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Goodwill U: School Name Change & Trademark Law

Alexandra J. Roberts*

Introduction

When I read last year's deeply disturbing Rolling Stone article about dangerous fraternity hazing rituals at Dartmouth College,[1] I—like most readers—was horrified. But unlike some readers, I was also mortified. Several months later, when I learned that U.S. News and World Reports had ranked Dartmouth first on its list of schools most committed to teaching[2] and tenth among national universities overall,[3] I felt proud. My reactions to both events were not just manifestations of affection for my alma mater. Rather, they stemmed from my awareness that public perceptions of Dartmouth shape perceptions of its alumni. Like all trademarks, university names serve as receptacles for goodwill. The DARTMOUTH COLLEGE trademark houses the associations, both positive and negative, that the school and its name bear for consumers. Those associations affect not only the institution and its current and potential students but also, to a large extent, its alumni.

Trademark malfeasance is typically measured in terms of its effects on a mark owner's bottom line. The Lanham Act provides producers with a cause of action for trademark infringement because if potential consumers are confused or deceived by an infringing use, the producer risks losing sales. It provides the owners of famous marks with a cause of action for dilution on the theory that diluting uses will harm the brand's reputation or prestige, undermining its earning potential. Conversely, mark owners are free to abandon or reduce the use of a trademark in connection with goods or services, a process some commentators have termed "unbranding,"[4] when the mark's goodwill is net negative (that is, when goodwill becomes "badwill").[5] In those

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1. Janet Reitman, *Confessions of an Ivy League Frat Boy: Inside Dartmouth's Hazing Abuses*, Rolling Stone (Mar. 28, 2012). http://www.rollingstone.com/culture/news/confessions-of-an-ivy-league-frat-boy-inside-dartmouths-hazing-abuses-20120328.
2. U.S. News, *Best Undergraduate Teaching National Universities*, U.S. News Education, http://colleges.usnews.rankingsandreviews.com/best-colleges/rankings/national-universities/undergraduate-teaching (last visited April 16, 2013).
3. U.S. News, *National University Rankings*, U.S. News Education, http://colleges.usnews.rankingsandreviews.com/best-colleges/rankings/national-universities/page+2(last visited April 16, 2013).
4. For further discussion of unbranding, *see* Aaron Perzanowski, *Unbranding, Confusion, and Deception*, 24 Harv. J.L. & Tech. 1, n.46 (2010).
5. *See generally* Note, *Badwill*, 116 Harv. L. Rev. 1845, 1852-54 (2003).

situations, trademark law does not prevent producers from shedding a bad reputation by changing a product's name while they continue to make the same product available under a different name. Nor does trademark law prevent producers from abandoning trademarks possessed of copious positive goodwill, because only the producers themselves usually stand to lose from such a business decision.

Setting aside the intentional deception that characterizes some instances of unbranding, the existing regime appears to foster competition and protect consumers adequately when it regulates trademark use on traditional goods and services. It succeeds precisely because consumer consumption of branded goods is often, quite literally, consumptive, and the consumer's engagement with the mark thus finite rather than continuous. If I buy a cup of coffee marked DUNKIN' DONUTS, I will finish drinking it within the hour and throw the cup in the garbage, terminating my association with the DUNKIN' DONUTS trademark (at least for the time being). A hoodie emblazoned with the mark NIKE lasts longer, but I can don it and doff it at will: if I learn of Nike's reputation for relying on sweatshop labor and decide I no longer want to be associated with NIKE products, I can toss it, sell it, or abstain from wearing it in public. The same holds true for service marks, whether used in connection with luxury spas or budget-friendly barbers.

Dartmouth is, or ought to be, different from Nike and Supercuts. I can't shed my identity as an alumna like I can a hoodie or a hairdo; it appears on my resume and diploma and forms an integral part of my identity and my professional reputation. If the trustees decided to change Dartmouth's name today, their decision to do so would necessitate abandoning the goodwill that has accrued in the DARTMOUTH mark over nearly two hundred and fifty years of use, affecting not only current and future students but alumni as well. If they chose instead to operate the school under the trademark D'SOUZA COLLEGE in honor of conservative alumnus Dinesh D'Souza, a large number of alumni would likely revolt. If the Dartmouth, Massachusetts campus of the University of Massachusetts were to change its name simply to "Dartmouth," the change could trigger confusion that would harm Dartmouth College students and alumni as they apply to graduate schools, seek employment, and otherwise attempt to avail themselves of the benefits afforded by a Dartmouth College education. When a student enrolls in a school, it creates a relationship between the student and the school's trademark that is different from and broader than the relationship created when a consumer buys a more easily articulable good or service: the "product" purchased comprises not only educational services, but a degree. The school's good name, which may fluctuate over time, affects the degree's value.[6] In that sense,

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6. With luxury goods, as with universities, trademark owners may at times find the brand's reputation subject to events beyond their control. When an alumnus of a school or wearer of a branded good becomes infamous, the brand owner often has little recourse, and other alumni of those schools and owners of those goods may be affected to varying degrees. Abercrombie & Fitch's well-publicized response to a cast member on the television show Jersey Shore wearing its clothes regularly, for example, revealed the company's fear that the endorsement tainted its brand and detracted from its image. *See* Laurie Segall, *Abercrombie to 'Jersey Shore': Ditch our Brand*, CNN Money (Aug. 17, 2011), http://money.cnn.com/2011/08/16/news/companies/abercrombie_jersey_shore/index.htm.

students and alumni themselves become products of the university they attend; they represent the school to the world and bear its mark in perpetuity.

Despite the high stakes in school name changes, schools seem to be renamed just as often as are traditional goods.[7] A new name might acknowledge a major benefactor,[8] reflect a change in the school's status or affiliation,[9] seek to clarify existing misconceptions,[10] or serve as a component of a comprehensive rebranding initiative.[11] Yet when an existing institution abandons one name and adopts another, its actions beget a host of trademark issues, some of which cannot be adequately understood by analogy to traditional brand and product name changes. School name changes can confuse or deceive consumers and infringe competitor schools' marks, affecting alumni of all of the schools involved. Adopting a new name often necessitates that a school abandon a prior name that has acquired extensive goodwill, to the detriment of past, current, and future students. New names, especially those that honor living donors, risk tarnishing schools' trademarks by associating them with controversial figures. In addition, renaming may deeply harm alumni, who serve as not only their alma mater's consumers, but as its products. This Essay identifies and explores some of the intellectual property issues that university renaming raises and the trademark ramifications for alumni, including infringement, dilution, and abandonment of goodwill.

I. Infringement

When a school acquires trademark rights in its name, the mark can provide the basis for a cause of action for infringement against a competitor that uses

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7. See, for example, the lengthy (but non-exhaustive) list of US university and college name changes on Wikipedia, http://en.wikipedia.org/wiki/List_of_university_and_college_name_changes_in_the_United_States#cite_ref-1 (last visited April 16, 2013).
8. For example, DePaul University's College of Commerce was renamed the Richard H. Driehaus College of Business in 2012 following a thirty million dollar donation. Geoff Gloeckler, *What's in a Name? For B-Schools, Millions*, Business Week (Mar. 14, 2012), http://www.businessweek.com/articles/2012-03-14/whats-in-a-name-for-b-schools-millions.
9. For example, the Franklin Pierce Law Center became the University of New Hampshire School of Law in 2010 to reflect its new affiliation with the state university. Holly Ramer, *Trustees back merger of UNH, law school*, Boston Globe (Mar. 17, 2010), http://www.boston.com/news/education/higher/articles/2010/03/17/trustees_back_merger_of_unh_law_school/.
10. Western Maryland College was renamed McDaniel College in 2002 to correct what the administration perceived as misconceptions that the school was part of the state university system and that it was located in the far western part of the state. McDaniel College: History, http://www.mcdaniel.edu/information/about/history/ (last visited Apr. 16, 2013) ("Prospective students often mistook Western Maryland for a satellite of a public university and thought it was located in rural western Maryland.").
11. In 2013, the President of the University of Connecticut announced that with the help of Nike, the school will maintain its formal name but will be rebranded under its nickname "UConn." The nickname, along with a new logo, "will replace [']the University of Connecticut['] on the school[']s signs, letterhead, banners, advertising and web pages." Associated Press, *Nike helps rebrand University of Connecticut as UConn*, Oregon Live (Apr. 4, 2013), http://www.oregonlive.com/playbooks-profits/index.ssf/2013/04/nike_helps_rebrand_university.html.

a confusingly similar name or mark. A junior user's adoption of a similar mark constitutes infringement if it is likely to confuse consumers as to the goods or services' source or create the mistaken impression of sponsorship, affiliation, or approval.[12] In determining whether consumer confusion is likely, courts will typically look to a number of factors, including the mark's strength; the proximity of the goods or services; the similarity of the marks in sound, appearance, and meaning; any evidence of actual confusion; the similarity of marketing channels used; the degree of caution or sophistication exercised by the typical purchaser; and the defendant's intent.[13]

In 2011, a public university then known as Metropolitan State College of Denver announced its intention to change its name to Denver State University. Its re-branding initiative had four stated goals: "demonstrate the quality of the College's degree; eliminate confusion that Metro State is a community college, when it is a four-year baccalaureate and graduate institution; clarify the College's location in Denver; and make the name more concise."[14] Alumni of the University of Denver (also known as "DU"), a smaller private school that boasts a stronger reputation and higher price tag than Metro State, were furious about the potential change. They believed Metro State's new name was too similar to its UNIVERSITY OF DENVER and DU marks, and that the change would confuse consumers and enable Metro State to trade on the University of Denver's goodwill. Alumni feared they would be mistaken for graduates of Metro State, and that the latter's use of a similar name would "water down" their diplomas. One student noted, "I don't want some school that doesn't amount to the same level as [the University of Denver] to come and ride the coat tails of our reputation and confuse any of my future employers as to what school I went too" [sic].[15] Another believed that the name change reflected the administration's desire to pass off Metro State as the University of Denver and benefit from consumer confusion: "Metro knew what it was doing when it went for this name change. [It was] leeching off [the University of Denver's] reputation."[16] Other students and

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12. 15 U.S.C. § 1114, Lanham Act § 32(1); 15 U.S.C. § 1125, Lanham Act § 43(a).
13. Each circuit considers a different set of factors in gauging the likelihood of confusion between two marks, ranging from as few as six factors in the Tenth Circuit to as many as thirteen in the Federal Circuit. E.g., Sally Beauty Co. v. Beautyco, Inc. v. Marianna Im., Inc., 304 F.3d 964, 972 (10th Cir. 2002); In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973). For a general discussion of the various multi-factor tests, including the relative ability of each factor to predict the outcome of infringement litigation, *see* Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581 (2006).
14. Donna Fowler, *Strategic Name Initiative: DSU off the Table*, Metro State News (Nov. 14, 2011), http://www.mscd.edu/~collcom/artman/publish/name_twv9111411.shtml.
15. Comment by "DU Student," *Metro State Scumbags Trying To Steal Our Name*, Let's Go DU (March 9, 2011), http://letsgodu.blogspot.com/2011/03/metro-state-scumbags-trying-to-steal.html.
16. Comment by "dggoddard," *Metro State Scumbags Trying To Steal Our Name*, Let's Go DU (March 9, 2011), http://letsgodu.blogspot.com/2011/03/metro-state-scumbags-trying-to-steal.html.

alumni asserted that the potential trademark mis-described the school and thus misled the public, in that Metro State was more accurately characterized as a college rather than a university.[17]

Had the conflict between the two schools resulted in litigation, several of the traditional likelihood of confusion factors would weigh toward a finding of infringement. The UNIVERSITY OF DENVER and DU marks—assuming the school could establish trademark rights in its informal nickname—and the potential DENVER STATE UNIVERSITY mark would be used in connection with the provision of educational services, so their proximity is quite close. The marketing channels are likely to be the same, given that both entities advertise higher education opportunities for students at universities located in Denver, Colorado. The marks are also very similar in sound, appearance, and meaning. On the other hand, all three marks are weak, undercutting a likelihood of confusion. Both UNIVERSITY OF DENVER and DU are merely descriptive for universities located in the city of Denver, so each is only protectable upon a showing of secondary meaning. Even assuming the marks have acquired distinctiveness based on the duration of their use, a geographically descriptive mark is one of the weakest mark types, and its sphere of protectability is among the smallest.[18]

The characteristics that make UNIVERSITY OF DENVER and DU weak marks are characteristics common to many university trademarks. The vast majority of school names would likewise be classified as weak, whether they describe a school's services (in trademark terms, a "merely descriptive" mark), its location (a "primarily geographically descriptive" mark), a donor or namesake (considered "primarily merely a surname" and thus descriptive),[19] or some other aspect of the school. In fact, 6,232 of the 7,316 institutions of higher learning listed by the National Center for Education incorporate one of the four most common nouns to appear in school names: "college," "university," "institute," or "school."[20]

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17. To qualify as a university rather than a college, a school should offer more than a token number of graduate degrees. See, for example, the methodology used by US News and World Reports in categorizing colleges and universities, based on classifications created by the Carnegie Foundation for the Advancement of Teaching. Robert Morse, *Methodology: Best Colleges Ranking Category Definitions*, US News, (Sept. 10, 2012), http://www.usnews.com/education/best-colleges/articles/2012/09/10/methodology-best-colleges-ranking-category-definitions-2. Schools categorized as universities are more likely to have high research activity; however, some schools with both high research activity and graduate programs, such as Dartmouth College and Boston College, use the term "college" to highlight their emphasis on undergraduate education.
18. HBP, Inc. v. American Marine Holdings, Inc., 290 F.Supp.2d 1320, 1328 (M.D. Fla. 2003).
19. 15 U.S.C. § 1052, Lanham Act § 2. Mark strength is a product of two things: inherent distinctiveness and acquired distinctiveness (also called inherent strength and commercial strength). Marks that are merely descriptive, geographically descriptive, or primarily merely surnames lack inherent distinctiveness and thus are likely to be deemed weak unless they have acquired a great deal of distinctiveness through use. For example, STANFORD UNIVERSITY combines a surname with the generic term "university," but has achieved a degree of fame sufficient to make it a strong mark; many lesser-known schools are unlikely to have acquired sufficient fame to render their descriptive names strong.
20. *Can you name the most common words in the names of US colleges and universities?* Sporcle, http://www.sporcle.com/games/Tahnan/words-in-universitycollege-names (last visited March 13, 2013).

The most popular modifiers for those nouns, including "valley," "central," "technical," "American," "design," "career," and "new," are found in the names of over a hundred schools apiece.[21] Whether or not a mark is technically descriptive, courts will treat it as a weak mark that merits less protection if it includes terms common in the industry, reasoning that consumers are less likely to be confused when a term is already in use by multiple competitors.[22]

The degree of sophistication factor (or "consumer care" factor) also warrants extra attention in evaluating potential confusion for university name trademarks.[23] In a typical infringement analysis, a court analyzing the likelihood of confusion between trademarks used on relatively inexpensive consumer goods, such as air fresheners or peanuts, might deem purchasers of the goods unsophisticated (and thus confusion more likely). Given the products' low price, fact-finders expect shoppers to grab a box from a store shelf without carefully examining it.[24] On the other hand, purchasers of major investment items like automobiles will likely be deemed more sophisticated shoppers, due to the time they invest in selecting a car, the length of their commitment, the high price, and the risk inherent in choosing the wrong car.[25] In those cases, consumer sophistication weighs against the likelihood of confusion.

At first glance, the car analogy seems most apt in evaluating consumer sophistication in relation to school trademarks: if the relevant consumers are potential students, they stand poised to invest an enormous amount of money and time, and will select with great care the schools to which they apply and the schools that they ultimately attend. Courts would rightfully assume no one contemplating spending four years of his life and accruing six

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21. *Id*.
22. *See, e.g*., Peoples Federal Sav. Bank v. People's United Bank, 672 F.3d 1, 15 (1st Cir. 2012) (PEOPLES lacked distinctiveness for banking services, in part because "'people' ranks as the twelfth most commonly used word in bank names on the FDIC's website, appearing in the names of 159 banks in the United States");); Labrador Software, Inc. v. Lycos, Inc., 32 F. Supp. 2d 31, 33 (D. Mass. 1999) (LABRADOR and dog images as trademarks for information retrieval software lacked distinctiveness in light of frequent use by competitors of terms "Labrador" and "retriever"); Bliss Salon Day Spa v. Bliss World LLC, 268 F.3d 494, 498 (7th Cir. 2001) (affirming denial of injunctive relief for Bliss Salon against Bliss World, noting that "Bliss marks are a glut on the market in hair styling and beauty care" and thus not distinctive).
23. See Beebe, supra n.13. ("It makes sense, and has been confirmed empirically, that the more sophisticated the consumers, the more care with which they will treat their search and purchasing decisions.").
24. E.g., Car-Freshner Corp. v. Big Lots Stores, Inc., 314 F. Supp. 2d 145, 152 (N.D.N.Y. 2004) ("ordinary consumers of inexpensive retail products are likely to be confused by similar labels bearing similar marks"); Beer Nuts, Inc., v. Clover Club Foods Co., 805 F.2d 920, 926-27 (10th Cir. 1986) ("consumers exercise little care in purchasing…a small, inexpensive item such as a package of nuts").
25. E.g., Malletier v. Dooney & Bourke, Inc., 561 F.Supp.2d 368, 389 (S.D.N.Y. 2008) ("consumers of quality, expensive handbags—made by Louis Vuitton, Dooney & Bourke, and other high-end brands—tend to be sophisticated, hyper fashion-conscious, and are not likely to be easily confused…") Nautilus Group, Inc. v. Savvier, Inc., 427 F.Supp.2d 990, 999 (W.D. Wash., 2006) ("When the product is expensive," as is the $1,200 Bowflex exercise machine, "a buyer can be expected to exercise greater care."). *See generally* Thomas R. Lee, Glenn L. Christensen, & Eric D. DeRosia, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, 57 Emory L.J. 575, 580-81 (2008).

figures of debt would mistakenly enroll at Cornell College of Iowa when he intended to enroll at Cornell University in Ithaca.

But high school seniors are not the only members of the public who are relevant in evaluating whether similar university names create a likelihood of confusion. Trademark infringement analyses generally focus on confusion at the point of sale, asking whether a defendant's use of a trademark or trade dress might lead consumers to mistakenly purchase a product other than the one they intended to buy or thought they were buying, or whether consumers were confused as to affiliation or sponsorship at the time they made a purchase. But post-sale confusion—confusion that occurs not during but after a sale, and is experienced in the minds not of purchasers but of members of the general public—may also be actionable.[26] In the paradigmatic post-sale confusion case, someone knowingly purchases a knockoff luxury handbag, perhaps spending just twenty dollars on Canal Street for the imitation version of a purse that sells for over a thousand dollars at retail and bears the logo of a renowned fashion house like Prada. While the owner of the knockoff Prada is not deceived and never was, others observe the logo on the bag and believe it to be genuine. If they also observe that the bag is poorly made or falling apart, their source confusion affects the likelihood that they will buy a genuine Prada product in the future. In addition, if the Prada bag is perceived as a symbol and signal of high status due to its scarcity and price, and the availability of knockoffs renders that symbol widely obtainable, "the claim [to high status] loses its credibility—indeed its very meaning—due to indiscriminate use,"[27] and the mark's value decreases.

Many of the justifications for including post-sale confusion among the types of actionable trademark confusion apply with equal force in the context of university name confusion. If Metro State had changed its name to Denver State University, it is unlikely a student would arrive there for orientation week believing himself enrolled at the University of Denver. But others with whom he comes into contact are more likely to be deceived because some are bound to take less care than he did in distinguishing the two schools.[28] If Denver State University alumni enter the job market and prove less intelligent or less erudite than their

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26. *See, e.g.*, Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc., 221 F.2d 464 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955); Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235 (6th Cir. 1991), *cert. denied*, 505 U.S. 1219 (1992). For a discussion of the various types of injury that post-sale confusion may inflict on trademark holders, see General Motors Corp. v. Keystone Automotive Indus., Inc., 453 F.3d 351, 358 (6th Cir. 2006); Jeremy Sheff, *Veblen Brands*, 96 Minn. L. Rev. 769, 773-74 and n.16 (2012) (identifying three theories of post-sale confusion: "bystander confusion," "downstream confusion," and "status confusion.").
27. Sheff, supra note 26.
28. For an example of post-sale or analogous confusion of schools, consider the frequency with which journalists and others confuse the University of Pennsylvania with Pennsylvania State University; their errors shape the perceptions of both schools held by the general public. See, e.g., Rebecca Greenfield, *A Penn Service Announcement: It's Not Penn State*, The Atlantic Wire (Nov. 9, 2011), http://www.theatlanticwire.com/national/2011/11/penn-service-announcement-its-not-penn-state/44753/; *see also* posts tagged "Not Penn State" at blog Under the Button, http://underthebutton.com/tag/not-penn-state/.

DU counterparts, DU's reputation for selecting impressive students and providing high-quality education could be damaged, and that damage would extend to the reputations of its alumni. Employers and members of the public have less reason to exercise sophisticated reasoning than does a candidate in the process of selecting a school to attend; they are therefore more likely to confuse the two trademarks and thus to confuse the two schools and their alumni. When one school's name is confusingly similar to that of another school, the inferior school doesn't just improve its reputation by free-riding on that of the superior school; it also drags the latter down. If Denver State University graduates begin to pass themselves off as University of Denver graduates, then the market will suddenly be flooded with what appear to be DU alumni, decreasing the exclusivity and thus the value of a DU diploma. Likewise, in the wake of last month's bombing at the Boston Marathon, a handful of media outlets reported that one of the suspected bombers, Dzhokhar Tsarnaev, was a student at Dartmouth College, rather than the University of Massachusetts in Dartmouth.[29] Dartmouth College alumni took to Facebook and Twitter to lament the confusion and dispel the misconception that Tsarnaev had any association with their alma mater.[30]

In the case of the two Denver schools, officials at the University of Denver agreed with the school's alumni that Metro State's potential name change could create problems for the University of Denver community. Rather than wait to see how the name change would play out, they conducted a survey to gauge potential confusion, interviewing alumni, high school students, school counselors, and educators.[31] While surveys play a major role in trademark litigation, they typically seek to gauge the perceptions of potential consumers only;[32] the administrators' decision to include alumni in the relevant population is thus telling. Alumni opinions may have been deemed relevant not (or not only) because alumni bear the school's mark and are directly affected by name changes, but because alumni as a group include

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29. *E.g., WATCH LIVE: Press Conference For Lawyers Of Three New Suspects In Boston Bombing*, MEDIAITE TV (May 1, 2013) (cached version available at http://webcache.googleusercontent.com/search?q=cache:cS_gbvaeq-MJ:www.mediaite.com/tag/boston-marathon-bombing/+&cd=44&hl=en&ct=clnk&gl=us) ("The three new suspects arrested in connection with the Boston Marathon bombing[—] …students at Dartmouth College, where the younger Tsarnaev brother was a student — were arrested and charged with obstruction of justice for allegedly discarding fireworks and a laptop computer owned by the bombing suspect."); Malcolm Morrow, *Dartmouth Students Discuss Boston Bomber: 'He Was Calm,'* YOUR BLACK WORLD (Apr. 2013), http://www.yourblackworld.net/2013/04/black-news/dartmouth-students-discuss-boston-bomber-he-was-calm/ (listing the school correctly as the University of Massachusetts Dartmouth but illustrating the article with the Dartmouth College seal).

30. E.g., @Ami_N_Jones, "@BBCNews have been raving all afternoon about Tsarnaev attending the prestigious Dartmouth College. He goes to UMass Dartmouth. Whoops." (Apr. 19, 2013); @runningseal, "Dartmouth College and University of Massachusetts -Dartmouth. Two very different things and no the bomber did not go to my college." (Apr. 22, 2013); @AngelMCastillo, "Tsarnaev went to UMass Dartmouth, NOT Dartmouth College…" (Apr. 19, 2013); @safu_z, "Thank you, @WolfBlitzer, for clarifying that UMass Dartmouth has no relation to Dartmouth College." (Apr. 19, 2013).

31. *See* Nelson Garcia, *DU studies moving 'Denver' into Metro State's new name*, 9 NEWS (Nov. 29, 2011), http://www.9news.com/news/article/232882/188/DU-studies-moving-Denver-into-Metro-States-new-name-.

32. 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:158 (4th ed.).

potential future donors. Using the survey results as ammunition, the University of Denver officials communicated their opposition to the new name before the state legislature was called upon to approve it. DU succeeded in preventing the proposed change, and Metropolitan State College of Denver instead became Metropolitan State University of Denver.[33]

But alumni and their alma maters aren't always able to block competitors' name changes before they happen. In 2004, the entity that operates the University of Missouri opposed Southwest Missouri State University's attempt to change its name to Missouri State University,[34] but the bill passed the state legislature and the name was changed despite Mizzou's objections.[35] More recently, in 2012, alumni from Augusta State University and Georgia Health Sciences University actively opposed the name "Georgia Regents University" for the product of those two schools' consolidation.[36] Their opposition wasn't based on potential confusion with another school's mark, but on the loss of goodwill that would ensue if the school's new name bore no resemblance or connection to either of its predecessor schools' names. In response to a survey soliciting their opinions about potential names, alumni ranked "Georgia Regents University" last, preferring every other option. "Nobody wanted [that name]," one student complained.[37] "[The regents] really didn't listen to anyone that went here and that's not fair to us because we have to have it on our diploma."[38] Regents University, a private school located in Virginia, also contacted the Georgia Board of Regents to discuss the potential conflict that the schools' similar names would create.[39] The Georgia Board of Regents ignored both constituencies and executed the name change. While the alumni themselves lack legal standing to challenge that decision, Regents University filed a lawsuit in federal court alleging infringement of its registered trademark REGENTS UNIVERSITY for educational services.[40]

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33. *Metro State U! Metro State community invited to "Name Change" bill-signing ceremony April 18 in the SSB*, This Week at MSU Denver (Apr. 12, 2012), http://www.mscd.edu/~collcom/artman/publish/Billsigning_TWV9041112.shtml.
34. Marc Powers, *Southwest State name change faces opposition*, The Southeast Missourian (Mar. 7, 2002), http://www.semissourian.com/story/64869.html ("University of Missouri officials—especially those at the flagship Columbia campus, the state's largest—said they are concerned Southwest is trying to encroach on MU's turf.").
35. *History of the University*, About Missouri State, http://www.missouristate.edu/about/history.htm (last visited Mar. 16, 2013).
36. Tyler Kingkade, *Augusta State University Students Protest Against Decision To Change School Name To Georgia Regents University*, The Huffington Post (Aug. 21, 2012), http://www.huffingtonpost.com/2012/08/21/augusta-state-university-georgia-regents-protest_n_1818848.html.
37. *Id*.
38. *Id*.
39. Walter C. Jones, *Virginia college objects to Augusta university name*, The Augusta Chronicle (Aug. 6, 2012), http://chronicle.augusta.com/news/government/2012-08-06/virginia-college-objects-augusta-university-name.
40. Regent University v. Board of Regents of the University System of Georgia, et al., No. 1:12-cv-00141-JRH-WLB, filed Sept, 20, 2012 in the U.S. District Court for the Southern District of Georgia, Augusta Division, available online at http://aug-cdn.com/sites/default/files/Regent%20University%20lawsuit%20filing_0.pdf.

While the Regents lawsuit is an outlier among university trademark conflicts, it makes salient the fact that only other trademark owners, not students or alumni affected by consumer confusion, are empowered to challenge a name change. In many cases, the interests of alumni and the interests of a school—as embodied by its board of directors, its president, or its general counsel—are united in opposing a potentially infringing name change by a competitor school. In the stories above, the University of Denver and Regents University acted in their alumni's best interest, and the University of Missouri attempted to do the same. While affording alumni legal standing to challenge the use of marks that decrease the value of their diplomas or create confusion about the quality of their degrees might be impractical, schools should carefully consider the effects of name changes—their own and those of competitors—on alumni and solicit feedback from them directly. If a student exists in the world as a product of her university, it stands to reason that she need not be an entirely passive product. Rather, that status should entitle her to some protection and perhaps a vote in the process.

II. Tarnishment

Under federal trademark law, a producer can also bring an action based on a use of its mark that dilutes the mark's distinctiveness. "Dilution" is defined in the Lanham Act as "the lessening of the capacity of a famous mark to identify and distinguish goods or services."[41] A mark owner need not show a likelihood of confusion to establish that a use is dilutive, nor must the two parties be competitors. The two types of actionable dilution are blurring and tarnishment.[42] In a case of dilution by blurring, a senior user's mark is ostensibly weakened by its identification with dissimilar goods, as when a hamburger stand sells ROLEX hamburgers and TIFFANY hot dogs. In a case of dilution by tarnishment, the senior user's mark is cast in an unflattering light, usually by its association with shoddy or unsavory goods or services. Tarnishment cases often involve uses that associate a mark with sex, drugs, crimes, or other tawdry activities that the mark owner perceives as cheapening its name in the public eye. For example, a federal district court found the mark POLO, famous for apparel, was diluted by the defendant's use of "the Polo Club" for adult entertainment.[43] Another district court case enjoined a maker of board games with racist titles including Ghettopoly, Thugopoly, Latinopoly, and Hoodopoly because the games tarnished Hasbro's MONOPOLY trademark.[44]

Alumni at the Ralph R. Papitto School of Law probably sympathized with Hasbro when they learned in 2007 that Mr. Papitto, chairman of the Board of Trustees at Roger Williams University in Rhode Island and the donor for whom the university's law school was named, had let slip a particularly offensive racial slur during a board meeting. At the time, the

41. 15 USC § 1127, Lanham Act § 45.
42. 15 USC § 1125(c)Lanham Act § 43(c).
43. Polo Ralph Lauren LP v. Schuman, 46 U.S.P.Q.2d 1046 (S.D. Tex. 1998).
44. Hasbro v. Chang, 2006 WL 1549052 (D. R.I. May 31, 2006).

members were discussing a report that criticized the board for being insufficiently diverse; Papitto paraphrased the criticism, "[t]hey want us to add more . . . well, I can't call them n——, I learned that from [Don] Imus," referring to the backlash over the talk radio host's then-recent comments about college basketball players.[45] The response in Rhode Island was swift: students and alumni circulated a petition and requested Papitto's ouster from the board and from the school's moniker, deeming it "a disgrace to have the Papitto name on their resumes and their diplomas."[46] Ultimately, Papitto took it upon himself to resign from the board, and asked that his name be removed from the law school. The board eagerly acquiesced.

Had Papitto not suggested that the law school drop his name, the board might have reached the same decision itself, but it's unclear whether the school's alumni would have had a voice in the process. The Lanham Act doesn't protect a school named for a donor in this scenario, even if the association casts the school in an unflattering light because of the donor's unseemly actions. Dilution doctrine would be nonsensical in the context of donors tarnishing the schools named after them simply by continuing to use their own names as personal names. Non-commercial uses are exempt from dilution claims,[47] and a donor or namesake who stirs up controversy in his personal or professional life is usually not making a commercial use of his own name. In addition, federal anti-dilution doctrine protects only marks that are famous among the general consuming public,[48] which describes few if any schools named for donors. Further, a school suing its own donor would only serve to alienate the donor and further draw attention to the controversy, exacerbating any dilutive effects. A school that no longer wishes to be associated with the person for whom it has been named has just one choice—change its name and dissociate itself from the donor. Alumni whose reputations suffer because of the actions of a donor are left without recourse for tarnishment just as they are for infringement. Given the immediate effects and the impracticality of legal action, stories about school name tarnishment should serve to dissuade administrators from naming schools for living donors.

Schools that do name themselves after individual benefactors, publicly forging a connection between the school and the individual,[49] must consider the substantial and very real risk tarnishment poses. In the late nineties, the University of Florida College of

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45. Scott Jaschik, *A Board Implodes Over N-Word*, Inside Higher Ed (July 16, 2007), http://www.insidehighered.com/news/2007/07/16/rwu.
46. Associated Press, *Slur 'slipped out,' says former university chair*, MSNBC (July 16, 2007), http://www.msnbc.msn.com/id/19791485/ns/us_news-life/t/slur-slipped-out-says-former-university-chair/#.UOyUkram7bI.
47. 15 USC § 1125.
48. 15 USC § 1125; see generally Alexandra J. Roberts, *New-School Trademark Dilution: Famous Among the Juvenile Consuming Public*, 49 IDEA 579 (2009), reprinted in 100 Trademark Rep. 1021 (May/June 2010).
49. Ann Bartow, *Trademarks of Privilege: Naming Rights and the Physical Public Domain*, 40 U.C. Davis L. Rev. 919, 933 (2007). *See id*. at 948-49 and n.91 for a discussion of the relationship between naming rights and gift size.

Law—a then-ninety-year-old public law school ranked first in its state—changed its name to the University of Florida Fredric G. Levin College of Law.[50] The name change honored plaintiffs' attorney Levin, who had donated ten million dollars to the school. While Levin's reputation within the state was generally positive, many alumni opposed the new name, noting that the state Supreme Court had publicly reprimanded Levin a few years earlier after he admitted (on his own television show) that he used a bookmaker to bet on football.[51] News coverage of the name change described "embittered" alumni, "vehement and organized opposition" to the change, and "turmoil" and "animosities" in its wake, and cited the name change controversy as the primary reason for the departure of the school's dean later that year.[52] One prominent alumnus characterized Levin's attitude toward the law as "sneering, cynical and selfish" and decried the name change, which he felt "sen[t] the wrong message to law students, lawyers and the public."[53] Whether the school could have predicted such a reaction to Levin as a person is beside the point; in fact, some blamed the backlash on anti-Semitism.[54] But most living donors will, at some point before or after making a naming gift to a school, say or do or be something that will alienate a segment of relevant consumers. Instances of alienation and subsequent un-naming thus stand as cautionary tales for schools contemplating naming a school for a donor.

Even awarding a donor naming rights for a building or center, rather than an entire school, can lead to controversy. When UCLA law alumnus Lowell Milken made a $10 million gift to his alma mater in 2011 to establish the Lowell Milken Institute for Business and Law, some UCLA faculty members and alumni were outraged. The donor is the younger brother of Michael Milken, who pleaded guilty to securities law violations in 1990 in exchange for the government dropping criminal charges against Lowell; Michael served a 22-month prison term and paid $600 million in fines and restitution, and both brothers were permanently barred from the securities industry.[55] In response to the news of Milken's gift, one professor asserted that "[t]he creation of a Lowell Milken Institute for Business Law and Policy [would] damage her personal and professional reputation"; another former professor agreed that accepting the gift would be a mistake, and told the New York Times, "[t]o say that I was outraged would be something of an understatement."[56]

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50. As Ann Bartow points out in the context of naming rights for physical spaces, the donor name (Fredric G. Levin) can interfere with or crowd out the university name (University of Florida), "mut[ing] or "obscur[ing]" the university's predominance. "This sort of interference with a consumer's ability to distill accurate source identifying information from a trademark usage conflicts with trademark law's stated goal of conveying accurate information to consumers." Bartow, supra note 49 at 927.
51. *UF law school dean's exit prompts backlash*, Florida Times-Union (Apr. 28, 1999), http://jacksonville.com/tu-online/stories/042899/met_3a1Law_s.html.
52. *Id*.
53. *Id*.
54. *Id*.
55. Julie Creswell & Peter Lattman, *Milken's Gift Stirs Dispute at U.C.L.A. Law School*, N.Y. Times (Aug. 22, 2011), http://dealbook.nytimes.com/2011/08/22/milkens-gift-provokes-dispute-at-u-c-l-a-law-school/.
56. *Id*.

Similar stories abound, leading a New York University employee who handled naming negotiations to report that NYU "now rejects deals outright if the namesake misses a high ethical bar, i.e., if the donor is "indicted or convicted."[57] Villanova University accepted money from John du Pont for a new basketball arena that it named du Pont Pavilion. The school renamed the arena after du Pont was convicted of murder.[58] Princeton returned money that Ivan Boesky had donated to build a Jewish Center after the government charged Boesky with insider trading.[59] Billionaire Wal-Mart heirs the Laurie family were forced to remove their daughter Paige's name from the Paige Sports Arena at the University of Missouri after allegations surfaced that Paige had given her undergraduate roommate twenty million dollars to do her homework.[60] More recently, Seton Hall University removed the name of L. Dennis Kozlowski from an academic building and library rotunda after the disgraced Tyco chief executive officer was convicted of embezzling $150 million from his employer.[61] And this year, Scott Ginsburg sued Georgetown University seeking the return of his 7.5 million dollar gift when the school failed to name a fitness center after him as promised; the school was reluctant to affiliate itself with Ginsburg after the SEC brought a civil case against him for insider training.[62]

Naming things—buildings, rotundas, arenas—for donors is a trademark risk. Naming an entire school for a family or individual is an even greater risk. While schools may weigh the desire to curry favor with donors or exchange naming rights for substantial sums of money against the community's occasional reluctance toward name changes and the possibility of later renaming due to controversy, they often do not take into account the effect on alumni of either the controversy or the (multiple) name changes. In a typical dilution case, a mark owner is adverse to the party tarnishing its mark; a win for one is a loss for the other. When schools are named for donors and those donors' actions tarnish the school's reputation,

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57. Matthew Quirk, *Your Name Could Go Right Here!* Washington Post (Oct. 21, 2007), http://www.washingtonpost.com/wp-dyn/content/article/2007/10/19/AR2007101901548.html. Joseph Blocher cautions that allowing some donors to purchase naming rights and precluding others from doing so could create liability for public schools under the first amendment. Blocher, *School Naming Rights and the First Amendment's Perfect Storm,* 96 Geo. L. J. 1, 3 (2007) (Public schools selling naming rights "might find it increasingly hard to reject undesirable sponsors—'bad name' sponsors, or those marketing undesirable products, for example—without running afoul of the First Amendment.").
58. *"Du Pont" Removed From Arena*, News OK (July 9, 1997), http://newsok.com/du-pont-removed-from-arena/article/2584690; Quirk, *supra* note 57.
59. Creswell & Lattman, *supra* note 55; *see also Boesky Withdraws $1.5 Million Pledge*, 87 Princeton Alumni Weekly 11 Geo. L. J. (Dec. 10, 1986).
60. Creswell & Lattman, *supra* note 55; *see also* Quirk, supra note 57.
61. Creswell & Lattman, *supra* note 55. According to a university press release, Kozlowski requested the name change, citing "his desire to spare Seton Hall any further adverse attention or distraction from its educational mission." *Kozlowski Hall Bites the Dust*, White Collar Crime Prof Blog (Aug. 23, 2005), http://lawprofessors.typepad.com/whitecollarcrime_blog/2005/08/page/3/ (quoting a press release that is no longer available on Seton Hall's website).
62. Jeff Bounds, *Scott Ginsburg wants his $7.5M back from Georgetown*, Dallas Business Journal (Mar. 15, 2013), http://www.bizjournals.com/dallas/news/2013/03/15/scott-ginsburg-wants-his-75m-back.html?page=all; Eric Nicholson, *Dallas Millionaire Upset Georgetown Didn't Name Gym after Him, Wants His $7.5 Mil Back*, Dallas Observer Blogs (Mar. 5, 2013), http://blogs.dallasobserver.com/unfairpark/2013/03/dallas_millionaire_upset_georg.php. *See also* Complaint, Ginsburg v. Georgetown, 3:13-cv-00952-L (N.D. Tex, Mar. 4, 2013).

the school and donor began as partners, rather than adversaries. It can thus be difficult for the school to extricate itself from the relationship gracefully and truncate the tarnishment without lasting effects. When the makers of "Ghettopoly" are enjoined and any remaining games destroyed, the tarnishment of the MONOPOLY mark ceases; when the Ralph R. Papitto School of Law selects a new name, it remains the law school formerly known as Papitto, and its alumni remain linked to the controversial donor for years to come.[63]

Despite the risks of naming a school after a living donor, what's jettisoned when a school takes on a new name may be more detrimental to alumni than what's added. When school administrators change a school's name, abandoning a trademark with extensive goodwill in the field of education[64] in favor of a donor's name with none, the change is often made without consulting alumni. And yet alumni who graduated as products of one institution are converted overnight into products of what is at least nominally a different institution. In the contexts in which their university trademark is relevant—when they are interviewing, networking, socializing, or seeking recognition—a name change can mean forfeiting the recognition and goodwill that gave the mark and the diploma its value for an alumnus.[65] As an undergraduate at Loyola College noted on the eve of her school's voluntary name change, in effect "graduates… lose their alma mater"[66] when that alma mater sheds its name.

Conclusion

While the names of drugs and biomedical products are heavily regulated by governmental entities, universities have a great deal of leeway in selecting school names and a great deal

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63. Related concerns may plague employees: after working for a particular employer, the employer's reputation remains relevant and may influence future employers' perceptions of the potential employee. Lowell Milken's former assistant, for example, is likely to have suffered acute reputational harms that impeded her ability to secure new employment.

64. A school that abandons a university name trademark must also be cognizant of the risk that a junior user might adopt the school's former name in order to take advantage of any residual goodwill in the mark. For an example of one school's attempt to mitigate that risk, see the website owned and operated by California Southern University, formerly known as Southern California University for Professional Studies ("SCUps") at http://www.scups.net/Index.html ("The SCUps website previously hosted at www.scups.edu which was owned and operated by SCUps since 1990 has been discontinued as of October 2007. Please visit the 'Contact Us' page to see the current web address and contact information for the University.").

65. C. Hsieh, while a faculty member at the school formerly called the University of Missouri Rolla, highlighted how professors are affected by name changes: "[I]n the past I would have been able to introduce myself to business academics and some would recognize the UMR name from their brief exposure to the engineering school (e.g. esp[ecially] those who study innovation). …Now, likely, any uninitiated, unassisted attention I could attract at academic business conferences due to an association with an obviously legitimate institution (i.e. the University of Missouri system) is now gone. People will look at my nametag and see "Missouri University of Science & Technology" and look at me as if I were from a 2-year vocational institute." Comment posted to Peter Klein, *What's In a (University) Name?*, Organizations and Markets (Apr. 30, 2007), http://organizationsandmarkets.com/2007/04/30/whats-in-a-university-name/.

66. Michael Roberts, *Students React to Loyola Maryland's Name Change*, Politics Daily, July 17, 2009) http://www.politicsdaily.com/2009/07/17/students-react-to-loyola-marylands-name-change/.

of freedom in changing them. Federal grants and loans compose a substantial proportion of student tuition; the government thus has a stake in ensuring that a student attends the best possible school for his abilities and aspirations and the one that will create the most opportunities for him in the future. Should the government play a greater role in approving university name selection and reviewing proposed changes? The Lanham Act prohibits infringement and protects famous marks against dilution, and states may enact various rules regarding public school names, but private schools have more autonomy, and most states currently leave it to the schools themselves to decide what names to use.[67]

Yet a student's choice of school is not only a major expense, it's arguably a life-long commitment to a brand—a commitment that turns a student into a branded alumnus. Do schools act irrationally when they change names to rebrand or honor donors to the detriment of alumni, who are also potential donors? Abandonment, infringement, and tarnishment represent three of the mechanisms by which an alumnus may suffer a reputation-related injury when his alma mater changes names. While schools occasionally survey alumni and factor their opinions into name change decisions, those schools are the exception, rather than the rule. As the above stories suggest, alumni deserve more consistent consideration and a louder voice in the name change decisions of their alma maters. ■

67. Kim Clark, *Colleges Play the Name Game*, US News & World Report (Sept. 17, 2009), http://www.newriver.net/US_News.htm.