Lions, and Tigers, and Bears...

Trademark Information – UND Nickname Committee

Tuesday, July 21, 2015
...oh, my!

- Eagles (76)
- Tigers (46)
- Bulldogs (39)
- Panthers (33)
- Knights (32)
- Lions (32)
- Bears (30)
- Hawks (28)
- Cougars (27)
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https://en.wikipedia.org/wiki/List_of_college_team_nicknames_in_the_United_States
What are trademarks?

• Words, logos, symbols, or other indicia that serve as a source identifier for goods or services
• Represent the good will that the provider of goods or services enjoys with the relevant public
• Infringed when a third party makes a use that is likely to cause confusion among consumers as to the source of goods or services
Are certain names off limits?
ACME Co.
<table>
<thead>
<tr>
<th>Company Name</th>
<th>Address</th>
<th>Neighborhood</th>
<th>Distance</th>
</tr>
</thead>
<tbody>
<tr>
<td>Acme Roofing</td>
<td>15323 Drexel Cir</td>
<td>unknown</td>
<td>9.8 mi</td>
</tr>
<tr>
<td>Acme Carpet Co</td>
<td>1336 Park Ave</td>
<td>Southeast Omaha</td>
<td>1.3 mi</td>
</tr>
<tr>
<td>Acme Fitness LLC</td>
<td>18101 R Plz</td>
<td>Millard</td>
<td>14.0 mi</td>
</tr>
<tr>
<td>Acme Dock Specialist Inc</td>
<td>8601 F St</td>
<td>South Central Omaha</td>
<td>6.2 mi</td>
</tr>
<tr>
<td>Acme Lawn &amp; Tree Service</td>
<td>4840 S 137th St</td>
<td>Millard</td>
<td>10.4 mi</td>
</tr>
<tr>
<td>Acme Auto Service</td>
<td>6145 N 89th Cir</td>
<td>North Central Omaha</td>
<td>6.8 mi</td>
</tr>
<tr>
<td>Acme Rug Cleaners</td>
<td>1334 Park Ave</td>
<td>Southeast Omaha</td>
<td>1.3 mi</td>
</tr>
<tr>
<td>Acme Rug Cleaners</td>
<td>3712 S 138th St</td>
<td>unknown</td>
<td>9.5 mi</td>
</tr>
</tbody>
</table>
But is it infringement?

• Not every unauthorized use of the same mark is infringing
• Evaluated in light of many factors
  – Respective marks compared in their entirety
    • Words, designs
    • Dominant portions
  – Similarity of goods or services
    • Identical marks used in completely different fields?
    • Similar marks used in similar fields?
  – Context
    • Channel(s) of commerce
    • Types of uses
    • Sophistication of consumers
Co-Existence, not Exclusion
Co-Existing
Co-Existing
Co-Existing
Navigating the minefield
Navigating the minefield
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But, occasionally...
A crowded (mine)field?

• Clearance
  – Can I use a particular mark?
    • Answer is often yes, but there may be qualifiers
  – Risks of infringing third party rights?
  – SEARCH!

• Protection
  – Can I register it?
  – Do I need third party consent?

• Enforcement
  – Can I protect it?
  – Strong marks versus weak marks
  – Senior users may have superior rights
TM Searching

- Reliable (not perfect) methodology
- Purpose is to identify senior users
  - Federal registrations
    - Presumption of priority nationwide
    - Can be used to block applications of junior users
  - State registrations
    - Local effect
- Other uses
  - Lay of the land
  - Kinds of uses and users that are out there
    - These are the folks with whom you must co-exist
  - Expansion
Our Search

• Searched each of the six names under consideration by the Committee
• Comprehensive; federal and state; international; business registries, domain names, internet, misc.
• 3 focus classes
  – 16, paper and printed matter
  – 25, apparel
  – 41, sports and entertainment services
Fighting Hawks

• Exact matches (Federal) 0
• Close matches (Federal) 1
  – Closely related services 0
    • THE FIGHTING HAWKS SERIES – historical books (fiction)

• Team Sports
  – Collegiate
    • Univ of MD-Eastern Shore (informal)
  – High School/Youth/Club
    • CA, FL, NB, SC
Green Hawks

• Exact matches (Federal) 0
• Close matches (Federal) 1
   – Closely related services 0
     • GREENHAWK – Greenhawk Harness & Equestrian; Canadian supplier of equine products at wholesale, retail, and mail order

• Notable
  – Maryland/Washington Green Hawks “professional entertainment basketball team” (MD) – non-profit fundraising – may be inactive
  – Green Hawk Solutions (India) – Aviation consulting
  – GreenHawk Corporation (NC) – real estate and investments
  – GreenHawk Financial Solutions (CA) – asset investigation and location
Nodaks

• Exact matches (Federal) 0
• Close matches (Federal) 1
  – Closely related services 0
    • NODAK SPUD/NODAK SPUD LLC
      – Minnesota-based company dealing in firearms and gun parts

• Notable state registrations
  – North Dakota
    • NODAK NATION (UND) – fan club services (2012)
Nodaks

- Notable ND businesses
  - Nodak Communications
  - Nodak Speedway
  - Nodak Race Club Inc.
  - Nodak Agency
  - Nodak Air Incorporated
  - Nodak Coaches Inc.
  - Nodak Drywall LLC
  - Nodak Electric
Northstars

• Exact matches (Federal) 0
• Close matches (Federal) > 30
  – Closely related goods/services 7
    • NORTHSTAR – motorsports company, automobile racing
    • NORTHSTAR – recreational services and facilities
    • NORTHSTAR – sporting goods retailer specializing in lacrosse equipment
    • NORTH * STAR (design) – European footwear supplier
    • NORTHSTAR NATIONALS (pending) – NHRA; motorsports events
    • MINNESOTA NORTH STARS – Owned by NHL (former franchise); registered for apparel
    • NORTHERN STARS (design; pending) – Clothing; soccer-related
Northstars

• Note about NHL registration
  – Registered only in apparel class
  – Third-party NORTH STARS application (sports entertainment services) vigorously opposed, later abandoned

• Miscellaneous
  – NORTHERSTAR – Marvel, comic books
  – NORTH STAR – Royal Caribbean, cruises

• Notable state registrations
  – Wisconsin
    • N NORTHSTARS (design) – school goods and services, athletic wear

• Team Sports
  – High School/Youth/Club
    • CA, CT, GA, MA, MI, NJ, NY, ON, PA
Roughriders

• Exact matches (Federal) 1
  – Closely related goods/services 1
    • Colorado-based company; entertainment – hockey games
• Close matches (Federal) ≈ 20
  – Closely related goods/services 9
    • ROUGHRIDER - clothing
    • FRISCO ROUGHRIDERS – clothing, sports entertainment
    • SASKATCHEWAN ROUGHRIDERS – sports entertainment
    • ROUGHRIDERS LACROSSE – sports entertainment (pending)
    • ROUGHRIDERS GOLF – sports entertainment (pending)
    • ROUGHRIDERS SOCCER – sports entertainment (pending)
    • ROUGHRIDERS SPORTS CLUB – sports entertainment (pending)
    • ROUGHRIDER DAYS – clothing, entertainment/fairs (pending)
    • RUFF RYDERS – clothing (pending)
Roughriders

- Notable state registrations
  - Nebraska
    - ROUGHRIDERS – education and entertainment

- Team Sports
  - Professional
    - Saskatchewan Roughriders (CFL)(Canadian football)
    - Frisco (TX) RoughRiders (AA baseball)
    - Haddonfield (NJ)(semi-pro baseball)
    - Raleigh (NC)(semi-pro basketball)
    - Boise (ID)(semi-pro football)
    - Cedar Rapids (IA)(USHL)(junior hockey)
  - Collegiate
    - Yavapi College (AZ)(baseball, softball, soccer, VB)
  - Adult Recreational
    - Lynbrook (NY), Long Island Sled Hockey
  - High School/Youth/Club
    - ND (Grand Forks, Dickinson); AZ, CO, CT, FL, GA, KS, MD, NY, OH, PA, TX, WA

- Notable
  - Roughrider Academy (Mandan, ND)
  - Roughrider Area Career & Technical Center (Hebron, ND)
Sundogs

• Exact matches (Federal) 0
• Close matches (Federal) 9
  – Closely related goods/services 2
    • ARIZONA SUNDOGS – sports entertainment, hockey
    • SUNDOG (design) - clothing

• Notable state registrations
  – Arizona
    • ARIZONA SUNDOGS - printed matter, apparel, sports/entertainment
  – Hawaii
    • SUNDOG INTERNATIONAL – apparel
  – Kansas/Missouri
    • SUNDOGS – entertainment, computer games
  – New York
    • SUNDOG – entertainment services, film production
  – Montana
    • SUNDOGS – retail sales, Native American merchandise
Sundogs

• Team Sports
  – Arizona Sundogs (CHL)(minor league hockey)
  – Great Plains College (SK)(M/W VB, M/W BB)

• Notable
  – Sun Dog Athletics (CO) – “Aspen’s Adventure Sports School”
  – Sundog Adventure Sports & Training (BC) – Surf Shop, Stand Up Paddle activities
  – Sundog Interactive, Inc. (Fargo, ND) – communications and publishing
  – Sundog Sports Broadcast Productions (Fairbanks, AK) -
Risk Management

• Minimize potential conflicts when choosing a mark
  – Arbitrary and fanciful (made-up words)
  – Distinctive, unique
Dodging the landmines

• Fear of liability for infringement should not be the only (or even the most important) consideration
  – Strength of the brand
• More common the mark, more challenging the job of designers and brand managers
  – Fewer standalone options
  – Increased emphasis on secondary marks, logos
• Distinguish, distinguish, distinguish
  – Designs, Typefaces, Colors
• In exceptional cases, secure permission
  – Informally
  – Formally
    • Consent Agreements; Co-Existence Agreements; Covenants not to sue
    • Licenses; some parties may expect or require compensation
    • May include restrictions on marketing and use
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Takeaways

• No guarantees
• None of the six names under consideration are categorically ‘unavailable’ for adoption and use
• Naturally, some reside in more crowded fields than others
• Opportunities for further evaluation and investigation
  – Careful assessment of risks, benefits
  – Inquiries with third party owners
• ‘A way through’ in each case
Minefield successfully navigated.

Questions?