

No. _____

IN THE
Supreme Court of the United States

SPORTSWEAR, INC., D/B/A PREP SPORTSWEAR,
Petitioner,

v.

SAVANNAH COLLEGE OF ART AND DESIGN, INC.,
Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Eleventh Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Does the scope of a federally registered service mark extend to unrelated goods bearing that service mark?

CORPORATE DISCLOSURE STATEMENT

Petitioner Sportswear, Inc., d/b/a Prep Sportswear, has no outstanding shares or debt securities in the hands of the public, and it does not have a parent company. No publicly held company has a 10% or greater ownership interest in Petitioner.

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PETITION FOR WRIT OF CERTIORARI

Sportswear, Inc., d/b/a Prep Sportswear, petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eleventh Circuit.

OPINIONS BELOW

The decision of the Eleventh Circuit (Pet. App. 1a-21a) is reported at 872 F.3d 1256. The decision of the District Court (Pet. App. 22a-28a) is unreported. The Eleventh Circuit's order denying rehearing and rehearing *en banc* (Pet. App. 29a-31a) is unreported.

JURISDICTION

The judgment of the Eleventh Circuit was entered on October 3, 2017. The Eleventh Circuit's order denying rehearing and rehearing *en banc* was entered on January 23, 2018. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Pertinent provisions of the Lanham Act are quoted at Pet. App. 32a-34a.

INTRODUCTION

Every trademark dispute boils down to two questions. First: does the plaintiff have the right to exclusive use of a mark? Second: if it does, did the defendant infringe that right? This case concerns the first question: the scope of a plaintiff's right to exclusive use of a mark. In particular, the question presented is whether federal registration of a mark for a *service* confers the right to exclude others from using

that mark on an unrelated *good*.

The facts are straightforward. Respondent Savannah College of Art and Design, Inc. is a college located in Georgia. In 2003, Respondent registered service marks with the U.S. Patent and Trademark Office (“PTO”) for the words “SCAD” and “SAVANNAH COLLEGE AND ART AND DESIGN.” These registrations were limited to the field of “educational services.” Under the Lanham Act, those registrations are “prima facie evidence ... of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration.” 15 U.S.C. § 1115(a).

In 2009, Petitioner Sportswear, Inc. began selling apparel printed with the words “Savannah College of Art and Design” and “SCAD.” As of 2009, Respondent had not sold any apparel bearing those words. Nonetheless, in 2014, Respondent sued Petitioner for trademark infringement.

The District Court granted summary judgment to Petitioner. It reasoned that Respondent’s “registrations are for use of the marks in connection with educational services,” but that Respondent “does not have registrations for the marks related to apparel.” Pet. App. 26a. The District Court also concluded that Respondent lacks a common-law right to exclusive use of its marks on apparel, given that Petitioner proved it was the first to use the mark on apparel. Pet. App. 26a-27a. Thus, the District Court held that Respondent had no basis for excluding Petitioner from using Respondent’s marks on apparel.

Id.

The Eleventh Circuit reversed the District Court—but not because it disagreed with the District Court’s legal analysis. Instead, the Eleventh Circuit deemed itself bound by a 43-year-old precedent: *Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir. 1975).¹ In *Boston Hockey*, the court “extend[ed] protection for federally-registered service marks to goods.” Pet. App. 2a. The Eleventh Circuit found that even though Respondent sought and obtained federal registration for the use of its mark on only educational services, *Boston Hockey* confers upon Respondent the right to exclusive use of its mark on *any* good or service. And because *Boston Hockey* “constitutes binding precedent” that the Eleventh Circuit was “bound to follow,” *id.*, the Eleventh Circuit held that it was constrained to reverse.

But the Eleventh Circuit was not shy about expressing its displeasure with that result. The Eleventh Circuit “paus[ed] to note the unexplained analytical leap in *Boston Hockey*.” Pet. App. 17a. The court noted that a federal registration confers the exclusive right to use a mark “on or *in connection with the goods or services specified in the registration*.” *Id.* (quoting 15 U.S.C. § 1115(a)) (emphasis in original). “If that is so,” the court stated, “there should be some legal

¹ All Fifth Circuit decisions handed down prior to October 1, 1981, are binding precedent in the Eleventh Circuit. See *N. Ins. Co. of N.Y. v. Chatham Cty.*, 547 U.S. 189, 192 & n.1 (2006).

basis for extending the scope of a registered service mark in a certain field (e.g., educational services) to a different category altogether (e.g., goods).” *Id.* But “*Boston Hockey* does not provide any basis for extending service mark rights to goods.” Pet. App. 18a.

The court then observed that “other circuits have said that service marks do not by their nature extend to goods or products.” Pet. App. 18a. And it explained that *Boston Hockey* conflicted with two bedrock principles of trademark law. First: “[A] right in a mark is not a ‘right in gross,’” yet *Boston Hockey* “seems to provide the holder of a service mark with a form of monopolistic protection.” *Id.* (citation omitted). Second: “trademark (and service mark) rights are derived through use,” yet *Boston Hockey* “extend[ed] the scope of a registered service mark (which identifies ‘services’) to a different category of ‘goods’” without requiring any showing of use. Pet. App. 19a-20a. The court concluded: “There may be a sound doctrinal basis for what *Boston Hockey* did. But unless the concept of confusion completely swallows the antecedent question of the scope of a registered mark, we have yet to hear of it.” Pet. App. 20a. Notwithstanding the panel’s criticism of *Boston Hockey*, the Eleventh Circuit denied rehearing *en banc*.

This Court should grant certiorari and reverse the Eleventh Circuit’s errant ruling. As the Eleventh Circuit itself explained, *Boston Hockey* is obviously wrong, and other circuits have rejected it. Even worse, *Boston Hockey* is irreconcilable with the Federal Circuit’s jurisprudence concerning the requirements to register a mark. In the Federal Circuit—which has

exclusive jurisdiction over appeals from the Patent and Trademark Office—Respondent would have had no chance of obtaining a federally-registered mark covering apparel. Yet Respondent was able to do the next best thing—obtain a narrow registration for educational services, and then take advantage of the Eleventh Circuit’s indefensible *Boston Hockey* precedent to significantly expand the scope of that registration to apparel.

The asymmetry between the Eleventh Circuit’s standard and the standards applied by other circuits undermines the Lanham Act’s mission of ensuring uniform nationwide standards for trademark enforcement. This Court’s review is needed.

STATEMENT OF THE CASE

A. Statutory Background

1. *Federal registration of marks*

The Lanham Act permits persons to obtain federal registrations for several types of “marks.” Two types of marks are at issue here: “trademarks” and “service marks.” A “trademark” is a “word, name, symbol, or device, or any combination thereof,” used “to identify and distinguish [one’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. A “service mark” is similar to a trademark, except that it identifies services, rather than goods. *Id.*

Obtaining federal registration of either a trademark or a service mark requires a showing that the mark has

been “use[d] in commerce” with the claimed good or service. *Id.* But the showing necessary to establish a “use in commerce” differs for trademarks and service marks. For trademarks, “a mark shall be deemed to be in use in commerce (1) on goods when (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce.” *Id.*

The test for establishing “use in commerce” for a service mark is easier to satisfy: “a mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.” *Id.* Thus, the use of a mark on advertisements can form the basis for registration of a service mark, but not a trademark. *See id.*; accord U.S. Patent & Trademark Office, U.S. Dep’t of Commerce, *Trademark Manual of Examining Procedure* § 904.04(b) (Oct. 2017).

For both trademarks and service marks, the effect of registering the mark is that the federal registration “shall be admissible in evidence and shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce *on or in connection with the goods or services specified in the registration.*” 15 U.S.C. § 1115(a) (emphasis added). Registration also constitutes “constructive notice of the registrant’s claim of ownership” of the mark. 15 U.S.C.

§ 1072.

2. Causes of action under the Lanham Act

The Lanham Act provides two federal causes of action relevant to this case. Both apply equally to goods and services.

First, Section 32 of the Lanham Act provides a cause of action for infringement of a federally-registered mark. As relevant here, that provision provides:

Any person who shall, without the consent of the registrant, ... use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, ... shall be liable in a civil action by the registrant.”

15 U.S.C. § 1114(1)(a).

Second, Section 43 of the Lanham Act provides a cause of action for unfair competition, regardless of whether the plaintiff owns a federally-registered mark. As relevant here, that provision provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person,

...

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

As this Court has observed, “Section 43(a) prohibits a broader range of practices than does § 32, which applies to registered marks.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (internal quotation marks omitted). But “the general principles qualifying a mark for registration ... are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).” *Id.* In particular, regardless of whether a mark is registered or unregistered, a mark is not entitled to protection in litigation unless it is actually being *used*. Pet. App. 19a; *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926) (“There is no property in a trade-mark apart from the business or trade in connection with which it is employed.”)

Thus, a holder of a registered mark may seek to enforce its exclusive right to use the mark on goods or services other than those identified in the registration. But to do so, the holder must actually be *using* that mark on goods or services other than those identified

on the registration. See *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1301 (2015) (“In infringement litigation, the district court considers the full range of a mark’s usages, not just those in the application.”); *id.* at 1307-08 (noting that trademark holder may enforce “common-law rights in usages not encompassed by its registration,” so long as the “mark owner uses its mark in ways that are materially unlike the usages in its application” (internal quotation marks omitted)).

B. Factual and Procedural Background

Respondent Savannah College of Art and Design, Inc. is a college based in Georgia. Pet. App. 2a-3a. It provides educational services and fields athletic teams. Pet. App. 3a.

In 2003, Respondent obtained federally-registered service marks for the words “SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN.” Pet. App. 3a. “The federal registrations for these marks were issued for ‘education services,’ *i.e.*, the provision of ‘instruction and training at the undergraduate, graduate, and post-graduate levels.” *Id.* Respondent “continuously used its marks for the promotion of its ‘education services.”” *Id.*

Petitioner is an online seller of “fan” clothing and other items, such as baseball caps and duffel bags. Pet. App. 4a. Since 2003, Petitioner has sold “made-to-order apparel and related goods” for many types of entities, including colleges, Greek and military organizations, and others. *Id.* “To purchase an item from Sportswear, a customer is generally required to select its preferred

organization’s ‘online store,’” and “choose an item like a t-shirt or hat.” *Id.* A customer may then select an organization’s name to be placed on that item. *Id.* “Sportswear’s website then generates a sample of the selection, prompts the customer to checkout online, and ships the final product to the customer’s home in a package indicating that it was delivered from a Sportswear facility.” Pet. App. 5a.

In August 2009, Petitioner began selling apparel printed with the words “SAVANNAH COLLEGE OF ART AND DESIGN” and “SCAD.” Pet. App. 5a. In 2014, Respondent sued Petitioner for infringement of its marks under 15 U.S.C. §§ 1114 and 1125. Pet. App. 1a, 5a.

The District Court granted summary judgment to Petitioner. The District Court observed that Respondent’s registrations were “for use of the marks in connection with educational services,” and that Respondent lacked “registrations for the marks related to apparel.” Pet. App. 26a. Thus, “[b]ecause [Respondent] does not have registered marks for apparel, it must show that it used the marks in commerce prior to [Petitioner’s] use.” *Id.* The Court concluded that no such evidence existed: “there are no records of when [Respondent] first used its marks on apparel.” Pet. App. 27a.²

² The District Court granted Petitioners’ motion to strike certain evidence proffered by Respondent, which appeared for the first time in a reply brief and contradicted Respondent’s prior admissions. Pet. App. 27a-28a.

The Eleventh Circuit reversed. It concluded that because this case “does not involve the alleged infringement of a common-law trademark,” “the date of SCAD’s first use of its marks on goods is not determinative.” Pet. App. 2a. Rather, the court held that *Boston Hockey* “controls, as it extends protection for federally-registered service marks to goods.” *Id.* It stated that although “*Boston Hockey* does not explain how or why this is so, it constitutes binding precedent that we are bound to follow.” *Id.*

The Eleventh Circuit began by laying out the pertinent principles of trademark law. It explained that Section 32(1)(a) of the Lanham Act, 15 U.S.C. § 1114(1)(a), “guards against infringement” of a “registered mark.” Pet. App. 8a (internal quotation marks omitted). Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), creates a “federal cause of action for unfair competition.” *Id.* (quotation marks omitted). “A claim for infringement under § 1114(1)(a) lies only for federally-registered marks, while a claim under § 1125(a) is broader and may also be based on unregistered (i.e., common-law) marks.” *Id.* For both claims, the court explained, Respondent was required “to establish two things.” First, it was required to show that it had “enforceable trademark rights in a mark or name.” *Id.* (brackets and internal quotation marks omitted). Second, it had to show that the right was infringed, *i.e.*, that Petitioner “made unauthorized use of its marks such that consumers were likely to confuse the two.” *Id.* (quotation marks and brackets omitted).

The Eleventh Circuit held that the District Court

had erred in looking to who was using the mark first on goods. It said that when parties “assert common-law trademark rights,” “priority of use become[s] a critical issue.” Pet. App. 10a. But because Respondent’s “claims revolve around federally-registered marks,” the question of priority of use did not apply either to Respondent’s § 1114 claim or to its § 1125 claim. *Id.*

As the Eleventh Circuit framed the issue, the question was whether Respondent “has enforceable service mark rights that extend—beyond the services listed in its federal registrations—to goods in order to satisfy the first prong of an infringement analysis: the validity and scope of a contested mark.” Pet. App. 10a. It held that “*Boston Hockey* provides the answer to that question.” *Id.* After rejecting Respondent’s alternative argument based on a prior Eleventh Circuit case addressing common-law trademark rights, Pet. App. 10a-12a, the court concluded that “*Boston Hockey* extends protection for federally-registered service marks to goods, and therefore beyond the area of registration listed in the certificate.” Pet. App. 12a.

The court summarized the facts of *Boston Hockey*. “In *Boston Hockey*, the National Hockey League and twelve of its member teams sued to prevent a manufacturer from selling embroidered sew-on patches featuring the teams’ federally-registered service marks.” Pet. App. 12a. Most of the teams’ federal registrations were for services, not goods. *Id.* Yet, the *Boston Hockey* court concluded that “granting relief was appropriate because the teams’ efforts gave commercial value to the patches.” Pet. App. 13a. “Absent from the panel’s analysis was an explanation

for how or why the teams’ registrations for ‘hockey entertainment services’ provided statutory protection as to goods like embroidered patches.” *Id.*

The court below explained that “*Boston Hockey*, though in our view lacking critical analysis, implicitly but necessarily supports the proposition that the holder of a federally-registered service mark need not register that mark for goods—or provide evidence of prior use of that mark on goods—in order to establish *the unrestricted validity and scope of the service mark*, or to protect against another’s allegedly infringing use of that mark on goods.” Pet. App. 14a (emphasis added). Thus, “[o]n remand, the district court will have to review SCAD’s claims under § 1114 and § 1125 in light of *Boston Hockey*.” *Id.* The court therefore remanded to the District Court to conduct the likelihood of confusion analysis. It underscored, however, that *Boston Hockey* “did not do away with traditional confusion analysis,” and that “confusion must stem from a perceived connection between the product and the rightful owner of the mark.” Pet. App. 16a-17a.

The court then “pause[d] to note the unexplained analytical leap in *Boston Hockey*.” Pet. App. 17a.³ The court observed that under 15 U.S.C. § 1115(a), “registration is prima facie evidence of the ... registered mark in commerce on or *in connection with the goods or services specified in the registration*.” (emphasis in original; internal quotation marks

³ Judge Martin did not join this portion of the court’s opinion. Pet. App. 2a n.1.

omitted). “If that is so,” the court stated, “one would think that there should be some legal basis for extending the scope of a registered service mark in a certain field (e.g., educational services) to a different category altogether (e.g., goods).” *Id.* But “*Boston Hockey* does not provide any basis for extending service mark rights to goods,” which, the court stated, was “potentially problematic for several reasons.” Pet. App. 18a.

First, the court emphasized that other circuits and commentators had previously “said that service marks do not by their nature extend to goods or products.” *Id.* “If these other circuits and commentators are wrong, in whole or in part, we should explain why.” *Id.*

Second, the court noted that “a right in a mark is not a ‘right in gross.’” Pet. App. 18a (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)).⁴ But *Boston Hockey* “seems to provide the holder of a service mark with a form of monopolistic protection, a so-called ‘independent right to exclude.’” Pet. App. 18a-19a (citation omitted).

Third, “it is well-settled that trademark (and service mark) rights are derived through use,” and the court had not “critically analyzed whether the procedural advantages of a mark’s registration or incontestability can serve as a basis for expanding the scope of service mark protection to a tangible good or

⁴ *United Drug* held that a trademark used for a product could not be extended to prevent use of a similar mark for retail services. 248 U.S. at 97-98.

product.” Pet. App. 19a (internal citations omitted).

The court recognized that in prior cases, it had “not limited protection to the actual product or products listed in the certificate of registration,” but instead extended that protection to “any goods on which the use of an infringing mark is likely to cause confusion.” Pet. App. 20a (quotation marks omitted). But it found that “extending the scope of a registered trademark (which identifies ‘goods’) to a different product appears to be qualitatively different from extending the scope of a registered service mark (which identifies ‘services’) to a different category of ‘goods.’” *Id.*

The court concluded: “There may be a sound doctrinal basis for what *Boston Hockey* did. But unless the concept of confusion completely swallows the antecedent question of the scope of a registered mark, we have yet to hear of it.” Pet. App. 20a. It stated that “If *Boston Hockey* did not exist, the district court’s rationale might provide a reasonable way of analyzing the alleged infringement of registered service marks through their use on goods. But *Boston Hockey* is in the books, and it compels reversal of summary judgment in favor of Sportswear.” Pet. App. 21a.

The Eleventh Circuit denied rehearing and rehearing *en banc*. Pet. App. 29a-31a.

REASONS FOR GRANTING THE WRIT

I. *BOSTON HOCKEY* IS INDEFENSIBLE.

This is the unusual case where the rule of law applied by the court below is literally indefensible: the Eleventh Circuit could not think of any ground on

which to defend the legal rule it applied. *Boston Hockey* gave no reasons for its holding: it “does not provide any basis for extending service mark rights to goods.” Pet. App. 18a. And although the Eleventh Circuit was bound to follow *Boston Hockey*, it had “yet to hear of” of any “sound doctrinal basis for what *Boston Hockey* did.” Pet. App. 20a.

No “sound doctrinal basis” exists. Respondent’s federal registrations are “*prima facie* evidence ... of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration.” 15 U.S.C. § 1115(a). The “goods or services specified in the registration” are educational services. Those registrations therefore did not confer on Respondent rights over apparel goods.

Moreover, the right to register a mark arises only through use: an applicant cannot register a trademark or service mark unless it is *already* using that trademark or service mark for the goods or services listed in the registration. 15 U.S.C. § 1127.⁵

⁵ Indeed, this was an entrenched principle of federal trademark law even before the Lanham Act. *See, e.g., Hamilton-Brown Shoe Co. v. Wolf Bros & Co.*, 240 U.S. 251, 259 (1916) (“The right to use a trademark is recognized as a kind of property, of which the owner is entitled to the exclusive enjoyment to the extent that it has been actually used.”); *Del. & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871) (“No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself.”).

Respondent was using its mark in connection with the sale of educational services, not apparel. The Lanham Act provides no basis for extending the scope of Respondent's service mark to apparel.

The Eleventh Circuit reversed the District Court's grant of summary judgment on both Respondent's § 1114 claim and its § 1125 claim. On both claims, the Eleventh Circuit erred.

Section 1114 guards against infringement of federally-registered marks: it regulates the "use in commerce" of "any reproduction, counterfeit, copy, or colorable imitation of a *registered mark*." 15 U.S.C. § 1114(1)(a). The Eleventh Circuit reversed the District Court's grant of summary judgment on Respondent's § 1114(1)(a) claim, based on *Boston Hockey's* improperly broad view of the scope of a federally-registered mark. Pet. App. 14a.

Section 1125, by its terms, says nothing about federally registered marks. To the contrary, as the Eleventh Circuit explained, Section 1125 provides a federal cause of action for unfair competition, and "a claim under § 1125(a) is broader and may also be based on unregistered (*i.e.*, common-law) marks." Pet. App. 8a. Yet the Eleventh Circuit did not conduct a common-law analysis of whether Respondent stated a claim under § 1125(a). The District Court did conduct such an analysis, and found that Respondent lacked common-law rights because Petitioner was using the mark first. Pet. App. 26a-27a. But in the Eleventh Circuit's view, this common-law analysis was irrelevant because Respondent's claims "revolve around federally-registered marks." Pet. App. 10a. Indeed, the

Eleventh Circuit went out of its way to hold that its prior case law involving common-law trademark protection was irrelevant to this case, because that prior case law did not involve a federally-registered mark. Pet. App. 10a-12a (discussing *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985)). Instead, the Eleventh Circuit took the view that because Respondent holds a federally-registered mark, *Boston Hockey's* holding dictated the scope of Respondent's rights not only with respect to its § 1114 claim, but also with respect to its § 1125 claim. Pet. App. 14a (“On remand, the district court will have to review SCAD’s claims under § 1114 and § 1125 in light of *Boston Hockey*”). Because *Boston Hockey* is wrong, the Eleventh Circuit’s reversal with respect to both claims was wrong.

The Eleventh Circuit got one issue right: *Boston Hockey* “did not do away with traditional confusion analysis.” Pet. App. 16a. To the contrary, “confusion must stem from a perceived connection between the product and the rightful owner of the mark because ‘it is not enough that typical buyers purchase the items because of the presence of the mark.’” Pet. App. 16a-17a (quoting *Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co.*, 676 F.2d 1079, 1084–85 & n.7 (5th Cir. 1982)). But this is cold comfort to Petitioner. Petitioner should not have to face a trial on whether there is any likelihood of confusion. Likelihood of confusion is the test for *infringement* of a trademark right. Here, there is no property right to infringe. Respondent’s federal registration does not confer Respondent with any rights with respect to apparel.

The Eleventh Circuit erred in holding otherwise.

II. THE ELEVENTH CIRCUIT'S DECISION CONFLICTS WITH DECISIONS OF OTHER CIRCUITS.

Not only is the decision below incorrect, but it conflicts with decisions from other regional courts of appeals, and is irreconcilable with the Federal Circuit's case law governing trademark registration.

A. The Eleventh Circuit's Decision Conflicts with Decisions from Other Regional Courts of Appeals.

1. *In the Third Circuit, the Scope of Rights Based on a Federal Registration Extends Only to Goods or Services Identified in the Registration.*

The Eleventh Circuit's decision squarely conflicts with *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383 (3d Cir. 1985) (Becker, J.). *Natural Footwear* was a trademark dispute over the mark "ROOTS." The plaintiff, Natural, obtained federal registration for the mark ROOTS, limited to "Footwear – Namely Shoes, Slippers and Boots." *Id.* at 1396. Thereafter, Natural sued the defendant, Roots, Inc., over the use of the "Roots" mark in its retail clothing stores. *Id.* at 1387.

The Third Circuit held that Natural could not assert a Lanham Act claim based on its federally-registered mark, because that mark was for footwear—not apparel. The Third Circuit emphasized that under the Lanham Act, "the protection afforded by registration

extends to ‘*the goods or services specified in the registration* subject to any conditions or limitations stated therein.’” *Id.* at 1395-96 (quoting 15 U.S.C. § 1115(a)) (emphasis in original). The court concluded that the Lanham Act’s “purpose is best served by limiting the impact of a registered mark to only the specific terms of the registration so as to allow parties interested in marketing products with a new mark to rely as fully as possible on the [federal trademark] registry.” *Id.* at 1396. The court held that its rule “will appropriately encourage registrants who wish to receive the full scope of the Act’s protection in regard to the new use of the mark to file a new application covering the new products and making reference to the earlier registration once they begin to sell a new line of products under their registered mark.” *Id.* The court also noted that “the grant of a form of monopoly should not be liberally construed.” *Id.* (footnote omitted).

The Third Circuit then “turn[ed] to the scope of Natural’s national trademark rights.” *Id.* It observed that Natural’s trademark registration identified only footwear. *Id.* at 1396-97. Thus, with respect to Natural’s claims for “relief based on the federal registration of the ROOTS mark, Natural is only entitled to gain relief pursuant to the Lanham Act in regard to its marketing of footwear.” *Id.* at 1397.

The Third Circuit’s decision conflicts with the decision below. The Third Circuit “limit[s] the impact of a registered mark to only the specific terms of the registration.” *Id.* at 1396. In this case, the Eleventh Circuit rejected that rule.

Rather than misconstruing the scope of Natural’s

federal registration, the Third Circuit explained that “Natural’s trademark rights in accessories and clothing must be considered under the common law.” *Id.* at 1397 n.31. It emphasized that common-law trademark rights “are not necessarily limited to the product originally identified by the trademark. Rather, protection from the date of the first use of the mark may extend to related products that are later sold under the common law mark.” *Id.* at 1396 n.27. But, the Third Circuit held that the scope of common-law rights depended on who was using the mark first, and remanded to the district court for further consideration of that issue. *Id.* at 1406-07.

The District Court applied a similar analysis here, holding that Respondent lacked common-law rights before Petitioner first used the mark. *Supra*, at 10. By contrast, the Eleventh Circuit held that the scope of Respondent’s federal registration extended to apparel—thus foreclosing the need for a common-law analysis. Pet. App. 10a.

2. *In the Second, Fourth, and Ninth Circuits, the Scope of Rights Based on a Federal Registration Extends to the Goods or Services Identified in the Registration and “Related” Goods or Services.*

The Second, Fourth, and Ninth Circuits have held that the scope of a mark extends not only to the specific good or service identified in the registration, but to goods or services “related” thereto. Those circuits do not, however, apply the Eleventh Circuit’s rule that the scope of a federal service mark is “unrestricted,” Pet.

App. 14a, and extends to unrelated goods.

Chandon Champagne Corp. v. San Marino Wine Corp., 335 F.2d 531 (2d Cir. 1964) (Friendly, J.), exemplifies the “related goods or services” rule. In that case, Chandon registered the “Dom Perignon” mark for champagne. *Id.* at 533. San Marino started selling cheap sparkling wine under the name “Pierre Perignon.” *Id.* at 533-34. Chandon sued San Marino for trademark infringement, but the District Court rejected Chandon’s claim, noting the difference between the “finest and dearest of French champagnes” and the “low-priced American vintage.” *Id.* at 534.

The Second Circuit reversed, holding that this analysis “embodies too restricted a notion of the protection that Congress afforded.” *Id.* The Second Circuit adopted the following rule: “A registered trademark is safeguarded against simulation not only on competing goods, but on goods so related in the market to those on which the trademark is used that the good or ill repute of the one type of goods is likely to be visited upon the other.” *Id.* (internal quotation marks omitted). The court therefore held that the scope of Chandon’s protection extended not only to champagne, but also to cheap sparkling wine: “[O]ne who was served the defendant’s mass-produced ‘Pierre Perignon’ with only partial disclosure of its identity by his host, or who knowingly ordered the domestic variety under the mistaken assumption that it was made with the skill and taste employed at supposedly related French vineyards, would be more likely to turn thereafter on appropriate occasions to another high

priced competitor rather than to Dom Perignon.” *Id.*

There is a fundamental difference between the Second Circuit’s analysis in *Chandon* and the Eleventh Circuit’s analysis below. In *Chandon*, the court held that Chandon could enforce its marks against a seller of cheap sparkling wine, even though Chandon registered its mark for champagne, because the defendant’s sales infringed on Chandon’s right to use its mark *on champagne*. The purpose of registering Chandon’s mark was to ensure that if a consumer saw champagne with the Chandon label, the consumer would assume the champagne was of high quality. If the defendant sold cheap sparkling wine with the Chandon mark, Chandon’s ability to use its mark *on champagne* would be infringed—because consumers would infer that Chandon sells low-quality alcohol. Thus, the Second Circuit held that the use of Chandon’s mark *on cheap sparkling wine* infringed Chandon’s exclusive right to use its mark *on champagne*.

That is emphatically not the *Boston Hockey* rule. Sparkling wine and champagne are substitutes; clothing and university educations are not. If the shirt from Petitioner’s website arrives in frayed condition, no one would infer that Respondent offers a poor education. The *Boston Hockey* rule does not merely extend the scope of a federally-registered mark to goods or services related to the goods or services in the registration. It requires *no* relationship between the product in the registration and the defendant’s product. Indeed, it extends a *service* mark to wholly unrelated, dissimilar, non-competing *goods*. As the Eleventh Circuit put it below: “[E]xtending the scope of a

registered trademark (which identifies ‘goods’) to a different product appears to be qualitatively different from extending the scope of a registered service mark (which identifies ‘services’) to a different category of ‘goods.’” Pet. App. 20a. Or, as the Second Circuit later put it (in dictum): “Clearly, the term [services in the Lanham Act] does not apply to goods or products.” *Murphy v. Provident Mut. Life Ins. Co. of Philadelphia*, 923 F.2d 923, 926 (2d Cir. 1990).

The Ninth Circuit took a similar view as the Second Circuit in *Applied Information Services Corp. v. eBay, Inc.*, 511 F.3d 966 (9th Cir. 2007). In that case, AIS registered the mark “SmartSearch” for use on “computer software and instruction manuals sold together which allow the user to retrieve information from on-line services via [a] phone line in the fields of agriculture and nutrition, books, chemistry, computers and electronics, education, law, medicine and biosciences, news, science and technology, social sciences and humanities.” *Id.* at 968-69. AIS then sued eBay in connection with eBay’s use of the “SmartSearch” mark in connection with eBay’s “advanced search options.” *Id.*

The District Court held that AIS did not have a “protectable interest” in the mark because eBay was not selling the item identified in AIS’s registration, *id.* at 968, but the Ninth Circuit reversed. It held that “[h]aving established a protectable interest by proving it is the owner of a registered trademark, the owner does not additionally have to show that the defendant’s

allegedly confusing use involves the same goods or services listed in the registration.” *Id.* at 972.⁶

But its analysis of the issue differed markedly from the Eleventh Circuit’s analysis. The Ninth Circuit distinguished its prior case in *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1354 (9th Cir. 1985) (en banc), in which the Ninth Circuit had held that Levi Strauss could not pursue a “trademark infringement claim ... based on an alleged trademark in *clothing* pocket tabs,” when its “federally registered trademark was limited to *pants* pocket tabs.” *Applied Information*, 511 F.3d at 972 (citing *Levi Strauss*, 778 F.2d at 1359). In *Applied Information*, the Ninth Circuit explained that where “a plaintiff bases its trademark infringement claim upon the confusion the defendant’s use will create for the plaintiff’s use of its mark in connection with its *own* registered goods or services, *that* claim comes within the scope of its protectable interest.” *Id.* (emphasis in original). The court held, however, that there was no evidence of a likelihood of confusion under that standard. *Id.* at 973.

Thus, the Ninth Circuit adopted the same rule as the Second Circuit in *Chandon*—a trademark holder can sue the seller of related goods if its right to use its mark *on the goods named in the registration* is infringed. Indeed, the Ninth Circuit characterized

⁶ The Ninth Circuit observed that it is “possible—though not entirely clear—that one circuit has established a rule to the contrary,” and cited the Third Circuit’s *Natural Footwear* case. 511 F.3d at 972 n.3.

itself as adopting the same rule as *Chandon*, and quoted *Chandon* for the proposition that, “A registered trademark is safeguarded against simulation not only on competing goods, but on goods so related in the market to those on which the trademark is used that the good or ill repute of the one type of goods is likely to be visited upon the other.” *Id.* at 971-72 (quoting *Chandon*, 335 F.2d at 534).

By contrast, in the decision below, the Eleventh Circuit adopted the view that the Ninth Circuit rejected in its *Levi Strauss* case—that the scope of Respondent’s service mark extended to unrelated goods. Again, as already noted, that approach is fundamentally different from the approach in *Chandon* and *Applied Information*.

Finally, in *Synergistic International, LLC v. Korman*, 470 F.3d 162 (4th Cir. 2006), the Fourth Circuit similarly held that the scope of a federally-registered mark extended to goods or services related to the goods or services named in the registration. In that case, Synergistic registered the mark “GLASS DOCTOR®” in connection with the “installation of glass in buildings and vehicles.” *Id.* at 172. Synergistic sued the defendant, Korman, over the use of the “GLASS DOCTOR®” mark in connection with the repair of windshields. Relying on the Third Circuit’s *Natural Footwear* decision, Korman argued that “Synergistic cannot own the exclusive right to use its ‘GLASS DOCTOR®’ mark in connection with the repair of windshields, in that it was never registered for that purpose.” *Id.* at 173.

The Fourth Circuit disagreed. The court expressly

rejected *Natural Footwear*, emphasizing that it had “not adopted such a narrow view of a trademark’s registration.” *Id.* Instead, it held that “a suggestive mark is entitled to protection against the same or a confusing mark on the same product, or related products, and even on those which may be considered by some to be unrelated but which the public is likely to assume emanate from the trademark owner.” *Id.* (internal quotation marks omitted). It found it “apparent that windshield repair and windshield installation are related services. In fact, the parties have stipulated that potential customers have called Korman assuming that her business also installs windshields.” *Id.* Thus, it found that the “scope of protection” for Synergistic’s mark extended to “Korman’s use of a similar trademark for similar services.” *Id.*

Thus, the Fourth Circuit’s approach is identical to the Second and Ninth Circuit’s approach. The Fourth Circuit reasoned that windshield repair and windshield installation are similar services—the person who repairs a windshield is also likely to install a windshield—so, in the Fourth Circuit’s view, the scope of protection for a mark for windshield installation extended to windshield repair. This is because the defendant’s use of the mark for windshield *repair* infringed the plaintiff’s right to use the mark for windshield *installation*. That is nothing like the rule adopted by the Eleventh Circuit. Educational services and clothes are completely different. No one would show up at a retail clothes store and expect to find a university education on the shelf. Indeed, unlike the

Fourth Circuit, the Eleventh Circuit did not even consider whether there was a similarity between the services in the registration and the goods sold by Sportswear. Instead, it followed *Boston Hockey*, which made that comparison unnecessary.

3. *The Ninth and Tenth Circuits Have Expressly Rejected Boston Hockey.*

Finally, the Ninth and Tenth Circuits have expressly rejected *Boston Hockey*'s logic. Those cases do not directly conflict with the decision below: they arose in different procedural postures, and thus did not address the question presented here regarding the scope of a federal registration. Nevertheless, their repudiation of *Boston Hockey*'s reasoning illustrates the extent to which *Boston Hockey* is an outlier.

In *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), the plaintiff, Job's Daughters, was a "young women's fraternal organization." *Id.* at 914. It sued the defendant, Lindeburg, for the sale of jewelry bearing the Job's Daughters insignia. *Id.* The question addressed by the Ninth Circuit on appeal was whether Lindeburg's use of the insignia was "functional," *i.e.*, whether it "constitute[d] the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product." *Id.* at 917.⁷ Relying on *Boston*

⁷ Petitioners have preserved the alternative defense that its use of Respondent's marks was functional, and that Petitioners therefore should not be subject to Lanham Act liability. *See* Appellees' Brief

Hockey, the plaintiff contended that “even purely functional use of a trademark violates the Lanham Act.” *Id.* at 918. The court “reject[ed] the reasoning of *Boston Hockey*.” *Id.* It observed that “[i]nterpreted expansively, *Boston Hockey* holds that a trademark’s owner has a complete monopoly over its use, including its functional use, in commercial merchandising.” *Id.* The court rejected that principle, holding that *Boston Hockey* had improperly “inject[ed] its evaluation of the equities between the parties and of the desirability of bestowing broad property rights on trademark owners.” *Id.* at 919.

United States v. Giles, 213 F.3d 1247 (10th Cir. 2000), was a criminal case in which the defendant was charged with trafficking in “patch sets” bearing a company’s logo, which could be sown onto handbags and other accessories. *Id.* at 1248. The legal question was whether “patch sets” were “goods” under the Lanham Act. *Id.* at 1249-50. Relying on *Boston Hockey*, the government argued that the company’s trademark rights inherently extended to anything bearing that trademark, including “patch sets.” *See id.* The Tenth Circuit disagreed. As relevant here, the

at 20-21, 34-35, *Savannah College of Art and Design, Inc. v. Sportswear, Inc.*, No. 15-13830 (11th Cir. Nov. 4, 2015), 2015 WL 6777680; Mem. of Law in Opp. to Plfs’ Mot. for S.J. at 11-12, 24-25, *Savannah College of Art and Design, Inc. v. Sportswear, Inc.*, No. 14-cv-02288-TWT (N.D. Ga. May 11, 2015), 2015 WL 5969181. Petitioners have not raised that issue in this petition because the District Court granted summary judgment to Petitioners on different grounds, and the Eleventh Circuit did not consider that issue in reversing the District Court.

court found that the *Boston Hockey* court “relied upon a novel and overly broad conception of the rights that a trademark entails.” *Id.* at 1250. The court explained that “[i]n deciding that the emblems should be protected goods despite the fact that the plaintiffs had not registered their marks for use on patches, the court essentially gave the plaintiffs a monopoly over use of the trademark in commercial merchandising.” *Id.*

In the decision below, the Eleventh Circuit followed *Boston Hockey*’s holding that the scope of a federally registered service mark extends to unrelated goods bearing that mark. That holding, too, grants Respondent an improperly broad monopoly. In the view of the Eleventh Circuit, Respondent can sue the seller of *any* good or service, regardless of the dissimilar relationship between that good or service and the “educational services” identified in Respondent’s registration. That holding is fundamentally contrary to Congress’s design, which defines the scope of the federally-protected property right by reference to the good or service for which the mark is used and registered.

B. The Eleventh Circuit’s Decision Conflicts with the Federal Circuit’s Decisions Regarding Trademark Registration.

The Federal Circuit has exclusive jurisdiction over appeals from the Patent and Trademark Office, and therefore hears all appeals concerning the criteria for registering marks. In the Federal Circuit, Respondent could not have registered its marks for use on apparel. Indeed, Respondent could not have obtained a trademark (as opposed to a service mark) registration

for *anything*.

Respondent could not have obtained a trademark registration for the use of its mark on apparel. Under the Lanham Act, an applicant cannot obtain a registration unless it is actually selling goods with that trademark affixed to it. 15 U.S.C. § 1127. Under Federal Circuit precedent, failure to meet this statutory requirement is grounds for denial of an application for a trademark registration. *See M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015). For instance, if an applicant generates images of a product bearing the mark, but the images were “created with an intention to advance the prosecution of the trademark application rather than an intention to move forward on an actual product in commerce,” the trademark registration will not issue. *Id.* at 1377. Here, Respondent proffered no evidence that it sold apparel with its mark on it at the time of its federal service mark registration. Therefore, it could not have obtained a trademark registration for apparel.

Indeed, there is no evidence that Respondent could have obtained a registration for *any* goods. In the Federal Circuit, a provider of services cannot obtain a mark for goods unless that good has an “independent value apart from the services.” *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1380 (Fed. Cir. 2012) (quotation marks omitted). For instance, an Internet service provider can obtain a service mark for Internet services, but cannot additionally obtain a trademark registration even if it puts its software in a box and ships it through the mail: the “software is inextricably intertwined with the *service* that [the provider]

provides to its customer.” *Id.* at 1382 (emphasis in original). Thus, Respondent could not have obtained trademarks based on its use of student IDs, mailings, or other documents ancillary to its educational services: it would have had to show that it sold goods with independent value from the university education it provided. There was no evidence that it did.

Thus, Respondent was gifted with valuable trademark rights from the Eleventh Circuit that it could not have obtained from the Patent and Trademark Office. Even though the Federal Circuit would not have allowed Respondent to obtain a trademark for apparel (or any other goods), the Eleventh Circuit effectively did exactly that: it extended the scope of Respondent’s service mark to apparel.

III. THIS COURT SHOULD GRANT CERTIORARI IN THIS CASE.

This case meets all of this Court’s criteria for granting certiorari. The decision below is plainly incorrect and conflicts with the decisions of other courts of appeals. Further, this case is the ideal vehicle to correct that plain error and resolve the circuit split. The Eleventh Circuit’s resolution of the question presented was outcome-determinative. The District Court ruled that Petitioner was entitled to summary judgment; the Eleventh Circuit reversed that ruling based entirely on *Boston Hockey*, while making its opinion known that *Boston Hockey* was wrong.

Moreover, there are additional prudential reasons that the Court should grant certiorari here. First,

national uniformity is particularly important in Lanham Act cases. The Lanham Act was enacted in order to create “uniform legal rights and remedies that were appropriate for a national economy.” *Two Pesos*, 505 U.S. at 782 (Stevens, J., concurring in judgment). “Although the protection of trademarks had once been ‘entirely a State matter,’ the result of such a piecemeal approach was that there were almost ‘as many different varieties of common law as there are States’ so that a person’s right to a trademark ‘in one State may differ widely from the rights which [that person] enjoys in another.’” *Id.* (quoting H.R. Rep. No. 76-944, at 4 (1939) (alteration in original)). The Lanham Act fixed that problem by creating “national legislation along national lines [to] secur[e] to the owners of trademarks in interstate commerce definite rights.” *Id.* (quoting H.R. Rep. No. 76-944, at 4 (1939) (alteration in original)).

The decision below severely undermines that goal by establishing different trademark rules in different circuits—thus creating an incentive for sellers of goods to sell in some states but not others. In Lanham Act cases, venue is proper at any location where an infringing item is sold. *See Woodke v. Dahm*, 70 F.3d 983, 985 (8th Cir. 1995) (“The place where the alleged passing off occurred therefore provides an obviously correct venue.”). This means that if a mail-order company like Petitioner mails a single allegedly infringing item to a district within the Eleventh Circuit, a plaintiff can file suit there. Mail-order companies like Petitioner therefore have a powerful incentive to withhold sales from customers within the

Eleventh Circuit—an outcome utterly contrary to the Lanham Act’s goal of facilitating interstate commerce via a single national rule.

Alternatively, if mail-order companies do sell to consumers within the Eleventh Circuit, they are exposed to the Lanham Act’s crippling remedies, including treble damages, attorney’s fees, and even nationwide injunctions. *See* 15 U.S.C. § 1117(a), (b); *EarthGrains Baking Cos. v. Sycamore*, No. 15-4145, -- F. App’x --, 2017 WL 4518664, at *7-9 (10th Cir. Oct. 10, 2017) (upholding nationwide injunction in Lanham Act case). This means that a single district court within the Eleventh Circuit could prevent the mail-order company from doing business *anywhere*—either because a multiple-damages award puts the company into bankruptcy or because an injunction applies nationwide. The harmful effects of the Eleventh Circuit’s decision, therefore, cannot be confined to the States within that Circuit.

National uniformity is also essential because federal registration confers “the right to enlist the Customs Service’s aid to bar foreign-made goods bearing that trademark.” *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 186 (1988); *see also Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) (“Registration enables the trademark holder to stop the importation into the United States of articles bearing an infringing mark” (internal quotation marks omitted)); 15 U.S.C. § 1124. A circuit conflict on the scope of federal registration could create practical difficulties for federal customs officials in deciding whether imported goods should be seized.

The conflict between the Eleventh and Federal

Circuits provides an additional basis for granting certiorari. This is no ordinary circuit split. Rather, the effect of the conflict is that disparate interpretations of the Lanham Act are applied to the *exact same mark*. When an applicant seeks to register a mark in the Patent and Trademark Office, that Office—bound by the Federal Circuit’s precedents—permits registration of a mark for a good or service only if the applicant proves it is *using* that mark with respect to that good or service. Yet, in the Eleventh Circuit, the scope of that very mark extends to *all* goods and services.

The result will be a kind of regulatory arbitrage, where applicants can exploit different rules in different circuits. An applicant can persuade the Patent and Trademark Office to register a service mark based on a very narrow definition of that mark. Armed with that federal registration, the applicant can then file suit in a district court within the Eleventh Circuit, and extend the scope of such mark to a host of unrelated goods—even though if it had tried to obtain such protection from the Patent and Trademark Office directly, it would have failed. Meanwhile, when other businesses decide whether a mark is clear for use in the United States, they cannot rely on the scope of goods or services stated in the federal registration—even though a fundamental purpose of the federal registration system is to provide that notice function. *See* 15 U.S.C. § 1072 (providing that registration also constitutes “constructive notice of the registrant’s claim of ownership” of the mark). That outcome profoundly undermines the national system of trademark registration, and warrants this Court’s

review.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

Appendix A

United States Court of Appeals
Eleventh Circuit.

SAVANNAH COLLEGE OF ART
AND DESIGN, INC.,
Plaintiff-Appellant,

v.

SPORTSWEAR, INC., d.b.a. Prep Sportswear,
Defendant-Appellee.

No. 15-13830
October 3, 2017

Before MARTIN and JORDAN, Circuit Judges, and
COOGLER, District Judge.

Opinion

JORDAN, Circuit Judge:

“Imitation may be the sincerest form of flattery,” Charles C. Colton, *Lacon*, Vol. 1, No. 183 (1820–22), in *Bartlett’s Familiar Quotations* 393:5 (16th ed. 1992), but when the imitation consists of commercial reproduction for profit, all bets are off. So when Sportswear, Inc. began using the federally-registered service marks of the Savannah College of Art and Design without a license to sell apparel and other goods on its website, SCAD did not take kindly to the copying and sued for equitable and monetary relief. SCAD asserted a number of claims against Sportswear, including service mark infringement under 15 U.S.C. § 1114; unfair competition and false designation of origin under 15 U.S.C. § 1125; and unfair competition under O.C.G.A. § 10-1-372.

This is SCAD’s appeal from the district court’s grant of summary judgment in favor of Sportswear. The district court, relying on *Crystal Entertainment & Filmworks, Inc. v. Jurado*, 643 F.3d 1313, 1315–16 (11th Cir. 2011)—a case involving a dispute over common-law trademark rights to a band name—concluded that SCAD had failed to establish that it had enforceable rights in its marks that extended to apparel. SCAD, which validly registered its marks only in connection with the provision of “education services,” did not show that it had used its marks on apparel earlier than Sportswear in order to claim common-law ownership (and priority) over its marks for “goods.” See *Savannah Coll. of Art & Design, Inc. v. Sportswear, Inc.*, 2015 WL 4626911, at *2 (N.D. Ga. 2015).

We reverse. This case, unlike *Jurado*, does not involve the alleged infringement of a common-law trademark, and as a result the date of SCAD’s first use of its marks on goods is not determinative. One of our older trademark cases, *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975), controls, as it extends protection for federally-registered service marks to goods. Although *Boston Hockey* does not explain how or why this is so, it constitutes binding precedent that we are bound to follow.

I¹

Founded in 1978, SCAD is a private, non-profit college based in Georgia, and provides educational

¹ Judge Martin joins all except Part IV.C of the opinion.

services to over 11,000 students from across the United States and more than 100 countries. SCAD is primarily known for specialized programs related to the arts, such as painting, sculpture, architecture, fashion, photography, film, and design. In addition to providing educational programs, SCAD fields athletic teams in a variety of sports.

To distinguish itself in the market and promote its programs and services, SCAD holds four federally-registered marks:



The federal registrations for these marks were issued for “education services,” *i.e.*, the provision of “instruction and training at the undergraduate, graduate, and post-graduate levels.” *See, e.g.*, D.E. 1-1, 1-2. And the parties agree that SCAD has continuously used its marks for the promotion of its “education services.”²

² SCAD may have been able to secure federal trademark registrations for the use of its word marks on goods such as apparel, but apparently did not attempt to do so. “There is no doubt that a given symbol can be used in such a way that it functions as both a trademark for goods and a service mark for services, and be the subject of separate registrations.” 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:84 (4th ed. June 2017). *See also id.* at § 19:87 (“If a service company (or a producer of goods) puts its mark on promotional items to be used by recipients, such as ball point pens and wearing apparel, the mark

SCAD has used the two word marks at issue here—“SCAD” (registered in 2003) and “SAVANNAH COLLEGE OF ART AND DESIGN” (registered in 2005)—since 1979, and they have now achieved incontestable status. In general, this means that SCAD has filed the requisite affidavit of use and incontestability under 15 U.S.C. § 1065(3), and that the U.S. Patent and Trademark Office has acknowledged that these two marks have been validly registered and in continuous use for at least five years. *See* D.E. 49-3 at 5, 10, 15, 24.

Sportswear operates entirely online and uses an interactive website to market and sell “fan” clothing and items like t-shirts, sweatshirts, baseball caps, and duffel bags. Sportswear began selling apparel for K-12 schools in 2003, and it now offers made-to-order apparel and related goods for other entities, including colleges, Greek and military organizations, golf courses, professional sports teams, and even fantasy sports teams with—and without—licensing agreements. To purchase an item from Sportswear, a customer is generally required to select its preferred organization’s “online store,” choose an item like a t-shirt or hat, and select that organization’s emblem, mascot, or name.

can be registered for such goods.”); *Hans C. Bick, Inc. v. Watson*, 253 F.2d 344, 344 (D.C. Cir. 1958) (discussing registrations for the word “Nylonized” as a trademark for women’s nylon hosiery and as a service mark for the application of a nylon coat); *In re McDonald’s Corp.*, 199 U.S.P.Q. 702, 1978 WL 21263, at *3 (T.T.A.B. 1978) (registering “McDonald’s” and “golden arches” marks for clothing because they “indicat [e] the source of origin of the various items of apparel in [the] applicant [McDonald’s Corporation]”).

Sportswear's website then generates a sample of the selection, prompts the customer to checkout online, and ships the final product to the customer's home in a package indicating that it was delivered from a Sportswear facility.

In February of 2014, a parent of a student-athlete forwarded Sportswear's website to one of SCAD's coaches. As a result, SCAD learned that Sportswear had been using its word marks on products without authorization (and without a licensing agreement) since August of 2009. Seeking to protect its marks from further unauthorized use, SCAD sued Sportswear in July of 2014. At that point, Sportswear stopped selling products with SCAD's word marks.

During discovery, SCAD provided several examples of Sportswear's products featuring its word marks and a printout of Sportswear's website-generated "SCAD" store. SCAD also submitted images of current merchandise sold on its own website and side-by-side comparisons of Sportswear's products. Sportswear conceded that it was selling products online with virtually indistinguishable reproductions of the "SCAD" and "SAVANNAH COLLEGE OF ART AND DESIGN" word marks, but asserted that its website contained a prominent disclaimer showing that the products were in no way affiliated with the school.

Since 2011, SCAD has licensed Follett Education Group to operate its online stores and Georgia-based on-campus bookstores, which sell clothing and other goods displaying SCAD's word marks. Sportswear agreed that Follett markets and sells SCAD's merchandise, but contested the degree of SCAD's involvement in

approving and designing those items. SCAD admitted that it did not submit evidence showing when it first used its word marks on apparel or related goods.

At the close of discovery, the district court reviewed the parties' cross-motions for summary judgment and ruled in favor of Sportswear. Relying on *Jurado*, the district court held that SCAD failed to establish that its service mark rights extended to apparel because it could not show priority in use as to goods.

II

We exercise plenary review of the district court's grant of summary judgment in favor of Sportswear, viewing the record and drawing all factual inferences in the light most favorable to SCAD. *See Tana v. Dantanna's*, 611 F.3d 767, 772 (11th Cir. 2010). Summary judgment is appropriate when "there is no genuine dispute as to any material fact" and the moving party is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56(a); Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

III

Trademark law, as codified by the Lanham Act, *see* 15 U.S.C. § 1051 *et seq.*, largely serves two significant but often conflicting interests. It "secure[s] to the owner of the mark the goodwill of his business[;]" and it "protect[s] the ability of consumers to distinguish among competing producers." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985).

The Lanham Act prohibits the infringement of trademarks that are used to identify “goods,” and of service marks that are used to identify “services.” See 15 U.S.C. § 1127. Trademarks and service marks are used “to indicate the source of the [goods and services], even if that source is unknown.” *Id.* Generally, “a trademark serves to identify and distinguish the source and quality of a tangible product,” while “a service mark functions to identify and distinguish the source and quality of an intangible service.” 3 McCarthy on Trademarks § 19:81.

In most respects, the “analysis is the same under both [types of marks] and courts thus treat the two terms as interchangeable in adjudicating infringement claims.” *Frehling Enterprises, Inc. v. Int’l Select Grp., Inc.*, 192 F.3d 1330, 1334 n.1 (11th Cir. 1999) (citations omitted). For both trademarks and service marks, therefore, the “the touchstone of liability ... is not simply whether there is unauthorized use of a protected mark, but whether such use is likely to cause consumer confusion.” *Custom Mfg. & Eng’g, Inc. v. Midway Servs., Inc.*, 508 F.3d 641, 647 (11th Cir. 2007). See also 4 McCarthy on Trademarks § 23:1 (“The test for infringement of a service mark is identical to the test of infringement of a trademark: is there a likelihood of confusion?”).³

³ Many other circuits also analyze trademarks and service marks under the same legal standards. See, e.g., *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1156 (9th Cir. 2001) (“Service marks and trademarks are governed by identical standards.”); *Circuit City Stores, Inc. v. CarMax, Inc.*, 165 F.3d 1047, 1054 (6th Cir. 1999) (same); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192

The Lanham Act provides different types of statutory protection. As relevant here, § 32(a) of the Act, codified at 15 U.S.C. § 1114(1)(a), guards against “infringement”—the “reproduction, counterfeit, copy, or colorable imitation of a registered mark”—while § 43(a), codified at 15 U.S.C. § 1125(a), protects against “false designation of origin,” which we have referred to as “a federal cause of action for unfair competition.” *Custom Mfg.*, 508 F.3d at 647 (citation omitted). A claim for infringement under § 1114(1)(a) lies only for federally-registered marks, while a claim under § 1125(a) is broader and may also be based on unregistered (i.e., common-law) marks. *See Jurado*, 643 F.3d at 1320.

The statutory claims at issue here more or less required SCAD to establish two things. First, SCAD needed to show “enforceable trademark rights in [a] mark or name[.]” Second, it had to prove that Sportswear “made unauthorized use of [its marks] ‘such that consumers were likely to confuse the two.’” *Custom Mfg.*, 508 F.3d at 647 (describing the requirements for a § 1125 claim) (citation omitted); *Dieter v. B & H Indus.*

F.3d 337, 344 n.2 (2d Cir. 1999) (same); *Walt-West Enterprises, Inc. v. Gannett Co., Inc.*, 695 F.2d 1050, 1054 (7th Cir. 1982) (same). This analytical overlap likely contributes to the uncertainty about the scope of protection afforded to registered service marks. *See generally* Paul M. Schoenhard, *Why Marks Have Power Beyond the Rights Conferred: The Conflation of Trademarks and Service Marks*, 87 J. Pat. & Trademark Off. Soc’y 970, 971–72 (2005) (explaining that the two distinct forms of intellectual property have been treated as the same even though “service marks did not exist as a protectable form of intellectual property under [f]ederal law prior to the passage of the [Lanham Act]”) (emphasis in original).

of *Southwest Florida, Inc.*, 880 F.2d 322, 326 (11th Cir. 1989) (same for a § 1114 claim).

We, like other circuits, often blur the lines between § 1114 claims and § 1125 claims because recovery under both generally turns on the confusion analysis. *See Tana*, 611 F.3d at 773 n.5 (stating that the district court’s error in analyzing a trademark case under § 1114 rather than § 1125 was irrelevant “because the district court based its grant of summary judgment on the likelihood-of-confusion prong”); *Tally-Ho, Inc. v. Coast Community Coll. Dist.*, 889 F.2d 1018, 1026 n.14 (11th Cir. 1989) (“an unfair competition claim based only upon alleged trademark infringement is practically identical to an infringement claim”). *Accord Water Pik, Inc. v. Med-Sys, Inc.*, 726 F.3d 1136, 1143 (10th Cir. 2013) (explaining that the “central inquiry is the same” for both § 1114 and § 1125); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 114 (2d Cir. 2006) (same); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000) (same). The district court here, however, never reached likelihood of confusion. Under the district court’s rationale, the infringement claim under § 1114 necessarily failed because the limited federal registrations for “education services” meant that SCAD did not have rights as to “goods,” and SCAD did not provide evidence showing that it used its marks on apparel before Sportswear.⁴

⁴ Because the district court did not expressly distinguish between SCAD’s statutory causes of action, we assume that its analysis applied to both the § 1125 claims.

But the district court’s reliance on *Jurado* for that rationale was misplaced. In *Jurado* neither party had a federally-registered trademark, *see* 643 F.3d at 1316, and as a result both sides could only assert common-law trademark rights. That is why priority of use became a critical issue in that case. As we explained: “Common-law trademark rights are appropriated only through actual prior use in commerce.... Crystal [the plaintiff] bore the burden of proving its prior use.” *Id.* (citations and internal quotation marks omitted). Because SCAD’s claims revolve around federally-registered marks, *Jurado* cannot inform our analysis of the infringement claim under § 1114, a provision which requires a federally-registered mark, or under § 1125, a provision which can apply to a federally-registered mark.

IV

The question for us is whether SCAD has enforceable service mark rights that extend—beyond the services listed in its federal registrations—to goods in order to satisfy the first prong of an infringement analysis: the validity and scope of a contested mark. *See Dieter*, 880 F.2d at 326 (observing that a plaintiff must show that a mark is valid before a likelihood of confusion analysis becomes necessary). As we explain, we do not write on a clean slate, and *Boston Hockey* provides the answer to that question.

A

Before discussing *Boston Hockey*, we analyze *University of Georgia v. Laite*, 756 F.2d 1535 (11th Cir. 1985), a case that SCAD also relies on. SCAD argues

that *Laité* stands for the principle that even if a mark is registered only for services, the mark holder is entitled to broader protection in order to prevent *any* infringing conduct that is likely to cause confusion. *See* Appellant’s Br. at 17–21. We disagree with SCAD’s reading of *Laité*. Although at first glance the facts of that case closely resemble those here, there is one significant difference, and SCAD’s argument conflates the standards for service mark protection under § 1114 and § 1125.

In *Laité*, the University of Georgia Athletic Association sued to enjoin a novelty beer wholesaler from selling “Battlin’ Bulldog” beer. *See* 756 F.2d at 1537. The UGAA sued the wholesaler under § 1125 and state trademark law, but it did not (and could not) sue for infringement under § 1114. *See id.* at 1538. SCAD correctly points out that the UGAA had filed state registrations for its marks only for “athletic services,” but downplays a significant fact—at the time of the litigation, it had not yet acquired federal registrations for the contested “Georgia Bulldog” mark. *See id.* at 1537 & n.2. Federally-registered marks were not, as SCAD infers, part of the analytical line up in that case.

The key holding in *Laité* was that proof of secondary meaning (i.e., “the power of a name ... to symbolize a particular business, product, or company”) is only required for descriptive marks. *See id.* at 1540 (citation omitted). Reasoning that the “Georgia Bulldog” mascot was not a descriptive mark, we affirmed, on clear error review, the district court’s finding that the UGAA had established a likelihood of confusion based on the similarity of the Bulldog designs and the beer

wholesaler's intent. *See id.* at 1541, 1543–46. *Laite* therefore does not stand for the principle SCAD advocates. *See Belen Jesuit Preparatory Sch., Inc. v. Sportswear, Inc.*, 2016 WL 4718162, at *6 (S.D. Fla. May 3, 2016) (explaining that *Laite* did not involve or analyze federally-registered marks).

B

Although *Laite* does not resolve the question before us, our binding 1975 decision in *Boston Hockey* stands on different footing. As SCAD correctly asserts, *Boston Hockey* extends protection for federally-registered service marks to goods, and therefore beyond the area of registration listed in the certificate.

In *Boston Hockey*, the National Hockey League and twelve of its member teams sued to prevent a manufacturer from selling embroidered sew-on patches featuring the teams' federally-registered service marks. *See* 510 F.2d at 1008. Like SCAD, most of the hockey teams had registered marks only in connection with the provision of services, and held no registrations for goods, apparel, or promotional merchandise. *See id.* at 1009. Two of the hockey teams had also registered their marks for certain goods, *see Boston Prof'l Hockey Ass'n Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 360 F.Supp. 459, 461 (N.D. Tex. 1973), but we conducted the § 1114 infringement analysis without distinguishing the teams on that basis. *See* 510 F.2d at 1011.

The *Boston Hockey* panel phrased the issue of first impression as “whether the unauthorized, intentional duplication of a professional hockey team's symbol ... to be sold ... as a patch for attachment to clothing, violates

any legal right of the team to the exclusive use of that symbol.” *Id.* at 1008. As SCAD has done in this case, the NHL and its hockey teams sued for violations of §§ 1114 and 1125 of the Lanham Act, and for common-law unfair competition. *Id.* at 1009. The material facts here are very similar to those in *Boston Hockey*, with one main exception. The manufacturer in *Boston Hockey* sold only mark-replica patches, and did not affix the teams’ marks to other goods such as t-shirts or jackets. *See id.* The panel acknowledged that trademark law generally protects against the sale of “something other than the mark itself,” *see id.* at 1010, but concluded that each team had an interest in its mark “entitled to legal protection against such unauthorized duplication.” *Id.* at 1008.

Recognizing that its “decision ... [could] slightly tilt the trademark laws from the purpose of protecting the public to the protection of the business interests of [the teams],” the *Boston Hockey* panel was persuaded that granting relief was appropriate because the teams’ efforts gave commercial value to the patches, and “the sale of a reproduction of the trademark itself on [a patch] is an accepted use of such team symbols” in the arena of professional sports. *See id.* at 1011. When it came to the statutory claim under § 1114, the panel reasoned that the teams’ marks were validly registered and skipped straight to determining whether the manufacturing company’s use was likely to cause confusion. *See id.* Absent from the panel’s analysis was an explanation for how or why the teams’ registrations for “hockey entertainment services” provided statutory protection as to goods like embroidered patches.

In the end, the *Boston Hockey* panel rejected the manufacturer’s argument that consumer confusion must derive from the “source of the manufacture” of the mark because the mark, “originated by the team, [was] the triggering mechanism for the sale of the [patch].” *Id.* at 1012. In other words, “[t]he confusion ... requirement [wa]s met by the fact that the [manufacturer] duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams’ trademarks.” *Id.*

Boston Hockey, though in our view lacking critical analysis, implicitly but necessarily supports the proposition that the holder of a federally-registered service mark need not register that mark for goods—or provide evidence of prior use of that mark on goods—in order to establish the unrestricted validity and scope of the service mark, or to protect against another’s allegedly infringing use of that mark on goods. On remand, the district court will have to review SCAD’s claims under § 1114 and § 1125 in light of *Boston Hockey*.⁵

Among other things, the district court will need to assess the strength of SCAD’s word marks. *See, e.g., Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1357–58 (11th Cir. 2007) (describing the “four gradations of distinctiveness”). And it will have to consider whether

⁵ Given that *Boston Hockey* controls, we need not and do not address whether SCAD used its word marks on apparel prior to Sportswear or whether the district court properly excluded an article on a website submitted by SCAD.

SCAD has demonstrated that Sportswear’s use of its word marks is likely to create consumer confusion as to origin, source, approval, affiliation, association, or sponsorship. See *Burger King Corp. v. Mason*, 710 F.2d 1480, 1491–92 (11th Cir. 1983); *Professional Golfers Ass’n of Am. v. Bankers Life & Casualty Co.*, 514 F.2d 665, 670 (5th Cir. 1975).

Once a party has shown an enforceable right in a mark, a court usually considers a number of factors in assessing whether an infringing use is likely to cause confusion. These are “(1) the strength of the allegedly infringed mark; (2) the similarity of the infringed and infringing marks; (3) the similarity of the goods and services the marks represent; (4) the similarity of the parties’ trade channels and customers; (5) the similarity of advertising media used by the parties; (6) the intent of the alleged infringer to misappropriate the proprietor’s good will; and (7) the existence and extent of actual confusion in the consuming public.” *Florida Int’l Univ. Bd. of Trustees v. Florida Nat’l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016). Generally, “the type of mark and the evidence of actual confusion are the most important” factors. *Id.* (citation omitted); *Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC*, 605 F.3d 931, 935 (11th Cir. 2010).

We add one final note about the confusion analysis. The confusion discussion in *Boston Hockey*, 510 F.2d at 1012, came under strong criticism because it “did not require proof of a likelihood that customers would be confused as to the source or affiliation or sponsorship of [the] defendant’s product,” and instead only asked whether “customers recognized the products as bearing

a mark of the plaintiff[s].” 4 McCarthy on Trademarks § 24:10 (describing the “heresies” of *Boston Hockey* and concluding that its “attempt to stretch trademark law failed”). See also Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461, 474 (2005) (“The court [in *Boston Hockey*] ... presumed actionable confusion based solely on the consumer’s mental association between the trademark and the trademark holder.”).

In a binding decision issued only two years later, however, we read *Boston Hockey* narrowly, limited its confusion analysis to the facts in the case, and explained that it did not do away with traditional confusion analysis. See *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 389 (5th Cir. 1977) (“[W]e do not believe *Boston Hockey* equates knowledge of the symbol’s source with confusion sufficient to establish trademark infringement, and we deem the confusion issue unresolved by our existing decisions.”). The current Fifth Circuit echoed that discussion and similarly retreated from a broad reading of *Boston Hockey*. See *Bd. of Supervisors for Louisiana State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485 (5th Cir. 2008) (reiterating “that a showing of likelihood of confusion [i]s still required [and] ... not[ing] that the circumstances in *Boston Hockey* supported ... ‘the inescapable inference that many would believe that the product itself originated with or was somehow endorsed by [the teams]’ ”) (citation omitted); *Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co.*, 676 F.2d 1079, 1084–85 & n.7 (5th Cir. 1982) (clarifying that confusion must stem from a perceived connection between the product and the

rightful owner of the mark because “[i]t is not enough that typical buyers purchase the items because of the presence of the mark”).⁶

So, although the district court on remand is to apply *Boston Hockey* as to the validity and scope of SCAD’s service marks, it will have to analyze what impact, if any, the case has on the confusion issue.

C

We pause to note the unexplained analytical leap in *Boston Hockey*. Under the Lanham Act, registration is “*prima facie* evidence of the *validity* of the registered mark ..., of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or *in connection with the goods or services specified in the registration.*” § 1115(a) (emphasis added). If that is so, then one would think that there should be some legal basis for extending the scope of a registered service mark in a certain field (e.g., educational services) to a different category altogether (e.g., goods). As we have noted elsewhere, “[d]etermining whether an infringement has taken place is but the obverse of determining whether the service mark owner’s property right extends into a given area.”

⁶ In passing, we note that *Laite* has also been recognized—albeit to a much lesser extent—as providing protection where the owner of a common-law mark has not adequately established confusion as to the origin of a contested product. See, e.g., Steve McKelvey & Ari J. Sliffman, *The Merchandising Right Gone Awry: What “Moore” Can Be Said?*, 52 Am. Bus. L.J. 317, 343 (2015) (discussing the “judicial trend expanding the concept of a ‘merchandising right’ “).

Jellibeans, Inc. v. Skating Clubs of Georgia, Inc., 716 F.2d 833, 839 (11th Cir. 1983).

Yet *Boston Hockey* does not provide any basis for extending service mark rights to goods. This silence is potentially problematic for several reasons.

First, other circuits have said that service marks do not by their nature extend to goods or products. See *Murphy v. Provident Mut. Life Ins. Co. of Philadelphia*, 923 F.2d 923, 927 (2d Cir. 1990) (“Clearly, the term [‘services’ in the Lanham Act] does not apply to goods or products.”); *Application of Radio Corp. of Am.*, 205 F.2d 180, 182 (C.C.P.A. 1953) (“Clearly had Congress intended service marks to apply to goods or products, we believe it would have so stated.”). See also A. Samuel Oddi, *The Functioning of ‘Functionality’ in Trademark Law*, 22 U. Houston L. Rev. 925, 958 (1985) (“In fact, the marks that had been registered by the hockey teams [in *Boston Hockey*] were service marks, and it may be questioned whether it is appropriate to extend service mark protection to ‘goods’ [the patches].”). If these other circuits and commentators are wrong, in whole or in part, we should explain why.

Second, a right in a mark is not a “right in gross.” *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97, 39 S.Ct. 48, 63 L.Ed. 141 (1918). This means that “[t]here is no property in a [mark] apart from the business or trade in connection with which it is employed.” *American Steel Foundries v. Robertson*, 269 U.S. 372, 380, 46 S.Ct. 160, 70 L.Ed. 317 (1926) (addressing trademarks). The decision in *Boston Hockey*, however, seems to provide the holder of a service mark with a form of monopolistic protection, a

so-called “independent right to exclude.” 4 McCarthy on Trademarks § 24:10. *See also United States v. Giles*, 213 F.3d 1247, 1250 (10th Cir. 2000) (noting that even though the teams in *Boston Hockey* “had not registered their marks for use on patches, the [former Fifth Circuit] essentially gave the[m] a monopoly over use of the trademark in commercial merchandising”); *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980) (“Interpreted expansively, *Boston Hockey* holds that a trademark’s owner has a complete monopoly over its use, including its functional use, in commercial merchandising. But our reading of the Lanham Act and its legislative history reveals no congressional design to bestow such broad property rights on trademark owners.”) (footnote omitted).

Third, it is well-settled that trademark (and service mark) rights are derived through use, *see, e.g., United Drug*, 248 U.S. at 97, 39 S.Ct. 48, and we have not critically analyzed whether the procedural advantages of a mark’s registration, *see Laite*, 756 F.2d at 1541, or incontestability, *see Dieter*, 880 F.2d at 325–26, can serve as a basis for expanding the scope of service mark protection to a tangible good or product. *See* 3 McCarthy on Trademarks § 19:3 (explaining that, although registering a mark provides procedural and legal benefits, “the registration does not create the trademark”); *id.* at § 32:141 (observing that “the case law usually discusses incontestability when a plaintiff asserts incontestability as the source of its right to be secure from a challenge to the validity of its mark”). *Cf. In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1353 (Fed. Cir. 2001) (observing that “[a] registered mark is

incontestable only in the form registered and for the goods or services claimed”).

We recognize that, as to federally-registered trademarks, we have not limited protection to the actual product or products listed in the certificate of registration. “The remedies of the owner of a registered trademark,” we have held, “are not limited to the goods specified in the certificate, but extend to any goods on which the use of an infringing mark is ‘likely to cause confusion.’ ” *Continental Motors Corp. v. Continental Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) (citation omitted). *See also E. Remy Martin & Co., S.A. v. Shaw-Ross Int’l Imports, Inc.*, 756 F.2d 1525, 1530 (11th Cir. 1985) (examining the similarity of products factor, we acknowledged that registered trademark rights may “extend to any goods related in the minds of consumers in the sense that a single producer is likely to put out both goods”). *Accord* 6 McCarthy on Trademarks §§ 32:137, 32:152. Yet extending the scope of a registered trademark (which identifies “goods”) to a different product appears to be qualitatively different from extending the scope of a registered service mark (which identifies “services”) to a different category of “goods.”

There may be a sound doctrinal basis for what *Boston Hockey* did. But unless the concept of confusion completely swallows the antecedent question of the scope of a registered mark, we have yet to hear of it.

V

On some level, we understand that allowing a party to “take a free ride on another’s registered trademark,”

see *B. H. Bunn Co. v. AAA Replacement Parts Co.*, 451 F.2d 1254, 1261 (5th Cir. 1971), simply feels wrong. Trademark rights, however, do “not confer a right to prohibit the use of [a] word or words” generally and exist “to protect the owner’s good will against the sale of another’s product as his.” *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368, 44 S.Ct. 350, 68 L.Ed. 731 (1924).

If *Boston Hockey* did not exist, the district court’s rationale might provide a reasonable way of analyzing the alleged infringement of registered service marks through their use on goods. But *Boston Hockey* is in the books, and it compels reversal of summary judgment in favor of Sportswear. Although there may be “error in [that] precedent,” *United States v. Romeo*, 122 F.3d 941, 942 n.1 (11th Cir. 1997), we do not have the authority, as a later panel, to disregard it. The case is remanded to the district court for further proceedings consistent with this opinion.

REVERSED AND REMANDED.

22a

Appendix B

United States District Court,
N.D. Georgia,
Atlanta Division.

SAVANNAH COLLEGE OF ART
AND DESIGN, INC.,
Plaintiff,

v.

SPORTSWEAR, INC. doing business
as PrepSportswear,
Defendant.

Civil Action File No. 1:14-CV-2288-TWT.

Filed Aug. 3, 2015.

OPINION AND ORDER

THOMAS W. THRASH, JR., District Judge.

This is a trademark infringement case. It is before the Court on the Defendant's Motion for Summary Judgment [Doc. 39], the Plaintiff's Motion for Summary Judgment [Doc. 40], and the Defendant's Motion to Strike Improper Evidence [Doc. 50]. For the reasons stated below, the Defendant's Motion for Summary Judgment is GRANTED and the Plaintiff's Motion for Summary Judgment is DENIED. The Defendant's Motion to Strike Improper Evidence is GRANTED in part and DENIED as moot in part.

I. Background

The Plaintiff, Savannah College of Art and Design, Inc., was founded in 1978 as a private, non-profit college.¹ The Plaintiff now has campuses in Savannah, Atlanta, Hong Kong, and Lacoste, France.² The Plaintiff's business is providing educational services.³ The Plaintiff owns several service mark registrations: Registration No. 3,751,493 for a circular bee design,⁴ Registration No. 3,118,809 for a circular shield design,⁵ Registration No. 2,686,644 for the text mark "SCAD,"⁶ and Registration No. 2,918,888 for the text mark "Savannah College of Art and Design."⁷ All of the registrations were issued in connection with the provision of educational services.⁸ None of the marks are registered for use in connection with the sale of clothing or headwear.⁹ Additionally, the Plaintiff has no evidence of when any of the marks were first used in

¹ Def.'s Statement of Facts ¶ 1.

² *Id.*

³ *Id.* ¶ 2.

⁴ *Id.* ¶ 4.

⁵ *Id.* ¶ 8.

⁶ *Id.* ¶ 14.

⁷ *Id.* ¶ 17.

⁸ *Id.* ¶¶ 5, 9, 15, 18.

⁹ *Id.* ¶¶ 6, 10, 16, 19.

connection with the sale of apparel or related goods.¹⁰ The Plaintiff did enter into a license agreement with Follett in June of 2011, which allowed Follett to provide licensed apparel at the campus bookstores.¹¹

The Defendant, Prep Sportswear, is an internet-based business incorporated under Washington law in 2005.¹² The Defendant sells customizable apparel and fan clothing for a variety of organizations, including high school and college sports teams.¹³ In August of 2009, the Defendant began selling goods bearing the words “Savannah College of Art and Design” and “SCAD.”¹⁴ The Plaintiff alleges that the Defendant infringed its trademarks under both the Lanham Act and Georgia law. Both parties now move for summary judgment.

II. Legal Standard

Summary judgment is appropriate only when the pleadings, depositions, and affidavits submitted by the parties show no genuine issue of material fact exists and that the movant is entitled to judgment as a matter of law.¹⁵ The court should view the evidence and any inferences that may be drawn in the light most favorable

¹⁰ *Id.* ¶ 24.

¹¹ *Id.* ¶¶ 27-30.

¹² *Id.* ¶ 44.

¹³ *Id.* ¶ 45.

¹⁴ *Id.* ¶¶ 53-54.

¹⁵ Fed. R. CIV. P. 56(a)

to the nonmovant.¹⁶ The party seeking summary judgment must first identify grounds to show the absence of a genuine issue of material fact.¹⁷ The burden then shifts to the nonmovant, who must go beyond the pleadings and present affirmative evidence to show that a genuine issue of material fact does exist.¹⁸ “A mere ‘scintilla’ of evidence supporting the opposing party’s position will not suffice; there must be a sufficient showing that the jury could reasonably find for that party.”¹⁹

III. Discussion

Both the Plaintiff and the Defendant move for summary judgment on the Plaintiff’s claims under the Lanham Act and Georgia law. In the Eleventh Circuit, “the use of another’s unregistered, i.e., common law, trademark can constitute a violation of [section 43(a) of the Lanham Act].”²⁰ To establish a violation, a plaintiff must show that it had enforceable rights in the mark and “that the defendant made unauthorized use of it such

¹⁶ *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 158-59, 90 S.Ct. 1598, 26 L.Ed.2d 142 (1970).

¹⁷ *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

¹⁸ *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 257, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

¹⁹ *Walker v. Darby*, 911 F.2d 1573, 1577 (11th Cir. 1990).

²⁰ *Crystal Entertainment & Filmworks, Inc. v. Jurado*, 643 F.3d 1313, 1320 (11th Cir.2011)

that consumers were likely to confuse the two.”²¹ It is well established in trademark law “that a mark can identify and distinguish only a single commercial source.”²² “Common-law trademark rights are appropriated only through actual prior use in commerce.”²³ Additionally, registration of a mark is prima facie evidence “of the registrant’s exclusive right to use the registered mark in commerce or in connection with the goods or services specified in the registration.”²⁴ That presumption, however, only applies to the goods or services specified in the registration, not to all goods and services.²⁵

Here, the parties agree that the Plaintiff has valid registrations for the four marks at issue. Those registrations are for use of the marks in connection with educational services. The Plaintiff admits that it does not have registrations for the marks related to apparel. Instead, the Plaintiff argues that it needs no such registrations. That is not the case. Because the Plaintiff does not have registered marks for apparel, it must show that it used the marks in commerce prior to the Defendant’s use.²⁶ The Plaintiff has not presented

²¹ *Id.*

²² *Id.*

²³ *Id.* at 1321.

²⁴ 15 U.S.C. § 1115(a).

²⁵ *Gameologist Grp., LLC v. Scientific Games Int’l, Inc.*, 838 F.Supp.2d 141, 153 (S.D.N.Y.2011).

²⁶ *Crystal Entertainment*, 643 F.3d at 1321.

that evidence. In fact, the deposition of Hannah Flowers demonstrated that there are no records of when the Plaintiff first used its marks on apparel.²⁷ The Plaintiff also initially admitted that it did not have any evidence of when the marks were first used.²⁸

In its reply in support of its motion for summary judgment, the Plaintiff attempted to introduce a website indicating prior use of the marks on apparel. The Defendant moved to strike that evidence, along with two other pieces of evidence cited in the Plaintiff's reply brief. The Court considers the motion to strike as a motion to exclude, given that motions to strike are not the proper method for challenging the admissibility of evidence on summary judgment.²⁹ For two reasons, the motion to exclude the website should be granted. First, the evidence and argument were raised for the first time in a reply brief. Arguments raised for the first time in a reply brief may not be considered by the Court.³⁰ Second, even if this Court could consider an argument raised for the first time in a reply brief, it would not consider the evidence here. Both in a 30(b)(6) deposition and in its response to the Defendant's Statement of Facts, the Plaintiff stated that it had no evidence of when the marks at issue were first used on apparel. Under the principle of estoppel, therefore, this Court will not permit the Plaintiff to introduce

²⁷ Flowers Dep. At 16.

²⁸ Pl.'s Resp. to Def.'s Statement of Facts ¶ 24.

²⁹ Fed.R.Civ.P. 56(c)(2); *Id.* advisory committee's note of 2010.

³⁰ *United States v. Oakley*, 744 F.2d 1553, 1556 (11th Cir.1984).

evidence to contradict its earlier admissions. The Defendant's motion to exclude the evidence on page 2, footnote 1, of the Plaintiff's Reply in Support of its Motion for Summary Judgment should therefore be granted. The remainder of the motion to exclude addresses evidence the Court does not need to consider in ruling on the motions for summary judgment and should be denied as moot.

Because the Plaintiff fails to present admissible evidence showing that it has enforceable rights in a mark related to apparel, the Defendant's motion for summary judgment on the Plaintiff's Lanham Act claims should be granted and the Plaintiff's motion for summary judgment should be denied. The analysis under the Georgia Uniform Deceptive Trade Practices Act ("GUDTPA") is "co-extensive" with the analysis under the Lanham Act.³¹ The Defendant's motion for summary judgment on the Plaintiff's claim under the GUDTPA should also be granted. The Plaintiff's motion should be denied.

IV. Conclusion

For the reasons stated above, the Defendant's Motion for Summary Judgment [Doc. 39] is GRANTED. The Plaintiff's Motion for Summary Judgment [Doc. 40] is DENIED. The Defendant's Motion to Strike Improper Evidence [Doc. 50] is GRANTED in part and DENIED as moot in part.

SO ORDERED, this 31 day of July, 2015.

³¹ *Optimum Techs., Inc. v. Henkel Consumer Adhesives, Inc.*, 496 F.3d 1231, 1248 n. 11 (11th Cir.2007).

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IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 15-13830-BB

SAVANNAH COLLEGE OF ART AND DESIGN, INC.
Plaintiff – Appellant,

versus

SPORTSWEAR, INC., d.b.a. PrepSportswear,
Defendant – Appellee.

Appeal from the United States District Court
for the Northern District of Georgia

ON PETITION(S) FOR REHEARING AND
PETITION(S) FOR REHEARING ENBANC

BEFORE: MARTIN and JORDAN, Circuit Judges,
and COOGLER, District Judge.

PER CURIAM:

The petition(s) for Rehearing are DENIED and no Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc (Rule 35, Federal Rules of Appellate Procedure), the Petition(s) for Rehearing En Banc are DENIED.

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ENTERED FOR THE COURT:

/ss/

UNITED STATES CIRCUIT JUDGE

Appendix D

Section 33(a) of the Lanham Act, 15 U.S.C. § 1115(a), provides:

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.

Section 32(1)(a) of the Lanham Act, 15 U.S.C. § 1114(1)(a), provides in relevant part:

Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with

which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1), provides:

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship,

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or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.