



**Board of Supervisors for Louisiana State
University Agricultural & Mechanical College v.
Smack Apparel Co.**

550 F.3d 465, 475-478 (5th Cir. 2008)

REAVLEY, Circuit Judge:

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The parties correctly agree that a color scheme can be protected as a trademark when it has acquired secondary meaning and is non-functional. *Qualitex Co. v. Jacobson Prods. Co.*²² Although the parties discuss color at length in their briefs, the Universities do not claim that every instance in which their team colors appear violates their respective trademarks. Instead, the claimed trademark is in the colors on merchandise that combines other identifying indicia referring to the Universities. It is appropriate therefore to consider not only the color but also the entire context in which the color and other indicia are presented on the t-shirts at issue here.

Smack contends that the claimed marks are too broad to encompass a trademark because the concept of color along with other identifying indicia is not distinctive. We disagree. As noted, the statute contemplates that a trademark may include any word, name, or symbol “*or any combination thereof.*”²³ The Supreme Court has recognized that the Lanham Act describes the universe of permissible marks “in the broadest of terms.”²⁴ Because the Court recognizes that trademarks

²² 514 U.S. 159, 163–64 (1995).

²³ 15 U.S.C. § 1127 (emphasis added).

²⁴ *Qualitex*, 514 U.S. at 162.

may include color, we see no reason to exclude color plus other identifying indicia from the realm of protectible marks provided the remaining requirements for protection are met. Thus, the first step here is to ask whether the Universities' claimed marks have acquired secondary meaning.

Secondary meaning "occurs when, 'in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.'" *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*²⁵ The inquiry is one of the public's mental association between the mark and the alleged mark holder. *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*²⁶ A mark has acquired secondary meaning when it "has come through use to be uniquely associated with a specific source." *Pebble Beach Co. v. Tour 18 I Ltd.*²⁷ We have applied a multi-factor test for determining secondary meaning. The factors include: "(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant's intent in copying the trade dress."²⁸ These factors in combination may show that consumers consider a mark to be an indicator of source even if each factor alone would not prove secondary meaning.²⁹

There is no dispute in this case that for a significant period of time the Universities have been using their color schemes along with other indicia to identify and distinguish themselves from others. Smack admits in its brief that the Universities' colors are well known among fans "as a shorthand nonverbal visual means of identifying the universities." But according to Smack, the longstanding use of the school colors to adorn licensed products is not the same as public recognition that the school colors identify the Universities as a unique source of goods. We think, however, that the factors for determining secondary meaning and an examination of the context in which the school colors are used and presented in this case support the conclusion that the secondary meaning of the marks is inescapable.

²⁵ 529 U.S. 205, 211 (2000) (citation omitted).

²⁶ 791 F.2d 423, 427 (5th Cir. 1986) ("[T]he prime element of secondary meaning is 'a mental association in buyers' minds between the alleged mark and a single source of the product." (citation omitted)).

²⁷ 155 F.3d 526, 536 (5th Cir. 1998) (internal quotation marks omitted), *abrogation on other grounds recognized by Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 356 (5th Cir. 2002).

²⁸ *Pebble Beach*, 155 F.3d at 541.

²⁹ *Id.*

The record shows that the Universities have been using their color combinations since the late 1800s.³⁰ The color schemes appear on all manner of materials, including brochures, media guides, and alumni materials associated with the Universities. Significantly, each university features the color schemes on merchandise, especially apparel connected with school sports teams, and such prominent display supports a finding of secondary meaning.³¹ The record also shows that sales of licensed products combining the color schemes with other references to the Universities annually exceed the tens of millions of dollars.³² As for advertising, the district court held that the Universities “advertise items with their school colors in almost every conceivable manner . . .”³³ It is not clear from the summary judgment evidence where and how the Universities advertise their merchandise, but they certainly do use their color schemes and indicia in numerous promotional materials aimed at students, faculty, alumni, and the public in general, which strengthens the conclusion that the color schemes and indicia viewed in context of wearing apparel also serves as an indicator of the Universities as the source or sponsor of the apparel. Furthermore, the district court correctly observed that the school color schemes have been referenced multiple times in newspapers and magazines and that the schools also frequently refer to themselves using the colors.³⁴ The district court did not specifically refer to any consumer-survey evidence or direct consumer testimony, but it noted that Smack admitted it had incorporated the Universities’ color schemes into its shirts to refer to the Universities and call them to the mind of the consumer. Thus, Smack itself believed that the Universities’ color schemes had secondary meaning that could influence consumers, which further supports the conclusion that there is secondary meaning here.³⁵ Given the longstanding use of the color scheme marks

³⁰ OSU adopted its school colors in 1878, while LSU has been using its colors since 1893, and OU and USC since 1895.

³¹ See *Pebble Beach*, 155 F.3d at 541–52 (prominent display of golf hole’s trade dress in advertising supported finding of secondary meaning as a designator of source).

³² For example, LSU sells between \$10 and \$20 million worth of goods each year, while the annual sales volume for the other schools is approximately \$13 million for USC, \$20 million for OU, and \$50 million for OSU.

³³ *Bd. of Supervisors*, 438 F.Supp.2d at 658.

³⁴ For example, LSU and third parties have referred to that university as the “Purple and Gold.”

³⁵ See also *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 663 (7th Cir. 1995). We also note that the record does contain survey evidence compiled by the Universities indicating that approximately thirty percent of consumers interviewed believed two of Smack’s t-shirts were produced or sponsored by the Universities. We have indicated that survey evidence often may be the most direct and persuasive evidence of secondary meaning. *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999). Nevertheless,

and their prominent display on merchandise, in addition to the well-known nature of the colors as shorthand for the schools themselves and Smack's intentional use of the colors and other references, there is no genuine issue of fact that when viewed in the context of t-shirts or other apparel, the marks at issue here have acquired the secondary meaning of identifying the Universities in the minds of consumers as the source or sponsor of the products rather than identifying the products themselves.

We think this conclusion is consistent with the importance generally placed on sports team logos and colors by the public. We have previously noted, although not in the context of secondary meaning, that team emblems and symbols are sold because they serve to identify particular teams, organizations, or entities with which people wish to identify. *See Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*³⁶ We think this desire by consumers to associate with a particular university supports the conclusion that team colors and logos are, in the minds of the fans and other consumers, source indicators of team-related apparel. By associating the color and other indicia with the university, the fans perceive the university as the source or sponsor of the goods because they want to associate with that source.

Smack argues that because photographs of businesses near the campuses of the Universities show use of school colors by those businesses, consumers in college towns merely associate school colors with "support of the home team." Smack cites no authority or supporting evidence for its contention, however. Moreover, the fact that other businesses in college towns may use the same colors as a local university does not create an issue of fact as to the secondary meaning of the colors used in merchandise that the Universities indisputably produce, especially given Smack's admission of intentional use of the colors to influence consumers.

Smack also argues that because the Universities grant licenses to many licensees, a consumer may not identify a university as the *single* source of the product. The fact that the Universities may grant licenses to many licensees to sell authorized products does not negate the fact that the schools are still the sources of the marks.³⁷ We conclude that the record establishes secondary meaning in the marks here.

Smack moved in limine to exclude the Universities' survey evidence, and the district court found it unnecessary to rule on the motion because of the other evidence in the record. Because no party has raised the issue, we express no opinion on the correctness of the district court's belief and merely note the presence of the survey evidence in the record.

³⁶ 510 F.2d 1004, 1011 (5th Cir. 1975).

³⁷ Cf. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1121 (5th Cir. 1991) ("An owner may license its trademark or trade dress and retain proprietary rights if the



B. Likelihood of confusion

Once a plaintiff shows ownership in a protectible trademark, he must next show that the defendant's use of the mark "creates a likelihood of confusion in the minds of potential customers as to the 'source, affiliation, or sponsorship' " of the product at issue. *Westchester Media v. PRL USA Holdings, Inc.*³⁸ When assessing the likelihood of confusion, we consider a nonexhaustive list of so-called "digits of confusion," including: "(1) the type of mark allegedly infringed, (2) the similarity between the two marks, (3) the similarity of the products or services, (4) the identity of the retail outlets and purchasers, (5) the identity of the advertising media used, (6) the defendant's intent, and (7) any evidence of actual confusion."⁴⁰ Courts also consider (8) the degree of care exercised by potential purchasers.⁴¹ No single factor is dispositive, and a finding of a likelihood of confusion need not be supported by a majority of the factors.⁴²

Smack argues that there were genuine issues of material fact whether its t-shirt designs were likely to cause confusion among consumers. We disagree. The first digit, the type of mark, refers to the strength of the mark. Generally, the stronger the mark, the greater the likelihood that consumers will be confused by competing uses of the mark. We agree with the district court that the plaintiffs' marks, which have been used for over one hundred years, are strong. As noted

owner maintains adequate control over the quality of goods and services that the licensee sells with the mark or dress.").

³⁸ 214 F.3d 658, 663 (5th Cir. 2000) (citation omitted).

⁴⁰ *Id.* at 664.

⁴¹ *Am. Rice*, 518 F.3d at 329.

⁴² *Id.*

above, Smack concedes that the Universities' color schemes are well-known and are used to identify the plaintiff Universities. It argues, however, that the district court disregarded evidence of third-party use of the Universities' team colors in a non-trademark manner, and it cites *Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association*⁴⁶ in support of its argument.

In *Sun Banks*, we held that "extensive" third-party use can weaken a mark and negate a likelihood of confusion. In that case there were "over 4400 businesses" in Florida that were using the word "Sun" in their names, and we noted that "a significant number" fell within the same category of financial institutions as the plaintiff.⁴⁸

Smack presented photographs of three businesses in Louisiana, eight businesses in Ohio, and approximately 20 businesses in Oklahoma that incorporated in their signage color schemes similar to the school colors of LSU, OSU, and OU, respectively. The businesses included several restaurants and bars, a driving school, a pain management clinic, a theater, a furniture store, a dry cleaners, a motel, a donut shop, an apartment complex, and a car care company. All third-party use of a mark, not just use in the same industry as a plaintiff, may be relevant to whether a plaintiff's mark is strong or weak.⁴⁹ But the key is whether the third-party use diminishes in the public's mind the association of the mark with the plaintiff—surely lacking where colors are shown on a store wall. See *Univ. of Ga. Athletic Ass'n v. Laite*.⁵⁰ Smack's evidence falls far below that of extensive use, and the specific photographs of third-party use here fail to create an issue of fact concerning the public's association between the plaintiffs and color schemes and other indicia that clearly reference the Universities. We conclude that the Universities possess strong marks in their use of color schemes and other identifying indicia on college sports-themed merchandise.

The second digit is the similarity of the marks. This factor requires consideration of the marks' appearance, sound, and meaning. The district court held that the marks at issue are virtually identical. Smack argues that there was no evidence that any of its shirts were identical to any shirts licensed by the Universities and that its t-shirt designs are not at all similar to any of the Universities' licensed products. Smack's contention is belied by the record, and

⁴⁶ 651 F.2d 311 (5th Cir. 1981).

⁴⁸ *Sun Banks*, 651 F.2d at 316.

⁴⁹ *Union Nat'l Bank of Tex.*, 909 F.2d at 848 n. 24; see also 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:88 (4th ed.) ("[E]vidence of extensive third party use on a wide range of goods and services does tend to weaken strength and narrow the scope of protection.").

⁵⁰ 756 F.2d 1535, 1545 n. 27 (11th Cir. 1985).

even a cursory comparison of Smack's designs with the plaintiffs' licensed products reveals striking similarity.

For example, one of Smack's shirt designs in purple and gold is referred to as the "sundial" shirt and was targeted toward LSU fans. The front of the shirt proclaims "2003 National Champions," and the back contains the scores from twelve games won by LSU. The scores are arranged in a circle with a short phrase poking fun at each opponent. The shirt also contains the final score of the 2004 Sugar Bowl, which LSU won, and the phrase "Sweet as Sugar!" Although the shirt does not use the initials "LSU" anywhere, its identification of LSU as the national champion is unmistakable from the colors and from the references to the games in which LSU played. This shirt is strikingly similar to LSU's own merchandise that also uses the purple and gold colors and proclaims LSU as the national champion. Several of the official designs contain the scores of the games from LSU's season and at least two designs present those scores in a circular arrangement. The official designs also contain the phrases "Ain't It Sweet!" and "Pour It On!"

Another Smack shirt directed at LSU fans is the "Beat Oklahoma" shirt. It states, "Bring it Back to the Bayou." This is very similar to two official designs that state in part "Bring It Home" and "We'll Have Big Fun on the Bayou."

The evidence of similarity is not limited to the shirts targeted toward LSU fans. For example, the "Bourbon Street or Bust!" shirt directed at OU fans highlights the letters "OU" in a different type face in the words "Bayou" and "your." It also states "Sweet as Sugar," references beads, and contains a picture of a mardi gras mask. OU presented evidence of official t-shirt designs that also highlight the letters "OU," contain phrases such as "Ain't Nothin' Sweeter" and "100% Pure Sugar," and contain depictions of mardi gras masks and beads. Another Smack OU design encourages, "Let's Make it Eight," while official designs proclaim "Sugar is Sweet But . . . 8 is Great!"

In the district court, Smack presented the affidavit of its principal, Wayne Curtiss, who explained that Smack uses humor and creative language to distinguish its t-shirt designs from those of the purportedly more conservative licensed or school-endorsed apparel. Curtiss asserted that the "got seven?" and "got eight?" shirts directed toward OSU and USC fans, respectively, are parodies of the "got milk" campaign. He further averred that he has used a similar design on shirts for LSU and OU fans. It is clear from the record, however, that use of creative language is not unique to Smack and does not make Smack's shirts dissimilar to the Universities' own products. For example, LSU presented evidence of a school-endorsed design that included the phrase "got sugar?" We conclude that Smack's shirts and the Universities' products are similar in look, sound, and meaning, and contain very similar color schemes, words, and images. The similarities in design elements are overwhelming and weigh heavily in favor of a

likelihood of confusion. The district court correctly held there is no genuine issue of material fact with respect to this digit of confusion.⁵⁴

The third digit in the likelihood of confusion analysis is the similarity of the products or services. We disagree with Smack's assertion that the district court did not find a great deal of similarity between the plaintiffs' products and the t-shirts at issue, as the district court specifically held that "[i]t is undisputed that both Smack and the universities market shirts bearing the same color schemes, logos, and designs."⁵⁵ The district court went on to reject Smack's argument that its t-shirts differed from the Universities' products because of the use of irreverent phrases or slang language, reasoning that Smack's use of such phrases and language was a misuse of the Universities' good will in its marks. Smack denies that it appropriated the Universities' good will, but it does not make an argument here that its shirts are distinguishable from those of the Universities because of particular language on its shirts. We therefore find this factor weighs in favor of a likelihood of confusion.

Smack concedes that the fourth factor of the analysis—identity of retail outlets and purchasers—weighs in favor of a likelihood of confusion because the Universities' licensed products are often sold wholesale to the same retailers who purchase Smack's products.

The fifth digit is the identity of advertising media. The district court found that Smack used the Universities' color schemes, logos, and designs in advertising its shirts at the same or similar venues as those used by the Universities. The court based its finding on Smack's admission that it participated in the same trade shows as the Universities and that it displayed its shirts at the trade shows. The Universities do not point us to evidence that trade shows are a significant advertising channel for the kinds of products at issue in this case. Although the t-shirts are sold to the public at the same retail outlets as officially licensed merchandise, Curtiss testified that beside limited sales on Smack's web site, Smack does not sell directly to the public and does not advertise. Curtiss testified that Smack sells mainly to wholesalers. Some of these wholesalers may include Smack's shirts in advertisements that promote their own business, but Curtiss was unable

⁵⁴ Because we conclude that there is no issue of fact as to the similarity of the use of the marks in the t-shirt designs, we need not consider Smack's contention that the district court erroneously stated there had been instances where consumers actually believed Smack's shirts were affiliated with or sponsored by the Universities. Smack points to a stipulation by the parties at the summary judgment stage that there was no evidence any consumer purchased a Smack shirt believing it to be licensed by one of the Universities. Actual confusion on the part of a consumer is not required to find a likelihood of confusion, however. *Elvis Presley Enters.*, 141 F.3d at 203.

⁵⁵ *Bd. of Supervisors*, 438 F.Supp.2d at 660.

to provide much information about these ads. We conclude that this digit, based on trade show advertising, is minimally probative.

The sixth digit of confusion further supports a likelihood of confusion. Although not necessary to a finding of likelihood of confusion, a defendant's intent to confuse may alone be sufficient to justify an inference that there is a likelihood of confusion. As noted by the district court, Smack admitted that it "used school colors and "other indicia" with the intent of identifying the university plaintiffs as the subject of the message expressed in the shirt design." Curtiss testified that it was "no coincidence" that Smack's shirts incorporated the color schemes of the plaintiff Universities and that he designed the shirts to make people think of the particular school that each shirt targeted. Smack asserts that its intent to copy is not the same as an intent to confuse. The circumstances of this case show, however, that Smack intended to capitalize on the potential for confusion. Smack knew that its shirts were sold in the same venues as and sometimes alongside officially licensed merchandise, and it intentionally incorporated color marks to create the kind of association with the Universities that would influence purchasers.

The Eleventh Circuit found a likelihood of confusion based on a similar intent by the defendant to capitalize on the popularity of a college sports team. *Univ. of Ga. Athletic Ass'n v. Laite*.⁵⁹ In *Laite*, the defendant used school colors and a mark strikingly similar to the University of Georgia's bulldog mascot on cans to sell "Battlin' Bulldog Beer." After concluding that the defendant's bulldog mark was similar to the university's mark, the court turned to the defendant's intent, concluding "there can be no doubt that Laite hoped to sell 'Battlin' Bulldog Beer' not because the beer tastes great, but because the cans would catch the attention of University of Georgia football fans."⁶¹ Significantly, the court found "the defendant's intent and the similarity of design between the two marks sufficient to support the district court's finding of a 'likelihood of confusion . . .'"⁶² The same is true here. Smack did not hope to sell its t-shirts because of some competitive difference in quality or design compared with the Universities' licensed products, but rather it intended to take advantage of the popularity of the Universities' football programs and the appearance of the school teams in the college bowl games. We have previously said that when a "mark was adopted with the intent of deriving benefit from the reputation of [the mark holder] that fact alone 'may be sufficient to justify the inference that there is confusing similarity.'" *Amstar Corp. v. Domino's Pizza, Inc.*⁶³ We believe that Smack's admitted intent and the

⁵⁹ 756 F.2d 1535 (11th Cir. 1985).

⁶¹ *Id.* at 1545 (footnote omitted).

⁶² *Id.* at 1545.

⁶³ 615 F.2d 252, 263 (5th Cir. 1980) (quoting RESTATEMENT OF TORTS § 729, comment f (1938)).

similarity in appearance between Smack's shirts and the Universities' licensed products is strong evidence of a likelihood of confusion.

Smack argues that an intent to confuse is negated by its use of its own logo and the words "Talkin' the Talk," which it maintains identifies it as the source of the shirt. We are not persuaded. Smack's logo appears in a space that is only 2.5 inches wide. We cannot conclude, without more, that this small and inconspicuous placement of the logo would disabuse consumers of a mistaken belief that the Universities sponsored, endorsed or were otherwise affiliated with the t-shirts.⁶⁴ Smack has not pointed to evidence that its own logo is recognizable by consumers or that it was acting to trade off its own reputation as a producer of specialty t-shirts. Nor are we convinced that Smack's logo on the shirts acts as a disclaimer. The Universities point out that they require all licensed products to contain the licensee's name. Therefore, a consumer could believe that Smack's logo merely indicated that it was a licensee.⁶⁶ We conclude that the intent digit weighs in favor of a conclusion that there is a likelihood of confusion.

The seventh digit is evidence of actual confusion. Evidence that consumers have been actually confused in identifying the defendant's use of a mark as that of the plaintiff may be the best evidence of a likelihood of confusion. It is well established, however, that evidence of actual confusion is not necessary for a finding of a likelihood of confusion. The district court did not resolve whether there was sufficient evidence of actual confusion, and because such evidence is not required we also find it unnecessary to pass on the question further.⁶⁹

With respect to the eighth digit of confusion—the degree of care exercised by potential purchasers—the district court held that the t-shirts at issue are relatively inexpensive impulse items that are not purchased with a high degree of care. Where items are relatively inexpensive, a buyer may take less care in selecting the item, thereby increasing the risk of confusion. Smack contends there was insufficient evidence for the district court's conclusion. In response, the

⁶⁴ See *Pebble Beach*, 155 F.3d at 552 (noting that "conspicuous disclaimers that disclaim affiliation may reduce or eliminate confusion").

⁶⁶ See *A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692 (2d Cir. 1972) (defendant's placement of its own name on pen also bearing mark similar to plaintiff's mark "does not save the day; a purchaser could well think plaintiff had licensed defendant as a second user and the addition is thus 'an aggravation, and not a justification'" (citation omitted)).

⁶⁹ The Universities contend that there was evidence of actual confusion consisting of consumer surveys concerning two of the six t-shirt designs and testimony from Curtiss that "I have had people come up and go-at the booth and go, 'Are these licensed?'" The evidence is arguably minimal, see *Amstar*, 615 F.2d at 263, but as discussed we need not resolve the matter.

Universities note Curtiss' testimony that he hoped customers' decisions to purchase Smack's shirts would be "quick," and they point out that the shirts sell for less than \$18. Smack cites no evidence to demonstrate an issue of fact on this point, and we agree with the district court that this digit weighs in favor of a likelihood of confusion.

After reviewing the record, we conclude that there is no genuine issue of fact that Smack's use of the Universities' color schemes and other identifying indicia creates a likelihood of confusion as to the source, affiliation, or sponsorship of the t-shirts. As noted above, the digits of confusion—particularly the overwhelming similarity of the marks and the defendant's intent to profit from the Universities' reputation—compel this conclusion. This is so, we have noted, because Smack's use of the Universities' colors and indicia is designed to create the illusion of affiliation with the Universities and essentially obtain a "free ride" by profiting from confusion among the fans of the Universities' football teams who desire to show support for and affiliation with those teams.⁷² This creation of a link in the consumer's mind between the t-shirts and the Universities and the intent to directly profit therefrom results in "an unmistakable aura of deception" and likelihood of confusion.

Smack contends that there is no evidence that consumers care one way or the other whether t-shirts purchased for wear at a football game are officially licensed and that, absent evidence that consumers prefer licensed merchandise, it was error for the district court to conclude there was a likelihood of confusion. Smack relies in part on our decision in *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Company*.⁷⁴ The context of that case is different from the instant case.

In *Rainbow for Girls*, a fraternal organization and its official jeweler sued a retailer for trademark infringement based on the retailer's sale of jewelry bearing the organization's registered mark. Purchasers in the fraternal-organization jewelry market bought jewelry to show membership and status in the organization. We upheld the district court's finding of no likelihood of confusion, concluding that "[t]he fact that purchasers purchased Rainbow jewelry as a direct result of the presence of the Rainbow emblem does not compel the conclusion that they did so believing that the jewelry was in any way endorsed, sponsored, approved or otherwise associated with Rainbow, *given the court's findings*."⁷⁶ The district court had held that there was no historic custom or practice specific to Rainbow jewelry

⁷² See *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 33 (1st Cir. 1989) ("Defendants' shirts are clearly designed to take advantage of the Boston Marathon and to benefit from the good will associated with its promotion by plaintiffs. Defendants thus obtain a 'free ride' at plaintiffs' expense.").

⁷⁴ 676 F.2d 1079 (5th Cir. 1982).

⁷⁶ *Id.* at 1084 (emphasis added).

or to the fraternal jewelry industry that Rainbow jewelry could be manufactured only with Rainbow's sponsorship or approval. Instead, the court noted that fraternal organizations exercised little control over the manufacture of jewelry bearing their emblems. Furthermore, the court had held that because Rainbow's "official jeweler" was itself well-advertised and used its own distinctive mark on the jewelry, any jewelry without that distinctive mark could not cause confusion. We noted that the district court's findings distinguished the case from our decision in *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing*.

In *Boston Hockey*, we held that the defendant infringed the plaintiff's trademark rights by selling embroidered patches containing the emblems of professional hockey teams.⁸¹ There, the emblems were sold for use by the public to show "allegiance to or identification with the teams."⁸² We held that the likelihood of confusion requirement was met because the defendant duplicated and sold the emblems "knowing that the public would identify them as being the teams' trademarks" and because the public's "certain knowledge . . . that the source and origin of the trademark symbols were in plaintiffs satisfies the requirements of the act."⁸³

Subsequently, in *Kentucky Fried Chicken Corporation v. Diversified Packaging Corporation*, we recognized that *Boston Hockey* might be read to dispose of the confusion issue when buyers undoubtedly know that the plaintiff is the source and origin of a mark.⁸⁴ We reiterated that a showing of likelihood of confusion was still required. But we noted that the circumstances in *Boston Hockey* supported the likelihood of confusion there insofar as the sale of products "universally associated" with the hockey team "supported the inescapable inference that many would believe that the product itself originated with or was somehow endorsed by Boston Hockey." In *Rainbow for Girls*, the district court opinion, which we upheld, also recognized in reference to *Boston Hockey* that "(i)t is not unreasonable to conclude, given the degree to which sports emblems are used to advertise teams and endorse products, that a consumer seeing the emblem or name of a team on or associated with a good or service would assume some sort of sponsorship or association between the product's seller and the team."⁸⁷

We agree with this reasoning as applied to this case, which is more like *Boston Hockey* than *Rainbow for Girls*. We hold that given the record in this case and the

⁸¹ 510 F.2d 1004 (5th Cir. 1975).

⁸² *Id.* at 1011.

⁸³ *Id.* at 1012.

⁸⁴ 549 F.2d 368, 389 (5th Cir. 1977).

⁸⁷ *Rainbow for Girls*, 676 F.2d at 1085.

digits of confusion analysis discussed above—including the overwhelming similarity between the defendant’s t-shirts and the Universities’ licensed products, and the defendant’s admitted intent to create an association with the plaintiffs and to influence consumers in calling the plaintiffs to mind—that the inescapable conclusion is that many consumers would likely be confused and believe that Smack’s t-shirts were sponsored or endorsed by the Universities. The Universities exercise stringent control over the use of their marks on apparel through their licensing program. It is also undisputed that the Universities annually sell millions of dollars worth of licensed apparel. We further recognize the public’s indisputable desire to associate with college sports teams by wearing team-related apparel. We are not persuaded that simply because some consumers might not care whether Smack’s shirts are officially licensed the likelihood of confusion is negated. Whether or not a consumer *cares* about official sponsorship is a different question from whether that consumer would likely *believe* the product is officially sponsored. For the foregoing reasons, we conclude that a likelihood of confusion connecting the presence of the Universities’ marks and the Universities’ themselves was demonstrated in this case.

....

D. Nominative fair use

Smack used the Universities’ colors and indicia in more than a nominative sense. It did not incorporate the colors and other indicia to describe or compare its shirts with shirts licensed by the Universities, nor did it do so to tell the public what it had copied. Smack did incorporate the marks to identify the Universities as the subject of the shirts, but it did so in a way that improperly suggested affiliation, sponsorship, or endorsement.

To take a simple example, two shirt designs targeted toward the fans of OSU and USC refer to the number of national championships those universities have won and ask, respectively, “got seven?” and “got eight?” Both shirts proclaim “WE DO!” and contain other specific indicia identifying the schools. Smack did not win any national championships—the respective Universities did. The use of the inclusive first-person personal pronoun “we” easily permits the inference that the schools are the speakers in the shirts and therefore endorsed the message.

As noted by the district court, Smack copied the mark with “an intent to rely upon the drawing power in enticing fans of the particular universities to purchase their shirts.” Such an attempt to capitalize on consumer confusion is not a nominative fair use.¹²² We conclude that the district court correctly granted summary judgment to the Universities on this issue.

¹²² See *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).