

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF KANSAS**

**UNIVERSITY OF KANSAS and KANSAS  
ATHLETICS, INC.,** )

**Plaintiffs,** )

**vs.** )

**Case No. 06-2341-JAR**

**LARRY SINKS, CLARK ORTH, and  
VICTORY SPORTSWEAR, L.L.C.  
(collectively d/b/a/ Joe-College.com),** )

**Defendants.** )

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**JURY INSTRUCTIONS**

## INSTRUCTION NO. 1

### MEMBERS OF THE JURY:

The presentation of evidence is now complete. I gave you some general instructions and definitions at the outset of this case and I now give you final instructions. You may read along with me, or you may simply listen as I read these instructions. If you read along, stay with me. You will each be allowed to take your copy of the instructions to the jury room for further reference during your deliberations.

You must follow the law as set out in these instructions and apply that law to the facts you find from the evidence presented in this trial. No single instruction or smaller group of instructions states the law; you must consider all the instructions as a whole. You are not to question the wisdom of any of these instructions.

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## INSTRUCTION NO. 2

You must weigh and consider this case without sympathy and without bias for or against any party. You must not be influenced by anything not within the issues of the case.

You must consider and decide this case as an action between persons of equal standing in the community. A corporation is entitled to the same fair trial as an individual.

### INSTRUCTION NO. 3

You may consider as evidence the testimony of witnesses in person or by deposition, and the exhibits admitted into evidence, which you will have in the jury room during your deliberations.

#### INSTRUCTION NO. 4

The rules of evidence provide that if scientific, technical, or other specialized knowledge might assist the jury in understanding the evidence or in determining a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify and state his or her opinion concerning such matters.

You should consider each expert opinion received in evidence in this case and give it such weight as you may think it deserves. If you should decide that the opinion of an expert witness is not based upon sufficient education and experience, or if you should conclude that the reasons given in support of the opinion are not sound, or that the opinion is outweighed by other evidence, then you may disregard the opinion entirely.

## INSTRUCTION NO. 5

The parties may prove any fact through either direct or circumstantial evidence. Direct evidence is direct proof of a fact, such as testimony of an eyewitness. Circumstantial evidence is indirect evidence, that is, proof of a chain of facts from which you could find that another fact exists, even though not proved directly.

In deciding if a fact has been proved by circumstantial evidence, you will consider all the evidence in the light of reason, common sense, and experience.

You may give the same weight to circumstantial evidence as you give to direct evidence.

#### INSTRUCTION NO. 6

You are permitted to draw reasonable inferences from the testimony and exhibits you feel are justified in the light of common experience. In other words, you may make deductions and reach conclusions which reason and common sense lead you to draw from the facts established by the testimony and evidence in the case.

## INSTRUCTION NO. 7

Statements, objections or arguments the lawyers make are not evidence. Lawyers point to those matters which are most significant or most helpful to their side of the case and to those matters which are most damaging to the opponent's case, calling your attention to certain facts or inferences that might otherwise escape your notice.



## INSTRUCTION NO. 8

You must consider all the evidence, but you need not accept all evidence as true or accurate.

You will determine the weight and credit to be given the testimony of each witness. You may use common sense, common knowledge and experience in weighing that testimony.

The number of witnesses who testify about a matter may or may not determine the weight of the evidence. The testimony of a fewer number of witnesses concerning any fact may be more credible than the testimony of more witnesses to the contrary.

Similarly, you will determine the weight and credit to be given to each exhibit.

## INSTRUCTION NO. 9

You are the sole judges of the credibility or “believability” of each witness and the weight to be given to his or her testimony. In weighing the testimony of a witness you should consider the witness’s relationship to the plaintiff or to the defendant; any interest the witness may have in the outcome of the case; the witness’s manner while testifying; the opportunity and ability to observe or acquire knowledge concerning the facts about which the witness testified; the witness’s candor, fairness and intelligence; and the extent to which the witness has been supported or contradicted by other credible evidence. You may, in short, accept or reject the testimony of any witness in whole or in part.

When weighing conflicting testimony you should consider whether the discrepancy has to do with a material fact or with an unimportant detail, and should keep in mind that innocent misrecollection—like failure of recollection—is not uncommon.

In addition, while you must consider only the evidence in the case, you are permitted to draw such reasonable inferences from the testimony and exhibits as you feel are justified in the light of common experience. In other words, you may make deductions and reach conclusions which reason and common sense lead you to draw from the facts which have been established by the testimony and evidence in the case.

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## INSTRUCTION NO. 10

In considering the evidence in this case, you are expected to use your good sense; consider the evidence for only those purposes for which it has been admitted, and give it a reasonable and fair construction in the light of your common knowledge of the natural tendencies and inclinations of human beings.

You are to perform your duty without bias as to any party or person. The law does not permit jurors to be governed by sympathy, prejudice, or public opinion. That was the promise you made and the oath you took before being accepted by the parties as jurors and they have the right to expect nothing less.

Keep constantly in mind that it would be a violation of your sworn duty to base a verdict upon anything but the evidence in, and the law applicable to, this case.

## INSTRUCTION NO. 11

A witness may be discredited or “impeached” by contradictory evidence, or by evidence that at some other time the witness has said or done something, or failed to say or do something, which is inconsistent with the witness’s testimony at trial.

If you believe any witness has been so impeached, you may give the testimony of that witness such weight as you believe it deserves.

If a witness is shown to have deliberately testified falsely concerning any material matter, you have a right to distrust that witness’s testimony. You may reject any part or all of that witness’s testimony.

An act or omission is deliberate if done voluntarily and intentionally and not through mistake, accident, or other innocent reason.

## INSTRUCTION NO. 12

The foregoing instruction sets forth the claims of the respective parties, as stated in the case, and these claims are not to be considered by you as any evidence in this case. The allegations of the respective parties must be established and proven by the evidence.

### INSTRUCTION NO. 13

Plaintiffs University of Kansas and Kansas Athletics (“Plaintiffs” or “KU”) contend that defendants Larry Sinks, Clark Orth, and Victory Sportswear, L.L.C. (“Defendants”) are liable for trademark infringement, dilution, and unfair competition arising from defendants’ sale of unlicensed products that allegedly bear identical or confusingly similar imitations of plaintiffs’ trademarks.

Plaintiff University of Kansas is an institution of higher learning having its principal place of business in Lawrence, Kansas. Plaintiff Kansas Athletics, Inc. is a Kansas corporation having its principal place of business in Lawrence, Kansas. Defendant Larry Sinks is an individual who resides in Lawrence, Kansas. Defendant Clark Orth is an individual who resides in Lawrence, Kansas. Defendant Victory Sportswear, L.L.C. is a Kansas limited liability company having its principal place of business in Lawrence, Kansas. Joe-College.com is a subsidiary of Victory Sportswear, L.L.C. Defendant Larry Sinks is the sole owner of defendant Victory Sportswear, L.L.C.

Plaintiff University of Kansas owns or claims to own a variety of trademarks. Plaintiff Kansas Athletics, Inc. is a licensee of the University of Kansas’s trademarks, and participates in the oversight and enforcement of those trademarks. Defendant Victory Sportswear, L.L.C. sells T-shirts to the public under the name Joe-College.com. Joe-College.com is the name of a retail store located on Massachusetts Street in Lawrence, Kansas, and is also the domain name of an Internet website where the same products are sold and offered for sale to the public. Defendant Clark Orth operates a screen printing business which is located in Lawrence, Kansas. The T-shirts which are sold by Joe-College.com are manufactured and sold to Joe-College.com by

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defendant Clark Orth.

Plaintiffs contend that some of the T-shirts manufactured and sold by defendants infringe and dilute their trademarks and contend that defendants' manufacture and sale of those shirts constitutes unfair competition. Defendants deny that plaintiffs own all of the marks that plaintiffs claim to own, and deny that consumers are confused, or are likely to be confused, by the T-shirts which plaintiffs find objectionable. Defendants also deny that the T-shirts which they manufacture and sell dilute plaintiffs' trademarks, and deny that they have engaged in acts of unfair competition.

#### INSTRUCTION NO. 14

The burden is on the plaintiff in a civil action, such as this, to prove every essential element of its claim by a preponderance of the evidence. If the proof should fail to establish any essential element of plaintiffs' claim by a preponderance of the evidence in the case, the jury should find for defendants as to that claim.

To "establish by a preponderance of the evidence" means to prove that something is more likely so than not so. In other words, a preponderance of the evidence in the case means such evidence as, when considered and compared with that opposed to it, has more convincing force, and produces in your minds belief that what is sought to be proved is more likely true than not true. This rule does not, of course, require proof to an absolute certainty, since proof to an absolute certainty is seldom possible in any case.

In determining whether any fact in issue has been proved by a preponderance of the evidence in the case, the jury may, unless otherwise instructed, consider the testimony of all witnesses, regardless of who may have called them, and all exhibits received in evidence, regardless of who may have produced them.



#### INSTRUCTION NO. 15

Various internet postings on a number of topics made by anonymous members of the public have been admitted into evidence by the Court for a limited purpose. You are instructed that these internet postings are considered hearsay, and you may not consider them as evidence to prove the truth of the matters contained in the postings. You may consider them, however, as evidence to prove either (1) the state of mind of the person making the statement, or (2) to show what words they use when they reference KU.

## INSTRUCTION NO. 16

A trademark is any word, color, symbol, device, or any combination thereof, used by a person to identify and distinguish that person's goods from those of others and to indicate the source of the goods.

A person acquires the right to exclude others from using a trademark by being the first to use it in the marketplace. Rights in a trademark are obtained only through commercial use of the mark. The owner of a trademark has the right to exclude others unless the trademark has been abandoned.

One who uses an identical or confusingly similar imitation of the trademark of another may be liable for damages.

## INSTRUCTION NO. 17

The trademark laws balance three often-conflicting goals: (1) protecting the public from being misled about the nature and source of goods and services, so that the consumer is not confused or misled in the market; (2) protecting the rights of a business to identify itself to the public and its reputation in offering goods and services to the public; and (3) protecting the public interest in fair competition in the market.

The balance of these policy objectives varies from case to case, because they may often conflict. Accordingly, each case must be decided by examining its specific facts and circumstances, which you are to evaluate.

In my instruction, I will identify types of facts you are to consider in deciding if defendants are liable to plaintiffs for violating trademark law. These facts are relevant to whether defendants are liable for:

- (1) infringing KU's trademark rights in its federally registered marks by using these trademarks in a manner likely to cause confusion among consumers;
- (2) infringing KU's trademark rights in its state registered marks by using these trademarks in a manner likely to cause confusion among consumers;
- (3) infringing KU's trademark rights in its common law marks by using these trademarks in a manner likely to cause confusion among consumers;
- (4) unfairly competing, by using KU's trademarks in a manner likely to cause confusion as to the source or origin of defendants' and plaintiffs' goods;
- (5) diluting KU's trademark rights in its federally registered marks by eroding the public's exclusive identification of the marks with plaintiffs or creating an association that is

likely to harm KU's reputation; or

(6) diluting KU's trademark rights in its state registered marks by eroding the public's exclusive identification of the marks with plaintiffs or creating an association that is likely to harm KU's reputation.

INSTRUCTION NO. 18

Each defendant is alleged to be liable for each of the six claims at issue in this case. It is your duty to give separate consideration to the evidence as it pertains to each defendant. Your verdict with respect to each defendant must be unanimous.

INSTRUCTION NO. 19

On each of KU's claims for infringement and unfair competition, KU has the burden of proving by a preponderance of the evidence that:

1. the mark is a valid, protectable trademark;
2. KU owns the mark as a trademark; and
3. defendants used a mark similar to one of KU's marks without the consent of KU in a manner that is likely to cause confusion among ordinary consumers as to the source, sponsorship, affiliation, connection, or association of the goods.

If you find that each of the elements on which KU has the burden of proof has been proved by a preponderance of the evidence, your verdict should be for KU. If, on the other hand, KU has failed to prove any of these elements by a preponderance of the evidence, your verdict should be for defendants.

I will instruct you on how to apply each of these elements to the evidence before you.

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## INSTRUCTION NO. 20

I gave you Instruction No. 19 that requires plaintiff to prove by a preponderance of the evidence that the trademark is valid and protectable and that plaintiff owns the trademark. One way for the plaintiff to prove trademark validity is to show that the trademark is registered. An owner of a trademark may obtain a certificate of registration issued by the United States Patent and Trademark Office and may submit that certificate as prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein.

Exhibits 1, 87, 89, 91, 93, 95, 97, and 98 are registrations for the KANSAS, KU, JAYHAWKS, JAYHAWK Head design, and JAYHAWK design marks. KU's registration of these trademarks is conclusive evidence of KU's ownership of these marks and that the trademarks are valid and protectable. Incontestable marks cannot be challenged as lacking secondary meaning; such marks are conclusively presumed to be nondescriptive or to have acquired secondary meaning.

I instruct you that for the purposes of Instruction No. 19, you must find that KU owns these marks and that these trademarks are valid and protectable as to the goods and services for which the registrations were issued.

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INSTRUCTION NO. 21

Exhibits 73, 97-98, 100-101, 400, and 440 are registrations for the JAYHAWK design, the JAYHAWK mark, THE PHOG mark, the ROCK CHALK JAYHAWK mark, and the ALLEN FIELDHOUSE mark. These registrations serve as prima facie evidence of KU's ownership of these marks and that the trademarks are valid and protectable. There is a presumption in favor of KU that these marks are valid and protectable. It is the defendants' burden to show otherwise by a preponderance of the evidence.

I instruct you that for the purposes of Instruction No. 19 unless you find that defendants have shown by a preponderance of the evidence otherwise, you must find that KU owns the marks set forth in these registrations and that these trademarks are valid and protectable as to the goods and services for which the registrations were issued.



## INSTRUCTION NO. 22

I gave you Instruction No. 20 which identified several marks owned by KU that are the subject of incontestable registrations and, therefore, you must find that these marks are valid and protectable for the goods and services for which the registrations were issued. For the remaining marks that KU alleges to own, you must determine whether they are valid trademarks. A valid trademark is a word, symbol, or device that is either:

1. inherently distinctive; or
2. descriptive, but has acquired secondary meaning.

Only if you determine that KU's mark is not inherently distinctive should you consider whether it is descriptive but became distinctive through the development of secondary meaning, as I will direct in Instruction 24.

## INSTRUCTION NO. 23

How distinctively or strongly a trademark indicates that a good comes from a particular source is an important factor to consider in assessing its validity and for determining whether the trademark used by defendants creates for consumers a likelihood of confusion with plaintiffs' trademark.

Plaintiffs assert certain words, colors, and symbols are valid and protectable trademarks. Plaintiffs contend that defendants' use of those similar words, symbols, or devices in connection with the defendants' T-shirts infringes plaintiffs' trademarks and are likely to cause confusion about the origin, sponsorship, connection, or affiliation of goods associated with those trademarks.

In order to determine if plaintiffs have met their burden of showing that a given trademark is a valid trademark, you should classify it on the spectrum of trademark distinctiveness that I will explain in this instruction.

An inherently distinctive trademark is a word, symbol or device, or combination of them, which intrinsically identifies a particular source of a good in the market. The law assumes that an inherently distinctive trademark is one that almost automatically tells a consumer that it refers to a brand or a source for a product, and that consumers will be predisposed to equate the trademark with the source of a product.

### **Spectrum of Marks**

Trademark law provides protection to distinctive or strong trademarks. Conversely, trademarks that are not as distinctive or strong are called "weak" trademarks and receive less protection from infringing uses. Trademarks that are not distinctive are not entitled to any trademark protection. For deciding trademark protectability you must consider whether a trademark is inherently distinctive. Trademarks are grouped into five categories according to their relative strength and distinctiveness. These five categories are, in order of strength or distinctiveness: fanciful (which is inherently distinctive), arbitrary (which is inherently

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distinctive), suggestive (which also is inherently distinctive), descriptive (which is protected only if it acquires in consumers' minds a "secondary meaning" which I explain in Instruction 24), and generic trademarks (which are entitled to no protection).

Fanciful Trademarks. The first category is "fanciful" trademarks. They are considered strong marks and are clearly protectable. They are words invented or selected for the sole purpose of functioning as a trademark.

Arbitrary Trademarks. The second category is "arbitrary" trademarks. They are considered strong marks and are clearly protectable. They involve the arbitrary or fictitious use of a word to designate the source of a product. Such a trademark is a word that in no way describes or has any relevance to the particular product it is meant to identify. It may be a common word used in an unfamiliar way. It may be a newly created (coined) word or parts of common words which are applied in a fictitious or unfamiliar way, solely as a trademark.

For instance, the common word "apple" became a strong and inherently distinctive trademark when used by a company to identify the personal computers that company sold. The company's use of the word "apple" was arbitrary or fanciful because "apple" did not describe and was not related to what the computer was, its components, ingredients, quality, or characteristics. "Apple" was being used in an arbitrary way to designate for consumers that the computer comes from a particular manufacturer or source.

Suggestive Trademarks. The next category of marks is suggestive trademarks. These trademarks are also inherently distinctive but are considered weaker than arbitrary trademarks. Unlike arbitrary trademarks, suggestive trademarks imply some characteristic or quality of the product to which they are attached. If the consumer must use imagination or any type of multi-stage reasoning to understand the trademark's significance, then the trademark does not describe the product's features, but suggests them.

A suggestive use of a word involves consumers associating the qualities the word suggests to the product to which the word is attached. For example, when "apple" is used not to

indicate a certain company's computers, but rather "Apple-A-Day" Vitamins, it is being used as a suggestive trademark. "Apple" does not describe what the vitamins are. However, consumers may come to associate the healthfulness of "an apple a day keeping the doctor away" with the supposed benefits of taking "Apple-A-Day" Vitamins.

Descriptive Trademarks. The fourth category of marks is descriptive trademarks. These trademarks directly identify or describe some aspect, characteristic, or quality of the product to which they are affixed in a straightforward way that requires no exercise of imagination to be understood.

For instance, the word "apple" is descriptive when used in the trademark "CranApple" to designate a cranberry-apple juice. It directly describes ingredients of the juice. Other common types of descriptive trademarks identify where a product comes from, or the name of the person who makes or sells the product. Thus, the words "Apple Valley Juice" affixed to cider from the California town of Apple Valley is a descriptive trademark because it geographically describes where the cider comes from. Similarly, a descriptive trademark can be the personal name of the person who makes or sells the product. So, if a farmer in Apple Valley, Judy Brown, sold her cider under the label "Judy's Juice" (rather than Cran Apple) she is making a descriptive use of her personal name to indicate and describe who produced the apple cider and she is using her first name as a descriptive trademark.

Generic Trademarks. The fifth category of trademarks is entitled to no protection at all. They are called generic trademarks and they give the general name of the product of the plaintiff. They are part of our common language which we need to identify all such similar products. They are the common name for the product to which they are affixed. It is the general name for which the particular product or service is an example.

It is generic if the term answers the question "what is the product being sold?" If the average consumer would identify the term with all such similar products, regardless of the manufacturer, the term is generic and not entitled to protection as a trademark.

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Clearly, the word apple can be used in a generic way and not be entitled to any trademark protection. This occurs when the word is used to identify the fleshy, red fruit from any apple tree.

The computer maker who uses that same word to identify the personal computer, or the vitamin maker who uses that word on vitamins, has no claim for trademark infringement against the grocer who used that same word to indicate the fruit sold in a store. As used by the grocer, the word is generic and does not indicate any particular source of the product. As applied to the fruit, “apple” is simply the common name for what is being sold.

### **Mark Distinctiveness and Validity**

If you decide that plaintiffs’ claimed trademark is fanciful, arbitrary, or suggestive, it is considered to be inherently distinctive. An inherently distinctive trademark is valid and protectable.

On the other hand, if you determine that plaintiffs’ claimed trademark is generic, it cannot be distinctive and therefore is not valid nor protectable.

If you decide that plaintiffs’ claimed trademark is descriptive, you will not know if the trademark is valid or invalid until you consider if it has gained distinctiveness by the acquisition of secondary meaning, which I explain in the next Instruction. Likewise, a color can never be inherently distinctive. Color can only be protected as a trademark upon a showing of secondary meaning.

## INSTRUCTION NO. 24

If you determined that one of plaintiffs' claimed trademarks is descriptive, you must consider the recognition that the mark has among prospective purchasers. This market recognition is called the trademark's "secondary meaning."

A word, color, or symbol acquires a secondary meaning when it has been used in such a way that its primary significance in the minds of the prospective purchasers is not the product itself, but the identification of the product with a single source, regardless of whether consumers know who or what that source is. You must find that the preponderance of the evidence shows that a significant number of the consuming public associates the alleged trademark with a single source in order to find that it has acquired secondary meaning.

You may consider the following factors, as well as any other relevant evidence, when you determine whether the mark has acquired a secondary meaning: (a) direct consumer testimony, (b) surveys, (c) amount and manner of advertising, (d) unsolicited media coverage, (e) exclusivity, length and manner of use, (f) volume of sales and number of customers, and (g) proof of intentional copying.

Descriptive marks are protectable only to the extent you find they acquired distinctiveness through secondary meaning. Descriptive marks are entitled to protection only as broad as the secondary meaning they have acquired, if any. If they have acquired no secondary meaning, they are entitled to no protection and cannot be considered a valid mark.

The mere fact that plaintiffs are using the mark, or that plaintiffs began using them before the defendant, does not mean that the trademark has acquired secondary meaning. There is no particular length of time that a trademark must be used before it acquires a secondary meaning.

## INSTRUCTION NO. 25

If you find that one of plaintiffs' marks are inherently distinctive, then you must consider whether the evidence shows that plaintiffs used the mark as a trademark for plaintiffs' products before the defendants began to use the mark. That is, plaintiffs must have attached the mark to plaintiffs' products before defendants made such use of the mark.

You must also determine whether the evidence shows that the plaintiffs' use of the mark as a trademark for its products was continuous. That is, the plaintiffs' use of the mark must not have constituted merely a token use of the mark. Token use is sporadic, casual, or transitory use that is not part of an ongoing program to exploit the trademark commercially. The number of sales does not conclusively establish continuous use, but there must be a bona fide attempt to establish a trade or a market in the product.

The date that the party conceived the idea of the mark does not constitute use.

If you find that one of plaintiffs' marks is not inherently distinctive, but that plaintiffs' have established secondary meaning in it, you must then consider whether plaintiffs' can prove by a preponderance of the evidence that plaintiffs' mark possessed secondary meaning before defendants first began use of the mark.

## INSTRUCTION NO. 26

Confusion in the marketplace can occur at three distinct times: at the moment of purchase (called “point-of-sale” confusion), before the purchase (called “initial-interest” confusion), and after the purchase (called “post-sale” confusion). I will now explain each of these concepts to you.

Point-of-sale confusion can occur when defendants’ use of a trademark is likely to cause consumers confusion about the source, sponsorship, connection, or affiliation of defendants’ products at the time of purchase.

Initial-interest confusion occurs when a consumer is lured to the product of a competitor by the competitor’s use of the same or similar mark. Even though the consumer may realize that the product is not the one originally sought, he or she may stay with the competitor. In that way, the competitor has captured the trademark holder’s potential visitors or customers. Even if the consumer eventually becomes aware of the source’s actual identity, or where no actual sale occurs, there is still damage to the trademark. Thus, defendants also may be liable if you find a likelihood of initial-interest confusion.

Post-sale confusion occurs when someone other than the purchaser sees the item after it has been purchased and mistakenly believes it is approved, sponsored or affiliated with the trademark owner. Thus, defendants may also be liable for infringement if you find that one or more potential purchasers of apparel bearing the KU marks have been or are likely to be confused by one or more of the accused T-shirts if such potential purchasers encounter defendants’ T-shirts in public, not knowing the circumstances under which they were sold.



## INSTRUCTION NO. 27

It is not necessary for KU to manufacture or sell its T-shirts in order to receive protection of its marks. When KU's licensees manufacture or sell T-shirts, the placement of KU's marks on a T-shirt signifies that KU authorizes, endorses and licenses the sale of the T-shirt. For this reason, KU remains the source of its licensed T-shirts even if they are manufactured and distributed by licensees. You should attribute any goodwill generated by the licensees' use of KU's marks to KU.

## INSTRUCTION NO. 28

You must consider whether the defendants' use of the accused marks is likely to cause confusion about the source, affiliation, sponsorship, connection, association, or approval of defendants' goods.

I will suggest some factors you should consider in deciding whether there is a likelihood of confusion. The presence or absence of any particular factor that I suggest should not necessarily resolve whether there was a likelihood of confusion, because you must consider all relevant evidence in determining this. Likelihood of confusion is not determined by mechanically counting the number of factors that weigh in favor of each party. As you consider the likelihood of confusion you should examine the following non-exhaustive list of factors:

- (1) The strength or weakness of the marks.
- (2) The degree of similarity between the marks.
- (3) Similarity of products and manner of marketing.
- (4) The degree of care likely to be exercised by purchasers
- (5) The intent of the defendants in adopting its marks.
- (6) Evidence of actual confusion.

I will now instruct you about how these factors should be applied to the factual determinations that you will make in this case.

## INSTRUCTION NO. 29

The first factor is the strength or weakness of KU's trademarks.

The more the consuming public recognizes KU's trademarks as an indication of the origin of KU's goods, the more likely it is that consumers would be confused about the source, affiliation, sponsorship, connection, or association of defendants' goods if defendants use similar marks.

The stronger the mark, the greater the likelihood that encroachment on the mark will cause confusion. The weaker the mark, the less likelihood that encroachment on the mark will cause confusion.

In determining the strength of KU's marks, you should refer to the five categories of marks that you considered when determining the marks' protectability and validity in Instruction 23. If you determine a trademark is weak—that is, suggestive or descriptive, you must consider the trademark's "secondary meaning." If a suggestive trademark has secondary meaning, it becomes stronger. If it has developed no secondary meaning, it remains a weak trademark.

To determine whether KU's trademarks are strong, you may also consider factors such as sales of products bearing KU's trademarks, the duration and nature of use of KU's trademarks, the popularity of KU's trademarks, and unsolicited media coverage of KU's trademarks.

Finally, you are instructed that a strong trademark is one that is rarely used by parties other than the owners of the trademark, while a weak trademark is one that is often used by other parties. The weight to be given such evidence may be limited when the use of similar marks is not on similar goods. When deciding how much weight to give to the use of KU's marks by other parties, you should consider the probable impact of the use of those marks on the minds of the target group of consumers.

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## INSTRUCTION NO. 30

The second factor is the similarity of the marks.

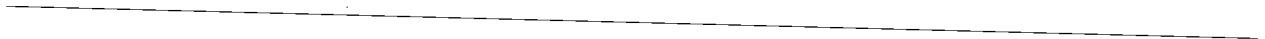
You should evaluate similarity between marks on the levels of sight, sound, and meaning and should consider them in the context of the marks as a whole as they are encountered by consumers in the marketplace. Furthermore, you should give the similarities between the marks more weight than the differences. KU's marks and the marks used by defendants do not need to be identical. All that is necessary is enough similarity between the marks to confuse consumers.

You should not engage in a side-by-side comparison of the marks to determine similarity. This means you are prohibited from considering differences so minuscule they are only detectable via a side-by-side comparison.

# INSTRUCTION NO. 31

A potential infringer cannot avoid confusion simply by adding a word or phrase to the mark. Thus, you may still find a likelihood of confusion even if defendants have added words, phrases, or a logo to their T-shirts.

Furthermore, for purposes of the likelihood of confusion analysis, you may not shorten a trademark when evaluating the similarity of the marks.



## INSTRUCTION NO. 32

The third factor is similarity of the products and the manner of marketing.

When evaluating the similarity of the products, it is not necessary for the parties' goods to be identical for there to be a likelihood of confusion about the source, affiliation, connection, or association of goods. However, the greater the similarity between the products, the greater the likelihood of confusion. Where goods are directly competitive, the degree of similarity of the marks needed to cause likely confusion is less than in the case of dissimilar goods.

When evaluating the manner of marketing, you should consider whether the parties reach the same consumers through overlapping marketing channels. Confusion is more likely where the plaintiffs' and defendants' goods are sold through similar outlets and target similar consumers.

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### INSTRUCTION NO. 33

The fourth factor is the consumer's degree of care.

For purposes of evaluating likelihood of confusion at the point-of-sale, you must consider whether a typical consumer exercising ordinary care would be confused as to the source, sponsorship, affiliation, connection, or association of defendants' T-shirts with plaintiffs. Buyers typically exercise little care in the selection of inexpensive items that may be purchased on impulse. Thus, if you find that defendants' T-shirts are inexpensive goods, you should take into account that consumers will exercise a low degree of care when purchasing them.

In the post-sale confusion context, the degree of care exercised by a consumer is irrelevant because a post-sale observer may be unaware of the cost of the infringing product.

#### INSTRUCTION NO. 34

The fifth factor is defendants' intent.

Bad faith or fraudulent intent is not required for trademark infringement. However, proof that defendants intentionally chose KU's marks in order to benefit from KU's reputation creates a presumption that defendants' marks in fact infringe upon KU's marks.

If you find that defendants' intended to derive a benefit from the goodwill or reputation of KU, this intent alone may justify an inference of likelihood of confusion. If you find that defendants did not intend to derive a benefit from one of plaintiffs' existing marks, this factor weighs against a likelihood of confusion.



INSTRUCTION NO. 35

If you find that there is a high degree of similarity between KU's marks and those used by defendants, you may use this finding to infer that defendants intended to draw upon the reputation of KU's preexisting marks.

INSTRUCTION NO. 36

The sixth factor is actual confusion.

If defendants' use of marks similar to KU's marks has led to instances of actual confusion, this strongly suggests a likelihood of confusion. Actual confusion may be proved by direct or circumstantial evidence.

However, actual confusion is not required for a finding of likelihood of confusion.

#### INSTRUCTION NO. 37

A survey is not required to demonstrate actual confusion. However, a reliable consumer survey conducted according to accepted survey principles may be used as a proxy for evidence of actual confusion. You may determine the weight to attribute a survey as with all other evidence in the case.

INSTRUCTION NO. 38

Disclaimers in a store or on a website do not have any effect on initial-interest confusion or post-sale confusion. When you are determining whether defendants' behavior has led to the likelihood of initial-interest or post-sale confusion, defendants' disclaimers should not impact your decision.

### INSTRUCTION NO. 39

While you may consider whether a trademark owner would license the alleged infringing products in determining whether there is a likelihood of confusion or unfair competition, the fact that a trademark owner would not license the infringing product does not prevent a finding of infringement or unfair competition.

#### INSTRUCTION NO. 40

KU also has a claim known as “unfair competition.” Whether the violation is called infringement or unfair competition, the test is identical: “is there a likelihood of confusion?” Unfair competition protects registered and unregistered trademarks. Accordingly, in considering KU’s unfair competition claims, you are to apply the same multi-factor test for likelihood of confusion described earlier for trademark infringement.

Defendants are liable for unfair competition if defendants’ shirts are likely to cause confusion as to affiliation, connection, approval, sponsorship or association with KU.

## INSTRUCTION NO. 41

KU has asserted a claim of state trademark infringement. For KU to recover from defendants on their claims for state trademark infringement, you must find that the following has been proved by KU by a preponderance of the evidence:

Defendants' unauthorized use in commerce of KU's state registered marks or reproductions, counterfeits, copies of colorable imitations thereof, in connection with defendants' sale, distribution, offering for sale, or advertising of any goods or services or in connection with such use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services.

Plaintiffs' state law registrations are deemed to be evidence of the facts set forth in those registrations, and this evidence is to be given such weight as the you think it is entitled to.

In considering KU's state trademark infringement claim, you are to apply the same multi-factor test for likelihood of confusion described earlier for federal trademark infringement and unfair competition.

## INSTRUCTION NO. 42

KU owns State of Kansas registrations for the following trademarks: JAYHAWK BASEBALL, JAYHAWK FOOTBALL, JAYHAWK BASKETBALL, KIVISTO FIELD, ALLEN FIELDHOUSE, THE PHOG, LATE NIGHT IN THE PHOG, BEWARE OF THE PHOG, FIGHTING MANGINOS, ROCK CHALK JAYHAWK, and ROCK CHALK.



#### INSTRUCTION NO. 43

KU has also asserted a claim for common law trademark infringement of its crimson-and-blue color scheme in combination with other trademarks such as KANSAS and JAYHAWKS. KU has the burden of demonstrating that defendants' use of KU's crimson-and-blue color scheme in connection with other indicia referencing KU is protectable and is likely to cause confusion among consumers as to the source, affiliation, connection, approval, sponsorship or association of defendants' goods or services.

In considering KU's common law trademark infringement claim, you are to apply the same multi-factor test for likelihood of confusion described earlier for federal trademark infringement and unfair competition.

#### INSTRUCTION NO. 44

You may not award damages against Mr. Orth if Mr. Orth proves by a preponderance of the evidence that he is both (1) “engaged solely in the business of printing” and (2) an “innocent” infringer.

A printer that in some manner aids or encourages his customers to infringe KU’s trademarks or participates in the infringement to a degree greater than just printing the product, cannot be considered to be “engaged solely in the business of printing.” In addition, to establish that he is an “innocent infringer,” Mr. Orth must prove by a preponderance of the evidence that, regardless of his state of mind, his conduct was objectively reasonable.

INSTRUCTION NO. 45

Mr. Sinks is personally liable for trademark infringement, dilution, and unfair competition if KU proves by a preponderance of the evidence that he directs, controls, ratifies, participates in, or is the moving force behind the infringing activity.

#### INSTRUCTION NO. 46

KU has also asserted two trademark dilution claims, one under federal law and one under state law. I will now give you some specific instructions to apply in considering these claims.

Trademark dilution is the lessening of the capacity of a famous or well-known or distinctive mark or trade dress to identify and distinguish goods or services. The purpose of the anti-dilution laws is to protect against the erosion, or blurring, of the trademark's value, or the tarnishment of a trademark's image.

#### INSTRUCTION NO. 47

Dilution can happen in two ways: blurring and tarnishment.

Blurring occurs when a defendant uses an identical or nearly identical version of the plaintiff's trademark to identify the defendant's goods or services, creating the possibility that the plaintiff's mark or trade dress will lose its ability to serve as a unique identifier of the plaintiff's product. This can occur even though there is no confusion as to source, sponsorship, affiliation, or connection.

Tarnishment is using a mark that is identical or nearly identical to a famous mark or trade dress of the plaintiff in such a way that harms the reputation of the plaintiff's mark by degrading the public's positive associations with the mark.

If KU proves dilution either by blurring or by tarnishment, then you should find for KU. KU is not required to prove dilution both by blurring and by tarnishment.

INSTRUCTION NO. 48

Defendants are liable on the federal dilution claim if KU has proven the following by a preponderance of the evidence:

- (1) KU owns famous marks that are distinctive;
- (2) Defendants are making use in commerce of one or more marks that are so similar to the famous marks as to give rise to an association between the marks;
- (3) Defendants' use began after KU's Marks became famous and distinctive; and
- (4) The association between the marks impairs the distinctiveness of KU's marks or harms the reputation of the marks through either blurring or tarnishment.

#### INSTRUCTION NO. 49

To prevail on its federal law claims for dilution of its marks, KU must prove by a preponderance of the evidence that its marks are “famous.” In considering whether KU’s trademarks are “famous,” you may consider the following factors:

- (1) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by KU or third parties;
- (2) The amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (3) The extent of actual recognition of the mark; and
- (4) Whether the mark is registered.

INSTRUCTION NO. 50

Defendants are liable for state dilution if KU has proven the following by a preponderance of the evidence:

- (1) KU's marks are distinctive and famous;
- (2) Defendants are making use in commerce of one or more marks that are identical or nearly identical to KU's marks;
- (3) Defendants' use began after KU's marks became distinctive and famous; and
- (4) Defendants' use of a mark identical to or nearly identical to KU's marks causes dilution of the distinctive quality of the marks.



## INSTRUCTION NO. 51

To prevail on its state law claim for dilution, KU must prove by a preponderance of the evidence that its mark is “distinctive and famous.” In determining whether the mark is distinctive and famous, consider the following, non-exclusive list of factors:

- (1) The degree of inherent or acquired distinctiveness of KU’s marks in Kansas;
- (2) The duration and extent of KU’s marks in connection with the goods and services with which the marks are used;
- (3) The duration and extent of advertising and publicity of KU’s marks in Kansas;
- (4) The geographical extent of the trading area in which KU’s marks are used;
- (5) The channels of trade for the goods or services with which KU’s marks are used;
- (6) The degree of recognition of KU’s marks in the trading areas and channels of trade in Kansas used by KU and defendants;
- (7) The nature and extent of use of the same or a similar marks by third parties; and
- (8) Whether KU’s marks are subject to a federal or State of Kansas registrations.

INSTRUCTION NO. 52

To prevail on its dilution claims, KU need not prove actual or likely confusion.

INSTRUCTION NO. 53

If you find for KU on any of its trademark infringement, unfair competition, or dilution claims, you may award the following:

- (1) Actual damages; and
- (2) Defendants' profits.

I will instruct you as to the requirements for each award and provide guidance as to how to calculate those awards.

#### INSTRUCTION NO. 54

If you find for KU on any of its trademark infringement, unfair competition, or dilution claims, you must determine KU's actual damages.

KU has the burden of proving actual damages by a preponderance of the evidence. Damages means the amount of money which will reasonably and fairly compensate KU for any injury you find was caused by either defendants' infringement or dilution of KU's marks or defendants' unfair competition with respect to KU's marks. It is not necessary for KU to prove that defendants acted willfully in order to recover actual damages. It is necessary for KU to prove actual confusion or actual dilution to recover actual damages.

In determining KU's actual damages, you should consider the following:

- (1) The injury to KU's reputation;
- (2) The injury to KU's goodwill, including injury to KU's general business reputation; and
- (3) Whether the evidence would support a reasonable royalty.

To recover actual damages, it is not necessary for KU to prove it has actually lost any sales because of the infringement, dilution, or unfair competition. Such damages may be based on direct evidence, such as a diversion of sales or testimony from the public, or from circumstantial evidence.

## INSTRUCTION NO. 55

KU is seeking actual damages in the form of a reasonable royalty. I want to give you some idea of what a reasonable royalty is, and how one is calculated.

A royalty is a payment made to the owner of a trademark by a non-owner in exchange for rights to use the trademark. A reasonable royalty is the royalty that would have resulted from a hypothetical negotiation between the trademark owner and a company in the position of defendants, taking place just before the infringement, dilution, or unfair competition began. You should also assume that both parties to that negotiation understood the trademark to be valid.

#### INSTRUCTION NO. 56

In order for KU to be entitled to recover defendants' profits from the sale of the infringing or diluting items, KU has the burden of proving by a preponderance of the evidence that defendants acted willfully or in bad faith when they infringed, diluted, or engaged in unfair competition with respect to the marks.

If you find that defendants intended to benefit from the goodwill or positive reputation associated with KU's trademarks, then you may find that defendants acted willfully or in bad faith.

It is not necessary for KU to prove actual damages or actual confusion in order to recover profits.

#### INSTRUCTION NO. 57

On any federal trademark infringement, unfair competition, or dilution claim on which you find for KU and you find that defendants acted willfully, KU is entitled to any profits earned by defendants that are attributable to defendants' infringement, subject to the limitations set forth in this instruction. You may not include in an award of profits any amount that you took into account in determining actual damages.

Profit is determined by deducting allowable expenses from gross revenue.

Gross revenue consists of all money derived by defendants from the sale of any items found to have infringed or diluted KU's marks, or from the sale of any items found to constitute unfair competition with KU. KU has the burden of proving defendants' gross revenue by a preponderance of the evidence.

Allowable expenses are those costs that defendants prove were of actual assistance in the production, distribution, or sale of the infringing or diluting items. Defendants have the burden of proving allowable expenses by a preponderance of the evidence.

## INSTRUCTION NO. 58

If you award monetary recovery to KU on its state trademark infringement claims, or any of its state unfair competition claims, you must also determine whether KU is entitled to punitive damages.

In this case KU claims defendants acted in a willful manner towards KU. If you award plaintiffs actual damages on the state claims, then you may consider whether punitive damages should be allowed. Punitive damages may be allowed in the jury's discretion to punish a defendant and to deter others from like conduct.

The burden is on the plaintiffs to prove by clear and convincing evidence defendants acted as claimed. Clear and convincing evidence means evidence that is certain, unambiguous and plain to the understanding and so reasonable and persuasive as to cause you to believe it.

If you find defendants did one or more of the acts claimed by plaintiffs you should then determine whether clear and convincing evidence has been presented that defendants acted in a willful manner. If you determine punitive damages should be allowed, your finding should be entered in the verdict form. After the trial the court will conduct a separate hearing to determine the amount of punitive damages allowed.



## INSTRUCTION NO. 59

I have instructed you concerning plaintiffs' damages, but that does not mean I believe the plaintiffs should, or should not, prevail in this case. That decision rests with you.

Your verdict must represent the considered judgment of each juror. Your verdict must be unanimous.

As jurors, you must consult with one another and deliberate with a view to reaching an agreement if you can do so without violence to individual judgment. Each of you must decide the case for yourself, but only after an impartial consideration of all the evidence with your fellow jurors. During your deliberations, do not hesitate to re-examine your own views or to change your opinion if you are convinced it is erroneous. But do not surrender your honest conviction as to the weight or effect of the evidence solely because of the opinion of your fellow jurors or simply to return a verdict.

Remember at all times you are not partisans. You are judges of the facts. Your sole interest is to seek the truth from the evidence in the case.

#### INSTRUCTION NO. 60

At the beginning of trial, I instructed that you could take notes during the course of trial and cautioned that your note-taking should not interfere with your duty to listen and consider all the evidence. Now that you are about to begin your deliberations, I would like to comment on your use of any notes during the deliberations.

There is always a tendency to attach undue importance to matters which one has written down. Some testimony which is considered unimportant at the time presented, and thus not written down, takes on greater importance later in the trial in light of all the evidence presented. Therefore, you are instructed that your notes are only a tool to aid your own individual memory. Your notes are not evidence, and are by no means a complete outline of the proceedings or a list of the highlights of the trial. If you did not take notes, you should rely upon your own independent recollection or memory of what the evidence was, and you should not be unduly influenced by the notes of other jurors. Notes are not entitled to any greater weight than the recollection or impression of each juror as to what the evidence was. Above all, your memory should be your greatest asset during your deliberations.

# INSTRUCTION NO. 61

At times during the trial, I have ruled on the admission of certain testimony and exhibits. Those matters are questions of law for the court. Do not concern yourselves with or draw any inferences from those rulings.

I have not intended to and I do not express or suggest any opinion in these instructions, my rulings, actions or remarks about the resolution of any issue in this case.

You will now hear arguments of counsel. Their role is to offer interpretations of the evidence consistent with their respective causes. Please give them your thoughtful and respectful attention.

## INSTRUCTION NO. 62

This is an important case. If you should fail to reach a decision, the case is left open and undecided. Like all cases, it must be decided sometime. There is no reason to believe that the case can be tried again any better or more exhaustively than it has been. There is no reason to believe that more evidence or clearer evidence would be produced on behalf of either side. Also there is no reason to believe that the case would ever be submitted to people more intelligent or more impartial or more reasonable than you. Any future jury must be selected in the same manner that you were.

This does not mean that those favoring any particular position should surrender their honest convictions as to the weight or effect of any evidence solely because of the opinion of other jurors or because of the importance of arriving at a decision.

This does mean that you should give respectful consideration to each other's views and talk over any differences of opinion in a spirit of fairness and candor. If at all possible, you should resolve any differences and come to a common conclusion so that this case may be completed.

### INSTRUCTION NO. 63

When you retire to the jury room, you will first select one of your members to preside over your deliberations, speak for the jury in court and sign the verdict upon which you agree. In this case your verdict will be returned in the form of written answers to special written questions submitted by the court. Your answers will constitute your verdict. Your answers to the questions must be unanimous. Your verdict must be founded entirely upon the evidence admitted and the law as given in these instructions.

It is your duty, as jurors, to discuss this case with one another in the jury room. You should try to reach agreement if you can do so without violence to individual judgment, because a verdict must be unanimous.

Each of you must make your own conscientious decision, but only after you have considered all the evidence, discussed it fully with your fellow jurors, and listened to the views of your fellow jurors.

Do not be afraid to change your opinions if the discussion persuades you that you should. But do not come to a decision simply because other jurors think it is right, or simply to reach a verdict. Remember at all times you are not partisans. You are judges of the facts. Your sole interest is to seek the truth from the evidence in the case.

#### INSTRUCTION NO. 64

During your deliberations, that is when all of you are together in the jury room, you are released from the admonition regarding discussion of the case.

The admonition regarding discussion remains in effect at any time when all of you are not in the jury room, or when you are away from the courthouse. The admonition regarding reading, listening to or watching news reports about the case, doing any sort of independent investigation or discussing the case with any third party, remains in effect at all times until such time as I release you from the admonition. I cannot overemphasize the importance of this admonition.

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## INSTRUCTION NO. 65

If it becomes necessary during your deliberations to communicate with the court, please write out your message or question, have the presiding juror sign and date it, and give the note to the law clerk or bailiff stationed outside of the jury room. No member of the jury should ever attempt to communicate with the court by any means other than a signed writing, and the court will never communicate with any member of the jury on any subject touching the merits of the case otherwise than in writing, or orally here in open court.

You will note from the oath taken by the bailiffs that they too, as well as all other persons, are forbidden to communicate in any way or manner with any member of the jury on any subject touching the merits of the case.

I will respond as promptly as possible, either in writing or by having you return to the courtroom so that I can address you orally. With regard to any message or question you might send, you should never state or specify your numerical division at the time. In other words, do not reveal how the group is voting, unless it is in response to a direct question from me about your division. Bear in mind also that you are never to reveal to any person how the jury stands—numerically or otherwise—on the question before you, until after you have reached an unanimous verdict.

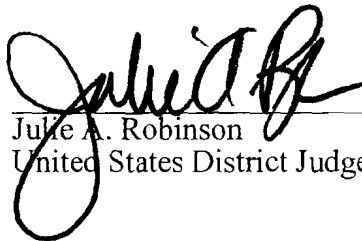
You may now retire and conduct your deliberations in such manner as may be determined by your good judgment as reasonable people.

INSTRUCTION NO. 66

A final suggestion by the court—not technically an instruction upon the law—may assist your deliberations. The attitude of jurors at the outset of and during their deliberations is important. It is seldom productive for a juror, immediately upon entering the jury room, to make an emphatic expression of his or her opinion upon the case or to announce a determination to stand for a certain verdict. The reason is obvious: we are all human and it is difficult to recede from a position once definitely stated, even though later convinced it is unsound.

Jurors are selected for the purpose of doing justice. This presupposes and requires deliberation—counseling together in an effort to agree. Have in mind at all times, therefore, that you are a deliberative body, selected to function as judges of the facts in a controversy involving the substantial rights of the parties. You will make a definite contribution to efficient administration of justice when and if you arrive at a just and proper verdict under the evidence which has been adduced. No one can ask more and you will not be satisfied to do less.

July 1, 2008  
Date

  
Julie A. Robinson  
United States District Judge