

Protecting University Names, Symbols

Courts enjoin use of university names for commercial purposes where public may be confused; 'invasion-of-right-to-privacy' theory explored

BY SIDNEY W. MILLARD*
and
GERALD L. SMITH*



S. Millard

For many years it was common practice for the public relations offices of colleges and universities in the U.S.A. to gratuitously grant the right to use the schools' names and symbols on various products and services. Only in unusual or extremely questionable enterprises was the request for use denied and the denial was usually based on an opinion that the use would reflect unfavorably on the college or be offensive to alumni. By way of examples, the football coach should not be permitted to use the school stadium for background in endorsements of commercial products and some alumni are offended at seeing their college's seal boldly displayed on toilet seats (sophomores are notoriously sacrilegious).

Comparatively recently some universities have begun to more specifically control or limit the use of their names and symbols by commercial enterprises and often even when a request for use is granted, the use is no longer gratuitous. In many instances the effort to control use began as a result of some specific event or unauthorized use where the school president received several letters from upset alumni. Within the past few years the frequency of the undesired use has increased and review of requests is becoming more stringent; today the request to use is often answered by a lawyer.

In controlling the use of their names and symbols, the universities have found new evidence of the old axiom that "You can't be a little bit pregnant." Specifically, they have found that they must exercise their right to control the use of their names and symbols completely or they may have no right at all. As a result of these activities, the names of universities have begun appearing more frequently on the U.S. Trademark Register.¹ "Control" is the key word and as a consequence many companies which previously operated in the lucrative college paraphernalia market with the acquiescence or endorsement of the universities involved are more and more frequently find-

ing themselves asked to enter into royalty-bearing license agreements for the privilege of continuing the use of the universities' marks on goods. Such companies have occasionally taken the position that:

1. The university has no legal right to prevent the company from using the university marks.

2. Even if the university once had that right, it is barred from asserting the same by laches.

Responsibility

With respect to the former, the U.S. Patent and Trademark Office is charged with the responsibility of registering trademarks, service marks, collective marks and certification marks which are used in interstate commerce.² It would appear that this controversy over the right to prevent use by others would be settled by the mere fact of a university registering its marks with the U.S. Patent and Trademark Office since section 7(b) of the Lanham Act³ states:

A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations therein.

Since the Patent and Trademark Office is charged with determining an applicant's right to registration, if it issues a registration there should be no real question that the applicant had at one time the right to exclusive use of its mark. Additionally, this issue has been tested in various courts from time to time and the courts are unanimous in holding that educational institutions as well as other non-profit corporations have a protectable proprietary right in their names and symbols.⁴ Most of the cases involved have been between two or more schools using the same or similar names. But, in at least three instances, *Cornell University v. Messing Bakeries* (1955), *John Roberts v. University of Notre Dame* (1957), and *Yale University v. Bennesson* (1960), the issue involved commercial use of university names by the defendants to enhance the marketability of their products or services. In all three cases, the university asked for injunctive relief and it was granted in the Cornell and Notre Dame cases. The Cornell case involved use of the mark "Cornell Recipe" on bakery goods and the Notre Dame case involved the sale of class rings bearing the university seal. The bases for the injunctions were that the commercial use of the university's name suggested connection, sponsorship, or benefit to the institution from the commercial enterprise, when, in fact, there was none. The Yale case involved the name "Yale Motor Inn" used by a motel in proximity to the

*Partners in the firm of Millard, Cox, and Smith, Columbus, O.

university. In that case the court felt that any confusion as to whether the motel was a part of the university or sponsored by the university would be more the result of ignorance or carelessness on the part of the uninformed rather than that degree of likelihood of confusion thought of in strictly commercial usage. Thus, if the buying public might reasonably be deceived as to sponsorship, etc., the injunction will issue. Proof of these facts falls on the complaining institution. However, with a federal trademark registration pleaded in the complaint in a federal district court, the legal presumptions of section 7(b) of the Lanham Act, *supra*, shift the burden of proof to the defendant.

State Universities

It may be thought that state-run institutions of higher learning stand on a different footing than private colleges and indeed they do. State universities appear to have greater rights under the law. Most state universities are held to be branches of state government or nonprofit corporations, depending on the state. For example, in Ohio, section 3335.01 of the code recites that the name of the state university shall be "The Ohio State University"; another section⁵ provides how and who shall govern the university; an early case⁶ under the code established that The Ohio State University is "an institution of the state"; and subsequent cases have established that as a branch of state government it can claim the defense of sovereign immunity.⁷ Similar law exists for several of the various state university systems but they will not be listed here because of the sheer volume of citations.

Some courts have been impressed with the fact that a college name was conferred by the state legislature⁸ but that legislative act is probably true of most colleges. In any case, an early Pennsylvania litigation, *Commonwealth v. Banks*⁹ established that proprietary rights in names of state institutions (University of Pennsylvania) would be enforced against infringers. The contention that state universities have fewer rights in controlling the use of their names than private institutions has not been specifically litigated for 75 years, for whatever reason.

In considering the second objection to a college's control of its symbols, the defense of laches, courts are far from unanimous. But as a general rule, they tend to enjoin further use by the infringer even though they may not be inclined to grant damages for past infringement. The well-known text by Vandenburg, *Trademark Law and Procedure*¹⁰ states:

"Mere delay in taking action, even though long continued, will not bar the issuance of an injunction although it will prevent the attaining of damages. However, there are many cases to the contrary . . . On the other hand, where the prior user actively encourages the use of the mark by the second user or so conducts himself that the second user has reason to believe that the prior user does not object to the second user's activities, an injunction will be refused. For the defense to arise there must be a reliance by the defendant-latecomer upon the encouragement or conduct of the plaintiff".

It must be kept in mind that the defense of laches is an equitable defense and is not available to a deliberate infringer operating without claim or right.¹¹ Thus, if a company now using a university mark on its goods originally

asked for the right to use that mark, it may be operating under a royalty free license, cancelable at will; but, if the company did not request permission to use the mark in question, the equitable defense of laches may not be available because of the deliberate infringement. Along this line, it had been held that a trademark infringer is not prejudiced by a delay of the trademark owner in bringing an infringement suit where all that has happened to the infringer is its continuance of producing and selling its infringing products.¹²

The defense of laches is probably not available at all to an infringer in the case of state universities since they are a branch of the government. The Supreme Court, speaking through Mr. Justice Story, spoke to this issue in 1824:

"... laches is not imputable to the government; and this maxim is founded, not in the notion of extraordinary prerogative, but upon a great public policy. The government can transact its business only through its agents; and its fiscal operations are so various and its agencies so numerous and scattered, that the utmost vigilance would not save the public from the most serious losses, if the doctrine of laches can be applied to its transactions."¹³

The general principle espoused has been reaffirmed many times.¹⁴

Litigation has been fairly limited up to this time but it seems likely that such activity will pick up in the near future¹⁵ as more universities become involved in trademark licensing.

In addition to the traditional theories of unfair competition, trademark infringement, etc. put forward by trademark owners, there appears to be one area not previously dealt with which may be raised by educational institutions as plaintiffs. That is in an area of the law characterized as "invasion of right to privacy." Cases on this point involving companies, schools, or anything else except living individuals or associations of individuals are totally lacking. However, a corporation is a statutory person and in many instances branches of state government are defined by statute as persons.¹⁶ Cases on the subject are collected in the ALR annotation "Invasion of Privacy-Advertising."¹⁷ All those cases revolve around some commercial enterprise using the name or likeness of a prominent personality to sell goods and that personality bringing suit to enjoin the use by unauthorized persons for commercial gain.¹⁸ However, the principal as stated in *Uhlander v. Henrickson*¹⁹ is applicable to statutory persons as well as natural persons:

Such argument (prior widespread publication) may or may not have weight against a right of privacy claim but in an appropriate action such as in the case at bar the names and statistics are valuable only because of their past public disclosure, publicity and circulation. A name is commercially valuable as an endorsement of a product or for use for financial gain only because the public recognizes it and attributes good will and feats of skill and accomplishment of one sort or another to that personality. To hold that such publicity destroys a right to sue for appropriation of a name or a likeness would negate any and all causes of action for only by the disclosure and public acceptance does the name of a celebrity have any value at all to make its unauthorized use enjoined.

It is clear that where a public personality (or institution) is complaining about the unauthorized use by another for its commercial gain under the theory of "invasion of right to privacy," the complaining entity is not

really talking about "privacy." Rather, it is talking about the right to exclusive exploitation of its name, likeness, and reputation for commercial gain. The principal of exclusive right to commercial exploitation of one's own name is well established (by the cases cited in footnote 18) even though the cases are few, and there is no apparent reason why this principle is not applicable to statutory persons and institutions as well as natural born persons. Should that issue have been raised more specifically in *University of Notre Dame v. Twentieth Century Fox*²⁰ the court might well have rendered a different decision about releasing a satirical film using the University name. The basis of that suit was a New York statute permitting a non-profit corporation to restrain the use of its name for commercial purposes. The film, "John Goldfarb Please Come Home," involved a challenge to the Notre Dame football team by a mythical university and the game was won when a female ran for a touchdown because the Notre Dame players refused to tackle a girl. The trial court refused to enjoin the showing of the film and the appellate division affirmed. The trial court noted that the mere use of Notre Dame's name and symbols was not actionable of itself and that the university had failed to show that viewers of the motion picture would infer any suggestion of sponsorship. The dissent of Judge Burke at the appellate level is consistent with the "privacy" theory discussed above. The invasion-of-right-to-privacy theory presented more specifically in arguing for injunction might have tipped the scales in favor of Notre Dame, the appellate decision vote was 3-2. In view of the valuable publicity surrounding the law suit, Twentieth Century Fox would probably have agreed to pay Notre Dame's attorney fees if Notre Dame had agreed to appeal to the Supreme Court. By the time a decision could have been handed down the picture might have been resurrected and reissued.

In summary, the courts are prone to enjoin the use of university names for commercial purposes where there is evidence that the public will attribute sponsorship, endorsement, or some other connection between the unauthorized user and the university. The defense of laches may be available to an infringer in some cases depending on the particular circumstances involved, but

probably not where the plaintiff is a branch of state government. It is likely that more litigation will occur in this area and one fertile ground for recovery by universities might be based on the theory of an exclusive right to commercialization of one's own name, characterized broadly under the title "invasion of right to privacy."

NOTES

1. University of Santa Clara, Reg. No. 1,003,069; The Ohio State University, Reg. No. 1,005,655; University of Detroit, Reg. No. 965,807; University of Houston, Reg. No. 946,525; University of Virginia, Ser. No. 57,652 (Published March 23, 1976); Asbury College, Ser. No. 476,623 (Published Dec. 30, 1975).
2. Lanham Act, Title 15 USC, Sec. 1051 et seq.
3. 15 USC Sec 1057(c).
4. John Roberts Mfg. v. University of Notre Dame, 152 F. Supp. 269 (N.D. Ind. 1957), aff'd 258 F2d 256 (7th Cir., 1958), Cernell University v. Messing Bakeries 138 NYS 2d 280, 285 App. Div. 490, aff'd 309 NY 722, 128 NE 2d 421 (1955); Yale University v. Bennesson, 147 Conn 254, 159 A2d 169 (1960); Trustees of Columbia University v. Axenfeld, 241 NYS 4, 136 Misc. 831 (1930).
5. Section 3335.02, Ohio Revised Code.
6. Neil v. Board of Trustees, 31 O.S. 15 (1876).
7. Wolfe v. Ohio State University Hospital, 170 Ohio St. 49 (1959); Thacker v. Board of Trustees, 35 Ohio St. 2d 49 (1973).
8. Trustees of Columbia Univ. v. Axenfeld (see footnote 4).
9. 198 Pa 397, 48 A. 277 (1901).
10. 2d Ed. (1968), Section 11.40(11).
11. Baker v. Simmons, 307 F 2d 458, 134 USPQ 266 (1st Cir., 1962); Phoenix Mfg. v. Plymouth Mfg. 238 F. Supp. 324, 160 USPQ (DC Mass., 1968).
12. Dunhill v. Dasser 350 F. Supp 1341 (DC Pa, 1972) aff'd 480 F2d 917.
13. U.S. v. Kirkpatrick, 6 US (9 Wheat.) 244 (1824).
14. Dox v. Postmaster General, 7 US (1 Pet.) 596 (1828); US v. Knight 13 US (14 Pet.) 470 (1840); Gaussen v. US, 97 US (7 Otto) 584 (1878).
15. Board of Trustees of The Ohio State Univ. v. Lancaster Colony, Case No 75CV-05-2137 Court of Common Pleas, Columbus, Ohio (case settled); Board of Trustees of The Ohio State Univ. v. John Roberts, Incorporated, Case No. 75CV-12-4934 Court of Common Pleas, Columbus, Ohio (case settled); suit was filed by UCLA against a local travel agent for use of the school name abbreviation under California Code Education Sec. 23001, making use of the name a misdemeanor the case was settled without an answer being filed and the case number is not readily available.
16. Section 4165.01, Ohio Revised Code; "organization", Ill. Statutes, Chap 26, §1-201; Conn. Gen. Stat. §35-11a(e) and §42a-1-201(28).
17. 23 ALR 3d 873.
18. Uhlander v. Henricksen 316 F. Supp. 1277 (1970); Paulsen v. Personality Posters 29d NYS 2d 501, 59 Misc. 2d 444 (1968); Lugosi v. Universal Pictures 172 USPQ 541 (1972).
19. See footnote 18.
20. 256 NYS 2d 301, aff'd 259 NYS 2d 832 (1965).