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**SCHOOL NICKNAMES AND ACRONYMS AS
TRADEMARKS: KICKING THE BAND OFF THE
BANDWAGON**

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I. ABSTRACT

Colloquial and quaint nicknames have often been devised by the public to refer to students and alumni linked with specific colleges and universities. Similarly, acronyms and initials have become widely utilized to refer to these schools. However, collegiate licensing programs have aggressively sought to appropriate these same nicknames and acronyms as trademarks. This effectively monopolizes as commercial brands and allows the schools to use the legal system's heavy hand to prevent unauthorized uses.

Consequently, legal conflicts can erupt within the schools' local communities. Intellectual property lawyers working for these universities have devised clever and effective legal strategies to squelch any legal opposition, but not without a real cost—the schools often alienate their own alumni. Schools should become mindful that vigorously enforcing their newfound legal rights against members of their own communities and alumni can lead to unpopular results and, ironically, tarnish the very brand they are reportedly protecting.

II. INTRODUCTION

The public has devised colloquial and quaint nicknames to refer to students and alumni associated with various colleges and universities. For example, “aggie” is a diminutive form of the

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word “agricultural,” which forms part of the name of several state universities, such as Texas Agricultural & Mining (Texas A&M).¹

The nickname “domers” connotes any student of the University of Notre Dame in South Bend, Indiana, past or present.² “Hokies” is a term used to describe students, alumni, supporters, or any combination thereof of Virginia Tech.³ “Drewids” describes students attending Drew University in New Jersey, “mudders” go to Harvey Mudd College, “skiddies” to Skidmore, “whoopis” are students at Worcester Polytechnic Institute, and Yale students and alumni are sometimes called “elis.”⁴ Additionally, college students and alumni have occasionally adopted unofficial mascots to help them support their alma mater. For example, the University of California at Santa Barbara adopted the colorful term “gauchos” to describe themselves.⁵

Similarly, acronyms and initials provide an easy shorthand to describe entire regions of cities and towns that house universities and colleges. For example, “NYU” refers to a portion of Manhattan south of Houston Street, including Washington Square Park. “ASU” is used to refer to Alabama State University, Arizona State University, and others. “BU” has been used to describe Baylor University in Texas, Binghamton University in upstate New York, as well as Boston University, Bradley University, and Butler University.⁶

¹ See *infra* Section III.B.

² In contrast, the wider term “hoosier” can be applied to any resident of the state of Indiana, but “Hoosiers” is also the official name of the Indiana University athletic team. See *What Is a Hoosier?*, WE DO HISTORY, http://www.indianahistory.org/feature-details/what-is-a-hoosier#.Wb_M262ZNok (last visited Nov. 1, 2018); see also *infra* Section III.C.

³ See *infra* Section III.A.

⁴ See generally MARK T. JENKINS, NICKNAME MANIA: THE BEST OF COLLEGE NICKNAMES AND MASCOTS AND THE STORIES BEHIND THEM (1997).

⁵ See Paul Rivas, *The Men Behind the Myths: From Argentine Cowboys to Tossed Tortillas, the True Story of UCSB’s Mascot*, SANTA BARBARA INDEP. (April 21, 2009), <http://www.independent.com/news/2009/apr/21/men-behind-myths/>.

⁶ Other commonly used acronyms for colleges and universities include: “CU”, “NU”, “OSU”, “PCC”, “SU”, “UC”, “UCLA”, “UMD” and “WSU.”

Collegiate licensing programs have become immensely valuable intellectual property assets, generating hundreds of millions of dollars in revenue each year for colleges and their profitable licensees.⁷ But when collegiate licensing programs aggressively seek to appropriate colloquial nicknames as federal trademarks and monopolize them as commercial brands, conflicts can erupt within the local communities where these schools are located, as well as between schools.⁸

This article will canvass several real-world examples of such conflicts. It will analyze the legal and practical problems inherent in aggressive collegiate brand strategies that seek to own and ultimately prohibit the unauthorized use of nicknames and acronyms originally coined by the public to describe local regions, students, alumni and supporters of that same university.

One strategy that some universities appear to use is that of a war of attrition—by foisting significant litigation costs onto small companies and creating long delays before applicants can receive trademark registrations, universities are unafraid of exerting their size and influence to create value in their highly lucrative intellectual property portfolios.⁹ As one trademark

⁷ See Cork Gaines, *The 25 Schools That Make the Most Money in College Sports*, BUSINESS INSIDER (Oct. 13, 2016), <https://www.businessinsider.com/college-sports-revenue-leaders-2015-9> (“In all, there are now 24 schools that make at least \$100 million annually from their athletic department.”); see also Darren Heitner, *Sports Licensing Soars To \$698 Million In Royalty Revenue*, FORBES (June 17, 2014), <https://www.forbes.com/sites/darrenheitner/2014/06/17/sports-licensing-soars-to-698-million-in-royalty-revenue/#6c7a5013756b> (total revenues from collegiate licensing estimated at \$209 million, or \$3.88 billion at retail).

⁸ See, e.g., Lauren T. Warbington, *Crossing the Line: The Collegiate Licensing Company's Overindulgent Attempt to Limit Small Businesses' Online Marketing Techniques Based on Frivolous Claims of Trademark Infringement*, 19 J. INTELL. PROP. L. 517 (2012) <http://digitalcommons.law.uga.edu/jipl/vol19/iss2/12>; see also Lee Green, *Trademark Issues with Use of College Names, Logos, Mascots*, NAT'L FED'N OF HIGH SCHOOL ASSOCIATIONS (April 13, 2015) <https://www.nfhs.org/articles/trademark-issues-with-use-of-college-names-logos-mascots/>.

⁹ See generally JACOB H. ROOKSBY, *THE BRANDING OF THE AMERICAN MIND: HOW UNIVERSITIES CAPTURE, MANAGE, AND*

lawyer colorfully put it, the university jumps on the bandwagon, then shamelessly kicks the band off.¹⁰

III. HISTORICAL ORIGINS OF LOCAL COLLEGIATE NICKNAMES

Approximately 3,000 institutions of higher learning in the United States offer four-year scholastic degrees, such as a Bachelor of Arts or Bachelor of Science.¹¹ Several hundred of these colleges and universities date their founding back a century or more.¹² Many of these schools have witnessed their alumni rise to the highest ranks of society. Consequently, these institutions have profound cultural impacts on their wider communities.

Additionally, most institutions of higher learning are major employers in their geographic regions. Their presence has significant economic and environmental impacts on the local communities that host their students.¹³ While these universities offer many local benefits, there is often tension between universities and their neighboring communities as both continue to grow and change.¹⁴ Schools' acronym and licensing issues contribute to that tension.

MONETIZE INTELLECTUAL PROPERTY AND WHY IT MATTERS (JHU Press 2016).

¹⁰ See U.S. Trademark Opposition No. 91207895, Opposer's Main Brief [Dkt. 88] ("The public created and adopted the HOKIE nickname to refer to members of the Virginia Tech community, but [Virginia Tech] ... waited more than two decades before deciding to jump on the bandwagon and use term HOKIE too, along with the public. Yet now, Applicant is trying to kick the public off of that bandwagon.").

¹¹ See NAT'L CTR. FOR EDUC. STAT., <https://nces.ed.gov/fastfacts/display.asp?id=84> (last visited Nov. 8, 2018).

¹² See e.g., *Historical Facts*, HARVARD UNIV., <https://www.harvard.edu/about-harvard/harvard-glance/history/historical-facts> (last visited Nov. 8, 2018).

¹³ See, e.g., John Falconer, *The Impact of Public Four-Year Colleges and Universities on Community Sustainability in Non-Metropolitan Areas of the Great Plains* (June, 2006) (unpublished Ph.D. dissertation, University of Nebraska—Lincoln), <http://digitalcommons.unl.edu/dissertations/AAI3218892/>.

¹⁴ See Wallace Warfield, *Town and Gown: Forums for Conflict and Consensus Between Universities and Communities*, NEW DIRECTION FOR HIGHER EDUC., Winter 1995, at 63–69.

A. “HOKIES” IN BLACKSBURG, VIRGINIA

Virginia Polytechnic Institute and State University, popularly known as Virginia Tech, is a public land-grant research university with a main campus in Blacksburg, Virginia, as well as educational facilities in six regions statewide, and a study-abroad site in Switzerland.¹⁵ Through its Corps of Cadets ROTC program, Virginia Tech is also designated as one of six senior military colleges in the country.¹⁶ Virginia Tech was founded in 1872.¹⁷

As Virginia’s third-largest university, Virginia Tech offers 225 undergraduate and graduate degree programs to some 30,600 students and manages a research portfolio of \$513 million—the largest of any university in Virginia.¹⁸ The university fulfills its land-grant mission of transforming knowledge into practice through technological leadership, and by fueling economic growth and job creation—both locally and across Virginia.¹⁹

According to the federal trademark office database, the university owns legal rights to its nickname “Virginia Tech,”²⁰ its formal name “Virginia Polytechnic Institute and State University,”²¹ the tagline “Invent the Future,”²² and logos including the university’s official motto, “Ut Prosim,” which in Latin means “That I may serve.”²³

¹⁵ Topic – Virginia Tech, WASH. TIMES, <https://www.washingtontimes.com/topics/virginia-tech/> (last visited Nov. 8, 2018).

¹⁶ *Is the Corps Right for Me?*, VIRGINIA TECH, <https://www.vtcc.vt.edu/join.html> (last visited Nov. 9, 2018).

¹⁷ *The Minor Years*, VIRGINIA TECH., https://www.unirel.vt.edu/history/historical_digest/minor_years.html (last visited Nov. 3, 2018).

¹⁸ Virginia Polytechnic School and State University, *VIRGINIA TECH*, SEXSEED (Oct. 13, 2018, 5:00 AM), <http://www.fc.up.pt/sexseed/virginia.html>.

¹⁹ *Id.*

²⁰ See VIRGINIA TECH, Registration No. 5,216,616.

²¹ See VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, Registration No. 2,389,184.

²² See INVENT THE FUTURE, Registration No. 3,181,946.

²³ See VIRGINIA POLYTECHNIC AND STATE UNIVERSITY UT PROSIM, Registration No. 5,221,329.

The term “Hokie” has been associated with Virginia Tech’s students for over a century.²⁴ According to Virginia Tech’s website, the term “Hokie” was coined by a student in 1896:

The origin of the word “Hokie” has nothing to do with a turkey. It was coined by O.M. Stull (class of 1896), who used it in a spirit yell he wrote for a competition. Here’s how that competition came to be. Virginia Tech was founded in 1872 as a land-grant institution and was named Virginia Agricultural and Mechanical College. In 1896, the Virginia General Assembly officially changed the college’s name to Virginia Agricultural and Mechanical College and Polytechnic Institute, a name so long that people shortened it in popular usage to VPI. The original college cheer, which made reference to the original name of the institution, was no longer suitable. So a contest was held to select a new spirit yell, and Stull won the \$5 top prize for his cheer, now known as Old Hokie Later, the phrase “Team! Team! Team!” was added at the end, and an “e” was added to “Hoki.”²⁵

However the legend began, extensive historical research shows that the term “Hokie,” when used to mean a student, athlete, alumnus or supporter of Virginia Tech, likely arose sometime around 1949, despite Virginia Tech’s claim that its first use began in 1901 or earlier.²⁶ In any event, there is no dispute that, at some point, the public spontaneously gave the term its present meaning and made it part of the everyday regional language. For example,

²⁴ See *History and Traditions*, VA. POLYTECHNIC SCH. AND STATE UNIV. (Sept. 18, 2017), <https://vt.edu/about/traditions.html>.

²⁵ *What is a Hokie Hoopty?*, BLOGSPOT.COM (Oct. 18, 2005, 6:24 PM), <http://thehokiehooptydefined.blogspot.com>.

²⁶ In none of the yearbooks from 1895 through 1972 was there any specific example of trademark use of the terms HOKIE or HOKIES by Virginia Tech. See *Opposer’s Main Brief at 16, Hokie Objective Onomastics Soc’y LLC v. Va. Polytechnic Institute and State Univ., Opposition No. 91207895 (T.T.A.B. 2017)* (hereinafter “Onomastics Opposition”). “Rather, all uses in these yearbooks of HOKIE and its variants were purely nominative and descriptive.” *Id.* In fact, “[t]he earliest evidence of trademark use of any HOKIE variant by Applicant is in the 1973 yearbook, which contains photographs of cheerleaders wearing jerseys bearing the term HOKIES (which presumably were taken during the 1972 football season).” *Id.* at 16–17.

Dr. Wayne Massey, a former Virginia Tech student who attended the university from 1959 to 1961, testified before the Trademark Trial and Appeal Board (“TTAB”) that during his time on campus and afterwards, students and alumni referred to themselves as “Hokies.”²⁷

During Dr. Massey’s time at the school, the primary popular nicknames for Virginia Tech students were “gobblers” and/or “techmen.”²⁸ “Hokies” did not become the favored nickname until the 1970’s.²⁹ Virginia Tech appears to have officially changed its nickname from Gobblers to Hokies around 1978.³⁰ Student newspapers published by Virginia Tech students from 1935 to 1979 confirm widespread use of the term “Hokies” peaked by the late 1970’s.³¹

Virginia Tech’s sports teams’ website confirms that “[t]he official definition of ‘hokie’ is ‘a loyal Virginia Tech Fan.’”³² Furthermore, Virginia Tech has approved and marketed designs for apparel that indicate that the wearer is a “Hokie,” bearing statements such as “Hokie Girl,” “I am a Hokie,” “It’s Official, I’m a Hokie,” and “What’s a Hokie? I Am!”³³ By the time Virginia Tech made its first commercial use of the term “Hokies,” the word had spent at least several decades in the linguistic public domain.³⁴

Nonetheless, Virginia Tech’s administration decided to take advantage of modern federal intellectual property laws. In 1998, Virginia Tech sought to federally register the word “Hokies” for diverse commercial goods such as jewelry, watches, bumper stickers, backpacks, waste paper baskets, baby bibs, and bath robes.³⁵ That trademark registration issued in May 2000 and has now been renewed through 2020.³⁶ In 2009 alone, Virginia

²⁷ *Id.* at 12.

²⁸ *See id.* at 15–18.

²⁹ *Id.* at 3.

³⁰ *Id.*

³¹ *Id.* at 15.

³² *What's a Hokie*, VA. TECH ATHLETICS (July 24, 2018), <https://hokiesports.com/sports/2018/4/19/whats-a-hokie.aspx>.

³³ *See* Onomastics Opposition, *supra* note 26, at 12.

³⁴ *Id.*

³⁵ *See* HOKIES, Registration No. 2,351,364.

³⁶ *Id.*

Tech made about \$1.6 million in fees and royalties from sales of licensed products and services.³⁷

Virginia Tech's intellectual property lawyers quickly became assertive in protecting their client's newfound legal rights. For example, in 2010, Virginia Tech sued a Blacksburg real estate agent and Virginia Tech alumnus in federal court for using the word "HOKIE" in his business's name.³⁸ He named his business Hokie Real Estate, Inc.,³⁹ even though Virginia Tech has never been commercially engaged in local residential real estate.⁴⁰

The Virginia Tech alumnus had submitted a request to the University's licensing program to use the name, but was refused for unknown reasons.⁴¹ Virginia Tech's Amended Complaint alleged that Hokie Real Estate was nonetheless infringing upon and diluting Virginia Tech's exclusive legal right to commercialize the "famous Hokies and Hokie trademarks."⁴² The school demanded that the defendant be ordered to reimburse its legal fees and pay the school unspecified compensatory damages in the form of triple the real estate business's profits.⁴³

The defendant argued that the term "Hokies" was legally "generic" and in common use, and therefore legally unprotectable

³⁷ Complaint at ¶ 11, *Va. Polytechnic Inst. and State Univ. v. Hokie Real Estate, Inc.*, 813 F. Supp. 2d 745 (W.D. Va. 2011) (No. 7:10CV00466), 2010 WL 4232598.

³⁸ *Id.* at 5.

³⁹ *Id.* at 6.

⁴⁰ Virginia Tech alleged in its Amended Complaint that Virginia Tech houses thousands of students annually in its residence halls; that it is a substantial landowner in the Blacksburg, Virginia area; that there has been and is a significant amount of property that Virginia Tech purchases and develops; and that it has been involved in and has endorsed and helped to develop the HOKIE HOMES program since at least 2005 under which Virginia Tech has worked with an architect to develop home plans that are specifically drawn up for and targeted to Virginia Tech alumni, fans, and friends. Amended Complaint at 3–4, *Va. Polytechnic Inst. and State Univ. v. Hokie Real Estate, Inc.*, 813 F. Supp. 2d 745 (No. 7:10CV00466).

⁴¹ Tonia Moxley, *Blacksburg Real Estate Firm Gets Right to Use "Hokie" in Company Name*, ROANOKE TIMES, (Sept. 8, 2011), https://www.roanoke.com/news/blacksburg-real-estate-firm-gets-right-to-use-hokie-in/article_10f263f7-9682-5b98-a4f4-70c8e49540e8.html.

⁴² Amended Complaint at 8–11, *Va. Polytechnic Inst. and State Univ. v. Hokie Real Estate, Inc.*, 813 F. Supp. 2d 745 (No. 7:10CV00466).

⁴³ *Id.* at 15.

as a federal trademark.⁴⁴ By seeking the exclusive right to use the term Hokie, the defendant argued that Virginia Tech was “attempting to usurp the right of the public . . . to use a term that [Virginia Tech] did not itself invent, and which the public adopted as a nickname for members of the Virginia Tech community long before [Virginia Tech] ever attempted to use the term as a mark.”⁴⁵

The defendant also argued that Virginia Tech essentially gave up any legal claims to control and ownership of the term.⁴⁶ It believed that it did so by allowing, or at least failing to challenge, use of the term by several local businesses, three of which were still operating—HOKIE HOUSE, HOKIE HAIR and HOKIE SPOKES.⁴⁷ The defendant alleged that none of these businesses ever paid any licensing fees to Virginia Tech.⁴⁸

⁴⁴ Memorandum in Support of Defendant’s Motion to Dismiss Pursuant to Federal Rule of Civil Procedure 12(b)(6) at 3–7, Va. Polytechnic Inst. and State Univ. v. Hokie Real Estate, Inc., 813 F. Supp. 2d 745 (No. 7:10CV00466).

⁴⁵ Defendant’s Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction at 17, Va. Polytechnic Inst. and State Univ. v. Hokie Real Estate, Inc., 813 F. Supp. 2d 745 (No. 7:10CV00466).

⁴⁶ See Memorandum in Support of Defendant’s Motion to Dismiss Pursuant to Federal Rule of Civil Procedure 12(b)(6), *supra* note 44, at 3.

⁴⁷ Defendant’s Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction, *supra* note 45, at 31–32.

⁴⁸ Hokie Spokes’ owner Dave Abraham apparently told reporters that several years ago he had signed a royalty-free contract with Virginia Tech to continue using the name as part of his business, thus avoiding a legal fight Tonia Moxley, *Virginia Tech Files Trademark Suit Over ‘Hokie’*, THE ROANOKE TIMES (Oct. 29, 2010), <https://www.deseretnews.com/article/700077265/Virginia-Tech-files-trademark-lawsuit-over-Hokie.html>. It is also worth noting that one of the three allegedly grandfathered businesses, a local bar in Blacksburg, Virginia recently attempted to federally register its name “HOKIE HOUSE” in International Class 43 for bar services and restaurant services, a name that it has apparently used since November 1967, presumably without paying any licensing fees to the university. However, this trademark application was later abandoned after the Trademark Examiner refused registration. U.S. Trademark Application Serial No. 86/827,306 (filed Nov. 20, 2015).

Virginia Tech ultimately settled the dispute with the real estate agency by granting it a retroactive license.⁴⁹ Recently, however, that defendant's trademark counsel began to formally complain to the U.S. Patent and Trademark Office.⁵⁰ Specifically, he opposed Virginia Tech's most recent efforts to own the term "Hokie" for "educational services," by creating a new "educational" company that would seek to undercut the school's attempts to control the term, "Hokies" as commercial property in International Class 41.⁵¹

The legal test employed was fairly clear. In *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*,⁵² the Federal Circuit Court of Appeals had identified the following two-step inquiry for determining the possible "genericness" of an applied-for trademark. "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered on the register understood by the relevant public primarily to refer to that genus of goods or services?" Therefore, the challenge with mounting a successful legal attack on Virginia Tech's efforts to own a registered trademark is that such a term does not "generically" refer to a genus of any educational goods or services.⁵³ That is, one does not "go to a Hokie," or "take a Hokie." Rather, a "Hokie" might take a class at Virginia Tech. Ultimately, this fine distinction mattered to the TTAB who resolved the legal dispute in the school's favor, as "genericness" was the primary obstacle to Virginia Tech's application for registration of that term in International Class 41 for educational services.⁵⁴

The TTAB ruled that Virginia Tech successfully argued that "HOKIES" is not generic for the precise services defined in the application.⁵⁵ As to the second part of the "genericness" test, the Board found that "the record does not demonstrate how the

⁴⁹ Tonia Moxley, *Blacksburg Real Estate Firm Gets Right to Use "Hokie" in Company Name*, THE ROANOKE TIMES (Sept. 8, 2011), https://www.roanoke.com/news/blacksburg-real-estate-firm-gets-right-to-use-hokie-in/article_10f263f7-9682-5b98-a4f4-70c8e49540e8.html.

⁵⁰ *Hokie Objective Onomastics Soc'y LLC v. Va. Polytechnic Inst. and State Univ.*, No. 91207895, 2017 WL 4790886 (T.T.A.B. Oct. 20, 2017).

⁵¹ HOKIE, Registration No. 5,398,859.

⁵² *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986).

⁵³ Onomastics Opposition, *supra* note 26, at 10.

⁵⁴ *Id.*

⁵⁵ *Id.* at 11.

term ‘Hokie’ is understood by the relevant consuming public in the context of educational and entertainment services.”⁵⁶ The TTAB went on to hold that:

[e]ven if, *arguendo*, we accept Opposer’s contention that ‘Hokie’ is a generic reference meaning a supporter of Applicant and such supporter or ‘Hokie’ may also be a consumer of Applicant’s services, the evidence does not establish that the consuming public uses this term as a generic reference for educational and entertainment services.⁵⁷

Thus, the TTAB found that Virginia Tech correctly argued that even if “Hokie” means a student or supporter of Virginia Tech, it is not “generic” as used in the context of the applied-for educational services in Class 41.⁵⁸ Virginia Tech had won: A fine legal distinction ruled the day.

Virginia Tech’s aggressive efforts to commercially appropriate the term “Hokies,” even though it was ultimately successful as a matter of technical trademark law, will continue to annoy and harass the local community. Virginia Tech will be forced into the uncomfortable posture of repeatedly suing members of that local community to stop unauthorized use of the term, which will likely include its own alumni and supporters.

B. “AGGIES” IN TEXAS AND ELSEWHERE

It should come as no surprise that Texas A&M zealously seeks to protect its intellectual property, given that it regularly generates \$37.5 million each year in revenue from licensing alone.⁵⁹ Texas A&M owns well over one hundred federally-registered trademarks, including many variants of its name and numerous logos.⁶⁰ However, the tactic that has probably generated the most controversy for the school has been its attempt to own

⁵⁶ *Id.* at 10.

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ See Gaines, *supra* note 7.

⁶⁰ See, e.g., FIGHTIN’ AGGIE TEXAS BAND, Registration No. 1,881,969; see also TEXAS AGGIES, Registration No. 1,979,207; AGGIELAND, Registration No. 3,200,003; TEXAS A&M AGGIES, Registration No. 3,970,755; GIG ’EM AGGIES, Registration No. 3,981,001; AGGIE ENERGY, Registration No. 3,999,623; AGGIEFBLIFE, Registration No. 4,735,302.

and control the use of the widely used term “AGGIES.” Derived from the “AG” of “Agricultural & Mechanical” commonly associated with universities established under the Morrill Land-Grant Acts of July 2, 1862,⁶¹ dictionary definitions describe “AGGIES” generically as any agricultural college or students attending such a school.⁶²

Students at Delaware Valley University in Doylestown Pennsylvania, as well as students attending New Mexico State in Las Cruces New Mexico are called “AGGIES.”⁶³ Additionally, Kansas State University College of Agriculture in Manhattan, Kansas and the University of Florida College of Agricultural and Life Sciences in Gainesville, Florida are examples of schools whose students have been called “AGGIES” for over a century.⁶⁴ And Utah State University, located in Logan, Utah, has used the term to describe its athletic teams.⁶⁵ Nonetheless, Texas A&M has zealously sought to corral the term.⁶⁶

1. “WE ARE THE AGGIE NETWORK”

In January 2011, A group of Texas A&M alumni successfully registered the trademark “WE ARE THE AGGIE NETWORK” for “association services, namely, promoting the

⁶¹ See generally Tanya Ray Fox, *March Madness Mascots & Nicknames 101: What is an Aggie?*, SPORTSGRID (Mar. 13, 2017, 6:30 PM), <https://www.sportsgrid.com/real-sports/ncaa-basketball/march-madness-mascots-nicknames-101-what-is-an-aggie/> (discussing how colleges that use the nickname “Aggie” are agricultural and mechanical colleges).

⁶² See *Aggie*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/aggie> (last visited Nov. 3, 2018).

⁶³ See *List of College Sports Team Nicknames*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_college_sports_team_nicknames (last visited Nov. 3, 2018).

⁶⁴ See *Kansas State Bands*, KANSAS STATE UNIVERSITY, <https://www.k-state.edu/band/thepride/history.html> (last visited Nov. 3, 2018) (explaining that Kansas State students were referred to as “Aggies” at the turn of the century).

⁶⁵ See *List of College Sports Team Nicknames*, *supra* note 63.

⁶⁶ See Collin Binkley, *Trademark Bullies? Many Big Colleges Fiercely Protect Brands*, US NEWS (Aug. 28, 2018, 3:08 PM), <https://www.usnews.com/news/best-states/minnesota/articles/2018-08-28/trademark-bullies-many-big-colleges-fiercely-protect-brands> (discussing how Texas A&M University asked trademark officials to cancel a trademark its own alumni association had registered).

interests of alumni” in International Class 35.⁶⁷ Texas A&M later filed a formal petition to cancel that registration, claiming that the students had been using the trademark “pursuant to a license from Texas A&M” and that it had no authorization or permission “to file for registration of the mark in its own name.”⁶⁸ Subsequently, Texas A&M withdrew its petition with prejudice.⁶⁹

2. “AGGIE ANGEL NETWORK”

In 2012, a corporation located in Texas filed for a registration for “AGGIE ANGEL NETWORK” in connection with financial and investment services.⁷⁰ Specifically, the corporation assists entrepreneurs to obtain financing and provide “seed capital[,] financial information[,] and resources related to creating and building a business in International Class 36.”⁷¹ Texas A&M initially sought additional time to oppose the application, but never did so.⁷² The university’s filings led to delays, but the mark ultimately registered and has been subsequently renewed.⁷³

3. “AGGIENOSTIC”

An individual from Texas filed an application for “AGGIENOSTIC” in connection with t-shirts.⁷⁴ Texas A&M opposed the application, claiming that consumers would falsely perceive an association, and that the use would both confuse and

⁶⁷ See WE ARE THE AGGIE NETWORK, Registration No. 3,912,028.

⁶⁸ See Petition for Cancellation at ¶6, *Tex. A&M Univ. v. The Ass’n of Former Students*, No. 92063077 (T.T.A.B. 2016).

⁶⁹ See Withdrawal of Petition to Cancel, *Tex. A&M Univ. v. The Ass’n of Former Students*, No. 92063077 (T.T.A.B. 2016).

⁷⁰ U.S. Trademark Application Serial No. 85/224,731 (filed Jan. 24, 2011).

⁷¹ *Id.*

⁷² See Request for Extension, *Tex. A&M Univ. v. Aggie Angel Network, Inc.*, No. 85224731 (T.T.A.B. 2011).

⁷³ See AGGIE ANGEL NETWORK, Registration No. 4,117,091.

⁷⁴ U.S. Trademark Application Serial No. 85/724,811 (filed Sept. 10, 2012).

dilute the “AGGIES” trademarks.⁷⁵ The applicant simply abandoned the application rather than fight the university.⁷⁶

4. “AGGIELAND” for Credit Cards

The term “AGGIELAND” now describes College Station, the geographic region in Texas surrounding Texas A&M University.⁷⁷ In 2002, before Texas A&M ever sought a trademark for “AGGIELAND,” the Greater Texas Federal Credit Union applied for a trademark registration for the term in International Class 36 for “credit union services and credit card services.”⁷⁸

Texas A&M nonetheless commenced a formal cancellation proceeding and alleged that the school’s use of “AGGIELAND” predated the bank’s usage for credit card services.⁷⁹ The bank avoided a protracted dispute with the school by amending its trademark application to claim the entire term, “AGGIELAND CREDIT UNION,” but the bank simultaneously disclaimed any rights to the words, “credit union” and the registration issued and has been subsequently renewed several times.⁸⁰

5. “AGGIELAND DEPOT”

In 2001, Hudson Ventures, Inc. applied for a trademark for “AGGIELAND DEPOT” in connection with retail store services.⁸¹ The store claimed that it had used the term since 1998.⁸² Texas A&M filed a formal opposition, and proceedings dragged on for nearly four years.⁸³ Ultimately, Hudson Ventures amended its application to formally disclaim any products

⁷⁵ Notice of Opposition at 4, Texas A&M Univ. v. Peer, No. 91/211,057 (T.T.A.B. 2013).

⁷⁶ Voluntary Surrender of Application with Consent, Texas A&M v. Peer, No. 91/211,057 (T.T.A.B. 2013).

⁷⁷ See TEXAS A&M UNIVERSITY, <https://www.tamu.edu/about/index.html> (last visited Nov. 9, 2018).

⁷⁸ AGGIELAND CREDIT UNION, Registration No. 2,050,398.

⁷⁹ Petition to Cancel at 3, Texas A&M Univ. v. Greater Texas Fed. Credit Union, No. 92/040,492 (T.T.A.B. 2002).

⁸⁰ See Resubmission of Amendment at 1–2, Texas A&M Univ. v. Greater Texas Fed. Credit Union, No. 92/040,492 (T.T.A.B. 2003).

⁸¹ AGGIELAND DEPOT, Registration No. 3,069,612.

⁸² *Id.*

⁸³ Notice of Opposition, Texas A&M Univ. v. Hudson Ventures, Inc., No. 91/151,749 (T.T.A.B. 2002).

associated with Texas A&M.⁸⁴ The trademark issued but was ultimately abandoned by 2012.⁸⁵

As is evident from these various skirmishes, despite its massive resources, Texas A&M has not fared as well as Virginia Tech in legally monopolizing the term the Texas school treasures.

C. “DOMER” IN SOUTH BEND, INDIANA

Founded in 1842, the University of Notre Dame du Lac (“Notre Dame”) is an independent, national Catholic research university located adjacent to the city of South Bend, Indiana.⁸⁶ Notre Dame is one of America’s leading teaching institutions.⁸⁷ It is regularly rated among the nation’s top 25 institutions of higher learning in surveys conducted by U.S. News and World Report, Princeton Review, Time, Kiplinger’s, Kaplan/Newsweek, and others.⁸⁸

Notre Dame is also home to one of the most storied college football programs in the nation. It has a history of success that includes 11 consensus national championships over six decades (one of the highest winning percentages in college football), and seven Heisman trophy winners—more than any other college football program in the country.⁸⁹

The term “domer” has regularly been used for decades to refer to Notre Dame students and alumni.⁹⁰ Students that attend

⁸⁴ See Order Granting Agreed Motion to Amend Applicant’s Description of Goods of Services, Texas A&M Univ. v. Hudson Ventures, Inc., No. 91/151,749 (T.T.A.B. 2003).

⁸⁵ AGGIELAND DEPOT, *supra* note 81.

⁸⁶ See *History*, UNIVERSITY OF NOTRE DAME, <https://www.nd.edu/about/history/> (last visited Nov. 9, 2018).

⁸⁷ See, e.g., *University of Notre Dame*, U.S. NEWS REPORT & WORLD REPORT, <https://www.usnews.com/best-colleges/notre-dame-1840> (last visited Nov. 9, 2018).

⁸⁸ *Id.*

⁸⁹ The Notre Dame “Fighting Irish” have about twenty varsity NCAA Division I athletic teams and are well known for their consistently strong football program. See *Notre Dame Championships*, UNIVERSITY OF NOTRE DAME, <https://www.uhnd.com/history/national-championships/> (last visited Nov. 9, 2018); *Notre Dame Heisman Trophy Winners*, UNIVERSITY OF NOTRE DAME, <https://www.uhnd.com/history/heismans/> (last visited Nov. 9, 2018).

⁹⁰ See, e.g., KEVIN COYNE, *DOMERS: A YEAR AT NOTRE DAME* (Penguin Books 1996).

Notre Dame are known as “domers” in reference to the gold-colored top of the school’s administration building.⁹¹ Notre Dame began to sell apparel items, including t-shirts, under the “DOMER” trademark at least as early as 1998.⁹² Notre Dame also uses “The Daily Domer” as the name of a website that collects local and national news stories about Notre Dame.⁹³ Students make on-campus purchases using “Domer Dollars” which are electric funds remotely programed into the campus ID cards.⁹⁴

In 2002, Notre Dame sought a federal trademark registration for “DOMER” in connection with clothing, including headwear.⁹⁵ Initially, the Trademark Examiner refused registration, citing a pre-existing trademark design registration including the term “domer” for headwear and caps owned by Domer Sportswear, a Minnesota company.⁹⁶

The University vehemently argued that its “goods will be marketed through on-campus bookstores, and through authorized licenses and retailers.”⁹⁷ Thus, it argued that “there is almost no chance of Applicant’s and Registrant’s products being marketed together or sold on the same store shelves.”⁹⁸ Nonetheless, the Examiner refused to withdraw the refusal, and formal appeal was ultimately taken to the TTAB, which thus permitted the

⁹¹ According to Notre Dame’s website, the main campus building was built in 1879 after the previous building burned down. The famous golden dome was added to the structure in 1882 and has been gilded multiple times to maintain its shiny luster, most recently in 2005. *See The Great Fire*, UNIVERSITY OF NOTRE DAME, <https://175.nd.edu/175-moments/the-great-fire/> (last visited Nov. 9, 2018); *The Statue and the Dome*, UNIVERSITY OF NOTRE DAME, <https://175.nd.edu/175-moments/the-statue-and-the-dome/> (last visited Nov. 9, 2018).

⁹² *See* DOMER, Registration No. 2,852,483.

⁹³ *See* THE DAILY DOMER, <https://dailydomer.nd.edu> (last visited Nov. 9, 2018).

⁹⁴ *See Domer Dollars*, UNIVERSITY OF NOTRE DAME: IRISH1CARD (last visited Nov. 9, 2018), <https://irish1card.nd.edu/domer-dollars2/>.

⁹⁵ *See* U.S. Trademark Application Serial No. 76/391,175 (filed Apr. 2, 2002).

⁹⁶ *See* DOMER, Registration No. 1,679,480.

⁹⁷ *See* Procedural History, DOMER, Registration No. 1,679,480, available at <https://perma.cc/M2YK-B6MJ>.

⁹⁸ *Id.*

University's registration to issue in 2004.⁹⁹ Both registrations currently coexist on the Principal Register.¹⁰⁰

In 2015, an individual sought to register the phrase "Once a Domer, Always a Domer" in International Class 25 for "Polo shirts; Shorts; Sweatpants; Sweatshirts; T-shirts" on an intent-to-use basis.¹⁰¹ Notre Dame opposed his application, claiming that it owned exclusive rights in the term "domer."¹⁰² The applicant was given multiple opportunities to address Notre Dame's arguments, but his attorney ultimately withdrew as counsel, a default judgment was entered, and his contested trademark application was abandoned.¹⁰³

In 2017, a distilling company located in Iowa sought to register the term "Domer," but met similar opposition efforts by Notre Dame. As a result, that application was also later abandoned.¹⁰⁴ Thus, the Indiana university has largely succeeded in controlling the use of the term, "domer."

IV. COLLEGIATE ACRONYMS/INITIALS

A. ONGOING BATTLES TO CONTROL "ASU"

Similar to nicknames, acronyms and initials used as linguistic shorthand to describe universities and colleges are often as old as the schools themselves.¹⁰⁵ ASU, for example, has been used to refer to a number of schools, including Alabama State University, Arizona State University, Angelo State University, and others.¹⁰⁶ As a result, in the United States Patent and

⁹⁹ See *DOMER*, *supra* note 92.

¹⁰⁰ See *id.*; see also *DOMER*, Registration No. 1,679,480.

¹⁰¹ See U.S. Trademark Application Serial No. 86/535,930 (filed Feb. 16, 2015).

¹⁰² See Notice of Opposition, *Univ. of Notre Dame v. Vrana*, No. 91225439 (T.T.A.B. 2015).

¹⁰³ See Withdrawal of Counsel, *Univ. of Notre Dame v. Vrana*, No. 91225439 (T.T.A.B. 2015); see also Board Decision, *Univ. of Notre Dame v. Vrana*, No. 91225439 (T.T.A.B. 2015).

¹⁰⁴ See *Univ. of Notre Dame v. Foundry Distilling Co.*, No. 87191838 (T.T.A.B. 2017).

¹⁰⁵ See, e.g., Notice of Opposition, *Hokie Objective Onomastics Soc'y, LLC v. Virginia Polytechnic Inst. and State Univ.*, Opposition No. 91207895 (T.T.A.B. 2012).

¹⁰⁶ See *ALABAMA STATE UNIVERSITY*, <http://alabama.stateuniversity.com> (last visited Nov. 3, 2018); see also *ARIZONA STATE UNIVERSITY*, <https://www.asu.edu> (last visited Nov. 3,

Trademark Office, there have been many competing interests vying over legal ownership of these initials.¹⁰⁷

In the 1980's, Arizona State University first applied for and received a federal trademark registration for a specific ASU logo to be used on clothing and headwear.¹⁰⁸ That registration was cancelled in 1993 because Arizona State had failed to show that it was still using it.¹⁰⁹ Arizona State gained renewed interest in protecting intellectual property, leading it to file a slew of trademark applications for "ASU" and related logos in the late 1980's and early 1990's.¹¹⁰ Many registrations ultimately issued.¹¹¹ Similarly, Arizona State currently owns a number of trademark registrations covering classes like educational services in International Class 41, clothing in International Class 25, and mugs and cups in International Class 21.¹¹² Arizona State admits that it spent "hundreds of thousands of dollars on registration and enforcement activities" and "even greater amounts on marketing activities" to promote its trademarks.¹¹³

Arizona State's investment of resources successfully precluded many others, including other schools and universities, from acquiring intellectual property rights to the letters, "ASU."¹¹⁴ For example, in 1999, Augusta State University, located in Georgia, filed trademark applications for a logo containing the letters "ASU" in a variety of classes including clothing and

2018); ANGLO STATE UNIVERSITY, <https://www.angelo.edu> (last visited Nov. 3, 2018).

¹⁰⁷ See, e.g., U.S. Trademark Application Serial No. 75/842,036 (filed Nov. 5, 1999); see also U.S. Trademark Application Serial No. 85/461,475 (filed Nov. 1, 2011); see also U.S. Trademark Application Serial No. 75/270,563 (filed Apr. 7, 1997).

¹⁰⁸ See ASU, Registration No. 1,433,972.

¹⁰⁹ *Id.*

¹¹⁰ See ASU, Registration No. 1,445,083; see also ASU, Registration No. 1,445,086; ASU, Registration No. 1,449,742; ASU, Registration No. 1,433,973; ASU, Registration No. 1,462,309.

¹¹¹ See, e.g., ASU, Registration No. 1,462,309; see also ASU, Registration No. 1,449,742.

¹¹² See, e.g., ASU Registration No. 1,462,309; ASU Registration No. 1,433,973; ASU Registration No. 1,449,742.

¹¹³ Petition for Cancellation at 6, *Ariz. Bd. of Regents v. Angelo State Univ.*, No. 92067468 (T.T.A.B. 2017).

¹¹⁴ See, e.g., *id.* at 7.

educational services.¹¹⁵ Those applications were later abandoned because of Arizona State's pre-existing registrations.¹¹⁶

Subsequently, legal conflicts erupted between Angelo State University, which sought and received a registration for its logo which included the initials "ASU" and the words "Arizona State."¹¹⁷ In its Petition to Cancel, filed in late 2017, Arizona State alleged that Angelo State's trademark registration is intentionally designed to "trade on" Arizona State's goodwill, and thus, make it "likely, when applied to the registered goods and services, to cause mistake and confusion among, and to deceive, the trade and the public, with consequential injury" to Arizona State.¹¹⁸ No specific instances of any actual confusion are cited by Arizona State's Petition, despite the fact that Angelo State's trademark was issued in 2013, and has been used by that school since January 2002.¹¹⁹

Nonetheless, Angelo State is now forced to litigate and defend its existing trademark registration against Arizona State's petition to cancel it.¹²⁰ In the unlikely event that Arizona State litigates its Petition to an ultimate legal victory, not only will Angelo State's trademark be removed from the Principal Register of the Trademark Office, the school also faces the possibility of an injunction and liability for financial damages.¹²¹

¹¹⁵ U.S. Trademark Application Serial Nos. 75/823,792 (filed Oct. 15, 1999); 75/842,036 (filed Nov. 5, 1999).

¹¹⁶ *Id.*

¹¹⁷ Petition for Cancellation, *supra* note 113, at 8.

¹¹⁸ *Id.* at 11.

¹¹⁹ *Id.* at 8.

¹²⁰ *See, e.g.*, Answer to Petition for Cancellation, *Ariz. Bd of Regents v. Angelo State Univ.*, No. 92067468 (T.T.A.B. 2017).

¹²¹ In such a hypothetical civil action, Angelo State could to present an affirmative defense of estoppel by laches based on Arizona State's unexplained delay before filing suit. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:30 (5th ed. 2013). However, a loss in the TTAB on the substantive issue of likelihood of confusion could potentially create collateral estoppel if Angelo State tried to re-litigate that same issue in District Court. *See* B&B Hardware Inc. v. Hargis Indus. Inc., 135 S.Ct. 1293, 1299 (2015).

B. THE CROWDED FIELD OF “BU”

“BU” has been used to describe Baylor University in Texas, Binghamton University in upstate New York, as well as Boston University, Bradley University, and Butler University. No single one of these entities has been successful in monopolizing the shared initials. Such a situation is typically called a crowded field.¹²²

Baylor University beat Boston University in taking advantage of federal intellectual property laws. In 1987, Baylor filed the first trademark applications for its interlocking BU logo for clothing in Class 25, printed matter in Class 16, and cups and mugs in Class 21.¹²³ Baylor also owns a trademark for a similar logo in Class 9 for computer application software.¹²⁴

However, in 2006, Biola University, a California school, filed a trademark application for an eagle logo, also containing the acronym “BU,” which issued in 2008.¹²⁵ The field became even more crowded in 2015, when Bloomsburg University of Pennsylvania filed and received a trademark which consists of stylized letters “B” and “U” with the image of the head of a husky in between the two letters.¹²⁶ Thus, no one entity has successfully managed to corral legal rights to the letters “BU” for educational services and related products.

V. LEGALLY CAPTURING A NICKNAME OR ACRONYM AS A TRADEMARK

A. THE PUBLIC USE DOCTRINE

Are universities within their legal rights to corral a nickname or acronym from the popular lexicon into their private trademark portfolios? Appellate courts have not authoritatively addressed this controversial issue, and legal and academic commentators are split on the propriety of their approach. For example, one district court said that it is “doubtful” whether a manufacturer can legitimately claim legal protection for an abbreviation that only the public, and not the manufacturer, has

¹²² See, e.g., *Juice Generation, Inc. v. GS Enter. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015) (evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection).

¹²³ See BU, Registration No. 1,558,080.

¹²⁴ See BU, Registration No. 5,429,446.

¹²⁵ See BU, Registration No. 3,494,058.

¹²⁶ See BU, Registration No. 4,666,136.

used.¹²⁷ Other court decisions indicated that where, as a result of use by customers, the trade, or the media, an abbreviation has become identified in the public mind with a particular company or source, then that abbreviation should be a protectable trademark—even if the company itself has not formally adopted that abbreviation as a trademark or trade name.¹²⁸ This is often called the “Public Use” doctrine.¹²⁹ One commentator has noted that some courts are hesitant to recognize such trademark rights created solely by the public use doctrine because it seems contrary to the rule of law that the owner of a trademark must actually use that mark in commerce.¹³⁰

With respect to such publicly-generated nicknames, the United States Court of Appeals for the Second Circuit dealt with a similar situation in *Harley-Davidson, Inc. v. Grottanelli*.¹³¹ In that case, the Harley-Davidson motorcycle manufacturer sought to prevent a motorcycle repair shop from using the term “HOG” to refer to Harley-Davidson motorcycles.¹³² In the late 1960’s and 1970’s, motorcycle enthusiasts had organically begun to use the nickname, “HOG” to refer to all large motorcycles, but from the

¹²⁷ *Cont’l Corrugated Container Corp. v. Cont’l Group, Inc.*, 462 F. Supp. 200, 204 (S.D.N.Y. 1978); *see also* MCCARTHY, *supra* note 121, § 7:18 (discussing cases).

¹²⁸ MCCARTHY, *supra* note 121, (citing *Big Blue Prod., Inc. v. Int’l Bus Mach. Corp.*, 19 U.S.P.Q.2d 1072 (T.T.A.B. 1991)) (IBM may be able to prove that the designation “BIG BLUE” was a trade name identifying IBM because of use in the trade, news media and public, even prior to actual use in commerce as a trademark by IBM in 1988).

¹²⁹ *See Nat’l Cable Television Ass’n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572 (Fed. Cir. 1991) (finding that an organization need only to have used a name or acronym in a manner that identifies the company by that name or acronym to the public, no particular formality of adoption or display is necessary to establish trade name identification).

¹³⁰ *See* Peter M. Brody, *What’s in a Nickname? Or, Can Public Use Create Private Rights?*, 95 TRADEMARK REP. 1123, 1164 (2005); *see also* Llewellyn J. Gibbons, *Crowdsourcing a Trademark: What the Public Giveth, the Courts May Taketh Away*, 35 HASTINGS COMM. & ENT. L.J. 35, 69–70 (2012).

¹³¹ *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 809 (2d Cir. 1999).

¹³² *Id.* at 808.

1970's into the early 1980's, motorcyclists increasingly used the nickname to refer to Harley-Davidson motorcycles specifically.¹³³ However, the Harley-Davidson company did not use the term in a commercial trademark manner until 1981, or in connection with the advertising of its motorcycles until 1990.¹³⁴

Consequently, because the evidence showed that the public's use was not consistently in line with always referring to Harley-Davidson brand motorcycles as "HOG," the New York court found the term "HOG" to be "generic as applied to motorcycles" and held that the Harley-Davidson company had "no . . . right . . . to withdraw from the language a generic term, already applicable to the relevant category of products, and accord it trademark significance, *at least as long as the term retains some generic meaning.*"¹³⁵

Large university detractors argue, like Harley-Davidson, Virginia Tech and others are attempting to appropriate exclusive rights in essentially generic words coined by the public. Thus, they argue the "Public Use" doctrine should not apply.¹³⁶ Applying these critics' arguments against the public use doctrine would hold that the nicknames the public applied to members of their own community long before the schools ever attempted to use them in a commercial manner should remain generic and in the public domain.¹³⁷

However, other legal commentators agree with the line of cases that uphold trademark rights even in nicknames and abbreviations used only by the public.¹³⁸ Professor McCarthy argues:

an abbreviation should be protectable from infringement if in the public mind the abbreviation identifies a company or its product, even if the company itself has not used the abbreviation in a

¹³³ *Id.* at 808–09.

¹³⁴ *Id.* at 809.

¹³⁵ *Id.* at 811–12 (emphasis added).

¹³⁶ See Brody, *supra* note 130, at 1158–62; see, e.g., George & Co. v. Imagination Entm't Ltd., 575 F.3d 383, 403 (4th Cir. 2009) (“[T]he Public Use doctrine generally is confined to instances in which the public modifies a well-known brand into a nickname or abbreviation.”).

¹³⁷ See Brody, *supra* note 130, at 1158–62; see also Gibbons, *supra* note 130, at 70–71.

¹³⁸ MCCARTHY, *supra* note 121, at § 7:18.

formalistic way as a trade name, trademark or service mark. It is public use that will set the stage for confusion, which is the evil to be remedied in trademark cases.¹³⁹

Interestingly, Virginia Tech essentially concedes that the term HOKIE retains some generic meaning by indicating that the term's common and ordinary meaning is "a loyal Virginia Tech Fan" or "a supporter of Virginia Tech."¹⁴⁰ The rationale adopted by the court in *Grottanelli* therefore seems relevant: "[n]o manufacturer can take out of the language a word, even a slang term, that has generic meaning as to a category of products and appropriate it for its own trademark use."¹⁴¹

However, the TTAB sidestepped the controversy of the Public Use doctrine in its *Hokie* decision by holding: "[t]he facts in Harley-Davidson are inapposite to the relevant circumstances of this proceeding."¹⁴² The Second Circuit found that "'hog' was a generic term in the language as applied to large motorcycles before the public (or at least some segments of it) began using the word to refer to Harley-Davidson motorcycles."¹⁴³ That is, the court held that the term "hog" was a generic reference in connection with respect the relevant genus of goods, namely large motorcycles, before ruling that the motorcycle manufacturer could not prohibit the opposing party from using "hog" to identify his motorcycle parts and services. In contrast, the plaintiff in the *Hokie* case "ha[d] not argued, or proven, that the term HOKIE is generic for the relevant genus of services, namely, educational or entertainment services."¹⁴⁴

¹³⁹ *Id.*

¹⁴⁰ See VA. TECH ATHLETICS, *supra* note 32; see also Complaint at 3, *Hokie Real Estate*, 813 F. Supp. 2d at 752 (W.D. Va.) (No. 7:10CV00466).

¹⁴¹ *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999); *accord Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001) ("[T]he law of trademarks . . . protects for public use those commonly used words and phrases that the public has adopted, denying to any one competitor a right to corner those words and phrases by expropriating them from the public 'linguistic commons.'").

¹⁴² *Onomastics Opposition*, *supra* note 50, at 22.

¹⁴³ *Harley-Davidson*, 164 F.3d at 812.

¹⁴⁴ *Onomastics Opposition*, *supra* note 50, at 38.

Thus, while not precedential, the recent *Hokie* decision by the TTAB and other applicable case law supports the general proposition that universities can legally appropriate a generic or descriptive term by developing a single source identification among the relevant consuming public, at least for a slightly different type of services or goods.¹⁴⁵

B. RATIONALE FOR APPROPRIATING GENERIC/DESCRIPTIVE TERMS

Even if the law permits such an aggressive and creative approach, why would a university choose to market its products or services by attempting to capture a previously-used nickname coined by the public, instead of inventing a wholly new arbitrary one? To the extent that a term has already been time-tested and established (*e.g.*, it has functioned in the local lexicon), it may stand a better chance of garnering and retaining brand equity than a new one that is unknown.

First, a captured nickname is more “authentic.” Such an authentic captured term starts out with an advantage in having public recognition and acceptance on day one. Virginia Tech is in a better marketing position with ownership of the term, “HOKIES” than it would be with ownership of an artificially invented term like “VTEKKER,” because it is not certain that students would ever adopt the artificial nickname.

“Rights in a trademark are acquired and maintained through *commercial* use,” which the universities will invariably make.¹⁴⁶ A mark is used in commerce on goods in the United States when “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.”¹⁴⁷ Similarly, a mark is used in conjunction with services “when it is used or displayed in the sale or advertising of services.”¹⁴⁸

¹⁴⁵ *See id.*

¹⁴⁶ *Major League Baseball Props., Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1126 (S.D.N.Y. 1993) (emphasis added) (“The law of trademarks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption” (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918))), *vacated by settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994).

¹⁴⁷ 15 U.S.C. § 1127 (2006).

¹⁴⁸ *Id.*

Thus, various students, alumni, and supporters of the schools could have used these terms in a colloquial, generic, or descriptive fashion. However, if they have not consistently or *commercially* exploited the term as a brand, the nickname or acronym can ultimately be appropriated through commercial use that begins to alter the linguistic terrain, such that the term becomes associated with a single commercial source—namely, the university itself. Further, trademark rights are based on time—priority of rights is based on the principle of first in time, first in right. Thus, a university that plants its flag by claiming rights to a mark that was once descriptive (*e.g.*, Notre Dame’s use of “domers”) can force all newcomers off the market through protracted litigation. Over time, the mark would presumably begin to function as a single source identifier with the university alone.

VI. CONCLUSION

Collegiate licensing programs have aggressively sought to appropriate nicknames and acronyms as trademarks, and to monopolize them as commercial brands using the legal system’s heavy hand to prevent unauthorized uses. While trademark law apparently permits such a creative approach to acquire legal rights, real conflicts can erupt within the local communities where these schools are located when those rights are vigorously enforced. Universities should be mindful to exert their newfound intellectual property rights in a measured way to recognize that the public should have a limited right to continue to use the terms they coined.