

No. 16-1225

IN THE SUPREME COURT OF THE UNITED STATES

PATTEL, INC.,

Petitioner,

v.

CAMMY GARDASHYAN,

Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FOURTEENTH CIRCUIT

BRIEF FOR PETITIONER

TEAM No. 101
COUNSEL FOR THE PETITIONER

QUESTIONS PRESENTED

- I. Whether the District Court of the Central District of Bel Air correctly held that, based on the Lanham Act and Supreme Court precedent, nominative fair use cases require a distinct and separate test in addition to the likelihood of confusion analysis and such use should be adopted as an affirmative defense when a user utilizes a trademark owner's mark to reference the owner's product in order to describes the user's own product?
- II. Whether the District Court of the Central District of Bel Air correctly applied the Ninth Circuit's three-prong nominative fair use test as an affirmative defense when the court held that Pattel's use of the mark was a nominative fair use?

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STATEMENT OF JURISDICTION

The judgment of the court of appeals was entered on June 5, 2016. The petition for a writ of certiorari was filed and granted by this Court. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STANDARD OF REVIEW

Whether nominative fair use is to be applied an affirmative defense per the Lanham Act and Supreme Court precedent is a question of law and is reviewed *de novo*. *Pierce v. Underwood*, 487 U.S. 552, 558 (1988).

Further, a grant of summary judgment is also reviewed *de novo*. *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001).

RELEVANT PROVISIONS INVOLVED

This case involves the determination of the nominative fair use doctrine and its elements to an incontestable trademark as specified in § 33(b)(4) of the Lanham Act which appears at 15 U.S.C. § 1115(b)(4). The relevant text appears below.

That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin;

This case also involves the interpretation of the fair use doctrine and the types of uses the doctrine encompasses as specified in § 43(c)(3)(A) of the Lanham Act which appears at 15 U.S.C. § 1125(c)(3)(A). The relevant text appears below.

Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services

STATEMENT OF THE CASE

Pattel, Inc. (“Pattel”), the creator of the iconic Bambi doll, has sold over 500 million dolls since 1961. *Gardashyan v. Pattel, Inc.*, 1135 F.3d 759, 355 (14th Cir. 2016). Since its creation, the original Bambi has always been a major source of inspiration for the new dolls. *Id.* The Bambi doll has proven to be a timeless doll and a collectable item. *Id.* It is sought after by people of many different ages, either as a toy or as a collector’s item. *Id.*

When designing the new Bambi dolls, Pattel takes inspiration from a variety of sources. *Id.* Some of the sources include, the original Bambi doll, actors, public figures, musicians, and different aspects of popular culture. *Id.* Bambi represents female independence and modern social values through its portrayal of said different sources of inspiration. *Id.* To create their successful dolls, Pattel often looks to popular trends in the market for inspiration. *Id.*

In January of 2015 Pattel released the Fashionista Bambi. *Id.* at 357. The Fashionista Bambi, as inspired by the original Bambi doll, follows the standard Bambi height and body figure. *Id.* She has long, black, straight hair, and wears an animal print tops, knee-length skirt, and sparkly high-heeled shoes. *Id.* One of the many sources of inspiration for the Fashionista Bambi was Cammy Gardashyan. *Id.* at 356.

Gardashyan is a widely known personality whose personal life is captured on several reality television shows and through multiple social media outlets. *Id.* Her fan base attracts people of all ages. *Id.* Gardashyan has been highly rated by

fashion magazines. *Id.* She and her sisters, like many other celebrities, follow the current fashion trends, which can include animal prints, knee length skirts or dresses, and shiny high-heeled shoes. *Id.* Further, although Gardashyan has long, straight, black hair, and a curvy-figure, she is only one of many celebrities who have the same trendy features. *Id.*

Pattel's Fashionista Bambi doll comes in a standard rectangular box with a transparent cover that allows customers to view the doll inside the sealed box. *Id.* at 357. The front and back covers include Pattel's standard messages, including warnings, recommendations, and the Bambi trademark. *Id.* The front cover of the box also displays the name "Fashionista Bambi." Underneath, there is a caption that advertises that the doll has a talking feature. *Id.* The caption reads: "I say: I want to be just like Cammy Gardashyan." The doll's recording says: "I want to be a fashionista just like Cammy Gardashyan." *Id.*

When referencing Gardashyan in the caption, Pattel did not utilize Gardashyan's stylized mark. *Id.* The stylized mark consists of "CG" displayed back to back and the words "Cammy Gardashyan" underneath in capital letters and in block typeface. *Id.* at 356. Pattel's caption is written in twenty-point font and in a standard black block typeface. *Id.* at 357. In addition, Pattel included a disclaimer on the back of the box that reads: "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan." *Id.*

The District Court for the Central District of Bel Air denied Gardashyan's claim for permanent injunction for trademark infringement for the use of "Cammy

Gardashyan.” *Id.* at 357-58. The district court held that Pattel is entitled to a nominative fair use affirmative defense and granted summary judgment in favor of Pattel. *Id.* at 365. On appeal, the Fourteenth Circuit Court of Appeals declined to adopt an affirmative defense for nominative fair use, and reversed and remanded the district court’s decision. *Id.* Pattel appealed to this Court and was granted certiorari.

SUMMARY OF THE ARGUMENT

The heart of trademark protection centers on protecting consumers from being deceived. As a result, trademark infringement focuses on one important factor, whether the use of the trademark is likely to cause confusion, mistake, or to deceive. To determine likelihood of confusion, the Fourteenth Circuit adopted a multi-prong likelihood of confusion test known as the *Polaroid* test, while other courts have adopted similar multi-prong tests.

If a trademark owner (“owner”) is able to meet its burden to prove the likelihood of confusion then the trademark user (“user”) can raise a defense to prove the use of the trademark was not infringement. One of those defenses is the fair use defense, which includes both classic fair use and nominative fair use. While both are fair uses of another’s mark, each one has a different factual issue on how the mark was used. In classic fair use, the user utilizes the owner’s mark to describe his own product. In nominative fair use, the user utilizes the owner’s mark to reference the owner’s product to describe his own product.

Nominative fair use should have a distinct and separate analysis in addition to the likelihood of confusion test. Because nominative fair use presents a different factual issue than classic fair use, a different analysis test is required in addition to the *Polaroid* test factors. The test should be additional to the likelihood of confusion analysis because it would relieve the owner from his burden to prove confusion. Further, the nominative fair use test should be separate from the likelihood of confusion test because it would prevent the defendant from raising and proving a fair use defense.

According to the Lanham Act and this Court's precedent, fair use is an affirmative defense. The Lanham Act directly states that fair use is a defense available in the event that confusion is found. According to the Lanham Act, a mark is infringed when the use of the mark causes confusion. Thus, when the use of the mark does not cause confusion there is no infringement and, therefore, no need to go through a fair use analysis. Accordingly, fair use is a defense that is raised when the owner meets his burden of showing a likelihood of confusion. Moreover, the Lanham Act refers to fair use as including both classic and nominative fair use; therefore, whenever the Act refers to a fair use it includes both fair uses. Additionally, this Court held that likelihood of confusion is the owner's burden, and it is not the burden of the user to negate confusion. Instead, if confusion is found, the Court concluded that the user could raise a fair use defense.

Further, the purpose of trademark law is to prevent consumer confusion. A trademark is not meant to provide the owner with a monopoly over all uses of the

mark. However, in this case, the Fourteenth Circuit Court of Appeals, contrary to basic trademark law, ultimately provided Gardashyan with a monopoly in *all* uses of the mark.

The most appropriate nominative fair use test is the Ninth Circuit's test. The Ninth Circuit's three-prong test is parallel to the fair use test in the Lanham Act. The test is tailored for nominative fair use but still closely matches the factors in the Act. Moreover, the Third Circuit's affirmative defense sets the bar higher than the Lanham Act allows. Thus, the Third Circuit's nominative fair use affirmative defense test is invalid.

In the present case, Pattel's use of the mark was a nominative fair use subject to an affirmative defense. Pattel had to use the mark because Gardashyan is not readily identifiable without use of her personal name and there is no substitute term. Moreover, Pattel did not use the entire logo on Gardashyan's mark, nor did Pattel make the mark stand out or be distinct from the rest of the message. In addition, Pattel used only enough of the mark that it needed to provide its customers context to describe what a "fashionista" is. Finally, Pattel did not suggest sponsorship or endorsement from Gardashyan, and even added a disclaimer to clarify that Pattel and Bambi were neither affiliated nor endorsed by Gardashyan.

ARGUMENT

- I. **The district court correctly determined that the nominative fair use doctrine requires a distinct and separate test in addition to the likelihood of confusion analysis and such use should be adopted as an affirmative defense.**

A trademark is a tool to protect consumers from product source confusion. *See* Lanham Act, 15 U.S.C. § 1114(1) (2012). The Lanham Act furthers the goal to protect consumers by allowing trademark owners to pursue action against infringers of their marks. In order to find infringement, it is necessary that the use of the mark lead to consumer confusion. *See id.* Use of the mark, alone, without cause for confusion, does not constitute trademark infringement. *Id.* However, even if confusion is found, the alleged infringer can put forth defenses to show that the use is fair. Lanham Act, 15 U.S.C. § 1115(b)(4).

One of those affirmative defenses is classic fair use, which is when the user utilizes a mark not as a mark, in a fair and good faith manner, and only to describe its goods. *Id.* Another affirmative fair use defense is nominative fair use. The Ninth Circuit first utilized the doctrine of nominative fair use when a user utilizes a mark to reference the owner's product in order to ultimately describe the user's own product. *See generally New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (1992). Nominative fair use is rooted in the Lanham Act, Supreme Court precedent, and case law. *See* Lanham Act, 15 U.S.C. § 1115(b)(4); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121-22 (2004). Although nominative and classic fair use present different factual issues, both doctrines allow

the user to describe his own product by utilizing another's mark in a fair and good faith manner. *See* Lanham Act, 15 U.S.C. § 1115(b)(4). Therefore, both should be subject to the same affirmative defense treatment.

A. When a user utilizes the owner's mark in reference to the owner's product, a distinct nominative fair use test should be applied separate and additional to the likelihood of confusion analysis.

Trademark infringement can present two different factual issues and therefore have two different fair use defenses. The first one, classic fair use, is when a user utilizes a mark to describe directly the user's own product. *New Kids*, 971 F.2d at 308. The second one, nominative fair use, is when a user utilizes a mark to reference the owner's product to ultimately describe the user's own product. *Id.* As a result, the distinct fact of referencing the owner's product to ultimately describe the user's product requires a distinct nominative fair use analysis separate and additional to the likelihood of confusion test.

1. Nominative fair use presents a different factual issue from classic fair use and therefore a distinct test is required.

One of the purposes of trademark law is to aid the consumer in distinguishing among competing products. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995). The heart of trademark protection centers on protecting consumers from being deceived. Under 15 U.S.C. § 1114, an owner is protected against infringement through the Lanham Act. To show trademark infringement under § 1114(1), the holder must show the use of the trademark is likely to cause confusion, or to cause mistake, or to deceive. *Id.* In determining whether there is a likelihood of confusion, each circuit applies a somewhat similar multi-prong test.

The Fourteenth Circuit has adopted the Second Circuit's likelihood of confusion test, known as the *Polaroid* test. The eight factors that should be analyzed in determining the likelihood confusion are:

(1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may "bridge the gap" by developing a product for sale in the market of the alleged infringer's product; (5) evidence of actual consumer confusion; (6) evidence that the imitative mark was adopted in bath faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.

Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 115 (2d Cir. 2009). The *Polaroid* factors test whether, looking at the products or services in their totality, consumers are likely to be confused as to the source of the product or service. *Id.* at 116.

The Lanham Act, while it protects trademark holders from trademark infringement, also provides defenses against infringement. One of those provided defense is § 1115(b)(4), commonly known as fair use. In classic fair use, after an owner has proven that there is a likelihood of confusion through the *Polaroid* test, then the user can raise a classic fair use defense by proving that: 1) the mark is not used as a mark, 2) the use is fair and in a good faith manner, and 3) the use is only to describe the goods or services. *See* § 1115 (b)(4). If the user can affirmatively

satisfy this test then the use is a permissive one and the defendant prevails regardless of a finding of a likelihood of confusion.

The Ninth Circuit Court of Appeals was the first court to utilize the different factual issues between classic and nominative fair use, when it created a separate nominative fair use test. In classic fair use, the user utilizes the owner's mark to describe the user's own product or service. *New Kids*, 971 F.2d at 308. Nominative fair use occurs when the user utilizes the mark to reference the owner's product in order to describe the user's own product. *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 214 (3d Cir. 2005). Because a nominative fair use presents a different factual issue, when the user refers to the owner's product in order to describe its own product, a different analysis is required to adequately address fair use in this fact pattern. *See generally Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 n.8 (9th Cir. 2002) (describing that a user would rarely, if ever, refer to an owner's product unless that reference ultimately helps to describe the user's own product).

When looking at the three-prong test the Ninth Circuit created to analyze nominative fair use, each factor is parallel to the Lanham Act's requirements for fair use. *See* Lanham Act, § 1115(b)(4). The court provides that a user is entitled to a nominative fair use defense provided the user affirmatively meets the following requirements: 1) the product must be one "not readily identifiable without use of the trademark"; 2) "only so much of the mark may be used as is reasonably necessary to identify the product"; and 3) the user must "do nothing that would, in conjunction

with the mark, suggest sponsorship or endorsement” by the mark holder. *New Kids*, 971 F.2d at 308.

The Sixth Circuit Court of Appeals declined to adopt a distinct nominative fair use analysis, stating that its likelihood of confusion test was sufficient, even in instances when the user utilized the owner’s mark to reference the owner’s products or services. *PACCAR, Inc. v. Telescan Techs., L.L.C.*, 319 F.3d 243, 251 (6th Cir. 2003). However, the Second, Third, and Ninth Circuit Court of Appeals agree that there needs to be a distinct analysis beyond likelihood of confusion when assessing nominative fair use cases. *See generally Century 21*, 425 F.3d at 224; *Int’l Info. Sec. Certification Consortium, Inc. v. Sec. Univ., L.L.C.*, 823 F.3d 153, 156 (2d Cir. 2016); *New Kids*, 971 F.2d at 305. In the context of nominative fair use cases, the application of the traditional multi-prong test is difficult because often many of the factors are either unworkable or not suited or helpful as indicators of confusion in this context. *Century 21*, 425 F.3d at 224. That is because, by definition, nominative fair use involves the use of another’s mark to reference the owner’s product. *Id.* Thus, application of the traditional multi-prong test, which focuses on the similarity of the mark used by the owner and the user, would lead to the incorrect conclusion that all nominative uses are confusing. *Playboy Enters. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002).

2. The nominative fair use test should be separate and additional to the likelihood of confusion analysis to not relieve the owner of his burden of proof and allow the user to argue fair use.

While a distinct analysis is needed for nominative fair use cases, there is no legal basis of supplanting the likelihood of confusion test entirely. *Century 21*, 425 F.3d at 220. Once the owner has met his burden of proving there is a likelihood of confusion, the burden then shifts to the user to show that his nominative use of the owner's mark is nonetheless fair. *Id.* at 222. Depending on the factual issue of infringement, a classic or nominative fair use test should be applied. The Ninth Circuit erroneously reasoned that because nominative use makes it clear to consumers that the owner, not the user, is the source of the mark's product or service, there is no need to prove likelihood of confusion. *New Kids*, 971 F.2d at 307-08. The court, in its reasoning, did not take into consideration that even accurate nominative use could potentially confuse consumers about the holder's endorsement or sponsorship of the user's products or services. *Century 21*, 425 F.3d at 221. As a result, the Ninth Circuit was wrong in supplanting the likelihood of confusion test and relieving the owner of meeting his burden of proving likelihood of confusion.

In addition to being separate, the nominative fair use test should not be incorporated into the likelihood of confusion analysis. The nominative fair use test does not require the user to negate likelihood of confusion, but instead to prove fair use. *See KP Permanent*, 543 U.S. at 118 (reasoning that Congress would not use the phrase "used fairly" and then require the user to negate confusion.). In *Century 21*,

Judge Fisher dissented, in part with the majority, in having a two-step approach to a nominative fair use defense, reasoning that having a bifurcated analysis places a burden of negating likelihood of confusion on the user. 425 F.3d at 232-33. The Second Circuit Court of Appeals followed this reasoning and rejected the Third Circuit's majority decision to have a two-step approach in nominative fair use cases, and instead, adopted the *Polaroid* test factors plus the three-prong nominative fair use factors from the Ninth Circuit. *See Int'l Info.*, 823 F.3d at 156. However, such arguments clearly go against this Court's holding that users do not have the burden of negating the likelihood of confusion when raising a fair use defense. *KP Permanent*, 543 U.S. at 118.

By allowing the three-prong nominative fair use test to be incorporated in the likelihood of confusion analysis, it wrongly places the burden to prove fair use on the owner instead of the user. *See id.* The two-step approach does not require the user to negate likelihood of confusion because the nominative fair use test analyzes fairness not likelihood of confusion. This Court reasoned in *KP Permanent* that the user could offer rebutting evidence to undercut the prima facie case of trademark infringement, including likelihood of confusion. *Id.* at 120. However, the user also has the opportunity to raise an affirmative defense even if the user cannot undercut the prima facie case. *Id.* As a result, when a user analyzes nominative fair use, he does not have to negate likelihood of confusion, but instead prove fair use through the three-prong test.

Thus, this Court should follow its binding precedent in *KP Permanent* and adopt the Third Circuit Court of Appeals' two-step approach in nominative fair use cases. Once the owner meets his burden to prove likelihood of confusion, the burden then shifts to the user to demonstrate fairness, not to negate confusion. *KP Permanent*, 543 U.S. at 120; *Century 21*, 425 F.3d at 222.

B. Nominative fair use is an affirmative defense in accordance with the Lanham Act, and Supreme Court precedent.

Both the intent of the Lanham Act and this Court's decision in *KP Permanent* require nominative fair use to be raised as an affirmative defense. According to the Lanham Act, trademark law does not limit trademark uses to either infringement or fair use. *See* Lanham Act, 15 § 1114(1). If a user utilizes another's mark, but the use does not cause confusion then the use is not infringement and, therefore, there is no need for a fair use exception. *See id.* (stating that when the use of a mark causes consumer confusion then the use is trademark infringement). Further, the Supreme Court determined that, in fair use cases, the owner's only burden is to present likelihood of confusion and then the user has the burden to show that the use was nonetheless fair. *KP Permanent*, 543 U.S. at 121-22. Ultimately finding that some degree of likelihood of confusion, by itself, does not preclude a fair use defense. *Id.* at 117.

1. The language Lanham Act encompasses nominative fair use.

The language of the Lanham Act clearly incorporates nominative fair use as an affirmative defense. In § 1115, the Lanham Act sets out the defenses for trademark infringement. *See* Lanham Act, 15 U.S.C. § 1115(b). The Lanham Act

discusses the fair use defense as when “the use of the name, [or] term . . . charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, . . . or of a term or device.” *Id.* at § 1115(b)(4). The Act further states that a use is fair when it “is descriptive of and used fairly and in good faith only to describe the goods or services of such party.” *Id.*

Section 1115(b)(4) provides a fair use exception for the use of an owner’s mark by a user in order to describe the user’s product. Nominative fair use is precisely that type of use; the use of an owner’s mark as a reference to the owner’s product to describe the user’s own product. *See Cairns*, 292 F.3d at 1151 (describing nominative fair use as when “the defendant’s ultimate goal is to describe his own product”); *Ty, Inc. v. Publ’ns Int’l, Ltd.*, No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420, at *15 (N.D. Ill. Feb. 25, 2005) (stating that a user will refer to the owner’s mark solely to describe his own product).

The Ninth Circuit’s nominative fair use test is parallel to the test set forth in the Lanham Act. The Lanham Act requires that, in order to be a fair use, the user must: 1) use the mark in a way “otherwise than as a mark,” 2) the mark must be “used fairly and in good faith,” and 3) “only to describe the goods or services of such party.” 15 U.S.C. § 1115(b)(4). The factors in the nominative fair use test from *New Kids* reflect the Lanham Act’s three requirements. *See* 971 F.2d at 306. First, the Ninth Circuit’s test requires “the product . . . in question must be one not readily identifiable without use of the trademark.” *Id.* This requirement is parallel to Lanham Act’s requirement that the mark is used descriptively and also considers

good faith. *See* Lanham Act, § 1115(b)(4). Second, the Ninth Circuit nominative fair use test requires that “only so much of the mark . . . may be used as is reasonably necessary to identify the product.” *New Kids*, 971 F.2d at 306. This second requirement serves the same purpose as the Lanham Act’s requirement that the mark is used fairly. *See* Lanham Act, § 1115(b)(4). Last, the Ninth Circuit requires that “the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.” *New Kids*, 971 F.2d at 306. This last prong is similar to the Lanham Act’s requirement that the user cannot use the owner’s mark as a trademark. *See* Lanham Act, § 1115(b)(4). The last requirement also touches on the user’s requirement to use the mark “fairly and in good faith.” *See id.*

Moreover, § 1125 of the Lanham Act includes nominative fair use in its definition of fair use exceptions. The Act cites “any fair use, including a nominative or descriptive [classic] fair use” as an exception to dilution. Lanham Act, 15 U.S.C. § 1125(c)(3)(A) (2012). Congress clearly included nominative fair use as part of the larger fair use exception; therefore, wherever the Lanham Act refers to “fair use” it is referring to both nominative and classic fair uses. *See id.* Thus, when referring to fair use, § 1115(b)(4) of the Lanham Act requires an affirmative defense for nominative fair use as well. *See id.* Moreover, § 1115 does not specifically cite “classic” fair use, thus if Congress intended to differentiate between classic and nominative fair use in this section it would have been explicit. *See id.*

2. The Lanham Act must be interpreted in accordance with Supreme Court precedent, which requires an affirmative defense for fair use.

Fair use exceptions are applied as affirmative defenses because only the owner has the burden of proving the likelihood of confusion. *See* Lanham Act, § 1115(b)(4) (describing fair use as a defense); *KP Permanent*, 543 U.S. at 120-22 (holding that in fair use cases the burden of showing likelihood of confusion always rests with the owner); *Century 21*, 425 F.3d at 221-22 (“We are thus left with the firm conviction that the burden of proving likelihood of confusion should remain with the plaintiff [owner] in a trademark infringement case – including one where the defendant claims nominative fair use.”).

Since as early as the 1920’s, this Court has not required the user to negate confusion in fair use cases. In *Prestonettes, Inc. v. Coty*, this Court reaffirmed that the purpose of trademark law is to prevent consumer confusion. 264 U.S. 359, 368 (1924). Later, in *KP Permanent*, this Court held that when a defendant raises a fair use defense, there is no burden to negate the likelihood of confusion. 543 U.S. at 120-22. This means that in fair use cases where the defendant raises the affirmative defense, the defendant only has to show that the use of the trademark is fair without having to argue about any confusion it may cause. *See id.*; *see also Dow Jones & Co. v. Int’l Sec. Exch., Inc.*, 451 F.3d 295, 308 (2d Cir. 2006) (“While a trademark conveys an exclusive right to the use of a mark in commerce in the area reserved, that right generally does not prevent one who trades a branded product from accurately describing it by its brand name, so long as the trader does not

create confusion by implying an affiliation with the owner of the product.").

Prior to this Court's holding in *KP Permanent* that the defendant has no burden to dispute confusion, the circuits were split as to the defendant's role in fair use claims. Some circuits determined that confusion and fair use could not coexist and, thus, required that the defendant contest the likelihood of confusion, while other circuits concluded that some confusion was permissible as long as the defendant could establish fair use. *Compare Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983) (holding that under the fair use defense, "anyone is free to use the term in its primary, descriptive sense so long as such use does not lead to customer confusion as to the source of the goods or services."), *with Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 110 F.3d 234, 243 (4th Cir. 1997) ("[A] determination of likely confusion [does not] preclud[e] considering the fairness of use."). *See generally* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:47 (4th ed.) (rev. ed. 2016).

This Court's standard regarding classic fair use is to be applied to nominative fair use. In response to the decision in *KP Permanent*, the Third Circuit addressed the issue of nominative fair use in accordance. *See Century 21*, 425 F.3d at 221-22. The Third Circuit highlighted that this Court "clearly established that it was plaintiff's burden in a classic fair use case to prove likelihood of confusion. . . . [O]nce the plaintiff proves likelihood of confusion, defendant only had to show that defendant's use, even if confusing, was 'fair.'" *Id.* at 221. Further, the Third Circuit pointed to this Court's determination that some confusion does not necessarily

negate fair use and thus, this Court upheld the use of the likelihood of confusion analysis in addition to a fair use affirmative defense. The court went on to say, “[u]nder our [affirmative defense] approach, the defendant has no duty to negate confusion as such, but rather must merely show that its use of the plaintiff’s mark is fair, a burden which, by contrast, is not cumbersome.” *Id.* at 223. This, the Third Circuit says, is inline with the Lanham Act and Supreme Court precedent. *Id.*

Moreover, the Sixth Circuit applies an affirmative defense test to determine nominative fair use. The Sixth Circuit has rejected a separate nominative fair use analysis and instead analyzes nominative fair use under the classic fair use analysis. *See ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 920-21 (6th Cir. 2003) (utilizing a fair use analyses for a traditionally nominative fair use issue); *PACCAR, Inc.*, 319 F.3d at 256 (“This circuit has never followed the nominative fair use analysis, always having applied the *Frisch’s Restaurants* test. We are not inclined to adopt the Ninth Circuit’s analysis here.”) (*rev’d on other grounds*). As a result of, *KP Permanent*, where the Supreme Court has required fair use to be applied as an affirmative defense without any burden to negate confusion, the Sixth Circuit’s fair use test, including nominative fair use, has been analyzed according to that approach. *See ETW Corp.*, 332 F.3d at 920-21.

Before *KP Permanent* was decided, the Ninth and Fifth Circuits determined that nominative fair use should not be applied as an affirmative defense. *See generally New Kids*, 971 F.2d at 302; *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546-47 (5th Cir. 1998). In the Ninth Circuit, the court replaced the likelihood

of confusion test with a three-prong nominative fair use test, *New Kids*, 971 F.2d at 308, and in the Fifth Circuit the court added the Ninth's Circuits three-prong test to the likelihood of confusion test. *Pebble Beach*, 155 F.3d at 546-47. However, neither of these courts revised their nominative fair use analyses after the *KP Permanent* decision. See generally *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175-75 (9th Cir. 2010) (applying the same three-prong nominative fair use test); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 488-89 (5th Cir. 2008) (applying the three-prong nominative fair use analysis in addition to a separate likelihood of confusion analysis as the owner's burden).

Likelihood of confusion does not necessarily negate fair use. This Court concluded that fair use could coexist with some confusion. See *KP Permanent*, 543 U.S. at 123. Thus, all fair use analyses, including nominative fair use, are to consider confusion; however, the determination of confusion should not always prevent application of the fair use exception. See *id.*; *Century 21*, 425 F.3d at 222-23 (holding that the possibility of confusion does not exclude nominative fair use). Based on this Court's precedent, a likelihood of confusion test is necessary to determine if there is confusion, but the use can still be deemed fair so long as the user can successfully raise the nominative fair use affirmative defense. See *KP Permanent*, 543 U.S. at 123.

Moreover, an affirmative defense is the most appropriate way to analyze nominative fair use because the defense may not even need to be analyzed. If a

trademark owner is not able to meet his burden to prove confusion, then there is no need to analyze any nominative fair use test. *See id.* In that case, the user's utilization of the owner's mark is not infringement, however, it is also not fair use. By allowing the nominative fair use analysis to be raised with the likelihood of confusion test would allow a user to be charged with infringement when the user does not pass the nominative fair use test even when *no* likelihood of confusion is found. This is a clear violation of the Lanham Act. 15 U.S.C. § 1114(1). This is because trademark law allows the use of another's trademark in a case where the use does not cause confusion. *Id.* There are exceptions to that rule, such as fair use exceptions, which still allows use despite confusion. Lanham Act, 15 U.S.C. § 1115(b)(4). Therefore, nominative fair use is not to be raised *with* a likelihood of confusion test, and is to be raised as a defense in the event that confusion is found. *See generally KP Permanent*, 543 U.S. at 124.

3. Classic and nominative fair use both allow users to describe their own products through the utilization of another's mark, and therefore, both exceptions are subject to an affirmative defense test, which best serves the purpose of trademark law.

Nominative and classic fair uses both allow a user to utilize another's trademark to describe their own product. In classic fair use a user may utilize another's trademark to refer to the user's own product in order to describe the product. *See New Kids*, 971 F.2d at 308. Analogously, nominative fair use allows a user to utilize another's trademark to reference the trademark owner's product as a way to describe the user's own product. *See id.* at 306. Nominative fair use

recognizes that in some instances there is only one way to refer to a product, by its trademark. *Id.* (highlighting that some trademarks have alternative identifiable names, such as “tissue” instead of “Kleenex,” but other trademarks do not have any other easily identifiable generic name, such as “Chicago Bulls”).

Both doctrines serve the same purpose because they each allow a user to describe his own product through the utilization of another’s trademark. *See Century 21*, 425 F.3d at 221-231. Accordingly, since both these fair use doctrines create parallel exceptions then they should have parallel tests. Thus, since this Court has determined that fair use is to be applied as an affirmative defense, the affirmative defense also applies to nominative fair use. *See KP Permanent*, 543 U.S. at 121-22; *Century 21*, 425 F.3d at 221-23.

Affirmative fair use defenses protect the public from monopoly in the sale of any goods other than those produced by the owner himself. *See Canal Co. v. Clark*, 80 U.S. 311, 323 (1871) (“No one can claim protection of the exclusive use of a trademark or tradename which would practically give him monopoly in the sale of any goods.”). Allowing users to raise an affirmative fair use will protect consumers from monopoly on use of a term simply by registering it first. *Id.* The Lanham Act’s language does not indicate that the statute was meant to deprive commercial speakers of the ordinary utility of descriptive words. *KP Permanent*, 543 U.S. at 122; *see also Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997) (“If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well known

descriptive phrase.”). Thus, as consistent with the Lanham Act and the purpose of trademark law, this Court should recognize the nominative fair use affirmative defense.

In this case, the United States District Court for the Central District of Bel Air correctly applied the past precedent by applying nominative fair use as an affirmative defense. The District Court looked to this Court’s opinion in *KP Permanent*, where the Court determined that the user has no burden to negate the likelihood of confusion. Further, the District Court applied an analysis similar to the Third Circuit’s analysis when the court maintained the plaintiff’s burden to show likelihood of confusion and applied the nominative fair use affirmative defense. *See Gardashyan*, 1135 F.3d at 358. Thus, the Court of Appeals for the Fourteenth Circuit erroneously concluded that Pattel was “taking a second bite of the apple.” *See id.* at 361.

Further, by allowing only Gardashyan to utilize the mark, the Court of Appeals for the Fourteenth Circuit effectively provided Gardashyan with a monopoly in the mark. *See Gardashyan*, 1135 F.3d at 363-65. Such a decision is contradictory to the premise of trademark law, which is only meant to prevent consumer confusion and is used as a means to prevent unfair competition. *See Lanham Act*, 15 U.S.C. § 1114(1). The Fourteenth Circuit went beyond and contrary to that purpose. *See generally Gardashyan*, 1135 F.3d at 363-65.

II. The District Court correctly adopted and applied the Ninth Circuit’s nominative fair use test as an affirmative defense when the court held that Pattel’s use of the Gardashyan mark was a nominative fair use.

The Ninth Circuit’s nominative fair use test should be applied as an affirmative defense to determine whether the use of a mark is a nominative fair use. As an affirmative defense, this three-prong test requires the user to show first, “the product or service in question must be one not readily identifiable with use of the trademark.” *New Kids*, 971 F.2d at 308. Second, the test goes on to require that “only so much of the mark or marks may be used as is reasonably necessary to identify the product or service,” and third “the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.” *Id.*

It was necessary for Pattel to use the mark because Gardashyan, who is not readily indefinable without the use of the mark, cannot be referenced with an alternative word. Pattel also depended on referencing Gardashyan, who is a fashionista, through the use of her mark to describe the Fashionista Bambi doll. Further, Pattel did nothing to suggest sponsorship and even included a disclaimer on the box stating that there is no affiliation or endorsement by Gardashyan.

A. The Ninth Circuit’s nominative fair use test, as an affirmative defense, is analogous to the Lanham Act’s fair use requirements.

When applied as a nominative fair use affirmative defense, the Ninth Circuit’s three-prong test is parallel to the Lanham Act’s fair use requirements. *Compare* Lanham Act, 15 U.S.C. § 1115(b)(4) (setting the requirements for fair use defenses), *with New Kids*, 971 F.2d at 308 (setting the requirements for nominative

fair use).

The language of the Ninth Circuit's nominative fair use test is more similar to the language of the Lanham Act. The Lanham Act requires the user to address his own use of the owner's mark. *See* 15 U.S.C. § 1115(b)(4). This is mirrored in the Ninth Circuit's test. The Ninth Circuit test requires the user to demonstrate that "the product or service in question must be one not readily identifiable without use of the trademark." *New Kids*, 971 F.2d at 308. Additionally, the user has the burden of showing that "only so much of the mark [. . .] [is] used as is reasonably necessary to identify the product or service," and "the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement, by the trademark holder." *Id.* This language is similar to the Lanham Act because it requires the user to qualify his own use of the owner's mark. Whereas, the Third Circuit's test requires the user to address the use in terms of how it describes his own product *as well as* how it refers to the owner's product. *See Century 21*, 425 F.3d at 222.

Additionally, neither the Lanham Act nor the Ninth Circuit's affirmative defense test considers whether or not the user could have achieved the same result without using the owner's mark. *See generally* Lanham Act, § 1114(b)(4); *New Kids*, 971 F.2d at 306. The only question that fair use analyzes is whether or not the use of the mark causes confusion and if so, whether the use is fair. *See generally KP Permanent*, 543 U.S. 111. However, the Third Circuit's test requires the user to begin a conversation about whether or not they could have reached the same result

without using the owner's mark. *See Century 21*, 425 F.3d at 222 (requiring that "the use of plaintiff's mark is *necessary* to describe both the plaintiff's product or service and the defendant's product or service") (emphasis added). The Ninth Circuit test, on the other hand, similar to the Lanham Act factors, does not require that the use of the mark was necessarily the only way to describe the product. *New Kids*, 971 F.2d at 306. If the owner cannot meet the burden of showing a likelihood of confusion with the *Polaroid* test then there is no infringement. Moreover, the Ninth Circuit does not reconsider infringement based on whether the user could have used something other than the owner's mark. Lanham Act, 15 U.S.C. § 1114(1). The Ninth Circuit test follows this closer than the Third Circuit nominative fair use test.

Further, the Ninth Circuit's test, as an affirmative defense, supports the purpose of nominative fair use to allow a user to utilize another's mark. The Ninth Circuit specifically raised this point when they coined nominative fair use and provided example of why nominative fair use is an exception. *See New Kids*, 971 F.2d at 306. The Court provided the following example, "one might refer to 'the two-time world champions' or 'the professional basketball team from Chicago,' but it's far simpler (and more likely to be understood) to refer to the Chicago Bulls." *See id.* Meaning, although there may be another way to accurately reference the owner's product, it may not be the most simple or effective reference for the user's descriptive purpose. *See id.*

Moreover, the Third Circuit's affirmative defense test exceeds to Lanham Act

requirements. The Third Circuit requires the user to only use the mark if it is “*necessary* to describe the both the plaintiffs product . . . and the defendant’s product.” *See Century 21*, 425 F.3d at 222 (emphasis added). The Third Circuit also requires that the user “only use so much of the plaintiff’s mark as is *necessary* to describe plaintiff’s product.” *Id.* (emphasis added). Last, that the user’s “conduct reflects the *true and accurate* relationship” between the user and the owner’s products. *Id.* (emphasis added).

These three requirements far exceed the requirements set in the Lanham Act. *See* 15 U.S.C. § 1115(b)(4). The Lanham Act does not require the user to only use the mark if it is necessary; instead, it only requires that the use of the mark be used descriptively, fairly, and in good faith. *Id.* Even the Fourteenth Circuit Court of Appeals recognized this when the court said “It is important to note that, when analyzing this factor, the courts do not need to find that the mark is ‘indispensable’ in order to find the factor satisfied.” *Gardashyan*, 1135 F.3d at 364. However, if a use is “necessary” then it is necessarily “indispensable” and therefore even the Fourteenth Circuit recognizes that its own test exceeds the Lanham Act’s burden. *See id.* Further, the Lanham Act does not require that the user must affirmatively disclose the “true and accurate relationship” between the parties. *See* Lanham Act, 15 U.S.C. § 1115(b)(4). The Act only requires that the user does not use the mark in a such a way to falsely suggest a relationship between the parties. *Id.* Thus, the Circuit Court of Appeals for the Fourteenth Circuit erred when it determined that the Third Circuit’s nominative fair use test was a better test because the court

wanted to “rais[e] the bar” for nominative fair use claims. *See Gardashyan*, 1135 F.3d at 364.

B. Pattel’s use of the mark is a nominative fair use because the reference to Gardashyan is not readily identifiable without use of the mark, Pattel did not use the entire trademark logo, and the use did not suggest sponsorship or endorsement.

It is often nearly impossible to refer to a particular product for purposes of comparison, criticism, point of reference, or any other such purpose without using the mark. *New Kids*, 971 F.2d at 306. The court reasoned that this type of use of the mark “does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.” *Id.* at 308. The court further reasoned that “because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition” and thus is a fair use because it does not suggest sponsorship or endorsement by the owner. *Id.* at 308.

If *Gardashyan* fails to meet her burden of proof for likelihood of confusion, the nominative fair use test does not have to be considered because the use does not constitute trademark infringement. However, in the event that *Gardashyan* is able to meet the burden, the case has to be analyzed through the application of the three-prong nominative fair use test. *Cammy Gardashian* is the “product” and her personal name is the mark. *Gardashyan*, 1135 F.3d at 356. Pattel’s product is the Fashionista Bambi doll that says: “I want to be a fashionista just like Cammy Gardashyan.” *Id.* at 357. Pattel used *Gardashyan*’s name to reference *Gardashyan* as a fashionista, although Pattel’s goal was to describe its own Fashionista Bambi

doll. Since Pattel used Gardashyan's mark to reference Gardashyan, the nominative fair use analysis, instead of the classic fair use analysis, applies.

Gardashyan is not readily identifiable without the use of her mark, which is her personal name. The first element of the nominative fair use test is that the product must be one not readily identifiable without use of the trademark. *New Kids*, 971 F.2d at 308. The Ninth Circuit reasoned that "one might refer to the 'two time world champions' or 'the professional basketball team from Chicago', but it's [sic] far simpler and more likely to be understood to refer to the Chicago Bulls." *Id.* at 306. In the present case, the doll could say: "I want to be a fashionista like the reality television star with a curvy figure who wears animal print and high heels." *See Gardashyan*, 1135 F.3d at 356. But it is simpler and more likely to be understood for the doll to say: "I want to be a fashionista like Cammy Gardashyan" since there are other celebrities who are not fashionistas who dress and look similar to Gardashyan. Using Gardashyan's mark allows the consumer to understand whom the doll is referencing.

The trademark "Cammy Gardashyan" is a personal name and therefore, there is no substitute that can readily identify Gardashyan the product. The Ninth Circuit has consistently held that the name of a brand can be used to describe a user's product. *See generally New Kids*, 971 F.2d at 306; *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969). The court held that when the only simple way to refer to the owner's product is by use of the mark then the use of the mark is a fair use. *New Kids*, 971 F.2d at 306. For example, the only

way to describe the band New Kids on the Block is to use the name of the band even though “New Kids on the Block” is a trademarked name. *Id.* Here, the *only* way to refer to Gardashyan is by the use of her personal name, even though her name is a trademark because there is no substitute term.

Pattel used the mark in a reasonably necessary manner as to reference Gardashyan. The second element is that only so much of the mark may be used as is reasonably necessary to identify the product or service. *New Kids*, 971 F.2d at 308. In *Volkswagenwerk*, the court held that the owner could not prevent the user, an automobile repair shop, from using the mark because it would be difficult, if not impossible, to avoid altogether the word “Volkswagen” or “VW.” *Volkswagenwerk*, 411 F.2d at 352. Further, the court reasoned that the user did not use Volkswagen’s distinctive lettering style or color scheme, nor did the user display the encircled “VW” emblem. Similarly, Pattel did not use the stylized “CG” displayed back to back that consists the Gardashyan’s mark. *Id.* Although Pattel did use standard block typeface when referring to Cammy Gardashyan in the box, the name was in the same size and font as the rest of the caption. *Gardashyan*, 1135 F.3d at 357; *see Volkswagenwerk*, 411 F.2d at 352 (reasoning that it is appropriate to weigh all of the pertinent factors, size, style, and appearance of the advertising when analyzing nominative fair use). Pattel did not use the full logo on Gardashyan’s mark, nor did it make the name Cammy Gardashyan stand out or be distinct from the rest of the message.

Pattel's description of the Fashionista Bambi doll depends on the use of the Gardashyan mark. The court in *Cairns* stated that if the description of the user's product depends on the reference of the owner's product, more use of the owner's mark is "reasonably necessary to identify the owner's product" than in cases where the description of the user's product does *not* depend on the reference of the owner's product. *See Cairns*, 292 F.3d at 1154 (reasoning that user's customers would have a hard time recognizing the doll is Princess Diana without use of the mark, and therefore the use was reasonably necessary for that purpose).

Pattel's Fashionista Bambi doll is not Gardashyan, but instead it is a doll that wants to be a "fashionista" *like* Gardashyan. Pattel needs to reference Gardashyan to describe a "fashionista." Pattel depends on the use of the Gardashyan mark to provide context to its customers so they can understand and interpret what a "fashionista" is. Pattel has customers of all ages, including very young and old consumers because the dolls are toys as well as valuable collectibles, therefore it cannot be expected that all of Pattel's customers would immediately recognize what a "fashionista" is. *Gardashyan*, 1135 F.3d at 355. Thus, the use of Gardashyan's mark to describe Pattel's Fashionista Bambi doll was reasonably necessary.

Pattel does not suggest sponsorship or endorsement by Gardashyan, and even disclaims that there is no sponsorship or affiliation. The third and final element of the nominative fair use test is that "the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the

owner.” *New Kids*, 971 F.2d at 308. Pattel’s packaging for the Fashionista Bambi doll does not claim that the product is sponsored or endorsed by Gardashyan. *See Gardashyan*, 1135 F.3d at 357. Pattel goes even further to add a disclaimer that Pattel and the Fashionista Bambi doll are not endorsed by or affiliated with Gardashyan. *Id. See Playboy*, 279 F.3d at 799 (reasoning that the user met this factor because, in addition to doing nothing in conjunction with use of the mark to suggest sponsorship or endorsement, the user included a statement disclaiming any connection to the holder of the mark).

While the plaintiff still has to meet his burden of proving a likelihood of confusion, even if there is a presence of somewhat likelihood of confusion, Pattel’s use of the Gardashyan mark is nominative fair use. Pattel used the trademark Cammy Gardashyan to refer to Gardashyan the fashionista, to describe its own Fashionista Bambi doll. Because Pattel needed to refer to Gardashyan’s name to describe its own product, a nominative fair use analysis is correct. Pattel had to use the Gardashyan mark because Gardashyan is not readily identifiable without use of her mark, nor is there an alternative term by which to reference her. Additionally, Pattel did not use the entire mark, and only used so much of the mark to provide context to its customers. Further, Pattel included a disclaimer on the box clarifying Gardashyan did not endorse and was not affiliated with the doll or the company. Therefore, Pattel satisfies all the factors to properly raise and prevail on the nominative fair use affirmative defense.

CONCLUSION

For the foregoing reasons, we respectfully request this Court to reverse the Fourteenth Circuit Court of Appeals decision and instead adopt the Ninth Circuit's three-prong test as an additional and separate nominative fair use affirmative defense when a user is referring to an owner's product to ultimately describe its own product as consistent with the Lanham Act and this Court's precedent.

Respectfully Submitted,

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CERTIFICATE OF COMPLIANCE

This brief complies with the Rules for the Seventeenth National Entertainment Law Moot Court Competition. This brief contains 8,727 words, excluding the Question Presented, Table of Contents, Table of Authorities, Opinion Below, Statement of Jurisdiction, and Relevant Provisions involved.

This brief complies with the typeface requirements of Rule 3.