

■ Trademark law for sports fans

The 12th Man goes to court

■ The Enforcer

Enforcing judgments within the European Union



NO joke

What can you do when parody goes too far?

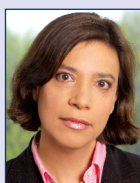
THE CASE

- *Texas A&M University v. Seattle Seahawks, Inc., et al.*
- Cause No. 06-000231-CV-85
- 85th Judicial, Brazos County, Texas



AUTHOR

Lisa Pearson is a partner in the New York office of Kilpatrick Stockton LLP specializing in trademark, copyright and Internet litigation and counselling. She has also designed and implemented comprehensive anti-counterfeiting, policing and enforcement programs for many well-known rights owners. Lisa has represented clients across a broad spectrum of industries, including publishing, entertainment, consumer products, fashion, advertising, hotel and travel and many others.



Trademark Law for sports fans

The 12th Man goes to court

Lisa Pearson of Kilpatrick Stockton reflects on the passions behind the recent tussle to win the right to the 12th Man.

What does it take to get American football fans impassioned about trademark law? A pre-Super Bowl dispute over a mark that, quite literally, signifies the good will of the fans themselves: THE 12th MAN. There are eleven players on a U.S. football team. The phrase “The 12th Man” refers to the team’s fans.

The fight

On 30 January 2006, Texas A&M University filed a complaint in its local state court in Brazos County, Texas against Seattle Seahawks, Inc., Seattle Professional Football, Inc. and Football Northwest, LLC (collectively, the “Seahawks”) alleging infringement and dilution of A&M’s cherished 12th MAN mark under state common law and the Lanham Act, the federal trademark statute. *Texas A&M University v. Seattle Seahawks, Inc., et al.*, Cause No. 06-000231-CV-85 (85th Judicial, Brazos County, Texas). The state university vehemently objected to the use of the 12th MAN mark by the Seahawks, a professional football team then on its way to the National Football League’s Championship Super Bowl game, to refer to Seahawks fans in advertisements, on the Seahawks website, and on merchandise such as shirts, towels, buttons and flags. In addition, A&M complained, the Seahawks raised a 12th Man flag at their stadium Qwest Field just before kick-offs, and similar flags were hoisted on the Space Needle (Seattle’s most famous landmark) and office buildings in the area.

A&M filed an application for a temporary restraining order together with its complaint to prevent the Seahawks from continuing these activities until the court could decide a preliminary injunction motion. A&M claimed: “there will be more and

more use of Texas A&M’s ‘12th MAN’ marks with the upcoming Super Bowl game, with millions of [infringing] products...being sold and with over a billion viewers watching the improper use and dilution of Texas A&M’s ‘12th MAN’ marks at the Super Bowl.”

That same day, Judge J.D. Langley entered the temporary restraining order *ex parte*, without notice to the Seahawks or requiring A&M to post a bond.

The fans of both teams went wild. The Seahawks obviously felt sandbagged. Sports commentators began sounding like legal correspondents and sports bloggers around the country, confident in their trademark law expertise, started arguing the merits of the case.

A&M’s 12th MAN tradition

The 12th MAN dispute, and the resulting hoopla, owes their origin to a great sports legend, dating back to 2 January 1922. Every A&M student knows it by heart. According to the school’s website,

“an underdog Aggie team was playing Centre College, then the nation’s top ranked team. As the hard fought game wore on, and the Aggies dug deeply into their limited reserves, Coach Dana X. Bible remembered a squad man who was not in uniform....His name was E. King Gill, and was a former football player who was only playing basketball. Gill was called from the stands, suited up, and stood ready throughout the rest of the game, which A&M finally won 22-14. When the game ended, E. King Gill was the only man left standing on the sidelines for the Aggies. Gill later said, ‘I wish I could say that I went in and ran for the winning touchdown, but I did not. I simply stood by in case my team needed me.’”

According to A&M, the 12th Man is one of its most “revered, inviolate, and time-honoured” traditions, and it not only symbolizes the school and its football program, but A&M’s school spirit. The phrase certainly garners enormous good will. Aggie fans – the collective 12th Man – reportedly stand throughout every A&M football game to show their solidarity with their team.

In 1990, A&M secured a federal trademark registration for the 12th MAN mark for a variety of merchandise (claiming use dating back to 1983) and college scholarship services (claiming use dating back to 1965). In 1996, A&M secured a second federal registration for “entertainment services, namely organizing and conducting intercollegiate sporting events” (claiming use dating back to 1922). In addition, it owns a 1998 registration for 12th MANIA! for a variety of merchandise and fund raising services. In its lawsuit, A&M also relied upon its common law trademark rights arising from somewhat vaguely defined use of the “12th MAN marks” since the momentous day when E. King Gill stood on the sidelines ready to serve if called.

Procedural skirmishing

On 2 February 2006, three days after A&M obtained its temporary restraining order, the Seahawks removed the case to federal district court in Houston, Texas based on the diversity of citizenship of the parties and the fact that the case raised a federal question.¹ Three days later, the Seahawks lost Super Bowl XL to the Pittsburgh Steelers, 21-10. They did not, however, lose the case. In fact, the Seahawks never even filed an answer to the complaint or opposed A&M’s motion for a preliminary injunction.

After removing the case to federal court in Texas, the Seahawks sought to gain another advantage by filing a motion to transfer the case to the federal district court in their own hometown, Seattle. That motion was never decided. Instead, on 5 May 2006, A&M and the Seahawks advised the court they had reached a settlement, and the case was dismissed. The Seahawks acknowledged A&M’s federal trademark rights and the teams entered into a license agreement permitting the Seahawks to continue using the phrase in the Pacific Northwest. According to certain news reports, the Seahawks made a one time payment of \$100,000 and further agreed to pay \$7,500 a year in license fees. Neither party admitted any fault or liability.

Hypothetical defence

The Seahawks never presented their defences to A&M’s claims, leaving plenty of room for commentary by trademark lawyers.

Here are a few possible lines the team could have pursued, depending on their game plan:

- To the extent that the Seahawks used the phrase “12th Man” to refer to fans and fan-related activities, they had plausible defences that the phrase has become generic and that their use was fair use. An Internet search discloses that many other school and professional teams use the phrase 12th Man in this manner. Further, the phrase has made its way into some dictionaries. Much of the emotion over this case stems from Aggie fans’ sense of ownership over the phrase, but U.S. trademark law does not give trademark owners that kind of a monopoly.
- Due to the undeveloped state of the record, the nature and extent of the Seahawks’ use of A&M’s registered 12th MAN marks is far from clear. The Seahawks so-called “12th Man flag”, for example, simply bore the number 12, as did much of the merchandise depicted in A&M’s pleadings (with the exception of a button bearing the phrase “THANKS 12th MAN”). Further, in their transfer motion, the Seahawks argued that local media companies, businesses, and other third parties not under the Seahawks’ control used the phrase “12th Man” and the number 12 as pseudonyms for Seahawks fans. (A&M did submit exhibits indicating that the Seahawks themselves referred to the Number 12 flag as the “12th Man flag” and carried on their website a 12th Man advertisement for a local restaurant.) In a telling footnote in its brief in opposition to the Seahawk’s transfer motion, A&M began to refine its legal arguments. It conceded that it did not object to fans flying a flag with a 12 on it or the Seahawks retiring a number 12 jersey: “It is only when Defendants inextricably tied the use of ‘12’ to Plaintiff’s mark ‘12th MAN’ as they have done recently at their stadium by using the identical slogan to that used by Plaintiff – HOME OF THE 12th MAN – that use of 12 becomes potentially an issue.” Had the case not settled, the Seahawks would no doubt have claimed that many if not all of their claimed infringements were not “trademark use” or were not attributable to the Seahawks at all.
- Yet another line of defence is suggested by



the Seahawks’ own 12th Man tradition, which evidently predates the filing dates of A&M’s federal trademark applications.

(The filing of a federal trademark application, establishes nationwide priority by operation of law once the registration issues.) The Seahawks reportedly retired their number 12 jersey in honour of their fans in 1984, and have evidently used the number 12 and the phrase “12th Man” to inspire fan loyalty since that date, if not earlier. In the U.S., common law trademark rights generally arise from use or reputation in a particular geographic area and are protected on a territorial basis. Accordingly, multiple users of similar marks may each acquire independent common law trademark rights in separate geographic markets regardless of who first used the mark in commerce. If the Seahawks could establish that they developed common law rights in the number 12 or the 12th MAN mark for certain goods or services before A&M applied to register its marks, perhaps they could carve out a niche for such uses, at least in the Pacific Northwest.



The return of the 12th Man

The Seahawks never tested their defences, real or hypothetical, due to the settlement. A&M walked away from the dispute with stronger rights in its 12th MAN marks by converting the Seahawks allegedly unauthorized uses into licensed uses that inure to A&M’s benefit. But that may not be the end of the story.

In late June 2006, the media reported that A&M was in another skirmish over the 12th Man. It sent a demand letter to Yahoo, the popular search engine, asking Yahoo to cease using the 12th MAN marks on its World Cup Soccer fan page. At the time of writing, Yahoo was still using the phrase.

Who would have guessed that trademark litigation could become such a popular spectator sport? 

Notes

- 1 In the U.S., both state and federal courts have jurisdiction over trademark cases brought under the federal Lanham Act. Plaintiffs sometimes prefer to file in their home state court, on the theory that the judge and jury pool will be more sympathetic. (Judge Langley, for example, was an A&M alumnus). The defendant may, in appropriate cases, remove the case to federal court, which is (at least in theory) less biased.