Protecting the University’s Name: Collegiate Licensing Programs

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Arizona State University

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Protecting the University’s Name

- Athletic Department
- Affiliated Organizations
- Athletic Conference
- Bowls and Tournaments
- Faculty/Staff
- Film Production on Campus
- Student Organizations/Club Teams

Arizona State University™
<table>
<thead>
<tr>
<th>DATE</th>
<th>OPPONENT</th>
</tr>
</thead>
<tbody>
<tr>
<td>SEPTEMBER</td>
<td></td>
</tr>
<tr>
<td>5  (SAT.)</td>
<td>WASHINGTON at BYU</td>
</tr>
<tr>
<td>12 (SAT.)</td>
<td>NORTH TEXAS</td>
</tr>
<tr>
<td>19 (SAT.)</td>
<td>OREGON STATE</td>
</tr>
<tr>
<td>26 (SAT.)</td>
<td></td>
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Protecting the University’s Name

- Advertising
- Campus Bookstore
- Coaches/Sports Camps
- Corporate Sponsors
- Donors
- Lessees
- Affinity Credit/Telephone Cards
- Commercial Web Sites
"Authorized" use

Unauthorized use
Quality Service Since 1978
Family Owned & Operated

Welcome to the Sun Devil Auto Website...Your First Choice for Complete Car Care

CORPORATE OFFICES
1830 E. Elliot Rd. #104
Tempe, AZ 85284
(480) 491-4246

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Brief History of Collegiate Licensing

- Colleges and Universities became involved to prevent unauthorized use of the institution's name and symbols by third parties
- UCLA, Ohio State, USC - first institutions to establish licensing programs in the mid 1970s
Growth of Licensing

- 1982 – 28 collegiate licensing programs
- 1992 – over 200 programs
- Present – approximately 400 programs
  - One-half are managed by Collegiate Licensing Company or the Licensing Resource Group.
  - Remainder are independent, self-managed programs

Association of Collegiate Licensing Administrators (ACLA) - forum for communication
Reasons for Establishing a Trademark Licensing Program

- Protection
- Promotion
- Profit
Protecting Your Rights

- Trademark rights protected by
  - maintenance
  - watching
  - enforcement

- Failure to prosecute infringers may result in abandonment
Recent Developments-Litigation

- **White v. Board of Regents of the University of Nebraska**
- **Buzas Baseball, Inc. v. Board of Regents of the University System of Georgia**
- **adidas America, Inc. v. National Collegiate Athletic Association**
- **President and Fellows of Harvard University v. Rhys dba Web-Pro**
Litigation (Continued)

- The Trustees of Columbia University v. Columbia HCA Healthcare Corporation
- Illinois High School Association v. GTE Vantage, Inc.
- Dream Team Collectibles, Inc. v. NBA Properties, Inc. and USA Basketball, Inc.
- Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions
Protecting Institutional Trademarks on the Internet
Use of trademarked words and logos on websites

- **®** Need permission
- **®** Unauthorized use may infringe
Educate your campus

- Ease of downloading does not eliminate need for permission
- Often the most frequent offenders are alumni, students, faculty and staff
- Instruct the campus community on ways to obtain permission
Website address

- Analogous to trademark
- Indicates source of the information
- Address may contain or reference institutional name or logo
<table>
<thead>
<tr>
<th>Website address concerns</th>
</tr>
</thead>
<tbody>
<tr>
<td>➢ May be misleading (e.g., compare whitehouse.com and whitehouse.gov)</td>
</tr>
<tr>
<td>➢ May suggest an affiliation with your institution (asunudes.com)</td>
</tr>
<tr>
<td>➢ May be intended to divert traffic from your sites</td>
</tr>
<tr>
<td>• To competitors</td>
</tr>
<tr>
<td>• To hate sites</td>
</tr>
</tbody>
</table>
Use of the domain name asunudes.com has been stopped. Asunudes.com constituted an infringement on the rights of Arizona State University, the owner of the ASU trademark. A decision of the World Intellectual Property Organization (WIPO) has determined that:

1. The asunudes.com domain name is confusingly similar to the University's ASU name and mark.
2. The operator of the asunudes.com website had no rights or interest in the asunudes.com domain name.
3. The asunudes.com domain name was registered and used in bad faith.

ICANN (Internet Corporation for Assigned Names and Numbers)

- Non-profit corporation
- Coordinates assignment of domain names
- http://www.icann.org
The Internet Corporation for Assigned Names and Numbers

ICANN Resources

- Announcements
- At Large Study
- Calendar of Events
- Contact ICANN
- Country-Code Top-Level Domain Resource Materials
- Correspondence
- Domain-Name Dispute Resolution (UDRP)
- Frequently Asked Questions (FAQ)

New and Noteworthy:

NEW: Questionnaire on Uniform Domain-Name Dispute Resolution Policy (UDRP) Posted (6 January 2002)


To register a website

- InterNIC lists registration resources
- http://www.internic.net
- Registration of obvious institutional references may discourage infringers
Welcome to the InterNIC Website!

This website has been established to provide the public information regarding Internet domain name registration services and will be updated frequently.

For a list of ICANN-accredited registrars that are currently taking registrations in the .com, .net and .org domains, please go to The Accredited Registrar Directory. To submit a complaint about an accredited registrar go to the Registrar Problem Report form.

To view a list of frequently asked questions (FAQs) regarding domain name registration, please go to The InterNIC FAQ.

To access information regarding registered domains, please go to the Registry Whois.

Current Topics
What if you find a site that is using your name, infringing on your mark or that contains disparaging material?
WHOIS can help you to identify the registered owner

✓ http://whois.net

✓ Provides contact information (name, address) for registered owner

✓ May also reveal other infringing sites
### Use this Whois Tool to:

<table>
<thead>
<tr>
<th>Search by Domain Name or by keyword</th>
<th>Explanation of Tool:</th>
</tr>
</thead>
<tbody>
<tr>
<td>Search domains and lookup whois information.</td>
<td></td>
</tr>
<tr>
<td>Research and protect trademarks.</td>
<td></td>
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</table>

**Get your own Domain Name**

- Find available domains and lookup Whois records

### Other tools and information:
- Whois Domain Name lookup
- Suggest-a-name Search
- Deleted domain Search [Try it!](#)
- Get Your Internet Keyword Now!
- Free Domain Name Monitoring!

### Domain Stats:
- 37,672,892 com/net/org domains registered
- 7,918,852 domains on-hold
<table>
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<tr>
<th><strong>Contact owner to discontinue infringing use</strong></th>
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<tbody>
<tr>
<td>✓ Similar to trademark cease and desist letter</td>
</tr>
<tr>
<td>✓ Infringer may offer to sell the offending registration to you</td>
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If an infringer will not discontinue use:

- **UDRP (Uniform Domain Name Dispute Resolution Policy)**
- [http://www.icann.org/udrp](http://www.icann.org/udrp)
- expedited arbitration procedure for suspected cybersquatting
- inexpensive and entirely electronic
- does not preclude later litigation
- consult with counsel regarding expense estimate
Uniform Domain-Name Dispute-Resolution Policy

General Information

All registrars in the .biz, .com, .info, .name, .net, and .org top-level domains follow the Uniform Domain-Name Dispute-Resolution Policy (often referred to as the "UDRP"). Under the policy, most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.

To invoke the policy, a trademark owner should either (a) file a complaint in a court of proper jurisdiction against the domain-name holder (or where appropriate an in-rem action concerning the domain name) or (b) in cases of abusive registration submit a complaint to an...
You must prove

- Respondent’s domain name is identical or confusingly similar to your institution’s trademarks or service marks
- Respondent has no right or legitimate interest in using the name
- Respondent has registered the domain name in bad faith
Code of Conduct

- University’s social responsibility
- Workplace Standards
- Amendment to Reauthorization of the Higher Education Act sponsored by Congressman George Miller of California
- University of California
  - First policy promulgated August 3, 1998
  - Current version adopted January 5, 2000
  - Member of WRC and FLA
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<tr>
<th>Oversight Organizations</th>
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<tr>
<td><strong>Fair Labor Association (FLA)</strong></td>
</tr>
<tr>
<td>• established under the auspices of the Apparel Industry Partnership (AIP) with participation from the White House and Dept. of Labor</td>
</tr>
<tr>
<td>• 173 members as of January 14, 2002</td>
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<tr>
<td><strong>Worker Rights Consortium (WRC)</strong></td>
</tr>
<tr>
<td>• organized by United Students Against Sweatshops</td>
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<tr>
<td>• 92 members as of December 13, 2001</td>
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Implementation of Labor Codes

- Independent University Initiative (IUI)
- Joint University/Collegiate Licensing Company (CLC) pilot project conducted by Verité