



# THINK FORWARD

We've got trademarks, yes we do! We've got trademarks, how about you?

March 17, 2015

**ANN ARBOR** – For decades, fans have been sporting various color combinations to show allegiance to their school. However, according to a report by [Briana Emerson](#) and Michael Spink, intellectual property attorneys with Brinks Gilson & Lione, these colors are more than a way to show school pride; color combinations are part of universities' licensing portfolios and the schools are guarding their identities.

"Even when the colors are not registered, universities have been taking legal action to protect their licensing portfolios, which racked in \$209 million in royalties in 2013 alone," Spink, who [blogs](#) and [tweets](#) about unusual trademarks @funkymarks, said.

In a 2008 case, Louisiana State University, the University of Oklahoma, Ohio State University and the University of Southern California, along with the schools' licensing agent, sued Smack Apparel Company for selling unlicensed t-shirts featuring the schools' color schemes and additional unregistered indicia of the schools and their sports teams. According to Spink, the schools claimed protectable trademark rights in their unregistered color combinations specifically when used with other indicia identifying the school.

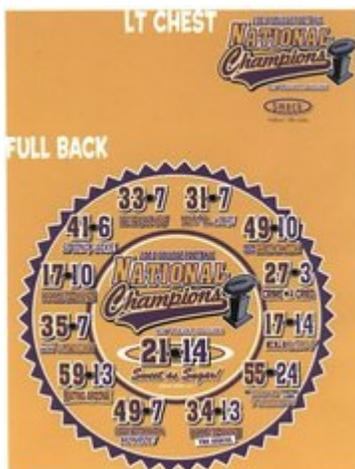
"The parties agreed that an unregistered color scheme could be protected as a trademark if it had acquired secondary meaning and was not functional," Spink said. "A mark acquired secondary meaning when its primary significance is to identify the source of the product."

After taking into consideration the length and manner of use of the marks, the volume of sales associated with the marks, the amount and manner of advertising, and the defendant's intent in copying the marks, it was found the schools' color combinations in conjunction with other indicia had acquired secondary meaning. Specifically, the court found potential customers would be confused into thinking the universities were the source of, or otherwise affiliated with or sponsored, the Smack t-shirts.

Emerson says that while schools might consider registering their colors so they have less to prove when attempting to enforce their rights, it may be difficult for some schools to obtain federal registrations because many schools use similar color combinations.

"Variations of red and white are the most commonly used school colors in NCAA football," Emerson said. "As such, attempting to register red and white in international class 25 for athletic apparel would likely face strong objection and rejection."

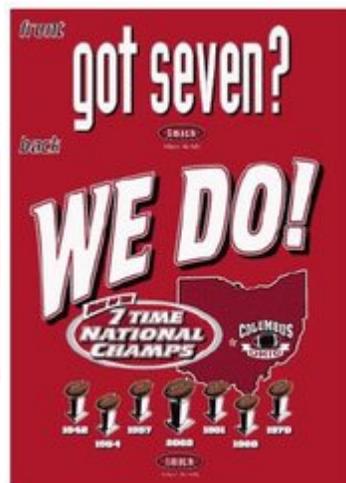
When a school has commonly used colors, Emerson suggests applying to register those colors along with other identifying indicia of the school. For example, Ohio State University has a trademark registration depicting silhouettes of men spelling out "OHIO" with their arms (US Reg. No. 4297349), Boise State University registered the color blue used on the artificial turf in its stadium (US Reg. No. 3707623), and Arizona State University, the University of Miami and the University of Texas have all registered depictions of human hands making various gestures.



US Reg. No.  
4631228



US Reg. No.  
4147043



US Reg. No.  
4535612

Universities in Michigan have not yet ventured too far into the field of registering their non-traditional trademarks (e.g. colors and sounds), according to Spink.

“In the rivalry between Michigan State University and the University of Michigan, U of M is the clear winner in the trademark competition,” Spink said. “MSU has four primary visual marks including the block S and Spartan helmet and a total of 17 live registrations for various goods and services; while U of M has 16 non-registered trademarks and 58 live registrations including the block M and a word mark for the BIG HOUSE.”

Additionally, Spink states that the University of Michigan does have trademarks that incorporate the names of its school colors including “MAIZE RAGE” (US Reg. No. 2683625) and “M GO BLUE” (US Reg. No. 2781716) for both collegiate athletic exhibitions and games.

“After the Smack decision, it is clear that school color combinations used in conjunction with indicia of that same school cannot be used without risking infringement,” Spink said. “What remains to be seen is how far a school’s trademark rights extend, namely how tenuous can the additional indicia be and still constitute trademark infringement? What we do know is select universities are pushing boundaries and showing the broader consumer industry that trademarks are no longer limited to words and logos.”

Spink and Emerson hold degrees from the University of Michigan (Go Blue!) and Michigan State University (Go Green!) respectively. To view the entire school colors report, [click here](#).

### **Brinks Gilson & Lione**

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