

BIG 12 EXPANSION (Of Its Trademark Portfolio)

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The college football blogs are rife with rumors of conference expansions and the wave of team reshuffling should certain teams change conferences. The Big 10 (which has 11 teams) is rumored to be seeking anywhere from one to three teams. Quotes from Big 12 commissioner Howard Beebe suggest the Big 12 is content with its moniker matching its conference roster and will not add teams. Nonetheless, the Big 12 seems to be hedging its bets or at least trying to block the Big 10 from being able to remove its mathematical misnomer in the event it expands to 14 teams.

Since 1997 the Big 12 has maintained an application at the United States Patent and Trademark Office (PTO) for the BIG 14 trademark. None of the Big 12's applications for BIG 14 have matured into registrations because the Big 12 has never been able to show a use of the BIG 14 mark in commerce within the window of time afforded its applications. In effect, the Big 12 keeps sitting on the BIG 14 mark by filing a new application every time its former application expires. The Big 12's latest application was filed in September 2009. Curiously, Big 12 assistant commissioner Bob Burda was quoted in that same month as saying, "We license and protect a whole array of names just so we can be protected if the landscape of the conference were to ever change." Surely, Burda's statement elicited a collective groan from the Big 12's trademark attorneys because trademarks cannot be reserved on mere speculation that one may someday have a use for a mark.

Trademark applications can be applied for based on the applicant's actual use of the mark in commerce or based on its "bona fide intent to use a mark in commerce at the time of application." Trademark applications, and the resulting registered marks, are subject to attack based on claims of fraud or lack of bona fide intent to use the mark in commerce. This area of trademark law recently went through a bit of an upheaval with respect to fraud. For some time the Trademark Trial and Appeal Board (TTAB), the PTO's administrative tribunal, applied a virtual strict liability standard to claims of fraud. This resulted in a number of registered marks being cancelled on the basis of fraudulent procurement when an applicant obtained a registration for goods or services which did not exactly match those on which it used its mark. In October 2009, in *Bose v. Hexawave*, the TTAB did a near about-face, removing the "knew or should have known" standard and replacing it with essentially no standard. Despite this change, the Big 12's long-standing practice of keeping an unregistered application lodged at the PTO seems hardly innocent and is arguably an abuse of the trademark filing system. Unless the Big 12 has some (and it doesn't take much) evidence it intended to use the mark BIG 14 when it filed its most recent application in 2009, its claim to the BIG 14 mark may be as sure a bet as Mike Leach returning to the sidelines at Texas Tech.

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