

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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QUESTIONS PRESENTED

1. Does the scope of a federally-registered service mark extend to unrelated goods bearing that service mark?
2. Does the defendant's copying of a mark, without proof of consumer confusion as to the source of the parties' goods or services, establish trademark infringement merely because consumers recognize the mark?

LIST OF PROCEEDINGS

Sportswear, Inc., d/b/a PrepSportswear v. Savannah College of Art and Design, Inc., No. 17-1316 (U.S.)

Savannah College of Art and Design, Inc. v. Sportswear, Inc., d/b/a PrepSportswear, No. 19-11258 (11th Cir.)

Savannah College of Art and Design, Inc. v. Sportswear, Inc., d/b/a PrepSportswear, No. 15-13830 (11th Cir.)

Savannah College of Art and Design, Inc. v. Sportswear, Inc., d/b/a PrepSportswear, No. 1:14-cv-02288-TWT (N.D. Ga.)

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.

TABLE OF CONTENTS

QUESTIONS PRESENTED	i
LIST OF PROCEEDINGS	ii
CORPORATE DISCLOSURE STATEMENT	iii
TABLE OF AUTHORITIES	viii
OPINIONS BELOW	1
JURISDICTION	1
STATUTORY PROVISIONS INVOLVED	1
INTRODUCTION	1
STATEMENT OF THE CASE	5
A. Statutory Background	5
B. First Eleventh Circuit Decision	8
C. Second Eleventh Circuit Decision	13
REASONS FOR GRANTING THE WRIT	14
I. THE ELEVENTH CIRCUIT’S SCOPE- OF-THE-MARK HOLDING WARRANTS REVIEW	15
A. The Eleventh Circuit’s Decision is Wrong	15
B. The Eleventh Circuit’s decision conflicts with decisions from other circuits	17

1.	In the Third Circuit, the Scope of Rights Based on a Federal Registration Extends Only to Goods or Services Identified in the Registration.....	17
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.....	19
C.	Because there is now a final judgment, there are no vehicle problems.....	24
II.	THE ELEVENTH CIRCUIT’S LIKELIHOOD-OF-CONFUSION HOLDING WARRANTS REVIEW.....	27
A.	The Eleventh Circuit’s Decision is Wrong.....	27
B.	The Ninth and Tenth Circuits Have Expressly Rejected Boston Hockey.	32
III.	THE ELEVENTH CIRCUIT’S DECISION CONFLICTS WITH THE FEDERAL CIRCUIT’S REGISTRATION DECISIONS.	34
	CONCLUSION	38

Appendix A

Savannah College of Art & Design, Inc. v. Sportswear, Inc., 983 F.3d 1273 (11th Cir. 2020) 1a

Appendix B

Savannah College of Art and Design, Inc. v. Sportswear, Inc., 872 F.3d 1256 (11th Cir. 2017) 28a

Appendix C

Savannah College of Art and Design, Inc. v. Sportswear, Inc., Civ. A. No. 1:14-CV-2288-TWT, 2019 WL 11542685 (N.D. Ga. Mar. 1, 2019) 49a

Appendix D

Savannah College of Art and Design, Inc. v. Sportswear, Inc., Civ. A. No. 1:14-CV-2288-TWT, 2015 WL 4626911 (N.D. Ga. Aug. 3, 2015) 80a

Appendix E

Judgment and Permanent Injunction, *Savannah College of Art and Design, Inc. v. Sportswear, Inc.*, Civ. A. No. 1:14-CV-2288-TWT (N.D. Ga. Dec. 7, 2020) 87a

Appendix F

Order denying panel rehearing and rehearing
en banc, *Savannah College of Art and Design,
Inc. v. Sportswear, Inc.*, No. 19-11258-JJ (11th
Cir. Feb. 17, 2021)..... 91a

Appendix G

Order denying panel rehearing and rehearing
en banc, *Savannah College of Art and Design,
Inc. v. Sportswear, Inc.*, No. 15-13830 (11th
Cir. Jan. 23, 2018)..... 93a

Appendix H

Statutory Provisions Involved 96a

TABLE OF AUTHORITIES

CASES

<i>American Steel Foundries v. Robertson</i> , 269 U.S. 372 (1926).....	7
<i>Applied Information Services Corp. v. eBay, Inc.</i> , 511 F.3d 966 (9th Cir. 2007).....	21, 22
<i>B&B Hardware, Inc. v. Hargis Industries, Inc.</i> , 575 U.S. 138 (2015).....	7, 8, 16
<i>Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Manufacturing, Inc.</i> , 510 F.2d 1004 (5th Cir. 1975).....	3, 28
<i>Chandon Champagne Corp. v. San Marino Wine Corp.</i> , 335 F.2d 531 (2d Cir. 1964)	20
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	30
<i>Hydro-Dynamics, Inc. v. George Putnam & Co.</i> , 811 F.2d 1470 (Fed. Cir. 1987)	35
<i>International Order of Job’s Daughters v. Lindeburg & Co.</i> , 633 F.2d 912 (9th Cir. 1980).....	32, 33
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 543 U.S. 111 (2004).....	30
<i>Levi Strauss & Co. v. Blue Bell, Inc.</i> , 778 F.2d 1352 (9th Cir. 1985).....	21-22
<i>M.Z. Berger & Co. v. Swatch AG</i> , 787 F.3d 1368 (Fed. Cir. 2015).....	34

<i>Moseley v. V Secret Catalogue, Inc.</i> , 537 U.S. 418 (2003).....	30
<i>Natural Footwear Ltd. v. Hart, Schaffner & Marx</i> , 760 F.2d 1383 (3d Cir. 1985)	17, 18, 19
<i>Northern Insurance Co. of New York v. Chatham County</i> , 547 U.S. 189 (2006).....	3
<i>Synergistic International, LLC v. Korman</i> , 470 F.3d 162 (4th Cir. 2006).....	22, 23
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	7, 36, 37
<i>United Drug Co. v. Theodore Rectanus Co.</i> , 248 U.S. 90 (1918).....	12
<i>United States v. Giles</i> , 213 F.3d 1247 (10th Cir. 2000)	32, 33
<i>Virginia Military Institute v. United States</i> , 508 U.S. 946 (1993).....	24
<i>Woodke v. Dahm</i> , 70 F.3d 983 (8th Cir. 1995).....	37
STATUTES	
15 U.S.C. § 1052(d).....	35
15 U.S.C. § 1114(1)(a)	7
15 U.S.C. § 1115(a)	2, 6, 16
15 U.S.C. § 1116	13
15 U.S.C. § 1125(a).....	7
15 U.S.C. § 1127	6, 34

OTHER AUTHORITIES

- Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461 (2005).....31
- Glynn S. Lunney, Jr., *Trademark's Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 Calif. L. Rev. 1195 (2018)31
- J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Westlaw (5th ed. updated Mar. 2021)31, 32

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 Eleventh Circuit's decisions are reported at 983 F.3d 1273 (Pet. App. 1a-27a) and 872 F.3d 1256 (Pet. App. 28a-48a). The district court's decisions (Pet. App. 49a-79a, 80a-86a, and 87a-90a) are unreported. The Eleventh Circuit's orders denying rehearing and rehearing *en banc* (Pet. App. 91a-92a and 93a-95a) are unreported.

JURISDICTION

The judgment of the Eleventh Circuit was entered on December 22, 2020. The Eleventh Circuit's order denying rehearing and rehearing *en banc* was entered on February 17, 2021. 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. 96a-98a.

INTRODUCTION

Respondent Savannah College of Art and Design, Inc. ("SCAD") is a college located in Georgia. SCAD holds registered service marks with the Patent and Trademark Office ("PTO") for the words "SCAD" and "SAVANNAH COLLEGE AND ART AND DESIGN." These registrations are limited to the field of "educational services."

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

SCAD’s claim differed from the typical trademark claim. In a typical trademark case, the plaintiff alleges that a defendant’s use of the plaintiff’s mark will confuse consumers into thinking that the defendant’s products originated with the plaintiff. Here, however, SCAD never produced any evidence that consumers might be confused as to the origin of Sportswear’s apparel. Nonetheless, SCAD contended that regardless of the lack of any actual or potential confusion, Sportswear should not be allowed to sell any apparel with SCAD’s name on it.

SCAD should have lost. To prove infringement, SCAD was required to make two showings: first, that it had the right to exclusive use of its mark on apparel, and second, that Sportswear infringed that right. SCAD’s case failed on both counts.

SCAD failed to make the first showing because it does not have the exclusive right to use its mark on apparel. Under the Lanham Act, SCAD’s 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). Here, “the goods or services specified in the registration,” *id.*, are educational services. Apparel is not educational services. Therefore, SCAD’s registrations did not

confer it the exclusive right to use its mark on apparel.

SCAD failed to make the second showing, too. Proving infringement under the Lanham Act requires showing a likelihood of confusion. Here, SCAD did not show a likelihood of confusion. Although SCAD provided evidence that Sportswear's apparel *referred* to SCAD (this was undisputed and the whole point of the apparel), it provided no evidence that anyone thought, or would be likely to think, that the apparel *came from* SCAD. Because there was no likelihood of confusion as to the apparel's origins, there was no trademark infringement.

Yet, the Eleventh Circuit ruled for SCAD on both issues. How could it possibly have justified this result? The answer is that it couldn't. Instead, the Eleventh Circuit deemed itself bound by a 46-year-old precedent—*Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir. 1975)¹—a decision that the Eleventh Circuit itself acknowledged to be indefensible, and in conflict with decisions from other circuits.

The Eleventh Circuit resolved these two issues in separate published decisions. In its first decision, the court held that the scope of SCAD's registration—which, by its terms, applied only to educational services—extended to apparel. Pet. App. 29a. The court explained that *Boston Hockey* dictated this

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 Cnty.*, 547 U.S. 189, 192 & n.1 (2006).

result, and because *Boston Hockey* “constitutes binding precedent,” the Eleventh Circuit was “bound to follow” it. *Id.*

But the Eleventh Circuit acknowledged that this result was wrong. The court noted that “*Boston Hockey* does not provide any basis for extending service mark rights to goods.” Pet. App. 44a. It also observed that “other circuits have said that service marks do not by their nature extend to goods or products.” *Id.* After walking through *Boston Hockey*’s numerous analytical flaws, the Eleventh Circuit stated that it had “yet to hear” of *any* doctrinal justification for the result it was constrained by precedent to reach. Pet. App. 47a.

In its second decision, the Eleventh Circuit ruled that SCAD had proven trademark infringement, finding once again that “*Boston Hockey* and its progeny control our analysis here.” Pet. App. 22a. The Eleventh Circuit did not shy away from the weaknesses in SCAD’s case. As the Eleventh Circuit acknowledged, SCAD could not produce *any* evidence that *any consumer* thought that Sportswear’s apparel originated from, or was sponsored by, SCAD. The best SCAD could do was an email showing that a *SCAD employee*—not a member of the public—was *unsure* whether SCAD had authorized Sportswear’s apparel. Pet. App. 23a.

Yet the Eleventh Circuit again found that under *Boston Hockey*, the mere fact that Sportswear’s apparel *referred to* SCAD was sufficient to show likelihood of confusion. In the court’s view, Sportswear was benefitting from SCAD’s reputation and goodwill

among consumers seeking apparel bearing SCAD's name—and under *Boston Hockey*, deriving this benefit was a violation of the Lanham Act, irrespective of whether those consumers were confused as to whether SCAD had produced or authorized the apparel.

This Court should grant certiorari and reverse. As the Eleventh Circuit correctly recognized, *Boston Hockey* is wrong and conflicts with decisions of other circuits. And this is no ordinary circuit split. *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—SCAD would have had no chance of obtaining a federally-registered mark covering apparel. Yet SCAD was able to do the next best thing—obtain a narrow registration for educational services; take advantage of the Eleventh Circuit's indefensible *Boston Hockey* precedent to significantly expand the scope of that registration to apparel; and then take advantage of *Boston Hockey* again to establish trademark infringement even without any evidence of a likelihood of consumer confusion.

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

The Lanham Act permits persons to obtain federal

registrations for “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 ... 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 for either a trademark or a service mark requires a showing that the mark has been “use[d] in commerce” with the specific good or service. *Id.*

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).

The Lanham Act provides two federal causes of action relevant to this case. First, it 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, 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 bars the use of a mark in a manner that “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.” 15 U.S.C. § 1125(a).

“[Section 1125] prohibits a broader range of practices than does [Section 1114], 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 [Section 1125(a)].” *Id.* In particular, regardless of whether a mark is registered or unregistered, it is not entitled to protection in litigation unless it is actually being *used in association with a particular good or service*. Pet. App. 45a-46a; *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, when registering a mark, the PTO considers the mark “as used on the goods described in the application.” See *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 156 (2015). And although a holder of a registered mark may also enjoy a common-

law right to exclude others from using marks on goods or services dissimilar from those in the registration, that right exists only if that holder *uses* the mark on those dissimilar goods or services. *Id.* at 155-56 (stating that mark holder may have “common-law rights in usages not encompassed by its registration”).

B. First Eleventh Circuit Decision

SCAD is a college based in Georgia. Pet. App. 30a. SCAD holds federally-registered service marks for the words “SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN.” Pet. App. 31a. “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.’” Pet. App. 30a.

Sportswear is an online seller of “fan” clothing and other items, such as baseball caps and duffel bags. Pet. App. 31a. Since 2003, Sportswear has sold “made-to-order apparel and related goods” for many types of entities, including colleges, Greek and military organizations, and city departments. *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.” Pet. App. 31-32a. 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. 32a. Sportswear’s website bears “prominent disclaimers” such as “This

store is not affiliated with, sponsored or endorsed by Savannah College of Art and Design.” Pet. App. 21a.

In August 2009, Sportswear began selling apparel printed with the words “SAVANNAH COLLEGE OF ART AND DESIGN” and “SCAD.” Pet. App. 32a. In 2014, SCAD sued Sportswear for infringement of its marks under 15 U.S.C. §§ 1114 and 1125. *Id.*

The District Court granted summary judgment to Sportswear. The District Court observed that SCAD’s registrations were “for use of the marks in connection with educational services,” and that SCAD lacked “registrations for the marks related to apparel.” Pet. App. 84a. Thus, “[b]ecause [SCAD] does not have registered marks for apparel, it must show that it used the marks in commerce prior to [Sportswear’s] use.” *Id.* The Court concluded that “[SCAD] has not presented that evidence.” *Id.*

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. 29a. In the Eleventh Circuit’s view, when parties “assert common-law trademark rights,” “priority of use become[s] a critical issue.” Pet. App. 37a. But because SCAD’s “claims revolve around federally-registered marks,” the question of priority of use did not apply either to SCAD’s § 1114 claim or to its § 1125 claim. *Id.*

Rather, the court held that *Boston Hockey* “controls, as it extends protection for federally-registered service marks to goods.” Pet. App. 29a. 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.*

As the Eleventh Circuit framed the issue, the question was 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.” Pet. App. 37a. It held that “*Boston Hockey* provides the answer to that question.” *Id.* “*Boston Hockey* extends protection for federally-registered service marks to goods, and therefore beyond the area of registration listed in the certificate.” Pet. App. 39a.

The court summarized the facts of *Boston Hockey*, where several NHL teams “sued to prevent a manufacturer from selling embroidered sew-on patches featuring the teams’ federally-registered service marks.” *Id.* 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. 40a. “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. 41a (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.

The court then “pause[d] to note the unexplained analytical leap in *Boston Hockey*.” Pet. App. 44a.² The court observed that under 15 U.S.C. § 1115(a), “registration is 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*.” *Id.* (emphasis in original; internal quotation marks 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.” *Id.*

First, other circuits and commentators had previously “said that service marks do not by their nature extend to goods or products.” *Id.* “If these

² Judge Martin did not join this portion of the court’s opinion. Pet. App. 30a n.1.

other circuits and commentators are wrong, in whole or in part, we should explain why.” Pet. App. 45a.

Second, “a right in a mark is not a ‘right in gross.’” *Id.* (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)).³ 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.’” *Id.* (citation omitted).

Third, “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 product.” Pet. App. 46a (internal citations omitted).

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. 47a. 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.” *Id.*

³ *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.

The Eleventh Circuit denied rehearing and rehearing *en banc*. Pet. App. 93a-95a.

C. Second Eleventh Circuit Decision

On remand, the district court granted summary judgment to SCAD, finding that SCAD had established a likelihood of confusion. Pet. App. 49a-79a. The district court entered a permanent nationwide injunction, as authorized by the Lanham Act. 15 U.S.C. § 1116. The injunction barred Sportswear from selling any products bearing the SCAD marks in the continental United States. Pet. App. 87a-90a.

The Eleventh Circuit affirmed, applying the multifactor test for determining likelihood of confusion. It first concluded that SCAD's descriptive marks had become strong based on the school's history and existence "[a]t the time the parties filed their cross-motions for summary judgment," and then concluded that Sportswear had copied those exact marks. Pet. App. 14a, 17a.

The court then turned to the "similarity-of-goods factor," which "assesses 'whether the goods are so related in the minds of consumers that they get the sense a single producer is likely to put out both goods.'" Pet. App. 17a. This factor should have supported Sportswear, given that apparel is nothing like educational services. But, in the court's view, "this factor is less important in cases—like this one—that concern the use of the plaintiff's service marks on the defendant's good for the very reason that the plaintiff's marks embody the plaintiff's goodwill and reputation." *Id.* For similar reasons, the court discounted whether

there was similarity of actual sales methods or advertising. *Id.*

Next, the court turned to “Sportswear’s intent to misappropriate SCAD’s goodwill.” Pet. App. 18a. Sportswear pointed out that its website states: “This store is not sponsored or endorsed by Savannah College of Art and Design.” Pet. App. 20a-21a. Nevertheless, the court held that *Boston Hockey* precluded Sportswear from relying on this disclaimer. *Id.* As in *Boston Hockey*, the customers who purchased Sportswear’s merchandise “did so because of the merchandise’s affiliation with the marks and because what the marks represent are meaningful to buyers.” Pet. App. 22a. Thus, whether consumers saw and understood the disclaimer was, in the court’s view, immaterial as to whether consumers would be confused. *Id.*

Finally, as to actual confusion, SCAD’s sole evidence was that “a parent of a student sent a link to Sportswear’s website to one of SCAD’s employees, and the employees were unsure whether Sportswear’s use was authorized.” Pet. App. 23a. This was “hardly strong evidence of actual confusion.” *Id.* Nevertheless, the court concluded that there would be a likelihood of confusion. *Id.*

The Eleventh Circuit denied rehearing and rehearing en banc. Pet. App. 91a-92a.

REASONS FOR GRANTING THE WRIT

In its two decisions, the Eleventh Circuit concluded that: (1) The scope of SCAD’s service mark registrations extended to apparel goods, even though

SCAD’s registrations, by their terms, apply only to “educational services,” and (2) SCAD had established trademark infringement merely because Sportswear’s apparel *referred* to SCAD. Both decisions warrant review.

I. THE ELEVENTH CIRCUIT’S SCOPE-OF-THE-MARK HOLDING WARRANTS REVIEW.

In its first question presented, Sportswear challenges the Eleventh Circuit’s 2017 decision, which held that Sportswear’s registration—which, by its terms, applies only to “educational services”—had unrestricted scope. As the Eleventh Circuit acknowledged, that decision is indefensible and conflicts with decisions from other circuits.

A. The Eleventh Circuit’s Decision is Wrong.

The Eleventh Circuit awarded SCAD’s federally-registered marks “unrestricted ... scope.” Pet. App. 41a. The court concluded that because SCAD held a registration on educational services, it could assert that mark against unrelated products—here, apparel. Thus, the effect of the Eleventh Circuit’s first decision is that the identification of the good or service in the registration is irrelevant. Once a court ascertains that a trademark holder has a registered mark on *anything*, it can then ignore the scope of the registration and bar the use of the mark on *everything* so long as there is a likelihood of confusion—which, under the Eleventh Circuit’s second decision, merely requires that consumers might recognize the mark as belonging to the registrant. *See infra* at 28-29.

The Eleventh Circuit’s first decision is wrong for the reason stated by the Eleventh Circuit: It allows “the concept of confusion” to “completely swallow[] the antecedent question of the scope of a registered mark.” Pet. App. 47a. Whether there was a likelihood of confusion—the test for infringement—should have been irrelevant because there was nothing to infringe. SCAD lacked any exclusive right to use the “SCAD” mark on apparel, and thus had no right to exclude Sportswear’s products.

Indeed, the Eleventh Circuit could not conceive of any ground on which to defend the legal rule it applied. *Boston Hockey* “does not provide any basis for extending service mark rights to goods.” Pet. App. 44a. And the Eleventh Circuit had “yet to hear of” of any “sound doctrinal basis for what *Boston Hockey* did.” Pet. App. 47a.

No “sound doctrinal basis” exists. SCAD’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 SCAD any 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. *B&B Hardware*, 575 U.S. at 143. When Sportswear began its apparel offerings in

2009, SCAD 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 SCAD's registration to apparel.

The Eleventh Circuit provided a detailed and persuasive explanation of *Boston Hockey's* faults. Pet. App. 44a-47a. The Eleventh Circuit was correct: *Boston Hockey* is wrong. SCAD's federal registrations should not have conferred SCAD with any rights with respect to apparel.

B. The Eleventh Circuit's decision conflicts with decisions from other circuits.

The Second, Third, Fourth, and Ninth Circuits have rejected the Eleventh Circuit's legal standard.

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 first Eleventh Circuit 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 (capitalization omitted). 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 (emphasis in original) (quoting 15 U.S.C. § 1115(a)). 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 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 for further consideration of that issue. *Id.* at 1406-07.

The District Court applied a similar analysis here, holding that SCAD lacked common-law rights before Sportswear first used the marks. Pet. App. 84a. By contrast, the Eleventh Circuit held that the scope of SCAD’s federal registration for educational services extended to apparel—thus foreclosing the need for a common-law analysis of Sportswear’s prior use of the marks on apparel. Pet. App. 47a.

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. 41a.

In *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531 (2d Cir. 1964), 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 trade-mark 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). Thus, the scope of Chandon’s protection extended not only to champagne, but also to cheap sparkling wine. *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*. 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 *shopping for champagne* would infer that Chandon sells low-quality alcohol.

That is emphatically not the *Boston Hockey* rule. The *Boston Hockey* rule does not merely extend the scope of a federally-registered mark to goods *similar* to the goods or services in the registration. Instead, it extends the scope of a service mark to *all goods and services*—effectively rendering irrelevant the identification of goods or services in the registration.

The Ninth Circuit followed 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.” *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.

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 (9th Cir. 1985) (*en banc*), in which it 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).

Thus, like the Second Circuit, the Ninth Circuit holds that a mark’s scope extends to products that will cause confusion *when consumers shop for the plaintiff’s own registered products*. So if a defendant’s products will cause confusion for a consumer shopping for software (or champagne or an education), then the plaintiff’s exclusive right to use its mark on software (or champagne or education) will extend to the defendant’s products. Here, however, there was no allegation that a consumer would be confused by Sportswear’s apparel *when shopping for educational services*. Instead, the Eleventh Circuit held that the scope of SCAD’s mark extended to *any* product bearing SCAD’s name.

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, the “scope of protection” for Synergistic’s mark extended to “Korman’s use of a similar trademark for similar services.” *Id.*

Thus, consistent with the Second and Ninth Circuits, 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 the scope of protection for a mark for windshield installation extended to windshield repair. 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 clothing 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.

C. Because there is now a final judgment, there are no vehicle problems.

Sportswear filed an interlocutory petition for certiorari challenging the Eleventh Circuit’s first decision, which this Court denied. That denial is no basis to deny certiorari here. This Court “generally await[s] final judgment in the lower courts before exercising [its] certiorari jurisdiction,” and an interlocutory denial of certiorari “does not, of course, preclude [a litigant] from raising the same issues in a later petition, after final judgment has been rendered.” *Virginia Military Institute v. United States*, 508 U.S. 946, 946 (1993) (Scalia, J., respecting denial of certiorari).

In this case, SCAD’s prior Brief in Opposition (“2018 BIO”) argued that the petition should be denied because the lower courts had not yet resolved

likelihood of confusion, posing a vehicle problem. There is now a final judgment, so the vehicle problem is gone and review is now warranted.

Sportswear's prior petition contended that the scope of Sportswear's service mark should not extend to apparel—an unrelated good. In its BIO, SCAD contended that Sportswear's petition was premature. In SCAD's view, the question of whether “goods and services are ‘related’” was co-extensive with the question of whether there would be a likelihood of confusion. 2018 BIO at 2. Further, as SCAD pointed out, the lower courts had not yet resolved the likelihood-of-confusion inquiry. *Id.*

SCAD represented that it was “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.” *Id.* at 2-3. SCAD claimed that the case arose “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.” *Id.* at 27. In its closing paragraph, SCAD stated: “If the law really is as broken as Sportswear suggests, another case will come along soon, or this case will come back.” *Id.* at 28.

As SCAD predicted, the case has come back because the law is fundamentally broken—and now that there is a final judgment, the vehicle problem asserted in the BIO has vanished.

First, SCAD's promise that it 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,” *id.* at 2-3, turned out to be a complete bluff. As explained below, SCAD proffered no evidence that any consumer was or would likely be confused as to the source of Sportswear’s apparel. *Infra*, at 27.

More pertinently, in its likelihood-of-confusion analysis, the Eleventh Circuit did not even try to defend the improbable proposition that there is any similarity between the services in the registration (*i.e.*, educational services) and the accused product (*i.e.*, apparel). Instead, it said that the similarity between the plaintiff’s and defendant’s products “is less important in cases—like this one—that concern the use of the plaintiff’s service marks on the defendant’s goods for the very reason that the plaintiff’s marks embody the plaintiff’s goodwill and reputation.” Pet. App. 17a. Of course, this statement depends on the premise that the scope of a mark extends to dissimilar goods or services when marks “embody the plaintiff’s goodwill and reputation.” *Id.* And, as the Eleventh Circuit’s second opinion made clear, that premise derives entirely from *Boston Hockey*. Pet. App. 22a-23a (explaining that Sportswear sold its apparel for “the same reason the *Boston Hockey* defendant sold patches bearing the teams’ trademarks: it hoped to benefit from the patches’ association with what they represented”).

Sportswear disagrees with the Eleventh Circuit’s likelihood-of-confusion analysis, which furnishes the basis for its second question presented. For purposes of the first question, however, the important point is that there is a final judgment with a closed factual record that has crystallized the dispute. The record

now definitively shows that the Eleventh Circuit permitted SCAD to assert its mark against *any* good or service that “embod[ied] the plaintiff’s goodwill and reputation.” Pet. App. 17a. The court required no showing of any relationship between the service in the registration and the accused product. That decision is wrong and is now ripe for review.

II. THE ELEVENTH CIRCUIT’S LIKELIHOOD-OF-CONFUSION HOLDING WARRANTS REVIEW.

In its second decision, the Eleventh Circuit was again constrained by *Boston Hockey* to hold that SCAD had established a likelihood of confusion. That decision, too, is wrong and perpetuates a circuit split.

A. The Eleventh Circuit’s Decision is Wrong.

To prevail on its claim of trademark infringement, SCAD was required to prove a likelihood of confusion. It failed to do so. First, there was no evidence that any consumer ever thought that SCAD’s products originated with, or were endorsed by, SCAD. SCAD’s best evidence was an email showing that a *SCAD employee*—not a consumer—was *unsure* whether SCAD had authorized Sportswear’s apparel. Pet. App. 23a.

Second, Sportswear provided consumers with an explicit disclaimer that its products were *not* endorsed by SCAD. There was no allegation that this disclaimer was somehow hidden or unnoticed—even the Eleventh Circuit acknowledged that the disclaimer was “prominent.” Pet. App. 20a.

Why, then, did the Eleventh Circuit find a likelihood of confusion? The answer, again, was *Boston Hockey*. *Boston Hockey* held that the unauthorized manufacturing of NHL cloth emblems was trademark infringement—regardless of whether the manufacturer made clear it was not affiliated with the team. The *Boston Hockey* court reasoned:

The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams' trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in plaintiffs satisfies the requirement of the [Lanham] act. The argument that confusion must be as to the source of the manufacture of the emblem itself is unpersuasive, where the trademark, originated by the team, is the triggering mechanism for the sale of the emblem.

510 F.2d at 1012. Hence, the manufacturer's disclaimer as to the origin of the product could not cure the purported "confusion" drawn merely from copying something recognizable: "The exact duplication of the symbol and the sale as the team's emblem satisfying the confusion requirement of the law, words which indicate it was not authorized by the trademark owner are insufficient to remedy the illegal confusion." *Id.* at 1013.

In the decision below, the Eleventh Circuit was constrained to adopt the same understanding of

“confusion” as *Boston Hockey*. It found that Sportswear’s mere copying of a mark that incorporated SCAD’s goodwill and reputation—rather than any confusion regarding the source of Sportswear’s goods—was sufficient to satisfy the “confusion” requirement: “the concern for confusion *does not arise from the defendant’s unfair competition with the plaintiff’s products*, but rather from the defendant’s misuse of the plaintiff’s reputation and good will as embodied in the plaintiff’s mark.” Pet. App. 11a (emphasis added; internal quotation marks omitted). Hence, expressly following *Boston Hockey*, the Eleventh Circuit found that the disclaimer on Sportswear’s website could not cure the alleged confusion: “as in *SCAD I, Boston Hockey* and its progeny control our analysis here—this time on the disclaimer issue—and they require us to find that the intent factor does not favor Sportswear.” Pet. App. 22a. The court emphasized the factual similarity to *Boston Hockey*:

Like the intended customers in *Boston Hockey*, ... the customers who purchased Sportswear’s SCAD-branded merchandise ... did so because of the merchandise’s affiliation with the marks and because what the marks represent are meaningful to buyers. Indeed, that’s the same reason the *Boston Hockey* defendant sold patches bearing the teams’ trademarks: it hoped to benefit from the patches’ association with what they represented.

Pet. App. 22a-23a. The court expressed misgivings about this decision, but deemed it required by binding precedent. Pet. App. 22a (“Perhaps the website

disclaimers here may be viewed as negating some of Sportswear’s intent. But even if they are, ... they are insufficient under our binding precedent to totally negate the confusion.”).

This aspect of *Boston Hockey* is wrong too. As this Court has repeatedly held, the Lanham Act requires a likelihood of confusion as to whether the defendant was the *source of the goods*. Thus, here, SCAD bore the burden of proving that consumers would think SCAD was the *source of the apparel*, not merely that consumers would understand Sportswear’s apparel as *referring to SCAD*. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 31-32 (2003) (Lanham Act requires confusion over the “producer of the tangible product sold in the marketplace,” not “the ideas or communications that ‘goods’ embody or contain”); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004) (Lanham Act “requires a showing that the defendant’s actual practice is likely to produce confusion in the minds of consumers *about the origin of the goods or services in question*” (emphasis added)); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432-33 (2003) (same).

The leading trademark treatise has emphatically rejected *Boston Hockey*’s effective elimination of the likelihood-of-confusion standard:

In the famous 1975 *Boston Hockey* decision, the Fifth Circuit appeared to create a new ‘merchandising right’ to control all uses of a trademark of a sports team. This seemed to be an independent right to exclude, unmoored to the traditional rule that likelihood of confusion of

source, sponsorship or approval marked the outer boundaries of trademark infringement.

...

The *Boston Hockey* decision appeared to say 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. This radical break with traditional trademark law provoked a storm of criticism, both from other courts and commentators.

4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:10, Westlaw (5th ed., updated Mar. 2021). Other commentators have similarly repudiated *Boston Hockey*'s creation of a "merchandising right." See, e.g., Glynn S. Lunney, Jr., *Trademark's Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 Cal. L. Rev. 1195, 1226-27 (2018); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461, 475-76 (2005).

The *McCarthy* treatise states that "[t]he Fifth Circuit itself later retreated from the heresies of *Boston Hockey*," citing post-*Boston Hockey* case law. McCarthy, *supra*, § 24:10. Regrettably, in the decision below, those heresies came back with a vengeance. The Eleventh Circuit effectively conferred on SCAD exactly what trademark law does not permit: an "independent right to exclude, unmoored to the traditional rule" requiring "likelihood of confusion of

source, sponsorship or approval.” *Id.* In other words, the court conferred a merchandising right. That view of trademark law was wrong in *Boston Hockey* and is still wrong.

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

The Ninth and Tenth Circuits have repudiated the faulty reasoning of *Boston Hockey*. In *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), the plaintiff sued the defendant for the sale of jewelry bearing the plaintiff’s insignia. In finding for the defendant, the Ninth Circuit “reject[ed] the reasoning of *Boston Hockey*.” *Id.* at 918. 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 of a merchandising right, holding that the Lanham Act’s “scope is much narrower: to protect consumers against deceptive designations of the origin of goods and, conversely, to enable producers to differentiate their products from those of others.” *Id.* The court concluded 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. Relying on *Boston*

Hockey, the government argued that the company's trademark rights extended to anything bearing that trademark, including "patch sets." *See id.* at 1249-50. The Tenth Circuit disagreed. As relevant here, the 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.* This, the court held, was inappropriate because "trademark is meant to identify goods so that a customer will not be confused as to their source," not to "protect the owner's right in an abstract design or other creative product." *Id.* at 1252.

In the Ninth and Tenth Circuits, Sportswear would have prevailed. If the Lanham's Act purpose is to ensure that consumers can "identify goods" so as not to "be confused as to their source," *Giles*, 213 F.3d at 1252, and "to protect consumers against deceptive designations of the origin of goods and, conversely, to enable producers to differentiate their products from those of others," *Job's Daughters*, 633 F.2d at 918, then SCAD would have no case. Sportswear prominently and repeatedly told purchasers that it was not affiliated with SCAD; it engaged in no deceptive conduct; and there was obvious differentiation between SCAD's educational services and Sportswear's apparel. Yet *Boston Hockey* compelled the Eleventh Circuit to reach the contrary conclusion.

III. THE ELEVENTH CIRCUIT'S DECISION CONFLICTS WITH THE FEDERAL CIRCUIT'S REGISTRATION DECISIONS.

There is a final reason to grant review on both questions presented: the Eleventh Circuit's decision conflicts with the Federal Circuit's decisions regarding trademark registration. That conflict is guaranteed to create significant practical problems in the administration of the national trademark system.

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, SCAD could not have registered its marks for use 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, SCAD proffered no evidence that it sold apparel bearing its mark at the time of its federal service mark registration. Therefore, it could not have obtained a trademark registration for apparel.

Further, under the Lanham Act, an applicant cannot obtain a registration unless it is the first to use the mark with the designated goods or services. 15 U.S.C. § 1052(d). This is because “[t]he common law and the Lanham Act require that trademark ownership be accorded to the first bona fide user.” *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1472 (Fed. Cir. 1987). SCAD also proffered no evidence that it sold apparel before Sportswear, and for this reason as well it could not have obtained a trademark registration for apparel.

Yet, the effect of the Eleventh Circuit’s first decision was to put SCAD into the exact position it would have occupied in litigation if it *did* obtain a registration on apparel. The Eleventh Circuit held that SCAD’s mark had *unrestricted* scope. To be sure, the Eleventh Circuit remanded for a likelihood-of-confusion determination—but a likelihood-of-confusion determination would have been necessary even if SCAD *had* obtained a registration on apparel. Hence, the narrow scope of SCAD’s federal registration had *no effect whatsoever* on the practical scope of SCAD’s litigation rights.

If the Eleventh Circuit’s decision stands, then 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—will permit registration of a mark for a good or service only if the applicant proves it is *using* that mark with respect to that particular good or service, and only if others have not previously used

that mark with a similar good or service. Yet, under the Eleventh Circuit's first holding, the scope of that very mark extends to *all* goods and services.

The far-reaching effect of that decision might have been mitigated if the Eleventh Circuit had conducted a proper likelihood-of-confusion analysis. But it did not: Under the Eleventh Circuit's second holding, a plaintiff can establish a likelihood of confusion merely by showing that the mark is *printed* on any good or service, irrespective of source confusion.

The result of these two holdings 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 service offering. 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 goods on which it never used the mark and goods used first by others with that same mark—even though if it had tried to obtain such protection from the Patent and Trademark Office directly, it would have utterly failed. That outcome profoundly undermines the national system of trademark registration.

Further, that outcome would threaten the Lanham Act's goal of ensuring national uniformity. 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 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.”). Mail-order companies like Sportswear 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. And for mail-order companies with national operations, prospective plaintiffs can forum-shop, selecting courts within the Eleventh Circuit so they can exploit the Eleventh Circuit’s two decisions in this case.

In view of the conflict between the Eleventh Circuit and Federal Circuit, and the practical problems that conflict will generate, this Court’s review is warranted.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

Appendix A

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 19-11258

D.C. Docket No. 1:14-cv-02288-TWT

SAVANNAH COLLEGE OF ART
AND DESIGN, INC.

Plaintiff-Appellee,

Versus

SPORTSWEAR, INC., d.b.a. PrepSportswear,

Defendant-Appellant.

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

(December 22, 2020)

Before WILLIAM PRYOR, Chief Judge,
ROSENBAUM, Circuit Judge, and MOORE*,
District Judge.

* Honorable K. Michael Moore, Chief United States District Judge
for the Southern District of Florida, sitting by *designation*.

As a student struggling in 1971 to afford art classes at Portland State University, Carolyn Davidson did not say “no” when a businessman offered to pay her to come up with a logo design for his company. She drew a few different designs on tissue paper, and the businessman selected one. From these humble origins, Davidson’s design became the globally recognized Nike Swoosh.¹

Successful logos and design marks are lucrative—their recognition can instantly ignite an emotional connection with the associated brand.² And this is especially true for colleges, where sentimentality and pride create great demand for products emblazoned with schools’ word and design marks—so much so that

¹ Carolyn Davidson, *How a College Student created One of Sport’s Most Iconic Images*, ABC News, (June 17, 2016, 4:57 PM), <https://abcnews.go.com/Sports/College-student-created-sport-iconic-images/story?id=39945185> (last visited Dec. 21, 2020). Davidson charged only \$35 for her first deal with the shoe company now valued in the billions. Twelve years later, in 1983, Nike also gave her a gold ring in the shape of the Swoosh with a diamond in it and shares of Nike stock (not to mention chocolate dessert Swooshes). *Id.*

² When Tropicana briefly dropped its iconic green-and-gold, lettering and orange-with-a-protruding-straw design marks for plain font appearing next to a glass of orange juice, the Tropicana Pure Premium line experienced a 20% drop in sales in less than two months. Sarah Shearman, *Five Brand Logos Redesigns that Misfired and How to Deal with the Backlash*, *The Guardian*, (Aug. 1, 2014), <https://www.theguardian.com/media-network/media-network-blog/2014/aug/01brand-logo-redesign-airbnb-foursquare>. That was apparently enough to convince Tropicana to return to its former design marks. *See id.*

an entire industry has grown up around producing logo products for schools, colleges, and universities.

Plaintiff-Appellee Savannah College of Art and Design, Inc. (“SCAD”), and Defendant-Appellant Sportswear, Inc. (“Sportswear”), are now before us a second time on the merits in a dispute over Sportswear’s use of the college’s word marks “SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN” and the college’s design mark that includes its mascot, Art the Bee.

SCAD did not authorize Sportswear to use its marks to sell products inscribed with SCAD’s name and mascot. Upon discovery of Sportswear’s offerings, SCAD sued Sportswear for trademark infringement, unfair competition, false designation of origin, and counterfeiting under the Lanham Act, and for unfair competition and trademark infringement under Georgia common law.

On the first trip to this Court, SCAD appealed, and we considered the district court’s grant of summary judgment to Sportswear on all counts. We reversed, holding that our precedent required us to conclude that SCAD enjoyed enforceable trademark rights in the marks Sportswear used.³ We remanded to the district court to determine, in the first instance, whether Sportswear’s uses of the marks were likely to cause

³ An infringement claim requires demonstration “(1) that the plaintiff had enforceable trademark rights in the mark or name, and (2) that the defendant made unauthorized use of the mark or name such that consumers were likely to confuse the two.” *See Custom Mfg. & Eng’g, Inc. v. Midway Servs., Inc.*, 508 F.3d 641, 647 (11th Cir. 2007) (citation and internal quotation marks omitted).

consumer confusion. *Savannah College of Art & Design, Inc. v. Sportswear, Inc.*, 872 F.3d 1256, 1264, 1265 (11th Cir. 2017) (“*SCAD I*”).

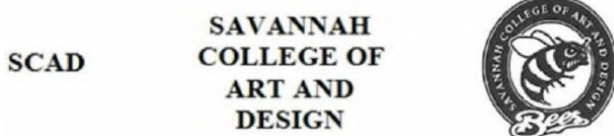
On remand, the district court concluded they were. Having previously dismissed SCAD’s counterfeit claim, the district court granted summary judgment to SCAD on its remaining three counts—two claims under the Lanham Act and one claim under Georgia law—and permanently enjoined Sportswear from selling products bearing the SCAD marks at issue. Now, on this case’s second merits trip to this Court, Sportswear appeals the district court’s decision. After careful consideration, we affirm.

I. Factual Background

We begin with a summary of the underlying facts of this case.⁴ SCAD, based in Georgia, is a private, non-profit college founded in 1978. It provides educational services to more than 11,000 students from more than 100 countries, including the United States. SCAD is principally known for specialized art programs in areas like painting, sculpture, architecture, fashion, photography, film, and design. Beyond SCAD’s educational programs, SCAD’s athletic teams compete in a variety of intercollegiate sports.

⁴ The facts are outlined in more detail in *SCAD I*, 872 F.3d at 1259-60, including specific circumstances surrounding the marks’ registrations and incontestable status. For reasons we discuss below in Section IV, we do not reach the legal arguments regarding the significance of the marks’ incontestable status, so we need not recount those details here.

This case concerns two word marks and one design mark that SCAD has used to market and promote its educational programs and services, as well as its athletic teams:



SCAD has used the two word marks—“SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN”—since 1979. As for the design mark containing SCAD’s mascot, “Art the Bee,” SCAD began using that in 2001, after having used variations of the bee portion since 1996.⁵

Sportswear operates an online business that markets and sells “fan” apparel and other items, such as t-shirts, sweatshirts, baseball caps, and duffel bags. Although Sportswear began selling apparel for kindergartens, grade schools, and high schools in 2003, it currently 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. Sportswear sells some of its goods with licensing agreements and others—such as the goods bearing SCAD’s marks—without.

⁵ The design mark, as shown above, consists of an image of SCAD’s mascot, “Art the Bee,” in the middle of a circle containing the words “SAVANNAH COLLEGE OF ART AND DESIGN” and “BEES.” In this opinion, we refer to this design mark as the “Bee Design Mark.”

In August 2009, Sportswear sold its first merchandise bearing SCAD's marks. But SCAD remained unaware of Sportswear's unauthorized use of its marks on products until February 2014, when a parent of a student-athlete forwarded Sportswear's website to one of SCAD's coaches. SCAD filed this case in July 2014, and Sportswear then stopped selling the unlicensed merchandise with SCAD's marks in its online "Savannah College of Art and Design Bees" store.

Before then, though, Sportswear undeniably marketed and sold products with both of SCAD's word marks, "SCAD" and "Savannah College of Art and Design." And while it did not use the Bee Design Mark in its full depiction, Sportswear's online store did offer apparel imprinted with SCAD's "Art the Bee" mascot, a prominent feature in the Bee Design Mark.

Sportswear's website contained several disclaimers that the clothing was not sponsored, endorsed by, or affiliated with SCAD and that all products were exclusively produced and fulfilled by Sportswear. Similarly, Sportswear's website, advertising material, and packaging material did not indicate that any of the merchandise constituted official SCAD products or were endorsed by SCAD. Finally, we note that several other third-party online retailers besides Sportswear printed SCAD's word marks on apparel.

II. Procedural Background

Based on these facts, SCAD sued Sportswear under the Lanham Act for claims of trademark infringement, unfair competition and false designation of origin, and counterfeiting, and under Georgia common law for unfair competition and trademark infringement.

Sportswear moved for summary judgment, and the district court granted its motion. SCAD appealed.

That brings us to *SCAD I*, *Savannah College of Art & Design, Inc. v. Sportswear, Inc.*, 872 F.3d 1256 (11th Cir. 2017). In *SCAD I*, we reversed the district court’s grant of summary judgment in favor of Sportswear. We explained that SCAD’s claims for trademark infringement under § 32(a) of the Act, codified at 15 U.S.C. § 1114(1)(a), and for unfair competition and false designation of origin under § 43(a), codified at 15 U.S.C. § 1125(a), required SCAD to establish two things. First, SCAD needed to show enforceable trademark rights in its marks used by Sportswear. *Id.* at 1261. And second, it had to prove that Sportswear’s unauthorized use of its marks was likely to confuse consumers. *Id.*

With respect to the first requirement, we concluded that the district court had applied an erroneous standard in limiting the reach of SCAD’s service-mark rights from extending to goods. *Id.* at 1260, 1262. Under our binding precedent, we said, SCAD’s enforceable service-mark rights for educational “services” could also cover “goods” in the form of the apparel Sportswear sold. *Id.* at 1262–64 (relying on *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975)).⁶

Then we turned to the second inquiry: likelihood of confusion. Because the district court had not

⁶ See *Bonner v. City of Prichard*, 661 F.2d 1206, 1207 (11th Cir. 1981) (en banc) (holding that all decisions of the “old Fifth” Circuit handed down prior to the close of business on September 30, 1981, are binding precedent in the Eleventh Circuit).

previously had the opportunity to assess the likelihood of confusion, we remanded the matter and directed the district court to assess in the first instance whether Sportswear's use of SCAD's service marks in Sportswear's apparel was likely to cause confusion. *Id.* at 1264. To evaluate this, we instructed the district court to consider the following seven factors: the strength of SCAD's marks; the similarity between SCAD's and Sportswear's marks, between Sportswear's goods and SCAD's services represented by the marks, between the parties' trade channels and customers, and between the advertising media used by the parties; Sportswear's intent; and the existence of any actual consumer confusion. *Id.* (citing *Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016)).⁷

Following remand, the parties filed letter briefs with the district court and responses thereto, addressing the likelihood-of-confusion issue and asserting that the record was complete and that no disputes of fact remained for trial. The court then once again took under advisement the parties' previously filed cross-motions for summary judgment, this time applying our guidance in *SCAD I*.

After consideration, the district court entered an order granting in part Sportswear's motion for summary judgment⁸ and granting SCAD's motion for

⁷ Before the case returned to the district court, Sportswear unsuccessfully sought a writ of *certiorari to the United States Supreme Court*. *Sportswear, Inc. v. Savannah Coll. Of Art & Design, Inc.*, 139 S. Ct. 57 (2018).

⁸ The district court ruled on two issues that are not subject to this appeal. It granted Sportswear's motion for summary judgment on

summary judgment on the trademark-infringement, unfair-competition, and false-designation-of-origin claims. Based on this ruling, the district court ultimately entered permanent injunctive relief for SCAD against Sportswear. In particular, the court enjoined Sportswear from using in any way the three SCAD marks at issue in this case. It further ordered Sportswear to delete all references to the three SCAD marks from its websites and databases. Finally, the court directed that any sales or shipments in the continental United States by Sportswear of products bearing the SCAD marks, without SCAD's prior written consent "shall be deemed a presumptive violation" of the injunction.

Sportswear appeals.

III. Standard of Review

We review de novo the district court's grant of summary judgment. *Code Revision Comm'n for Gen. Assembly of Ga. v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1235 (11th Cir. 2018). In so doing, we apply the same standards that bound the district court. *Id.* We view the record and draw all factual inferences in the light most favorable to the non-movant—here, Sportswear. *SCAD I*, 872 F.3d at 1260. Summary judgment is proper if the movant demonstrates that no genuine dispute of any material fact exists and the

SCAD's claims for infringement of the "shield design mark" because SCAD offered no proof that Sportswear has ever used the image. And to the extent that SCAD sought to hold Sportswear liable for its use of the words in the shield design, the district court noted that SCAD's other counts already covered that. The district court also denied Sportswear's motion for summary judgment on the defense of functionality.

movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a).

We may affirm a district-court judgment on any ground supported in the record, even if the district court did not specifically address it. *Wetherbee v. S. Co.*, 754 F.3d 901, 905 (11th Cir. 2014).

IV. Discussion

We conclude that our trademark precedents of *Boston Hockey, Laite*,⁹ and *SCAD I* require affirmance of the district court's judgment. Our mandate in *SCAD I* directed the district court to "assess the strength of SCAD's word marks" and 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." 872 F.3d at 1264. The district court complied, and we see no error in its determination.

1. Likelihood-of-Confusion Framework

In this Circuit, we consider seven factors when we analyze whether a likelihood of confusion exists between two marks:

- (1) strength of the mark alleged to have been infringed;
- (2) similarity of the infringed and infringing marks;
- (3) similarity between the goods and services offered under the two marks;
- (4) similarity of the actual sales methods used by the holders of the marks, such as their sales outlets and customer base;
- (5) similarity of advertising methods;
- (6) intent of the alleged

⁹ *Univ. of Ga. Ath. Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985).

infringer to misappropriate the proprietor's good will; and (7) the existence and extent of actual confusion in the consuming public.

Sovereign Military Hospitaller Order of Saint John of Jerusalem of Rhodes & of Malta v. Florida Priory of the Knights Hospitallers of the Sovereign Order of Saint John of Jerusalem, Knights of Malta, The Ecumenical Order, 809 F.3d 1171, 1181 (11th Cir. 2015) (quoting *Tana v. Dantanna's*, 611 F.3d 767, 774–75 (11th Cir. 2010)). The district court need not consider all factors in every case. *Id.* But we have said that “the type of mark and the evidence of actual confusion are the most important” of all the factors. *Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016).

On the other hand, in cases where the concern for confusion does not arise from the defendant's unfair competition with the plaintiff's products, but rather from “the defendant's misuse of the plaintiff's reputation and good will as embodied in the plaintiff's mark,” we discount certain likelihood-of-confusion factors. *Laite*, 756 F.2d at 1547. In particular, we have held that the three factors of similarity of product, identity of retail outlets and purchasers, and identity of advertising media utilized are less relevant in these types of cases. *Id.* So their absence “does not undermine the district court's finding of a ‘likelihood of confusion.’” *Id.*

In line with the reasoning we expressed in *Laite*, our instructions in *SCAD I* to address the likelihood-of-confusion analysis focused on confusion over “origin, source, approval, affiliation, association, or sponsorship.” 872 F.3d at 1264. These considerations

directly relate to the misuse of SCAD’s “reputation and good will as embodied in [its] mark[s].” *Laite*, 756 F.2d at 1547.

On review of a district court’s grant of summary judgment on a likelihood-of-confusion analysis, “[t]he real question is whether the court’s ultimate determination about the ‘likelihood of confusion’ was correct.” *Sovereign Military*, 809 F.3d at 1181 (11th Cir. 2015) (citation and internal quotation marks omitted). And while generally likelihood of confusion raises a question of fact, when appropriate, it may be determined as a matter of law. *Alliance Metals, Inc., of Atlanta v. Hinely Indus., Inc.*, 222 F.3d 895, 907 (11th Cir. 2000).

We decide each case on its own merits, determining whether the plaintiff has satisfied the threshold for evidence of confusion based on the circumstances of the particular case. *See Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 122 F.3d 1379, 1382 (11th Cir. 1997). When we analyze the likelihood of confusion, we are mindful that “sophisticated consumers” of complex goods or services “are less likely to be confused than casual purchasers of small items.” *Fla. Int’l Univ.*, 830 F.3d at 1256 (citation and internal quotation marks omitted). We accord weight to the individual likelihood-of-confusion factors based on what the situation calls for and do not simply calculate the number of factors favoring such a conclusion and the number of factors militating against it. *See Jellibeans, Inc. v. Skating Clubs of Ga., Inc.*, 716 F.2d 833, 840 n.17 (11th Cir. 1983).

In reviewing the likelihood-of-confusion factors here, we begin with SCAD's word marks and then move on to its Bee Design Mark.

2. SCAD's Word Marks

a. Strength of the Marks

On the issue of the strength of SCAD's word marks ("SCAD" and "Savannah College of Art and Design"), it is undisputed that both service marks hold incontestable status. But as we have noted above, *see supra* at n.10, on this record we do not rely on the *Dieter* presumption to conclude that SCAD's word marks are strong under these facts.

Instead, we consider the strength of the mark under our traditional analysis. Our Circuit recognizes four categories of a mark's distinctiveness, listed in ascending order of strength:

(1) generic—marks that suggest the basic nature of the product or service; (2) descriptive—marks that identify the characteristic or quality of a product or service; (3) suggestive—marks that suggest characteristics of the product or service and require an effort of the imagination by the consumer in order to be understood as descriptive; and (4) arbitrary or fanciful—marks that bear no relationship to the product or service, and the strongest category of trademarks.

Gift of Learning Found., Inc. v. TGC, Inc., 329 F.3d 792, 797–98 (11th Cir. 2003). We have explained that we view the last two categories of marks—suggestive and arbitrary or fanciful—as “inherently distinctive.”

Tana, 611 F.3d at 774 (citation and internal quotation marks omitted). These are marks whose “intrinsic nature serves to identify a particular source of a product.” *Id.* (citation and internal quotation marks omitted). At the other end of the spectrum, generic marks, which cannot be registered as trademarks under the Lanham Act, generally cannot receive trademark protection. *Id.*

Descriptive marks fall between these two extremes. Although they are not inherently distinctive like suggestive and arbitrary or fanciful marks, descriptive marks nonetheless may become distinctive enough to enjoy trademark protection if they acquire “secondary meaning.” *Id.*; 15 U.S.C. § 1052(f). Secondary meaning develops when the consuming public primarily associates a name with the producer, as opposed to the product. *Tana*, 611 F.3d at 774. Ultimately, the strength or distinctiveness of the trademark or service mark corresponds directly with the scope of protection it receives. *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1361 (11th Cir. 2007).

SCAD’s word marks have acquired significant strength through the more than four decades of their use and through SCAD’s investment in goodwill. At the time the parties filed their cross-motions for summary judgment, SCAD enrolled over 11,000 students, and now its enrollment numbers thousands more than that. It is among the leading institutions for creative professionals, with several programs honored as the best in the nation. Not only that, but SCAD also has nationally ranked athletic teams. As a consequence of that growth in goodwill and reputation since 1978, SCAD enjoys a worldwide reach of students and alumni, as well as other supporters, who recognize its

marks. And beyond academics and athletics, SCAD coordinates other events throughout the year that draw tens of thousands of attendees.

These unrebutted facts support the conclusion that SCAD's word marks have acquired strength through the promotional efforts of SCAD and its network of connections. See *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 974 n.13 (11th Cir. 1983). Even words that could be considered weak, such as geographical terms, can acquire secondary meaning and be afforded protection for that secondary meaning. See also *Cont'l Motors Corp. v. Cont'l Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) ("Protection is warranted on what it has come to signify regardless of any original weakness, actual or supposed.").

Sportswear attempts to rebut any strength of SCAD's word marks by pointing to three other third-party apparel manufacturers who have used the marks. Sportswear is correct that, as a general matter, third-party use has the potential to weaken a finding of a mark's strength. See *Fla. Int'l Univ.*, 830 F.3d at 1257 ("Thus, the number of third-party users is important, but there is no hard-and-fast rule establishing a single number that suffices to weaken a mark." (citation and internal quotation marks omitted)). Indeed, when extensive third-party use has occurred, that diminishes a mark's strength. *Id.* at 1257–58 (finding twelve third-party uses sufficient to diminish); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1539 (11th Cir. 1986) (affording lesser protection where eight third-party users employed similar trade dress); *El Chico, Inc. v. El Chico Cafe*, 214 F.2d 721, 725 (5th Cir. 1954) (concluding "El Chico" trademark was "weak" in light

of registrations of the name and similar names by twenty-seven third parties).

But here, Sportswear has identified only three third-party usages of SCAD's marks—significantly fewer than we have previously relied on in finding a mark's strength to be materially diluted. “[C]ommercial strength measures the marketplace's recognition value of the mark.” *Fla. Int'l Univ.*, 830 F.3d at 1258. And as we have explained, SCAD's word marks here developed substantial strength over SCAD's forty years of existence, because of the size and reach of its student body, its alumni network, and its programs. Under these circumstances, even viewing the facts in the light most favorable to Sportswear, we cannot conclude that Sportswear has shown that the three third-party uses diminished the strength of SCAD's word marks by more than any negligible amount.

Nor can Sportswear contend persuasively that the SCAD marks are weak. On the contrary, it strains credulity for Sportswear to argue against the strength of SCAD's marks when Sportswear offered and sold merchandise with those identical word marks to obtain a profit from its consumers. If the marks had no strength, consumers would not purchase attire imprinted with them in the first place, and Sportswear would have no reason to offer for sale products bearing the marks. We have recognized this concept in our precedent that proof of intentional copying is probative on the secondary-meaning analysis. *See Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 860 (11th Cir. 1983).

In sum, the strength factor favors SCAD, as the district court correctly concluded, even without reliance on the *Dieter* presumption.

b. Similarity Between the Infringed and Infringing Marks

We evaluate similarity by accounting for “the overall impression created by the marks.” *Jellibeans*, 716 F.2d at 842. Here, Sportswear undoubtedly used similar marks to SCAD’s word marks. In fact, they were not just similar, but identical, as the record shows that Sportswear used SCAD’s two word marks on its apparel, as well as the Art the Bee design with other SCAD marks. So this factor weighs in SCAD’s favor as well, as the district court correctly concluded.

c. Similarity of Goods or Services

The similarity-of-goods factor assesses “whether the goods are so related in the minds of consumers that they get the sense that a single producer is likely to put out both goods.” *Frehling Enters., Inc. v. Int’l Select Grp., Inc.*, 192 F.3d 1330, 1338 (11th Cir. 1999); *see also PlayNation Play Sys., Inc. v. Velez Corp.*, 924 F.3d 1159, 1168 (11th Cir. 2019).

In *Laite*, as we have highlighted, we noted that this factor is less important in cases—like this one—that concern the use of the plaintiff’s service marks on the defendant’s goods for the very reason that the plaintiff’s marks embody the plaintiff’s goodwill and reputation. *See Laite*, 756 F.2d at 1547. So the district court did not err in giving the factor little significance.

d. Similarity of Actual Sales Methods

The similarity-of-actual-sales-methods factor contemplates the similarity of the parties' customer bases. *See Sovereign Military*, 809 F.3d at 1181. Here, the parties' customer bases overlap, as the target customers for Sportswear's apparel goods bearing SCAD's word marks are the same as those of SCAD's educational services—namely, its current students and their parents, its alumni and faculty, and fans of its athletic teams. This factor therefore weighs in favor of SCAD. Nevertheless, since *Laite* instructs that this factor bears less (if any) weight in cases like this one (where the defendant seeks to trade off the plaintiff's goodwill and reputation, as opposed to its products), its weight is not much. *See Laite*, 756 F.2d at 1547.

e. Similarity of Advertising Methods

The similarity of advertising methods is the third factor that *Laite* holds is less important to the likelihood-of-confusion analysis in a case like this one. *See Laite*, 756 F.2d at 1547. We conclude that the district court did not err in finding this factor neutral. As the district court noted, although both parties advertise over the internet, “[t]hat the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.” 4 McCarthy on Trademarks and Unfair Competition § 24:53.50 (5th ed.).

f. Sportswear's Intent to Misappropriate SCAD's Goodwill

Next up, we consider Sportswear's intent to misappropriate SCAD's goodwill. Sportswear relies on

its use of website disclaimers to negate any finding of intent to confuse consumers. Intent may be proven by circumstantial evidence. *Jellibeans*, 716 F.2d at 843. The district court, relying on *Babbit Electronics, Inc. v. Dynascan Corp.*, 38 F.3d 1161, 1179 (11th Cir. 1994), reasoned that intent to copy in itself can create a rebuttable presumption of the likelihood of confusion. But the district court ended its analysis there, noting that SCAD had not argued for such a presumption, yet concluding that the factor favored SCAD.

Babbit certainly supports the notion that, as a matter of law, courts may find a likelihood of confusion “if the defendant intended to derive benefit from the plaintiff’s trademark.” 38 F.3d at 1179. And where a party copies a mark “with the intent that the public recognize and purchase the emblems as the symbol of the” mark holder, intent likewise can be found. *Boston Hockey*, 510 F.2d at 1012.

This is equally true when the defendant intends to derive a benefit from the good will of the mark holder. *See John H. Harland Co.*, 711 F.2d at 977 (“In this case, there is some evidence from which the jury might have inferred that Clarke adopted the Entry Stub mark in order to appropriate some of the good will associated with Harland’s Memory Stub mark. Clarke was well aware of the success of Harland’s Memory Stub product.”); *AmBrit*, 812 F.2d at 1542 (“[A] finding that Kraft adopted the trade dress with the intent of deriving benefit from the reputation of Isaly’s Klondike may alone be enough to justify the inference that there is confusing similarity.”); *see also AmBrit*, 812 F.2d at 1543 (“Although Kraft was free to copy the Klondike product and the functional packaging features of that product, the finder of fact may infer from

evidence of such actions an intent to derive benefit from Isaly's goodwill.”).

Nevertheless, we have observed that mere evidence of intentional copying—in the absence of any other evidence—does not conclusively establish a likelihood of confusion. *Yellowfin Yachts, Inc. v. Barker Boatworks, LLC*, 898 F.3d 1279, 1293 (11th Cir. 2018). Rather, the plaintiff must also present some evidence indicating that the defendant copied the marks with the intent to confuse customers. *Id.* at 1294 (finding the district court properly concluded plaintiff put forth no evidence showing intent to copy “in order to deceive consumers as to the source of [the] boats” and “cause consumer confusion”); *see id.* at 1293 (“There is a difference between intentional copying and intentional copying *with the intent to cause confusion.*” (emphasis in original)); *see also Jellibean*s, 716 F.2d at 843 (circumstantial evidence, including testimony, supported finding of intent to confuse roller-skaters).

The very nature of school memorabilia relies upon the goodwill, reputation, and affiliation people associate with that school. So it is not surprising that Sportswear even admits on appeal that customers visit its website to “create apparel bearing the name of the school, team, or organization with which they desire to express affiliation.” Cognizant of the intuitive link between school merchandise and sponsorship, Sportswear cannot reasonably argue against a finding of intent here.

Nor can Sportswear rely on its website disclaimers to completely negate any finding of intent. To be sure, Sportswear's website bears these prominent disclaimers: “This store is not sponsored or endorsed

by Savannah College of Art and Design” and “This store is not affiliated with, sponsored or endorsed by Savannah College of Art and Design. All products in this store are produced and fulfilled by Prep Sportswear.” And Sportswear urges the Court to distinguish our holdings on the insufficiency of product disclaimers in *Boston Hockey* and *Laite* and instead rely on the finding of successful website disclaimers in the District of Maryland and the Northern District of Georgia. But while Sportswear correctly notes that the disclaimers in *Boston Hockey* and *Laite* did not involve websites, but rather disclaimers on physical products, we are nonetheless guided by those holdings here.

In *Boston Hockey*, we considered the unauthorized manufacturing and sale of National Hockey League embroidered cloth emblems, which “were substantial duplications of the marks,” and which the defendant reproduced with the intention that consumers recognize the hockey-team symbols and purchase them for that reason. 510 F.2d at 1009. After we addressed the Lanham Act claims, we considered and rejected the idea that the common-law unfair competition claim could be rendered fair with a disclaimer. We said, “The exact duplication of the symbol and the sale as the team’s emblem satisfying the confusion requirement of the law, words which indicate it was not authorized by the trademark owner are insufficient to remedy the illegal confusion. Only a prohibition of the unauthorized use will sufficiently remedy the wrong.” *Id.* at 1013.

Similarly, in *Laite*, the defendant, a wholesaler of novelty beers, began marketing “Battlin’ Bulldog Beer,” which the district court found caused a likelihood of confusion with the *University of Georgia Bulldog*. 756 F.2d at 1537. The beer wholesaler

argued, among other things, on appeal that no confusion from the sale of “Battlin’ Bulldog Beer” could occur because each can contained a disclaimer that the beer was “[n]ot associated with the University of Georgia.” *Id.* at 1547. We soundly rejected that argument and held that the disclaimer was insufficient to negate confusion—both because the disclaimer was inconspicuous on the individual cans and because *Boston Hockey* required us to conclude that disclaimers noting that a product is not authorized by a trademark owner are insufficient to remedy the consumer’s confusion. *Id.* (citing *Boston Hockey*, 510 F.2d at 1013).

So as in *SCAD I*, *Boston Hockey* and its progeny control our analysis here—this time on the disclaimer issue—and they require us to find that the intent factor does not favor Sportswear. Perhaps the website disclaimers here may be viewed as negating some of Sportswear’s intent. But even if they are, like the disclaimers in *Boston Hockey* and *Laite*, they are insufficient under our binding precedent to totally negate the confusion. *See Boston Hockey*, 510 F.2d at 1013.

The record and the nature of this case demonstrate that companies like Sportswear copy the word marks of schools like SCAD for application on apparel for the very reason that SCAD’s goodwill and educational reputation fundamentally drive the sales. Like the intended customers in *Boston Hockey* and *Laite*, the customers who purchased Sportswear’s SCAD-branded merchandise, whether current students and faculty, alumni, or sports fans, did so because of the merchandise’s affiliation with the marks and because what the marks represent are meaningful to buyers. Indeed, that’s the same reason the *Boston Hockey*

defendant sold patches bearing the teams' trademarks: it hoped to benefit from the patches' association with what they represented. *See Boston Hockey*, 510 F.2d at 1012. Thus, we conclude that the district court did not err in finding that this factor favors SCAD.

g. Actual Confusion in the Consuming Public

While this final actual-confusion factor weighs heavily in the balance, we have noted that its absence does not necessarily spell doom for a final finding of a "likelihood" of confusion under the seven-factor analysis. *E. Remy Martin & Co., S.A. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1529 (11th Cir. 1985). "Actual confusion" and "likelihood of confusion" are demonstrably different concepts. That is especially the case in smaller markets with cheaper items and minimal sales. *AmBrit*, 812 F.2d at 1544. Survey evidence is similarly unnecessary for a likelihood-of-confusion finding. *See PlayNation*, 924 F.3d at 1169 ("Lack of survey evidence does not weigh against the plaintiff when determining likelihood of confusion.").

Here, SCAD offers only one piece of evidence to show actual confusion: a parent of a student sent a link to Sportswear's website to one of SCAD's employees, and the employees were unsure whether Sportswear's use was authorized. This is hardly strong evidence of actual confusion. As the district court correctly concluded, this factor weighs in favor of Sportswear, but it is not determinative of the issue of likelihood of confusion under the multifactor analysis. In fact, for the entirety of the nearly five-year period from August 31, 2009, to July 27, 2014, when Sportswear sold products bearing SCAD's marks, the record of total

sales for those products was \$23,703.14, with net profits of \$1,896.25. The vast majority of individual sales were under \$100, with a small number reaching into the \$200–\$300 range. In other words, this is precisely the type of case, with a smaller market and inexpensive goods, in which we have cautioned that weak evidence of actual consumer confusion is not dispositive. *See AmBrit*, 812 F.2d at 1544.

h. Balancing the Seven Factors

Now that we have individually reviewed each of the seven likelihood-of-confusion factors, we evaluate the weight of the facts, considering the unique circumstances of the case. *See Lone Star Steakhouse*, 122 F.3d at 1382; *Jellibbeans*, 716 F.2d at 840 n.17. In doing so, we must keep in mind that the strength and type of the mark and the evidence of actual confusion are the most important factors. *Fla. Int'l Univ.*, 830 F.3d at 1255.

Of the seven factors, four favor SCAD: the strength of the mark, the similarity of the infringed and infringing marks, the similarity of Sportswear's and SCAD's customer base, and the intent of Sportswear to misappropriate SCAD's goodwill.

One factor—undoubtedly one of the two most important ones—favors Sportswear, since the record contains little evidence of any actual consumer confusion. But as we just discussed, the relatively low sales volume, over the five-year period, of items bearing SCAD's marks and the relatively inexpensive nature of the goods further lessen the import of the actual-confusion factor. *See AmBrit*, 812 F.2d at 1544. As we have explained, the likelihood-of-confusion analysis must be mindful that “casual purchasers of

small items” are more likely to be confused than more sophisticated consumers of complex goods. *See Fla. Int’l Univ.*, 830 F.3d at 1256 (citation and internal quotation marks omitted).

Finally, as we have also described, the remaining factors are of little relevance here because the concern for confusion does not arise from Sportswear’s unfair competition with SCAD’s products, but rather from Sportswear’s “misuse of the plaintiff’s reputation and good will as embodied in the plaintiff’s mark.” *See Laite*, 756 F.2d at 1547. Given the balance of facts in this matter, we conclude that the district court correctly found a likelihood of confusion as to Sportswear’s use of SCAD’s word marks.

3. The Bee Design Mark

Now we briefly address the parties’ arguments concerning Art the Bee. First, Sportswear argues that it cannot be held liable for use of Art the Bee because SCAD ostensibly abandoned the design mark in 2011. But since we are reviewing the denial of Sportswear’s motion for summary judgment on that issue, we must take the facts in the light most favorable to SCAD. While Sportswear points to the 2011 memo regarding non-use of the Art the Bee mark in future athletic merchandise, SCAD responds with evidence of Art the Bee’s continued use on athletic apparel. So we cannot say that Sportswear has shown entitlement as a matter of law under the stringent, heavy burden for demonstrating abandonment. *See Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc.*, 304 F.3d 1167, 1175 (11th Cir. 2002).

Next, Sportswear argues that any claims regarding its use of Art the Bee are moot, relying on the cancellation of the design mark in September 2016. A case becomes moot if “the issues presented are no longer ‘live’ or the parties lack a legally cognizable interest in the outcome.” *De La Teja v. United States*, 321 F.3d 1357, 1362 (11th Cir. 2003) (citation and internal quotation marks omitted). A court may not decide a case that has become moot because it no longer constitutes a “Case” or “Controversy” as Article III of the Constitution requires, so the court lacks jurisdiction. *BankWest, Inc. v. Baker*, 446 F.3d 1358, 1363 (11th Cir. 2006). Rather, Article III’s case-or-controversy requirement demands a live controversy throughout all stages of the litigation. *Id.*

Here, the case is not moot. Though Sportswear points to SCAD’s cancellation of the Art the Bee design mark in 2016, all Sportswear’s uses occurred before that happened—between 2009 and 2014. So to the extent that Sportswear violated the Bee Design Mark during that period, SCAD may be entitled to damages, regardless of its later cancellation of the mark. As a result, the design-mark claim is not moot.

Sportswear next asserts that it should prevail on the design-mark issue because the record is devoid of any evidence that it ever printed products with the Bee Design Mark. But violating the Bee Design Mark does not require a verbatim copying of the Bee Design Mark. *Jellibbeans*, 716 F.2d at 842. Rather, a violation can occur based on the overall impression of the copy. *Id.*

Likewise, any argument by Sportswear that it cannot infringe SCAD’s Bee Design Mark because it

did not use the *identical* version of the design misunderstands the likelihood-of-confusion test, which does not require the marks to be identical. Rather, the question is *similarity* of the marks. And the graphic Sportswear used for apparel on its website is materially indistinguishable from the “angry bee” SCAD used as Art the Bee:



SCAD



Sportswear

For these reasons, the district court correctly determined that “uncontroverted evidence” established that Sportswear had used “the bee portion of the logo in conjunction with [SCAD’s] text marks.” And the same analysis we conducted with respect to SCAD’s word marks applies equally to the Bee Design Mark here. As a result, the likelihood-of-confusion factors support the district court’s finding that Sportswear’s uses of the Bee Design Mark were an infringement.

V. Conclusion

For the reasons we have explained, the district court properly entered summary judgment and the corresponding permanent injunction in favor of SCAD. We therefore affirm the judgment of the district court.

AFFIRMED.

Appendix B

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

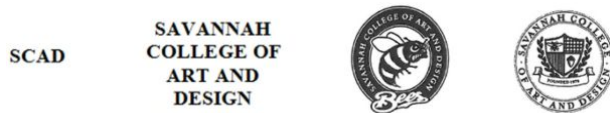
U.S.C. § 1125; and unfair competition under O.C.G.A. § 10-1-372.

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.

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

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

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

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

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 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]”).

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. 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.

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

1999) (same); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 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).

requirements for a § 1125 claim) (citation omitted); *Dieter v. B & H Indus. 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 *Laite* 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. *Laité* 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 *Laité* did not involve or analyze federally-registered marks).

B

Although *Laité* 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 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).

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.

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

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”*

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.” *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,

Can Be Said?, 52 Am. Bus. L.J. 317, 343 (2015) (discussing the “judicial trend expanding the concept of a ‘merchandising right’ “).

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

48a

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.

49a

Appendix C

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

SAVANNAH COLLEGE OF
ART AND DESIGN, INC.,

Plaintiff,

v.

SPORTSWEAR, INC.
d/b/a PrepSportswear,

Defendant.

CIVIL ACTION FILE
NO. 1:14-CV-2288-TWT

OPINION AND ORDER

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 in part and DENIED in part and the Plaintiff's Motion for Summary Judgment is GRANTED. The Defendant's Motion to Strike Improper Evidence is GRANTED.

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 marks registered in connection with the provision of educational services: 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 The Defendant, Prep Sportswear, is an internet-based business incorporated under Washington law in 2005.⁸ The Defendant sells customizable apparel and fan clothing for a variety of organizations, including high school and college sports teams.⁹ In August of 2009, the Defendant began selling goods bearing the words

¹ Def.'s Statement of Material Facts ¶ 1 [[Doc. 039-2].

² *Id.*

³ *Id.* ¶ 2.

⁴ *Id.* ¶ 4.

⁵ *Id.* ¶ 8.

⁶ *Id.* ¶ 14.

⁷ *Id.* ¶ 17.

⁸ *Id.* ¶ 44.

⁹ *Id.* ¶ 45.

“Savannah College of Art and Design” and “SCAD.”¹⁰ On July 18, 2014, the Plaintiff brought suit for trademark infringement under Section 32 of the Lanham Act, 15 U.S.C. § 1114; unfair competition and false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125; and unfair competition and trademark infringement under the Georgia Uniform Deceptive Trade Practices Act, O.C.G.A. § 10-1-372.

The parties filed cross-motions for summary judgment on April 17, 2015. The Court entered judgment in favor of the Defendant. The Court found dispositive the following facts: (1) all of the marks were registered in connection with the provision of educational services;¹¹ (2) none of the marks were registered for use in connection with the sale of apparel;¹² and (3) the Plaintiff produced no evidence that it or its licensees had used the marks in connection with the sale of apparel prior to 2011.¹³ Section 1114 protects against infringement only if the marks at issue are federally registered. The Court reasoned that the Plaintiff could not sustain its § 1114 claims because it could not show that it had federally registered its marks for use in connection with the sale of apparel. Section 1125 extends broader protections to the holders

¹⁰ *Id.* ¶¶ 53-54.

¹¹ *Id.* ¶¶ 5, 9, 15, 18.

¹² *Id.* ¶¶ 6, 10, 16, 19

¹³ In 2011, the Plaintiff entered into a licensing agreement with Follett Higher Education Group, Inc. to sell branded apparel in its campus bookstores. *Id.* ¶¶ 24, 27-30.

of both registered and unregistered, or “common-law,” marks. In order to sustain its § 1125 claim, however, the Plaintiff would need to demonstrate that it had appropriated common-law trademark rights through prior use of its marks in commerce. There is no evidence in the record that the Plaintiff used its marks in commerce prior to the Defendant’s first use of the marks on apparel in 2009. Therefore, the Court concluded that the Plaintiff’s federal claims, and by extension its state law claim, failed as a matter of law. The Court did not reach the question of whether the Defendant’s use of the contested marks created a likelihood of confusion.

The Plaintiff appealed to the Eleventh Circuit. The Eleventh Circuit reversed and remanded on the grounds that this Court’s decision could not be reconciled with the controlling authority of *Boston Professional Hockey As’sn, Inc., v. Dallas Cap & Emblem Mfg., Inc.*¹⁴ In *Boston Hockey*, the National Hockey League and several individual hockey teams sought to enjoin the defendant manufacturer from selling replica patches bearing the teams’ symbols. The hockey teams had federally registered their team symbols “as service marks for ice hockey entertainment services,” but had not registered their marks in connection with the sale of goods. The *Boston Hockey* panel nevertheless held that the plaintiffs were entitled to a permanent injunction barring the defendant from manufacturing and selling the replica patches. The Eleventh Circuit explained the doctrinal implications as follows:

¹⁴ 510 F.2d 1004 (5th Cir. 1975).

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.¹⁵

In light of *Boston Hockey*, the Eleventh Circuit held that the validity and scope of the Plaintiff's federally registered service marks extend to the Defendant's use of the allegedly infringing marks on apparel. The Eleventh Circuit remanded to this Court with instructions to "assess the strength of [the Plaintiff's] word marks" and 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."¹⁶ On remand, the parties agree that the record is complete and that the matter is ripe for summary adjudication.¹⁷ The Court will therefore address the parties' remaining arguments on summary judgment.

II. Standard Legal

Summary judgment is appropriate only when the pleadings, depositions, and affidavits submitted by the parties show no genuine issue of material fact exists

¹⁵ *Savannah Coll. Of Art & Design, Inc. v. Sportswear, Inc.*, 872 F.3d 1255, 1264 (11th Cir. 2017), *cert. denied*, 139 S. Ct. 57, 202 L. Ed. 2d 20 (2018).

¹⁶ *Id.*, 872 F.3d at 1264.

¹⁷ Pl.'s Letter Br. in Supp. of Summ. J., at 5 [Doc. 83]; Def.'s Resp. to Pl.'s Letter Br. in Supp. of Summ. J., at 1 [Doc. 85].

and that the movant is entitled to judgment as a matter of law.¹⁸ The court should view the evidence and any inferences that may be drawn in the light most favorable to the nonmovant.¹⁹ The party seeking summary judgment must first identify grounds that show the absence of a genuine issue of material fact.²⁰ 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 exists.²¹

III. Discussion

The Plaintiff argues that summary judgment should be granted for all of its infringement claims on likelihood of confusion grounds.²² “Although likelihood of confusion is a question of fact, it may be decided as a matter of law.”²³ The Defendant’s primary argument for summary judgment has been foreclosed by the

¹⁸ Fed. R. Civ. P. 56(c).

¹⁹ *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 158-59 (1970).

²⁰ *Celotex Corp. V. Catrett*, 477 U.S. 317, 323-24 (1986).

²¹ *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 257 (1986).

²² The Plaintiff’s § 1114 and § 1125 claims both turn on whether the Defendant’s use of similar or identical marks is likely to cause confusion as to the origin of the products. *Ross Bicycles, Inc. v. Cycles USA, Inc.*, 765 F.2d 1502, 1503-04 (11th Cir. 1985). Courts analyzing infringement claims arising under Georgia law apply the same likelihood of confusion test. *Kason Indus. v. Component Hardware Group*, 120 F.3d 1199, 1203 (11th Cir. 1997). Accordingly, there is no need for the Court to distinguish between the Plaintiff’s claims in addressing its arguments on summary judgment.

²³ *Tana v. Dantanna’s*, 611 F.3d 767, 775 n.7 (11th Cir. 2010).

Eleventh Circuit on appeal. In the alternative, the Defendant argues for summary judgment based on the affirmative defenses of abandonment and functionality. The Defendant further argues that there is no evidence in the record that it has actually used the Plaintiff's shield design mark on apparel goods. Finally, the Defendant renews its motion to exclude evidence pertaining to the Plaintiff's advertising of its marks from the summary judgment record.

“In a trademark infringement action, the plaintiff must show, first, that its mark is valid and, second, that the defendant's use of the contested mark is likely to cause confusion.”²⁴ The Defendant's affirmative defenses are challenges to the validity of the Plaintiff's marks that, in the Court's view, are best resolved before proceeding to the likelihood of confusion prong. Therefore, the Court will begin with the Defendant's affirmative defenses. The Court will also resolve the Defendant's evidentiary motions because the evidence that the Defendant seeks to exclude is relevant to the likelihood of confusion analysis.

A. Abandonment

The Defendant argues that the Plaintiff's marks have been abandoned through naked licensing. “A license is naked, resulting in trademark abandonment,

²⁴ *Dieter v. B & H Indus. of Sw. Fla., Inc.*, 880 F.2d 322, 326 (11th Cir. 1989). The Plaintiff's federal claims for infringement and unfair competition and its parallel state law claims all turn on the likelihood of confusion test. See *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 258-59 (5th Cir. 1980); *Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC*, 605 F.3d 931, 935, 935 n.16 (11th Cir. 2010).

when there is insufficient control retained by the trademark owner to ensure the quality of production and prevent public confusion.”²⁵ An abandoned trademark “falls into the public domain and is free for all to use[.]”²⁶ The party alleging abandonment must meet a stringent burden, because “only minimal control is required to make the trademark license valid.”²⁷

In June of 2011, the Plaintiff entered into a “Bookstore Management Agreement” with Follett Higher Education Group, Inc. that, among other things, licensed Follett to sell merchandise bearing the Plaintiff’s marks online and in the Plaintiff’s brick and mortar bookstores.²⁸ The parties contest the extent of the Plaintiff’s control over the quality of the goods sold by Follett. The Defendant relies on excerpts from depositions with the Plaintiff’s employees that purportedly show that the Plaintiff’s employees do not select, approve, or inspect the quality of the clothing

²⁵ *Go Med. Indus. Pty, Ltd. Bav. Inmed Corp.*, 300 F. Supp. 2d 1297, 1315 (N.D. Ga. 2003) (citing *Barcamerica Intern. USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596 (9th Cir. 2002)), *aff’d sub nom. Go Med. Indus. Pty., Ltd. v. Inmed Corp.*, 471 F.3d 1264 (Fed. Cir. 2006)

²⁶ *Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc.*, 304 F.3d 1167, 1173 (11th Cir. 2002) (quoting 3 McCarthy on Trademarks and Unfair Competition § 17:1 (4th ed.)).

²⁷ *Go Med. Indus. Pty, Ltd.*, 300 F. Supp. 2d at 1315 (citing U.S. *Jaycees v. Philadelphia Jaycees*, 639 F.2d 134, 140 (3rd Cir. 1981); *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 387 (5th Cir. 1977)

²⁸ Ex. 6 to Axel Decl., at 3 [Doc. 39-10].

manufactured and sold by Follett.²⁹ In response, the Plaintiff points to language from the licensing agreement indicating that the Plaintiff may “in its sole discretion” direct Follett to discontinue sale of any goods deemed to be of insufficient quality.³⁰ The Plaintiff also points to evidence tending to show that its employees are involved in some capacity in the design and quality control process.³¹ It is clear from the record that the Plaintiff exercises at least some control over the Follett’s products bearing its marks.

In addition to its naked licensing argument, the Defendant makes the related but analytically distinct argument that the Plaintiff has “expressly abandoned” the bee design mark when it issued internal instructions in 2011 to cease use of the mark on apparel.³² The Defendant’s abandonment argument with respect to the bee design mark is without merit. It appears from the record that the Plaintiff has continuously used the bee design mark in connection with the educational services for which it is registered. There is no direct or circumstantial evidence in the record to support a finding that the Plaintiff intended to abandon its service mark. As the Eleventh Circuit explained on appeal, whether the Plaintiff does or does not use its marks on goods has no bearing on the marks’ validity in this infringement action. Therefore, the

²⁹ Def.’s Statement of Material Facts ¶¶ 37-43.

³⁰ Pl.’s Resp. to Def.’s Mot. for Summ. J., at 11 [Doc. 46] (citing Ex. 6 to Axel Decl.).

³¹ *Id.* at 11-15.

³² Def.’s Br. in Supp. of Mot. for Summ. J., at 24 [Doc. 39-1].

Defendant's motion for summary judgment on the defense of abandonment should be denied.

B. Functionality

The Defendant argues that its use of the Plaintiff's marks is functional and therefore cannot constitute trademark infringement. "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature."³³ A product feature that is deemed functional is not protected by trademark law even if its use might give rise to confusion as to the source of the product. The Eleventh Circuit has recognized two tests for determining functionality. The "traditional test" asks whether a product feature "is essential to the use or purpose of the article or if it affects the cost or quality of the article."³⁴ The "competitive necessity test," which applies in cases of aesthetic functionality, asks whether "a functional feature is one the 'exclusive use

³³ *Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, 369 F.3d 1197, 1202 (11th Cir. 2004) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995)); see also 1 McCarthy on Trademarks and Unfair Competition § 7:63 (5th ed.) ("The requirement of nonfunctionality in trademark and trade dress law is concerned with whether the particular shape or feature claimed to be a trademark or trade dress contributes to a utilitarian purpose. If it makes the product more useful for its purpose or contributes to economy of manufacture or use, then the feature is 'functional' and is not capable of trademark protection.").

³⁴ *Dippin' Dots, Inc.*, 369 F.3d at 1203 (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001)).

of [which] would put competitors at a significant non-reputation-related disadvantage.’”³⁵

Although not specifically couched as such, it is clear that the Defendant is proceeding on a theory of what one commentator describes as “defensive” aesthetic functionality.³⁶ The Defendant argues that, unlike the Plaintiff, it uses the Plaintiff’s marks not as indicators of the product’s source but rather as aesthetic features that serve to increase the desirability of the apparel for consumers who want to signal their affiliation with the Plaintiff. This use of the Plaintiff’s marks, the Defendant argues, is functional and therefore not actionable under trademark law. The Defendant cites in support the post-split Fifth Circuit case *Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co.*³⁷ In *Supreme Assembly*, the Fifth Circuit affirmed a lower court decision holding that the defendant jewelry maker’s use of the plaintiff fraternal organization’s collective mark on jewelry served the functional purpose of showing affiliation with the organization.³⁸ The Defendant also cites the Ninth

³⁵ *Id.* (quoting *TrafFix Devices, Inc.*, 532 U.S. at 32).

³⁶ See 1 McCarthy on Trademarks and Unfair Competition § 7:82 (5th ed.) (“A handful of cases take the position that the unauthorized use of what is unquestionably someone else’s valid and nonfunctional trademark is not an infringement because the *defendant* is making an aesthetically functional use of the mark. These cases take the aesthetic functionality theory of a challenge to the validity of a mark and turn it on its head into a defense to a valid mark.”).

³⁷ 676 F.2d 1079 (5th Cir. 1982).

³⁸ *Id.*, at 1083 n.5.

Circuit case *International Order of Job's Daughters v. Lindeburg & Co.*³⁹ In *Job's Daughters*, the Ninth Circuit held that the use of a fraternal organization's marks on jewelry was functional because consumers purchase such products to express allegiance to the organization and it "would be naïve to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies."⁴⁰

The Defendant's reliance on these cases is misplaced. In *Supreme Assembly*, the Fifth Circuit did not reach the question of whether the lower court's findings on functionality were correct, instead affirming based on the district court's finding of no likelihood of confusion.⁴¹ As for *Job's Daughters*, the broad interpretation of aesthetic functionality espoused in that case has since been substantially narrowed by the Ninth Circuit,⁴² and its underlying assumptions regarding consumer behavior have been rejected by the Eleventh Circuit.⁴³ Neither case involved application of the modern test for "comparative necessity" employed by the Eleventh Circuit. The Defendant does not even cite the Eleventh Circuit test,

³⁹ 633 F.2d 912 (9th Cir. 1980).

⁴⁰ *Id.*, at 918.

⁴¹ 676 F.2d at 1083 n.5.

⁴² *Au-Tomotive Gold, Inc. v. Volkswagen of Am.*, 457 F.3d 1062, 1070 (9th Cir. 2006).

⁴³ *Univ. of Georgia Athletic Ass'n v. Laite*, F.2d 1535, 1547 (11th Cir. 1985).

much less explain how being denied the use of the Plaintiff's marks would put it at a "non-reputation-related disadvantage." Indeed, the inability to use the trade name of another on one's own product would appear to be precisely the kind of "reputation-related disadvantage" sanctioned by trademark law. The mere fact that the use of the Plaintiff's mark adds value to the Defendant's product does not support a finding that the use is functional. The Defendant's motion for summary judgment on the defense of functionality should be denied.

C. Non-Use of Shield Design Mark

The Defendant argues that there is no evidence that it has used any portion of the Plaintiff's shield design mark on apparel.⁴⁴ The Plaintiff concedes that the Defendant "has apparently not offered for sale or sold any goods with that exact shield design."⁴⁵ The Plaintiff instead contends that the Defendant has sold goods bearing the words "Savannah College of Art and Design," which appear in a circular border of the design mark.⁴⁶ But the infringement alleged is already covered by the Plaintiff's word mark for this exact phrase. The Plaintiff cannot show that the Defendant has ever used the shield image or used the phrase "Savannah College of Art and Design" arranged as it appears on the shield design mark. Therefore, the Defendant's motion for summary judgment as to the Plaintiff's claims for infringement of the shield design mark is granted.

⁴⁴ Def.'s Br. in Supp. of Mot. for Summ. J., at 22-23.

⁴⁵ Pl.'s Resp. to Def.'s Br. in Supp. of Mot. for Summ. J., at 15.

⁴⁶ *Id.*

D. Renewed Motion to Exclude

The Defendant asks the Court to revisit its decision granting in part and denying as moot in part the Defendant's motion to exclude evidence from the record on summary judgment. After the parties' final round of summary judgment briefing, the Defendant moved to exclude three pieces of evidence attached to the Plaintiff's reply brief: (1) a website purporting to show prior use of the Plaintiff's marks on apparel; (2) a paragraph from the declaration of Hannah Flower, the Plaintiff's Associate Vice President for Academic Support and Legal Affairs and a deponent in this case, detailing expenditures related to the marketing of the Plaintiff's services and programs; and (3) a different paragraph from the same declaration detailing the avenues through which the Plaintiff markets its services. The Court granted the Defendant's motion to exclude the website. The Court denied the remainder of the motion to exclude as moot because, in the Court's view, evidence of the Plaintiff's advertising expenditures and methods was not relevant to the question of whether the Plaintiff possessed enforceable rights in a mark related to the sale of apparel goods.

The Court's ruling on the admissibility of the website was not disturbed by the Eleventh Circuit on appeal and the Court sees no reason to revisit it. The Court must, however, revisit its ruling regarding the evidence contained in the declaration attached to the Plaintiff's reply brief. Evidence of the Plaintiff's general advertising expenditures and methods is potentially relevant to the question of likelihood of confusion, which the Court did not reach in its prior summary judgment Order. The Court concludes that

the declaration must also be excluded. The declaration, in effect, provides new testimony from one of the Plaintiff's deponents after the close of discovery and after the Defendant's response brief had already been filed. The Court finds no support for this procedural maneuver in the federal rules or case law. Accordingly, the renewed motion to exclude is granted in full and the Court will not consider the declaration on summary judgment.

E. Likelihood of Confusion

“In a trademark infringement action, the plaintiff must show, first, that its mark is valid and, second, that the defendant's use of the contested mark is likely to cause confusion.”⁴⁷ The Court must now proceed to the second prong of the test for trademark infringement: whether the Defendant's use of the Plaintiff's marks is likely to cause confusion.⁴⁸ The Plaintiff argues that the

⁴⁷ *Dieter*, 880 F.2d at 326.

⁴⁸ While the Eleventh Circuit applied *Boston Hockey* to the question of whether the Plaintiff's marks were valid and enforceable, the Eleventh Circuit specifically disclaimed what one commentator described as the “heresies” of *Boston Hockey* with regards to likelihood of confusion. *Savannah Coll. of Art & Design, Inc.*, 872 F.3d at 1264 (citing 4 McCarthy on Trademarks § 24:10). *Boston Hockey* appears to suggest that infringement lies when customers “recognize[] the product as bearing a mark of the plaintiff[s],” regardless of whether the customers are thereby confused as to the affiliation or sponsorship of the product. 4 McCarthy on Trademarks § 24:10. As the Eleventh Circuit explained, that is not the law. The Plaintiff must show likelihood of confusion in order to prevail. Therefore, the Court proceeds with the understanding that *Boston Hockey* is of little relevance to the task at hand.

likelihood of confusion factors weigh so heavily in its favor that this Court should find infringement as a matter of law.

In determining whether there is sufficient evidence in the record to support a finding of likelihood of confusion, the Court must assess the following seven factors: (1) the strength or distinctiveness of the allegedly infringed mark; (2) the similarity between the infringed and infringing marks; (3) the similarity of the goods or services offered under the infringed and infringing marks; (4) the similarity of actual sales methods; (5) the similarity of advertising methods; (6) the intent of the alleged infringer to misappropriate the proprietor's good will; and (7) the existence of actual confusion in the consuming public.⁴⁹ The Court must consider each of the seven factors,⁵⁰ but the factors need not be accorded equal weight depending on the facts of the case.⁵¹ Typically, the most important factors are the strength of the mark and the existence of actual confusion.⁵²

Before proceeding, however, the Court will address the Defendant's argument that the Plaintiff's services and the Defendant's goods are unrelated, such that confusion is "highly unlikely."⁵³ According to the

⁴⁹ See *Tana*, 611 F.3d at 775; *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1360 (11th Cir. 2007).

⁵⁰ *Welding Servs., Inc.*, 509 F.3d at 1361.

⁵¹ *Laite*, 756 F.2d at 1542.

⁵² *Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 830 F.3d 1242, 1255 (11th Cir. 2016).

⁵³ Def.'s Resp. to Pl.'s Letter Br. in Supp. of Summ. J., at 1.

Defendant, the parties, this Court, and the Eleventh Circuit all agree that the Plaintiff's educational services are not "related" to the Defendant's apparel goods.⁵⁴ The Defendant mischaracterizes the Plaintiff's position and the prior rulings in this case. The Plaintiff has stipulated that it has no evidence that it used its marks "in connection with the sale of apparel or related *goods*" prior to the Defendant's first use.⁵⁵ The Plaintiff has not stipulated, nor has any court ruled, that the Plaintiff's *educational services* are unrelated to the Defendant's apparel goods. The relatedness of the Plaintiff's services and the Defendant's goods remains a live question, and indeed the central question, in this case. Goods or services can be related even if they are not in competition with one another.⁵⁶ In the context of trademark law, goods or services are "related" when consumers mistakenly believe that they originate from, or are somehow affiliated with, a single source.⁵⁷ This

⁵⁴ Def.'s Letter Br. in Supp. of Summ. J., at 2 [Doc. 82].

⁵⁵ Pl.'s Resp. to Def.'s Statement of Material Facts ¶ 24 [Doc. 46-1] (emphasis added).

⁵⁶ *Babbit Elecs., Inc. v. Dynascan Corp.*, 38 F.3d 1161, 1179 (11th Cir. 1994) ("[C]onfusion, or the likelihood of confusion, not competition, is the real test of trademark infringement.") (quoting *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58 (2d Cir. 1987)); *Cont'l Motors Corp. v. Cont'l Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) ("Often and recently we have made plain that direct competition between the products is not a prerequisite to protective relief.").

⁵⁷ *E. Remy Martin & Co., S.A. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1530 (11th Cir. 1985) ("Moreover, the rights of the owner of a registered trademark are not limited to protection with respect to the specific goods stated on the certificate ... but extend

determination is made after conducting the likelihood of confusion analysis, not before.⁵⁸ To presume that the goods and services at issue are unrelated prior to engaging in likelihood of confusion analysis is to beg the question.

Although not clearly articulated in the Defendant's briefing, the Defendant's focus on the "unrelatedness" of the parties' products could be construed as an objection to traditional likelihood of confusion analysis in a case that, as the Defendant puts it, "cross[es] the goods/services line." The Lanham Act distinguishes trademarks, which are registered in connection with goods, from service marks, which are registered in connection with services.⁵⁹ But, "while the distinction between a trademark and a service mark may be relevant for registration purposes, it is not particularly

to any goods related in the minds of consumers in the sense that a single producer is likely to put out both goods."); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) ("Thus, even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

⁵⁸ See *Tally-Ho, Inc. v. Coast Cmty. Coll. Dist.*, 889 F.2d 1018, 1027 (11th Cir. 1989) (" 'Related use' is merely a facet of the likelihood of confusion test and therefore requires an inquiry into seven factors affecting the likelihood of confusion among consumers[.]"); 4 McCarthy on Trademarks and Unfair Competition § 24:24 (Relatedness "is a conclusion to be made after a full analysis of the facts shows that there is a likelihood of confusion as to source, affiliation, sponsorship or connection because of the similarity of the marks and other facts in the case.").

⁵⁹ 15 U.S.C. § 1127.

relevant for the purposes of the likelihood of confusion analysis.”⁶⁰ In conducting its likelihood of confusion analysis, the Court asks whether the Defendant’s use of the allegedly infringing marks on its products causes consumer confusion as to origin, source, approval, affiliation, association, or sponsorship.⁶¹ The analysis remains the same regardless of whether the plaintiff seeks to enforce its rights in a trademark or a service mark.⁶² Examples abound of courts holding that a likelihood of confusion exists across the goods/services divide.⁶³ The seven-factor test for likelihood of

⁶⁰ *Frehling Enterprises, Inc. v. Int’l Select Grp., Inc.*, 192 F.3d 1330, 1334 n.1 (11th Cir. 1999).

⁶¹ *Burger King Corp. v. Mason*, 710 F.2d 1480, 1491-92 (11th Cir. 1983).

⁶² *Frehling Enterprises, Inc.*, 192 F.3d at 1334 n.1; *see also Bos. Athletic Ass’n v. Sullivan*, 867 F.2d 22, 24 n.1 (1st Cir. 1989) (“A trademark is used to distinguish one’s goods from those made by others, while a service mark is used to distinguish one’s services from those offered by others. In either case the marks are used to indicate the distinctive source of the goods or services, even if that source is unknown.”).

⁶³ *See In Re Comexa Ltda.*, 60 U.S.P.Q.2d 1118 (T.T.A.B. 2001) (affirming Examining Attorney’s refusal to register a trademark for chili and pepper sauce on the grounds that it was confusingly similar to a service mark registered in connection with restaurant services); *Beef/Eater Restaurants, Inc. v. James Burrough Ltd.*, 398 F.2d 637, 639 (5th Cir. 1968) (holding that the defendant’s use of the word “Beefeater” in connection with its restaurant services infringed on the plaintiff’s “Beefeater” trade name registered in connection with the sale of gin); *Bos. Athletic Ass’n v. Sullivan*, 867 F.2d 22, 34-35 (1st Cir. 1989) (holding that the defendant’s use of logos referring to the Boston marathon to sell shirts infringed on the plaintiff’s service marks used in connection with marathon-

confusion equips the Court to appropriately weigh the distinctions between goods and services to the extent that they are relevant in a particular case. It is to this test that the Court now turns.

1. Strength of the Mark

The Eleventh Circuit has established four categories of distinctiveness for trade and service marks. The more distinctive the mark, the more protection it receives under trademark law. In order of least to most distinctive, the categories are: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary.⁶⁴ Generic marks “refer to a class of which an individual service is a member[.]”⁶⁵ They are not entitled to protection. Descriptive marks “describe a characteristic or quality of an article or service[.]”⁶⁶ They warrant protection only if the mark owner can prove that the mark has acquired secondary meaning.⁶⁷

related services); *John Walker & Sons, Ltd. v. Bethea*, 305 F. Supp. 1302, 1304 (D.S.C. 1969) (holding that the defendant’s use of the words “Johnny Walker” in connection with motel services infringed on the plaintiff’s trademark for the words “JOHNNIE WALKER” in connection with the sale of liquor); *see also Murphy v. Provident Mut. Life Ins. Co. of Philadelphia*, 923 F.2d 923, 927 (2d Cir. 1990) (holding that it was irrelevant whether the plaintiff was claiming ownership of a trademark or a service mark because “[w]hether a mark is one or the other, the standards for determining infringement are essentially the same”).

⁶⁴ *Welding Servs., Inc.*, 509 F.3d at 1357-58; *see also Frehling Enterprises, Inc.*, 192 F.3d at 1335.

⁶⁵ *Frehling Enterprises, Inc.*, 192 F.3d at 1335.

⁶⁶ *Id.*

⁶⁷ *Welding Servs., Inc.*, 509 F.3d at 1358.

A descriptive name can acquire secondary meaning by “becoming associated with the proprietor’s product or service. A name has acquired secondary meaning when ‘the primary significance of the term in the minds of the consuming public is not the product but the producer.’”⁶⁸ Suggestive marks evoke certain characteristics of the goods or services and “require an effort of the imagination” by the consumer in order to be understood as descriptive, whereas arbitrary or fanciful marks bear no direct relationship to the goods or services bearing the mark.⁶⁹ Suggestive marks and arbitrary or fanciful marks are presumed strong without any showing of secondary meaning.⁷⁰

The Plaintiff does not dispute that its text marks are descriptive, but primarily relies on the presumption of strength accorded to descriptive marks that have achieved incontestable status. In *Dieter v. B & H Industries of Southwest Florida, Inc.*, the Eleventh Circuit held that a mark’s “incontestable status is a factor to be taken into consideration in likelihood of confusion analysis.”⁷¹ An incontestable mark “is presumed to be at least descriptive with secondary meaning, and

⁶⁸ *Welding Servs., Inc.*, 509 F.3d at 1358 (quoting *Vision Ctr. V. Opticks, Inc.*, 596 F.2d 111, 118 (5th Cir. 1979)).

⁶⁹ *Id.*

⁷⁰ *Trilink Saw Chain, LLC v. Blount, Inc.*, 583 F. Supp. 2d 1293, 1311 (D. Ga. 2008) (citing *Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association*, 651 F.2d 311, 315 (5th Cir. 1981)).

⁷¹ *Dieter*, 880 F.2d at 329.

therefore a relatively strong mark.”⁷² But, while incontestability creates a presumption of strength, that presumption is not conclusive.⁷³ Therefore, the Court will begin with the presumption that the Plaintiff’s marks are strong, but will consider whether other factors identified by the Defendant undermine or negate the presumption.⁷⁴

The Defendant insists that, while the Plaintiff’s marks may be strong as applied to educational services, they are weak as applied to apparel. If by this the Defendant means that the marks’ strength cannot extend beyond the goods or services for which they are registered, then the Defendant is eliding the distinction between the validity prong and the likelihood of confusion prong of the test for infringement. The statutory language and case law cited by the Defendant stand for the proposition that, when a mark’s *validity* is challenged, its incontestable status is conclusive evidence only of its validity in relation to the goods and

⁷² *Id.*

⁷³ *HBP, Inc. v. Am. Marine Holdings, Inc.*, 290 F. Supp. 2d 1320, 1329 (M.D. Fla. 2003) (“Incontestable status-somewhat of a misnomer-does not mean that a mark’s strength cannot be attacked[.] When determining the mark’s strength for the likelihood of confusion analysis, incontestability is ‘simply one piece of the overall determination of a mark’s strength.’”) (quoting *First Keystone Federal Sav. Bank v. First Keystone Mortg., Inc.*, 896 F.Supp. 456, 461 (E.D. Pa. 1995)), *aff’d sub nom. HBP, Inc. v. Am. Marine Holdings*, 129 F. App’x 601 (11th Cir. 2005).

⁷⁴ *See Trilink Saw Chain, LLC*, 583 F. Supp. 2d at 1312.

services listed on the registration.⁷⁵ But, “although 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.”⁷⁶ As the Eleventh Circuit has long recognized, “the rights of the owner of a registered trademark are not limited to protection with respect to the specific goods stated on the certificate ... but extend to any goods related in the minds of consumers in the sense that a single producer is likely to put out both goods.”⁷⁷ The stronger the mark, the greater the scope of protection it receives.⁷⁸

That is not to say that a mark’s strength transfers undiminished into every market in which the mark owner seeks to enforce it. Evidence of third party use of the marks in connection with different goods or services “limit[s] the protection to be accorded plaintiff’s mark outside the uses to which plaintiff has already put its mark.”⁷⁹ In *Amstar*, the pre-split Fifth Circuit recognized that the plaintiff’s “Domino” mark was strong when it appeared on packaging for sugar. But evidence of extensive third party use of the term to, for example, sell cigarettes and donut mix made it

⁷⁵ Cf. *Gameologist Grp., LLC v. Sci. Games Int’l, Inc.*, 838 F. Supp. 2d 141, 153 (S.D.N.Y. 2011) (interpreting 15 U.S.C. § 1115), *aff’d*, 508 F. App’x 31 (2d Cir. 2013).

⁷⁶ *Applied Info Scis. Corp. v. eBay, Inc.*, 511 F.3d 966, 971 (9th Cir. 2007).

⁷⁷ *E. Remy Martin & Co.*, 756 F.2d at 1530.

⁷⁸ *Welding Servs., Inc.*, 509 F.3d at 1361.

⁷⁹ 615 F.2s at 260.

less likely that the consuming public would associate the word “Domino” with the plaintiff when they encountered it on other products. In this case, the Defendant has presented evidence that four other online apparel retailers use the Plaintiff’s marks on apparel goods without a license. The proffered evidence of third party use falls short of constituting the kind of “extensive third-party use” that typically justifies limiting the protection extended to an otherwise strong mark, and does little to diminish the presumptive strength of the Plaintiff’s marks.⁸⁰ The Court concludes that this factor weighs strongly in the Plaintiff’s favor.

2. Similarity between the infringed and infringing marks

“In evaluating the similarity of marks, [the court] must consider the overall impression created by the marks, including a comparison of the appearance, sound and meaning of the marks, as well as the manner in

⁸⁰ The extent of use of a mark, which measures the duration of the mark’s use and the amount of advertising conducted under the mark, is another factor that the Court may consider in determining the mark’s strength. *See Trilink Saw Chain, LLC*, 583 F. Supp. 2d at 1313. Although the Plaintiff repeatedly emphasizes its worldwide renown in the educational sphere, the substantive evidence regarding the extent of use of its marks has not been well-presented to the Court on summary judgment. The Plaintiff has attempted to introduce evidence of its advertising efforts that, in the Court’s view, is not properly before the Court. The Court emphasizes, however, that even if this evidence were properly before the Court, it would not alter the Court’s ultimate conclusion on the likelihood of confusion question.

which they are displayed.”⁸¹ Evidence in the record indicates that the Defendant has branded its apparel goods with words that are identical to the Plaintiff’s text marks “Savannah College of Art and Design” and “SCAD.”⁸² While the Plaintiff concedes that the Defendant has not used the bee design logo in its entirety, it has submitted uncontroverted evidence that the Defendant has used the bee portion of the logo in conjunction with the Plaintiff’s text marks.⁸³ This factor weighs in the Plaintiff’s favor.⁸⁴

3. Similarity of the goods or services

The parties agree that the Plaintiff’s educational services and the Defendant’s apparel goods are not the same.⁸⁵ The Defendant views this fact as dispositive because, according to the Defendant, it demonstrates that the “goods and services are neither competitive nor related.”⁸⁶ As the Court has already explained and

⁸¹ *E. Remy Martin & Co., S.A.*, 756 F.2d at 1531.

⁸² Def.’s Statement of Material Facts ¶¶ 53-54.

⁸³ See Pl.’s Statement of Material Facts ¶ 27 [Doc. 40-2]; Def.’s Resp. to Pl.’s Statement of Material Facts ¶ 27 [Doc. 47-3].

⁸⁴ Confusingly, the Defendant argues that the marks are not similar because the Defendant did not use the Plaintiff’s marks as trademarks. Def.’s Resp. to Pl.’s Mot. for Summ. J., at 11-12. The Court has already discussed this argument in the context of the Defendant’s functionality defense, *supra*. How the Defendant intended to use the marks is not relevant to the question of whether the marks would appear similar to the consuming public.

⁸⁵ Pl.’s Br. in Supp. of Mot. for Summ. J., at 19 [Doc. 40-1].

⁸⁶ Def.’s Resp. to Pl.’s Mot. for Summ. J., at 13 [Doc. 47].

as the precedent cited by the Defendant holds, relatedness is determined only after consideration of all of the likelihood of confusion factors.⁸⁷ Goods and services can be related even if they are not similar in kind. Moreover, it is not necessary to establish that the goods or services are competitive in order to prevail in an infringement action. The Court will not engage in protracted analysis of this factor. While it does not weigh in the Plaintiff's favor, the Court views the other factors to be of greater significance.

4. Similarity of actual sales methods

“The fourth factor takes into consideration where, how, and to whom the parties' products are sold.”⁸⁸ Put differently, this factor asks whether the parties' customer bases overlap.⁸⁹ The Plaintiff asserts that the parties' “customers and methods of reaching them entirely overlap—people interested in apparel bearing [the Plaintiff's] marks.”⁹⁰ The Defendant does not appear to contest this claim, instead focusing on two

⁸⁷ The Defendant cites *Tally-Ho* for the proposition that “[r]elated goods are those that a consumer is likely to believe come from the same source and are somehow connected with a common company.” 889 F.2d at 1027. But the very next sentence of the opinion establishes that “ ‘[r]elated use’ is merely a facet of the likelihood of confusion test and therefore requires an inquiry into seven factors affecting the likelihood of confusion among consumers[.]” *Id.*

⁸⁸ *Fla. Int'l Univ. Bd. of Trustees*, 830 F.3d at 1261.

⁸⁹ *See Trilink Saw Chain, LLC*, 583 F. Supp. 2d at 1316.

⁹⁰ Pl.'s Br. in Supp. of Mot. for Summ. J., at 20.

arguments regarding its sales methods that it views as “fatal” to the Plaintiff’s claim.

First, the Defendant notes that customers visiting its site choose the color, text, and physical article of clothing that are ultimately combined into the product shipped to the customer. The Defendant argues that customers cannot be confused because “[t]here is simply no way a customer would believe a shirt’s ‘origin’ somehow changes” when the customer cycles through different color and text options.⁹¹ The Defendant’s argument appears to be premised on the mistaken belief that the only confusion actionable under trademark law is confusion as to the physical origin of the goods or services at issue. That is not the case—consumers can instead be confused as to whether the Plaintiff endorsed, sponsored, licensed, or otherwise approved of the use of its marks on apparel.⁹² Whether the product exists prior to the consumer’s order or is manufactured after the fact is not particularly relevant to the likelihood of confusion analysis.

Second, the Defendant argues that no confusion can arise because the Defendant posts disclaimers on its website stating that “[t]his store is not sponsored or endorsed by Savannah College of Art and Design.”⁹³ The Defendant contends that these disclaimers are prominently displayed and therefore confusion on the part of consumers is near-impossible. In response, the Plaintiff cites *Boston Hockey*. In *Boston Hockey*, the

⁹¹ Def.’s Resp. in Opp. to Pl.’s Mot. for Summ. J., at 14 [Doc. 47].

⁹² *Burger King Corp.*, 710 F.2d at 1491-92.

⁹³ Def.’s Resp. in Opp. to Pl.’s Mot. for Summ. J., at 14.

lower court found that the sale of replica patches bearing the plaintiff hockey teams' marks was likely to cause confusion, but determined that the defendant could continue to sell the patches if the defendant attached a disclaimer indicating that the replicas were unauthorized.⁹⁴ The *Boston Hockey* panel rejected this approach on appeal, holding that “[o]nly a prohibition of the unauthorized use will sufficiently remedy the wrong” caused by “[t]he exact duplication of the symbol.”⁹⁵ While this section of the *Boston Hockey* opinion lends powerful support to the Plaintiff’s position, the Court concludes that it is no longer good law. The panel’s decision regarding the proposed disclaimers flowed from its conclusion that “exact duplication” necessarily results in confusion because the public will “identify” the marks as belonging to the mark owner. Because consumers would continue to identify the replica patches with the hockey teams regardless of whether a disclaimer was attached, it followed that such disclaimers could not remedy the harm. But, as the Eleventh Circuit explained on appeal in this case, the *Boston Hockey* panel’s approach to the likelihood of confusion analysis was incorrect. The Plaintiff cannot prevail merely by showing that consumers are aware that the Defendant’s apparel bears marks belonging to the Plaintiff. The Plaintiff must also show that the consumers are thereby likely to be confused as to whether the use is authorized, which is not a showing that the *Boston Hockey* panel required the plaintiff hockey teams to make. The

⁹⁴ *Bos. Prof'l Hockey Ass'n, Inc.*, 510 F.2 at 1013.

⁹⁵ *Id.*

presence of disclaimers on the Defendant's website is therefore relevant to the likelihood of confusion inquiry. This factor weighs weakly in favor of the Defendant.

5. Similarity of advertising media

There is little in the record with which the Court can assess the similarity of the parties' advertising methods. It appears that both parties advertise their respective goods and services online. But, as the Defendant points out, "[t]hat the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services."⁹⁶ The Court concludes that this factor is neutral.

6. Defendant's intent

"If it can be shown that a defendant adopted a plaintiff's mark with the intention of deriving a benefit from the plaintiff's business reputation, this fact alone may be enough to justify the inference that there is confusing similarity."⁹⁷ There is no question in this case that the Defendant intended to copy the Plaintiff's text marks. The Defendant insists that "intent to copy" is not the same as "intent to confuse."⁹⁸ But in the Eleventh Circuit, evidence of a Defendant's intent to

⁹⁶ 4 McCarthy on Trademarks and Unfair Competition § 24:53.50 (5th ed.).

⁹⁷ *Frehling Enterprises, Inc.*, 192 F.3d at 1340 (citing *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 977 (11th Cir. 1983)).

⁹⁸ Def.'s Resp. to Pl.'s Mot. for Summ. J., at 16-17.

copy is relevant to the question of whether the Defendant intended to confuse the consuming public. Indeed, the Eleventh Circuit has held that an “[i]ntent to copy in itself creates a rebuttable presumption of likelihood of confusion.”⁹⁹ The Plaintiff has not argued for the application of the presumption in this case, but the Court nevertheless concludes that this factor favors the Plaintiff.

7. Actual confusion

The Plaintiff admits that it does not have evidence showing that consumers have bought apparel from the Defendant under the mistaken belief that the apparel was licensed by the Plaintiff. The only evidence of actual confusion offered by the Plaintiff is an incident in which the parent of a student-athlete forwarded a link to the Defendant’s website to the Plaintiff’s employees and the employees were unsure whether the Defendant’s use was authorized.¹⁰⁰ This evidence is wholly insufficient to support a finding of actual confusion. “Although evidence of actual confusion is not necessary to a finding of likelihood of confusion, it is nevertheless the best evidence of likelihood of confusion.”¹⁰¹ This factor weighs in favor of the Defendant.

After careful consideration of the seven likelihood of confusion factors, the Court concludes that the strength of the mark, the similarity of the marks, and the

⁹⁹ *Babbit Elecs., Inc.*, 38 F.3d at 1179 (quoting *Bauer Lamp Co., Inc. v. Shaffer*, 941 F.2d 1165, 1172 (11th Cir. 1991)).

¹⁰⁰ Pl.’s Br. in Supp. of Mot. for Summ. J., at 23.

¹⁰¹ *Amstar Corp.*, 615 F.2d at 263.

Defendant's intent all weigh heavily in favor of the Plaintiff on the likelihood of confusion. These factors greatly outweigh the lack of any evidence of actual confusion and questions surrounding the efficacy of the Defendant's disclaimers. The Plaintiff's motion for summary judgment should be granted.

IV. Conclusion

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

SO ORDERED, this 1 day of March, 2019.

80a

Appendix D

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 connection with the sale of apparel or related goods.¹⁰

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.

¹⁰ *Id.* ¶ 24.

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 to the nonmovant.¹⁶ The party seeking

¹¹ *Id.* ¶¶ 27-30.

¹² *Id.* ¶ 44.

¹³ *Id.* ¶ 45.

¹⁴ *Id.* ¶¶ 53-54.

¹⁵ Fed. R. CIV. P. 56(a)

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

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 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

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)

²¹ *Id.*

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 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

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.

²⁷ Flowers Dep. At 16.

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 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

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).

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).

87a

Appendix E

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

THE SAVANNAH COLLEGE
OF ART AND DESIGN, INC.,

Plaintiff,

v.

SPORTSWEAR, INC. d/b/a
PrepSportswear,

Defendant.

Case No.

1:14-cv-02288-TWT

JUDGMENT AND PERMANENT INJUNCTION

This action having come before the Court, Honorable Thomas W. Thrash, United States Chief District Judge, on remand from the Eleventh Circuit Court of Appeals for the limited purpose of the Court clarifying its March 6, 2019 Judgment (ECF No. 87) in which the GRANTED IN PART AND DENIED IN PART the Defendant's Motion for Summary Judgment, GRANTED the Defendant's Motion to Strike Improper Evidence, and GRANTED the Plaintiff's Motion for Summary Judgment, it is hereby ORDERED AND ADJUDGED that:

1. The Court's March 6, 2019 Judgment (ECF No. 87) in this action is vacated in favor of this Judgment and Permanent Injunction, which shall be effective as of March 6, 2019. The Court's Opinion and Order dated March 1, 2019 (ECF No. 86) remains in effect.
2. Plaintiff has been granted summary judgment on its First, Second, and Fourth claims as to infringement of three of the asserted SCAD marks (as reflected in Registration No. 3,751,493 for a circular bee design, Registration No. 2,686,644 for the text mark "SCAD," and Registration No. 2,918,888 for the text mark "Savannah College of Art and Design") (collectively, the "SCAD Marks").
3. Plaintiff has suffered harm as a result of Defendant's conduct and will continue to suffer harm if the Defendant's conduct is not enjoined. On review and consideration of all relevant factors, the Court finds that Plaintiff is entitled to permanent injunctive relief on its First, Second, and Fourth claims for relief. Final judgment is hereby entered against Defendant and in favor of Plaintiff.
4. Defendant, its Owner(s) (defined below), and any successors or assigns of all or substantially all of Defendant's assets shall be and hereby are PERMANENTLY ENJOINED from making, marketing, offering for sale, reproducing, distributing, selling, and otherwise exploiting any products bearing the three SCAD Marks found previously to be infringed, or otherwise using, printing, or displaying these SCAD Marks, or directing any other company or natural person to act on their behalf in a manner contrary to this injunction. For purposes of this permanent injunction, the term "Owner" is a company

or natural person who owns at least fifty percent (50%) or more of the voting shares of Defendant.

5. The permanent injunction described in Paragraph 4 extends to words and/or designs that create a likelihood of confusion with the three SCAD Marks.

6. Defendant shall permanently disable and delete any existing database entries that result in depictions of products bearing the SCAD Marks, or words and/or designs that would create a likelihood of confusion with the three SCAD Marks, from its database of webpages and from its website, www.prepsportswear.com, and any other websites owned by Defendant or its Owner(s) (collectively, the "Websites").

7. In the event any listings or webpages with depictions of products bearing the SCAD Marks, or words and/or designs that would create a likelihood of confusion with the SCAD Marks, are inadvertently enabled on any of the Defendant's Websites through some process beyond Defendant's reasonable control despite Defendant's compliance with Paragraph 6, Defendant shall disable and delete such listings and webpages as soon as practicable, but in any event within five (5) days, after Defendant becomes aware of such listings and webpages. Defendant shall not fulfill any orders for any products depicted after it has become aware of such listings and webpages. Defendant shall be deemed to be "aware" of such listings and webpages if it receives written notice from Plaintiff or if one of such listings and webpages otherwise comes to the attention of one of Defendant's officers, directors, or high-level employees.

90a

8. Defendant's sale or shipment of any products bearing the SCAD Marks, or any words and/or designs that create a likelihood of confusion with the SCAD Marks, within the continental United States without Plaintiff's prior written consent is and shall be deemed a presumptive violation of this permanent injunction.

9. The parties shall bear their own attorneys' fees and costs related to this action.

SO ORDERED this 7th day of December, 2020.

/s/ Thomas W. Thrash, Jr.
THOMAS W. THRASH, JR.
UNITED STATES DISTRICT JUDGE

91a

Appendix F

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

February 17, 2021

No. 19-11258-JJ

SAVANNAH COLLEGE OF ART
AND DESIGN, INC.,

Plaintiff – Appellee,

versus

SPORTSWEAR, INC.
d.b.a. PrepSportswear,

Defendant – Appellant.

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

**ON PETITION(S) FOR REHEARING AND
PETITION(S) FOR REHEARING EN BANC**

92a

BEFORE: WILLIAM PRYOR, Chief Judge,
ROSENBAUM, Circuit Judge, and MOORE*, District
Judge.

PER CURIAM:

The Petition for Rehearing En Banc is DENIED, no
judge in regular active service on the Court having
requested that the Court be polled on rehearing en
banc. (FRAP 35) The Petition for Panel Rehearing is
also denied. (FRAP 40)

ORD-46

* Honorable K. Michael Moore, Chief United States District Judge
for the Southern District of Florida, sitting by designation.

94a

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.

95a

ENTERED FOR THE COURT:

/ss/

UNITED STATES CIRCUIT JUDGE

Appendix H

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(a) of the Lanham Act, 15 U.S.C. § 1114(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

97a

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

98a

(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.