“Dawg Pound” decision provides guidance for fan group-related trademarks

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The emphasis on licensing as a source of revenue for sport organizations, coupled with the creativity of sport marketers and their fans, serves to highlight the importance of securing trademark protection for unique slogans and nicknames that emerge in connection with a particular sport organization. For instance, Duke University has the “Cameron Crazies.” The historic favor of Red Sox fans has led to the recent creation of “Red Sox Nation,” a slogan that has provided a variety of new licensing opportunities including the purchase of “citizenship” and an official ID card for $9.95 (Hiestand, 2006). On occasion, the use of trademarked names for fan groups has led to litigation. Most recently, in the week leading up to the 2006 Super Bowl, Texas A&M University won a temporary restraining order to prevent the Seattle Seahawks from using its trademarked “12th Man” slogan in its promotional campaigns (Duarte, 2006). The parties eventually settled in May 2006, with the Seahawks agreeing to pay Texas A&M a licensing fee for use of the “12th Man” mark within the team’s seven-state broadcast area (Cohen, 2006). The potential for licensing revenue that can be derived from such ancillary team-related slogans and nicknames reinforce the need for sport marketers to be cognizant of the process for protecting such intellectual property, as well as diligent in the licensing of such trademarks.

Perhaps one of the most well-known of these team-related fan groups is the Cleveland Browns’ “Dawg Pound,” a phrase used since the early 1980s to describe the enthusiastic Browns fans who dressed up (and woofed) like dogs. Members of the “Dawg Pound” sat together in the bleachers of the old Municipal Stadium, and today sit together in the east end zone of the new Cleveland Browns stadium. Ownership of the phrase “Dawg Pound,” as well as the issue of trademark abandonment, was at the heart of a lawsuit recently decided in federal district court for the Southern District of New York in February 2006 (Hawaii-Pacific Apparel Group, Inc. v. Cleveland Browns Football Company LLC, 2006).

The Hawaii-Pacific (HP) case involves the Cleveland Browns and the league’s licensing arm, National Football League Properties (NFLP), who claimed to have “senior user” trademark rights to “Dawg Pound.” The “Dawg Pound” phrase originated in 1984 to refer to the Cleveland Brown’s defense but quickly also came to be associated with the team’s fans. In 1985, to capitalize on the growing notoriety of the phrase, the Cleveland Browns, at the suggestion of the NFLP, registered “Cleveland Browns Dogs” and “Cleveland Browns Dawgs” with the State of Ohio Trademark Office. The trademarks were officially registered in 1988 and expired ten years afterward. The NFLP, as the licensing agent for the club, began issuing licenses for the use of these phrases on items including T-shirts and other apparel, Christmas cards and posters. The licensing of “Dawg Pound” merchandise continued through the 1994 season, after which the Cleveland Browns franchise moved to Baltimore and became the Baltimore Ravens. As the court stated, “There was thus no longer a ‘Dawg Pound’ in Cleveland, in the sense that the Browns were no longer in existence” (Hawaii-Pacific v. Cleveland Browns, 2006, p. 504).

In 1986, Donald Shepherd founded HP—a Hawaiian corporation with its principal place of business in California. Shepherd began to manufacture and distribute non-football-related apparel bearing phrases such as “Dawg Pound,” “Lil Dawg Pound,” and “Top Dawg,” after Shepherd’s son was given the nickname “Tog Dawg” by members of his baseball team in 1991. In March 1994, HP attempted to register the “Dawg Pound” mark with the United States Patent and Trademark Office (USPTO), alleging a date of first use in commerce of March 1994, but the NFLP opposed the registration and the mark was never registered. Shepherd, who had no interest in football, stated at trial that he was not aware until the NFLP opposed the “Dawg Pound” registration that the words “Dawg” and “Dawg Pound” had been used to refer to Cleveland Browns fans. HP did, however, successfully register the marks “Top Dawg” and “Lil Dawg Pound” in 1995 and 1996, respectively, in applications that were not opposed by the NFLP. From the period of 1996 to 1999, HP sold close to $10 million of its apparel in national retail chains.

In 1999, when the NFL was preparing to bring a Browns franchise back to Cleveland after a four-year...
absence, the NFLP filed an intent-to-use application for the “Dawg Pound” mark with the USPTO. The application was rejected due to its similarity to HP’s “Lil Dawg Pound” mark.

In March 2000, HP’s counsel sent a letter to the Browns and NLFP demanding that they immediately cease and desist using the “Dawg Pound” mark. Five months later, the NFLP sued HP in Ohio district court, seeking a declaration of non-infringement. The suit was dismissed for lack of personal jurisdiction over HP, and affirmed on appeal in February 2004 (Cleveland Browns v. Hawaii-Pacific, 2004). HP commenced this action in October 2004. The issue presented to the district court related to whether HP or the NFLP had senior user status and prior use rights associated with the phrase “Dawg Pound.” In addition to deciding the issue of priority of use, the court also addressed the issue of trademark abandonment.

Prior Use
In analyzing the issue of priority of use, the court noted, “It is a fundamental principle of trademark law that the right to exclusive use of a trademark derives from its application and subsequent use in the marketplace. The user who first appropriates the mark obtains an enforceable right to exclude others from using it, as long as the initial appropriation and use are accompanied by an intention to continue exploiting the mark commercially” (Hawaii-Pacific v. Cleveland Browns, 2006, p. 505, citing H.P. Carter & Sons, Inc. v. William Carter Co., 1996, p. 802, quoting La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc., 1974, p. 1271).

The NFLP argued that it was entitled to summary judgment because it had licensed the “Dawg Pound” mark to other companies several years before HP alleged to have first used the mark in March 1994. The court, while stating that the date of first use in commerce is the controlling law, determined March 1994 to be HP’s date of first use. The court further noted, however, that even accepting HP’s claim of having first “adopted” the mark in 1991, the result would be no different since the NFLP had licensed the mark for use on merchandise as early as 1989.

HP argued that even conceding the use of the marks by a licensee would qualify as “use” for trademark ownership purposes, the defendants did not control their licensees. The court first held that use of the mark by a licensee to identify or distinguish goods is sufficient to create enforceable rights in favor of the licensor. The court cited McCarthy (2004) by noting, “Ownership rights in a trademark … can be acquired and maintained through the use of the mark by a controlled licensee even when the first and only use of the mark was made … by the licensee.” While the court thus emphasized that a licensor is “required to exercise some degree of control over the use of the mark by the licensee, at the risk of abandonment of the mark” (HP, 2006, p. 506), the court found indisputable facts indicating that before using the “Dawg Pound” mark on approved merchandise, licensees had to sign lengthy licensing agreements that included a rigorous approval process of samples prior to distributing the merchandise for retail sale.

Thus, on the issue of priority use, the court found that because the defendants licensed merchandise that contained the words “Dawg Pound” together with some reference to the Browns or the NFL many years prior to HP’s use of the “Dawg Pound” mark in commerce, no reasonable jury could find HP to be the senior user of the mark.

Abandonment
Although HP did not include abandonment among its legal claims, it did suggest in its briefs that the Browns and NFLP had abandoned their rights to the “Dawg Pound” mark because (1) their use of the mark was only sporadic between 1995 and 1999 (during which time there was no Browns franchise playing in Cleveland) and (2) the Browns and NFLP failed to oppose HP’s registration of its “Lil Dawg Pound” mark in 1996. The court nonetheless took the liberty of addressing this issue.

The court first noted that a finding of abandonment requires evidence that use of the mark “has been discontinued with intent not to resume such use” (Lanham Act, 15 U.S.C. § 1127). Once a mark is deemed abandoned it reverts back to the public domain and may be appropriated by anyone who adopts the mark for their own use. However, because abandonment constitutes forfeiture of a property right, courts require substantial proof. The issue of abandonment has arisen in several prominent sport law cases that illustrate the concept. In Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd., (1993), the court held, over the objections of Major League Baseball Properties and the Los Angeles Dodgers, that the team had legally abandoned the mark “Brooklyn Dodgers” when it moved to Los Angeles. This allowed a restaurant in Brooklyn to continue its use of the name “Brooklyn Dodger.” The court found that the use of the mark had been discontinued with no intent to resume such use. Conversely, in Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club (1994), the Seventh Circuit court ruled against a Baltimore-based team in the Canadian Football League (“the Baltimore CFL Colts”) that claimed that the Indianapolis Colts (who had formerly been the Baltimore Colts) had
abandoned its “Baltimore Colts” mark. This decision overturned a district court ruling that the Indianapolis Colts had abandoned the trademark “Baltimore Colts” simply by moving to Indianapolis.

In the instant case, the court observed that the Browns and the NFLP had enforced what they perceived to be their rights in the “Dawg Pound” mark during the period of 1995 to 1999, despite there being no NFL team in Cleveland at the time. Given the requirement for proving abandonment by clear and convincing evidence, the court held that no reasonable jury could find that the defendants had either discontinued the use of the mark or discontinued it with the intent not to resume use of the mark.

**Implications for Sport Managers**
The decision in this case suggests several implications for sport managers. First, given that creative slogans and nicknames represent potential licensing revenue streams, sport managers must be proactive in seeking trademark registration for such marks. Ideally, a federal registration of the mark is preferable since it provides national notice to others and, in the instant case, would have likely prevented this case from ever arising. Second, if there is a reason for discontinuing the use of the mark for some period of time (including a relocation of the sport organization), sport managers are advised to keep their trademark registration current and to find some means to continue utilizing the mark in commerce since even sporadic use will defeat a claim of abandonment by a subsequent user of the mark. Third, the sport manager must maintain sufficient control of the licensing process since a failure to do so can provide evidence of abandonment.

**References**


*Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club, 34 F.3d 410 (7th Cir. 1994).*

*La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc., 495 F.2d 1265 (2d Cir. 1974).*


*McCarthy, J. Thomas, McCarthy on Trademarks & Unfair Competition § 18.46 (4th ed. 2004).*

**Author Note**

At press time, HP had made no motion to appeal the verdict regarding the trademark claim. In a subsequent filing, however, HP added a copyright infringement claim. The copyright claim, as well as the issue of likelihood of confusion and hence damages, remain on the docket.

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