

No. 17-1316

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**In the  
Supreme Court of the United States**

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

*Petitioner,*

v.

SAVANNAH COLLEGE OF ART AND DESIGN, INC.,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT

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**BRIEF IN OPPOSITION**

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## **QUESTION PRESENTED**

The petition presents the following question:

“Does the scope of a federally registered service mark extend to unrelated goods bearing that service mark?” Pet. i.

**RULE 29.6 STATEMENT**

The Savannah College of Art and Design, Inc., does not have a parent corporation, and no publicly held corporation owns stock in it.

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## INTRODUCTION

Over the last four decades, the Savannah College of Art and Design (“SCAD”) has emerged as one of the nation’s leading universities for creative professionals. Through the hard work of its founder, many dedicated employees, and thousands of remarkable students and proud alumni, the SCAD name is well known and respected for excellence in intensely competitive fields like advertising, architecture, fashion, film and television, and graphic design. And SCAD has registered several service marks bearing its name, logo, and initials with the U.S. Patent and Trademark Office.

In 2009, Petitioner Sportswear, Inc. (“Sportswear”) decided to take advantage of consumers’ positive associations with SCAD to generate profits for itself. Operating entirely without SCAD’s permission, it opened up an online “Savannah College of Art and Design Bees Apparel Store.” Through that store, Sportswear sold apparel that featured SCAD’s name, SCAD’s mascot (a bee), and even messages like “Property of SCAD Bees” alongside the year of SCAD’s founding (1978). It did not remit any portion of its proceeds to SCAD, and refused to stop selling its line of SCAD-branded apparel even after SCAD demanded it do so.

In the decision below, the Eleventh Circuit reached the hardly surprising conclusion that Sportswear’s blatant co-opting of SCAD’s hard-won reputation raised triable issues under the Lanham Act and remanded for a likelihood-of-confusion determination. *See* Pet. App. 14a-15a (on remand the district “will have to consider whether 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”). Nothing in the Eleventh Circuit’s interlocutory decision warrants this Court’s review.

In arguing otherwise, Sportswear has constructed an entire petition on the premise that the Eleventh Circuit’s decision will allow markholders to recover for use of their mark on “unrelated goods.” Pet. i (Question Presented). But that premise is simply unfounded. In the trademark and unfair competition context, whether goods and services are “related” depends on whether “buyers are likely to believe that such goods, similarly marked, come from the same source, or are somehow connected with or sponsored by the same company.” 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:1 (5th ed. 2018, Westlaw). Goods are “unrelated” for trademark purposes only when there is no likelihood of consumer confusion. But where there is a likelihood of confusion, goods are “related” and the markholder can recover if it satisfies the other elements of an infringement claim.

The Eleventh Circuit did not find that the goods at issue were “unrelated.” Indeed, the word “unrelated” does not even appear in its decision. And, as noted, the Eleventh Circuit remanded for a likelihood-of-confusion determination. To be clear, *no one* contends that federal registration of a service mark protects against use of the mark on “unrelated goods” (Pet. i)—not SCAD, not the Eleventh Circuit, nor any other court of which we are aware. The dispute here is about whether the goods are actually “unrelated”—a factual question that the district court will resolve in the first instance on remand. SCAD is prepared to show that the goods are related, in that consumers

would be confused about the source, sponsorship, or affiliation of Sportswear’s knock-off apparel. But if Sportswear is able to show on remand that there is no likelihood of confusion, it will prevail.

Once the faulty premise on which the petition rests is corrected, it becomes obvious that there is no circuit conflict on the Question Presented, and no need at all for this Court’s review. The leading treatise on trademark law, writing approvingly about the Eleventh Circuit’s decision in this specific case, has recognized that “[i]t is clear” that the result in this case is correct under the law applied throughout the country: “There is *no doubt* that a registered service mark can be infringed by use on goods.” 4 McCarthy, *supra*, § 24:65 & n.6.30 (emphasis added). Meanwhile, the rule that Sportswear tries to extract from a single ambiguous 1985 Third Circuit decision, under which a federally registered service mark like SCAD’s can never be infringed through use on goods, “is not the law anywhere.” *Id.* § 24:65 n.7.

What remains is a transparent request for error correction centered on a more than 40-year-old court of appeals’ decision—*Boston Professional Hockey Ass’n v. Dallas Cap & Eblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975). But that attack, too, is misguided. To the extent that Sportswear argues that *Boston Hockey* wrongly establishes that a service mark can be infringed by use on goods, Sportswear is wrong for the reasons just discussed: It is blackletter law that a service mark can be infringed by use on goods. And to the extent that Sportswear suggests that *Boston Hockey* must be eradicated because it has been criticized more generally, its attack is off base. The critiques of *Boston Hockey* on which Sportswear relies are focused

on that decision's failure to engage in a traditional likelihood-of-confusion analysis, but the Fifth Circuit disavowed that aspect of *Boston Hockey* in 1977. See 4 McCarthy, *supra*, § 24:10. Confirming the point, the decision below remanded for just such an analysis.

The petition should be denied.

## STATEMENT OF THE CASE

### A. Legal Background

Congress has long played a role in protecting “trademarks” and “service marks,” which are distinctive marks used to distinguish goods or services and thus protect a markholder’s “good will” and “good reputation.” *Matal v. Tam*, 137 S. Ct. 1744, 1751-52 (2017) (citations omitted); see *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015). The regulation of such marks protects consumers by helping them to “identify goods and services that they wish to purchase, as well as those they want to avoid.” *Matal*, 137 S. Ct. at 1751.

The Lanham Act establishes three complimentary features of particular relevance here. *First*, the Act provides for national registration of trademarks and service marks. See 15 U.S.C. §§ 1052-53. Such registration is not a prerequisite to assertion of rights in the marks (because, as discussed below, a separate section of the Act may be asserted to protect unregistered marks), but registration confers certain benefits that make it easier to prevail on a claim of infringement. For example, the registration provides “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.” 15 U.S.C. § 1115(a).

*Second*, Section 32(a) of the Lanham Act makes it a violation of federal law to infringe a federally registered mark. Codified at 15 U.S.C. § 1114(1)(a), that provision broadly forbids any person to “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.” *Id.* § 1114(1)(a) (emphasis added). Section 32(a)’s use of “any goods or services” underscores the scope of the protection.

*Third*, Section 43(a)(1)—which applies to both registered and *unregistered* marks—creates federal civil liability for “[a]ny 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, . . . which . . . 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, as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” *Id.* § 1125(a)(1)(A) (emphasis added).

The elements of a claim under either Section 32(a) or Section 43(a)(1) are largely identical: (1) The plaintiff owns a valid and legally protectable mark; (2) the defendant used that mark or a similar mark in connection with “any goods or services” without consent; and (3) the defendant’s use of the mark at issue caused a likelihood of confusion. *See generally Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763,

784 (1992) (“The aim of the amendments [in Section 43(a)] was to apply the same protections to unregistered marks as were already afforded to registered marks.”); 5 McCarthy, *supra*, § 27:18. The difference is that Section 32(a) applies only to registered trademarks, and Section 43(a) applies to registered as well as unregistered trademarks.

### **B. Factual Background**

SCAD is one of the nation’s leading universities for undergraduate and graduate students in creative fields like advertising, architecture, graphic design, fashion, film and television, the fine arts, and writing. Founded in 1978, it currently enrolls more than 11,000 students. SMF ¶¶ 3-4.<sup>1</sup> With students and faculty hailing from all 50 states and more than 100 different countries, and campuses in Savannah, Atlanta, Hong Kong, and Lacoste, France, *id.* ¶¶ 5, 2, it has a globe-spanning reputation for excellence in education for creative professionals.

SCAD has used the “SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN” marks since 1979. *Id.* ¶ 8. In 2001, it began using an additional mark, consisting of a bee—“Art the Bee,” SCAD’s mascot—in the middle of a circle containing the words “SAVANNAH COLLEGE OF ART AND DESIGN BEES,” as follows<sup>2</sup>:

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<sup>1</sup> “SMF” refers to the Statement of Undisputed Material Facts SCAD filed along with its motion for summary judgment in the district court, ECF No. 40.

<sup>2</sup> See Compl. Exh. D, ECF No. 1-4.



*Id.* ¶ 9. SCAD registered each of those marks with the U.S. Patent and Trademark Office for inclusion on the principal register, based on its use of the marks in connection with the provision of educational services.

*Id.* ¶¶ 8-13.

SCAD does not limit the use of its marks to educational services. SCAD also uses the marks in connection with its varsity athletic programs in golf, tennis, lacrosse, soccer, swimming, fishing, and other sports. In addition, contrary to the assertions in Sportswear’s petition, SCAD has long made apparel featuring the marks available for sale to students and the general public—just as the vast majority of colleges and universities do. *See* Compl. ¶ 19. The parties dispute when SCAD first began selling apparel with SCAD marks, but SCAD has presented evidence that it has sold such apparel since at least 2008—before Sportswear began selling its knock-off

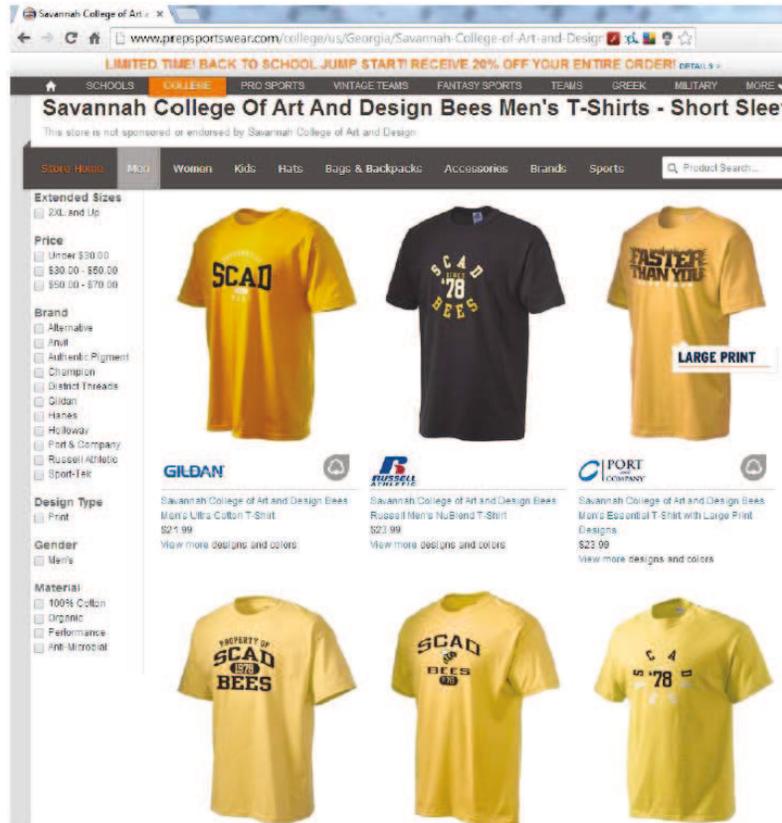
SCAD apparel. *See infra* at 10-11.<sup>3</sup> Many of the shirts and other items SCAD offers featuring its marks have been designed by SCAD's students. SMF ¶ 14.

In 2014, SCAD learned that its marks were being used without authorization by Sportswear, an internet-based retailer. *Id.* ¶ 17. Through an online "Savannah College of Art and Design Bees Apparel Store" that Sportswear had created on its own website, Sportswear was offering for sale thousands of items bearing SCAD's marks. *Id.* ¶¶ 17, 46. Many of the SCAD-branded products Sportswear offered were the same as or substantially similar to the SCAD-branded products that SCAD itself makes available to consumers online and in its campus bookstores through an arrangement with its licensed partner, Follett Education Group, Inc. *Id.* ¶¶ 14-15, 46. The following image from Sportswear's website provides a sampling of Sportswear's offerings<sup>4</sup>:

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<sup>3</sup> As discussed below, the district court excluded this evidence on the ground that it was not identified and produced until SCAD's reply in support of summary judgment (which was when SCAD discovered it). *See* Pet. App. 27a-28a. SCAD appealed that ruling, but the Eleventh Circuit did not reach the issue in its decision. In any event, Sportswear has never offered any reason to doubt the *veracity* of the evidence SCAD offered about SCAD's pre-2009 sales of SCAD-branded apparel.

<sup>4</sup> *See* Compl. ¶ 29.



### C. Procedural History

After Sportswear rebuffed SCAD's repeated requests for it to cease selling its unlicensed SCAD-branded products, SCAD brought this action in the Northern District of Georgia. It asserted claims under Sections 32 and 43(a) of the Lanham Act, as well as additional claims for trademark violation and unfair competition under Georgia law.

After discovery, the parties cross-moved for summary judgment. The district court denied SCAD's motion and granted Sportswear's. In doing

so, it focused on the fact that SCAD's federal registration of its marks had described SCAD's use of those marks in connection with educational services, and did not list SCAD's use of the marks on goods or apparel. Pet. App. 26a. In the district court's view, "[b]ecause [SCAD] does not have registered marks for apparel, it must show that it used the marks in commerce prior to the Defendant's use." *Id.*

In evaluating whether SCAD had done so, the district court focused solely on whether SCAD had presented evidence about its use of the mark on *goods*, ignoring SCAD's other use of the marks in commerce. *Id.* at 26a-27a. And as to SCAD's uses of the marks on apparel, the district court excluded evidence SCAD had uncovered for the first time during its summary judgment briefing—a news story describing SCAD's intentions in 2008 to expand its then-existing sales of SCAD-branded apparel—showing that SCAD had been selling branded apparel since at least 2008, before Sportswear's first sales in 2009. *Id.* at 27a; *see also* SCAD Reply in Supp. of Summ. J. 2 n.1, ECF No. 49 (citing Noell Barnidge, *Sports merchandising lucrative*, Savannah Morning News, Jan. 26, 2008, <http://www.savannahnow.com/sports/2008-01-26/sports-merchandising-lucrative>).

The district court stated that it would not consider this evidence because it was identified for the first time in SCAD's reply brief in support of summary judgment and SCAD had earlier represented that it was unaware of evidence as to precisely when SCAD began selling apparel with its own marks (a representation that was true when made). Pet. App. 27a. Refusing to consider evidence showing that SCAD sold branded apparel before Sportswear did, and believing that the law required SCAD to make

that showing to secure relief under the Lanham Act, the court entered summary judgment for Sportswear.

The Eleventh Circuit reversed. The court recognized that SCAD's claims under Sections 32 and 43(a) of the Lanham Act both turned, at bottom, on whether SCAD could "show 'enforceable trademark rights in [a] mark or name'" and that "Sportswear 'made unauthorized use of [its marks] 'such that consumers were likely to confuse the two.'" Pet. App. 8a (alterations in original) (citation omitted). The district court, however, had "never reached likelihood of confusion" because "[u]nder the district court's rationale, the infringement claim . . . 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 that it used its marks on apparel before Sportswear." *Id.* at 9a.

The Eleventh Circuit concluded that the district court's approach contravened governing circuit precedent under which "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." *Id.* at 14a (citing *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg, Inc.*, 510 F.2d 1004 (5th Cir. 1975)) (emphasis omitted).

Having rejected the district court's categorical holding that a federally registered service mark can never be infringed through use of a mark on goods unless the markholder used the mark on those goods before the accused infringer, the Eleventh Circuit remanded to the district court to "assess the strength

of SCAD's word marks" and "consider whether 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." *Id.* at 14a-15a.

SCAD also challenged the district court's refusal to consider the evidence it produced in support of summary judgment showing that it had sold apparel using its marks since at least 2008. *See* SCAD CA11 Br. 40-44; SCAD CA11 Reply 26-28. The Eleventh Circuit, however, found it unnecessary to reach that issue in light of its decision. Pet. App. 14a n.5 (declining to "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" in light of its analysis).

The Eleventh Circuit denied Sportswear's petition for rehearing and rehearing *en banc*, with no judge requesting a poll on the petition.

### **REASONS FOR DENYING THE WRIT**

The petition ultimately rests on three central premises, each of which is faulty:

*First*, Sportswear bases its Question Presented, and thus its entire case for review, on the premise that the Eleventh Circuit held that trademark rights extend to "unrelated goods." Pet. i. But the Eleventh Circuit made no such holding. Under blackletter law, whether goods or services are "related" for purposes of trademark law depends on whether consumers "are likely to believe that such goods, similarly marked, come from the same source, or are somehow connected with or sponsored by the same company." 4 McCarthy, *supra*, § 23:1. The Eleventh Circuit remanded for further proceedings on that exact

question. Pet. App. 14a-15a. As it comes to the Court, therefore, there is no finding that the goods are “unrelated” and *no one* argues that the protection of a registered trademark extends to unrelated goods. The Question Presented simply is not presented.

*Second*, Sportswear argues that the Eleventh Circuit’s decision presents “irreconcilable” and “square[] conflicts” with the decisions of other courts of appeals. Pet. 19. Again, not so. Sportswear has identified no other decision from any other circuit that reaches a contrary result on similar facts, and thus, has failed to identify a “square” or “irreconcilable” conflict. And the Eleventh Circuit’s decision is fully consistent with the approach taken in other courts around the country. Indeed, the leading authority on trademark law has observed that the rule that Sportswear advocates in its petition—which is based on a questionable reading of a single, decades-old Third Circuit opinion discussed below—“is not the law anywhere.” 4 McCarthy, *supra*, § 24:65 n.7.

*Third*, and finally, Sportswear argues—over and over—that the rule applied in the decision below is “literally indefensible.” Pet. 15. Here again, it overreaches. As Professor McCarthy said about this very case, it is “clear” that the Eleventh Circuit’s rule is correct, and consistent with the rule in courts around the country, notwithstanding the panel’s evident confusion about the basis for the rule it applied. 4 McCarthy, *supra*, § 24:65 & n.6.40. And while Sportswear is right that the *Boston Hockey* decision has been subjected to criticism, those criticisms have largely centered on aspects of *Boston Hockey* (like the court’s disavowal of a traditional likelihood-of-confusion analysis) that have—as

Sportswear itself acknowledges (at 28)—nothing to do with this case.

The petition should be denied.

### **I. SPORTSWEAR’S QUESTION PRESENTED IS BASED ON A FALSE PREMISE**

Sportswear has a major problem from the outset. The central premise of the Question Presented in its petition, and of its argument more generally, is that the Eleventh Circuit’s decision extends protection of a service mark to “unrelated goods.” Pet. i. That premise, however, is simply false.

Not only did the Eleventh Circuit never *say* that the goods at issue were “unrelated,” but it specifically remanded the case for the district court to decide that issue. As a matter of blackletter trademark law, “[g]oods (or services) are ‘related,’ not because of any inherent common quality of the respective goods, but ‘related’ in the sense that buyers are likely to believe that such goods, similarly marked, come from the same source, or are somehow connected with or sponsored by the same company.” 4 McCarthy, *supra*, § 23:1. In other words, asking whether the goods or services are “related” is just another way of asking whether the defendant’s use of the mark is likely to generate consumer confusion. *See id.* (“When the goods and services of the parties are not directly competitive, the question of likelihood of confusion is sometimes restated as: are the goods and services of the parties ‘related?’”). And here, the Eleventh Circuit expressly remanded for such a determination, stating that “the district court will . . . have to consider whether SCAD has demonstrated that Sportswear’s use of its word marks is likely to create consumer confusion.” Pet. App. 14a-15a.

Everyone agrees that a markholder can only recover if it shows that the defendant used its mark on “related” goods, as that term is used in trademark law. The Eleventh Circuit’s decision simply reflects the proposition that, if Sportswear used SCAD’s mark on *related* goods, then it may be liable under the Lanham Act. The only real dispute here is a factual one: whether the goods at issue are, in fact, “related”—i.e., whether there is a likelihood of confusion. The Eleventh Circuit remanded that question to the district court for resolution, and there is no basis for this Court to grant certiorari to decide a question that, in fact, is not even presented.

## **II. THERE IS NO CIRCUIT CONFLICT WARRANTING THIS COURT’S REVIEW**

### **A. The Lower Courts Are In Broad Agreement That Unauthorized Use Of A Registered Mark On Related Goods Constitutes Infringement**

Once one recognizes that the Eleventh Circuit merely held that a registered mark can be infringed through use on “related” goods and remanded for determination of whether the goods at issue here are in fact related (or not), the asserted conflicts evaporate. A reader of Sportswear’s petition might come away with the impression that the Eleventh Circuit stands by itself in holding that a registered service mark can be infringed through use of the mark on goods. But the reality is that “[*t*]*here is no doubt that a registered service mark can be infringed by use on goods.*” 4 McCarthy, *supra*, § 24:65 n.6.30 (emphasis added) (collecting cases).

Indeed, that rule flows inextricably from the text of the Lanham Act itself. Section 32(1)(a) of the Act

prohibits the use of a registered mark on “*any* goods or services” if “such use is likely to cause confusion.” 15 U.S.C. § 1114(1)(a) (emphasis added). Section 43(a)(1) similarly applies to “[a]ny person who, on or in connection with *any* goods or services, . . . uses” a “word, term, name, symbol, or device . . . which . . . is likely to cause confusion.” *Id.* § 1125(a)(1)(A) (emphasis added). Neither provision requires that the assertedly infringing use have occurred on the *particular* good or service listed in the registration—use on “*any* good or service” is a basis for infringement if it is likely to cause confusion.

The case law in the courts of appeals accords with that textual command. In *Applied Information Sciences Corp. v. eBAY, Inc.*, for example, the Ninth Circuit held that “a markholder’s rights to protect its interest in a registered mark [a]re not limited to infringement actions against those using the mark in connection with the specified goods or services,” but instead depend on a “likelihood of confusion analysis.” 511 F.3d 966, 971 (9th Cir. 2007) (citation omitted). Thus, “[a]lthough the validity of a registered mark extends only to the listed goods or services, an owner’s remedies against confusion with its valid mark are not so circumscribed.” *Id.* (emphasis omitted). As the Ninth Circuit explained, that is the “longstanding rule in other circuits as well.” *Id.*

The Second Circuit, for example, has held that “[a] registered trade-mark is safeguarded against simulation ‘not only on competing goods, but on goods so related in the market to those on which the trade-mark is used that the good or ill repute of the one type of goods is likely to be visited upon the other.’” *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 534 (2d Cir. 1964) (Friendly, J.)

(citation omitted). The Fifth Circuit has similarly recognized that “[t]he remedies of the owner of a registered trademark 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). And the Fourth Circuit squarely rejected the argument that a registered mark provides protection only against use of that mark on the particular goods or services listed in the registration, holding that protection extends to the use of “the same or a confusing mark . . . even on those [goods] which may be considered by some to be unrelated but which the public is likely to assume emanate from the trademark owner.” *Synergistic Int’l, LLC v. Korman*, 470 F.3d 162, 173 (4th Cir. 2006) (citation omitted).

Sportswear itself acknowledges that the decisions of the Second, Fourth, and Ninth Circuit described above allow the holder of a registered mark to assert infringement claims “not only [as] to the specific good or service identified in the registration, but to goods or services ‘related’ thereto.” Pet. 21. Its only basis for asserting a conflict with those decisions is its contention that the Eleventh Circuit’s decision would allow a trademark holder to assert a liability claim that “extends to *unrelated* goods.” *Id.* at 21-22 (emphasis added). But as discussed, Sportswear is simply wrong that the Eleventh Circuit concluded the goods here are “unrelated”; the court remanded for such a determination. *See supra* at 14-15.

On remand, if SCAD establishes that such confusion is likely, then it will have shown that Sportswear’s goods are “related” and thus that

Sportswear may be liable under the Lanham Act. If SCAD does *not* establish consumer confusion, then the goods will be deemed “unrelated” and Sportswear will prevail. That is exactly the same analysis that Sportswear itself concedes would apply in the Second, Fourth, and Ninth Circuits, and that would apply in the Fifth Circuit as well.

Sportswear insists that the Eleventh Circuit’s rule conflicts with the Third Circuit’s decision in *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383 (3d Cir.), *cert. denied*, 474 U.S. 920 (1985). Based on its reading of *Natural Footwear*, Sportswear argues that the Third Circuit would deny recovery to a registered trademark holder who claimed that its trademark was being infringed through uses or goods that were not listed in its registration. Pet. 19-20. On Sportswear’s theory, therefore, a company that had listed uses of its logo on tennis balls, baseballs, basketballs, and footballs in its trademark registration would be powerless to stop a competitor in the Third Circuit from using that same logo on soccer balls, regardless of whether it could show that consumers were likely to be confused by such use.

But nothing in *Natural Footwear* compels that counter-intuitive conclusion. In fact, in the thirty-plus years since *Natural Footwear* was decided, the Third Circuit has never invoked that decision to hold that a registered mark can only be infringed through use on the particular good or service listed in the registration. That explains the conspicuous absence in Sportswear’s petition of any Third Circuit case decided in the last three decades purporting to conflict with the decision in this case. And that absence is unsurprising. It is “not clear” from the language of *Natural Footwear*, which has been described as

“confused and internally inconsistent,” whether the court meant to “limit[] infringement remedies to only defendant’s goods which are identical to those in the plaintiff’s registration (which is not the law anywhere).” 4 McCarthy, *supra*, § 24:65 n.7.<sup>5</sup> The case is simply ambiguous on the point, leaving the Third Circuit free to consider the statute’s text and the approach of the other circuits whenever it is next called upon to decide a similar question.

At best for Sportswear, even if *Natural Footwear* plainly embraced the rule that Sportswear attempts to extract from the decision, it would present a stale, lopsided split in which the only case on Sportswear’s side is more than three decades old. Such a division would not warrant this Court’s intervention here, especially given the other defects discussed below.

**B. There Is No Conflict With The Federal Circuit’s Decisions Either**

Sportswear also contends (at 30-32) that the Eleventh Circuit’s approach to infringement cases is inconsistent with the law of trademark registration in the Federal Circuit. And again it is wrong.

Sportswear’s argument starts from the premise that, “[i]n the Federal Circuit, [SCAD] could *not* have registered its marks for use on apparel” because “an applicant cannot obtain a registration unless it is actually selling goods with that trademark affixed to it.” Pet. 30-31 (emphasis added). Sportswear then reasons that it would be inconsistent with that rule to

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<sup>5</sup> As the Ninth Circuit put it in *Applied Information*, “[i]t is possible—though not entirely clear—that” *Natural Footwear* established the categorical rule described by Sportswear. See 511 F.3d at 972 n.3.

allow SCAD to recover in an infringement action based on use of its mark on apparel.

There are several problems with this argument. The first is a factual one: SCAD *did* sell apparel bearing its mark prior to 2008, and thus could have registered a mark for use on apparel under the Federal Circuit's rule. *See supra* at 10-11. The second, and more fundamental, problem is that—as discussed above—“[t]he remedies of a registered trademark owner are not limited to the goods and/or services specified in the registration, but go to any goods or services on which the use of the mark is likely to cause confusion.” 4 McCarthy, *supra*, § 24:65. Because the goods or services listed in the registration are not *intended* to be the only goods or services in connection with which infringement might occur, there is nothing problematic about a finding of infringement based on use on a good or service that the markholder has not (or could not have) listed in the registration.

The “irreconcilable” conflict that Sportswear claims (at 19) between the Eleventh Circuit's approach and that of the Federal Circuit, therefore, is just a reflection of the fact that the courts are addressing different questions. The Federal Circuit addresses what goods or services can be listed on a registration, and the regional circuits address what additional goods or services—beyond those listed in the registration—can support an infringement claim under the likelihood-of-confusion standard.

In short, there is no conflict here, either.

### III. SPORTSWEAR MERELY SEEKS ERROR CORRECTION IN A CASE IN WHICH THERE HAS BEEN NO ERROR

#### A. The Eleventh Circuit Correctly Held That A Service Mark May Be Infringed By Use On Goods

Given the lack of any genuine division of authority among the lower courts, Sportswear has framed its petition primarily as a request for error correction. Indeed, its very first “reason[] for granting the writ” is that “the rule of law applied by the court below is literally indefensible.” Pet. 15 (capitalization altered). This Court rarely grants certiorari to engage in error correction. And here, there is a bigger problem: There is no error to begin with.

Indeed, while Sportswear’s petition rests almost entirely on the notion that the decision below is not just wrong, but *egregiously* wrong, the leading trademark treatise has endorsed the result reached by the Eleventh Circuit in this very case, explaining that “[i]t is clear that when the registration is for services, if there is a likelihood of confusion, then there is infringement. It matters not whether the accused use is on goods or services.” 4 McCarthy, *supra*, § 24:65 (citing and discussing the Eleventh Circuit’s decision in this case); *see id.* (“The remedies of a registered trademark owner are not limited to the goods and/or services specified in the registration, but go to any goods or services on which the use of the mark is likely to cause confusion.”).

As discussed above, *see supra* at 15-16, that conclusion, and the result reached by the Eleventh Circuit in this case, squares with Sections 32 and 43(a) of the Lanham Act, both of which provide that

use of a mark on “*any goods or services*” constitutes infringement if it is “likely to cause confusion.” Neither section of the Lanham Act so much as hints that, where the use of a mark on a given good would be likely to cause confusion, the infringer can nevertheless escape liability because the markholder has not previously produced that particular good.<sup>6</sup>

Sportswear makes no meaningful effort to reconcile its proposed rule with the text of Sections 32 and 43(a). To the extent Sportswear invokes the text of the Lanham Act at all (at 16), it relies on Section 33(a). But Section 33(a) merely describes certain evidentiary uses of the registration; it does not establish any limitations on the liability imposed in Sections 32 and 43(a). In particular, Section 33(a) states that “a mark registered on the principal register . . . shall be prima facie evidence of the validity of the registered mark and of the registration

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<sup>6</sup> Congress *did* include such a limitation, by contrast, in a parallel criminal restriction on trafficking in counterfeit goods. Unlike the provisions at issue here, which impose civil liability for the unauthorized use of a mark in connection with “any goods or services” if confusion is likely, Section 2320 of Title 18 imposes criminal liability for the use of a registered mark “that is applied to or used in connection with *the goods or services for which the mark is registered.*” 18 U.S.C. § 2320(f)(1)(A)(iii) (emphasis added). That Congress omitted such language in the Lanham Act, even as it included it in a related criminal liability provision elsewhere, confirms that it did not intend to limit liability under Sections 32 and 43(a) to only those uses made in connection with the goods and services listed in the registration. See, e.g., *Russello v. United States*, 464 U.S. 16, 23 (1983) (“We refrain from concluding here that the differing language in the two subsections has the same meaning in each. We would not presume to ascribe this difference to a simple mistake in draftsmanship.”).

of the mark.” 15 U.S.C. § 1115(a). Under Section 33(a), therefore, SCAD satisfied the first element of its infringement claims—namely, its ownership of valid marks, *see supra* at 5-6—simply by presenting its federal registrations in evidence.

Section 33(a) also provides that a registered mark serves as “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). But that portion of Section 33(a) is not at issue here. SCAD is not relying just on its registrations to establish that Sportswear cannot use SCAD’s marks on apparel. It has put forward other evidence, too, such as evidence showing that consumers were likely to believe that Sportswear’s SCAD-branded apparel—bearing SCAD’s name, logo, colors, and year of founding—was sponsored or approved by SCAD. The district court will consider that evidence on remand. Section 33(a)’s special evidentiary rule about cases in which infringement occurs “on or in connection with the goods or services specified in the registration,” 15 U.S.C. § 1115(a), is thus immaterial to the issues decided by the Eleventh Circuit and ostensibly presented in the petition.<sup>7</sup>

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<sup>7</sup> Even Sportswear accepts (at 16) that the registrations serve as prima facie evidence under Section 33(a) that SCAD’s use of its name and logo in connection with educational services has established marks that are valid with respect to provision of educational services. Sportswear’s use of those same marks on or in connection with “any goods or services” therefore violates Sections 32 and 43(a) if it is likely to confuse or mislead consumers into thinking that the goods or services that Sportswear is selling are manufactured, sponsored, or approved by, or otherwise affiliated with, the same entity that provides

### **B. Sportswear’s Focus On *Boston Hockey* Is Misplaced**

In arguing that the Eleventh Circuit’s decision is “indefensible,” Sportswear emphasizes the Eleventh Circuit’s reliance on the Fifth Circuit’s 1975 decision in *Boston Hockey*, as if it is a bogeyman that this Court must erase. And the Eleventh Circuit itself expressed misgivings with *Boston Hockey*. Pet. App. 17a-20a. But Sportswear’s attacks, and even the Eleventh Circuit’s misgivings, are misplaced here.

*Boston Hockey* involved claims by National Hockey League teams against a company that manufactured embroidered emblems bearing the teams’ logos, unattached to any distinct goods. 510 F.2d at 1008. The teams had “secured federal registration of their team symbols as service marks for ice hockey entertainment services,” and claimed that the defendant’s unauthorized use of their marks in selling the logos themselves violated Sections 32 and 43(a) of the Lanham Act. *Id.* The district court rejected the plaintiffs’ claims after finding that “there was no likelihood of confusion because the usual purchaser, a sports fan in his local sporting goods store, would not be likely to think that [the] emblems were manufactured by or had some connection with” the plaintiff teams. *Id.* at 1012. On appeal, however, the Fifth Circuit reversed on the ground that “[t]he certain knowledge of the buyer that the source and

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SCAD’s educational services (i.e., SCAD). *Cf.* 4 McCarthy, *supra*, § 24:65 (“The question of the scope of validity of a mark is a very different issue from that of what kind of uses could cause infringement by a likelihood of confusion. It is clear that when the registration is for services, if there is a likelihood of confusion, then there is infringement. It matters not whether the accused use is on goods or services.”).

origin of the trademark symbols were in plaintiffs satisfies the requirement of the act,” without regard to whether there was “confusion . . . as to the source of the manufacture of the emblem itself.” *Id.*

In holding that Sportswear may have infringed SCAD’s service mark by using it on goods, the Eleventh Circuit pointed to *Boston Hockey*. See Pet. App. 12a-16a. And, in doing so, the court expressed reservations about *Boston Hockey*, believing that *Boston Hockey* did not adequately explain why use of a service mark on goods could constitute infringement. See *id.* at 14a-17a. But as discussed in the preceding section, the Eleventh Circuit’s conclusion that use of a service mark on goods can result in infringement was correct—and in line with the decisions of other circuits. See *supra* at 21-23. While the Eleventh Circuit found that “*Boston Hockey* does not provide any basis for extending service mark rights to goods” (Pet. App. 18a), the case law developed over the past four plus decades since *Boston Hockey* does, as the leading commentator has recognized. There is nothing controversial about the Eleventh Circuit’s holding below that use of a service mark on goods can result in infringement.

What *is* controversial about the Fifth Circuit’s decision in *Boston Hockey* is its apparent holding “that infringement did not require proof of a likelihood that customers would be confused as to the source or affiliation or sponsorship of defendant’s product[;] only that customers recognized the products as bearing a mark of the plaintiff.” 4 McCarthy, *supra*, § 24:10. That separate holding of *Boston Hockey* represented a “radical break with traditional trademark law” and “provoked a storm of criticism.” *Id.*; see *International Order of Job’s*

*Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918-19 (9th Cir. 1980) (criticizing *Boston Hockey*'s failure to conduct likelihood-of-confusion analysis with respect to the manufactured products as opposed to the ownership of the trademark itself), *cert. denied*, 452 U.S. 941 (1981); *see also United States v. Giles*, 213 F.3d 1247, 1250-51 (10th Cir. 2000) (rejecting *Boston Hockey*'s holding that a patch bearing only the trademark itself constitutes a "good" within the meaning of the trademark law). And it is these criticisms of *Boston Hockey* that Sportswear emphasizes in its petition (at 28-30).

But as Sportswear itself admits (at 28), those criticisms of *Boston Hockey* "did not address the question presented here" and "do not directly conflict with the decision below." Indeed, far from *dispensing* with a likelihood-of-confusion analysis (the reason that *Boston Hockey* came under fire), the Eleventh Circuit remanded for exactly such an analysis. Pet. App. 14a-15a. Moreover, as the Eleventh Circuit recognized below, the Fifth Circuit itself eliminated the controversial aspect of *Boston Hockey* just two years after it was issued by "limit[ing] its confusion analysis to the facts in the case, and explain[ing] that it did not do away with traditional confusion analysis." *Id.* at 16a; *see* 4 McCarthy, *supra*, § 24:10 ("The Fifth Circuit itself . . . retreated from the heresies of *Boston Hockey*" in a 1977 decision that is binding in the Eleventh Circuit (citing *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 389 (5th Cir. 1977))); *see also International Order of Job's Daughters*, 633 F.2d at 918 n.10 ("The Fifth Circuit itself has apparently retreated from a broad interpretation of *Boston Hockey*").

In short, Sportswear’s attempts to capitalize on *Boston Hockey*’s notoriety (on other grounds) provides no basis for granting review either.

#### **IV. THIS CASE IS A HIGHLY DEFECTIVE VEHICLE IN ANY EVENT**

Even if Sportswear’s petition actually presented a question about which the lower courts genuinely disagreed, this case—especially at this juncture—would not be an appropriate case for review.

*First*, the case arises in an interlocutory posture in which the factual questions about whether the goods here are “related”—an essential premise of the Question presented—remain unresolved. The interlocutory posture of this case “alone furnishe[s] sufficient ground for the denial of the application.” *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 258 (1916); accord *Abbott v. Veasey*, 137 S. Ct. 612, 613 (2017) (Roberts, C.J., respecting the denial of the petition for a writ of certiorari).

And *second*, because the Eleventh Circuit recognized that its binding precedent made evidence about SCAD’s pre-2009 sales of SCAD-branded apparel irrelevant, it did not address SCAD’s challenge to the district court’s exclusion of evidence about those pre-2009 sales. *See* Pet. App. 14a n.5. The district court’s exclusion of such evidence, however, was highly prejudicial and unfounded. *See* SCAD CA11 Br. 40-44; SCAD CA11 Reply 26-28. And, as a result, the case reaches this Court in an artificial posture in which Sportswear asks this Court to pretend that SCAD did not sell its own apparel with the marks at issue before Sportswear did—even though SCAD plainly did make such sales.

If this Court were to grant review, SCAD would invoke that evidence of pre-2009 sales. In order to avoid issuing an advisory opinion on hypothetical (and incomplete) facts, the Court would likely need to re-examine the exclusion of that evidence itself, in the first instance. And even if this Court did conclude that the evidence was properly excluded as a matter of the district court's exercise of discretion or otherwise, the existence of a news article showing that SCAD in fact began selling apparel with SCAD marks before Sportswear opened its own "Savannah College of Art and Design Bees Apparel Store" would make this case an extremely unattractive vehicle for this Court to decide the question presented.

If the law really is as broken as Sportswear suggests, another case will come along soon, or this case will come back. But the Court need not, and should not, grant the petition here.

**CONCLUSION**

The petition should be denied.

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