an analysis of trademark bullying as high schools are put in a significantly lesser position compared to universities. Universities have more money, resources, attention, and power. The high schools, even if they wanted to challenge a trademark cease-and-desist letter, simply do not have the resources and backing to do so.

6. Darren Hunt, *Notre Dame Forcing Cathedral High to Drop ‘Fighting,’ Change Mascot*, KVIA, Aug. 23, 2016, <http://www.kvia.com/news/notre-dame-forcing-cathedral-high-to-drop-fighting-change-mascot/53320966>.

7. *Id.*

8. *Id.*

9. *Id.*

10. *Id.*

11. *What’s in a Name? Or a Logo? N.C. State, the “Wolfpack” Name, and Lessons in Sports Trademarks*, PERKOWSKI LEGAL: UPDATES FROM PERKOWSKI LEGAL (Feb. 22, 2016), <http://perkowskilegal.com/news/whats-in-a-name-or-a-logo-n-c-state-the-wolfpack-name-and-lessons-in-sports-trademarks/>.

12. *Id.*

13. *Id.*

When a high school receives a cease-and-desist letter from a university, most comply with the letter because they do not have the resources to fight it. The two sides are playing on an unequal playing field, but I believe both sides should be viewed in an equal light. High schools around the country should have the right to defend their mascot, logo, and name that they have used over the past fifty years, or come to a reasonable agreement with that university to license the name, logo, and mascot if they are found to be violating a legal trademark. Are universities too broadly enforcing their trademark rights? Are high schools actually violating the trademark rights of colleges and universities? Does the use of a high school logo really affect a consumer's perception of a collegiate institution? Is the relationship between collegiate institutions and high schools an example of ongoing trademark bullying? Are there any equitable solutions? This Comment will attempt to analyze and answer these questions.

This Comment will begin by looking at the history of the relationship between high schools and collegiate institutions. It will provide examples and history of how these conflicts have been handled in the past. Next, this Comment will look at the Lanham Act and analyze statutes and case law to find the current enforcement of trademark law, including trademark infringement and trademark dilution. Then, the Lanham Act and case law will be applied broadly to the current issue. The key trademark claims, confusion and dilution, will be analyzed to find if high schools actually have a case against collegiate institutions. Next, an analysis on trademark bullying will be analyzed and applied to this current relationship to see how high schools may be able to equal the playing field. Then, a quick section on whether high schools can assert trademark claims. Finally, proposed solutions to the problem of identical logos will be offered.

II. FACTUAL BACKGROUND/PRIOR LEGAL PRECEDENT

Imitation may not be the sincerest form of flattery. For years, high schools have copied the logos of big-time universities and professional teams or turned to them for inspiration. But as those insignias have become more valuable through licensing of merchandise and apparel, as these deals can be worth millions to a university, many universities have become more vigilant in

protecting them.¹⁴ Currently, collegiate licensed merchandise is a \$4.55 billion retail market.¹⁵

In the past five years, a flood of challenges have been made by universities to the use of nicknames, logos, colors, mascots, and other insignia by high schools.¹⁶ In some instances, a single university has sent cease-and-desist letters to as many as fifty high schools using nicknames, logos, or mascots even remotely similar to those of the college.¹⁷ For example, the University of Wisconsin is one university that has cracked down heavily in recent years on the borrowing of its logos, even if the high school has changed the colors.¹⁸ Woodlands High in Texas is one example of a school that Wisconsin contacted.¹⁹ Woodlands High “used Wisconsin’s ‘motion W’ logo on its team uniforms until university officials caught wind of it and had the school remove the insignia in 2007”²⁰ “In all, Wisconsin has asked nearly forty schools in over two dozen states to stop using its logo and phase out its use on Web sites, uniforms and elsewhere.”²¹ When analyzing this situation between universities and high schools, it is important to recognize that a lot of these situations occur between schools in different states with no association to each

14. James Wagner, *Copycat Logos Are Pitting High Schools and Colleges in a Trademark Turf War*, WASH. POST, Oct. 21, 2010, <http://www.washingtonpost.com/wp-dyn/content/article/2010/10/21/AR2010102106526.html>.

15. *Collegiate Licensing Company Announces Partnership with the University of Richmond*, IMG C. LICENSING (Mar. 22, 2017), [https://www.clc.com/News/Archived-News/Collegiate-Licensing-Company-Announces-Partner-\(2\).aspx](https://www.clc.com/News/Archived-News/Collegiate-Licensing-Company-Announces-Partner-(2).aspx).

16. Lee Green, *Trademark Issues with Use of College Names, Logos, Mascots*, NAT’L FED’N OF STATE HIGH SCH. ASS’NS (Apr. 13, 2015), <https://www.nfhs.org/articles/trademark-issues-with-use-of-college-names-logos-mascots/>.

Cease-and-desist letters have been sent by dozens of colleges to hundreds of school districts across the country, including ones from Penn State University to Buna High School (Texas), the University of Texas at Austin to Gardner Edgerton High School (Kansas), the University of Notre Dame to Cathedral High School (New Mexico), the University of Wisconsin to Woodlands High School (Texas), the University of Michigan to Round Lake High School (Illinois), the University of Arizona to Woodrow Wilson High School (Texas), West Virginia University to Waubonsie Valley High School (Illinois), the University of Florida to Glades Day School (Florida), the University of Pittsburgh to Whitmer High (Ohio), Florida State University to Southeast High School (Florida), Western Michigan University to Barrington High School (Illinois), the University of Missouri to Harrisburg High School (South Dakota), and Georgia Southern University to Freedom High School (Virginia).

Id.

17. *Id.*

18. Wagner, *supra* note 14.

19. *Id.*

20. *Id.*

21. *Id.*

other whatsoever. While the list in footnote fifteen does not cover every example out there, it shows that this is an issue happening in all areas around the country.

Increased revenues from university apparel and merchandise combined with the increased visibility of high school marks on the Internet through school websites and social media have given universities all over the country a rise in concern of protecting their trademarks.²² With high school games now televised nationally through networks such as ESPN, and through local Internet websites/social media, the national popularity of high school sports has risen greatly and increased the monetization of high school marks through the sales of merchandise both locally and nationally.²³ It has provided high schools with a larger platform and increased visibility than they had in the past. Additionally, when colleges are unwilling to compromise and a school acquiesces to its demands, the process of transitioning from the use of old to redesigned nicknames, logos, and mascots, and integrating them into school stationary, websites, signage, facilities, scoreboards, uniforms, equipment, and additional forms of display has been reported by schools to cost up to \$100,000.²⁴ If a school refuses to comply with a cease-and-desist letter, the process of fully litigating a trademark challenge could cost a school just as much, if not more.²⁵ Dineen Wasyluk, a trademark lawyer based in Tampa, Florida, said, “The problem when you’re a defendant is you can spend the money to fight it, and if you lose, you also have to spend the money to change everything.”²⁶

The current law in this area is complicated. The definitions of trademark and trademark infringement are clearly defined, but the uneven balance of power between the parties affects the legal outcome.²⁷ It is unclear whether colleges and universities have a legitimate trademark claim against a high school using a similar name, logo, or mascot.²⁸ Collegiate institutions may be asserting their trademark rights too broadly against high schools.²⁹ Statutory

22. Green, *supra* note 16.

23. *Id.*

24. *Id.*

25. *Id.*

26. Adam Himmelsbach, *Universities Tell High Schools Valuable Logos Are Off Limits*, N.Y. TIMES, Nov. 26, 2010, <http://www.nytimes.com/2010/11/27/sports/football/27logos.html>.

27. Travis Burchart, *High School Logos vs. Collegiate Enforcers: The Little Infringers That Could?*, LEXISNEXIS: LEXISNEXIS LEGAL NEWSROOM INTELL. PROP. (Nov. 9, 2010), <https://www.lexisnexis.com/legalnewsroom/intellectual-property/b/copyright-trademark-law-blog/archive/2010/11/09/high-school-logos-vs-collegiate-enforcers-the-little-infringers-that-could.aspx?Redirected=true>.

28. 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, 1835 (2011).

29. *Id.*

protection and case law have yet to put a true limit on collegiate institutions' trademark rights.³⁰ Without a court verdict that definitively establishes the outer boundaries of trademark protection for universities, most of these high schools continue to accept these assertions that they are infringers.³¹ Without a case or statute in their favor, most high schools are not willing to risk the money and time to fight against a trademark infringement claim. As a result, the high schools end up settling with the larger and stronger universities.

III. TRADEMARK RIGHTS: LANHAM ACT, TRADEMARK INFRINGEMENT, AND TRADEMARK DILUTION

The Lanham Act³² of 1946, also known as the Trademark Act, is the governing law over the nationwide coverage of trademarks.³³ It is a federal statute that regulates the use of trademarks in commercial activity.³⁴ The Lanham Act defines the term “trademark” as:

any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, 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.³⁵

Trademarks are “word[s], phrase[s], logo[s], or other sensory symbol[s] used by a manufacturer or seller to distinguish its products or services from those of others. The main purpose of a trademark is to designate the source of goods or services.”³⁶ The Lanham Act gives trademark users exclusive rights to their marks, distinctive pictures, words, and other symbols, protecting the time and money invested into those marks.³⁷ Generally, the scope of one’s

30. *Id.* at 1854.

31. *Id.* at 1868.

32. *See generally* Lanham Act, 15 U.S.C. §§ 1111–1129 (2018).

33. 15 U.S.C. § 1051 (provides nationwide legal protection for federally registered trademarks and provides remedies for their infringement by unauthorized usage that creates a likelihood of consumer confusion).

34. *Lanham Act*, DICTIONARY.COM, <http://legal-dictionary.thefreedictionary.com/Lanham+Act> (last visited July 30, 2018).

35. 15 U.S.C. § 1127.

36. *Trademark*, BLACK’S LAW DICTIONARY (10th ed. 2014).

37. *Id.*

interest in a trademark is only the right to prevent consumer confusion.³⁸ The Seventh Circuit explained: “[t]he trademark laws exist not to ‘protect’ trademarks, but . . . to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.”³⁹

A sports team’s name functions as a trademark by virtue of public association of that name with a particular team.⁴⁰ Sports team names generally are either inherently distinctive or have acquired “secondary meaning,” entitling them to trademark protection.⁴¹ The court in *Becker*⁴² explained: “Secondary meaning is the consuming public’s understanding that the mark, when used in context, refers, not to what the descriptive word ordinarily describes, but to the particular business that the mark is meant to identify.”⁴³

Trademark rights exist indefinitely as long as the mark continues to be used and serve as an indication of the source of the seller’s goods or services.⁴⁴ However, such rights are lost if usage of the mark to identify, advertise, or promote the seller’s goods or service is discontinued.⁴⁵ There are two claims that collegiate institutions can likely use to challenge a high schools use of a similar name or logo. The first is trademark infringement, and the second is trademark dilution.

“To prevail on [a] trademark infringement claim, the plaintiffs must show two things.”⁴⁶ “First, they must establish ownership in a legally protectable mark, and second, they must show infringement by demonstrating a likelihood of confusion.”⁴⁷ The court in *NFL Properties, Inc. v. New Jersey Giants, Inc.*, laid out the general multi-factor “likelihood of confusion” test.⁴⁸ In determining whether confusion exists, the following factors are relevant:

- (1) The degree of similarity between the owner’s mark and the alleged infringing mark;
- (2) [t]he strength of the owner’s mark;

38. MATTHEW J. MITTEN ET AL., *SPORTS LAW AND REGULATION CASES, MATERIALS, AND PROBLEMS* 977 (Rachel E. Barkow et al. eds., 4th ed. 2017).

39. *Id.* See *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976).

40. MITTEN ET AL., *supra* note 38.

41. *Id.*

42. *Maryland Stadium Auth. v. Becker*, 806 F. Supp. 1236 (D. Md. 1992).

43. *Id.* at 1241.

44. *Bos. Prof’l Hockey Ass’n. v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1011 (5th Cir. 1975) (“[T]here is no reason why trademarks should ever pass into the public domain by the mere passage of time.”).

45. MITTEN ET AL., *supra* note 38.

46. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 474 (5th Cir. 2008).

47. *Id.*

48. *NFL Props., Inc. v. N.J. Giants, Inc.*, 637 F. Supp. 507, 517 (D.N.J. 1986).

(3) [t]he price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; (4) [t]he length of time the defendant has used the mark without evidence of actual confusion; (5) [t]he intent of the defendant in adopting the mark; and (6) [t]he evidence of actual confusion.⁴⁹

The general multi-factor likelihood of confusion test has been interpreted and applied in many different ways. While one confusion test has not been preferred over another, all discuss the same general factors. Whether the likelihood of confusion exists is a question of fact decided on a case-by-case basis.⁵⁰ Each factor must be considered to the extent it is relevant, and no one factor should be given excessive weight at the expense of some other factor.⁵¹

In a case for trademark infringement, a plaintiff is entitled to a permanent injunction against a defendant by showing that the defendant's activities are likely to confuse consumers as to the source or sponsorship of the goods.⁵² As such, a university would be entitled to a permanent injunction against a high school if it can show that the high school's activities are likely to confuse consumers as to the source and sponsorship. In determining whether to grant a permanent injunction, courts must consider:

(1) whether the moving party has demonstrated success on the merits, (2) the probability of irreparable injury to the moving party, (3) the potential for harm to the non-moving party; and (4) the public interest if applicable.⁵³

The "grant of injunctive relief is an extraordinary remedy which should be granted only in limited circumstances."⁵⁴

49. *Id.* at 516. See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (explaining that the Ninth Circuit determined an eight factor "likelihood of confusion test" similar to that of the District Court in New Jersey). In determining whether confusion exists, the Ninth Circuit found the following factors relevant:

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.

AMF, Inc., 599 F.2d at 348-49.

50. *MITTEN ET AL.*, *supra* note 38, at 986.

51. *Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc.*, 815 F.2d 500, 504 (8th Cir. 1987).

52. *NFL Props.*, 637 F. Supp. at 517.

53. *Harlem Wizards Entm't Basketball, Inc. v. NBA Props.*, 952 F. Supp. 1084, 1091 (D.N.J. 1997). See *Church & Dwight Co. v. S.C. Johnson & Son*, 873 F. Supp. 893, 902-03 (D.N.J. 1994); *Fechter v. HMW Indus., Inc.*, 879 F.2d 1111, 1116 (3d Cir. 1989).

54. *Harlem Wizards*, 952 F. Supp. at 1091.

Next, the Trademark Dilution Revision Act of 2006 (TDRA), which is part of the Lanham Act, protects the owner of a “famous mark” from unauthorized use of its mark or a similar mark that is likely to cause dilution of the mark’s distinctiveness.⁵⁵ Proof that the high school’s unauthorized usage creates actual or likely confusion or actual economic injury is not required. For a trademark to be “famous,” a mark must be “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”⁵⁶ Many universities with prominent, successful football and basketball teams are examples of sports trademarks that are famous because of their extensive national and/or international promotion and recognition.⁵⁷

There are two forms of dilution: dilution by tarnishment and dilution by blurring.⁵⁸ Dilution by tarnishment is “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”⁵⁹ For purposes of this Comment, dilution by tarnishment is not a factor unless a high school is involved in some kind of scandal, for example crimes or hazing, that harms the reputation of the famous mark. Collegiate institutions likely would prevail in a trademark by dilution case if tarnishment by a high school were found. Because this Comment focuses on the general legality of trademarks with no tarnishment taking place by high schools, the Comment will not discuss it any further.

Dilution by blurring is the focus of concern by many large universities. Dilution by blurring is “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”⁶⁰ In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi)

55. *Id.* at 989. See 15 U.S.C. § 1125(c).

56. 15 U.S.C. § 1125(c).

57. MITTEN ET AL., *supra* note 38, at 989.

58. 15 U.S.C. § 1125(c)(1).

59. *Id.* § 1125(c)(2)(C).

60. *Id.* § 1125(c)(2)(B).

Any actual association between the mark or trade name and the famous mark.⁶¹

Collegiate institutions are fearful that the marks might become so commonplace as to be considered generic and therefore no longer protectable.⁶² In addition, they do not want the brand value of the famous marks to be diminished in value.⁶³

IV. TRADEMARK RIGHTS OF COLLEGES/UNIVERSITIES (CURRENT STATE)

Many high school football teams wear logos that resemble the logos of popular universities, and in these instances, there is a case to be made for trademark infringement.⁶⁴ The problem has been around for a long time and enforcement is spotty⁶⁵ as some universities see it as a waste of time to police high schools.⁶⁶ The other reason for spotty enforcement is public relations: the David versus Goliath perception that big, cash-rich universities should not step on the little, cash-strapped school districts.⁶⁷ The rise in cease-and-desist letters from universities can be attributed to two things: (1) the ever-increasing value of licensed college logos; and (2) the greater television exposure given to high school athletics.⁶⁸ Universities do not want their famous marks losing value.⁶⁹

On the other hand, many high schools also borrow the popular logos of the thirty-two NFL franchises, and this has not caused any problems.⁷⁰ Brian McCarthy, an NFL spokesman, said high school and youth football teams are allowed to freely use NFL insignias.⁷¹ Specifically, he said, “It is inspirational for young players to play football under the same name as NFL teams.”⁷²

“[D]espite numerous successful suits against small businesses or individuals selling counterfeit, pirated merchandise bearing university marks, no college has ever attempted to litigate a likelihood-of-confusion trademark case against a school district” or high school.⁷³ Most high schools simply

61. *Id.* §§ 1125(c)(2)(B)(i)–(vi).

62. Green, *supra* note 16.

63. *Id.*

64. Burchart, *supra* note 27.

65. *Id.*

66. *Id.*

67. *Id.*

68. *Id.*

69. MITTEN ET AL., *supra* note 38.

70. Wagner, *supra* note 14.

71. *Id.*

72. *Id.*

73. Green, *supra* note 16.

acquiesce to the demands of universities set forth in cease-and-desist letters because of the unequal bargaining power inherent in the risk-reward downside of potentially high-cost litigation.⁷⁴ Applying the criteria used by courts to evaluate dilution, it appears more likely that a university might succeed against a high school with a dilution argument than with a likelihood of confusion claim, although once again, no college has ever attempted to litigate a trademark dilution case against a high school.⁷⁵

V. TRADEMARK INFRINGEMENT ANALYSIS: CONFUSION

With the factual background of the issue stated and trademark law explained, this Comment will now assess whether high schools actually have a defense to fight against the trademark cease-and-desist letters that the collegiate institutions are sending. The trademark infringement confusion claim will be discussed first, followed by the trademark dilution analysis.

For a university to be successful in establishing trademark infringement based on confusion against a high school, “it must prove that there is a significant likelihood of confusion between its marks and those used by the school being challenged.”⁷⁶ “Applying the criteria used by courts in analyzing such claims . . . it appears unlikely that colleges would prevail against high schools in most such lawsuits.”⁷⁷

For example, the *Board of Trustees of the University of Arkansas v. Professional Therapy Services* case involved a situation where the University of Arkansas sued a physical therapy clinic for trademark infringement.⁷⁸ The University of Arkansas had long “identified itself with the ‘Razorback(s)’ mark and a design logo that features a red, running hog.”⁷⁹ “Increased television coverage of college athletics led to an enormous boom in the production and sale of goods bearing collegiate marks.”⁸⁰ “By the early and mid-1980’s, many colleges and universities began licensing programs to insure control over goods and services bearing collegiate marks.”⁸¹ The University of Arkansas “joined this trend in 1988 when it retained Collegiate Licensing Company (CLC) to oversee licensing of the RAZORBACK marks and to monitor and halt

74. *Id.*

75. *Id.*

76. *Id.*

77. *Id.*

78. *Bd. of Trs. of the Univ. of Ark. v. Prof'l Therapy Servs.*, 873 F.Supp. 1280, 1283 (W.D. Ark. 1995).

79. *Id.*

80. *Id.* at 1284.

81. *Id.*

unauthorized uses.”⁸² “Also in 1988, the University began the process of obtaining federal registration for its marks, and it obtained its first registration in 1989.”⁸³ It has since obtained twenty-five registrations for the Razorback marks.⁸⁴ “[T]he University and CLC have licensed the RAZORBACK marks to about 720 third party users.”⁸⁵ “[T]he Clinic has served the Northwest Arkansas region by providing physical therapy services”⁸⁶ The Clinic has two locations, one in Rogers and one in Fayetteville; the Fayetteville location is located within a hundred meters of a nearby University of Arkansas Medical Science Building.⁸⁷ The Clinic changed its name to the “Razorback Sports and Physical Therapy Clinic,” and “for a design logo, the Clinic used a red, running Razorback hog.”⁸⁸

“[F]or the University to establish that the Clinic has infringed on its trademarks, it must prove (a) that the mark at issue is valid; and (b) that [the] [Clinic’s] use of the mark is likely to cause confusion.”⁸⁹ To determine whether a likelihood of confusion exists, the court went through each confusion factor and applied it to the case.⁹⁰ The court concluded that “the visual impression created by the dominant elements of the RAZORBACK marks and the Clinic’s marks [are] highly similar.”⁹¹ “[T]he RAZORBACK marks are strong ones that distinctively identify the University” and “the Clinic’s services and the University’s are competitive [and] closely related”⁹² The court ruled that there was “a likelihood of confusion and a serious risk” that the University of Arkansas would “lose control over its public image as a provider of medical services, if the Clinic continue[d] to use its marks.”⁹³

On the other hand, *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties* applied the likelihood of confusion test and found no trademark confusion.⁹⁴ The Harlem Wizards are “a theatrical basketball organization that performs ‘show basketball’ in the tradition established by the world famous

82. *Id.*

83. *Bd. of Trs. of the Univ. of Ark.*, 873 F. Supp. at 1284.

84. *Id.*

85. *Id.*

86. *Id.*

87. *Id.*

88. *Bd. of Trs. of the Univ. of Ark.*, 873 F. Supp. at 1284–85.

89. *Id.* at 1285.

90. *Id.*

91. *Id.* at 1292.

92. *Id.*

93. *Bd. of Trs. of the Univ. of Ark.*, 873 F. Supp. at 1292.

94. *Harlem Wizards*, 952 F. Supp. at 1099.

Harlem Globetrotters.”⁹⁵ Conversely, the Washington Bullets were a member team of the National Basketball Association, the world’s preeminent professional basketball league.⁹⁶ NBA Properties, Inc. is the entity that holds the licensing rights of the names of NBA member teams.⁹⁷

In February 1996, “the Washington Bullets publicly announced that beginning in the 1997–1998 NBA season, the team would formally change its name to the ‘Washington Wizards.’”⁹⁸ Soon after, the Harlem Wizards filed this lawsuit against the Washington Bullets and NBA Properties, alleging that the proposed name change infringed its trademark in violation of the Lanham Act.⁹⁹ The court identified this case as a case of reverse confusion.¹⁰⁰ “[R]everse confusion arises when a larger, more powerful entity adopts the trademark of a smaller, less powerful trademark user and thereby causes confusion as to the origin of the senior trademark user’s goods or services.”¹⁰¹ To measure the likelihood of confusion in a reverse confusion case, a court applies the same test developed to assess the likelihood of confusion in direct confusion cases.¹⁰² The court ran through the likelihood of confusion test, dismissed the case, and held that the teams do not compete against each other for fan patronage and therefore there is no consumer confusion, and thus no trademark infringement.¹⁰³

With no litigation history between high school and university trademark infringement, the two cases discussed above assist in analyzing a likelihood of confusion claim. When assessing whether trademark infringement due to confusion exists between high schools using similar insignias to universities, it is important to remember that each case is treated on a case-by-case basis. That being said, it is likely that one standard could be applied and relied on in similar situations. How would the courts assess the two examples at the beginning of the Comment, University of Texas at Austin versus Rancho Buena Vista High School and Notre Dame versus Cathedral High School, in a trademark confusion analysis? The courts would likely run through some form of the “likelihood of confusion test.” Using the reasoning and holdings from *University of Arkansas* and *Harlem Wizards* can assist in predicting an outcome

95. *Id.* at 1086.

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.*

100. *Harlem Wizards*, 952 F. Supp. at 1091.

101. *Id.*

102. *Id.* at 1094.

103. *Id.* at 1099. See MITTEN ET AL., *supra* note 38.

in the two aforementioned examples. The main factors assessed in a likelihood of confusion case are: (1) the degree of similarity between the marks; (2) the strength of the owner's mark; (3) the price of goods and other factors affecting consumers; (4) the length of time the high school has used the mark without evidence of confusion; (5) the intent of the high school in adopting the mark; and (6) the evidence of actual confusion.¹⁰⁴

“In the sports context, many of the factors weigh in favor of the [] senior user: most sports trademarks are usually highly distinctive and therefore strong, and the goods and services (athletic events, and usually also apparel and other gear) of a mark owner and alleged infringer precisely overlap.”¹⁰⁵

Other factors point in the opposite direction: there usually isn't any evidence of actual confusion or intentional copying; the marks are often separated by large geographical distances, not in close physical proximity; and the sports consumer is generally highly sophisticated; thus able to distinguish between similar marks in a crowded sports marketplace.¹⁰⁶

“The remaining factor—similarity of the marks—could therefore have great weight.”¹⁰⁷ These cases and situations can go many different ways, and it seems that every situation would have to be balanced against the test to see if there is actual confusion.

In *University of Texas vs. Rancho Buena Vista High School*, the courts would look at the similarity of the marks, the intent of the high school, and evidence of confusion as the main factors in finding no confusion. The high school uses a silhouetted longhorn logo colored maroon and silver, which is different than the University of Texas's orange and white.¹⁰⁸ Additionally, the intent of the high school was not to compete or copy the University. This case is different from the *University of Arkansas* case because of the different locations and intent of using the mark. The clinic in *University of Arkansas* intended to use the logo to brand itself with the University and imply the appearance of association with the University because of its proximity.¹⁰⁹ Here, the high school is located in a different state and is using a modification of the logo. The similarity of the marks is altered. Rancho Buena Vista High School's intent is not to confuse them with the University of Texas. The case is similar

104. *NFL Props.*, 637 F. Supp. at 516.

105. *What's in a Name? Or a Logo? N.C. State, the "Wolfpack" Name, and Lessons in Sports Trademarks*, *supra* note 11.

106. *Id.*

107. *Id.*

108. Warth, *supra* note 1.

109. *Bd. of Trs. of the Univ. of Ark.*, 873 F. Supp. at 1284.

to *Harlem Wizards* because the University does not directly compete against the high school. Similar to the different forms of basketball, here there is a different level of competition in sport. The University of Texas is neither competing with a high school fan base in California, nor is it competing against the high school in sports. Because there is no confusion and competition between the schools, the University of Texas should not have a trademark infringement claim.

In *Notre Dame vs. Cathedral High School*, the courts would look at the similarity of the marks, the intent of the high school, evidence of confusion, and the length of time the high school has used the mark as the main factors in finding no confusion. Notre Dame would have a good claim with similarity and strength of its mark. The “Fighting Irish” name and logo is a strong brand, and the high school is using the name “Fighting Irish” and the leprechaun logo. But again, Notre Dame is not competing with a high school in New Mexico. The analysis is the same as the University of Texas example using the *Harlem Wizards* case analysis; they are competing at two different levels of sport, and the fan bases are different. High school athletics and college athletics are completely different markets with different fan bases, especially when the schools are located in different states. New Mexico Cathedral High School had been known as the “Fighting Irish” in the New Mexico community for eighty-six years.¹¹⁰ Think about that for a second. Eighty-six years. When this New Mexico community sees the words “Fighting Irish” they think Cathedral High School, not Notre Dame. Cathedral High School has a strong case that they are not causing confusion on Notre Dame’s trademarks, but a court could still rule against them based on the similarity of the logos and the use of the common words “Fighting Irish.” Both sides have credible arguments and strong points in the trademark confusion test.

In conclusion, under the current statutory and common law of trademark confusion, it seems that courts could rule in favor of high schools against trademark infringement and find no confusion. However, it is important to remember that these cases are judged on a case-by-case basis, and the scrutiny under the likelihood of confusion analysis can change. The analysis could turn on the similarity of the logo. While it is likely that courts would find some high schools in violation of collegiate trademarks, there is also a strong argument that other high schools are not violating those trademarks.

110. Hunt, *supra* note 6.

VI. TRADEMARK DILUTION ANALYSIS

Next, trademark dilution¹¹¹ may be a university's best argument to enforce their trademarks against high schools. Dilution is "premised on the idea that if widespread infringement of famous marks occurs, then the brand value of the famous marks will be diminished"¹¹² The trademark owner has the right for their mark to not be seen as commonplace. As mentioned above, dilution by blurring is "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."¹¹³ The key element in assessing a dilution claim is the word "famous." To be "famous," "the mark must be widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."¹¹⁴ Examples of sports trademarks that are famous because of their extensive national and/or international promotion and recognition are: the Indianapolis 500 auto race, Masters golf tournament, marks of major league professional teams, and many universities with prominent, successful football and basketball teams.¹¹⁵ So, looking at the two examples at the beginning of this Comment once again, are the University of Texas and Notre Dame considered "famous" marks?

In *Board of Regents v. KST Electric, Ltd.*, the University of Texas sued KST Electric "for a number of state and federal trademark claims, alleging that several logos developed and used by KST infringe[d] on UT's [the University of Texas] registered trademark that depicts its mascot, a longhorn steer, in silhouette."¹¹⁶ "KST argues that it should be granted summary judgment on UT's federal dilution claim because UT has not provided any evidence that the longhorn silhouette logo is famous for purposes of the Trademark Dilution Revision Act (TDRA)."¹¹⁷ Under the TDRA:

the owner of a famous mark . . . shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark,

111. 15 U.S.C. § 1125(c).

112. Green, *supra* note 16.

113. § 1125(c)(2)(B).

114. MITTEN ET AL., *supra* note 38, at 989.

115. *Id.*

116. *Bd. of Regents v. KST Elec., Ltd.*, 550 F. Supp. 2d 657, 663 (W.D. Tex. 2008).

117. *Id.* at 673.

regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.¹¹⁸

The court rejected the University of Texas's dilution claim because the University's evidence failed to demonstrate the extremely high level of recognition necessary to show "fame" under the Trademark Dilution Revision Act.¹¹⁹ The court reasoned that simply because the University of Texas has "achieved a level of national prominence does not necessarily mean that the longhorn logo is so ubiquitous and well known to stand toe-to-toe with [brands like] Buick or KODAK."¹²⁰ Reading through the evidence, the court found it is unclear that if a person is not a college football fan that they would recognize the Longhorn logo being associated with the University of Texas, as all the evidence presented relates to the use of the logo in sporting events.¹²¹

"As one academic commentator put it, the TDRA is simply not intended to protect trademarks whose fame is at all in doubt."¹²² If a court has previously found the University of Texas Longhorn silhouette to not be a "famous" mark, then a future court likely would not find it as a "famous" mark against Rancho Buena Vista High School. Notre Dame may have a stronger argument than the University of Texas would in a trademark dilution case. Notre Dame would need to demonstrate evidence that its brand is famous and recognizable outside of collegiate athletics. One can argue that Notre Dame can make a strong case, but ultimately that is up for the court to decide. In conclusion, the University of Texas would struggle to succeed with a trademark dilution claim against a high school because of case precedent finding against their longhorn trademark "famousness," while Notre Dame may have a stronger argument in winning a trademark dilution case because they may be able to prove that its marks are "famous."

Since high schools have a chance, or at least a strong argument, to win a trademark case if it goes to litigation, the issue and concern of trademark bullying must be discussed. If high schools have a legal right to continue using the name and insignia they have been using for years, then why are they being forced to change?

118. *Id.*

119. *Id.* at 679.

120. *Id.* at 678.

121. *Id.*

122. *Id.* at 679. See Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L. J.* 1143, 1158 (2006); Marc L. Delflache et al., *Life After Moseley: The Trademark Dilution Revision Act*, 16 *TEX. INTELL. PROP. L. J.* 125, 142–43 (2007) (the TDRA rejects niche fame).

VII. TRADEMARK BULLYING

The next issue that must be addressed in the relationship between universities and high schools is the idea of trademark bullying. This is not to say that all universities partake in trademark bullying, but it is no secret that universities hold a distinct advantage and leverage over most high schools. The United States Patent and Trademark Office (USPTO) defines trademark bullying “as the vexatious practice of a ‘trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow.’”¹²³ “According to the Report to Congress on trademark litigation [by the USPTO], only 1.5% of trademark infringement cases actually reach trial, which further underscores the issue that these abusive tactics are employed at the pre-trial or pre-litigation stages and are conveniently not made public.”¹²⁴

With all this being said, is there a way to combat trademark bullying? “[C]reative non-legal responses to bullying have been successfully employed to combat rights owners who elect to assert rights beyond the scope of trademark protection.”¹²⁵ Specifically, the use of “social media can place bullies’ actions in the public limelight while pressuring them into ceasing . . . predatory practices.”¹²⁶ “With proper execution, shaming campaigns may generate negative public scrutiny, which creates the image” of the large, money-hungry university picking on the modest high school.¹²⁷ “By shifting the disparity in bargaining power . . . many smaller entities have been able to successfully overcome meritless infringement claims.”¹²⁸ Once again, this is the David versus Goliath situation. The goal of most high schools is not to damage the brand or reputation of a university by the use of a same or similar logo/name. If anything, universities should spin the use in a positive light and promote the high school’s use of their name, logo, and insignia. It could be a way for universities to establish their brand to high school students and for communities to build a sense of loyalty instead of attacking and taking away the only logo or name a high school has ever known. This is why it would be smart for universities to act more as partners with high schools instead of bullies. It allows universities to continue to police and monitor their trademark so they do

123. Roxana Sullivan & Luke Curran, *Trademark Bullying: Defending Your Brand or Vexatious Business Tactics?*, IPWATCHDOG (July 16, 2015), <http://www.ipwatchdog.com/2015/07/16/trademark-bullying-defending-your-brand-or-vexatious-business-tactics/id=59155/>.

124. *Id.*

125. *Id.*

126. *Id.*

127. *Id.*

128. *Id.*

not lose their rights, but it also allows them to work with high schools instead of attacking them with cease-and-desist letters. It is important to recognize that trademark owners generate commercial success through goodwill and a positive rapport with the general public. Trademark owners have every right to actively protect their trademarks, however, trademark owners may act as a “bully” when they overreach. A social media campaign by the “little guys” may be exactly what is needed to equal the playing field.

VIII. CAN HIGH SCHOOLS OBTAIN THEIR OWN TRADEMARK RIGHTS?

Can high schools trademark their logos? Of course they can, and it may be a smart solution for many high schools. Enforcing their trademark may be even more difficult than universities trying to enforce their trademarks, but they still have the right. High schools can prevent others from copying their logo by obtaining a trademark.¹²⁹ To qualify for a trademark, the high school must be able to prove that it has exclusive rights to the logo, the logo must be original, and the logo must appear on merchandise, for example, t-shirts, stationery, or flags.¹³⁰ To apply for a trademark, a high school should search the website of the U.S. Patent and Trademark Office to make sure no one else has applied for a trademark.¹³¹ If no one has applied and a high school’s logo meets all the trademark requirements, then the school pays an application fee and submits their application to obtain rights to the mark.¹³²

IX. CURRENT SOLUTIONS AND PROPOSED SOLUTIONS

“Jim Arnowitz, associate legal counsel for Collegiate Licensing Co., an Atlanta-based agency that represents almost 200 colleges and related athletic bodies, said ‘like any trademark holder colleges need to protect their mark to retain value.’”¹³³ This statement is not in dispute, but the way universities are enforcing their trademarks, and the fact that they may be enforcing them too broadly, is the central concern, and the solution that needs fixing.

The solution to this issue begins with high schools not immediately giving in to university cease-and-desist letters. High schools should spend time researching and looking into the specifics of the letter that is sent to them.

129. Amanda Erickson, *Can High School Logos Be Copyrighted?*, AZCENTRAL, <http://your-business.azcentral.com/can-high-school-logos-copyrighted-7595.html> (last visited July 30, 2018).

130. *Id.*

131. *Id.*

132. *Id.*

133. Larissa Chinwah, *Colleges to High Schools: Stop Using Our Logos*, DAILY HERALD, Nov. 30, 2010, <http://www.dailyherald.com/article/20101130/news/712019831>.

Receiving opinion from outside counsel is also a wise first step. Additionally, instead of immediately complying with the letter, the high school should start a conversation (or “negotiation”) with the university and inquire about a possible licensing deal—one that is reasonable for both parties.

Universities should address the issue with a license-first approach instead of a cease-and-desist approach. “Trademark licensing is a contractual relationship under which a trademark owner grants another the right to use the mark, subject to terms of the contract.”¹³⁴ Robert D’Amelio, assistant athletic director for sports marketing, media relations, and trademark licensing at Western Michigan, said, “about 20 high schools or youth organizations from across the country are licensed to use the Western Michigan University bronco logo, paying a \$100 fee good for two years.”¹³⁵ He additionally stated the University “must control the use of the mark to retain ownership.”¹³⁶ This is a great solution and a fantastic example for other universities to follow. Licensing allows the schools to continue to police and retain the rights to their valuable trademarks while only making it more valuable and mainstream. It provides high schools with an affordable option to use a logo/name. It also allows potential goodwill to build up for Western Michigan University. In addition, licensing is a way for universities to establish their brand to high school students and communities, and build a sense of loyalty instead of attacking and taking away something a high school has known. Specifically, it is a smart move for universities similar to Western Michigan because they would likely not have a strong case under trademark infringement (confusion), and likely do not own a “famous” mark in order to win a trademark dilution claim.

As mentioned above, high schools applying and obtaining their own trademarks is another solution to this issue. Not every high school is going to be able to do this, but for a high school whose student population rivals small universities, this is both a smart and viable option. If the school has the available resources, it could hold a logo/branding design contest. The high school must be able to show it is an original work and receive written permission from the creator to use the logo on its goods and merchandise.

Additionally, the current trademark law is very broad and allows trademark holders to enforce their rights too broadly. A statistic mentioned earlier in this Comment reported that only 1.5% of trademark infringement cases make it to litigation. While it is good that the flow of litigation in this area is low, it may

134. Gary Moss, *Success of Trademarks and Licensing Program Translates Into Financial Support for Students*, UNIV. GAZETTE (Mar. 19, 2013), <http://gazette.unc.edu/2013/03/19/success-of-trademarks-and-licensing-program-translates-into-financial-support-for-students/>.

135. Chinwah, *supra* note 133.

136. *Id.*

also mean that trademark rights are being enforced wrongfully and too broadly. Congress should look to further define and limit the scope of trademarks, and clearly define when a trademark holder can enforce their rights against someone they believe is in violation.

Lastly, newly formed high schools might be best served by choosing names and logos that are dissimilar from those being used in their geographic region.¹³⁷ “The dozen most common four-year university nicknames in the country—Eagles, Tigers, Bulldogs, Panthers, Knights, Lions, Bears, Hawks, Cougars, Pioneers, Warriors, and Wildcats—are used by a cumulative 425 colleges.”¹³⁸ Creating a unique nickname and designing a unique logo, perhaps through a school-wide contest, will put a new high school in the best position.

X. CONCLUSION

Overall, with no litigation surrounding this issue it is tough to come to a definite conclusion and rule one way or another. However, applying the relevant statutory law and common law, it seems like universities could be enforcing their trademark rights too broadly. Every situation is judged on a case-by-case basis, and it seems in some cases that no trademark infringement may exist. After applying the likelihood of confusion test and looking at cases that have applied the test in the past, high schools have a strong argument to show that there is no consumer confusion. A university’s best argument, other than showing the degree of similarity between their logo and the high school’s logo, is to enforce their trademark rights under trademark dilution. However, to win under trademark dilution, the mark must be “famous,” which means it must be extremely well known to the general public. The *University of Texas v. KST* case demonstrates that it might be tough for many universities to be considered to have famous trademarks.¹³⁹ If the University of Texas is not considered a “famous” mark, then only a select few universities might be able to assert that they own a “famous” mark.

To further avoid situations of these cease-and-desist letters in the future, universities should take more of a partnership approach, instead of adversarial, and attempt to reach reasonable licensing deals with high schools. This is good public policy and a reasonable approach because in most cases it is not a high school’s intent to compete with the university or take away from its brand in any way. It is important to recognize the importance of the trademark value to universities. This approach allows universities to continue monitoring and

137. Green, *supra* note 16.

138. *Id.*

139. *Bd. of Regents*, 550 F. Supp. 2d at 657.

maintaining their trademark rights, but it also allows high schools to use names and logos that they have had since their creation. From a public relations perspective, it does not make sense for a university to attack and force a high school, located in a different place, with absolutely no connection at all, to change everything. If a high school is in the situation of trademark bullying, utilizing social media can place bullies' actions in the public limelight while pressuring them into ceasing such predatory practices.

In conclusion, lookalike logos are common and will only gain more attention as trademarks and other intellectual property rights continue to increase in value. It is important for both sides to work together with this issue and agree to equitable, reasonable solutions.