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## University Trademarks: Let's Get Down to Business!

By Kevin R. Casey

### PART II

*This three-part article focuses on how universities parlay trademarks into several benefits. In this second installment, read about enforcement against third-party merchandise.*

Ten recent cases highlight the variety of trademark enforcement actions taken by universities against (at least alleged) trademark infringers. These cases are summarized below in reverse chronological order. As we now know, such actions may be necessary to protect the universities' trademarks.

#### 1. Ohio State University (First of Two; See Case 10 Below)



When The Ohio State University and the University of Oklahoma meet on the field, two of the most tradition-rich programs in college football history do battle. On August 29, 2018, however, the two schools found themselves in a trademark battle because, on that date, Ohio State filed Opposition No. 91243311 with the TTAB. Ohio State has asked the Board to refuse Oklahoma's application to register the image on the left (above), described as "a drum major marching while leaning back with head tilted back," in connection with entertainment services, namely, live performances by musical bands. Oklahoma claims to have used the image as a service mark since August 1, 2001.

The issue? The uniform of the drum major has the letter "O" on the chest. Ohio State has registrations for what it calls "the Block O Mark" (depicted on the right above), which it claims to have used since 1898. Ohio State characterized the importance of the Block O Mark in its Notice of Opposition as follows:

Today, the Block O Mark is the heart of the branding and image of Ohio State and is used in connection with all products and services offered and provided by Ohio State,

including educational, athletic, recreational, and musical. Indeed, the Block O Mark is permanently displayed in the middle of the football field at Ohio Stadium where millions of viewers have seen the Ohio State Buckeyes football team play its home games and have cheered on Ohio State's marching band as it performs its famous "Script Ohio."

Ohio State asserts that Oklahoma's drum major image is highly similar to Ohio State's Block O Mark such that confusion is likely. Ohio State wrote, "The relevant consumer base, such as fans of collegiate athletic and musical band competitions, would presume a connection to Ohio State when confronted with the applied-for mark." Like many collegiate sports programs, Oklahoma has long used a blocky font for its acronym, but the school typically goes by "OU" rather than "O" alone, a point Ohio State mentioned in its opposition: "The use of a stand-alone block 'O' across the chest of the shirt of the drum major in [Oklahoma's] applied-for mark is inconsistent with the actual uniform worn by [Oklahoma's] drum majors during musical performances, such that the likelihood for confusion as to source is exacerbated."

## 2. University of Arkansas



On June 26, 2018, the University of Arkansas filed suit in Illinois federal court seeking to stop what it claimed are widespread online sales of counterfeit Razorbacks merchandise. Board of Trustees of the University of Arkansas v. The Partnerships and Unincorporated Associations Identified on Schedule A, No. 1:18-cv-04415 (N.D. Ill.). The suit claimed a "massive network" of overseas online stores have been selling counterfeit University of Arkansas sports merchandise to sometimes-unsuspecting U.S. customers and asked the court to, among other things, take away the alleged counterfeiters' online domain names and order internet platforms and search engines to shut them down. The suit claimed a number of organizations and individuals based in China and other countries have been operating websites selling counterfeit Razorbacks merchandise, operating under fictitious names, and changing internet domains, online accounts, and hosting services when they receive notice of lawsuits.

Specifically, the complaint stated: "Internet websites like the defendant internet stores are estimated to receive tens of millions of visits per year and to generate over \$135 billion in annual online sales." The complaint claimed

that similarities between the websites used to sell the merchandise indicate some kind of relationship exists between the defendants. "In addition, the counterfeit Razorbacks products for sale in the defendant internet stores bear similarities and indicia of being related to one another, suggesting that the counterfeit Razorbacks products were manufactured by and come from a common source and that, upon information and belief, defendants are interrelated." The university claimed the sites are designed to mimic legitimate retailers and use various techniques to appear at or near the top of search engine results, confusing customers into thinking they are purchasing licensed merchandise.

In addition to demanding \$2 million in statutory damages per trademark violation, the university asked for a court order either transferring the domain names listed in the suit to an owner of the university's choosing or permanently disabling them. It also asked for an injunction ordering online marketplaces and social media platforms to stop providing services and displaying ads for the defendants and ordering search engines to remove links to the named domain names from their indexes.

## 3. Western Kentucky University

In 1979, Western Kentucky University (WKU) student Ralph Cary created and introduced "Big Red," which has become the trademarked mascot of WKU's sports teams. "Gabibbo" is an Italian mascot for the Mediaset-controlled channel Canale 5, created in 2000 by Antonio Ricci. Gabibbo's main role has been in the programs Paperissima and Striscia la notizia, but he has appeared in several other Canale 5 programs. He is an on-screen comic who takes up consumer complaints and has spawned a hit album, a book, and other material. See <https://en.wikipedia.org/wiki/Gabibbo> (visited June 25, 2018). A comparison between Big Red (left) and Gabibbo (right) follows:



The legal battle began back in 2003, when WKU and the companies that license Big Red internationally filed a \$250 million lawsuit against the Mediaset company and Antonio Ricci, the creator of Gabibbo, in Italy. WKU asserted that Gabibbo is a copy of Big Red, supporting its claims of trademark and copyright infringement. Ricci did not help his case during an interview with Novella 2000,

in which Ricci stated that he created Gabibbo after seeing WKU's mascot, further adding that Gabibbo is in fact, "(an imported) Big Red." Ricci later claimed that he was joking.

WKU prevailed in the lower courts. On December 12, 2007, however, the Italian defendants were found not liable for infringement by the Court of Appeals in Milan. The Milan court held that the two mascots are similar but not the same. On June 7, 2018, the decision was overruled and remanded by the Italian Supreme Court. The case is now headed back to the Milan Court of Appeals.

#### 4. Duke University



Duke takes an aggressive approach to policing its marks, and is one of the most prolific Trademark Trial and Appeal Board ("TTAB") litigants in the country. The university files many cases each year opposing attempts to register marks involving "Duke," "Blue," or "Devil." In the past year, Duke filed cases challenging a "Duke's Chophouse" restaurant, an "Uncle Duke's" beer, "P-Duke Power" electronics, and a "Bluefood" brand of food and beverages. Perhaps most notably, in February 2018, Duke filed Opposition No. 91239624 against an application by Korean electronics giant LG Electronics Inc. to register "Duke (Stylized)" as a trademark for various mechanical parts, namely compressed air pumps, electric rotary compressors, and compressors for refrigerators. TTAB Electronic Filing System Tracking number: ESTTA878752. Duke asserted both likelihood of confusion and dilution with twenty-four of its registered marks (and its common law, or unregistered, rights in the "house" marks "Duke" and "Duke University"). Rather than contest the opposition, LG Electronics expressly abandoned its application and, therefore, Duke withdrew the opposition.

#### 5. University of Virginia



The University of Virginia (UVA) filed Opposition No. 91238899 with the TTAB in January of 2018 against Super

Bakery Inc. of Pittsburgh, Pennsylvania, a national food service firm that applied to register "Cavalierade" as a trademark for "powders used in the preparation of sports drinks." TTAB Electronic Filing System Tracking number: ESTTA870327. UVA argued that Super Bakery's mark was likely to cause confusion with the mark "Cavaliers," which UVA has used as the nickname of its sports teams since 1923. More specifically, UVA has used and federally registered the mark "Cavaliers," and a related family of marks, in connection with various services and goods, including the organization and administration of athletic events. Further, UVA licenses the marks "Cavaliers" and "Virginia Cavaliers" in connection with a wide variety of consumer products, including beverage containers. Joining previous opposers Duke University and the University of Arkansas, UVA was not the first entity to oppose Super Bakery, which in recent years has filed applications for dozens of "-ade" trademarks linked to professional and collegiate team names. When Super Bakery agreed to amend its pending application Serial No. 87/454,978 to clarify and limit the identification of goods to "powders used in the preparation of sports drinks, the foregoing not for use in connection with any collegiate institution," UVA withdrew the opposition.

#### 6. University of Texas



Just after Christmas, on December 27, 2017, the University of Texas (UT) filed Opposition No. 91238611 with the TTAB to protect its famous "Hook 'em Horns" hand gesture. TTAB Electronic Filing System Tracking number: ESTTA867484. A California company named Tan Cha - Hi Tea, Inc. applied to register a mark described as "a hand gesture with the index and pinky up and the rest of fingers folded" for restaurant services:



UT asserted likelihood of confusion, dilution by blurring, and a false suggestion of connection with UT. The applicant's design mark looked much like the gesture that UT fans have used for years. "The UT Hand Design Mark received its origin more than sixty years ago when students and others at UT began using the hand signal, where students

and other UT fans raise one hand in the air with the palm facing forward, the index and little finger extended, and the middle and ring fingers held down with the thumb.”



UT has also registered the mark for decals, stickers, and shirts. Tan Cha - Hi Tea, Inc. chose not to contest the opposition and, therefore, the TTAB entered judgment by default against it and sustained the opposition.

The December opposition followed action by UT against a higher-profile set of “horns.” On June 9, 2017, Kiss lead singer and frontman Gene Simmons applied to register the iconic but similar-looking rock ‘n’ roll “horns” – “a hand gesture with the index and small fingers extended upward and the thumb extended perpendicular.” Simmons sought to register the mark for “entertainment, namely, live performances by a musical artist; personal appearances by a musical artist,” which was reportedly first used during his band’s 1974 “Hotter Than Hell” tour. Days later, UT President Greg Fenves tweeted “sorry” at Simmons, but added that the school had been doing its horns “since the 50s – more than 20 years before Kiss got going.” Simmons abandoned his application on June 20, 2017.

## 7. University of Michigan



In November of 2017, the University of Michigan (UM) opposed an “intent-to-use” application filed by an individual residing in Scottsdale, Arizona, T. Michael McGuire d/b/a Beat Meechigan, who sought to register the mark “Beat Meechigan” for T-shirts. Opposition No. 91237661, TTAB Electronic Filing System Tracking number: ESTTA856772. The opposition focused on an historical “different pronunciation” of UM’s name that the university asserted has become “synonymous” with its sports programs. UM asserted likelihood of confusion and dilution with both its registered “Michigan” marks and the unregistered mark “Meechigan” – all used in connection with T-shirts. According to UM, the “Meechigan” pronunciation refers to the way that legendary Fielding H. Yost, a native of West Virginia, pronounced the state’s name during his tenure as Michigan’s football coach beginning in 1901. In memory of Yost, longtime Wolverines broadcaster Bob Ufer used the “Meechigan” name so often that “Ufer became remembered



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for being the voice of ‘Meechigan’ football.” “Yost’s and Ufer’s reference to Michigan as ‘Meechigan’ was picked up and carried on by Chris Fowler, a television sports broadcaster, who hosted ‘College Game Day’ for national college football audiences on the ESPN television network until 2014,” UM asserted. “This national exposure of Michigan’s athletic programs as ‘Meechigan’ has resulted in ‘Meechigan’ being synonymous with ‘Michigan’ in the minds of college football fans and the general public.” Mr. McGuire chose not to contest the opposition and, therefore, the TTAB entered judgment by default against him and sustained the opposition.

## 8. University of Kentucky



In September of 2017, the University of Kentucky (UK) opposed an application by an individual named Sanjeev Vohra from New Delhi, India, to register “Kentucky Blue” as a trademark for wines, distilled spirits, and liqueurs. Opposition No. 91236653, TTAB Electronic Filing System Tracking number: ESTTA845510. UK uses blue and white as its “official school colors,” and has registered several marks including the words “Kentucky” and “Blue.” Registration of the applicant’s mark allegedly would create a likelihood of confusion and falsely suggest connection with UK. Moreover, UK asserted, registration by the applicant would be particularly confusing because UK has licensed the famed bourbon distiller Maker’s Mark to produce commemorative bottles of bourbon featuring famous teams and basketball coaches, like Adolph Rupp and John Calipari. “The Maker’s Mark-brand commemorative bottles typically utilize a distinctive Kentucky blue dripping wax seal over a white dripping wax seal in place of the Maker’s Mark federally protected and signature red dripping wax seal.” As of June 20, 2018, the opposition was pending.

## 9. University of Tennessee



In August 2017, the University of Tennessee (UT) filed Opposition No. 91235924 with the TTAB asserting common law (unregistered) rights in the acronym “GBO,” which stands for “Go Big Orange,” in connection with clothing. (UT also asserted a pending application, Serial No. 87/192,044) to register “GBO” for clothing items.) TTAB Electronic Filing System Tracking number: ESTTA837209. The case was filed against a bodybuilding company called Big E Bodz Productions, LLC of Sugar Land, Texas, which filed an “intent-to-use” application to register the mark “GBO ATHLETES FIRST & Design” as a trademark for clothing (namely hats, sweatshirts, and T-shirts) and as a service mark for “competitions in the field of fitness.” UT asserted likelihood of confusion, dilution, a lack of a bona fide intent to use the mark, that Big E is not the rightful owner of the mark, and fraud on the PTO. UT opposed only the clothing aspect of the application, and the PTO has since allowed the application for fitness competitions. Big E Bodz Productions chose not to contest the opposition and, therefore, the TTAB entered judgment by default against it and sustained the opposition.

## 10. Ohio State University (Second of Two)



The Ohio State University filed a federal infringement lawsuit against a clothing retailer that it alleged sold T-shirts aimed at confusing the school’s nearly half-million alumni. The Ohio State University v. Lamp Apparel, LLC, Case No. 2:17-cv-00516-MHW-EPD (S.D. Ohio June 14, 2017). The action asserted trademark infringement, counterfeiting, unfair competition, passing off, and dilution by tarnishment under the Lanham Act, 15 U.S.C. § 1114, § 1125(a), and § 1125(c), relating to the unlawful appropriation of Ohio State’s registered and common law trademarks by defendant in its sale of T-shirts and other merchandise online. Not only was Lamp Apparel selling shirts featuring school colors or references to “Buckeyes,” Ohio State claimed, but also less traditional trademarks like “O-H-I-O” spelled out by fans’ outstretched arms. “When consumers throughout the nation (or world) hear the word ‘Buckeye’ in connection [with] college athletics, hear the words Buckeye Battle Cry or the fight song, or see the words ‘Buckeye Battle Cry’ or the O-H-I-O cheer, they immediately associate that phrase as indicating origin with Ohio State and its athletic teams and band.” The two parties reached a consent agreement in October 2017, and the company no longer sells any Ohio State-linked merchandise.

**Stay tuned for Part III in the series.**