

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
July 29, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The University of Iowa and
The Board of Regents, State of Iowa

v.

The University of Southern Mississippi

Opposition No. 91164745
against Serial No. 76483437

Wendy K. Marsh and Kevin H. Collins of Nyemaster Goode West
Hansell & O'Brien, P.C. for The University of Iowa and The
Board of Regents, State of Iowa.

J.T. Martin for The University of Southern Mississippi.

Before Bucher, Kuhlke and Wellington, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

The University of Southern Mississippi (also "Southern
Miss," "USM" or "applicant") seeks registration on the
Principal Register of the following mark:



for goods identified in the application as:

"metal car tags, metal key chains, metal money clips, metal key rings and metal mailboxes" in International Class 6;

"electric, luminous, neon and mechanical yard signs, telephones, magnets, radios hung on ropes, hockey, safety and bicycle helmets" in International Class 9;

"clocks, precious metal money clips, watches, jewelry, namely class rings and ornamental lapel pins" in International Class 14;

"bumper stickers, windows decals, paper car flags, bank checks, paper banners, paper pennants, greeting cards, post cards, graduation announcements, paper weights, stationery, binders, note books, and stationery-type portfolios" in International Class 16;

"umbrellas, backpacks, wallets, brief-case type portfolios" in International Class 18;

"pillows, diploma frames, picture frames, stadium seats, plastic banners, non-metal key chains, plastic car flags, non-metal money clips, non-metal mailboxes, plastic and non-metal key rings, plastic pennants and non-metal car tags" in International Class 20;

"plastic beverage containers, mugs, glass beverage containers, ice buckets, salt and pepper shakers, birdhouses, pottery dinnerware, dinnerware including plates and cups, insulated sleeve holders for beverage cans" in International Class 21;

"afghans, towels, knit stadium blankets, cloth and felt pennants and cloth banners" in International Class 24;

"t-shirts, polo shirts, sweaters, jerseys, wind suits, warm-up suits, rainwear, sleepwear, lingerie, neckwear, infant apparel, baseball caps, headwear, socks, gloves,

ties, golf shoes and outerwear, namely, jackets, ponchos and overcoats" in International Class 25;

"doormats" in International Class 27;

"footballs, basketballs, Christmas tree ornaments, plush toy mascots, balloons, beanbags and stuffed toys" in International Class 28; and

"bottled drinking water" in International Class 32.¹

The University of Iowa and The Board of Regents, State of Iowa (hereinafter "opposers" or simply "Iowa") have opposed registration of applicant's mark, asserting as its ground for opposition, likelihood of confusion, namely that as used in connection with applicant's goods, the mark so resembles Iowa's previously used and registered marks shown below:



for "entertainment services-namely, presenting athletic events at the university level" in International Class 41;²

¹ Application Serial No. 76483437 was filed on January 21, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The drawing is lined for the color gold, but color is not claimed as a feature of the mark. On November 17, 2006 (subsequent to the filing of this notice of opposition), applicant filed a Statement of Use (SOU). Once an application has been published for opposition, a SOU may not be filed until after the issuance of a notice of allowance. See Trademark Rule 2.88 (A statement of use that is filed prior to issuance of a notice of allowance is premature, will not be considered, and will be returned to the applicant). Therefore, we have given no consideration to this document.

² Registration No. 1312703 issued on January 1, 1985; renewed. The mark consists of a fanciful representation of a hawk's head.



for "items of jewelry and wrist watches" in International Class 14;
"stationery and wrapping paper and checkbook holders" in International Class 16;
"wallets, attaché cases, waist pouches, and all-purpose sports and athletic bags" in International Class 18
"decorative novelty buttons and emblems" in International Class 20;
"beverage glassware" in International Class 21;
"flags and banners made of cloth and fabric" in International Class 24;
"wearing apparel; namely, aprons; infant wear; namely, bibs; bandannas and scarves; sport coats and vests; outerwear; namely, coats, jackets, parkas, gloves, mittens and scarves; shirts, jerseys and blouses; underwear; pajamas and robes; footwear including socks and athletic shoes; headwear; sweaters; neckwear; shorts; and sweat suits, pants and shirts" in International Class 25;
"sporting goods and toys; namely, basketballs; footballs; game boards and puzzles; golf clubs, bags and balls; toy stuffed animals and dolls; fishing lures; toy planes, trucks and cars; football helmets; toss toys; bowling pins; pool and cue balls; and toy banks" in International Class 28;³ and



for "entertainment services, namely, presenting athletic events" in International Class 41;⁴

³ Registration No. 1772928 issued on May 25, 1993; renewed.

⁴ Registration No. 2616009 issued on September 3, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Under this same section of the Lanham Act, Iowa has also alleged likelihood of confusion with its previously used common law marks (¶¶ 3 and 5 of the Notice of Opposition) which are the same marks as those registered but are presented in the color yellow, on many other goods. Further, to the extent that opposers' prior common law usage of the marks shown below for the pleaded goods and services was not fully articulated in the pleading, it was tried by implied consent and we deem the pleadings as amended to assert these marks.



Applicant has filed an answer denying the salient allegations of the notice of opposition.

Evidentiary Issues

Before addressing the merits of the case, we turn to numerous objections that each of the involved parties has filed against its adversary herein.

Opposers' objections to Testimony Depositions of survey participants Willingham, Mundheim, Paglomutan, Grillo and Shuler, and all of the related exhibits

USM elicited testimony in 2010 from a number of Iowa's earlier survey participants⁵ regarding their respective declarations from 2009. We agree with Iowa that USM attempted to elicit testimony from each of these witnesses regarding their memory of declarations signed by the witnesses much earlier, but the referenced declarations were not before the witnesses during their respective depositions. Nonetheless, we do not find it necessary to exclude these depositions in their entirety. Rather, we have accorded them limited probative value. In our analysis of likelihood of confusion, *infra*, we have given only limited weight to opposers' survey results, and consequently, these depositions are less important.

Opposers' objections to Testimony Deposition of Kathleen Hayman ("TD-Hayman") 4:1-36:8 and Expert Report of Kathleen Hayman (Applicant's Exhibit Q) i.e. lay witness, expert witness, or neither?

Ms. Hayman has clearly demonstrated her first-hand knowledge about the purchasers of collateral products from applicant's bookstore in Hattiesburg, MS, over a period of many years. However, we agree with Iowa that Ms. Hayman does

⁵ As noted later in this opinion, in support of this litigation, Iowa commissioned a mall intercept survey involving interviews with several thousand participants at shopping malls in Dallas, Des Moines, Los Angeles, Orlando and Phoenix.

not qualify as an expert in this proceeding as contemplated by Fed. R. Evid. 702. On the other hand, we accord her personal opinions about USM's eagle head mark the same value as we would any other of USM's lay witnesses, pursuant to Fed. R. Evid. 701.⁶

Opposers' objections to Testimony Depositions of court reporter, Nancy Farris, regarding a conversation she had with a third party, Mike Banning, as well as a written declaration of Mike Banning (Exhibit PP) introduced by applicant during this deposition

USM elicited testimony from its court reporter, Nancy Farris, regarding a conversation that she had with Mike Banning - an earlier participant in Iowa's mall intercept survey - who USM was attempting to depose. During this deposition, USM's counsel also questioned Ms. Farris about a written declaration of Mr. Banning given in 2009. Iowa objected to this testimony on the basis of hearsay and to Mr. Banning's 2009 declaration on the basis of hearsay and as lacking proper foundation.

We agree with opposers that Ms. Farris's recounting of her earlier conversation with Mr. Banning outside the presence of the parties, and the statements in Mr. Banning's declaration, clearly constitute hearsay and are inadmissible. See *Blansett Pharmacal Co. v. Carmirick Laboratories Inc.*,

⁶ We note that Exhibit 1 (2001) to Exhibit Q (2008) was drafted in the context of a totally unrelated matter preceding USM's adoption of the involved eagle head logo (2003), and has absolutely no relevance to this case.

25 USPQ2d 1473, 1476 (TTAB 1992) [statements attributed to others are hearsay].

Opposers' objections to that portion of the Testimony Deposition of Mr. Fitts as to third-party trademarks and various exhibits (Applicant's Exhibit 1-6 as well as Exhibits DD and EE) on the ground of relevancy.

We deem neither this testimony nor the third-party trademarks as outcome determinative, and therefore choose to let these into the record without further discussion of these objections.

Applicant's objections to the record including the various Notices of Reliance that were offered by Opposers during the period of suspension for Opposers to take depositions by written questions

Southern Miss objects to all of Iowa's evidence introduced in its notices of reliance on the basis they were offered "on dates outside of Opposers' Testimony Period, which was reset to begin on April 1, 2010 and conclude on May 1, 2010." (Applicant's Brief, p. iv(2)).

Accordingly, it would seem that the basis for objection to Iowa's Notices of Reliance is that they were submitted prior to the technical opening of Iowa's testimony period. However, we recognize the confusion in the timing of Iowa's testimony period created by the depositions upon written questions. Applicant's objection to opposers' premature filing of the notice of reliance is a procedural objection

that should have been raised promptly to permit the defect to be cured. However, Southern Miss waited nine months to raise this matter until the time of its brief on the case. If, as here, the objection is one that could have been raised promptly, and was not timely raised, the objection is deemed waived. TBMP Section 707.02(b) (3rd ed. 2011). As a result, we hold that opposer waived its objection to Iowa's premature filing of a notice of reliance.

Applicant's motion to strike opposers' Separate Statement of Objections for exceeding the number of pages allowed for Opposers' Trial Brief.

We find that Iowa's main brief at trial complies with all requirements of Trademark Rule 2.128(b). The brief itself is forty-four pages.⁷ Under our practice, an appendix or separate statement of objections, as Iowa submitted, does not count toward the brief page limit. See TBMP § 801.03, citing to *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) [appropriate evidentiary objections may be raised in appendix or separate paper rather than in text of brief]; and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

⁷ We do not count the ESTTA cover sheet, the certificates of mailing, or Exhibit 1 (at 47-83 of TTABVUE #131 - the slip opinion from Opposition Nos. 91160755 and 91160763) See *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187 (TTAB 2007).

Applicant's motion to strike opposers' reply brief as untimely

Opposers filed their reply brief on January 6, 2011 and served a copy on counsel for Applicant by first-class mail on the same date. Applicant argues that under Trademark Rule 2.128(a)(1), Iowa's reply brief was required by to be filed by December 28, 2010. Iowa's counsel explains that it inadvertently logged the due date as January 12, 2011 (thirty days after USM's brief rather than the fifteen days of the rule) and believed its reply brief had been timely filed.

Accordingly, Iowa's reply brief was filed nine days after the date upon which it was required to be filed by the Trademark Rules of Practice. Contrary to applicant's assertions, the record does not show that Iowa has taken a "cavalier attitude toward the procedural rules of practice" of this Board. The reasons for years of pendency of this litigation cannot be laid solely at the doorstep of opposers. Furthermore, in reviewing this litigation, the Board has not always held applicant "to the strict letter of the procedural rules in this opposition" during past procedural skirmishes.

On the other hand, the nine-day delay in filing Iowa's reply brief was within Iowa's control. Although it is clear that this docketing error on the part of Iowa's counsel clearly did not occur in bad faith, we cannot tolerate missed deadlines inasmuch as this tribunal is constantly under

pressure to reduce the length of our proceedings. This is a case where we must require strict compliance with our rules, and hence, we have not considered opposers' reply brief.

Evidence of record

In addition to the pleadings, the file of opposed application Serial No. 76483437 is part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

Opposer has made the following evidence of record: the Testimony Deposition of Lonnie Shoultz taken January 20, 2010, with Shoultz Exhibits 1-3; the Testimony Deposition of Dale Arens taken January 27, 2010, with Arens Exhibits 1- 23; the Testimony Deposition of Gary Barta taken January 28, 2010, with Barta Exhibits 1-2; the Testimony Deposition of Philip Houle taken January 29, 2010, with Houle Exhibits 1-3; opposers' Notice of Reliance and Exhibits 1-9 (Paper No. 103); opposers' Supplemental Notice of Reliance and Exhibits 10-32 (Paper Nos. 104-106); the Testimony Deposition of Doug Brown taken September 1, 2010, with Brown Exhibits 1-2 (opposers' Exhibits 33-34); and the Testimony Deposition of Theresa Laree Grantham taken September 1, 2010, with Grantham Exhibits 1-2 (opposers' Exhibits 33-34).

Applicant has made the following evidence of record: the Testimony Deposition of Rodney Richardson taken June 9, 2010, with applicant's Exhibits A-L; the Testimony Deposition of Kathleen Hayman taken June 10, 2010, with applicant's Exhibits M-R; the Testimony Deposition of E. Eugene Fitts, II taken June 11, 2010, with applicant's Exhibits S-FF; applicant's Notice of Reliance dated July 6, 2010 and accompanying evidence; the Testimony Deposition of Rocky Willingham taken June 22, 2010, with applicant's Exhibit GG; the Testimony Deposition of Paul Mundheim taken June 23, 2010, with applicant's Exhibit HH; the Testimony Deposition of Dee Dee Galvao taken June 23, 2010, with applicant's Exhibit II; the Testimony Deposition of Tom Younger taken June 29, 2010, with Applicant's Exhibit JJ; the Testimony Deposition of Royce Paglomutan taken June 29, 2010, with applicant's Exhibit KK; the Testimony Deposition of Thomas Grillo taken June 29, 2010, with applicant's Exhibit LL; the Testimony Deposition of Joseph Fink taken July 1, 2010, with applicant's Exhibit MM; the Testimony Deposition of Don Delici taken July 7, 2010, with applicant's Exhibit NN; the Testimony Deposition of Daniel Shuler taken July 22, 2010, with applicant's Exhibit OO; and the Testimony Deposition of Nancy L. Farris taken July 28, 2010, with applicant's Exhibit PP.

The Parties

Opposers/Iowa

The University of Iowa, in Iowa City, has been using the Hawkeyes mark of Registration Nos. 1312703 and 1772928 for over thirty years in connection with its NCAA athletic events and on a variety of collateral goods including clothing, sporting goods and novelty items. The Iowa Hawkeyes play in the Big Ten Conference, with a hundred plus years of tradition of competitive intercollegiate athletic programs with Illinois, Indiana, Michigan, Michigan State, Minnesota, Ohio State, Penn State, Purdue and Wisconsin. This provides Iowa ready access to all the largest media markets through CBS Sports, ABC/ESPN, the Big Ten Network and CBS College Sports Network. In 2001, Iowa also began using a second, similar Hawkeyes mark (Registration No. 2616009) in connection with all the same goods and services.

These Hawkeyes marks are used by all of the intercollegiate athletic teams that play for Iowa. Although color is not claimed in the registrations of record, both Hawkeyes marks are frequently used in a black and/or gold color scheme, reflecting the University of Iowa's school colors. These marks are placed prominently on the university's playing fields, stadiums, arenas, on its website,

on flags and banners hung at athletic games, and at a wide variety of events associated with collegiate sports. At right is a depiction of Iowa's mark on the floor of Carver-Hawkeye Arena.



Similarly, the Hawkeyes mark has also been used on Iowa's



football helmets for more than thirty years.

In fact, based on its long, competitive traditions, opposers allege that this iconic

university symbol is one of the most widely recognized logos in all of collegiate athletics. Between the designs as registered and used, the following four Hawkeyes images are predominant:



Applicant/Southern Miss

The record contains a brief retrospective on the origins of the Southern Miss school colors and the evolution over the years of its team names, such as Tigers, Normalites, Yellow Jackets, Confederates, Southerners, and General Nat; and in 1972, Golden Eagles beat out Raiders, War Lords, Timber Wolves and a reprise of Southerners.

Black and gold have been Southern Miss' colors since the beginning, thanks to Florence Burrow Pope, who, with her husband Moran, was in the school's first class in 1912.

Soon after school opened, a committee was appointed to make recommendations concerning school colors. Florence was on the committee. "We were charged with selecting colors which no other college in Mississippi had adopted," she said. "Marye Miller suggested that the colors be maroon and gray. I suggested that they be black and gold. The two suggestions were submitted to the student body, and the student body voted to have black and gold as the school colors."

Since that day, mascots, names, customs and the campus have changed, but black and gold have remained the school's colors.

...

The earliest nickname for the University's athletic teams was Tigers, but early teams were also referred to as Normalites. Then, in 1924, our teams' name was changed to Yellow Jackets.

When the school was renamed Mississippi Southern College in 1940, a name change for the athletic teams was fitting. In April 1940, the student body voted to name the teams Confederates. The teams were called the Confederates during fall 1940 and spring 1941. In September 1941, Confederates was dropped, and the teams were named Southerners.

Several years later, in 1953, General Nat (for Gen. Nathan Bedford Forrest) was approved as the Southerners' mascot. In 1972, alumni, faculty, students and staff were asked to submit new names for the athletic teams, and an ad hoc committee appointed by the Alumni Association voted on the submissions. Our present mascot, the Golden Eagles, was chosen as the athletic teams' name. Golden Eagles was chosen over Raiders, War Lords, Timber Wolves and Southerners.

The record shows that until 2002/2003, the mascot design used by Southern Miss was a full eagle sometimes called the "attack eagle."

However, in an era of ever-increasing emphasis on collateral products and



television imagery, Rodney Richardson, a 1994 graduate of USM and the owner of a graphic design firm in Hattiesburg, MS, in 2001 proposed the creation of a new athletic mark for the University of Southern Mississippi. According to Richardson,

[The attack eagle] was a very, very difficult logo to execute in game day and retail product. It was – from a licensing standpoint, it is very difficult to embroider that logo. It is very difficult to screen

print it in certain applications. It is not a product-friendly graphic.⁸

Mr. Richardson suggested replacing the image of a full eagle with the head of an eagle to derive a "more product-friendly graphic."⁹ During 2002, his company, Rare Design, presented at least nine phases of imagery for consideration by USM as the selection project progressed. The general directions of the folios from each stage of the project give some indication of the modernization process. With Phase 1, on April 4th, "Design Direction: 2 - Contemporary South" shows a series of largely angular-looking eagles, the majority left-facing and having the words "Southern Miss" as part of a composite mark.¹⁰ Phase 2,

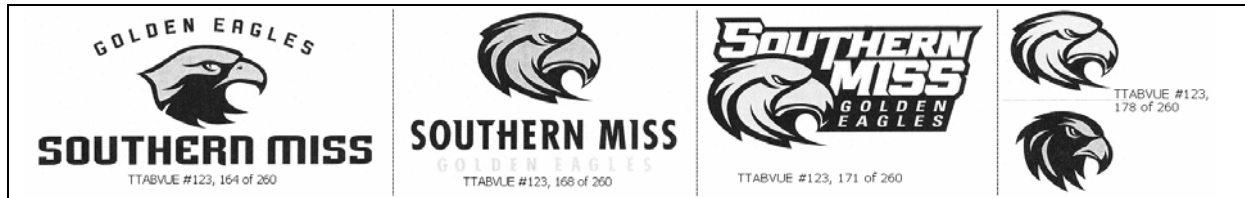
on May 1st shows an elongated and angular eagle head placed



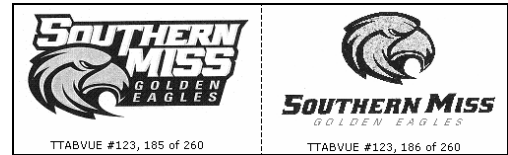
in composite marks where the image of the bird head is relatively small compared with the literal elements "Southern Miss" and "Golden Eagles." Phase 3, on May 20th, shows a less angular, larger and more rounded eagle head, but in most of the "marks" or "primary logo" presentations, the school name and mascot identification remain as prominent features. One exception is the "icon" imagery, at the far right below.

⁸ Rodney Richardson deposition of March 22, 2006, at 23.

⁹ *Id.* at 24.



In Phases 4-5, with images dated July 3rd, the words are still dominate within the composite marks,



revealing only new variations on typefaces from the Phase 3 images seen above. Phase 6, dated July 31st,¹¹ and Phase 7, dated August 23rd,

continued the eagle head imagery above



the terms "Southern Miss" and "Golden Eagles," making further changes only in fonts/typefaces. Likewise, the presentations of October 24th and November 12th continued with an earlier eagle head design, as shown.



After almost a year of development, on January 29, 2003, the record shows that a "New Golden Eagle Comes to Roost at Southern Miss."¹² At a press conference, Southern Miss unveiled a sleek, new and modern eagle head mark, standing alone, without any wording. At the same time, and in a move

¹⁰ TTABVUE #123, at 137 of 260. These left-facing drawings, as placed into the record, are black-and-white images. Later phases of development involved the right-facing images shown above.

¹¹ See TTABVUE #123, at 192 and 193.

¹² Applicant's Appendix I, Richardson Testimony exhibit.

seemingly not discussed anywhere in this ongoing process, applicant also unveiled a unified color scheme, choosing a much more vibrant shade of golden yellow than the "Vegas Gold" seen in the old Southern Miss's attack eagle.



According to applicant, almost immediately the number of vendors of applicant's merchandise increased dramatically, and the eagle head mark suddenly became USM's "best selling logo."¹³

Standing and Priority

Because opposers have properly made their pleaded registrations of record, and thereby have shown that they are not mere intermeddlers, we find that opposers have established their standing to oppose registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); see also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Moreover, because opposers have made the pleaded registrations summarized above properly of record, Section

¹³ Kathleen M. Hayman testimony deposition, at 21.

2(d) priority is not an issue in this case as to the marks and goods and services covered by said registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposers have shown, through an extensive record that includes catalogues, websites and other documentation, that they established prior common law trademark rights in the Hawkeyes marks in the color yellow, as depicted above. Opposers' common law rights extend to a wide variety of goods for which it pleaded common law rights, including college apparel such as polos and rugbys, house wares, posters, prints, tailgating supplies, CDs, DVDs and books, pet accessories, and popular college bookstore items for sports fans and alumni. Accordingly, our likelihood of confusion analysis includes not only the registered marks and goods covered by said registrations, but also the Hawkeyes marks, in yellow, for the various goods identified in the record.

Likelihood of Confusion

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours &*

Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The renown of the prior mark

Opposers have been using these Hawkeyes marks, including in the color yellow, for over thirty years in connection with athletic events and on a variety of goods and services including clothing, sporting goods and novelty items. Comparing the recognition of Iowa's collegiate athletics program with that of Southern Mississippi, applicant's own witness admitted that "the stage that [Iowa] would play on would allow greater recognition [than Southern Miss]." ¹⁴ The Hawkeyes football team has made appearances in eleven post-season bowl games in the past fifteen years, including the Orange Bowl in January 2010. ¹⁵ While opposers have not alleged, and do not make the argument, that Iowa's marks are "famous," based upon revenues generated by the licensing of its marks, Iowa's long history in Big Ten Conference athletics and NCAA post-season play, and the degree of television exposure throughout each calendar year given to the Hawkeyes marks, we find that they are at least well-known in the field

¹⁴ Testimonial deposition of Rodney Richardson at 24.

¹⁵ Arens testimony deposition at 12.

of national collegiate athletics and, as such, must be accorded a wider scope of protection.

We turn then, to consider the *du Pont* factors of the relatedness of the goods and services, channels of trade and classes of purchasers. We must make our determinations on these factors based on applicant's goods as they are identified in the application. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ["The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."]

Relationship of the goods and services:

Both parties in this proceeding operate large NCAA collegiate athletic programs. We agree with the thrust of applicant's argument that each of these universities is best known within their respective regions of the country and among the universities within the respective conference in which each school plays many of their intercollegiate sports. However, the record also shows the degree to which Iowa is

afforded regular nation-wide exposure via several different sports programs and networks.

In addition to their popular entertainment services, the record demonstrates the variety of broad categories of goods for which the Hawkeyes marks are licensed. These collateral goods include almost "everything you can imagine" - apparel,

headwear, footwear, sporting goods, gifts,

luggage and sports bags, wallets,

umbrellas, novelties and holiday items,

jewelry, watches, clocks, toys and games,



¹⁶

www.memorycompany.com

house wares, office and school supplies, printed items, auto accessories, consumables, and tailgating and other promotional items such as flags and banners.

In reviewing the collateral goods that applicant has identified in the dozen classes of its application, we find that opposers have shown, both by the submission of registrations, and with their common law rights through the prior use of the Hawkeyes marks in marketing goods, both legally identical goods and those otherwise closely related to Southern Miss's goods in International Classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28 and 32. Specifically, opposer has demonstrated common law rights through use of its yellow Hawkeyes mark on the following goods, *inter alia*, college

¹⁶ Arens Exhibit-13.

apparel such as polos and rugbys, house wares, posters, prints, tailgating supplies, CDs, DVDs and books, pet accessories, and popular college bookstore items for sports fans and alumni. Based upon this evidence, we find that the second *du Pont* factor weighs strongly in favor of a finding of likelihood of confusion.¹⁷

The similarity of trade channels

We further find that these identical goods are or would be marketed in some of the same trade channels to identical classes of customers. To be sure, the parties' respective goods will have been marketed in campus stores and through other means that would be particular to each institution. However, none of applicant's listed goods and none of opposers' goods or services listed in their registrations, have any limitations or restrictions as to the trade channels or purchasers for the goods and services, and we therefore presume that the identified goods include all trade channels

¹⁷ We note that although Southern Miss's application does not list any entertainment services, the record shows nearly identical usage on the respective schools sports' venues, cheerleaders' uniforms, football helmets, basketball court, and ESPN programs. After all, it is through exposure to these sports entertainment services that the universities gain goodwill in the marks emblazoned across every kind of collateral product one can imagine.

for such goods, especially national sporting goods outlets, and online merchants of collegiate paraphernalia.¹⁸

Opposers and applicant are both prominent NCAA Division I universities having potential nationwide markets for their collegiate merchandise and each having aggressive promotional outlets through popular sports television exposure on networks like ESPN, fan clubs and product licensees available through many websites on the Internet.

The fact that opposer applies its marks to a variety of sports products [and services] makes it more likely that purchasers, aware of opposer's use of the mark on a variety of sports products [and services], when seeing a similar mark used in connection with [the goods offered by another], are likely to believe that these products are also being produced or sponsored by opposer.

Nike, Inc. v. WNBA Enterprises, LLC, 85 USPQ2d 1187, 1195 (TTAB 2007).

Applicant's own witness concedes that there are clear examples of an overlap in the parties' respective channels of trade.¹⁹ For example, Conference USA (applicant's conference) and the Big Ten Conference (opposers' conference) have merchandise available on the same websites.²⁰ Brick-and-mortar retailers across the country such as Wal★Mart, Target, Kohl's,

¹⁸ Even if it were possible at this late stage of the litigation to amend applicant's identification of goods to restrict the channels of trade or classes of purchasers (as suggested in applicant's brief), Iowa's registrations would still have no restrictions, and hence, we would still be compelled to find an overlap of channels of trade and classes of purchasers.

¹⁹ Accord Testimonial deposition of Rodney Richardson at 39-41.

Dick's Sporting Goods, Nike, Tailgate and Titleist, among many others, carry nearly identical goods of both parties.²¹ As a result, we conclude that this *du Pont* factor favors Iowa's position on likelihood of confusion.

Conditions of Purchase

The fourth *du Pont* factor requires us to consider evidence pertaining to the buyers to whom and the conditions under which the goods are marketed. We find based upon the evidence that the majority of the items identified in Iowa's registration or shown to be covered by common law marks are relatively inexpensive items.

We note that a mark appearing on collegiate sports teams' merchandise usually serves as an indication of secondary source. That is, it refers to or identifies the school or the team itself. The purchaser's decision to purchase the product is not based on who actually manufactured the product, but rather is based on the ornamental presence of the secondary source mark on the product. The decision to purchase arises from the purchaser's desire to demonstrate his or her allegiance to, or affiliation with, that secondary source (the school or sports team), or if the purchaser is purchasing the product as a gift, to allow the gift recipient to demonstrate

²⁰ See <http://www.teamfanshop.com/>, Arens Exhibit-9.

²¹ *Id.* at 11.

that allegiance or affiliation. These more casual purchasers, upon encountering Southern Miss's mark, are likely not to engage in a close inspection of the mark, but buy the product on impulse.

The most enthusiastic fans (e.g., students, faculty, staff and alumni) of collegiate athletic teams likely are knowledgeable about a particular school's trademarks and, hence, will exercise a degree of care in looking for and making their decisions to purchase collateral goods. This will certainly include Golden Eagles fans around Hattiesburg²² and Hawkeyes fans in the vicinity of Iowa City. Perhaps not surprisingly, in opposers' mall intercept survey in Iowa, many of the respondents said that Southern Miss's new Golden Eagle called to mind their familiar Hawkeyes, but expressed some misgivings because they recognized differences with USM's design. However, we must proceed on the presumption that these sophisticated purchasers are not the only purchasers of applicant's and opposers' goods. Rather, we find that purchasers of collegiate merchandise include those who are not necessarily attuned to minor differences between somewhat similar sports teams' logos. As noted above, this population includes persons such as relatives or friends who are purchasing the goods as gifts. These less knowledgeable

²² Kathleen M. Hayman testimony deposition, at 19-23, 27-32.

purchasers also would include new or casual fans nationwide who are likely to purchase a school's athletic merchandise in years in which the school's sports teams win national championships or are otherwise especially successful on a national level. Such new purchasers are less knowledgeable than the school's more longstanding fans that would be much more familiar with the school and its trademarks.²³ In short, although some purchasers of the parties' goods will be knowledgeable fans who are likely to notice if a logo is different from the team logo to which they are accustomed, there are others who may not be so perceptive about subtle differences between the logos of sports teams. These less knowledgeable purchasers are likely to exercise a lesser degree of care in purchasing the goods given the inexpensive nature of many of the products sold under the marks. In selecting the applicable standard of care, we are constrained to make our determination based upon the least sophisticated consumers. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). For all of the reasons discussed above, we find that the *du Pont* factor focusing on the conditions of purchase weighs in favor of a finding of likelihood of confusion.

²³ *Id.*

Against this backdrop, specifically, the renown of opposers' marks and the legally identical nature of the parties' respective goods, we consider the similarities and dissimilarities of the marks. The greater the degree of renown of the senior user's mark, the lower the tolerance of the Lanham Act for similarities. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) [" ... there is 'no excuse for even approaching the well-known trademark of a competitor'"]; and *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992) [where the goods are identical, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines."].

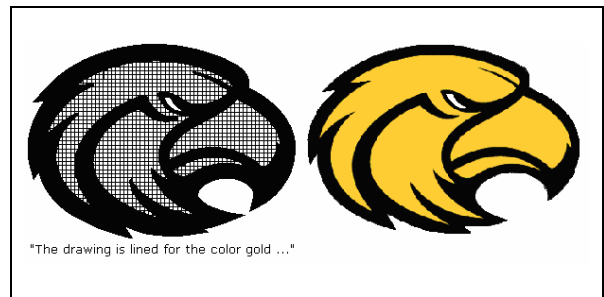
Similarity of the marks

We now turn to consider the similarity or dissimilarity of the marks when compared in their entireties. Iowa asserts rights in both its registered marks and its common law marks, wherein the hawk logo is



depicted in the color yellow. Although applicant does not claim that color is a feature of its applied-for mark,

applicant has depicted its mark in the color gold in both the drawing and the lining statement of its application. In actual usage,



its Golden Eagle mark is identical to the yellow color of Iowa's Hawkeyes marks for which opposers have demonstrated prior common law rights.

As to this *du Pont* factor, it is applicant's contention that the respective marks create radically different commercial impressions. Specifically, applicant argues that each of the Iowa Hawkeyes marks is a collection of four separate silhouette shapes put together in close proximity creating a two dimensional image that is then displayed against backgrounds of changing colors. Applicant suggests that each Iowa's Hawkeyes mark has the simplicity of a stenciled or stamped image. By contrast, Southern Miss argues that its new eagle head is more complex, having the "fierce eyed gaze of independence" and the "black peak of the beak" to create a "symbol of courage and power" reminiscent of "Roman soldiers ... going into battle [with] a crimson banner with a golden eagle emblazoned on the banner."

However, in reviewing this extensive record, we are not persuaded that these alleged distinctions between the marks are significant when the respective marks are compared in their entireties. Granted, the parties' respective marks are not identical when dissected into their component parts and the minute details of each part are compared with other parts. See *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

However, in the normal marketing environment, purchasers would not usually have the luxury of examining marks in such minute detail. Hence, it is well-settled that the test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impressions such that confusion as to the source of the goods and services offered under the respective marks is likely to result. Ordinary purchasers who are familiar with opposers' marks on collateral goods, upon later encountering applicant's mark on identical collateral items, would not necessarily remember fine details about the mark they had previously seen, given consumers' imperfect recall, and they are likely to remember the marks as being essentially the same.

We know that the average purchaser is not infallible in his/her recollection of trademarks and often retains only a general, rather than a specific, recollection of marks that may previously have been seen in the marketplace. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). When, as here, the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. Design marks without any wording may be particularly difficult to recall clearly and may therefore be somewhat more likely to result in confusion when used for the same or similar goods. *See In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) [the silhouette of two profiles



facing right within a teardrop background is confusingly similar to a silhouette of two profiles facing left in an oval background]; *In re Steury*



Corp., 189 USPQ 353 (TTAB 1975) [for recreational vehicles, a

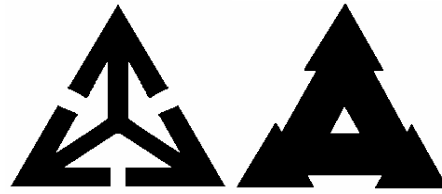


design consisting of three horizontal bars is confusingly similar to a design



of two horizontal bars]; and *Matsushita Electric Industrial*

Co., Ltd. v. Sanders Associates, Inc., 177 USPQ 720 (TTAB 1973)
[for electrical equipment, two



triangular arrow designs are confusingly similar].

In the case at hand, we find that the visual resemblance of these respective marks is much closer than applicant contends. Furthermore, as noted above, in cases such as this, where applicant's goods are virtually identical to the opposers' goods, the degree of similarity between the marks that is required to support a finding of likely confusion is less than it would be if the goods were not identical.

Century 21 Real Estate Corp., 23 USPQ2d at 1701.

It is in this context that we find that the commercial impressions of the marks are essentially the same. Both parties' marks present the head of a bird of prey facing right, and basically oval in shape. Both contain identical colors. These images are very similar to each other in style and proportion. They both involve a bold profile image of the head of a large bird. That Southern Miss's eagle may be a bit more literal and fierce than Iowa's original Hawkeyes mark does not overcome the overall similarities. Furthermore, applicant's argument that its mark is "complex" while opposers' marks are stencil-like does not persuade us that consumers will note the difference in the marketplace.

The general rule is that in an opposition, the background trade dress of applicant is not to be considered as a means for distinguishing marks because the trade dress is not part of what applicant seeks to register and could be changed. However, the Board must try to visualize the mark as it may be used in the marketplace, and in this case, the record illustrates the mark as actually used by applicant will be even more similar to opposers' marks. See *Kenner Parker Toys*, 22 USQP2d at 1458 ["The trade dress of the marks enhances their inherently similar commercial impression"]. The respective images taken from various catalogues and online sources accentuate the strong similarities.²⁴



In evaluating the likelihood of confusion, we may take into account whether the trade dress in evidence demonstrates that the applicant's trademark projects a confusingly similar commercial impression. *Specialty Brands, Inc. v. Coffee Bean*

²⁴ See 3 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20.15 (4th Ed. 2010).

²⁵ See TTABVUE #104 at 118, 119 126 & 128 of 149, and TTABVUE #107 at 141, 142, 143, 149 & 152 of 173.

Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) [Applicant's labels for SPICE VALLEY spices depicting a sailing vessel negates applicant's claim that its mark conveyed a different commercial impression from that of SPICE ISLANDS]; and *American Rice, Inc. v. H.I.T. Corporation*, 231 USPQ 793 (TTAB 1986) [the "contest award" ribbon device on applicant's package undercuts applicant's argument that its mark conveys a different commercial impression].

In sum, the overall similarity in appearance of the marks on the goods, particularly in light of the use of identical color schemes, creates virtually identical commercial impressions. The points of similarity strongly outweigh the minor dissimilarities. *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161, 163 (D.C. Cir. 1956). Hence, we find that opposers have shown a similarity in these parties' respective marks that favors a finding of likelihood of confusion.

The number and nature of similar marks in use on similar goods.

Defendants in *inter partes* cases often attempt to whittle down the scope of protection of the plaintiffs' marks. And this is clearly a legitimate inquiry under the sixth *du Pont* factor. However, Iowa, as the owner of marks registered on the Principal Register, is entitled to a presumption that the marks are valid and distinctive. 15 U.S.C. §§ 1057(b),

1115(a) [marks registered on the Principal Register are entitled to certain presumptions, including presumption of validity and use]. In the present case, it is undisputed that Iowa's marks are arbitrary as the designs certainly do not describe or suggest the relevant goods and services. Consequently, there can be no dispute but that Iowa's marks, on their face, are valid, distinctive and entitled to some scope of protection.

Nonetheless, applicant argues at some length that the relevant marketplace is replete with bird head designs, that the Hawkeyes mark resides in a crowded field, and that, hence, Iowa's Hawkeyes marks are quite weak. Under the sixth *du Pont* factor, it is appropriate that we consider the evidence of record pertaining to the number and nature of similar marks in use on similar goods. "The purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Most of the third-party marks highlighted by applicant involve eagle head or hawk head trademarks. The marks, in the form of sports team logos, were placed prominently on the

front of goods like caps and shirts. These items were ordered by Mr. Gene Fitts from various colleges and universities around the country during the course of this litigation (mostly 2006-07). Fitts deposition at 27, Exhibit DD3-20. Based upon this evidence, Southern Miss alleges that there are many other colleges, universities and even professional sports teams having logos similar to Iowa's marks, which organizations are offering similar goods through the same channels of trade. Southern Miss contends that the purchasing public is conditioned to distinguish slight differences between bird head design marks, and that even minute differences in appearance are sufficient to distinguish the marks from each other, allowing Iowa's Hawkeyes marks and Southern Miss's Golden Eagle mark to coexist without confusion. Iowa takes issue with applicant's persistent arguments that the Hawkeyes marks are weak.

We concur with applicant that birds of prey such as eagles and hawks are popular mascots for collegiate and professional sports teams. Hence, it is not surprising that fanciful representations of the heads of such birds commonly show up in service marks and trademarks owned by such enterprises.

Images of these majestic birds of prey tend to accentuate the strong, sharp beak, the fierce eyes and swept-back head

feathers. On the other hand, it does not necessarily follow that all marks incorporating images of birds will therefore be deemed weak. See *Playboy Enters., Inc. v. Chuckleberry Publ'g*, 486 F. Supp. 414, 429 (S.D.N.Y. 1980) [where a common subject has "been used in a suggestive as opposed to descriptive manner, courts have readily granted protection from similar marks"]. Iowa should be able to establish a reasonable zone of protection around its Hawkeyes marks in spite of the existence of many other representations of bird heads.

In spite of the fact the record has substantially no details about the sales, advertising, or media exposure of these various marks, and despite opposers' repeated objections, we turn to a closer examination of the logos that applicant has placed into the record.

We note that some of these composite marks contain other distinctive matter, including words. Where a composite mark contains literal elements (e.g., the university name, the team name or mascot, or even one or more letters), there is arguably much less chance of confusion - even among the most uninitiated of sports fans:



While applicant is correct that Central Methodist University's composite mark, above, includes "a graphic execution of separate shapes of a single color put together in proximity" (as applicant claims is the case for the original Hawkeyes mark), the similarities end there. This image is clearly in motion, is quite angular and very green, and the composite is dominated by the literal elements "Central Methodist University." Similarly, St. Joseph's University's mark, above, is red and is dominated by the word "Hawks."

²⁶ Eagles: Central Methodist University (Fayette, MO); the school colors are green and white; Fitts, Exhibit DD-3.

²⁷ Mountain Hawks: Lehigh University (Bethlehem, PA); the school colors are brown and white; Fitts, Exhibit DD-15.

²⁸ Thunderbirds: Southern Utah University (Cedar City, Utah); the school colors are red, white and black; Fitts, Exhibit DD-17.

²⁹ Purple Eagles: Niagara University (Lewiston, NY); the school colors are purple and white; Fitts, Exhibit DD-16.

³⁰ Redhawks: Seattle University (Seattle, WA); the school colors are red and white; Fitts, Exhibit DD-11 and 11A.

³¹ Hawks: St. Joseph's University; the school colors are crimson and gray.

Applicant also submitted for the record the logos of the Atlanta Hawks and the Philadelphia Eagles. These marks are clearly composed of images of a hawk and an eagle, respectively. A not unimportant distinction is that these Atlanta and Philadelphia teams are professionals in the NBA (basketball) and NFL (football), respectively, and professional sports organizations do not field teams in more than one sport. Moreover, the Philadelphia Eagles logo bears much more resemblance to the eagle marks of several smaller colleges (more *infra*), as well as Southern Miss's former logo (USM's "attack eagle") seen earlier -- than the Philadelphia Eagles logo bears resemblance to the bird head marks involved herein:



33



34



Philadelphia Eagles



Golden Eagles, University of Minnesota, Crookston



Eagles, Northwestern College



USM's "Attack Eagle"



Hawkeyes, 1979



Hawkeyes, 2001



Golden Eagle, USM, 2003

³² Golden Eagles: John Brown University (Siloam Springs, AR); school colors are royal blue and gold; Fitts, Exhibit DD-19.

³³ Atlanta Hawks of the NBA.

³⁴ Philadelphia Eagles of the NFL.

As to any other NCAA Division I schools having a hawk head or an eagle head design without any wording, we note the variety of possible designs, varying degrees of anatomical detail, and a variety of color combinations used by schools having a hawk or an eagle as the school's mascot:



When making a visual comparison between Iowa's Hawkeyes marks and each of these designs, we find that none of these Division I third-party marks remotely resembles Iowa's Hawkeyes designs. Certainly, none is as similar to Iowa's marks as is applicant's mark. Moreover, whether some of these third-party marks (e.g., those having commercial impressions

³⁵ Eagles: Eastern Michigan University (Ypsilanti, MI); the school colors are green and white; Fitts, Exhibit DD-5.

³⁶ Eagles: Winthrop University (Rock Hill, SC); school colors are garnet and gold; Fitts, Exhibit DD-13.

³⁷ Eagles: Georgia Southern University (Statesboro, GA); school colors are blue and white; Fitts, Exhibit DD-6.

quite distinct from the marks of Iowa and USM) are similar to each other is not relevant to our analysis, and has no bearing on the question of whether the marks in this case are likely to cause confusion.

In this vein, applicant includes information about the new "Golden Eagle Graphic" that Marquette University announced



³⁹

prospectively would be available on its merchandise on August 1, 2007. Although Marquette's design of a Golden Eagle head is arguably closer to Iowa's involved marks than is any one of the other third-party Division I university marks applicant has located (or even any one of the various other "Golden Eagles" of college teams displayed in this record), it does consist of Marquette's school colors of gold and navy blue. In any case, there is no evidence of record showing that the mark has actually been used by Marquette, let alone the extent of any such use. For this reason, we cannot consider this logo in assessing the sixth *du Pont* factor, which is the number of marks in *actual use*.

Even if the adoption of a quite similar mark to the Hawkeyes by one of the smaller colleges who do not compete in

³⁸ RedHawks: Miami University (Oxford, OH); the school colors are red and white; Fitts, Exhibit DD-18.

³⁹ Golden Eagles: Marquette University is located in Milwaukee, WI and is an NCAA Division I team in the Big East Conference. Fitts, Exhibit EE-1.

NCAA Division I intercollegiate sports were of concern to Iowa, we note that these design marks are quite different in color and overall appearance as well:



We find that these half-dozen marks are of little probative value under the sixth *du Pont* factor. Even if we were to assume that each of these schools sells collegiate merchandise bearing a bird head design mark, we find that these schools are unlikely to have had any measurable effect on the strength of Iowa's marks in the national marketplace, or any effect on the ability of relevant purchasers to distinguish between Iowa's and Southern Miss's bird head

⁴⁰ Golden Eagles: The University of Minnesota, Crookston campus; the school colors are maroon and gold; Fitts, Exhibit DD-7.

⁴¹ Eagles: The athletic teams of Northwestern College; the school colors include dark violet; Fitts, Exhibit DD-9.

⁴² Redhawks: The athletic teams of Southeast Missouri State; red is a prominent school color; Fitts, Exhibit DD-12.

⁴³ Warhawks: The University of Wisconsin-Whitewater campus; the school colors are purple and white; Fitts, Exhibit DD-14.

⁴⁴ Eagles: Robert Morris University Illinois; the school colors are maroon and gold; Fitts, Exhibit DD-20.

⁴⁵ Eagles: Chadron State College; the school colors are cardinal and white; Fitts, Exhibit DD-4.

design marks. The Board has in the past been unpersuaded by such an argument, even in a case when the involved design mark was found to be laudatory (unlike the current opposers' designs):

... By relying on the third-party star marks in the restaurant field, applicant would have us conclude that small variations in the star marks used in the field, including opposer's and applicant's marks, are sufficient to avoid confusion.

We have carefully considered the evidence of third-party use, but find that it is not persuasive to reach the result urged by applicant. We are not the least bit surprised that the word "star" and/or various star designs appear in connection with restaurants, as they undoubtedly do in connection with many other goods and/or services. That is to say, we recognize that a star design is a common shape, and that such designs, as well as the word "star", are laudatory in nature. Nonetheless, applicant's evidence of third-party use is balanced by opposer's evidence of its marks' considerable notoriety. We have no problem concluding that opposer's marks are strong, even in the face of applicant's evidence. ...

We see some other problems which limit the probative value of the evidence of third-party use. Many of the marks being used are less similar to opposer's marks than are applicant's marks. Further, applicant has not furnished any evidence regarding the extent of use of the marks by these third parties. The geographic locations of these restaurants, in many instances, are relatively obscure. Moreover, the pictures of these restaurants tend to indicate that the operations are small and local in nature.

In sum, the evidence of third-party use is of limited probative value to support applicant's position.

Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.,

35 USPQ2d 1125, 1131 (TTAB 1995)

We have reviewed carefully all of the third-party marks displayed throughout the record. We also note applicant's

emphasis on the number of bird head designs that are, like both Southern Miss's and Iowa's bird head design marks, right-facing images. We have considered the similarities and dissimilarities of each third-party mark in relation to the Hawkeyes marks as to overall design, the depth and complexity of the image, sharp corners and angular patterns versus soft, oval or rounded imagery, as well as the general shape, the proportions, the colors, the curvature of the head and beak, and the overall commercial impression conveyed by each design. We have compared the cumulative "look and feel" of each mark against that of the Hawkeyes marks. Indeed, as a result of this exercise, we reach a conclusion different from the one urged on us by applicant and that taken by the dissent herein - namely, that these third-party marks serve to demonstrate the myriad ways one can design a composite mark incorporating the imagery of a bird of prey without moving close to mimicry of opposers' marks. In spite of applicant's arguments to the contrary, we find that none of these third-party marks is as similar to the parties' marks as the respective marks are to each other.

Applicant argues that the Hawkeyes marks are generally oval in shape, and we agree. Yet while an oval shape does not characterize most of the third-party marks seen above, and does not describe most of the early stages of USM's year-long

modernization process, we note that the final design applicant selected and applied-for is, like Iowa's marks, fairly characterized as largely oval.

While the many third-party uses of bird head designs by other universities and colleges may narrow somewhat the scope of protection for Iowa's marks, making this one *du Pont* factor weigh slightly in applicant's favor, it is not sufficient on balance to overcome the other *du Pont* factors. In particular, while there may be a number of third-party universities having bird head logos, they can often be distinguished by a number of prominent characteristics,⁴⁶ but especially the colors employed. The evidence of record does *not* show the popularity among these third-party universities' marks of a combination of a vivid amber shade of yellow and black. On this point, we disagree with the conclusion of the dissent.

Opposers' claim there are multiple instances of actual confusion

Iowa points to nine specific examples, as set forth *infra* (footnote 47), in which it asserts that persons have been confused by the involved marks, and argues this actual confusion amounts to strong proof of a likelihood of confusion. See *e.g. In re Majestic Distilling Co., Inc.*,

⁴⁶ As noted earlier, these include the depth and complexity of the image, sharp corners and angular patterns versus soft, oval or rounded imagery, as well as the general shape, the proportions, the colors and the curvature of the head and beak.

315 F.3d 1311, 1317, 65 USPQ2d 1201 (Fed. Cir. 2003) ["A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion."]. We agree with Iowa that these examples serve to corroborate the strong similarity of the marks in that sports leagues, manufacturers, marketers and shared university licensees have been confused.⁴⁷

However, we also agree with applicant that most of the instances of confusion cited by Iowa do not involve actual consumers, and hence they are not strong evidence of confusion in the marketplace. Rather, as seen above in our discussion of the similarity in appearance and commercial impressions of the respective marks, these multiple examples are at least "illustrative of how and why confusion is likely." See *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975).

Opposers' Survey

Finally, in support of their case, opposers submitted evidence of likelihood of confusion drawn from an empirical

⁴⁷ We point specifically to the two eBay listings; Nike's jacket embroidered with Iowa's Hawkeyes logo but Southern Miss's school name; Knights Apparel's sending to Iowa a proof design for Iowa's approval that included photographs of a shirt having Southern Miss's mark; Iowa received a proof from Adidas Group, LLC, which incorrectly used Southern Miss's Golden Eagle mark to identify Iowa's team; and Press Pass Inc. sent Iowa proofs of collector trading cards displaying the Golden Eagle mark of Southern Miss.

survey conducted for this litigation. Opposers assert that the results of this survey strongly support a finding of likelihood of confusion.

Iowa commissioned a mall intercept survey involving interviews with a very large group of respondents (i.e., several thousand participants) at shopping malls in five geographically separate metropolitan areas (Dallas, Des Moines, Los Angeles, Orlando and Phoenix). Iowa claims that the survey indicates that the net measured likelihood of confusion is approximately 31%.

However, applicant attacks the probative value of opposers' made-for-litigation survey, contending that this work product suffers from several flaws in methodology and administration.

Upon review of the survey, we conclude that there are flaws in the manner in which the survey was conducted that diminish the reliability of Iowa's survey results. For example, based on testimony submitted by applicant, we cannot be sure that all participants were given identically prepared, color exhibits displaying the mark of the Texas Longhorns (the control) and/or the applied-for mark of the University of Southern Mississippi. Several of the survey administrators in the regional units contracted to run this survey may have sacrificed reliability with their intercept and interview

methodologies, as detailed in applicant's myriad criticisms. And finally, many of the survey results from Des Moines, for example, clearly reflected respondents finding similarity between the marks involved herein. However, the gist of several repeated statements was that although USM's Golden Eagle mark called to mind their well-known Iowa Hawkeyes mark, it was not that mark. This sophisticated response with the clear feel of "call to mind" associations cannot be correctly counted as an indication of consumer confusion. While the results that Iowa touts from this survey are indeed consistent with a finding of a likelihood of confusion, they are not reliable enough to play a significant role in supporting Iowa's case herein.

Any other established fact probative of the effect of use

It is appropriate to consider, under the thirteenth *du Pont* factor, applicant's intentions to adopt and use its claimed mark. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). The record establishes that applicant was aware of Iowa's Hawkeyes marks when it adopted its new mark. Even without any specific proof of intent to confuse,⁴⁸ its actions in adopting its mark are relevant. In this regard, we

⁴⁸ See *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783, 1789 (TTAB 2006).

focus specifically on the final months of USM's modernization effort of 2002.

During 2002, applicant spent an entire year on an extensive process-driven effort to update its primary mark. At the time of Mr. Richardson's internal presentation on November 12, 2002, the Rare Design final stage portfolio shows that a black-and-white image of the proposed eagle head was still paired with the words "Southern Miss" and "Golden Eagles." Yet at the press conference unveiling the new mark to the public, on January 29, 2003, USM had both moved toward a primary mark without any wording, and to a color identical to that of the Iowa Hawkeyes. The perception that USM's new mark was confusingly similar to Iowa's mark came up immediately at the press conference. The record has a variety of other anecdotes in the years since that day in January 2003 reflecting on the similarity between these respective marks.

The record clearly establishes that applicant moved much closer to Iowa's well-known marks with its 2003 mark which is the subject of its application. There were certainly a myriad of ways in which USM could have modernized its primary logo without moving so close to the well-known Hawkeyes marks. For example, even the bird head designs within a composite mark containing the words "Southern Miss" and "Golden Eagles," as contemplated in all the earliest iterations of Rare Design's

regular folios throughout 2002, certainly would have lessened the points of similarity with Iowa's marks.

In addition to adopting a bird head having overall design similarities, USM's new mark unveiled in January 2003 reflected a significant shift in color for applicant. Mr. Richardson's year-long study which is of record does not deal with this element of the modernization effort, namely, the change in color. Prior to 2002, applicant's attack eagle was a darker, fallow shade of moderate amber, sometimes called "Vegas Gold." Yet, if one looks carefully at the bird head design appearing on USM merchandise approved by the athletic department since 2003, applicant's eagle head appears in a light brilliant amber shade of yellow - substantially identical in shade and hue to Iowa's well-known common law uses of its luminous vivid amber Hawkeyes marks seen nationwide for years. Interestingly, while applicant indicated in its press releases of January 2003 that it was moving toward a uniform shade of "gold," the details of the school's official color palette contained in its graphic standards, and as used in print and digital media in non-athletic settings, is actually a shade of amber verging on orange rather than the vivid amber shade of yellow used by its athletic programs.

At the very least, we find that USM did not exercise care in the choice of this particular mark, and essentially ignored concerns and comments about how similar its new logo was to Iowa's marks.⁴⁹ This approach to mark development is a far cry from the conventional wisdom that there is "no excuse for even approaching the well-known trademark of a competitor."

Planter's Nut, 134 USPQ at 511. Accordingly, applicant's standard of care in adopting this particular mark enters into our likelihood of confusion determination herein under the final *du Pont* factor, and it weighs against applicant.⁵⁰

It is well established that as a newcomer, applicant had both the opportunity and the obligation to avoid confusion, and one who adopts a mark similar to the mark of another for related goods or services does so at his own peril. *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976). This is especially relevant where the senior, established mark is one that is well known in the field. *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989).

⁴⁹ Taken in its entirety, the record presents various examples, occurring both before and after USM unveiled its modernized Golden Eagle in January 2003, that suggest a somewhat cavalier attitude about the potential for likelihood of confusion with Iowa's marks.

⁵⁰ We hasten to add that our determination herein does not rely upon our resolution of this particular "catch-all" *du Pont* factor.

Conclusion

On balance, the relevant *du Pont* factors weigh in favor of a likelihood of confusion herein. In spite of the fact that the sixth *du Pont* factor may weigh slightly in applicant's favor, given the legally identical goods, the legally identical trade channels of the identified goods and the actual trade channels of opposers' common law usages, the same classes of ordinary consumers, the similarity of the marks, and the renown of Iowa's marks, we find a likelihood of confusion as between applicant's mark and opposers' marks, such that registration of applicant's mark is barred under Trademark Act Section 2(d).

Finally, to the extent that any doubts might exist as to the correctness of our conclusion, we must resolve such doubts in favor of the prior user and registrant. See *Century 21 Real Estate Corp.*, 23 USPQ2d at 1701; *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Decision: The opposition is sustained as to opposers' claim of likelihood of confusion and registration to applicant is hereby refused under Section 2(d) of the Lanham Act.

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Wellington, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority decision and do not believe there is a likelihood of confusion between the parties' marks.

In contrast with the majority, I find the sixth *du Pont* factor weighs heavily in applicant's favor and the parties' marks may be distinguished as two visually different bird head logos being used in connection with two different college sports teams, albeit on the same goods. The record demonstrates that there are numerous third-party uses of bird head logos as mascots or otherwise in connection with sports teams. As a result, the relevant consumers have become so conditioned by such similar uses that they will know to distinguish such marks based on what may otherwise be considered minimal differences. This conditioning transcends any varying degrees of consumer sophistication; that is, one would be hard-pressed to find a member of the general public who is unaware that bird heads are commonly used as logos on merchandise to represent school and professional sports teams.

With the above "conditioning" in mind, the fact that both marks are bird head sports logos is hardly relevant and consumers will look to certain distinguishing features of the

marks. In particular, consumers will notice that opposers' marks depict a "stencil-like" image of a bird head that is quite different from the numerous third-party uses of bird head sports logos. Applicant's mark, on the other hand, comprises a much more realistic bird head and is more in line with the third-party uses of bird head logos of record. Furthermore, and for sake of clarity, I note that neither the application nor the pleaded registrations claim any specific color as a feature of the respective marks. Regardless, the fact that the marks may be presented in a similar gold or yellow color has little persuasive value given the popularity, as shown by the evidence, of such colors in other bird head sports logos. Ultimately, given the importance I believe is due to the sixth *du Pont* factor in this case and the overall dissimilarity of the parties' marks, I would not find a likelihood of confusion.