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A LEGAL PERSPECTIVE ON LICENSING ... REFLECTIONS FROM THE FRONT LINES

With this year marking the 25th anniversary of our industry's professional association, it is a fitting time to reflect on the growth and evolution of collegiate licensing. Today we may take for granted that colleges and universities have the right to protect and license the use of their names and other marks. I began practicing in this area (coincidentally, 25 years ago), having had the good fortune of being hired by Bill Battle as a lawyer for The Collegiate Licensing Company (CLC), an IMG Company. Our focus then was bringing the bad guys (a.k.a. infringers) into the fold. We dealt with many companies that had sold collegiate product for years, offering them the rights to continue, provided they sign a license and pay royalties. This was often a tough sale.

Not surprisingly, there were significant legal challenges to institutions that sought to register and protect their marks. Many felt that collegiate institutions could not protect marks that had been created many years ago, but never formally licensed. There was controversy over the fundamental right to license basic university marks. The landscape has certainly changed — the sophistication of brand management and licensing is impressive. Trademark protection and enforcement remains the bedrock; the scope has expanded to encompass a range of new challenges and opportunities. This article will provide a reflection on past and recent cases and actions that have shaped collegiate trademark protection and licensing.

A TRIP DOWN (LEGAL) MEMORY LANE

Early Cases. I began at CLC in the aftermath of two important cases. In 1983, the *Pittsburgh v. Champion* case presented the first major legal challenge to collegiate trademark licensing. The University of Pittsburgh sued bookstore supplier Champion Products after the company refused to sign a license. The court held that Pitt's 45-year delay in bringing a trademark infringement action did not prevent Pitt from protecting its marks going forward. The court found that Champion was "exploiting" Pittsburgh's popularity and consumers' desire to identify with Pittsburgh by purchasing products using Pittsburgh's marks. This case paved the way legally for licensing to take off.

Shortly thereafter came the famous *Battlin' Bulldog Beer* case. In 1985, a court ordered a beer distributor to stop selling *Battlin' Bulldog Beer* in cans featuring a bleary-eyed version of the Bulldog mascot, noting that the infringer's intent was to capitalize on the popularity of the University of Georgia football program. This is a strong case frequently cited as solid precedent for broad trademark protection.

Johnny T-Shirt. One of my first university tours of duty was to North Carolina, to visit each CLC-represented college or university in the state, including the University of North Carolina (UNC). While surveying the local marketplace, I came across a campus retailer that printed its own UNC-logged product. *Johnny T-Shirt* was operated by a university alumnus, who felt that as a citizen of North Carolina and former student, he had every right to use the university's marks. As a newly minted lawyer, it was my job to convince him otherwise. After several settlement attempts failed, UNC filed a lawsuit. The *Johnny T-Shirt* case, decided in 1989, resulted in UNC stopping *Johnny T-Shirt* from producing and selling unlicensed UNC products. The court held that the University did not legally abandon its marks, which remained strong despite years of use before UNC started its licensing program.



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Bucky Badger. Not long after that, CLC began representing the University of Wisconsin. We quickly learned that Bucky Badger was in great need of trademark protection. The mighty mascot was featured in a variety of unsavory ways on suspicious products and designs. Our efforts resulted in a challenge by the Wisconsin Merchants Federation, a group of campus retailers. The university and the merchants group ultimately agreed to let the U.S. Patent and Trademark Office determine whether the marks could be federally registered. In a proceeding where the merchants formally opposed the university's trademark applications, Wisconsin prevailed in obtaining federal trademark registration of its marks, resulting in both confirmation that the marks were capable of registration and resolution of the dispute with the local merchants.

It was exciting to be part of this first wave of cases, where several key courts rejected challenges to the fundamental right of colleges and universities to protect and enforce their marks. The decisions confirmed the widespread public recognition that university names and other marks are clearly associated with the respective institutions.

FAST FORWARD

School Colors. Those earlier cases set the groundwork for collegiate trademark protection and licensing. More recent cases defined the scope of trademark protection. For example, in the *Smack Apparel* case, a group of institutions and CLC sued an apparel company over shirts that incorporated school colors with other material related to athletics. In 2008, a court confirmed that *Smack's* use of those designs constituted trademark infringement, even if neither the school names nor other school marks were included on the products. The *Smack* case (along with the recent *Texas Tech* and *Joe College* collegiate cases) continue the line of wins for schools that have taken action to protect their marks and the marketplace position of legitimate retailers and licensees. This judicial recognition that universities' rights extend beyond basic name and logos — i.e., to colors and other indicia referring to the universities — will benefit universities and other trademark owners well into the future.

The Coalition to Advance the Protection of Sports Logos (CAPS). Schools and other trademark owners design enforcement programs to address their respective priorities. At the same time, there are advantages to pursuing common infringement problems collectively, with efficiencies realized by pooling resources. CAPS is an organization that has afforded its members the opportunity to develop close working relationships and deal with enforcement matters of common interest. Composed of CLC and each major professional sports league, CAPS is committed to the protection of sports logos through trademark protection and enforcement actions, law enforcement training and educational efforts, improvement and expansion of infringement counterfeiting laws, publicity of CAPS actions, and membership in other enforcement alliances. CAPS shows how licensors can cast a wider enforcement net by working together.

CONCLUSION

As collegiate licensing has matured as an industry, licensing has evolved from primarily an enforcement effort to an important component of an overall brand strategy. Trademark licensing is thus an important mechanism not only for allowing third-party use, but for trademark protection and building and enhancing an institution's brand image.

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