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How (Not) to Get Sued for Using the Word “Houston”

BY [KEVIN ZHANG](#)/ ON APRIL 11, 2017

After the University of Houston (“UH”) filed suit against South Texas College of Law Houston (formerly South Texas College of Law) for trademark infringement last summer, the two sides have finally made progress in resolving their dispute via mediation.^[1] However, while UH has now found South Texas College of Law Houston’s amended name more to its liking, discussions regarding damages owed remain ongoing.^[2]

Trouble for South Texas College of Law Houston (“STCL”) began last summer when it became concerned about its national marketability. For the STCL board, “South Texas” indicated only regional presence—to the average Joe, STCL could be in Corpus Christi, Brownsville, Laredo, etc. As such, they wanted the school to bear a name that allowed the public to immediately identify the school with the city of Houston, the fourth largest city in America and the largest city in Texas. Consequently, on June 22 of last year, STCL decided to officially change its name to Houston College of Law, although that name change was short-lived.^[3] A mere five days later, UH brought suit against STCL in the United States District Court for the Southern District of Texas.^[4] UH complained that, *inter alia*, STCL’s new name infringed on UH’s trademark rights in the word “Houston” because STCL’s infringement created a strong likelihood of consumer confusion in that the public would inaccurately associate STCL with UH and that STCL diluted UH’s reputation as a top 50 law school (at the time) in the nation as derived from its mark’s staying power.^[5] In addition, STCL overhauled its logo and color scheme entirely, but whether by accident or on purpose, its new marks were similar to UH’s marks.^[6] For this, UH claimed that STCL infringed on UH’s trade dress.^[7] Ironically enough, STCL changed its name from “South Texas College of Law” to “Houston College of Law” in the first place because it felt that “South Texas” would confuse potential law school applicants, or “consumers” if you will, by misleading them away from STCL’s actual location in downtown Houston.^[8] In other words, STCL sought to avoid consumer confusion with the name change yet ultimately found itself being sued over consumer confusion anyway.

On October 14, 2016, approximately three and a half months after UH sued STCL, District Judge Ellison ruled in UH’s favor and granted its motion for a preliminary injunction against STCL.^[9] In evaluating UH’s likelihood of confusion claim, Judge Ellison applied the *Xtreme Lashes* digits of confusion, which are the Fifth Circuit’s equivalent of the *Polaroid* factors that the Second Circuit applies here in New York.^[10] While the latter contains eight factors in total as compared with the former’s six, they are substantively similar, and Judge Ellison found that

all six digits of confusion weighed either in favor or heavily in favor of UH.^[11] Although Judge Ellison did not address UH's trademark dilution and trade dress infringement arguments in his opinion, he felt that he need not do so since UH prevailed so lopsidedly on its likelihood of confusion claim, and such a victory was sufficient to show that "...UH will be irreparably harmed by [d]efendant's continued use of the 'Houston College of Law' mark to identify and market its brand."^[12]

In the aftermath of the litigation, UH and STCL proceeded to mediation, where STCL proposed to UH that instead of Houston College of Law, STCL would rebrand itself as South Texas College of Law Houston.^[13] UH agreed and so this is STCL's name...for now. The two sides have yet to agree on a final amount of damages.^[14] If mediation talks continue to stalemate on this thorny issue, UH could rescind its licensing of "Houston" to STCL, thereby barring STCL's school name once more. At the same time, should STCL choose to, it may appeal Judge Ellison's decision to the Fifth Circuit as an avenue of recourse.

If UH indeed prevails once and for all in the coming months, its victory may nonetheless ring hollow because other major players in Houston like the Houston Astros and even Houston Community College may contest UH's trademark rights in the word "Houston" as well.^[15] Because "Houston" is a geographic term under the Lanham Act, UH may lose its trademark rights in "Houston" if potential opposition make all the right arguments. For instance, they may choose to argue that "Houston" is primarily geographically descriptive and so unprotectable under the Lanham Act—this in turn would nullify UH's trademark registration.^[16] Of course, if UH could successfully prove secondary meaning, it would prevail on this claim,^[17] but I digress as this is all speculation. I guess it remains to be seen how events will unfold between UH and STCL down the line and whether UH will find itself in litigation hot water once more—this time, as a defendant.

Kevin Zhang is a second-year law student at Benjamin N. Cardozo School of Law and a Staff Editor of the Cardozo Arts & Entertainment Law Journal. If he makes it out of law school alive, he hopes to someday practice either corporate or copyright law. In his spare time, Kevin enjoys brushing up on the hard sciences, doing math problems, and playing the piano.

^[1] Gabrielle Banks, *What's in a Name? \$500K in Legal Costs for University of Houston*, Hous. Chron., Mar. 17, 2017, <http://www.chron.com/news/houston-texas/article/What-s-in-a-name-500K-in-legal-costs-for-UH-law-11009251.php>.

^[2] See *id.*

[3] Matthew Watkins, *Judge Tells School to Change Name Back to South Texas College of Law*, Tex. Tribune (Oct. 14, 2016, 4:45 PM), <https://www.texastribune.org/2016/10/14/judge-houston-law-school-change-its-name-back-sout/>.

[4] Kathryn Rubino, *University of Houston Law Center Files Lawsuit Against Unranked Law School*, Above the Law (June 27, 2016, 4:37 PM), <http://abovethelaw.com/2016/06/university-of-houston-law-center-files-lawsuit-against-unranked-law-school/>.

[5] See Watkins, *supra* note 3.

[6] See *id.*

[7] See *id.*

[8] *University of Houston Sues Houston College of Law for Trademark Infringement*, Click2Houston (June 27, 2016, 4:37 PM), <http://www.click2houston.com/news/university-of-houston-sues-south-texas-college-of-law-for-trademark-infringement>.

[9] Watkins, *supra* note 3.

[10] Bd. of Regents of the Univ. of Hous. Sys. *ex rel.* the Univ. of Hous. Sys. & Its Member Institutions v. Hous. Coll. of Law, No. 4:16cv01839, 2016 WL 6037243, at *4 (S.D. Tex. 2016).

[11] *Id.* at *17.

[12] *Id.* at *20.

[13] See Banks, *supra* note 1.

[14] See *id.*

[15] *Id.*

[16] See 15 U.S.C.A. § 1052(e)(2) (West 2017).

[17] See 15 U.S.C.A. § 1052(f) (West 2017).

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