

# Protecting the University's Name: Collegiate Licensing Programs

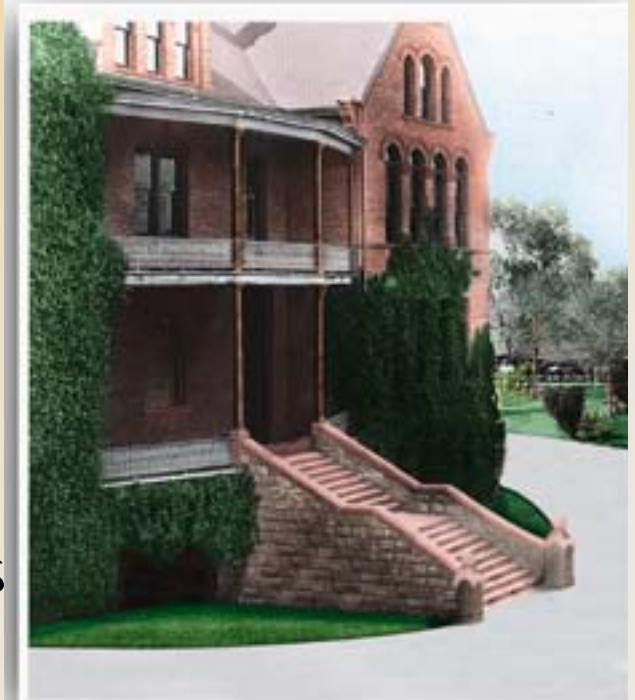


Paul J. Ward  
Nancy E. Tribbensee  
Arizona State University

February 17, 2002

# 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™**

**WELCOME BACK ASU**



**ASU SUN DEVILS**

**1998 FOOTBALL SCHEDULE**

**DATE**

**OPPONENT**

**SEPTEMBER**

**5 (SAT.)  
12 (SAT.)  
19 (SAT.)  
26 (SAT.)**

**WASHINGTON  
at BYU  
NORTH TEXAS  
OREGON STATE**

# 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



User Services

- ASU Homepage
- Alumni Homepage
- Sun Devil Athletics
- State Press
- ASU Public Events
- ASU Bookstore
- Career Services
- ASUChat
- Free E-mail
- Get Local Info!

add content | change colors

Search the Web my options Ask a question or search for a keyword: [input] Search

- zSunDevils News my options
- Arntzen to Join ASU as Nelson Presidential Chair
  - Professor of Year a difference maker
  - Millennium Fellowships provide boost for ASU's doctoral students

- Explore Interests my options
- |                                 |                             |                               |
|---------------------------------|-----------------------------|-------------------------------|
| <b>Auto</b>                     | <b>Games</b>                | <b>Travel</b>                 |
| <b>Business</b>                 | <b>Health &amp; Fitness</b> | Reservations, Research a Trip |
| Careers, Small Business         | Exercise, Medicine          |                               |
| <b>Computers &amp; Internet</b> | <b>Home &amp; Family</b>    |                               |
| Hardware, Software              | Parenting, Kids & Teens     |                               |
| <b>Entertainment</b>            | <b>Politics</b>             |                               |
|                                 | Campaign 2000               |                               |

First time User? Register Here.

MyWay tip Save your searches on our site for quick and easy reference. More tips

Local my options Enter zip code for local info [input] Go

Daily Planner my options Reminders Calendar Address Book

Favorite Links my options Add yours here

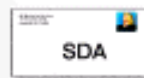


Complete Car Care



Quality Service Since 1978  
Family Owned & Operated

Welcome to the Sun Devil Auto Website...Your F



**CORPORATE OFFICES**

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

Design by MJ Marketing, Inc.

Copyright © 1998, Sun Devil Auto, Inc., All Rights Reserved

# 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

---

- ① Need permission
- ① 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

## Website address concerns

---

- May be misleading (e.g., compare [whitehouse.com](http://whitehouse.com) and [whitehouse.gov](http://whitehouse.gov))
- May suggest an affiliation with your institution ([asunudes.com](http://asunudes.com))
- May be intended to divert traffic from your sites
  - To competitors
  - To hate sites



## ARIZONA STATE UNIVERSITY

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.

*See Arizona Board of Regents for and on Behalf of Arizona State University v. Value Holdings, Inc., Case No. D2001-0445 (WIPO May 31, 2001).*

# 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

[About ICANN](#) [Supporting Organizations](#) [Committees, Task Forces,  
Etc.](#) [Organizational Chart](#) [Site  
Search](#)

## 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)

**NEW:** [ICANN Meetings in Accra, Ghana – 10-  
14 March 2002](#) (6 January 2002)

**NEW:** [DNS Security Update #1 \(November  
2001 Security Meeting Report\) Issued](#) (4 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

January 11th, 2002

Use this Whois Tool to:		Explanation of Tool:	
Search by Domain Name or by keyword	<input type="text"/>	<input type="button" value="Go!"/>	Search domains and lookup whois information.  Research and protect trademarks.
Get your own Domain Name	<input type="text"/> <input type="text" value=".com"/>	<input type="button" value="Go!"/>	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



## Contact owner to discontinue infringing use

---

- ✓ Similar to trademark  
cease and desist letter
- ✓ Infringer may offer to  
sell the offending  
registration to you

## If an infringer will not discontinue use:

---

- UDRP (Uniform Domain Name Dispute Resolution Policy)
- <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

# Oversight Organizations

---

- ❖ Fair Labor Association (FLA)
  - established under the auspices of the Apparel Industry Partnership (AIP) with participation from the White House and Dept. of Labor
  - 173 members as of January 14, 2002
  
- ❖ Worker Rights Consortium (WRC)
  - organized by United Students Against Sweatshops
  - 92 members as of December 13, 2001



# Implementation of Labor Codes

---

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