To: Ty Herrington

From: Jesse Wallace

Re: Proposal

Date: 11/02/2012

**Overview:**

I am proposing a written paper as my final artifact for the Intellectual Property course LCC 3843. This proposal will consist of six sections: an introduction, motivating factor of interest, legal basis, product description, implementation, and a conclusion.

**Introduction:**

This document is a proposal to create a paper which will cover a progressively more prevalent issue involving trademark brand and logo use between high school and college institutions. As a second year business management major at the Georgia Institute of Technology, I chose this topic because of my strong interests in trademark policy and also the sports industry. The main purpose behind this written artifact is to bring awareness on the social imbalance of the issue and to examine the legal aspects behind what is a fairly new and unresolved trademark policy concern. With the completion of this paper, my overall goal is to piece together the complexity of this situation from a legal and moral stand point and to exhibit the significance of addressing this issue now rather than later. Through a set schedule and research method of which I continue to develop, I plan to form a series of revisions in pursuit of a final paper artifact. This project is undoubtedly feasible, supportable, and in my opinion something that could be valuable knowledge for trademark policy proponents, high schools, and university institutions.

**Problem, Motivating Factor of Interest, or Question:**

As more and more big name universities become aggressive in their trademark protection policy, there is a significant urge for high schools and the general public to become more informed on the issue as well. In most dispute cases that have taken place up to this point, high schools do not have the legal power or resources to go up against these large institutions. Instead, they usually decide to cut their losses and fork up the thousands of dollars required to alter all aspects of the trademarked item within their school. Because of this, I feel as though some high schools are being unfairly targeted and denied of their legal rights. I’m proposing this artifact to address not only the rights of these high schools, but also to point out what falls into the realm of these universities’ trademark entitlements.

**Legal Issue Basis:**

Trademark is a very interesting component of IP law. Like most other areas of law, it is open to a great amount of legal interpretation. For my particular area of interest, trademark policy is intended to protect collegiate trademark holders from the threat of confusion, dilution, and misrepresentation. With the growth of collegiate sports and merchandise sales, many universities are sending cease and desist letters out to high schools across the nation demanding they stop use of their logo, brand name, etc. As noted earlier, many high schools choose to surrender without a fight, because in their financial position, it’s a no win situation. While that is an issue all its own, I’m here to present an interesting proposition that has very few times been taken to court. What if these high schools fought back? Would they have a legal case to make against these universities claiming infringement and could they somehow “even the playing field?” The answer to this question is yes. In this paper, I will break down these legal components based upon my research and a very important legal document that was passed in 1946- The Lanham Act.

* Lanham Act- “primary federal [trademark](http://en.wikipedia.org/wiki/Trademark) statute of law in the United States. The Act prohibits a number of activities, including [trademark infringement](http://en.wikipedia.org/wiki/Trademark_infringement), [trademark dilution](http://en.wikipedia.org/wiki/Trademark_dilution), and [false advertising](http://en.wikipedia.org/wiki/False_advertising)”

Breakdown of Main Trademark components (Confusion and Dilution):

* Confusion-
	+ Sec 1114 (Lanham Act): “Any person who shall, without the consent of the registrant --use 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”
		- When legal courts address this issue, courts typically go through a two-step process of determining whether or not a claim of confusion is just:
			1. Is the trademark valid and does it constitute protection?
				* In the case of nearly all Universities this is not really an issue.
			2. There must be evidence that the use of the trademark by the non-primary party was done so in a way that is likely not to cause a sense of confusion of the source.
				* From a famous legal case Polariod Corp vs Polaroid Elects, the United States Court of Appeals for the Second Circuit developed eight contributing factors for analysis when determining the basis of confusion:

The strength of the mark.

The more uniqueness – typically the more protection. Schools like Clemson University (paw print), while still somewhat unique, utilize a very well-known and recognized type of logo – and in my opinion would be considered a lesser strength that that of let’s say the Georgia Tech yellow jacket or the University of Florida gator.

The degree of similarity between marks and the impression it may leave on a typical consumer.

While colleges can often make a claim on similarity, high schools can counter with a claim on a lack of consumer confusion. Would you buy shirt with a green “G,” resembling that of the University of Georgia and be confused as to where the source came from? Odds are a typical consumer would realize this was not a representative mark of UGA’s famous red “G”.

The proximity of the products/services covered by the marks and the degree of competitiveness in the market place between the two.

Many high schools, like that of Buna High school in Texas, are being pursued by universities across the nation (in this case Penn State). Can you honestly say these two are even within remote proximity geographically? – no ; you can also make the case that both high school and college marks fall into completely different market places.

The likelihood that the plaintiff will bridge the gap.

Will high school (athletics in particular) ever reach a point in which they can compete from a merchandise revenue standpoint? – odds are this is not possible

Hard evidence of actual confusion by consumers.

The defendant’s good faith when adopting the mark.

The quality of product/service.

Consumer sophistication.

* + - * + Depending on the set of circumstances, many high schools can make a case on any of these areas. This reiterates the point made earlier that not all college vs. high school legal disputes are so cut and dry. In fact, one may argue that a University would have trouble backing their infringement case with hard legal evidence.
	+ Blurring dilution- “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark”
		- “In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.”

* + - Trademark Dilution Revision Act – overturned previous ruling which stated that you had to show actual proof of dilution instead of the likelihood of future dilution
			* Limited protection of dilution to those recognized by general public
			* Slightly amended defense on rights of fair use as well
		- The adopted principle is what many contribute to an increase in power by these large name Universities – and another reason why this is an even more complex issue.
		- Main focus question – Can high schools level the playing feel on a legal basis?

**Product Description:**

As stated earlier, my final project will consist of a written paper and general presentation. In my paper, I will break down the legal claims of confusion and dilution in regards to trademark infringement between college and high school institutes. I, too, will cite and examine specific infringement cases by way of ten articles that I have acquired throughout the semester, of which I have developed a much better understanding of through a very enlightening Boston College law review done by Randall L. Newsome. Trademark is a very complex area of Intellectual Property law, and it is important to make sure I do not get caught up in the many complexities, of which the reader will become lost and uninterested. Rather, I will simplify the components of both these categories in a way that the average person with no legal background can understand and relate to. This paper will not only examine the law behind these high school and collegiate trademark clashes, but will also encourage a more active response to the issue at hand, which eventually can lead to benefits for both the universities and high schools.

**Implementation:**

*Methodology***-** This particular area of study has required me to develop qualitative research, due to the fact that the information in trademark policy is much more “rich, time consuming, and less able to be generalized.” Through a series of ten articles I have gathered during the semester and also a legal review done by Randall L. Newsome at Boston College University, I will seek to expand my knowledge on the issues at hand and incorporate my own thoughts and opinions on the legal matter. These documents will provide a solid foundation for my research and be the basis of which I draw my ideas from.

*Author Credibility-* During the course of my research, I have gathered information from credible individuals involved in IP and/or other aspects of the legal system. This, along with my knowledge gained during this Intellectual Property course at Georgia Tech, should solidify my credibility with the reader. Nearly all of the aspects of trademark policy that I examine can be confirmed through a number of legal sources as well.

*Equipment/Supplies-* The only real equipment needed for this project will be my gathered research, my laptop, and the general equipment involved with giving and oral presentation (overhead projector, computer, power point, etc.). All of these items will be readily available to me with no real issue.

*Schedule-*

11/2 – 11/6 – Look over proposal and look for ways in which is can be improved – REVISE!

11/7 – Proposal Revision Due!

11/8 – 11/13 – Continue to revise the proposal and begin rapping up the final project.

11/13 – Have Final Proposal Complete and Ready For Due Date (11/14)

11/19 – Be prepared to give oral presentation on my topic issue & Have final draft complete.

To this point, I have had all previous assignments in the course complete in time of the due date, which should encourage the reader that I have an effective structure for completing assignments.

**Conclusion:**

With the increasing trademark policy issues surrounding college and high school trade mark use, I am asking approval for a final artifact which dissects the legal components of the issue (particularly the areas of confusion and dilution), provides a legal case in favor of high school’s use of the trademarked item, and concludes with some potential solutions and an urge to address the problem sooner rather than later with the hopes of minimizing further legal issues between the two parties. This is an issue that will only become progressively worse if steps are not taken now. Enhancing a topic area such as this can only further progress the interpretation of trademark policy and law, thus providing important valuable insight into other complex trademark issues beyond that of just the conflict I am researching. Finally, I feel as though I will have no issue managing my research and also that the project is undoubtedly feasible.

**References:**

Browning, John G. "Legally Speaking: Brand Name Bullies." *The Southeast Texas Record*. N.p.,

3 Oct. 2007. Web. Spring 2012. <http://setexasrecord.com/arguments/202105-legally-speaking-brand-name-bullies>.

Burchart, Travis. "High School Logos vs. Collegiate Enforcers: The Little Infringers That

Could?" *LexisNexis Communities*. N.p., 9 Nov. 2010. Web. Spring 2012. <http://www.lexisnexis.com/community/copyright-trademarklaw/blogs/copyrightandtrademarklawblog/archive/2010/11/09/high-school-logos-vs-collegiate-enforcers-the-little-infringers-that-could.aspx>.

Gile, Ryan. "Arizona State University Alleging Trademark Infringement by High School Team

Named the SunDevils." Web log post. *Las Vegas Trademark Attorney*. Ryan Gile, 5 Oct. 2007. Web. Spring 2012.

<http://www.vegastrademarkattorney.com/2007/10/arizona-state-university-alleging.html>.

Gottschalk, JJ. "Football Helmet Logos: Newest Place for Trademark Lawsuits." Rev. of *Copycat*

*Logos Are Pitting High Schools and Colleges in a Trademark Turf War*. Weblog post. *Intellectual Property Brief*. Washington College of Law, 27 Oct. 2010. Web. Fall 2012.

<http://www.ipbrief.net/2010/10/27/football-helmet-logos-newest-place-for-trademark-lawsuits/#respond>.

Himmelsbach, Adam. "Colleges Tell High Schools Logos Are Off Limits." *The New York Times*.

The New York Times, 27 Nov. 2010. Web. Fall 2012. <http://www.nytimes.com/2010/11/27/sports/football/27logos.html?\_r=0>.

Newsom, Randall L. "CEASE AND DESIST: FINDING AN EQUITABLE SOLUTION IN

TRADEMARK DISPUTES BETWEEN HIGH SCHOOLS AND COLLEGES." *Boston College Law Review*. Boston College Law School, 2011. Web. Fall 2012. <http://bclawreview.org/files/2012/10/06\_newsom.pdf>.

Wagner, James. "Copycat Logos Are Pitting High Schools and Colleges in a Trademark Turf

War." The Washington Post, 21 Oct. 2010. Web. Spring 2012. <http://www.washingtonpost.com/wp-dyn/content/article/2010/10/21/AR2010102106526.html?sub=AR>.