



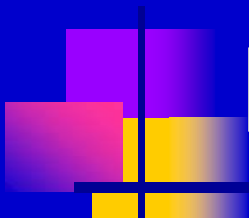
# High School Logo Challenge

Aimee Anderson, Licensing Manager, Georgia Tech

Jim Aronowitz, Associate General Counsel, Collegiate Licensing Company

Cindy Van Matre, Director of Trademark Licensing, University of Wisconsin

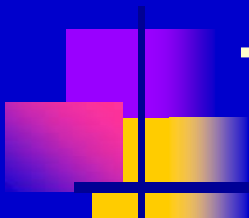




# How Issues are Brought to Light

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- Alumni
- Licensees/Companies
- Newspaper/Magazine articles
- High school booster clubs



# Three Possible Approaches

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- “Look the other way”
- Negotiate a “phase out”
- Licensing



# Look the Other Way

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- Advantages:
  - Avoid risk of PR backlash
  - “Imitation is the sincerest form of flattery”
- Disadvantages:
  - Erosion of brand
  - Risk of abandonment of rights to mark



# Negotiate a “Phase Out”

- Tools:
  - A “soft” c&d letter
  - Process of getting list of uses and negotiating a “phase out”
- Advantages:
  - Protect rights to mark/maintain brand integrity
- Disadvantages:
  - Potential PR backlash (although not often the case)



# Cease and Desist Letter

**VIA CERTIFIED MAIL**

Date

Address

Dear Mr. \_\_\_\_\_:

This letter is written in order to address your school's use of a design that is nearly identical to a trademark developed and protected by \_\_\_\_\_ University.

For your information, the Collegiate Licensing Company (CLC) is the authorized licensing representative of \_\_\_\_\_ University. CLC represents \_\_\_\_\_ University in connection with the licensing, protection and enforcement of its name, logos, slogans, mascot and other proprietary rights (hereafter "Marks"). The University owns all rights, title and interest in its Marks, including the \_\_\_\_\_ Mark.

On behalf of \_\_\_\_\_ University, CLC's intent is to notify you of the concerns that \_\_\_\_\_ University has with your school's use of a mark that is nearly identical to the \_\_\_\_\_ Mark owned by the institution in connection with its athletic teams and its licensing program. While we understand that your school did not intend to create any issues by using the Mark in question, it is important for you to understand the concerns that we have regarding your use of the Mark.

As you can imagine, \_\_\_\_\_ University has developed a valuable ownership interest in the \_\_\_\_\_ Mark, as it has promoted the Mark through extensive marketing and licensing programs associated with the University and its athletic teams. By using the Mark, the University has been able to create an identity in which consumers recognize the quality of the goods and services emanating from the University.

Your school's use of a mark that is nearly identical to the \_\_\_\_\_ Mark may cause consumers to erroneously believe that the University has authorized \_\_\_\_\_ High School to use its Marks. Additionally, it will dilute the distinctiveness of the Mark that the public associates with the University. It will also interfere with the University's ability to effectively market and license the use of the Marks in the marketplace.



# Licensing

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- Tools:
  - Introduction letter
  - License agreement
  - Electronic file
  - Licensee list
- Advantages:
  - High school acknowledges rights to mark are controlled by the university
  - Control over use of marks (ideal outcome)
  - PR goodwill
  - High school students develop affinity for your university
- Disadvantages:
  - Possibility of erosion of brand integrity or naked licensing



# Wisconsin's Approach

- “A trademark deals with a delicate matter that may be of great value but that is easily destroyed, and therefore should be protected with corresponding care.”

*Justice Oliver Wendell Holmes*  
*A. Bourjois & Co. v. Katze 1923*

# Infringement





# Wisconsin's Approach

- Schools that ignored request:
  - [West Lakota West High School, OH](#)
  - [Wisconsin Lutheran High School, WI](#)
  - [Weston High School, CT](#)
- Success stories
  - [The Woodlands High School, TX](#)
  - [Wapakoneta High School, OH](#)
  - [Waukee High School, IA](#)

# Wisconsin's Approach

March 2, 2007

Name  
School  
Address  
City

Dear \_\_\_\_\_,

Hello, from the University of Wisconsin-Madison. I am writing on behalf of the University to call your attention to an issue involving your school's use of a design that is virtually identical to the trademark-protected MOTION W<sub>0</sub> mark.

The University of Wisconsin applied for and received a federal registration in 1996 from the United States Patent and Trademark Office so that it would have exclusive and nationwide rights to prevent unauthorized use of the MOTION W<sub>0</sub> mark. A federal registration provides, among other things, a constructive notice to the public of the registrant's ownership of a mark, which is denoted by the Ø symbol. Trademark owners cannot pick and choose against whom they are going to enforce their mark, and so we cannot ignore your school's use of our federally registered mark, regardless of how harmless it may appear.

We realize that many Badger fans and alumni likely live within your school district and your use of the MOTION W<sub>0</sub> mark is viewed as flattering. However, the MOTION W<sub>0</sub> mark will lose its singular association to the University of Wisconsin if too many third parties are using the logo. As a result, the MOTION W<sub>0</sub> mark could ultimately become a generic mark if it is not protected. If this happens, UW-Madison loses its rights to the MOTION W<sub>0</sub> mark and it would then be exposed to any number of potentially undesirable applications; the University would not be able to object to any of them. Due to the hundreds of schools in the United States that have a N<sub>0</sub>W<sub>0</sub> as the initial letter of its city, high school or nickname, we hope you can understand the University of Wisconsin's need to be vigilant in protecting this valuable mark.

We would, however, like to work with you to find a solution. UW-Madison is sensitive to the costs a school incurs to change its logo and offers your school district a reasonable time period to phase out use of the MOTION W<sub>0</sub> with another logo as you replace the items (helmet decals, uniforms and signage, repaint gym courts, etc.) that display the MOTION W<sub>0</sub> mark. We realize this transition may take several years.

The enclosed documents should help answer most questions that you may have about trademarks and Wisconsin's MOTION W<sub>0</sub> mark. I am also more than willing to have a personal conversation with you, at your convenience. On behalf of the University of Wisconsin-Madison, I appreciate your understanding and anticipated cooperation and look forward to hearing from you so that we can develop a plan to amicably resolve this issue.

Sincerely,

Cindy Van Matre  
Trademark Licensing Director



## FREQUENTLY-ASKED QUESTIONS ABOUT THE MOTION W<sub>0</sub> MARK

### *What's the history of the MOTION W mark?*

The MOTION W mark was created as an original design in 1990 for the University of Wisconsin football team so that the "W" on its helmet would be distinctive from other "W's." In 1996, the University of Wisconsin obtained a federal trademark registration for the design of the MOTION W mark. The law considers a trademark to be a form of property.

### *What harm is done to the University of Wisconsin if our high school uses the MOTION W mark?*

If the University loses control of how and by whom the mark is being used, the University would no longer be able to object to undesirable uses by outside entities. Unfortunately, Wisconsin has first-hand knowledge of the effects of permitting others to use its trademarks. In the early 1990's, the University of Wisconsin was forced to fight a long and expensive legal battle to retain ownership of the BUCKY BADGER mark, as for many years it did not attempt to control use of that mark by non-University entities. In most cases, the use of BUCKY BADGER by businesses and others was seemingly harmless. However, over time, BUCKY BADGER began to appear on items such as condoms and T-shirts with images of BUCKY BADGER engaged in unsavory acts, or in connection with profane language that cannot be repeated here. When Wisconsin tried to regain control over BUCKY BADGER, it found that its failure to prevent others from using BUCKY BADGER in connection with even their harmless activities had very nearly landed BUCKY BADGER in the public domain. It took the better part of five years and many thousands of dollars in legal fees before Wisconsin was able to reclaim its trademark rights to its own mascot!

The University of Wisconsin does not actively seek out the use of our marks by high schools. However, as a trademark owner, the University is obligated to protect and maintain the integrity of the mark when it becomes aware of an unauthorized use by a third party. Trademark owners cannot pick and choose against whom they are going to enforce their mark. If the University does not act, the strength of the mark that it has expended a great deal of effort to develop and maintain will be diluted over time. Moreover, if it does not act on such uses, the University risks jeopardizing the rights that it has in its marks, or worse, will not be able to stop undesirable and unflattering uses by third parties.

Office of Trademark Licensing  
Camp Randall Stadium University of Wisconsin-Madison 1440 Monroe Street Madison, Wisconsin 53711  
608/265-1152 Fax: 608/265-1154 Phone 608/262-0195 www.wisc.edu/licensing

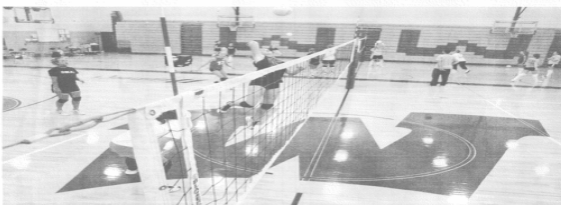
# Controversy and Conflict

The Des Moines Register

KATHY A. BOLTEK, Metro Communities Editor  
515-284-8262; kbolte@dmreg.com

## METRO & IOWA

### Pressured, Waukee elects to divorce its flying W



Waukee High School's girls' volleyball team practices Monday in the school's gym, which features a "W" logo. The school said it will change the logo to avoid a legal dispute over a University of Wisconsin trademark.

For second time in a decade, school hunts for logo

By CHRISTINA SMITH

Waukee school officials must spend an extra \$2 million to create a new logo for the "W" logo carved into the gymnasium ceiling if officials wish to avoid a legal battle, school officials have been told by the University of Wisconsin.

The Waukee Warriors general body was created about a decade ago after the long-time supporters of the school decided to change the school's name to Waukee. The school's logo, which features a stylized "W" with a winged figure, is a trademark of the University of Wisconsin.

Waukee school officials were told by the University of Wisconsin that the school's logo is a trademark of the University of Wisconsin. The school's logo, which features a stylized "W" with a winged figure, is a trademark of the University of Wisconsin.

See WAUKEE, Page 2B

#### The problem

A letter sent to Waukee students Tuesday showed Wisconsin on Sept. 20 from the Collegiate Licensing Co., which represents the University of Wisconsin, said Waukee's "W" logo resembles the trademark's universally used form closely.



Your school's use of a mark that is nearly identical to the MOTION W Mark may cause confusion. It is an infringement because the University has authorized Waukee Community Schools to use its Marks. Additionally, it will also interfere with the University's ability to effectively market and increase the use of the Marks in the marketplace.

#### What they are saying

The Des Moines Register asked Waukee students what they thought of plans to change the school's "W" logo after the University of Wisconsin threatened a trademark lawsuit.



"What's in a W? Who is that offending? I don't think we should have to change it."

"I'm not that upset because it's not affecting our play on the field. I'm kind of excited for the change. Because we'll get something new."

"We're just a little high school in Iowa. We're not hurting anything. I think it's a stupid lawsuit over a W."

MARCHANSEN

Trademark, Colby spends millions of dollars protecting the image in features of consumer brand cells. And more were spent on the trademark and the idea. It's a form of plagiarism.

Colby, what's the law? It's nothing like that. It's more like a high school student using a few lines from the Bible in a speech without getting permission from the White House.

### Wisconsin shouldn't have bothered

You can kind of understand the University of Wisconsin's High School's decision to change its logo. The school's logo, which features a stylized "W" with a winged figure, is a trademark of the University of Wisconsin.

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See WAUKEE, Page 2B

The Des Moines Register

AROUND IOWA

Tuesday, October 17, 2006 Page 5B

## Wisconsin should have just moved on

HANSEN, from Page 1B

Some would say the school is getting what it deserves for being too politically correct. Others would say Waukee is being punished for trying to do the right thing.

Collegiate Licensing Co. is the logo police, representing more than 100 colleges, keeping an eye out for blatant cases of piracy. The company argues that the similarity between the two "W"s could cause an identity crisis across the country.

The school has an identity to protect, after all. Suppose someone in Pennsylvania is watching the Wisconsin football team on national TV. Suppose this someone sees the design and says, "You know where they got that, don't you? Waukee, Iowa."

Chaos, confusion. There isn't much Waukee can do about it but agree to a lawsuit. Before Superintendent Dave Wilkerson gives in, however, he should appeal to the university's sense of political correctness. As everyone knows, Wisconsin is a nation of libertarians.

Not too long ago Waukee dumped its American Indian logo and held a contest to find a replacement. Hence the new W.

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In this photo from 1998, the Waukee school district's old American Indian mascot appears on a vertical mat in the middle school gym. Waukee dumped that mascot and logo about 10 years ago and now will find another new logo.

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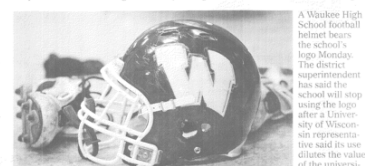
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A Waukee High School football helmet bears the school's logo Monday. The district superintendent has said the school will stop using the logo after a University of Wisconsin representative said its use dilutes the value of the university's trademark and its own logo.

### Pressured, Waukee chooses to divorce its flying W

WAUKEE, from Page 1B

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# Georgia Tech's Approach

- Two-year agreement for \$1
- High schools cannot create mascot identical to the Georgia Tech Buzz costume
- High schools cannot use trademark in conjunction with other corporate marks
- Georgia Tech has the right to inspect high school's goods/services bearing the trademark



“Buzz”





# Georgia Tech's Approach

## ■ Initial Letter

Insert Date

Dear

It has come to our attention that you are currently using the Georgia Institute of Technology's famous Buzz trademark as your [insert little league or high school name here] logo/mark. As you may know, the Buzz trademark is an officially licensed trademark, which is the subject of multiple federal trademark registrations owned by The Board of Regents of the University System of Georgia, on behalf of the Georgia Institute of Technology.

We're pleased that you like our marks and hope that you will continue to enjoy them and the traditions associated with them. However, in an effort to protect the licensed trademarks from unauthorized use and abuse, we must require all non-profit organizations to sign the attached License Agreement and submit it to the Georgia Tech Office of Institute Communications and Public Affairs. There is a nominal licensing fee of \$1 for a two-year agreement. By policy, all licensing agreements require a fee. Your organization will need to complete the agreement in order to continue to use the mark.

Once you have reviewed this Agreement, please sign it and return by \_\_\_\_\_ to:

Aimee Anderson  
Licensing Manager  
Communications & Marketing  
Georgia Institute of Technology  
177 North Ave., Suite 232  
Atlanta, GA 30332-0181

**Please make your \$1 check payable to The Georgia Tech Foundation.**

We hate to have to make this so formal, but we've found it is becoming increasingly important for universities like Georgia Tech to be vigilant in protecting our logos and marks; if we do not, we run the risk of losing ownership for lack of enforcement. Thus, it is important for us to have these agreements in place to protect us against less scrupulous organizations. Thank you for your cooperation. Please feel free to contact me at (404) 894-7613 if you have any questions about this process.

Sincerely,

Aimee Anderson  
Licensing Manager



# Georgia Tech's Approach

## ■ Agreement

### GEORGIA TECH TRADEMARK USE LICENSE AGREEMENT

This is an agreement between Name of School ("Licensee"), located at Address of School and The Board of Regents of the University System of Georgia by and on behalf of Georgia Institute of Technology with principal offices at 225 North Avenue, Atlanta, GA 30332 ("Georgia Tech") for the limited, non-exclusive, non-transferable use of the Buzz design trademark shown in the attached Exhibit A ("Trademark(s)").

Whereas Georgia Tech owns the Trademark(s);

Whereas Georgia Tech owns Reg. Nos. 2,930,301 and 1,456,921 for the Buzz Design mark;

Whereas Licensee desires to utilize the Trademark(s) in connection with its school's or organization's various activities as specified herein;

Georgia Tech and Licensee agree to the following terms and conditions:

1) Georgia Tech hereby grants Licensee a limited, non-exclusive, non-transferable license to use the Trademark(s) in connection with its school or organization for use on the following: athletic team apparel, such as football helmets, football uniforms, jerseys, basketball uniforms, hockey uniforms, etc, in connection with its school or organization; souvenirs sold by Licensee and official school or organization items including stationary, programs, web sites or yearbooks.

2) Nothing in this Agreement shall give Licensee any right, title, or interest in the Trademark(s), that the Trademark (s) is (are) the sole property of Georgia Tech and that Licensee shall not challenge the rights of Georgia Tech in the Trademark(s).

3) Licensee may not sublicense the use of the Trademark(s) or rights granted under this Agreement and/or may not grant permission to third parties (including federal programs or organizations) to use the Trademark(s) and/or any rights granted under this Agreement without the express written consent of Georgia Tech.

4) Licensee agrees to only use the Trademark(s) in connection with its activities as specified herein and to use the Trademark(s) as depicted in Exhibit A, including the appropriate trademark designation. Licensee agrees to use the Trademark(s) in marketing, sales or other activities involving products, articles, logos, characters, etc. bearing the Trademark(s) in such a way as to preserve the integrity, character, and dignity of Georgia Tech. Articles should be of high quality in design, material, and workmanship. Licensee shall not reference alcohol, drugs, or tobacco related products in conjunction with its use of the Trademark(s).