“Buckeye” Is Not for All "Buckeyes": Trademark Infringement, Dilution, and Passing-Off Claims in Intercollegiate Sports

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Given that merchandising and licensing in collegiate sports have become crucial sources of revenue, trademark protection is now a significant concern. For instance, in August 2010, the Ohio State University filed an action for trademark infringement against a business entity that had published two electronic magazines, i.e., Buckeye Gameday and Ohio State Buckeyes E-Book. Undisputed factual background of the case shows that the defendant used the federally registered mark owned by the school without consent, e.g., “Ohio State,” “Buckeyes,” scarlet and gray colors, etc. When the action was filed, the defendant was in the process of printing more than 100,000 hardcopies of Buckeye Gameday. The court granted the plaintiff’s motion for Temporary Restraining Order and Preliminary Injunction. 2010 U.S. Dist. LEXIS 96478. While the case has not reached to a decision for merits yet, it suggests an array of legal ramifications related to the issue of trademark protection in intercollegiate sports.

This study explores rules and scope of trademark law in the context of intercollegiate sports. It primarily examines several causes of action, i.e., trademark infringement, dilution, and passing-off, in terms of their unique regulatory schemes and scope of protection in conjunction with trademark management in intercollegiate sports.

Current jurisprudence of trademark law provides multiple causes of action, i.e., trademark infringement, dilution, and passing-off. Lanham Act 43(a) provides a cause of action for trademark infringement. The statute prohibits a false designation of a protected trademark that would likely cause confusion in the market as to the affiliation, sponsorship, or origin of the product. The legal test for an infringement claim is “likelihood of confusion.” A plaintiff only needs to show that a substantial number of consumers would be confused because of the defendant’s use of mark. Various factors are considered in determining whether the defendant’s use would create confusion: (a) strength of plaintiff’s mark; (b) relatedness of the goods or services; (c) similarity of marks; (d) actual confusion; (e) marketing channels used; (f) likely degree of purchaser care; and (g) intent of the defendant in selecting the mark; and (h) likelihood of expansion of the product lines. As the above-mentioned case suggests, it is an effective claim available to schools dealing with deceptive use of their marks.

In 1995, Congress enacted Trademark Dilution Act that protects “truly famous trademarks.” The statute created two types of action, i.e., blurring and tarnishment. A blurring claim can be brought against a defendant who uses a famous mark in a way that can diminish the distinctive value of the mark. For instance, if an adult shop owner in Texas uses the Longhorn silhouette for his retail chain, the University of Texas might not be able to enjoin the defendant’s use under the Lanham Act standard because two products and markets are completely different, i.e., no confusion in the relevant market. The University of Texas, however, may bring an action for trademark dilution, if it can establish that the defendant’s use of the mark would blur the distinctive value associated with the Longhorn silhouette. Tarnishment is another type of action under the law that can be filed against a defendant who puts a famous trademark in a negative light, e.g., Disparaging the Longhorn as a drug paraphernalia. To establish a dilution claim, a plaintiff must prove that his or her mark is “truly famous,” which might be the most challenging evidentiary burden. Under the current standard of the law, universities and colleges would not be able to establish federal dilution claims because their marks must have more than “niche fame.” That is, a plaintiff has to demonstrate that the mark is indeed “widely recognized by the general consuming public of the United States,” not merely by sport fans in the region or in the U.S.

On the other hand, some state-law based dilution claims might be possible on behalf of universities and colleges. Given the tough procedural requirement of the nationwide fame, schools are advised to resort to state statutes instead of the federal statute. State dilution statutes do not require the nationwide fame and it is indeed a remarkable procedural advantage in spite of some trade-offs. Additionally, in case of deceptive use of mark, state unfair trade practice law would provide plaintiffs with another cause of action, i.e., passing-off. Passing off occurs when the defendant attempt to pass off his or her product as the plaintiff's product. For instance, in the aforementioned OSU case, the plaintiff would have established a passing-off claim under the Ohio unfair competition law because the defendant seemingly passed off its electronic publications as OSU-affiliated.

In conclusion, both federal and state trademark statutes provide schools with effective causes of action against trademark infringement. In contrast, dilution claims are available only under state statutes because of the status of the nationwide fame required for the federal claim. Schools may also bring passing-off claims under state law in case of deceptive use of their marks. Public policy and legislative intent of trademark law will be discussed in conjunction with the substantive analysis of the law.