

Trademark Protection of School Colors: *Smack Apparel* and *Sinks* Decisions Trigger Color-ful Legal Debate for the Collegiate Licensing Industry

JOHN GRADY

University of South Carolina

&

STEVE MCKELVEY

University of Massachusetts Amherst

INTRODUCTION

Over the past two decades, the collegiate licensing industry has experienced exponential revenue growth, today topping \$3 billion in annual merchandise sales (Smith, 2007a). In fact, as reported in 2006, retail sales of collegiate licensed merchandise in the United States and Canada trailed only that of the National Football League and Major League Baseball among the major sport organizations (The Licensing Letter, 2006).

This stands in stark contrast to 30 years ago, when "only a few collegiate institutions had developed formal licensing programs to protect their marks and market licensed products" (Bearby & Siegal, 2002, p. 1). Bill Battle, founder of Collegiate Licensing Company ("CLC"), the country's largest collegiate licensing firm, has recalled that in the mid-1980s, universities were "ecstatic when they generated \$100,000 a year from athletic licensing" (Solomon & Perrin, 2008). By contrast, in 2007, the Southeastern Conference alone was responsible for \$600 million in retail sales of officially licensed products (Solomon & Perrin). Perhaps even more illustrative of the untapped potential of the collegiate licensing industry, in 2007 International Management Group ("IMG") acquired both CLC and collegiate sport marketing powerhouse Host Communications, rolling both iconic companies under the banner of IMG College Sports (Smith, 2007b).

As the demand for collegiate sports apparel has increased, the universities have responded, "spen[ding] millions of dollars over the years marketing and promoting items bearing their initials and school colors" (*Board of Supervisors*

of the Louisiana State University and Agricultural and Mechanical College, et al. v. Smack Apparel, et al., 2006, p. 655). The tremendous growth of the collegiate licensing industry can be traced to two companies.

The most prominent, and the first to see the potential for collegiate licensing, is Collegiate Licensing Company (hereinafter "CLC"). After absorbing sales lessons in the window and glass industries, and realizing the power of sports brands in a distribution deal with Jack Nicklaus's company Golden Bear, former Tennessee football coach Bill Battle founded Collegiate Concepts, Inc. in 1981 (Collegiate Licensing Company, n.d.). Several years later, the company name was changed to the Collegiate Licensing Company ("CLC"). CLC's lone competition in the collective management of collegiate licensing rights is Michigan-based Licensing Resource Group, Inc. ("LRG"). Founded in 1991, LRG manages the licensing rights to about 130 collegiate entities, including Texas A&M, Vanderbilt, Virginia Tech, the Big East Conference and the Pac-10 Conference (Smith, 2007a).

One of the first challenges Battle had to overcome in growing CLC was persuading colleges and universities that they owned their school names and marks. He then had to convince the universities that manufacturers and retailers using these university assets on merchandise should be sharing these revenues with the university. Once these initial hurdles were cleared, Battle had to convince manufacturers and retailers to participate in these new licensing programs. Demonstrating an affiliation with the school's name through the use of school colors became an increasingly important selling point over time. In the early days of the business, overcoming the "You can't protect Alabama, that's a state name" argument was key, according to Battle. "Interesting that you're putting the State of Alabama in crimson and white. Why don't you put it in purple and green and we probably won't bother you" was his response (Underwood, 2001). In other words, selling a shirt with the word "Alabama" in black and white would not convey the same message to fans or have nearly the same commercial appeal as selling a shirt with the school's name in the school's famous color scheme of crimson and white. Given the current focus on the protection of school colors which is analyzed in this article, Battle's comment was remarkably foretelling of the legal hurdles currently facing the collegiate licensing industry.

Because of its relatively recent emergence, the collegiate licensing industry has had a much less litigious past when compared to its counterparts in professional sport. The reasons for this are threefold: first, collegiate institutions have historically positioned their athletics programs as part of the overall educational mission of the institution and has thus long held itself out as anathema to the professional sport industry; 2) collegiate athletic programs,

as administered by individual academic institutions, have historically lacked the financial and personnel resources, as well as the sports marketing savvy, necessary to make trademark enforcement a high priority; and 3) the incremental revenue potential of collegiate licensing has only recently evolved into the notion of "big business," which has in turn incentivized collegiate institutions to expand their licensing and trademark enforcement personnel.

As a result of the relatively recent financial boom in licensing revenues, collegiate institutions have begun to gain greater appreciation and understanding of their legal rights with respect to their trademarks which has, in turn, fueled the growth of trademark protection and enforcement initiatives within collegiate athletic departments (Bearby & Siegal, 2002; Lattinville, 1996). In just the past three years alone, collegiate institutions, often in concert with licensing representatives such as CLC, have taken a much more aggressive stance against unlicensed entities alleged to be infringing their trademark rights. The most highly-publicized of these lawsuits evince the broadening scope of enforcement actions based on trademark infringement, unfair competition and dilution:

- *Use of university marketing slogans* - In *Texas A&M University v. Seattle Seahawks, Inc.* (2006), Texas A&M successfully gained an injunction against the NFL Seattle Seahawks for the latter's unauthorized use of the phrase "12th Man" (the parties settled and subsequently entered into a licensing agreement (Romero, 2006)).
- *Use of parody causing trademark dilution* - In *Board of Regents of University of Texas, et al. v. Kalcop Enterprises, Inc.* (2006), the University of Texas filed suit against a local business for diluting the university's famous Longhorn trademark. The defendant was selling merchandise featuring the longhorn silhouette logo, but the horns were disconnected from the Longhorn's head and accompanied by the phrase "Saw 'em off," a phrase intended to coincide with the Texas A&M war cry. This case was settled before the court could address the defendant's parody defense (Batista & McKelvey, 2007).
- *Use of altered trademarks* - In *Board of Regents, The University of Texas System v. KST Electric, Ltd.* (2008), the University of Texas sued a local company for trademark infringement and dilution based upon the defendant's use of an altered version of the university's trademarked logo (a longhorn steer in silhouette). The defendant's corporate logo design consisted of a longhorn silhouette with a "K" on the left cheek area of the longhorn, an "S" on the right cheek area, and a "lightning bolt T" in the face of the

silhouette, and the words "Electric, Ltd." in the space between the horns. Although the defendants won a summary judgment motion on the dilution claim, the university recorded a partial victory when the magistrate judge recommended that a district judge deny the defendant's summary judgment motion on the federal trademark infringement claim. This case was subsequently settled in March, 2008.

- *Use of university trademarks, including color schemes, in artwork*: In *Board of Trustees of University of Alabama v. New Life Art, Inc.* (2005) (pending), the University of Alabama brought suit against a local sports artist for paintings, reproduced in prints and on merchandise, alleged to violate the university's trademark rights through, inter alia, the use of the university's color scheme. The well-known artist had been painting and selling Alabama football-themed artwork for over 25 years without a license and without objection by the university. This lawsuit alleging trademark infringement and unfair competition raised complex legal issues at the nexus of trademark law and freedom of expression afforded by the First Amendment (Liptak, 2006; McMillen, Benedict, & McMillen, 2007).
- *Use of team nicknames and colors* – In *Georgia Athletic Association, Inc. v. Bulldog Movers, Inc.* (2006) (pending), the University of Georgia filed suit against a local moving van company calling itself "Bulldog Movers" and utilizing a logo that featured a white bulldog jumping across a red triangle that the company had used since it formed in 1983. The lawsuit claims that the defendant is causing the university irreparable harm by using its trademarked symbols and colors. The university brought suit after the company applied to register its trademark because it had been doing more out-of-state business and sought to avoid confusion with several other companies around the country operating under the name "Bulldog Movers" (Quigley, 2007).

As demonstrated by the cases cited above, the issue of trademark protection of school colors and color schemes has emerged as one of the most hotly-contested current legal issues facing the collegiate licensing industry. This issue is specifically at the heart of two additional cases that provide the legal focus for this article: namely, *Board of Supervisors of the Louisiana State University and Agricultural and Mechanical College, et. al. vs. Smack Apparel Company, et al.* (2006) (hereinafter "*Smack Apparel*") and *University of Kansas and Kansas Athletics, Inc. vs. Sinks et al.* (2008a) (hereinafter

"*Sinks*"). The outcome of these two cases has the potential to significantly alter the scope of trademark protection for collegiate institutions with respect to school colors.

The first section of this article provides an overview of trademark law, focusing primarily on the protections afforded trademarks under the Lanham Act, the federal trademark law. Of particular focus in this section is the legal standard upon which colors may be protectable as trademarks. This first section also discusses the statutory and common law defenses available to alleged trademark infringers, including most notably the protections afforded First Amendment freedoms of speech and expression that can arise in trademark infringement cases. The following sections provide the facts and holdings of the *Smack Apparel* and *Sinks* cases. The last section provides a discussion of the distinctions between the lower courts' decisions in these two cases, while also incorporating the legal scholarship of commentators who have previously analyzed the expanding scope of trademark law in the context of the collegiate licensing industry.

OVERVIEW OF U.S. TRADEMARK LAW

The Federal Trademark Act of 1946, commonly referred to as the Lanham Act, provides the basis for the establishment and protection of a collegiate institution's trademarks and is the law most typically relied upon by collegiate institutions in enforcing trademark rights. The underlying purpose of trademark law is to protect consumers from being deceived or confused as to either the source or origin of the goods and services available to them, or the sponsorship or affiliation of the goods and services of the trademark holder with that of the alleged infringer. Unlike copyright and patent laws designed to provide an economic incentive for creativity and invention, trademark law is not intended to convey a property interest for the mark-holder; it is instead premised upon pro-competitive goals.

There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed. The law of trade-marks is but a part of the broader law of unfair competition. . . . Its function is simply to designate the goods as a product of a particular trade and to protect his good will against the sale of another's product as his.

Accepting that there is no property right in a word or symbol independent of a trade or business, there can be no exclusive ownership or protection of a purported trademark beyond the prevention of deceit or confusion. The prevention of confusion has

been, is, and should be, the defining scope and purpose for protecting trademarks (Tschura, 2007, p. 876-878)

The Lanham Act provides causes of action for trademark infringement and unfair competition, each of which is often used simultaneously in actions by holders of federal trademarks. Both causes of action require not only that the plaintiff establish ownership of a valid and legally protectable mark, and that the defendant's use of the mark in commerce is likely to cause consumer confusion.

Section 1114 of the Lanham Act provides a cause of action for the infringement of a registered mark when a person

use[s] in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution or advertising of any goods or services on or in connection with which such use is likely to cause confusion or to cause mistake, or to deceive (15 U.S.C. §1114(1)(a), 2008)

The federal registration of a mark is *prima facie* evidence of the registrant's exclusive right to the mark in connection with the goods or services specified in the federal registration (15 U.S.C. §1115, 2008).

By contrast, Section 1125 of the Lanham Act regarding "false designations of origin, false descriptions, and dilution forbidden" provides a cause of action for non-registered marks and is considered an action for unfair competition. This section provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, 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. (15 U.S.C. §1125(a)(1), 2008)

In order for a plaintiff to prevail under this section, he or she must first establish ownership of a valid and legally protectable mark. In order to achieve

this, the plaintiff must prove not only prior use, but also that the mark has acquired distinctiveness in that it is nonfunctional. Regarding the requirement related to functionality, the rule is rather straight forward:

in general terms, a product feature is functional, and therefore cannot serve as a trademark "if it is essential to the purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage (*Qualitex Co. v. Jacobson Products Co.*, 1995, p. 165)

Therefore, the first step in demonstrating distinctiveness is for the plaintiff to establish both that the feature of the mark is not essential to the use, purpose, cost or quality of the good, and that the inability to use the mark would not put a competitor at a significant disadvantage (*Inwood Lab., Inc. v. Ives Lab, Inc.*, 1982). In other words, the mark must serve as an indication of origin and not in a decorative, ornamental or functional capacity. Trademark law does, however, permit reproduction of a product's functional features (*International Order of Job's Daughters v. Lindeburg & Co.*, 1980; *National Football League Properties, Inc. v. Wichita Falls Sportswear*, 1982). As McCarthy (1992) has noted:

That the logos or marks of educational, entertainment or commercial entities may also be visually pleasing when used on wearing apparel does not mean that they are automatically incapable of trademark significance as "functional." It is a question of fact as to whether consumers view such indicia as "merely ornamental" or as symbols that identify a source of sponsorship (§24.03[4][a])

In instances where a mark has not been granted trademark registration, the other requirement to demonstrate a valid and legally protectable trademark is that the plaintiff establish that the mark has acquired secondary meaning. This has been defined as a "mental recognition in buyers' and potential buyers' minds that products connected with the symbol or device emanate from or are associated with the same source" (*National Football League Properties, Inc. v. Wichita Falls Sportswear*, 1982, p. 658). In the seminal case of *Wichita Falls Sportswear* (1982), the court found that the regional designations of NFL football jerseys (i.e., the names of cities that had professional franchises) were descriptive and held that the NFL had to prove that secondary meaning existed as to the regional designations in the football context (e.g., selling "Seattle" jerseys in blue, green and silver, the Seahawks' colors). The NFL successfully established secondary meaning by presenting survey evidence demonstrating a high level of association between the defendant's jerseys sold in the teams'

colors and the NFL teams. Given that colors in and of themselves are not subject to trademark protection without some connection to one particular source (e.g., the team or school), the concept of secondary meaning is especially relevant to the forthcoming analysis regarding school colors.

Through the evolution of trademark law, trademark protection has now been expanded beyond words and logos to include a broad array of source-identifying elements, including slogans, pictures, characters, numbers, sounds, graphic designs and colors (*Restatement (Third) of Unfair Competition*, §9 & §13, 1995). The Lanham Act also provides protection for product and packaging designs, typically referred to as "trade dress" (McCarthy, 2003).

Once the plaintiff has established that he or she owns a valid and legally enforceable trademark, the linchpin of a trademark infringement case is the ability of the plaintiff to establish likelihood of consumer confusion. While the factors used to establish the likelihood of confusion vary among jurisdictions, they emanate from the eight-factor test first enumerated in the seminal case of *Polaroid Corp. vs. Polarad Electronics Co.* (1961). Subsequent to the establishment of the so-called "Polaroid factors," jurisdictions have fashioned their own list of six to eight factors, none of which are in and of themselves dispositive. In *Smack Apparel* (2006), the court relied on the following seven "digits of confusion:"

Those factors are: (1) the type of mark allegedly infringed; (2) the similarity between the two marks; (3) the similarity of the products or services; (4) the identity of retail outlets and purchasers; (5) the identity of the advertising media used; (6) the defendant's intent; and (7) any evidence of actual confusion (p. 659)

PROTECTION OF COLORS: THE *QUALITEX* CASE

Of particular relevance to this paper is the protectability of colors and color schemes as a trademark. This issue was resolved by the U.S. Supreme Court in *Qualitex Co. v. Jacobson Products, Co.* (1995) (hereinafter "*Qualitex*"), a landmark decision which held unanimously that "sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark" (*Qualitex*, 1995, p. 160).

The plaintiff in *Qualitex* manufactured dry cleaning press pads since the 1950s, with a special shade of green-gold. When a rival manufacturer began using a similar shade on its own press pads, the plaintiff sued for infringement of its registered trademark, which covered the green-gold color. The defendant counterclaimed to cancel the plaintiff's registration on the grounds that color

was not protectable. The California trial court upheld the plaintiff's trademark but, on appeal, the Ninth Circuit reversed, holding that the color alone of the pad should not be protectable as a trademark (*Qualitex*, 1994, p. 1302).

The Supreme Court reversed the Ninth Circuit and, resolving a split of authority among the circuit courts, held in favor of the plaintiffs (*Qualitex*, 1995). Focusing on Section 45 of the Lanham Act which defines a trademark to include "any word, name, symbol or device, or any combination thereof, the Court held that color may be considered a "symbol" or "device" much the same way as shapes, sounds and scents had been granted trademark protection (*Qualitex*, 1995, p. 253).

However, the Supreme Court qualified its opinion, holding that while color alone may not be inherently distinctive (such as a fanciful, arbitrary or suggestive word or design), it can be analogized to descriptive marks, which may only be registered if they have acquired secondary meaning (*Qualitex*, 1995, p. 254). The Court noted: "We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained "secondary meaning" and therefore identifies and distinguishes a particular brand (and thus indicates its "source") (*Qualitex*, p. 254).

The Court also found no objection in the "functionality doctrine" to prevent the protection of color as a trademark. To the contrary, the Court held that color could serve to act as a source identifier and, in this instance, the plaintiff's green-gold color was not functional since other colors were available for use on dry cleaning pads (*Qualitex*, 1995, p. 255-256). However, the Court did recognize that color may be functional in other situations (*Qualitex*). In 2000, in *Wal Mart Stores, Inc. vs. Samara Bros., Inc.*, the Supreme Court clarified its decision in *Qualitex*, holding that "color could be protected as a trademark, but only upon a showing of secondary meaning" (*Wal Mart Stores, Inc.*, 2000, p. 212).

DEFENSES TO TRADEMARK INFRINGEMENT CLAIMS

Ownership of a trademark is not, however, a right in gross. Trademark registrants are required to identify specific categories of goods and/or services on which the trademark will be utilized, thus preventing the trademark holder from securing a monopoly over use of the mark. Beyond merely proving that the plaintiff does not have a valid and legally enforceable trademark, the defendant may assert several affirmative defenses. The first, which is incorporated by statute into the Lanham Act, is abandonment, in which use of the mark has been discontinued with intent not to resume such use or when the

owner allows the mark to fall into the public domain (15 U.S.C. §1127, 2008). A second defense is that of functionality previously discussed above. The third is the "zone of expansion" defense, available when the defendant can demonstrate that the owner of a registered mark and the unauthorized user operate in two "sufficiently distinct and geographically separate" markets and there is no likelihood that the registered owner will enter into the unauthorized user's market, thereby eliminating the likelihood of confusion (*Major League Baseball Properties Inc. v. Sed Non Olet Denarius, Ltd.*, 1993, p. 1133).

In 1992, the U.S. Court of Appeals for the Ninth Circuit in *New Kids on the Block v. News America Publishing, Inc.* (1992) carved out another potential defense for unauthorized trademark use. The doctrine of "nominative fair use" allows defendant's use of a mark if he or she can meet a three-prong test:

- 1) the goods or services must not be readily identifiable without the use of the trademark; 2) only so much of the mark may be used as is reasonably necessary to identify the goods or services, and 3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder (*New Kids on the Block*, p. 308).

Finally, the provisions afforded by the First Amendment also provide a potential defense against some claims of trademark infringement, although there remain many unresolved issues at the intersection of trademark law and the First Amendment. This conflict arises from a dichotomy of overarching purposes: the purpose of trademark law being to protect consumers from confusion versus the purpose of the First Amendment to protect and encourage the free flow of communication and expression of ideas.

Balancing the First Amendment rights of potential trademark infringers with the rights afforded to trademark holders depends on the type and use of the speech. For example, as noted by McMillen et al. (2007), unauthorized users are "free to speak about trademarks in noncommercial or commercial-but-nontrademark ways" (p. 148), citing by way of illustration a published novel in which a character specifically drinks Starbucks coffee. Furthermore, in 1976, in a landmark decision, the U.S. Supreme Court held that under certain circumstances commercial speech (the advertising of commercial products) can be as deserving of First Amendment protection as is political speech or writing (*Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 1976). Finally, the Courts have generally afforded the strongest level of protection for speech that, although utilizing another's trademark, is deemed to convey important political or social commentary,

including satire and parody. However, as suggested by one commentator as far back as 1986, the law governing parody "remains a muddle in both principle and practice. Courts addressing the problem of trademark parody have not adequately reconciled the rights of the parodist with those of the trademark owner" (Shaughnessy, 1986, p. 1080). Courts and commentators have recently begun to more closely scrutinize trademark parody that was once considered a safe haven for third-party trademark users. As suggested by Lott & Hutton (n.d.), "[e]ngaging in trademark parody is a little like shooting at the king. You had better be good at it, because if you attempt and fail, you are in big trouble." A trademark parody, while necessarily being derivative of the original work, must be clever enough to avoid a likelihood of confusion. As a result of this subtle balancing of trademark protection and trademark parody, courts have rejected the parody defense in cases in which the parodic use of the plaintiff's trademark has been deemed to cause consumer confusion (e.g., *Mutual of Omaha vs. Novak*, 1986; *Nike vs. "Just Did It" Enterprises*, 1993; *Dallas Cowboys Cheerleaders, Inc. vs. Pussycat Cinema, Ltd.*, 1979).

Over the past two decades, seminal cases such as *Univ. of Ga. Athletic Association v. Laite* (1985) and *Board of Trustees of University of Arkansas v. Professional Therapy Serv.* (1995) have demonstrated the successful application of the Lanham Act to college and university registered trademarks, particularly with respect to the likelihood of confusion element. More recent legal victories or settlements in many of the cases cited in the Introduction section of this article have further emboldened intercollegiate institutions to take an increasingly proactive and arguably aggressive stance toward companies that utilize registered trademarks without approval in conjunction with their goods and services.

THE LEGAL BATTLE OVER USE OF SCHOOL COLORS

The *Smack Apparel* and *Sinks* cases, specifically involving the protectability of color schemes, provide the latest legal battleground for the enforcement of collegiate marks. At the appellate level, the ultimate resolution of these two cases (assuming the parties do not settle) rests on the courts' analysis of the following questions: First, are color schemes used in conjunction with unlicensed apparel deserving of trademark protection based on a finding of non-functionality? Second, can colleges and universities establish secondary meaning with respect to their color schemes? Third, assuming affirmative answers to the first and second questions, how should the courts interpret and apply the Lanham Act's likelihood of confusion requirement in cases involving unlicensed merchandise? Fourth and finally,

what are the practical and legal implications of disclaimers, as well as the distinction between "officially-licensed" merchandise and merchandise that is not "officially-licensed," in the context of lessening or eliminating consumer confusion?

Facts and Holding in *Smack Apparel*

The plaintiffs in this litigation included several universities with high profile athletics programs, including Louisiana State University, Ohio State University, the University of Southern California, as well as the licensing agent for these schools and others, the Collegiate Licensing Company. The plaintiff "universities each own trademark registrations for both their names and their commonly used initials" (*Smack Apparel*, 2006, p. 655).

The defendants are a Tampa, Florida-based corporation, Smack Apparel Company, and its principal, Wayne Curtiss. Since 1998, Smack Apparel has produced merchandise that celebrates the athletic accomplishments of colleges and universities or, in some cases, pokes fun at the losses of rival teams (Land, 2006). Many of the t-shirts produced used the color schemes adopted by each of the schools.

In addition to protection of their name marks, over a century ago in each case, each plaintiff university adopted a particular color scheme to represent their school colors. Furthermore, many universities have successfully used the school colors to refer to their university (e.g., "purple and gold" for LSU). The thrust of the plaintiffs' argument was that sale of merchandise that contained the unique color schemes adopted by each university, in addition to other "symbols" which identify the universities (i.e. the school's initials), as well as alluding to the athletic accomplishments of the specific university, constituted unfair competition as well as trademark infringement, more specifically trade dress infringement, in violation of Section 1125(a) of the Lanham Act (*Smack Apparel*, 2006, p. 656). For example, one of the t-shirts at issue in the litigation alluded to Ohio State University's seven college football national titles by stating "Got Seven?" on the front of the t-shirt and "We do! 7 Time National Champs," with a depiction of the state of Ohio and a marker noting "Columbus, Ohio" on the back of the shirt (*Smack Apparel*, p. 655). Similar references were made in a "Got eight?" T-shirt acknowledging the eight national titles won by the University of Southern California (*Id.*).

A critical piece of information necessary to appreciate the significance of the *Smack Apparel* case, and the resulting implications for licensing of collegiate sports merchandise, is the chronology of events that led to filing suit. "The *Smack* lawsuit was in large part brought as a result of Smack

products sold in connection with the 2004 National Championship game between LSU and the University of Oklahoma played in New Orleans" (Siegal, B., personal communication, January 14, 2008). In fact, four of the designs for the six T-shirts at issue in the *Smack Apparel* litigation made reference to this particular championship game. The first shirt made reference to the University of Oklahoma. The front of the shirt contained the phrase "Bourbon Street or Bust" with the "ou" in Bourbon in a different typestyle font in a crimson and crème design, OU's well-recognized color scheme (*Smack Apparel*, p. 655). A second shirt contained the phrase "Show us your beads" with the "ou" also in a different font on the front of the shirt and "Sweet as Sugar" on the back of the shirt, an obvious reference to the Sugar Bowl playing host to the national championship game that year (*Id.*). A third shirt with the phrase "Let's make it Eight" made reference to the possibility that a win by Oklahoma in the Sugar Bowl that year would give them an eighth national football championship (*Id.*). Some of the "bragging" T-shirts produced by Smack Apparel also contained additional identifying features that would be attractive to fans of a particular team, including graphics or type referencing championship trophies won or scores from previous games in which the school competed (p. 655-656). In addition, each T-shirt produced by Smack Apparel also contained a "relatively small" "Smack" logo (p. 656). The plaintiffs asserted that Smack Apparel's merchandise violated several federal and state laws. This included claims for trademark infringement and unfair competition under the Lanham Act, unfair trade practices under the Louisiana Unfair Trade Practices and Consumer Protection Law (La. Rev. Stat. §51:1401, 2008), federal trademark dilution, state trademark dilution, common law trademark infringement, and common law trademark infringement (*Smack Apparel*, 2006, p. 656). The plaintiffs and defendants each moved for summary judgment on the federal and state claims (*Id.*).

The plaintiffs alleged that Smack Apparel engaged in unfair competition by selling shirts bearing the distinctive color schemes and other identifying symbols of the schools, which they assert is their intellectual property (*Smack Apparel*, 2006, p. 655). In considering the plaintiffs' claims of unfair competition found in Section 43(a) of the Lanham Act, the court noted that "[a]s a general rule, the same facts which would support an action for trademark infringement would also support an action for unfair competition" (*Smack Apparel*, p. 656). The plaintiffs described their marks as "color schemes in the context of merchandise that makes reference to the Plaintiff Universities or their accomplishments and is directed to their fans and other interested consumers" (p. 657). In determining whether color schemes were

protectable as trademarks, the court found "there is no question" they are protected (*Id.*).

The *Smack Apparel* (2006) court clearly followed what Haplern (2005) identified as the Supreme Court's "expansive approach" (p. 251) to trade dress protection. This approach originated with the Supreme Court's *Qualitex* (1995) decision and was later refined in *Wal Mart Stores, Inc. v. Samara Bros., Inc.*, (2000) which established the need to demonstrate secondary meaning in cases involving the protectability of color as a trademark.

The court then proceeded to determine whether the requisite secondary meaning had been established by utilizing the seven factor-test adopted by the Fifth Circuit in *Pebble Beach Company v. Tour 18 I Limited* (1998): (1) length and manner of the 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 (*Smack Apparel*, 2006, p. 541).

In applying the seven factors to the *Smack Apparel* case, the court found that the plaintiff universities "have used their color combinations for a lengthy period of time" and "market scores of items bearing their color schemes, logos, and designs" with sales of those items reaching into the millions of dollars (2006, p. 658). The court also noted the extensive advertising conducted by the respective universities, including reference to the school colors in magazines and newspapers (*Id.*). The defendants admitted that their selection of the color schemes, logos, and designs for their merchandise to refer to the various universities was intended to call to mind the university in the mind of the consumer, yet they denied the claim that they intended to confuse consumers into thinking that the universities manufactured the Smack T-shirts, a subtle factual distinction with a potentially significant legal impact when considering the defendant's intent in a likelihood of confusion analysis (*Id.*). Based upon its analysis of the factors enumerated above and finding no genuine issue of material fact, the court found that the plaintiffs' color schemes, logos, and designs had achieved secondary meaning (*Id.*).

The court then turned its analysis to determining "whether the challenged marks were likely to cause confusion" as to the source, affiliation, or sponsorship of the defendant's products or services (*Smack Apparel*, 2006, p. 657.). In order to determine whether there is a likelihood of confusion as to endorsement or sponsorship, the court applied the "digits of confusion" test set forth in *Fetzer v. House of Vacuums, Inc.*, (2004). The following seven factors are weighed under this test: (1) the type of mark allegedly infringed; (2) the similarity between those two marks; (3) the similarity of the products or

services; (4) the identity of retail outlets and purchasers; (5) the identity of the advertising media used; (6) the defendant's intent; and (7) any evidence of actual confusion (*Fetzer*, 2004, p. 484-485). The degree of care employed by the consumer is an eighth digit added by the court in *Sunbeam Products, Inc. v. West Bend Co.* (1997). In applying the test, "no one factor is dispositive and a finding of a likelihood of confusion does not even require a positive finding on a majority of these 'digits of confusion'" (*Smack Apparel*, 2006, p. 659).

The first digit of confusion (the type of the mark) refers to the strength of the mark. In analyzing this factor, the court must determine whether the mark is a "weak or strong mark" (*Smack Apparel*, 2006, p. 659). In the instant case, the court noted that the color schemes, logos, and designs of the universities are "extremely strong marks" and have "acquired secondary meaning in the context of reference to the plaintiffs' universities and or their accomplishments, which are directed to their fans and other interested consumers" (*Id.*). The court concluded that "although there are many uses of the universities' color schemes, logos, and designs by third parties, there is no indication that any third party used the marks in reference to the plaintiff's universities or their accomplishments" (*Id.*).

The second digit of confusion (similarity of the marks) is "determined by comparing the marks' appearance, sound, and meaning" (*Elvis Presley Enterprises, Inc. v. Capece*, 1998, p. 201). More specifically, "[t]he relevant inquiry is whether, under the circumstances of the use, the marks are sufficiently similar that prospective purchasers are likely to believe that the two users are somehow associated" (*Id.*). The court concluded that the plaintiffs' and defendants' marks are "virtually identical" given that "Smack's shirts bear the same color schemes and similar logos and designs as the plaintiffs, and their shirts bear logos and designs leaving no doubt that they refer to the plaintiff universities" (*Smack Apparel*, 2006, p. 660).

The third digit of confusion (similarity of the products or services) provides that "the greater the similarity between products and services, the greater the likelihood of confusion" (*Elvis Presley Enterprises*, 1998, p. 201). The court noted that "it is undisputed that both Smack and the universities market shirts bearing the same color schemes, logos, and designs" (*Smack Apparel*, 2006, p. 660). Smack Apparel, however, argued that their inclusion of irreverent phrases or slang comments, in addition to the colors, made the products sufficiently different from those of the plaintiffs (*Smack Apparel*). The court disagreed with Smack's conclusion, finding instead that "Smack's use of irreverent phrases or slang comments misuses the plaintiffs' reputation and good will, which is embodied in their trademarks" (p. 660).

The fourth digit of confusion (the identity of retail outlets and purchasers) can be analyzed using the rationale that "dissimilarities between the retail outlets 'lessen the possibility of confusion, mistake, or deception'" (*Moore Business Forms, Inc. v. Ryu*, 1992, p. 490). Here, the court noted while some of Smack's shirts are sold through its website, others are sold in retail booths set up near stadiums on football game days of the respective plaintiffs' universities as well as in retail outlets alongside plaintiffs' merchandise (*Smack Apparel*, 2006, p. 660). This led the court to find "no dissimilarity between retail outlets" (*Id.*).

The fifth digit of confusion (the identity of the advertising media used) is "highly probative of whether the mark creates a likelihood of confusion in relation to another mark" (*Elvis Presley Enterprises*, 1998, p. 197). In the instant case, "Smack admits that it participates in the same trade shows as plaintiffs and advertises and markets its shirts for sale at those shows" (*Smack Apparel*, 2006, p. 660). Thus, Smack Apparel's use of the marks in advertising at the same or similar venues as plaintiffs creates a likelihood of confusion (*Smack Apparel*, p.660-661).

In weighing the sixth digit of confusion (intent to confuse consumers), the court acknowledged that while Smack Apparel did not admit it intended to deceive consumers as to the source of the goods, it "admit[ted] that they used the school colors and 'other indicia' with the intent of identifying the university plaintiffs as the subject of the message expressed in the shirt design" (*Smack Apparel*, 2006, p. 661). Given this admission, the court found "[t]his factor weighs in favor of likelihood of confusion because defendants used the color schemes, logos, and designs of the plaintiffs with 'an intent' to 'rely upon the drawing power' in enticing fans of the particular universities to purchase their shirts" (*Id.*).

The seventh digit of confusion (actual confusion) requires an inquiry into "whether defendants have used plaintiffs' trademarks, and the public has identified those marks as those of the plaintiffs" (*Smack Apparel*, 2006, p. 661). In determining if actual confusion exists, the court referenced the plaintiff's survey evidence but noted such evidence was unnecessary as only likelihood of confusion need be established (*Id.*).

The eighth digit of confusion (the degree of care employed by the consumer) also weighed in the plaintiff's favor as the court found that Smack's T-shirts were relatively inexpensive and not purchased with a high degree of care (*Smack Apparel*, 2006, p. 661).

Upon weighing the eight digits of confusion, the court concluded that the plaintiffs had established a likelihood of confusion (*Smack Apparel*, 2006, p. 661).

The court then considered the defenses raised by Smack Apparel, including functionality, fair use, parody, and laches. In considering the functionality claims, the court found that because consumers purchase shirts bearing the universities' colors and logos "in order to show support for the particular university; there is no consumer demand without these identifying characteristics" (*Smack Apparel*, 2006, p. 662). Moreover, since the color schemes and logos "have no demonstrated value other than their significance to identify with the universities," the color schemes, logos, and designs are not functional (*Id.*).

The court then considered the argument that Smack Apparel's use of the universities' marks constituted nominative fair use. The court noted that "in order to avail itself of the shield of nominative use, the 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" (*Smack Apparel*, 2006 p. 662). Thus, there is no infringement so long as there is no likelihood of confusion (*Id.*). However, because plaintiffs demonstrated a likelihood of confusion, the nominative fair use defense is not applicable (*Id.*).

The owners of Smack Apparel also argued that the T-shirts they produce constitute parodies that are protected by the First Amendment. In fact, a motto which appears prominently on the Smack Apparel website states that their products are "Licensed only by the First Amendment" (Welcome to Smack Apparel, n.d.). Representatives for Smack Apparel claimed that because they do not use the school's trademarks and because the merchandise they produce constitutes a parody, their merchandise does not infringe the trademarks of the universities that are the subject of the T-shirts and does not require a license from the universities (Land, 2006). Despite such claims, Smack Apparel did "admit [in connection with the lawsuit] that they selected the color schemes, logos and designs for their shirts in order to refer to the universities and call them to the mind of the consumer although defendants deny that they intended to confuse the public into thinking the universities manufactured Smack's shirts" (*Smack Apparel*, 2006. p. 658). The court acknowledged, however, "instances where consumers have connected Smack's shirts to the universities, believing there to be some affiliation or sponsorship" (*Smack Apparel*, p. 660).

Finally, in considering the defense of laches, defined as "an inexcusable delay that results in undue prejudice against the defendant" (*Smack Apparel*, 2006, p. 662), the court found that "because defendants admit[ed] that they intentionally copied plaintiffs' color schemes, their bad faith deprives it of the ability to assert the equitable defense of laches" (*Smack Apparel*, p. 663).

Upon rejecting all of the Smack Apparel defenses, the court confirmed its decision holding Smack Apparel liable for intentional trademark infringement based on its use of the color combinations of the schools. Of particular note in this case is that, of the hundreds of t-shirts produced and sold by Smack Apparel, only six shirts (the so-called laudatory, or "bragging" t-shirts) were found to infringe. Furthermore, Smack did not utilize any registered marks or marks previously claimed by the schools on any of the six shirts found to infringe (in fact, the plaintiffs specifically refer to Smack's use of "symbols" that identify the universities). For instance, no school logos were used. Nor were school initials used, other than embellishing the "O" and the "U" in words such as "Bourbon" and "YOUR" on several shirts. Finally, the court's analysis of the likelihood of confusion factors resulted in the broadest scope of protection for school color schemes. In an attempt to reverse the ruling, Smack Apparel filed an appeal with the Fifth Circuit Court of Appeals, tentatively scheduled to be heard in June 2008.

Texas Tech v. Red Raider Outfitter adds fuel to Smack Apparel decision

The *Smack Apparel* decision was widely hailed by the plaintiffs as a landmark victory in the area of trademark protection for colleges and universities, and was followed shortly thereafter by a second favorable ruling on the protectability of color schemes in *Texas Tech v. Red Raider Outfitter* (2006). In the latter case, a federal judge ordered defendant Red Raider Outfitter, to pay Texas Tech University at least \$3 million for selling unlicensed clothing and novelty items with the color schemes, insignias, and slogans of the Texas Tech Red Raiders (*Texas Tech*, 2006).

The university alleged that the Red Raider Outfitter continued to sell Texas Tech merchandise after the school terminated its licensing agreement (Land, p. 1). Texas Tech alleged that the continued marketing of Texas Tech items after termination of the licensing agreement constituted "passing off unlicensed merchandise to unsuspecting buyers" (*Texas Tech*, 2006, p. 1). Texas Tech also alleged that Red Raider Outfitter also attempted to trademark the phrases such as "Raiderland" and "Wreck 'em Tech," which plaintiff alleged were identical to marks it has used for years (*Texas Tech*, p. 1). Similar to the *Smack Apparel* decision, the judge found the functionality doctrine inapplicable to the color schemes at issue (p. 17). The judge also found that use of the color scheme could confuse the public as to whether such items are "official" (p. 18). The court opined:

Clearly, a Texas Tech fan who enters [Red Raider Outfitter] store will be affected in the same way by an unlicensed 'Double T' coffee mug

as by a licensed one . . . [the] inventory, both licensed and unlicensed, is designed to rally school pride and bolster support for the University. The licensed items and the unlicensed items have an identical commercial effect: to serve as outward signs of support for Texas Tech University (p. 20).

Because of the similarity between Raider Red and the cowboy image used by Red Raider Outfitter, the court found that the company's owner intentionally attempted to confuse customers about the licensing of the products being sold. "In the present case, Texas Tech has produced summary judgment evidence that [the owner] knowingly placed tags on unlicensed products which indicated that the products were 'Officially Licensed' . . . Knowingly placing 'Officially Licensed' tags on unlicensed products clearly shows that the Defendant intended to confuse the prospective purchasers" (*Texas Tech*, 2006, p. 24-25). The court found that "each of the digits of confusion weighed in Texas Tech's favor," and therefore, clearly established the likelihood of confusion (*Texas Tech*, p. 26). The court ultimately found Red Raider Outfitter and its owner liable for trademark infringement, unfair competition, and for trademark dilution by blurring (p. 31). In March, 2007, Texas Tech and the owners of Red Raider Outfitter reached a settlement (Kaskela, 2007).

Facts and Holding of *Sinks*

Roughly two years after the decisions in *Smack Apparel* (2006) and *Texas Tech* (2006), both hailed by the collegiate licensing industry insiders and some observers as significant victories, a federal district court in Kansas, in ruling on summary judgment motions in *University of Kansas v. Sinks* (2008a), proffered a much different view as to the protectability of school colors as trademarks. In addition to providing a much more thorough analysis of the issues than that found in *Smack Apparel*, the decision also provides a much narrower interpretation of the scope of protectability of school colors and color schemes.

The University of Kansas (commonly and hereinafter referred to as "KU") owns several trademark registrations related to the names and nicknames of the university, its athletics program, and the university's Jayhawk mascot (*Sinks*, 2008a, p. 29). These registered marks include "Kansas," "Jayhawks," and several Jayhawk designs (*Id.*). "KU does not own a registered trademark for the name 'Hawk,' but from time to time, KU has used the term 'Hawks' as a shorthand for 'Jayhawks' " (p. 29-30). Perhaps most pertinent to the focus of this paper, "KU does not own a registered trademark for the

crimson and blue colors. But for more than one hundred years, KU has used the crimson and blue color scheme as part of its Jayhawk mascot and in connection with its educational and entertainment services, athletics, student life, advertising, events, and website" (p. 32). In addition, the media frequently refers to KU by its school colors as "the crimson-and-blue" (*Id.*).

Like most educational institutions with high profile athletics programs, KU does not manufacture any apparel directly, but rather licenses the rights to use its name and logo trademarks via CLC, which manages all aspects of licensing KU's marks on apparel and other products. "KU does not permit the use of offensive language or references to sex or alcohol on officially licensed products" (p. 33). As part of the obligation to oversee how its marks are displayed in the marketplace, "KU monitors authorized uses of its color scheme and has set standards to instruct KU representatives and licensees as to how the crimson and blue color scheme is to be presented" (*Id.*).

Defendant Larry Sinks, a previous KU licensee, applied for a license but was denied by CLC on behalf of KU in October, 1996. In January 2006, Victory Sportswear, owned by Sinks, opened Joe-College.com as a subsidiary business, selling "products that bear printed slogans and phrases that relate to college life and to KU in general" (*Sinks*, 2008a, p. 34). Joe-College.com is situated close to KU's campus in Lawrence, Kansas and markets its products exclusively via the Internet despite having both a retail store and online sales operation.

The average t-shirt at Joe-College.com sells for approximately \$15 and varies in color and design. Joe-College.com does not currently sell any KU licensed apparel; however, for a period of time, Sinks stocked some licensed merchandise he purchased from a licensee of KU which was displayed in his store until December 2006. Joe-College.com sells blue t-shirts that utilize many registered and unregistered marks associated with KU, as well as t-shirts bearing the colors red and blue. Some of Joe-College.com's products also contain offensive language and references to both sex and alcohol.

Notably distinct from the facts in *Smack Apparel* (2006) and *Texas Tech* (2006), the Joe-College.com retail store currently has more than 100 signs posted that make clear that the products for sale are "not licensed, approved, sponsored, or authorized by KU, or affiliated or associated with KU in any way" (*Sinks*, 2008a, p. 37). However, as of July 21, 2006, such disclaimers were not present at the store (*Sinks*, 2008a). "[S]imilar disclaimers were added to the Joe-College.com website" (p. 37). Factually important to the likelihood of confusion inquiry, "no consumers have ever asked Sinks, or . . . the manager of the Joe-College.com retail store, whether the designs sold there are licensed, approved by, or affiliated with KU. Nor have any consumers ever

expressed confusion to Sinks or [the store manager] about the products sold there" (*Id.*).

In a May, 2006, KU Director of Athletics Lew Perkins sent Sinks a letter requesting he discontinue production and sales of certain T-shirt designs that infringe on the University's trademarks, including the term Kansas, and cease using designs that are closely identified with KU (*Sinks*, 2008a, p. 38). Perkins emphasized that many of the designs sold by Sinks' company "were offensive to the university, or disparaged KU athletic programs or coaches" (*Id.*). Perkins specifically identified shirts that used the terms "Kansas," "Jayhawk[s]," "Hawk," the Jayhawk design, examples of those that are "offensive" including "Kansas Drinking Team," "Muck Fizzou," as well as examples of shirts which used the names of current student athletes and coaches (p. 39).

On August 16, 2006, the University of Kansas filed suit against Sinks, asserting claims for federal trademark infringement, federal unfair competition, federal trademark dilution, trademark infringement under Kansas statutory law, trademark dilution under Kansas statutory law, and common law trademark infringement and unfair competition (*Sinks*, 2008a). At issue were "approximately 140 designs utilized by defendants" (*Sinks*, p. 38-39). The plaintiffs later amended the complaint to add several T-shirts produced related to their bowl game bids, bringing the total number of shirts at issue to approximately 200 (Wicks, 2008).

In analyzing the cross motion for summary judgment on the trademark infringement claims under the Lanham Act, the court addressed the protectability of color schemes through use of trademark law:

Defendants begin . . . by arguing that plaintiffs essentially seek 'a monopoly over anything blue, or which bears terms referencing KU or any of KU's rivals.' They further argue that plaintiffs' marks are not protectable because they do not identify the source of the products or relate to the quality of the products. At bottom, defendants' challenge the distinctiveness of plaintiffs' color schemes, logos, and designs, and thus, their protectability (*Sinks*, 2008a, p. 48).

Critical to finding a valid trademark is the requirement that the mark "indicate[s] the source of the goods, even if that source is unknown" (15 U.S.C. §1127, 2008). The court also acknowledged that a critical piece of the inquiry is to be able to categorize the mark in terms of conceptual strength according to the five widely accepted categories. "[The] five categories of trademarks [are]: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful; generic being the weakest and fanciful being the strongest" (*Sinks*,

2008a, p. 81). The court found that while the "KU" and "Kansas" marks and the Jayhawk design marks were incontestable under Section 1065 of the Lanham Act and, therefore, were protectable as a matter of law, the "Jayhawk" mark was not since it had not been in use for five consecutive years (*Sinks*, p. 50). "An incontestable' mark cannot be challenged as lacking secondary meaning; such marks are conclusively presumed to be nondescriptive or to have acquired secondary meaning" (p. 32). This finding was significant because only four of the approximately 200 shirts complained about in the lawsuit contained these specific marks or very similar marks used by themselves without additional phrases or other identifying indicia. As for the remaining marks, the court ruled that "[t]he categorization of a mark is a factual question" with the factfinder having to determine "...what the perception of the purchasing public is" (p. 51).

The court then shifted its inquiry to those marks that were ruled to be not incontestable by statute but which have been used by KU for a substantial amount of time and that may have acquired secondary meaning or are inherently distinctive and are, therefore, protected under the Lanham Act (*Sinks*, 2008a, p. 54). With regard to the scope of trademark protection for color schemes, the court noted that "... the distinctiveness acquired by plaintiffs for its marks does not dictate a finding of liability against defendants for every blue or red shirt it produces with a possible reference to KU on it" (*Id.*). Rather, the court is required "to conduct numerous fact-intensive inquiries" (*Id.*) where the plaintiffs must proffer specific evidence of infringement because "the court does not find that plaintiffs' marks are amenable to generalization" (p. 55). This finding was a significant blow to KU's attempts to "lump" all of the Joe-college.com T-shirt designs together to be considered as potentially infringing. Instead, the court suggested that the different shirt designs must be considered in different categories of protection, depending on which marks they contain, which would hypothetically dictate different outcomes on the issues of liability for infringement.

The court then analyzed the likelihood of confusion factors laid out in *Sally Beauty Supply Co. v. Beautyco., Inc.* (2002) (the appropriate list of factors for cases decided by the 10th circuit), and "consider[ed] the impact of the disclaimers posted at the Joe-College.com retail store and on the website" (*Sinks*, 2008a, p. 56). "[T]he key inquiry is whether the consumer is 'likely to be deceived or confused by the similarity of the marks.'" (*Id.*).

Regarding the first likelihood of confusion factor, "similarity of the marks," the court analyzed the similarity between registered and allegedly infringing marks based on the levels of sight, sound, and meaning. The court acknowledged difficulty in evaluating this factor because the parties did not

provide the court with a detailed explanation of how the marks on officially licensed merchandise compares to those produced by Sinks. "Some shirts are alleged to contain identical marks to federally registered trademarks, while other shirts are allegedly infringing based on the combination of various registered and unregistered marks," noted the court (*Sinks*, 2008a, p. 58). However, the court was able to distinguish "a small amount of shirts singled out by KU that are substantially similar in design to certain KU marks and are substantially different than the remaining shirt designs at issue" (*Sinks*, p. 59). In analyzing those specific shirts that "contain substantially similar marks as certain KU marks found on officially licensed products," (*Id.*) "... [t]he [c]ourt finds that the similarities of these shirts to officially licensed KU products are overwhelming and weigh heavily in favor of a finding of likelihood of confusion" (p. 60).

In analyzing the remaining shirts at issue in the lawsuit, the court noted several similarities between the Joe-college.com shirts and the officially licensed shirts. These similarities included identical words on some of the shirts as well as similar color schemes to the officially licensed shirts. The court found it significant that

all of the remaining shirts that contain the mark 'Kansas' on the front contain additional language on the back. KU fails to point the Court to officially licensed materials that are similar in look, sound or meaning to the multitude of messages on the backs of these shirts, which contribute to the overall presentation of the marks (*Sinks*, 2008a, p. 62).

The parties fundamentally disagreed about whether the remaining shirts are confusingly similar:

KU argues that marks such as these, in conjunction with the crimson and blue color scheme, render the shirts similar enough to officially licensed products to cause confusion in the marketplace. KU urges that "[i]t is simply inconceivable that someone seeing a royal blue shirt in Lawrence, Kansas with the phrase 'Hawk Basketball' emblazoned on it would not consider it to be a shirt referencing KU's basketball program." (*Sinks*, p. 63)

Because of the differences between the various shirt designs and the officially licensed shirts, "the Court [was] unable to conclude that all of the shirts are similar or different as a matter of law" (p. 64). The court found that "a reasonable jury could reach different conclusions about each of defendants' T-shirt designs" (*Id.*). The defendants also highlighted the fact that "all of the allegedly infringing shirts contain the Joe-College.com logo, which KU

licensees' shirts do not have" (p. 65). The court found that this difference was not enough to find the shirts are not similar as a matter of law (*Id.*).

In comparing the similarity of the marks used on the slightly irreverent shirts manufactured by Sinks and KU's officially licensed products, the court summed up the basic legal determination that must be made:

[T]he overall look, sound, and meaning of the shirts is also different than the licensed shirts in that they reference either sex or alcohol, use irreverent language, [and] make insulting references to rival universities KU cannot deny that these are important differences in the overall presentation of the marks to consumers and it is undisputed that these references are neither condoned by KU nor used on officially licensed products (*Sinks*, 2008a, p. 66-67).

Given the similarities and differences between KU's marks and the marks used on the remaining shirts produced by Sinks, the court was unable to conclude as a matter of law that the marks were similar or dissimilar as a matter of law (*Sinks*, p. 67).

In examining the degree of care likely to be exercised by purchasers, the court's analysis "focuse[d] on the consumer's degree of care exercised at the time of purchase" (*Sinks*, 2008a, p. 50). While the defendants acknowledged the relatively cheap price of the t-shirts sold by Joe-college.com, they argued that "consumers exercise greater care in this context because the message on the t-shirt is more important to them than the price" (*Sinks*, p. 80). The court ultimately concluded that this factor tipped in favor of plaintiffs (p. 81).

Regarding the strength of the marks factor, the court again reiterated that "plaintiffs' insistence on lumping all of its marks together for purposes of this analysis [was] problematic . . . [because] [e]ach of these marks requires a separate examination in terms of where it falls on the conceptual strength scale" (*Sinks*, 2008a, p. 81-82). Thus, the court was "unable to conclude as a matter of law that the marks in question are either strong or weak" (*Sinks*, p. 86) so a genuine issue of material fact existed related to this factor.

Regarding the defendant's intent, the court analyzed "whether they intended to derive a benefit from the goodwill or reputation of KU; whether they intended to confuse" (*Sinks*, 2008a, p. 70). "Usually, parties show defendant's intent to confuse consumers by producing evidence that the defendant tried to 'pass off [his] product as that of another" (*Sinks*, p. 69). The court again separated the different shirt designs into categories and noted that for the first category of shirts (four designs) "the use of almost identical marks supports a conclusion that defendants intended to derive a benefit from KU's reputation, rather than rely upon their own" (p. 70).

Importantly, there is no evidence that defendants were trying to pass the remaining infringing shirts off as their own—the placement of the Joe-College.com mark, as well as the disclaimers posted in the store and online could persuade a reasonable jury that defendants were instead attempting to capitalize on their own reputation for supplying irreverent T-shirts that refer to KU but that are explicitly not authorized by KU (p. 71)

Regarding the defendant's intent factor, the facts in *Sinks* stand in stark contrast to the facts in *Texas Tech* in which Spiegelberg "knowingly placed tags on unlicensed University products indicating that they were 'officially licensed,' imitated packaging material, code numbers, and adopted similar distribution methods" (*Sinks*, 2008a, p. 71). The *Sinks* court also noted "[w]hile . . . defendants [may have] intended to derive a benefit from the reference to KU, a reasonable jury could conclude that defendants relied on their own publicity and reputation as makers of irreverent and, at times, offensive shirts, rather than KU's reputation or goodwill" (*Sinks*, p. 72). Therefore, the court was unable to make a determination on this likelihood of confusion factor.

Regarding the impact of the disclaimers in alleviating any potential or actual confusion, the court acknowledged that "[t]o the extent the disclaimers are offered to disprove point-of-sale confusion, the court finds that the disclaimers weigh against a finding of a likelihood of confusion" (*Sinks*, 2008a, p. 89).

Considering all of the likelihood of confusion factors as a whole, the court found that summary judgment was only appropriate for the four shirts "displaying marks that are overwhelmingly similar to KU's marks" (*Sinks*, 2008a, p. 90). "These striking similarities trigger a presumption that defendants intended to infringe. These two factors weigh so heavily in favor of a likelihood of confusion that no reasonable jury could find otherwise" (*Id.*). Thus, plaintiff's summary judgment motion on the trademark infringement claims was granted for those four T-shirt designs only. Regarding the remainder of the shirt designs (accounting for the vast majority of the shirts), the Court could not conclude as a matter of law that the likelihood of confusion factors tipped in favor of either party. Therefore, both cross motions for summary judgment were denied as to the trademark infringement claims on the bulk of the remaining T-shirts at issue (p. 91).

On July 14, 2008, a federal jury found *Sinks* and the other defendants liable for federal trademark infringement, federal unfair competition, and federal trademark dilution of the University of Kansas's marks (*University of Kansas and Kansas Athletics, Inc. vs. Sinks et al.*, 2008b, p. 1). The jury

determined that 54 of the 206 shirts infringed and that 11 of the 206 shirts diluted (*Sinks*, 2008b). The jury also found the defendants liable for state trademark infringement and state trademark dilution and injury to business reputation (*Sinks*, p. 3). The jury also found the defendants liable for common law trademark infringement and unfair competition (p. 4). The jury's rationale for finding certain shirt designs to be infringing while others not to be infringing is unclear since only the jury verdict form is provided as guidance. For example, the infamous "Muck Fizzou" design was found to be neither infringement nor dilution (p. 33). Ironically, T-shirt with the phrases "Kansas XXL Drinking Team" (p. 31) and "Kansas Co-ed Naked Beer Pong" (p. 35) were found to be neither infringement nor dilution while "Kansas Swim Team" showing sperm cells swimming was found to be both infringement and dilution (p. 31). In addition, some shirts containing the color schemes of the university were found to be infringing while others were not so no conclusions can be drawn from the jury verdict form on the role that color played in determining infringement or dilution.

In terms of monetary recovery, the jury found actual confusion and unfair competition with regard to the trademark infringement claims and actual dilution with regard to the dilution claims and awarded \$8,250 in actual damages (*Sinks*, 2008b, p. 94). The jury further found *Sinks* and the other defendants acted willfully and in bad faith and determined that \$119,087.50 in profits should be awarded to plaintiffs (*Sinks*, p. 94). The jury declined to award punitive damages on the state law claims (p. 95).

While the reasoning behind the jury's verdict on the various shirt designs may never be known, it is important to recognize that "the majority of Joe-College T-shirts they judged —roughly 75 percent of the 206 shirts — did not violate KU's trademark or dilute the trademark in the marketplace" (Bauer, 2008, p. 1). Furthermore, "the damages awarded were about one-fourth of what the university asked for in the lawsuit" (*Id.*). The jury's verdict was hailed as a "win-win" for both sides in that it allows *Sinks* to remain in business and produce the shirts Joe college.com is known for while also allows the university to claim victory over the finding that *Sinks* and the other defendants willfully infringed KU's marks on some of their shirt designs (Bauer).

DISCUSSION

Although the facts were fairly identical to those raised in *Smack Apparel* and *Texas Tech*, the court in the *Sinks* case adopted a much different approach in its analysis of the legal issues. As discussed in further detail below, the two

divergent opinions regarding the use of registered trademarks on apparel, and more specifically the protectability of color schemes, reflect the ongoing legal tension between the granting of increased trademark protections for collegiate licensing programs versus a more narrowly focused application of the Lanham Act's likelihood of confusion standard.

The courts in *Smack Apparel* and *Texas Tech* focused predominantly on the color scheme issue, finding 1) that the color schemes served as an indicator of source or sponsorship, 2) that the color schemes had acquired secondary meaning deserving of trademark protection, and 3) that the color schemes were non-functional. As a result, these courts essentially skirted the issue of the overall "message" of the alleged infringing apparel indicating that the First Amendment defense may not be as viable in true "merchandise" cases such as *Smack Apparel*, as in cases involving artistic merchandise, such as a painting. Conversely, the court in *Sinks* placed much more emphasis on the alleged infringing shirts in their entirety, taking into account not merely the color schemes but the messages and logos on each shirt (including the Joe College logo). The *Sinks* court thus concluded that "K.U. cannot deny that these are important differences in the overall presentation of the marks to consumers" (*Sinks*, 2008, p. 66). Thus, a genuine issue of material fact exists about whether these shirts are so similar that they would "be confusing to the public when singly presented" (p. 67). Furthermore, the *Sinks* court found there to be a genuine issue of material fact about whether the marks had acquired secondary meaning or were inherently distinctive and thus protectable, stating, "...the distinctiveness acquired by plaintiffs for its marks, does not dictate a finding of liability against defendants for every blue or red shirt produced with a possible reference to K.U. on it" (p. 54).

The courts also differed in their application of the "intent factor" which implicates the likelihood of confusion analysis. Whereas the court in *Smack Apparel* placed heavy weight on the defendant's admitted intention to refer to the plaintiff universities, the *Sinks* court applied a much more narrow approach, stating: "While it may be undisputed that defendants intended to derive a benefit from the reference to KU, a reasonable jury could conclude that defendants relied on their own publicity and reputation as makers of irreverent and, at times, offensive shirts, rather than KU's reputation or goodwill" (*Sinks*, 2008, p. 72). Therefore, while the *Sinks* court found a likelihood of confusion on the limited set of T-shirts, the court held that "similarity does not support an inference of intent as to the remaining majority of defendant's marks" (p. 70-71). Furthermore, the court held that "evidence that Sinks was aware of K.U.'s trademarks, alone, is insufficient to establish intent to infringe" (p. 72).

The courts also took divergent views on the significance of disclaimers. While the courts in *Smack Apparel* and *Texas Tech* in essence never reached the issue of the use and effectiveness of disclaimers in curing consumer confusion, the *Sinks* court found sufficient evidence that the defendant's prominent use of disclaimers could weigh against a finding of a likelihood of confusion. Hence, unlike the courts in *Smack Apparel* and *Texas Tech*, the *Sinks* court ultimately chose to focus not as much on the issue of color schemes as protectable trademarks, but instead on the issue of consumer confusion.

The courts conflicting analysis regarding the protectability of school color schemes as seen in the *Smack Apparel*, *Texas Tech* and most recently *Sinks* cases, sets the stage for a potential resolution of the growing tension within the collegiate licensing industry that has already been the focus of several law review articles examining the application of the functionality doctrine and likelihood of confusion analysis to collegiate merchandise. These legal scholars make persuasive arguments that, in essence, the pendulum has swung too far in favor of the collegiate licensing industry in terms of the application and scope of the Lanham Act.

Withers' (2004) argument focused primarily on prior courts' interpretation and application of the likelihood of confusion requirement that has, in essence, established two ends of a spectrum. In illustrating how the pendulum has shifted toward the collegiate licensing industry, he analyzes a "family" of cases, all involving sports merchandise, (*Boston Professional Hockey Ass'n v. Dallas Cap & Emblem* (1975), *National Football League Properties v. Wichita Sportswear* (1982) and *Univ. of Ga. Athletic Ass'n v. Laite* (1985)), all of which have essentially held that unauthorized use of a mark is enough; "the consumer need not be confused as to whether the trademark owner sponsored the item bearing the mark; rather, the consumer need only believe that the trademark appearing on the item is the trademark of the entity with whom the consumer associates the product, regardless of who owns it" (Withers, p. 441). At the opposite end of the spectrum is what Withers refers to as the "*Job's Daughters*" family of cases (including, *International Order of Job's Daughters v. Lindeburg* (1980), *University of Pittsburgh v. Champion Products* (1982), and *Board of Governors of the University of North Carolina v. Helpingstine* (1989)). This line of cases "place[s] more faith in the consumer" (p. 446), and provides a much more rigorous and realistic application of the likelihood of confusion doctrine. In arguing in favor of the legal rationale in the *Job's Daughters* line of cases, Withers concluded:

Whether the consumer believes that the trademark originated in the entity owning it is irrelevant; of course, the consumer believes that to

be the case. That assumption does not indicate that the consumer buys the product because of such a belief. The reasoning of the "*Job's Daughters*" family of cases is therefore preferable because those courts recognized that consumers generally do not purchase items with the belief, mistaken or not, that the entity whose trademark appears thereon sponsored the products. The "*Job's Daughters*" court themselves noted that consumers often do not even care whether an item is sponsored by the entity whose trademark is used or whether the item is licensed. Therefore, if consumers do not care whether the item is sponsored by the entity, then there is no likelihood of confusion (p. 454).

In discussing the distinction between "officially-licensed" and non-licensed merchandise, Withers (2004) further advocated for courts to uphold the ability of disclaimers to cure potential consumer confusion. In referring to disclaimers, Withers concluded, "[w]hen the seller has removed all confusion from the mind of a reasonable consumer then he has also defeated the trademark owner's cause of action for unfair competition or trademark infringement. Likelihood of confusion is the sine qua non of the action, and where there is no confusion, there likewise can be no cause of action" (p. 456).

In an article more generally focused on the licensing industry and public policy, Dogan and Lemley (2005) argued against judicial recognition of a so-called "merchandising right" that would provide trademark holders with far broader rights over their marks than was intended by the Lanham Act. The authors note what they perceive as the misapplication of trademark law in cases in the 1970s and 1980s that "established merchandising rights with little regard for the competing legal or policy concerns at stake" (Dogan & Lemley, p. 464). The licensing process, whereby an item becomes "officially-licensed," thereby creates a presumption of trademark infringement and, in turn, a merchandising or licensing right for the trademark holder for any uses which are not licensed or authorized. Moreover, the sport licensing industry has taken the position that because sport leagues are in the business of generating revenues, and because licensing generates royalties, leagues and teams as trademark holders are entitled "to control any uses [of their marks] that benefit from its mark's goodwill" (Dogan & Lemley, p. 477). This position is flawed because it significantly expands the scope of trademark protection beyond the original function of trademarks, that the mark serve as an identifier of the source of origin of the goods. "When a trademark is sold, not as a source indicator, but as a desirable feature of a product, competition suffers – and consumers pay – if other sellers are shut out of the market for that feature" (Dogan & Lemley, p. 465). In supporting limitations on trademark

(merchandising) rights in the sports licensing realm, the authors cited to *Wal Mart Stores, Inc. v. Samara Bros.* (2000), the most recent Supreme Court decision regarding the protectability of colors: "Absent a 'consumer predisposition to equate the feature with the source', the mark is not serving as a trademark, and its use by others cannot infringe" (Dogan & Lemley, p. 497). In arguing against the watering down of the functionality doctrine or likelihood of confusion requirement that would further extend the so-called merchandising right for sport leagues, the authors conclude:

[W]e would eliminate the presumption of a merchandising right and put courts to the task of determining whether, under the circumstances, a particular use was in fact likely to confuse consumers as to source or sponsorship. If not, the competitor ought to have access to the mark as product without incurring the cost of labeling itself as an "unofficial" product. If confusion is likely, a disclaimer will ordinarily resolve it. . . . And when there is no consumer confusion at all, the assertion of a pure right to control use of the mark for no other reason than because it is "mine" is at odds with trademark theory and good public policy (p. 506).

Finally, Tschura (2007) commented most recently, having the benefit of the *Smack Apparel* decision in hand, citing the case as "exemplifying the aggressive posture" of schools seeking to prevent unlicensed use of school colors and other indicia (p. 874 n.3). Tschura built upon the notion that the pendulum has swung too far in favor of the collegiate licensing industry, decrying what he terms the "granting [of] broad sweeping property-like rights to the mark holders" that thwarts the underlying pro-competitive goal of trademark law (Tschura, p. 896). While conceding that "many color schemes have often acquired secondary meanings" (p. 889), he argued convincingly (relying in large part on the *Job's Daughters* decision) that school colors nonetheless serve more as "functional aesthetic components" (p. 889) or alternatively as an expressive function than as a designation of origin or sponsorship.

As for the likelihood of confusion issue, Tschura (2007), similarly to the legal commentators cited above, viewed the much bally-hooed use of "Officially-Licensed" labels as (ironically) sufficiently protecting consumers from confusion and added that "[p]erhaps the placement of prominent and conspicuous disclaimers on 'unofficial' collegiate merchandise can further satisfy any real concerns as to confusion while still satisfying trademark law's ultimate goal of providing consumers with informed choices" (p. 886). Tschura concluded:

In situations where consumers are not likely to be confused as to source, sponsorship, or affiliation either because it really does not matter to them or because it is otherwise clear due to the absence of any indicia of sponsorship [i.e., "officially-licensed" labels], there is simply no justification for granting the mark holder a monopoly on such goods. . . . Capitalizing on a market, a fad, or even the goodwill created by others, . . . is simply not prohibited in the absence of confusion. There is scarcely a business in existence that does not, in some manner, 'reap' some benefit arising out of the existence of another business" (p. 896)

It remains to be seen the extent, if any, to which the scholarship of Withers (2004), Dogan & Lemley (2005) and Tschura (2008), as well as the present authors, will inform the appellate courts who are left to grapple with the issue of the protectability of school colors.

CONCLUSION

The lower court's 2006 decision in *Smack Apparel* created a shakeup within the collegiate licensing industry, with the pendulum of trademark protection arguably swinging mightily in favor of colleges and universities upon the court's finding that color schemes were subject to trademark protection. The *Texas Tech* decision, to a lesser extent, re-affirmed the notion that schools were "winning the battle" against unlicensed merchandisers.

However, with the *Sinks* court ruling that only four of 200 T-shirts were infringing, the pendulum appears to have swung back to a more balanced point, whereby, absent the use of marks similar to those used by the universities on officially licensed merchandise, merchants of unlicensed merchandise utilizing school colors can at least get beyond summary judgment to a jury to determine whether likelihood of confusion exists, viewed by the majority of courts as a question of fact (Kirkpatrick, 2005).

The juxtaposition of the court's decision in *Smack Apparel* (and subsequent confirmation in *Texas Tech*) with that in the *Sinks* case leaves the collegiate licensing industry squarely at a crossroads with respect to the protectability of school color schemes, particularly with respect to their use on apparel. Decisions that were initially hailed as "landmark victories" for the collegiate licensing industry have been put in doubt given the better rationalized analysis and decision in *Sinks*. It remains for future appellate courts to determine what is the more appropriate manner in which to view the protectability of school color schemes.

Ultimately, and assuming that the circuit courts agree to follow the same rationale, the resolution of this legal conundrum will have a significant impact on the collegiate licensing business. It will either provide more expansive trademark rights to colleges and universities (extending the notion of property-like rights as suggested by the most recent legal scholarship), or provide much greater latitude and commercial freedom for companies that engage in the manufacture and sale of unlicensed merchandise. Armed with the three most recent decisions discussed in this paper, as well as a rich and still evolving body of legal scholarship in this area, the outcome of this *color*-ful debate will ultimately be decided by the appellate courts and will undoubtedly provoke ample debate amongst all stakeholders in the licensing of collegiate sport merchandise.

ABOUT THE AUTHORS

JOHN GRADY is an Assistant Professor in the Department of Sport and Entertainment Management at the University of South Carolina, where he teaches courses in sport law, risk management, and business law. He earned his Ph.D. from Florida State University, J.D. from the Florida State University College of Law, and B.S. in Management with Honors in Finance from Penn State University. His research interests focus on intellectual property issues in sport, specifically right of publicity and trademark, as well as ADA compliance in sport and entertainment venues.

STEVE MCKELVEY is an Associate Professor in the University of Massachusetts Amherst Sport Management department. He teaches courses in sport law, sport marketing and sales strategy. His research focuses on the intersection of sport marketing and the law, with a special emphasis on intellectual property law issues. He received his J.D. from Seton Hall School of Law, his M.S. in Sport Management from the University of Massachusetts Amherst, and his B.A. in American Studies from Amherst College.

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