

No. 20-1391

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

BRIEF IN OPPOSITION

W. ANDREW PEQUIGNOT
LISA FORTUNE MOORE
MOORE PEQUIGNOT LLC
887 W. Marietta St., NW
Suite M-102
Atlanta, GA 30318
(404) 748-9596
andrew@themoorefirm.com

GREGORY G. GARRE
Counsel of Record
ROMAN MARTINEZ
TYCE R. WALTERS
LATHAM & WATKINS LLP
555 Eleventh Street, NW
Suite 1000
Washington, DC 20004
(202) 637-2207
gregory.garre@lw.com

Counsel for Respondent

QUESTION PRESENTED

Whether the Eleventh Circuit's fact-bound conclusion that Petitioner Sportswear, Inc. (Sportswear)'s unauthorized use of respondent Savannah College of Art and Design (SCAD)'s name and logo on apparel sold by Sportswear violated SCAD's rights under the Lanham Act and Georgia law warrants this Court's review.

RULE 29.6 STATEMENT

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

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INTRODUCTION

This case involves petitioner Sportswear, Inc.’s blatant appropriation of the name, mascot, and other registered marks owned by Savannah College of Art and Design (SCAD), a world-renowned university for creative professionals. Sportswear sought to profit from SCAD’s hard-earned brand by putting SCAD’s marks on athletic apparel Sportswear sold on the internet. Both lower courts here have repeatedly rejected Sportswear’s defense of its knock-offs, and this Court has already denied certiorari in this case once. This petition should meet the same fate.

In the first round of litigation (*SCAD I*), the Eleventh Circuit held that Sportswear’s co-opting of SCAD’s marks could give rise to claims of trademark infringement and unfair competition under the Lanham Act if SCAD showed a likelihood of consumer confusion. Sportswear sought certiorari from that ruling, and this Court denied review. 139 S. Ct. 57 (2018). On remand, both the district court and Eleventh Circuit found that Sportswear’s use of SCAD’s marks on its apparel was likely to confuse consumers—and thus was related to SCAD’s own use—based on fact-bound application of the settled likelihood-of-confusion test. Sportswear now seeks certiorari again, but the case is if anything less certworthy today than it was three years ago.

For starters, Sportswear’s first question presented—the same question it presented in 2018—is (still) based on a false premise: that *SCAD I* extended the protection of SCAD’s service marks to “unrelated goods.” Pet. i. As the Eleventh Circuit made clear, however, a Lanham Act claim can lie only against uses of a mark on “goods related in the minds

of consumers,” Pet. App. 47a (citation omitted)—and whether a good is “related,” in turn, depends upon whether there is a likelihood of confusion, *see id.* at 41a-42a; 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:24 (5th ed. 2021, Westlaw). Because the Eleventh Circuit expressly required that Sportswear’s apparel be “related” in the trademark sense for SCAD’s claims to proceed—and ultimately found that Sportswear’s goods *were* so related—there is no circuit conflict on this issue, and no need for this Court’s review.

Sportswear’s second question presented does not warrant review, either. The petition does not challenge the legal rule the Eleventh Circuit applied—a seven-factor balancing test used in some form by all circuits to determine the likelihood of consumer confusion in this context. Instead, Sportswear ignores most of this fact-bound analysis, and wrongly bases its second question on the false premise that the Eleventh Circuit found a likelihood of confusion based on a single factor—“merely because consumers recognize the mark.” Pet. i. But the courts below correctly found that the balance of *all* the traditional factors confirmed a likelihood of confusion. Thus, Sportswear’s second question presented amounts to no more than a fact-bound request for error correction where there is no error.

As in the prior petition, Sportswear tries to paint the decisions below as resurrecting the “heresies” of the decades-old decision in *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975). Pet. 31. But the criticized feature of *Boston Hockey* was its *omission* of a likelihood-of-confusion analysis—a feature the Fifth

Circuit itself disavowed in 1977. *See Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 389 (5th Cir. 1977); *see also* 4 McCarthy, *supra*, § 24:10. Far from repeating that long-abandoned approach here, the Eleventh Circuit twice refuted it: *SCAD I* remanded for a likelihood-of-confusion analysis, and *SCAD II* undertook it in full. The Eleventh Circuit’s meticulous likelihood-of-confusion analysis refutes Sportswear’s repeated claims that *Boston Hockey* has tainted this case.

In short, the decisions below followed well-established law and reached the fact-bound and common-sense conclusion that SCAD can protect its marks from Sportswear’s unauthorized profiteering. There is no circuit conflict on either issue. Accordingly, the petition should be denied.

STATEMENT OF THE CASE

A. Legal Background

Congress has long protected “trademarks” and “service marks,” which are distinctive marks used to distinguish goods or services and thus protect a markholder’s “good will” and “good reputation.” *Matal v. Tam*, 137 S. Ct. 1744, 1751-52 (2017) (citations omitted). Regulating such marks protects consumers by helping them to “identify goods and services that they wish to purchase, as well as those they want to avoid.” *Id.* at 1751.

The Lanham Act has three complementary features relevant here. *First*, the Act provides for national registration of trademarks and service marks. *See* 15 U.S.C. §§ 1052-1053. Registration is not a prerequisite to assertion of rights in the marks—trademark owners acquire rights “from use, not registration.” *JBLU, Inc. v. United States*, 813

F.3d 1377, 1381 (Fed. Cir. 2016); *see Tam*, 137 S. Ct. at 1752-53. And in fact a separate section of the Act protects unregistered marks. *See infra*, 4-5. But registration confers certain benefits that can make it easier to prevail on a claim of infringement—*e.g.*, registration is “prima facie evidence of the validity of the registered mark . . . and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration.” 15 U.S.C. § 1115(a).

Second, Section 32(a) of the Lanham Act makes it unlawful to infringe a federally registered mark. That provision broadly forbids any person to “use in commerce . . . a registered mark in connection with the sale, offering for sale, distribution, or advertising of *any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.*” *Id.* § 1114(1)(a) (emphasis added). As explained below, Sportswear’s position largely ignores the “or” in “goods or services.”

Third, Section 43(a)(1)—which applies to both registered and unregistered marks—creates civil liability for “[a]ny person who, on or in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” *Id.* § 1125(a)(1)(A).

The elements of claims under Section 32(a) and Section 43(a)(1) are largely identical: (1) The plaintiff owns a valid and legally protectable mark; (2) the

defendant used that mark or a similar mark in connection with “any goods or services” without consent; and (3) the defendant’s use of the mark at issue caused a likelihood of confusion. *See generally Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 784 (1992) (Stevens, J., concurring) (“The aim of the amendments [in Section 43(a)] was to apply the same protections to unregistered marks as were already afforded to registered marks.”); 5 McCarthy, *supra*, § 27:18. Under either provision, the key question in conducting the likelihood-of-confusion analysis is whether the use is “likely to create consumer confusion as to origin, source, approval, affiliation, association, or sponsorship.” *See, e.g.*, Pet. App. 10a, 41a; *International Info. Sys. Sec. Certification Consortium, Inc. v. Security Univ., LLC*, 823 F.3d 153, 161 (2d Cir. 2016).

B. Factual Background

SCAD is one of the nation’s leading universities for students in creative fields. Founded in 1978, it currently enrolls more than 14,000 students, and is renowned for excellence in fields like advertising, architecture, fashion, film, and graphic design. SCAD’s Statement of Undisputed Facts (SMF) ¶¶ 3-4, ECF No. 40-2.¹ With students and faculty from all 50 states and more than 100 countries, and campuses in Savannah, Atlanta, and France, *id.* ¶¶ 5, 2, it has a globe-spanning reputation for excellence.

¹ “ECF No.” refers to District Court for the Northern District of Georgia No. 14-2288 docket.

SCAD has used its “SCAD” and “SAVANNAH COLLEGE OF ART AND DESIGN” marks since 1979. *Id.* ¶ 8. In 2001, it began using another mark—consisting of “Art the Bee,” SCAD’s mascot—inside a circle containing its name:²



SMF ¶ 9. SCAD registered each of those marks with the U.S. Patent and Trademark Office (USPTO) for inclusion on the principal register, based on its use of the marks in connection with the provision of educational services. *Id.* ¶¶ 8-13.

SCAD also uses the marks in connection with its varsity athletic programs in golf, tennis, soccer, and other sports. Pet. App. 4a-5a. In addition, and contrary to the assertions in Sportswear’s petition, SCAD has long made apparel featuring the marks available for sale to students and the public—just as nearly all colleges and universities do. See Compl. ¶ 19, ECF No. 1. The parties dispute when SCAD

² Compl. Exh. D, ECF No. 1-4.

first began selling apparel with SCAD marks, but SCAD has presented evidence that it has sold such apparel since at least 2008—before Sportswear began selling its knock-off SCAD apparel. *See infra*, 9.

In 2009, Sportswear, an internet-based retailer—in a blatant attempt to exploit consumers’ positive associations with SCAD—began selling “fan” apparel online bearing SCAD’s registered word marks “SCAD” and “Savannah College of Art and Design,” as well as a depiction of SCAD’s “Art the Bee” Mascot (pictured below), a prominent feature in SCAD’s registered logo. Pet. App. 5a, 6a, 27a.



SCAD



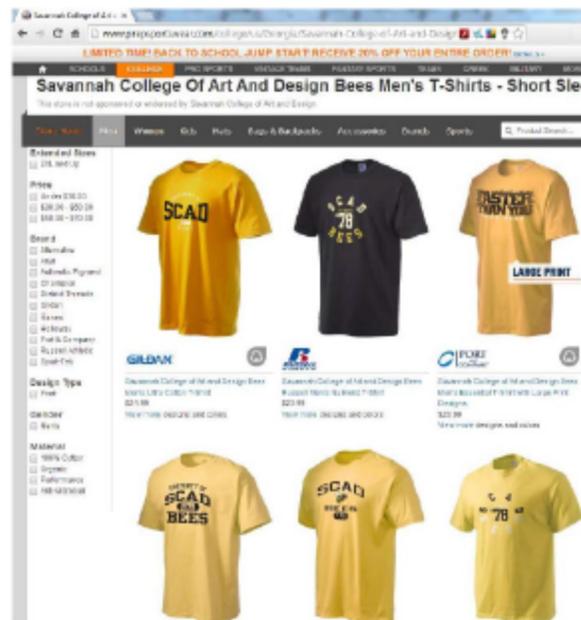
Sportswear

Sportswear never requested—and never received—SCAD’s permission to use these marks.

In 2014, SCAD learned that Sportswear was using its marks without authorization. SMF ¶ 17. Through an online “Savannah College of Art and Design Bees Apparel Store” that Sportswear created on its own website, Sportswear sold thousands of items bearing SCAD’s marks. *Id.* ¶¶ 17, 46. Many of the SCAD-branded products Sportswear offered were the same as or substantially similar to the SCAD-branded products that SCAD itself makes available to

consumers online and in its campus bookstores through an arrangement with its licensed partner, Follett Education Group, Inc. *Id.* ¶¶ 14-15, 46.

The following image from Sportswear's website shows a sampling of Sportswear's offerings:



Compl. ¶ 29.

C. Procedural History

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

1. After discovery, the parties cross-moved for summary judgment. The district court denied

SCAD's motion and granted Sportswear's. Pet. App. 80a. In doing so, it focused on the fact that SCAD's federal registration of its marks had described SCAD's use of those marks in connection with educational services, and did not list SCAD's use of the marks on goods or apparel. *Id.* at 84a.

The district court also excluded evidence SCAD had uncovered for the first time during its summary judgment briefing—a news story describing SCAD's intentions in 2008 to expand its then-existing sales of SCAD-branded apparel—showing that SCAD had been selling branded apparel since at least 2008, before Sportswear's first sales in 2009. *Id.* at 85a; see also SCAD Reply in Supp. of Summ. J. 2 n.1, ECF No. 49 (citing newspaper article). The court refused to consider this evidence because it was not discovered (and so not produced) until SCAD's reply in support of summary judgment. Pet. App. 85a-86a. Thus, refusing to consider evidence showing that SCAD sold branded apparel before Sportswear did, and believing that the law required SCAD to make that showing to secure relief under the Lanham Act, the court entered summary judgment for Sportswear.

The Eleventh Circuit reversed in *SCAD I*. Pet. App. 28a-29a. The court recognized that SCAD's claims under Sections 32 and 43(a) of the Lanham Act both turned, at bottom, on whether SCAD could “show ‘enforceable trademark rights in [a] mark or name’” and that “Sportswear ‘made unauthorized use of [its marks] such that consumers were likely to confuse the two.’” *Id.* at 35a (alterations in original) (citation omitted). The Eleventh Circuit explained that the district court, however, had “never reached likelihood of confusion” because “[u]nder the district court's rationale, the infringement claim . . . necessarily

failed because the limited federal registrations for ‘education services’ meant that SCAD did not have rights as to ‘goods,’ and SCAD did not provide evidence showing that it used its marks on apparel before Sportswear.” *Id.* at 36a.

The Eleventh Circuit concluded that the district court’s approach contravened circuit precedent under which “the holder of a federally-registered service mark need not register that mark for goods—or provide evidence of prior use of that mark on goods” to pursue an infringement claim *Id.* at 41a (citing *Boston Pro. Hockey Ass’n* (emphasis omitted)). Rather, the court explained, “registered trademark rights may extend to any goods related in the minds of consumers.” *Id.* at 47a (citation omitted). The Eleventh Circuit remanded for the district court 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.” *Id.* at 41a.³

Sportswear filed a petition for certiorari with this Court raising the same first question presented by the instant petition. This Court denied certiorari.

2. On remand, the district court explained that the “relatedness of the Plaintiff’s services and the Defendant’s goods remains a live question, and indeed the central question, in this case” under the Eleventh Circuit’s decision and that its answer depended on whether consumers would “mistakenly believe that they originate from, or are somehow affiliated with, a single source.” *Id.* at 65a. The court accordingly

³ The Eleventh Circuit declined to reach the issue whether the district court properly excluded SCAD’s evidence of having sold apparel using its marks since 2008. Pet. App. 41a. n.5.

undertook the established seven-factor likelihood-of-confusion analysis to determine whether Sportswear's use of SCAD's marks was likely to "cause[] consumer confusion as to origin, source, approval, affiliation, association, or sponsorship." *Id.* at 67a.

The district court held that the record showed a likelihood of confusion under the settled multi-factor test and granted summary judgment to SCAD. *Id.* at 54a-79a. In reaching that conclusion, the court expressly declined to rely on *Boston Hockey*, and it acknowledged that Sportswear's use of disclaimers on its website disavowing sponsorship by SCAD were relevant facts in the inquiry. *Id.* at 74a-77a. As a result, the court found that one factor, the "similarity of actual sales methods," weighed "weakly in favor of [Sportswear]." *Id.* at 74a, 77a. The court also found that a second factor, evidence of "actual confusion," favored Sportswear. *Id.* at 78a. The other factors, however—"the strength of the mark, the similarity of the marks, and the Defendant's intent"—together "greatly outweigh[ed]" the factors favoring Sportswear. *Id.* at 78a-79a.

The Eleventh Circuit affirmed. *Id.* at 10a-25a. The court first noted that the district court, in keeping with the "mandate in *SCAD I*," had properly considered whether Sportswear's use of its word marks was likely to create consumer confusion. *Id.* at 10a. Then, the court engaged in its own application of the seven-factor likelihood-of-confusion analysis, "evaluat[ing] the weight of the facts, considering the unique circumstances of the case." *Id.* at 24a; *see id.* at 10a-25a. The court ultimately concluded that four factors favored SCAD, one factor weakly favored Sportswear, and the remaining factors were largely irrelevant in this factual context. "Given the balance

of facts in this matter,” the Eleventh Circuit concluded that the district court correctly found that Sportswear’s copying of SCAD’s marks was likely to confuse consumers. *Id.* at 25a.⁴

REASONS FOR DENYING THE PETITION

I. THE FIRST QUESTION PRESENTED STILL DOES NOT WARRANT REVIEW

Sportswear’s first question presented again rests on a false premise—that the Eleventh Circuit held that SCAD’s service marks extend to “unrelated” goods, Pet. i.—that, once dispelled, eliminates any conflict or other basis for review. Not only did the Eleventh Circuit in *SCAD I* expressly remand to determine whether Sportswear’s apparel bearing SCAD’s marks would be “related” to SCAD’s services in the minds of consumers, but both the district court on remand and the Eleventh Circuit ultimately determined that the goods and services in this case *are* related in the trademark sense. That is to say that they (like the courts of every other circuit) looked to whether Sportswear’s blatant copying of SCAD’s indisputably valid marks was likely to cause confusion in the minds of consumers—and ultimately concluded on the facts here that it was. The careful findings by both courts only underscore that this Court was right to deny review in 2018.⁵

⁴ The Eleventh Circuit held that the “likelihood-of-confusion factors support the district court’s finding” as to SCAD’s Bee Mark too, and rejected Sportswear’s claims that SCAD had abandoned the mark. Pet. App. 25a-27a.

⁵ SCAD’s claims against Sportswear under § 32(a) of the Lanham Act and unfair competition and false designation of

A. The First Question Presented Rests On A False Premise

As the district court observed, Sportswear’s strategy has been to “mischaracterize[] the Plaintiff’s position and prior rulings in this case” as holding that the goods and services at issue in this cases are *unrelated*. Pet. App. 65a. Indeed, Sportswear bases its first question presented on the premise that the Eleventh Circuit held that the scope of SCAD’s marks extends to “unrelated” goods. *E.g.*, Pet. i. In fact, *neither court below* found, and SCAD has never argued in this case, that trademark protection extends to “unrelated products.” *Id.* at 15. To the contrary, *SCAD I* specifically remanded for the district court to decide whether the products at issue were related—in other words, whether Sportswear’s use of SCAD’s marks on its goods would confuse consumers. Pet. App. 41a. Once that premise is corrected, all of Sportswear’s arguments for certiorari on the first question evaporate.

Not only did the Eleventh Circuit never *say* that the goods at issue were “unrelated” to SCAD’s service marks, but it specifically remanded the case for the district court to determine whether the goods *were* related. Under black letter trademark law, “[g]oods (or services) are ‘related,’ not because of any inherent common quality of the respective goods, but ‘related’ in the sense that buyers are likely to believe that such goods, similarly marked, come from the same source, or are somehow connected with or sponsored by the

origin under § 43(a) of the Act both require the same showings, including as to likelihood of confusion. *See* Pet. App. 7a; *supra*, 4-5. For simplicity, this brief treats those two claims as equivalent and speaks mainly in terms of infringement.

same company.” 4 McCarthy, *supra*, § 23:1. In other words, relatedness in this context turns on “whether the consumer might . . . reasonably conclude that one company would offer both of these related products.” *Sabinsa Corp. v. Creative Compounds, LLC*, 609 F.3d 175, 189 (3d Cir. 2010) (alteration in original) (citation omitted); *see also Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1212 (9th Cir. 2012) (“Related goods (or services) are those ‘which would be reasonably thought by the buying public to come from the same source if sold under the same mark.’” (citation omitted)).

As relevant here, then, the parties’ products are “related” if a consumer, seeing a t-shirt bearing SCAD’s word mark and bee logo, would believe that the t-shirt was “somehow connected with or sponsored by” SCAD. 4 McCarthy, *supra*, §§ 23.1, 24:65; *see also* Pet. App. 65a (“The relatedness of the Plaintiff’s services and the Defendant’s goods remains . . . the central question, in this case.”); *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1244 (Fed. Cir. 2004) (“[G]oods that are neither used together nor related to one another in kind may still ‘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.’” (citation omitted)).

In *SCAD I*, the Eleventh Circuit remanded for further proceedings on that exact question. Pet. App. 14a-15a. The Eleventh Circuit affirmed that “registered trademark rights may extend to any *goods related* in the minds of consumers.” *Id.* at 47a (emphasis added) (citation omitted). And it directed the district court to consider on remand “whether SCAD has demonstrated that Sportswear’s use of its word marks is likely to create consumer confusion as

to origin, source, approval, affiliation, association, or sponsorship.” *Id.* at 41a. If the Eleventh Circuit had, as Sportswear repeatedly asserts, held that SCAD’s service marks extend to “unrelated” goods, that inquiry would have been unnecessary.

Sportswear relies heavily on an isolated statement in *SCAD I* that “the holder of a federally-registered service mark need not register that mark for goods . . . in order to established the *unrestricted validity* and scope of the service mark.” *Id.* (emphasis added); *see* Pet. 10-11, 15, 19-20, 35. But that statement—discussing the principle that a valid trademark can be infringed by use on *any* related good or service, *see* 15 U.S.C. § 1114(1)(a); *infra*, 17-18—ignores the very next paragraph, which remanded to the district court 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,” Pet. App. 41a. This is the relatedness inquiry that the district court later performed in the first instance, and the Eleventh Circuit reviewed *de novo* in *SCAD II*. *Id.* at 10a.

Ultimately, Sportswear’s claim that the Eleventh Circuit extended trademark protection to “unrelated goods” also defies common sense. Like most universities, SCAD provides apparel with its marks to allow purchasers to display their affiliation with or allegiance to the school. It is no surprise that a consumer, seeing a product (like a t-shirt) commonly marketed by a college and bearing a college’s mark might consider the t-shirt to be sponsored or approved by the college and thus “related” to its educational services. That is what the Eleventh Circuit’s ultimate likelihood-of-confusion analysis confirms as to the SCAD-branded apparel at issue in this case.

B. Sportswear’s Position Erroneously Equates Registration With The Scope Of Rights Against Infringement

Sportswear also argues that, because “[t]he goods or services specified in [SCAD’s] registration are educational services,” the registration “did not confer on SCAD any rights over apparel goods.” Pet. 16. But that assertion confuses the role of registration in establishing a trademark’s *validity* with the scope of a valid trademark’s rights against *infringement*. A registration is *prima facie* evidence of a mark’s validity for the *registered* goods or services, but a valid trademark’s rights against infringement extend to any *related* goods or services.

To make out a trademark claim, a plaintiff must show both (1) that it has a valid, protectable mark (validity), and (2) that the defendant’s use of that mark is likely to cause confusion (infringement). *See, e.g., Applied Info. Scis. Corp. v. eBay, Inc.*, 511 F.3d 966, 969 (9th Cir. 2007). Because registration by the USPTO is “*prima facie* evidence of the validity of the registered mark,” 15 U.S.C. § 1115(a), registration “discharges the plaintiff’s original common law burden of proving *validity* in an infringement action,” *Applied Info. Scis. Corp.*, 511 F.3d at 970 (emphasis added) (citation omitted).

Here, SCAD indisputably registered the marks at issue—the name of the school and logo—with the USPTO for educational services. *See supra*, 6. The question is whether SCAD can prevent Sportswear from using SCAD’s indisputably valid marks for its apparel. The resolution of that question turns on a straightforward *infringement* analysis—i.e., does Sportswear’s use of the marks on apparel infringe

SCAD’s registered marks—which, in turn, boils down to whether consumers would be “likely to confuse” the source, sponsorship, or affiliation of the goods. Pet. App. 3a n.3 (quoting *Custom Mfg. & Eng’g, Inc. v. Midway Servs., Inc.* 508 F.3d 641, 647 (11th Cir. 2007)).⁶

In other words, after a plaintiff has demonstrated validity by producing an unchallenged registration, that mark’s protection against infringement can extend to uses of the mark on a much wider category of goods or services than those for which the mark has been registered with the USPTO, so long as they are “related” in the trademark sense. *See, e.g., Applied Info. Scis. Corp.*, 511 F.3d at 971-72; *E. Remy Martin & Co., S.A. v. Shaw-Ross Int’l Imports, Inc.*, 756 F.2d 1525, 1530 (11th Cir. 1985); *see also* 4 McCarthy, *supra*, § 24:65; 2 Anne Gilson LaLonde, *Gilson on Trademarks* § 4.03[4][b] (2021). Thus, even if a USPTO *registration* does not apply by its terms to a particular good or service, there still can be infringement if the goods or services are related—if, that is, use of the mark creates a likelihood of confusion as to source, sponsorship, or affiliation as to that good or service. *Supra*, 13-15.

That rule flows from the text of the Lanham Act itself. Section 32(1)(a) of the Act prohibits the use of a registered mark on “*any* goods or services” if “such use is likely to cause confusion.” 15 U.S.C.

⁶ Although it is not necessary to the resolution of this case, the parties disagree as to whether SCAD *could* have registered its marks for apparel sales. As explained below, *infra* 24, SCAD produced evidence—excluded by the district court—that it had sold apparel using its marks since at least 2008, meaning that SCAD *could* have registered its marks for use on apparel.

§ 1114(1)(a) (emphasis added). Section 43(a)(1) similarly applies to “[a]ny person who, on or in connection with *any* goods or services, . . . uses” a “word, term, name, symbol, or device . . . which . . . is likely to cause confusion.” *Id.* § 1125(a)(1)(A) (emphasis added). Neither provision requires that the infringing use have occurred on the particular good or service listed in the registration—instead, use on “*any* good or service” is a basis for infringement if it is likely to cause confusion. Sportswear just ignores Congress’s use of “any” in “any goods or services,” in suggesting that the Eleventh Circuit erred in extending trademark protection beyond the goods or services listed in a USPTO registration.

In other words, Sportswear’s petition reflects “[a]n error sometimes made by both attorneys and judges unfamiliar with trademark law,” which treats trademark infringement “as if it were a case of patent infringement.” 4 McCarthy, *supra*, § 23:1. “That error is to compare the list of goods or services for which a trademark is registered and compare them to the goods and services on which the defendant uses the accused mark. That error leads to the false conclusion that there is trademark infringement only if the goods or services in the accused use is the same as the goods or services listed in the trademark registration. This most certainly is *not* the law.” *Id.* In attempting to shift focus from the question of relatedness to the precise goods or services listed in SCAD’s USPTO registrations, Sportswear asks this Court to endorse precisely this error.

C. There Is No Circuit Conflict

Because the Eleventh Circuit demonstrably required an inquiry into relatedness before finding

that SCAD's marks were infringed, there is no conflict at all. Sportswear's petition gives the impression that the Eleventh Circuit stands by itself in holding that a registered service mark can be infringed through use on related goods. But the reality is that there "is *no doubt* that a registered service mark can be infringed by use on goods," where the likelihood-of-confusion test is met. 4 McCarthy, *supra*, § 24:65 n.6.30 (emphasis added) (collecting cases). Sportswear's petition thus is as splitless today as it was in 2018.

1. The lower courts agree that the unauthorized use of a registered mark on goods *related* to the uses listed in the registration may constitute infringement. In *Applied Information Sciences Corp. v. eBay, Inc.*, for example, the Ninth Circuit held that "a markholder's rights to protect its interest in a registered mark [a]re not limited to infringement actions against those using the mark in connection with the specified goods or services," but instead depend on a "likelihood of confusion analysis." 511 F.3d at 971 (citation omitted). Thus, "[a]lthough the validity of a registered mark extends only to the listed goods or services, an owner's remedies against confusion with its valid mark are not so circumscribed." *Id.* (emphasis omitted). As the Ninth Circuit explained, that is the "longstanding rule in other circuits as well." *Id.*

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

(citation omitted). The Fifth Circuit has recognized that “[t]he remedies of the owner of a registered trademark are not limited to the goods specified in the certificate, but extend to any goods on which the use of an infringing mark is ‘likely to cause confusion.’” *Continental Motors Corp. v. Continental Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) (citation omitted). And the Fourth Circuit rejected the argument that a registered mark provides protection against only use of that mark on the particular goods or services listed in the registration, holding that protection extends to the use of “the same or a confusing mark . . . even on those [goods] which may be considered by some to be unrelated but which the public is likely to assume emanate from the trademark owner.” *Synergistic Int’l, LLC v. Korman*, 470 F.3d 162, 173 (4th Cir. 2006) (citation omitted).

Sportswear itself acknowledges that the decisions of the Second, Fourth, and Ninth Circuit described above allow the holder of a registered mark to assert infringement claims “not only [as] to the specific good or service identified in the registration, but to goods or services ‘related’ thereto.” Pet. 19. Its only basis for asserting a conflict with those decisions is its contention that the Eleventh Circuit’s decision would allow a trademark holder to successfully assert an infringement claim against “all goods and services,” including *unrelated* ones. *Id.* at 21 (emphasis omitted). But as discussed, Sportswear is simply wrong that *SCAD I* concluded the goods here are “unrelated.” The Eleventh Circuit remanded for the district court to make exactly that relatedness determination (through a traditional likelihood-of-confusion analysis)—and ultimately affirmed the commonsense conclusion that Sportswear’s use *was*

likely to confuse consumers as to source, approval, or sponsorship of the goods. *See infra*, 25-30; Pet. App. 25a, 41a.

Sportswear falls back on the Third Circuit's decision in *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383 (3d Cir.), *cert. denied*, 474 U.S. 920 (1985). But, here again, it is overreaching. In the thirty-plus years since *Natural Footwear* was decided, the Third Circuit has never invoked that decision to hold that a registered mark can be infringed only through use on the particular good or service listed in the registration. That explains the conspicuous absence in Sportswear's petition of any Third Circuit decision actually applying *Natural Footwear* in conflict with the Eleventh Circuit's decisions below.

That absence is unsurprising. As courts and commentators have explained, it is “not clear” from the language of *Natural Footwear*, which is “internally inconsistent,” whether the court even meant to “limit[] infringement remedies to only defendant's goods which are identical to those in the plaintiff's registration (which is not the law anywhere).” *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 300 n.25 (D.N.J. 1998) (quoting 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:65 n.3 (4th ed. 1997)); *see also Applied Information Scis. Corp.*, 511 F.3d at 972 n.3 (noting that it “is possible—though not entirely clear” that *Natural Footwear* embraced this rule). *Natural Footwear* is, at most, ambiguous on that point—leaving the Third Circuit free to consider the statute's text and the universal approach of the other circuits whenever it is next called on to decide a similar question. And even if *Natural Footwear* actually embraced the rule that Sportswear attempts to

extract from it, the case at best represents a decades-old outlier that would not warrant this Court's intervention here.

2. Perhaps sensing that the legal rules applied by the different circuits are fundamentally equivalent, Sportswear ultimately rests its claims of a conflict on its contention that the law in other circuits is “nothing like the rule adopted by the Eleventh Circuit” because “[e]ducational services and clothes are completely different” such that no one would confuse the two products. Pet. 24; *see also id.* at 22. But this argument misreads the case law and boils down to a fact-bound disagreement with the Eleventh Circuit's likelihood-of-confusion analysis. *See infra*, 25-30.

Indeed, courts routinely find that a defendant's uses of a plaintiff's mark on goods that are otherwise “different” from those specified in a registration are likely to cause confusion—and those goods and services are thus “related” for trademark purposes. *See, e.g., Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 36 (1st Cir. 1989) (“Boston Marathon” mark only registered for marathon services could be infringed by use of mark on t-shirts); *Chemical Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 434, 439 (5th Cir. 1962) (owner of registered slogan ‘Where there's life . . . there's Bud,’ for Budweiser beer could prevent defendant from using slogan ‘Where there's life . . . there's bugs,’ in sale of insecticide); *Tuxedo Monopoly, Inc. v. General Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336-37 (C.C.P.A. 1981) (use of “MONOPOLY” mark on apparel would create confusion with “MONOPOLY” mark registered only for board games); *Ducks Unlimited, Inc. v. Boondux, LLC*, No. 2:14-cv-02885, 2017 WL 3579215, at *21-25 (W.D. Tenn. Aug. 18, 2017) (graphic mark only registered

for services “promoting the preservation of waterfowl” could be infringed by use on hunting- and fishing-themed apparel). This case is no different.

And to the extent that Sportswear suggests that a *service* mark can never be infringed by use on *goods*, that contention, again, is refuted by the plain text of the Lanham Act, *see* 15 U.S.C. § 1114(1)(a) (forbidding use “in connection with the sale . . . of *any goods or services* on or in connection with which such use is likely to cause confusion” (emphasis added)), as well as by a host of decisions. *See, e.g., Boston Athletic Ass’n*, 867 F.2d at 23 n.1 (holding that “distinction between the two types of marks is irrelevant” and that use of service mark on apparel constituted infringement); *Rexel, Inc. v. Rexel Int’l Trading Corp.*, 540 F. Supp. 2d 1154, 1157, 1172 (C.D. Cal. 2008) (service mark for “wholesale distributorship services in the field of electrical supplies and lighting fixtures” was infringed by use on “batteries and related goods”); *WSM, Inc. v. Bailey*, 297 F. Supp. 870, 871, 873 (M.D. Tenn. 1969) (infringement of service mark for the “Grand Ole Opry” when defendant used the word “Opry” on phonograph records).

The case law in the circuits is perfectly consistent; it is Sportswear’s position that is out of whack.

3. Sportswear’s attempt (at 5, 34) to manufacture a conflict with the Federal Circuit also fails. Sportswear argues that, whereas “SCAD . . . could not have obtained a trademark registration for apparel,” the Eleventh Circuit “extend[ed] [SCAD’s mark] to *all* goods and services” and “establish[ed] a likelihood of confusion merely by showing that the mark is *printed* on any good or service.” Pet. 34-36. That is wrong.

In the first place, SCAD *could* have obtained a trademark registration for apparel because it sold apparel bearing its mark before 2008. *See supra*, 9. The district court excluded this evidence because it was not produced until SCAD’s reply in support of summary judgment (which was when SCAD discovered it). Pet. App. 85a; *see also id.* at 55a. Sportswear has never given any reason to doubt the *veracity* of that evidence, however. Indeed, this creates a vehicle problem that Sportswear never addresses: Sportswear asks this Court to, in essence, issue an advisory opinion on hypothetical facts.

More fundamentally, there is no conflict because trademark registration and trademark infringement are distinct concepts, with different standards and consequences. The Federal Circuit’s decisions address what marks can be registered and for which goods and services; the regional circuits address what additional goods or services—beyond those listed in the registration—can support an infringement claim under the likelihood-of-confusion standard used to determine relatedness.

There is no conflict of authority between these two different lines of decisions because, as explained, “[t]he remedies of a registered trademark owner are not limited to the goods and/or services specified in the registration, but go to any goods or services on which the use of the mark is likely to cause confusion.” 4 McCarthy, *supra*, § 24:65; *see supra*, 16-18. Sportswear is thus wrong to suggest (at 35) that registration with the USPTO as to services somehow *limits* SCAD’s rights against infringement.

II. THE SECOND QUESTION PRESENTED DOES NOT WARRANT THIS COURT'S REVIEW EITHER

Sportswear also seeks review of the Eleventh Circuit's holding that consumers were likely to be confused by Sportswear's use of SCAD's marks. But the Eleventh Circuit's fact-bound application of the well-established likelihood-of-confusion test was correct, and in any event does not conflict with the decisions of any other court of appeals.

A. *SCAD II* Correctly Found Likelihood Of Confusion On The Facts Of This Case

1. Sportswear does not challenge the actual legal rule applied by the Eleventh Circuit. In keeping with circuit precedent and the law of other circuits, *see infra*, 31, the Eleventh Circuit considered seven factors to assess the likelihood of confusion:

(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 the advertising methods; (6) 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.

Pet. App. 10a-12a (citation omitted).

The petition (at 27) contends that SCAD "failed" to "prove a likelihood of confusion" on the facts here, but the important point is that the petition fails to challenge the legal rule actually applied by the court.

That should be the end of the matter, because this Court generally does not grant review of lower courts' fact-bound application of settled rules. *See* Sup. Ct. R. 10(a); *see also, e.g., United States v. Johnston*, 268 U.S. 220, 227 (1925) (“We do not grant a certiorari to review evidence and discuss specific facts.”).

2. In any event, the Eleventh Circuit correctly concluded that consumers were likely to be confused under the settled test.

Sportswear suggests that the Eleventh Circuit found a likelihood of confusion “merely because consumers recognize[d] the mark.” Pet. i. But far from focusing merely on “consumer recognition,” the Eleventh Circuit found that *four* of the seven factors favored 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.” Pet. App. 24a.⁷ By contrast, only one factor—the volume of evidence of “actual confusion” of consumers—favored Sportswear, and that factor carried little weight because “low sales volume,” “the relatively inexpensive nature of the goods,” and the fact that “casual purchasers of small items’ are more likely to be confused than more sophisticated consumers” suggested that actual evidence of confusion would be hard to come by. Pet. App. 24a-25a (citation omitted).

In focusing exclusively on the “actual confusion” and “intent to misappropriate” factors—and ignoring

⁷ In fact, on remand below Sportswear’s arguments focused squarely on the “strength of the mark” factor—yet before this Court, Sportswear fails even to mention that factor. *See, e.g.,* Appellant’s CA11 Br. 13-24; CA11 Reply Br. 10-15.

the other five factors—Sportswear overlooks that the seven-factor test requires a balancing of *all* the factors, not simply cherry picking the ones that a particular party likes. And here, Sportswear provides no reason for second-guessing the Eleventh Circuit’s conclusion that the balancing favored a finding of a likelihood of confusion.

3. Sportswear’s attempts to identify a legal error in the decisions below similarly do not withstand scrutiny. Each of the asserted legal errors is based on a misstatement of either established law or the holdings below, and each fails on close inspection.

First, Sportswear suggests that only consumer confusion as to the “source,” or origin, of goods can give rise to a viable infringement claim. Pet. 29-30. On Sportswear’s telling, no infringement could occur here, because “[n]o one would show up at a retail clothing store and expect to find a university *education* on the shelf.” *Id.* at 24 (emphasis added). But consumer confusion is not limited to such product or “source” confusion—that is, whether a consumer would mistakenly buy one product rather than the other. Instead, it extends to any “confusion over affiliation, connection, or sponsorship,” which includes mistaken beliefs “that the senior user has expanded [its offerings] in some way” into the junior user’s market. 4 McCarthy, *supra*, § 23:5.

That result is dictated by the Lanham Act’s plain text, which extends liability to use of a mark that “is likely to cause confusion . . . 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)(1)(A) (emphasis added). *See also, e.g., International Info. Sys. Sec.*

Certification Consortium, Inc., 823 F.3d at 161 (“[T]he Act’s protection against infringement is not limited to . . . confusion as to source. Rather, the Lanham Act protects against numerous types of confusion, including confusion regarding affiliation or sponsorship.”); *Amoco Oil Co. v. Rainbow Snow*, 748 F.2d 556, 559 (10th Cir. 1984) (reversing where court “did not consider potential confusion . . . from a belief in common sponsorship or affiliation”).

Second, Sportswear asserts that the Eleventh Circuit found a likelihood of confusion “merely because consumers recognize[d]” SCAD’s marks. Pet. i; see Pet. 15. But only *one* of the seven factors—Sportswear’s “intent to misappropriate SCAD’s goodwill”—involved consumer recognition in the sense to which the petition objects. Pet. App. 18a-23a. The Eleventh Circuit never said this single factor was dispositive in the overall balancing. Rather, even as to this one factor regarding Sportswear’s intent, the Eleventh Circuit was careful to note that “mere evidence of intentional copying—in the absence of any other evidence—does not conclusively establish a likelihood of confusion.” *Id.* at 20a.

To be sure, the Eleventh Circuit recognized that consumers’ likelihood of recognition *weighed in favor* of a finding that Sportswear intended to misappropriate SCAD’s goodwill in its mark. But that makes perfect sense. After all, Sportswear’s entire business model “relies upon the goodwill, reputation, and affiliation people associate with” SCAD. *Id.* Sportswear in fact *admitted* “that customers visit its website to ‘create apparel bearing the name of the school, team, or organization with which they desire to express affiliation.’” *Id.*

On similar facts, numerous courts have found actionable confusion. In *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.*, for instance, the Fifth Circuit held that an apparel company infringed universities' unregistered marks in their color schemes. 550 F.3d 465, 484-85 (5th Cir. 2008), *cert. denied*, 556 U.S. 1268 (2009). Likewise, courts have found infringement of universities' marks by t-shirt distributors in analogous circumstances. See *University of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1294-95, 1310 (D. Kan. 2009) (summary judgment appropriate against seller of t-shirts bearing marks that were "overwhelmingly similar to KU's marks"); *Texas Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520, 523 (N.D. Tex. 2006) (finding trademark infringement based in part on the inexpensiveness of the shirts, making them impulse-buys more likely to result in confusion).

Third, Sportswear claims that "the Eleventh Circuit f[ound] a likelihood of confusion" only because it was "constrained" to do so by *Boston Hockey*. Pet. 28-29. That is false in multiple respects.

To begin, the Eleventh Circuit relied on *Boston Hockey* in only one of the seven likelihood-of-confusion factors: Sportswear's "intent to misappropriate SCAD's goodwill." Pet. App. 18a-23a. That precedent did not bear on any of the other six factors. And even as to that one factor, *Boston Hockey* was cited by the Eleventh Circuit only for the uncontroversial proposition that a defendant's use of a website disclaimer, standing alone, does not automatically negate other indicia of an infringer's bad intent. Throughout this litigation, Sportswear sought to "rel[y] on its use of website disclaimers to

negate any finding of intent to confuse consumers.” *Id.* at 18a-19a. In other words, Sportswear argued that its disclaimers created a safe harbor for its infringement. But *Boston Hockey* “considered and rejected the idea” that a disclaimer would necessarily and singlehandedly “remedy . . . illegal confusion.” *Id.* at 21a. This makes sense; in many cases, “a disclaimer does not serve to cure a strong case of likely confusion.” 4 McCarthy, *supra*, § 23:51; *id.* § 23:51 n.2.50 (collecting cases). Consumer studies have revealed, for instance, that not only are disclaimers sometimes “ineffective in curing customer confusion over similar marks,” but also may “aggravate, not alleviate, confusion over brands.” *Id.* § 23:51 & nn.3-4 (collecting studies). As the Seventh Circuit has explained, a “plaintiff’s reputation and goodwill should not be rendered forever dependent on the effectiveness of fine-print disclaimers often ignored by consumers.” *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1093 (7th Cir. 1988).

Here, the Eleventh Circuit reasonably concluded that, even if Sportswear’s disclaimers “may be viewed as negating some of Sportswear’s intent,” they were “insufficient under [*Boston Hockey* and *Laité*] . . . to totally negate the confusion.” Pet. App. 22a. This fact-bound conclusion—constituting the sole reliance on *Boston Hockey* in all of *SCAD II*’s likelihood-of-confusion analysis—does not merit review.⁸

⁸ Sportswear’s remaining complaints boil down to disagreements with the weight given to different factors by the courts below. Sportswear asserts, for instance, that there was no “evidence that any consumer ever thought that SCAD’s

B. There Is No Circuit Conflict

Sportswear does not allege that the Eleventh Circuit’s seven-factor balancing test conflicts with the tests employed by other circuits, and it doesn’t. *See* 4 McCarthy, *supra*, § 24:30; *see id.* §§ 24:31-43 (describing test in each circuit). Instead, Sportswear claims that the Ninth and Tenth Circuits have interpreted certain aspects of the Eleventh Circuit’s *Boston Hockey* decision differently from the Eleventh Circuit. Pet. 32-33. In reality, those others circuits have merely critiqued a maximalist reading of the *Boston Hockey* decision that the Eleventh Circuit itself has rejected and did not follow here. Thus, Sportswear’s claim (at 33) that it would have prevailed in other circuits also fails.

1. There Is No Conflict With Decisions Of The Ninth Or Tenth Circuits

The Ninth and Tenth Circuit cases cited by Sportswear criticizing *Boston Hockey* simply affirm the approach the Eleventh Circuit took in this case—engaging in a full likelihood-of-confusion analysis to determine whether infringement occurred.

In *International Order of Job’s Daughters v. Lindeburg & Co.*, the Ninth Circuit disagreed with

products originated with, or were endorsed by, SCAD.” Pet. 27. There was indeed such evidence, *see* Pet. App. 78a, but in any event, both the district court and Eleventh Circuit *agreed* that this factor favored Sportswear—they merely declined to hold that this factor, by itself, defeated a likelihood of confusion. *Id.*; Pet. App. 23a. Moreover, while evidence of actual confusion can in many cases be probative, “no[] proof of actual confusion is necessary” under either the text of the Lanham Act or mainstream trademark law to sustain an infringement claim. 4 McCarthy, *supra*, § 27:18. Here again, the Eleventh Circuit’s decision is perfectly consistent with existing law.

broad language in *Boston Hockey* that could potentially be interpreted to give a trademark owner “complete monopoly over [the mark’s] use,” such that any use of a mark—regardless of consumer confusion—constitutes infringement. 633 F.2d 912, 918 (9th Cir. 1980). Instead, the court held that a “trademark owner has a property right *only insofar as is necessary to prevent consumer confusion.*” *Id.* at 919 (emphasis added). To make that determination, the court suggested a multifactor analysis, including “closely examin[ing] the articles themselves, the defendant’s merchandising practices, and any evidence that consumers have actually inferred a connection.” *Id.* That is a precursor to the likelihood-of-confusion test applied in the decisions below.

In *United States v. Giles*, the Tenth Circuit—following *International Order of Job’s Daughters*—similarly condemned a maximalist reading of *Boston Hockey* that would give “the plaintiffs a monopoly over use of the trademark.” 213 F.3d 1247, 1250 (10th Cir. 2000). But then *Giles* articulated the correct standard: “Trademark law prevents the use of a similar mark on such goods or services as would probably cause confusion.” *Id.* at 1252 (citation omitted). Again, that is precisely the analysis that the district court and Eleventh Circuit undertook here.

Far from endorsing the aspects of *Boston Hockey* criticized by the Ninth and Tenth Circuits, the Eleventh Circuit expressly rejected them. *SCAD II* observed that in “a binding decision issued only two years later . . . 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.” Pet. App. 43a. Similarly, the

Fifth Circuit has interpreted *Boston Hockey* to depend on its unusual facts, which “supported . . . the inescapable inference that many would believe that the product itself originated with or was somehow endorsed by [the teams].” *Id.* (second alteration in original) (quoting *Smack Apparel Co.*, 550 F.3d at 485); see also *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...”).

This case proves the point. Instead of “do[ing] away with traditional confusion analysis,” Pet. App. 43a, the Eleventh Circuit in *SCAD I* instructed the district court to undertake precisely that analysis—just as the Ninth and Tenth Circuits would have done. On remand, the district court undertook that likelihood-of-confusion analysis in extensive detail. See *id.* at 63a-79a. And when the case returned to the Eleventh Circuit, the court engaged in its own, lengthy application of the traditional analysis. See *id.* at 10a-25a. The Eleventh Circuit did not remotely endorse the long-discredited reading of *Boston Hockey* under which likelihood of confusion is irrelevant.

Instead, the only aspect of *Boston Hockey* that the Eleventh Circuit relied on in its likelihood-of-confusion analysis was the holding that, even if “the website disclaimers [by Sportswear] may be viewed as negating some of Sportswear’s intent,” they “are, like the disclaimers in *Boston Hockey*, . . . insufficient under our binding precedent to totally negate the confusion.” Pet. App. 22a. That holding is entirely fact-dependent. And on this question—whether a disclaimer totally negates clear intent by a defendant

to profit from a plaintiff's marks—Sportswear does not allege any conflicting decisions at all.

2. Any Disagreement With *Boston Hockey* Is Purely Academic

In any event, review of the long-discredited aspects of *Boston Hockey* would not alter the outcome of this case. Indeed, the district court on remand, in conducting its likelihood-of-confusion analysis, did not cite *Boston Hockey* anywhere and, instead, affirmatively *repudiated* that case. *See id.* at 63a n.48 (noting that it “is not the law” that “infringement lies when customers” recognize a product as bearing a plaintiff's mark “regardless of whether the customers are thereby confused”); *id.* at 63a-79a. Yet the district court reached precisely the same result as the Eleventh Circuit, holding both that the intent-to-misappropriate-goodwill factor favored a finding of confusion and, more broadly, that SCAD was entitled to summary judgment on the question of infringement given the likelihood of confusion. Plainly, *Boston Hockey* was not outcome-determinative on the question of likelihood of consumer confusion.

The Eleventh Circuit, too, emphasized that it had multiple independent grounds for finding that the intent factor for which it cited *Boston Hockey* favored SCAD—to say nothing of the remaining six factors in the confusion analysis. For one, the circuit precedent of *University of Georgia Athletic Association v. Laite* also precluded a safe harbor for disclaimers. 756 F.2d 1535 (11th Cir. 1985); Pet. App. 21a-22a. There, the Eleventh Circuit held that the marketer of “Battlin’ Bulldog Beer,” bearing the University of Georgia’s mascot, could not evade infringement liability merely through a disclaimer stating its beer was not

associated with the university. Pet. App. 21a-22a (citing *Laite*). While *Laite* referenced *Boston Hockey*, the decision offered independent reasons for its conclusion—namely, that the disclaimers were inconspicuous and unlikely to be effective in dispelling consumer confusion. 756 F.2d at 1547. The Eleventh Circuit relied on *Laite* throughout its decision, including for that proposition. See Pet. App. 10a-12a, 17a-18a, 21a-22a, 25a. Remarkably, however, Sportswear’s petition ignores *Laite* entirely.

In the end, Sportswear’s reliance on *Boston Hockey* is just an attempt to create a bogeyman to distract the Court from the Eleventh Circuit’s own decision in this case—which is far removed from *Boston Hockey*. The criticized aspects of *Boston Hockey* had no impact on the Eleventh Circuit’s decision in this case. Instead, applying the settled likelihood-of-confusion analysis, both the district court and the Eleventh Circuit properly concluded that SCAD was entitled relief on this record. That fact-bound application of settled law does not conflict with the decision of any other circuit—and does not warrant further review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

W. ANDREW PEQUIGNOT
LISA FORTUNE MOORE
MOORE PEQUIGNOT LLC
887 W. Marietta St., NW
Suite M-102
Atlanta, GA 30318
(404) 748-9596
andrew@themoorefirm.com

GREGORY G. GARRE
Counsel of Record
ROMAN MARTINEZ
TYCE R. WALTERS
LATHAM & WATKINS LLP
555 Eleventh Street, NW
Suite 1000
Washington, DC 20004
(202) 637-2207
gregory.garre@lw.com

Counsel for Respondent

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