Legal Breakdown:

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.