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Trojans Overcome Gamecocks in Battle of the SC Logos

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By David R. Ellis, Attorney
Largo, Florida

In October 2010, the United States Supreme Court (SC) let stand a federal appeals court's decision in favor of the University of Southern California (SC) in a trademark dispute with the University of South Carolina (SC) over a trademark logo with the interlocking letters "SC".

Southern California v. South Carolina

In the sports world, the Southern California Trojans are known as a long-time national football power, winners of eleven national championships and featuring seven Heisman trophy winners including O.J. Simpson and Reggie Bush. The South Carolina Gamecocks, by contrast, have been less successful, but have done better recently under Steve Spurrier, former University of Florida Heisman trophy winning quarterback and coach.

The case between the two USC schools involved logos on baseball caps, each featuring interlocking SC designs. In 1997, South Carolina filed an application with the U.S. Patent and Trademark Office (PTO) to register its SC logo on various items of clothing, such as hats and uniforms. After the application was approved by the trademark examiner, Southern Cal opposed the application, claiming that its own registrations, one for a similar logo and another for just the letters SC, had priority over South Carolina's trademark and that consumers could be confused by the marks. South Carolina counterclaimed to cancel Southern Cal's SC registration, asserting that the initials SC falsely suggested an association with the State of South Carolina.

The PTO's Trademark Trial and Appeal Board (TTAB) refused to register South Carolina's trademark, finding that it would create a likelihood of confusion with Southern Cal's logo. The Board found that South Carolina's and Southern Cal's SC mark were legally identical, that the marks would appear on the same classes of goods in the same channels of trade, and that some consumers would exercise little care in making purchases.

On appeal, the U.S. Court of Appeals for the Federal Circuit affirmed the TTAB's decision to refuse registration of South Carolina's mark because of a likelihood of confusion between the two marks. The Court also denied South Carolina's cancellation counterclaim. To prevail on a claim for cancellation, a party must show that the challenged mark is "unmistakably associated" with another person or institution. Since South Carolina asserted that Southern Cal's use of the initials SC falsely suggested an affiliation with the State of South Carolina, it would have had to show that the initials SC "point uniquely" to the State and nothing else.

The Court agreed that the initials SC may refer to the State of South Carolina, but noted that SC also refers to many other entities, including at least sixteen other universities and colleges. The Court thus sustained the TTAB refusal to cancel Southern Cal's registration, and the Supreme Court denied certiorari. Univ. of S. Carolina v. Univ. of So. Cal., No. 2009-1064 (Fed. Cir. Jan. 19, 2010); cert. denied, Oct. 4, 2010.

My case

Ironically, I handled a somewhat similar dispute with Southern Cal over its trademarks several years ago. My client offered college alumni the opportunity to purchase unofficial "vanity" domain names with their institution's name or nickname in the heading, such as uscgrad.com or trojanfan.com. Southern Cal objected, claiming trademark rights in the terms "USC" and "Trojans" and I exchanged some letters with their attorneys.

I first pointed out that my client used "USC" and "Trojans" as part of composite domain names such as uscgrad.com and trojanfan.com, and not as trademarks. My client's use of these terms in this context was descriptive and a fair use in good faith as permitted by Section 33(b)(4) of the U.S. Trademark (Lanham) Act, 15 USC §1115(b)(4). (As an aside, I questioned whether Southern Cal was also claiming trademark rights in the United States Code.)

I contended that anyone who is a graduate of USC, whether it is Southern Cal, or the University of South Carolina, or the University of Southern Colorado, or the University of the Sunshine Coast in Brisbane, Australia, or Universidad Santiago de Compostela (Spain), should be able to say so, under the Lanham Act, and also the First Amendment of the U.S. Constitution (also USC).

The same holds true for "Trojan" fans, whether they root for Southern Cal or the University of Arkansas at Little Rock, or Troy State University, or the Eastleigh (UK) Trojans Rugby Club, or the Turku (Finland) Trojans Football Club, or the Liverpool (England) Trojans Baseball Club, or numerous high schools and other institutions with the same appellation, or if they simply wish to express their preference for a particular brand of condom.

After that, Southern Cal punted, and, other than a brief telephone call, we never heard from them again, perhaps because they were too busy challenging the Gamecocks.

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David R. Ellis is a Largo attorney practicing trademarks, copyrights, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and Board Certified in Intellectual Property Law by the Florida Bar. He is the author of the book, A Computer Law Primer, and has taught Intellectual Property and Computer Law as an Adjunct Professor at the law schools of the University of Florida and Stetson University.

Please direct comments to ellislaw@alum.mit.edu
For more information, see www.davidellislaw.com

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