

No. 16-1225

**In the Supreme Court of the
United States**

November Term, 2016

Pattel, Inc.,

Petitioner,

v.

Cammy Gardashyan,

Respondent.

**On Writ of Certiorari to the
United States Court of Appeals
for the Fourteenth Circuit**

BRIEF FOR THE RESPONDENT

Counsel for Respondent

QUESTION PRESENTED

- I. Should this Court adopt a nominative fair use test, considering that this Court and multiple circuit courts have repeatedly acknowledged the concept, and if this Court chooses to do so, should it be applied as an affirmative defense, despite this Court's holding in *KP Permanent Make-up v. Lasting Impressions, Inc.*, or applied as an additional part of the likelihood of confusion analysis?

- II. Which articulation of the Nominative Fair Use test would be the most appropriate considering the goal of the nominative fair use analysis, and what result would such an articulation yield when applied to Pattel's infringement on Gardashyan's trademark?

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CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Trademark Act of 1946, known for its inclusion of the Lanham Act, 15 U.S.C. § 1051 et seq., allows a trademark holder the opportunity to register its mark with the U.S. Patent and Trademark Office.

15 U.S.C. § 1114 allows for a trademark infringement suit to be brought when another has used a trademark without prior authorization.

15 U.S.C.S. § 1115(b) provides in relevant part: “the registration shall be conclusive 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.”

STATEMENT OF JURISDICTION

The United States District Court for the Central District of Bel Air granted summary judgment in favor of Pattel, Inc., to which Gardashyan filed a timely appeal. The United States Court of Appeals for the Fourteenth Circuit reversed and remanded the order of the district court on June 5, 2016. The opinion of the circuit court is reported at 1135 F.3d 759. This Court granted Pattel, Inc.'s timely petition for writ of certiorari and has jurisdiction under 28 U.S.C. §1254(1)

STATEMENT OF THE CASE

Imagine a scenario where you have created a brand. You have worked tirelessly, worked diligently, and worked intelligently to create this brand. You have put hundreds of thousands, if not millions of dollars into developing this brand and making into one that is recognized nationwide. In fact, imagine that this brand you have created could be recognized by name in practically every household in this country.

Now imagine that one day, you see a company use your brand on a new product they made. They used your name, your likeness, and even had an audio recording in the product that stated your name. This company went on to make \$45 million dollars off your trademarked brand. And even worse, you had no idea they were going to do this. They did not contact you. They did not try to work out any contractual agreement. They simply thought you were famous and marketable so they decided to exploit your brand. This would seem perfectly fair, right?

Completely in line with this hypothetical story, socialite Cammy Gardashyan has truly made her presence known to the world. *Cammy Gardashyan v. Pattel, Inc.*, 1135 F. 3d 759, 356 (14th Cir. 2016). Cammy built her career through reality television, social media, a variety of businesses, modeling, and singing. *Id.* at 356. Millions of fans follow her endeavors and watch her life unfold on their screens. *Id.*

Her fame has also led her status as a fashion icon. *Id.* Her signature style includes animal print, knee length skirts or dresses, and shiny high-heeled shoes. She is also known for her long black hair and “curvy” figure. *Id.*

People of all ages recognize Gardashyan and know her name, making her fan base eclectic in age and background. *Id.* Her multi-million dollar business ventures cover a variety of products including: clothing, jewelry, perfume, cosmetics, handbags, and footwear. *Id.* Her trademark consists of a stylized “CG” displayed back to back and her name in standard, blocked font using capital letters. *Id.* Gardashyan uses her mark to inform her loyal customers of her products as well as protect the successful brand that she has worked tirelessly to build. *Id.*

Pattel, Inc. is a toy manufacturing company located in Nautilus, Bel Air. *Id.* at 355. Of particular relevance to this case, Pattel manufactures Bambi dolls, which are often inspired by modern day celebrities. *Id.* at 356. After observing Gardashyan’s continuously rising fame, Pattel chose Gardashyan for its newest doll’s look. *Id.*

The doll mimicked Gardashyan’s signature style and long, black hair. *Id.* at 357. Additionally, the doll’s voice feature repeated the phrase: “I want to be a fashionista, just like Cammy Gardashyan.” *Id.* at 357. The doll’s packaging allowed customers to view inside without opening the box, and the box’s cover displayed a caption bubble in twenty point font that stated: “ I say: I want to be just like Cammy Gardashyan.” *Id.*

The doll's package used Gardashyan's entire name, which makes up the majority of her trademark, and her name was written in her mark's same standard, black block lettering. *Id.* On the reverse lower corner of the box, Pattel, Inc. placed a disclaimer in small font that stated: "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan." *Id.* Gardashyan did not authorize Pattel, Inc. to use her mark on the doll's package. *Id.* Within a year of releasing the doll worldwide, Pattel, Inc. grossed forty-five million dollars as a result of the thirty-five million Gardashyan inspired Fashionista Bambi dolls. *Id.*

Gardashyan commenced the underlying action on February 9, 2015 based on a claim of trademark infringement for Pattel's use of "Cammy Gardashyan" and sought a permanent injunction *Id.* Pattel responded by asserting the nominative fair use defense and arguing Gardashyan's claims should be dismissed because its was justified under the defense. *Id.* The District Court for the Central District of Bel Air chose to adopt the nominative fair use language used by the Ninth Circuit Court of Appeals. *Id.* at 358. The court held that nominative fair use acted as an affirmative defense and permitted Pattel's use of the mark, regardless of a finding of likelihood of confusion. *Id.* Gardashyan timely filed an appeal. *Id.* The Fourteenth Circuit Court of Appeals reversed the district court's decision on both counts and held that nominative fair use did not function as an affirmative defense and adopted different language for the analysis. *Id.* This Court granted Pattel's petition for writ of certiorari. *Id.*

SUMMARY OF THE ARGUMENT

Courts in this country have allowed for a few, small exceptions that would allow a party to fairly use another party's trademark without permission. This type of use has been frequently referred to as "fair use" doctrines. However, the court below made clear that the law identifies two types of fair use: classic fair use and nominative fair use. Further, the court below established that the current case deserves the treatment of nominative fair use as opposed to classic fair use. This Court has not recognized nominative fair use but should recognize it in this case as a doctrine that furthers the goals of trademark infringement law.

Courts that have dealt with nominative fair use in the past have had to decide whether to view it as part of the "likelihood of confusion" analysis or as an affirmative defense. This Court, along with a multitude of circuit courts, has held that because a "likelihood of confusion" is the primary indicator of infringement, the nominative fair use test should be adopted as a supplement to the likelihood of confusion analysis. Further, the circuits in this country that have dealt with the issue, have almost unanimously held that viewing nominative fair use as an affirmative defense would run counter to the purpose of the fair use. However, after this Court decides whether or not to adopt a nominative fair use test as part of the likelihood of confusion and not as an affirmative defense, it must then decide which articulation of the nominative fair use to adopt.

The circuits have used a variety of articulations for the nominative fair use test. The Court below held that the Third Circuit's articulation provides the most

in-depth and thorough look at nominative fair use. We agree. It is our contention that the Third Circuit's articulation provides the most appropriate way to view nominative fair use, giving both the plaintiff and defendant chances to prove their case.

When applied to the current case, Gardashyan will be able to clearly show that Pattel's use of her trademark was not nominative fair use. The use of the her trademark on Pattel's product would clearly breed confusion amongst consumers and runs contrary to the examples of acceptable uses detailed in our courts. This Court should adopt the Third Circuit's articulation of nominative fair use and view it through as part of the likelihood of confusion analysis. Doing this would provide this Court with the most fair way to adjudicate these types of trademark infringement cases. Our country thrives on the ability to create a product and be rewarded for its success in the economy. Gardashyan worked tirelessly to create her brand and deserves the protection that our trademark system can provide.

ARGUMENT

I. Standard of Review

This Court reviews decisions on questions of law de novo. *Highmark Inc. v. Allcare Health Mgmt Sys., Inc.*, 134 S. Ct 1744, 1748 (2014).

II. This Court Should Formally Adopt Nominative Fair Use to Provide Finality Concerning the Concept's Place in Trademark Law and Clarity for Its Appropriate Application.

Regardless of whether consumers are consciously aware, trademarks can impact their decision-making process and ultimate choice in product. Often, when people see a name or mark that they recognize and trust, no further examination into the product is done. See Michael B. Weitman, *Fair Use in Trademark in the Post-KP Permanent World*, 71 Brook. L. Rev. 1665, 1666 (2006). Because trademarks can play such a key role with consumers, the unauthorized use of another's mark should only be allowed in very limited circumstances. Therefore, clear trademark regulation is vital to providing the necessary guidance for the limited circumstances in which unauthorized use is permissible.

While this Court should adopt a nominative fair use analysis, the analysis should supplement the likelihood of confusion test used in traditional trademark infringement cases and not be applied as an affirmative defense. Pattel, Inc.'s unauthorized use of Cammy Gardashyan's trademark is ultimately underserving of the legal conclusion of nominative fair use and should be held as impermissibly infringing upon Gardashyan's rights. In order to best understand the importance

and intricacies of the matter before the Court today, it is advantageous to place the issues in context.

The Trademark Act of 1946, known for its inclusion of the Lanham Act, 15 U.S.C. § 1051 et seq., allows a trademark holder the opportunity to register its mark with the U.S. Patent and Trademark Office. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004). Upon the completion of several requirements, the right to use the registered mark is incontestable, excluding certain exceptions. *Id.* The very purpose of a trademark is to provide the holder with protection, through a means of uniquely identifying its product, in order to limit consumer confusion. William Spieler, *Nominative Fair Use in Trademark Law: A Fair Use Like No Other*, 89 J. Pat. & Trademark Off. Soc'y 780, 780 (2007).

The Lanham Act also provides the holder the authority to bring a trademark infringement suit under 15 U.S.C. § 1114 when another has used its mark without prior authorization. *KP Permanent Make-Up, Inc.*, 543 U.S. at 117. While the registration of the mark is conclusive evidence of the holder's exclusive right to use the mark in commerce¹, the success of the infringement suit depends on whether the holder can prove, by a preponderance of the evidence, that the alleged infringing use is likely to cause confusion, cause mistake, or to deceive. *Fortune Dynamic, Inc. v. Victoria Secret Stores Brand Mgmt., Inc.* 618 F.3d 1025, 1030 (9th Cir. 2010) (quoting 15 U.S.C. § 1114(1)(a)). Courts employ a likelihood of confusion analysis, which is relevant in all trademark infringement suits, in order to make this

¹ 15 U.S.C.S. § 1115(b).

determination.² *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 214 (3d Cir. 2005).

The modern view of likelihood of confusion goes beyond solely examining consumer confusion as to the product's source. *Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 161 (2d Cir. 2016). Congress amended § 1114 specifically to broaden the liability for infringement beyond just confusion of origin.³ *Id.* Therefore, the court now also considers whether the alleged infringing use is likely to cause an appreciable number of ordinarily prudent purchasers confusion as to sponsorship, affiliation, or connection. 4 *McCarthy on Trademarks and Unfair Competition* § 23:76 (4th ed.). See also *Int'l Info. Sys.*, 823 F.3d at 161. Thus, the trademark holder need only prove that the customer believed that the mark holder approved of the use.⁴ *Int'l Info. Sys.*, 823 F.3d at 162.

However, in certain limited circumstances, the law permits the unauthorized “fair use” of another’s trademark and holds that such use does not infringe on the holder’s rights. *Century 21*, 425 F.3d at 217. The purpose for allowing fair use is to ensure that a trademark holder does not reserve a descriptive term for its exclusive use, thus depriving others of the ability to accurately describing their own good. *New Kids On The Block v. News Am. Pub’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

² “The ‘core element’ of trademark infringement law is ‘whether an alleged trademark infringer’s use of a mark creates a likelihood that the consuming public will be confused’...” *Brother Records, Inc. v. Alan Jardine*, 318 F.3d 900, 908 (3d Cir. 2003).

³ See also *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 136 (2d Cir. 2009).

⁴ See also *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 114 (2d. Cir. 2009).

Therefore, fair use applies when an alleged infringer does not claim the trademark as its own, like in a traditional infringement suit, but simply used the mark in a way that may confuse the public. *Century 21*, 425 F.3d at 217.

Courts have identified two distinct types of fair use: classic, also referred to as descriptive fair use, and nominative. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2003). Classic fair use is a concept created by the Legislature and approved by this Court. *Century 21*, 425 F.3d at 217. In contrast, nominative fair use is a judicially created concept that this Court, as well as several circuit courts, has acknowledged but not yet explicitly adopted. Moreover, the circuits that have formally adopted nominative fair use have expressed differing treatments and articulations of the analysis. *Id.* Therefore, this Court's decisive word is needed to bring uniformity concerning nominative fair use.

A. This Court Should Adopt a Nominative Fair Use Test to Officially Recognize and Solidify the Circumstantial and Conceptual Distinctions from that of Classic Fair Use.

While classic and nominative fair use share certain similarities, the two arise under notably different circumstances. The key distinction lies in whose product the alleged infringing mark is referring. *Spieler*, *supra*, at 781. This difference is important because whether the mark is being used descriptively or for identification purposes mandates a *somewhat* unique analysis and confusion hurdle in order to determine the "fairness" of the unauthorized use. *KP Permanent*, 328 F.3d 1061, 1072 (9th Cir. 2003) *rev'd on other grounds*, 543 U.S. 111 (2004). Two distinct classifications with accompanying analyses would allow for a more specific and

thorough evaluation in trademark infringement cases. Moreover, it would further the goal of trademark law by offering better protection to trademark holders and, when appropriate, to third party users.

Classic fair use, established in the Lanham Act, only applies in cases where the mark used has a primary, descriptive meaning in addition to the secondary, trademark meaning. *Brother Records, Inc. v. Alan Jardine*, 318 F.3d 900, 905 (3d Cir. 2003). Therefore, classic fair use arises when the defendant has utilized the plaintiff's mark to describe his own product but for its primary meaning, as opposed to its trademark meaning. *Adobe Sys., Inc. v. Christenson* 809 F.3d 1071, 1081 (9th Cir. 2015). When an alleged infringer uses the mark in this descriptive way, no infringement exists. *New Kids*, 971 F.2d at 306.

Prior to *New Kids*, courts did not yet routinely differentiate between classic fair use and what is now known as nominative fair use. *New Kids*, 971 F.2d 302 (9th Cir. 1992). However, this changed when the Ninth Circuit coined the term “nominative fair use” in its *New Kids* decision. *Id.* Nominative fair use *potentially* arises when the defendant has used the plaintiff's mark to identify the trademark holder's product and not its own. *Int'l Info. Sys.*, 823 F.3d at 165. Therefore, the user did not utilize the trademark for its descriptive meaning but rather for its secondary, identifying meaning. *Id.*

When used properly, it is possible for the defendant's utilization of the holder's mark, in reference to the holder's own product, not to frustrate the identification purpose of trademarks. *Spieler, supra*, at 784. However, when the

defendant has used the mark in a way that is confusing to the consumer, the use becomes infringing. *Id.* Where the use of the mark implies or allows the belief of a relationship where none actually exists, the user has impermissibly capitalized off of the hard work and reputation of the trademark holder. *Id.* at 785. Thus, cases in which nominative fair use possibly applies are especially concerned with determining the potential of consumer confusion as to endorsement or affiliation. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010).

When two concepts arise under dissimilar circumstances, logic instructs separate terminology and tests; such treatment would be not only logistically sound but also would also provide courts with a more exact way to communicate and render a fair use analysis.

Moreover, this Court alluded to the concept of nominative fair use decades prior to *New Kids*.⁵ See *Saxlehner v. Wagner*, 216 U.S. 375 (1910). In *Prestonettes, Inc. v. Coty*, this Court stated that a trademark owner has no right to prohibit a defendant from making a collateral reference to the owner's mark. *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 369 (1924). Furthermore, in the decade immediately prior to *New Kids*, the Third Circuit referenced and utilized the nominative fair use concept directly referencing *Prestonettes* in its analysis. *G. D. Searle & Co. v. Hudson Pharm. Corp.*, 715 F.2d 837, 843 (3d. Cir. 1984). In *G.D. Searle*, plaintiff complained of defendant's reference to its product on defendant's competing product. *Id.* at 838. The court held that reference to plaintiff's product was allowed but only when the

⁵ See also *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 129 (1947).

reference would not cause confusion. *Id.* at 843. Therefore, this Court's adoption of nominative fair use, accompanied by an appropriate nominative analysis, would not only be consistent its own previous position but also with the view of numerous circuit courts.⁶

Likewise, the concept of nominative fair use is not controversial; no circuit court has blatantly rejected nominative fair use but instead has only ever postponed adoption for another day. See *Universal Commun. Sys. v. Lycos, Inc.*, 478 F.3d 413, 424 (1st Cir. 2007).

The theory of nominative fair use is not in its infancy; it merely awaited designation until the Ninth Circuit's opinion in *New Kids* and continues to wait for unanimous adoption within the judicial system. Should this Court chose to adopt a nominative fair use, the decision would not directly conflict with any circuit court's previous decision concerning adoption but instead would provide much needed guidance and a final stance on this issue.

B. This Court Should Supplement the Traditional Likelihood of Confusion Test with a Nominative Fair Use Analysis and Not Hold Nominative Fair Use as an Affirmative Defense.

Should the Court elect to formally adopt a nominative fair use test, a subsequent, and arguably more important, issue arises as to its placement. Of the circuits that have adopted a nominative fair use analysis, two approaches have emerged: (1) applying the nominative fair use test on the plaintiff's side of the equation or (2) applying the test on the defendant's side, as an affirmative defense.

⁶ See *SSP Agriculture, Etc. v. Orchard-Rite Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979)(quoting *Smith v. Chanel, Inc.*, 402 F.2d 562, 563 (9th Cir. 1968).

Spieler, *supra*, at 783. However, the only appropriate place for the nominative analysis is alongside the likelihood of confusion analysis, on the plaintiff's side of the equation. This placement is not only consistent with the language of the Lanham Act, this Court's previous opinion, and the view of several circuit courts but also is rationally superior. Therefore, this Court should adopt the nominative fair use analysis as an additional set of confusion considerations, which can potentially, if no confusion is established, lead to a conclusion of nominative fair use.

1. Designating Nominative Fair Use as an Affirmative Defense is Inconsistent with the Language of the Lanham Act and Previous Holding of this Court.

The Lanham Act not only provides trademark holders a cause of action for a trademark infringement but also explicitly postulates affirmative defenses for third-party users. *Int'l Info. Sys.*, 823 F.3d at 167. One of the defenses given describes a classic fair use scenario. *Id.* However, Congress noticeably left out the type of situation that would be classified as nominative fair use. *Id.*

While some might argue that the reason for Congress's exclusion of a nominative scenario is due to such situations not yet occurring, any such argument is futile. Nominative fair use was not a foreign concept at the time Congress drafted the Lanham Act. This Court described what would now be labeled as nominative fair use in *Prestonettes*, which was decided decades before prior to the Act. See *Prestonettes, Inc.*, 264 U.S. 359 (1924). It is well settled that Congress is presumed to act intentionally in both the words that it includes and excludes. *KP Permanent Make-Up, Inc.*, 543 U.S. at 118. Therefore, had Congress intended for what we now

know as nominative fair use to be an affirmative defense, Congress would have included such a scenario. It is not the job of the court to expand the language of a statute but instead to give exact effect to Congressional intent, using the language stated within the statute. *United States v. Am. Trucking Ass'ns*, 310 U.S. 534, 542-43 (1940).

In *KP Permanent Make-Up, Inc. v. Lasting Impression, Inc.*, this Court granted certiorari to determine a divisive class fair use issue. 543 U.S. 111 (2004). The Ninth Circuit previously stated that it was the defendant's burden to address and refute likelihood of confusion in order to successfully invoke the classic fair use affirmative defense. *Id.* at 115. However, this Court specified that the burden to prove likelihood of confusion rests solely with the plaintiff and identified two specific reasons for its holding. *Id.* First, Section 33 of the Lanham Act explicitly places the burden of proving infringement, which is established through the likelihood of confusion test, on the party alleging infringement. *Id.* at 118. Second, when the setting out the requirements for invoking the classic fair use defense, Congress made no requirement for the defendant to negate of the likelihood of confusion. *Id.* Therefore, this Court held that the Ninth Circuit had incorrectly shifted the burden upon the defendant. *Id.* at 123.

While *KP Permanent Make-Up* involved classic fair use rather than nominative, the analysis and holding is just as applicable in nominative fair use cases. By looking at the variations of the three nominative fair use factors, it becomes clear that they are merely more detailed inquiries into confusion. *Century*

21, 425 F.3d 211, 235 (3d Cir. 2005)(Fisher, J., dissenting). Thus, applying nominative fair use as an affirmative defense essentially places part of the burden of confusion squarely on the shoulders of the defendant, which directly contradicts this Court’s holding. *Id.* Therefore, it is simply improper to turn the nominative fair use inquiry into an affirmative defense. *Id.*

2. The Third Circuit Stands Alone in Treating Nominative Fair Use as an Affirmative Defense.

Examining the establishment and evolution of nominative fair use reveals treating nominative as an affirmative defense is misguided. When the Ninth Circuit created its three-part nominative analysis, the court labeled the analysis as a “defense” and expressly stated that it was to replace the traditional likelihood of confusion factors in nominative fair use cases. *New Kids*, 971 F.2d at 309. However, the Ninth Circuit later struggled with exactly how to apply its analysis, but with each decision, the court seemed to move closer to holding nominative fair use as an affirmative defense. J. David Mayberry, *Trademark Nominative Fair Use: Toward A Uniform Standard*, 102 Trademark Rep. 820, 820 (2012).

When the Ninth Circuit later encountered an unsettled classic fair use issue in *KP Permanent Make-Up*, this Court held that the plaintiff alone bears the burden to establish likelihood of confusion. 543 U.S. at 121. Despite not directly addressing nominative fair use, the *KP Permanent Make-Up* holding created uncertainty as to the validity of the Ninth’s Circuits treatment of nominative fair use as an affirmative defense. Mayberry, *supra*, at 820.

In *Century 21*, the first appellate case following *KP Permanent Make-Up* that involved nominative fair use, the court agreed with the Ninth Circuit's conclusion that nominative fair use needed a distinct analysis but disagreed with replacing likelihood of confusion factors altogether. *Century 21*, 425 F.3d at 220. Instead, the Third Circuit adopted a bifurcated analysis: a modified likelihood of confusion test for step one and reworded the Ninth's Circuit's three-part nominative analysis for step two. *Id.* at 222. The court explained that once the plaintiff established a prima facie case of likelihood of confusion, the burden then shifted to the defendant to show its use of the mark was nonetheless fair using the three part nominative analysis. *Id.* Thus, the Third Circuit applied the nominative analysis as an affirmative defense. Justice Fisher, in his dissenting opinion, detailed the many flaws in the court's affirmative defense treatment. *Id.* at 232. Therefore, the Third Circuit lacked unity even amongst itself concerning its nominative fair use treatment.

Conversely, the Ninth Circuit recognized the inconsistency of holding nominative fair use as an affirmative defense following this Court's decision in *KP Permanent Make-Up* and recanted its earlier leaning. *Toyota Motor Sales*, 610 F.3d at 1183. While the court maintained the nominative analysis as a replacement of the traditional likelihood of confusion factors, it stated that nominative fair use is an outcome of a plaintiff failing to carry its burden of establishing "likelihood of confusion." *Id.* This decision by the Ninth Circuit made the Third Circuit the lone court to hold nominative fair use as an affirmative defense. *Mayberry. supra*, at

833. Other circuit courts have since expressly declined to follow the Third Circuit's treatment of nominative fair use.⁷ *Int'l Info. Sys.*, 823 F.3d at 167. Therefore, the Third Circuit continues to stand alone.

3. The Application of Nominative Fair Use as an Affirmative Defense Produces Undesirable Results.

This Court stated that it is illogical to provide an affirmative defense that requires the defendant to show that the plaintiff cannot succeed in proving an element of its case; an affirmative defense is really only relevant once the plaintiff has been able to establish a prima facie case. *KP Permanent Make-Up*, 543 U.S. at 120. Applying a nominative fair use analysis as an affirmative defense essential does just that, requires the defendant to show that the plaintiff is unable to prove confusion after a plaintiff already has. Its application as an affirmative defense is simply illogical and places too great a burden on a defendant. "It simply defies logic to assert that a defense cannot be asserted in the only situation where it is even needed." *Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234, 243 (4th Cir. 1997).

Furthermore, treating nominative fair use as an affirmative defense creates a case that is judicially unmanageable. *Century 21*, 425 at 232 (Fisher, J., dissenting). The court would be required to look to essentially the same factors, or at the very least similar factors, when assessing both arguments. *Id.* Ultimately, this approach would lead to redundant litigation and a much slower judicial process, thus should be avoided. *Id.*

⁷ See J. David Mayberry, *Trademark Nominative Fair Use: Toward A Uniform Standard*, 102 Trademark Rep. 820, 840 (2012).

Congress's rationale behind holding classic fair use as an affirmative defense is sound; however, it does not extend to nominative fair use. *Spieler, supra*, at 786. In a classic fair use case, the mark is used for its descriptive meaning and not the secondary meaning associated with the holder's goods. *Id.* In choosing its mark, the holder accepted the risk of any confusion when it chose a mark that also possessed a descriptive meaning. *Id.* Therefore, as this Court noted, some level of confusion can co-exist in a classic fair use scenario. *KP Permanent Make-Up*, 543 U.S. at 121. However, this coexistence cannot occur in a nominative fair use situation, because the alleged infringer has used the mark specifically for its reference to the holder's goods. *Spieler, supra*, at 786. The mark in a nominative case ordinarily does not have a common, descriptive meaning apart from the holder's goods. *Id.* Because the use is more deliberate, the courts tolerating any level of confusion would be contrary to the very purpose of trademarks.

Nominative fair use as an affirmative defense essentially provides too broad a protection to an alleged infringer, while stripping the owner of its rightful protection. Therefore, nominative fair should instead be regarded as a legal conclusion reached only when the third party's use does not cause consumer confusion as to the relationship between the parties. *Spieler, supra*, at 786.

4. Combining Likelihood of Confusion and a Nominative Analysis is the Most Sensible Approach.

While nominative and classic fair uses are different enough to necessitate separate labels, they are not different enough to compel a total supplanting of the likelihood of confusion analysis. *Century 21*, 425 F.3d at 220. This Court's stated

that plaintiffs in *all* trademark infringement suits must show likelihood of confusion. *KP Permanent Make-Up*, 543 U.S. at 117. It is thus a fair inference that the traditional likelihood of confusion analysis is relevant to both classic and nominative fair use cases.

Moreover, using the traditional likelihood of confusion analysis in its entirety would provide a level of consistency between both types of fair uses. Courts have repeatedly stressed that the likelihood of confusion test is a totality of the circumstance analysis, with the factors most relevant to the particular case weighing the heaviest. *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 (5th Cir. 1998). Therefore, the traditional factors merely serve as a guide for the analytical process. *Id.* Adding a nominative analysis to the already accepted likelihood of confusion factors would provide the courts the greatest pool of considerations with which to begin its analysis. See *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 489 (5th Cir. 2008). Overall, this approach would help to avoid a lower standard of confusion and provide the as much uniformity as possible. Therefore, this Court should simply add the nominative fair use analysis to the complete likelihood of confusion test.

III. This Court Should Adopt a Strict Nominative Fair Use Test So That When Applied To Gardashyan’s Case, This Court Can Clearly See Pattel’s Trademark Infringement.

Trademark protection is an area of the law that should be treated with much care and concern. To further this, many of our circuit courts have held that the Nominative Fair Use test is necessary and useful when dealing with possible

trademark infringement.⁸ These circuits have established the necessity of that test with a few primary points. First, there must be a way to distinguish between instances of classic fair use and nominative fair use of a trademark. If this Court allowed a Nominative Fair Use test, that goal would be accomplished. Second, the Nominative Fair Use test should be part of the widely accepted confusion analysis, and not as an affirmative defense. *Int'l Info. Sys.*, 823 F.3d at 166. The necessity of the second reason is simple. This Court cannot allow the same issue to simply be re-litigated by the defendant once the plaintiff has already plead and proved the appropriate elements of confusion. However even when the Nominative Fair Use test is appropriately accepted as separate from classic fair use and not as an affirmative defense, this Court must still adopt an accurate and appropriate articulation of the test.

The Third Circuit articulation of the Nominative Fair Use test employs the most thorough inquiry into nominative fair use. In fact, other courts in this country currently employ the Third Circuit approach. *See Int'l Info. Sys.*, 823 F.3d at 168. These courts have reasoned that this approach provides parties with a more extensive, and more comprehensive way to answer the all-important question of, “was the defendant’s nominative use of the trademark fair or was it trademark infringement?” Further, the Third Circuit articulation provides an appropriate lense with which this Court should view the present facts. A lense that is much

⁸ *See Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153 (2d Cir. 2016); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010).

more appropriate than the way that courts have used the Ninth Circuit articulation. When Gardashyan's case is viewed in light of the Third Circuit analysis, as opposed to the Ninth Circuit analysis, we believe that the result is clear and that Pattel's use of Gardashyan's trademark was not nominative fair use.

A. The Third Circuit's Articulation of the Nominative Fair Use Factors Provides This Court with the Most Thorough and Complete Analysis.

In dealing with nominative fair use, circuits have taken different approaches in articulating the test. The two circuits in primary disagreement about the articulation of test are the Third Circuit and the Ninth Circuit. The Third Circuit articulates its version of the test in *Century 21*. *Century 21*, 425 F.3d 211 (3d Cir. 2005).

In *Century 21*, Century 21 and Coldwell Banker acquired several trademarks, which could be used to indicate their corporate presence in any given real estate transaction. *Id.* at 215. The dispute in the case arose when Lendingtree began using the reputable names of Century 21 and Coldwell Banker on their "For Sale" signs, their website, and on other advertising mediums. *Id.* The Third Circuit, in applying their articulation of the Nominative Fair Use test, ultimately remanded the case but in doing so, gave us insight into the application of the test. *Id.* at 222.

As the Third Circuit articulated, the test can be broken down into a three-pronged test using the following factors:

- (1) Is the use of the plaintiff's mark necessary to describe: (a) the plaintiff's product or service *and* (b) the defendant's product service?

- (2) Is only so much of the plaintiff's mark used as is *necessary* to describe plaintiff's products or services?
- (3) Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services? *Id.* at 228.

This articulation of the test serves to provide the courts with the clarity and completeness that the Ninth Circuit articulation cannot.

The Ninth Circuit articulation originated in *New Kids On The Block*. *New Kids*, 971 F.2d 302 (9th Cir. 1992). In this case, the 1990's hit band "New Kids on the Block" brought suit against two newspaper companies that used the bands' name in a pop culture poll within their respective newspapers. *Id.* at 304. The New Kids claimed that the newspapers should not be able to use the "New Kids on the Block" name without their permission. *Id.* at 305. However the newspapers asserted a "fair-use" defense that if proved, would allow them to fairly use the trademark in question to describe their own goods or services. *Id.* The Court stated that this "fair-use" defense, in essence, forbids a trademark registrant to appropriate a descriptive term for his exclusive use while preventing others from accurately describing a characteristic of their goods." *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178 (5th Cir. 1980). Following that discussion, the court held that the newspaper had fairly used the New Kids' name because they only used the name for news purposes and did not imply a false endorsement. Through this decision, the Ninth Circuit articulated their version of the nominative fair use test as follows: (1) The

product or service in question must be one not readily identifiable without use of the trademark; (2) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service and (3) 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 308. In doing this, the Ninth Circuit created a test that is fraught with ambiguity and uncertainty.

Although the Ninth Circuit test appears to be functional, its insufficiencies can be uncovered when applied to a given set of facts. In fact the Third Circuit, in *Century 21*, goes into detail as to how the Ninth Circuit test, as applied in *New Kids on the Block*, was incorrect. *Century 21*, 425 F.3d at 228. The *Century 21* court goes through the Ninth Circuits analysis prong by prong and begins with how the first prong is insufficient. *Id.*

The first prong of the Ninth Circuit Nominative Fair Use test discusses whether the product in question is readily identifiable without use of the trademark. The Ninth Circuit, in *New Kids*, only inquires into the “necessity of using the plaintiff’s trademark to describe the *plaintiff’s* product.” *Id.* (emphasis added) However, the district court in *New Kids* goes into detail regarding the necessity of using the plaintiff’s mark to describe the *defendant’s* product. *Id.* (emphasis added) Although what the district court did extends further than what the Ninth Circuit test requires, the extension seems to be entirely appropriate and falls more in line with the Third Circuit approach.

In cases of nominative fair use, the first prong of the Third Circuit test is trying to determine if defendant's use of the plaintiff's mark to describe the plaintiff's product is reasonably necessary – which takes the Ninth Circuit analysis one step further. Looking at the facts of *New Kids*, the Third Circuit analysis could be articulated as, “was the newspaper's use of New Kids on the Block's name to describe New Kids on the Block reasonably necessary?” In other words, could the newspaper still have accomplished their purpose in a reasonable manner without using the “New Kids on the Block” name? However, this inquiry must be a two-fold inquiry.

A two-fold inquiry, looking at both the plaintiff's and defendant's use of the trademark, allows the court to look at the necessity of the mark from both perspectives. Simply looking at the “necessary” requirement for the plaintiff's product is not enough...just like looking only at the defendant's product is not enough. The Third Circuit approach envelops this idea and looks at the necessary requirement for both the defendant and the plaintiff. Because of this, it truly provides the most thorough approach to first prong. Continuing with the analysis of the Nominative Fair Use test, the second prong, although articulated similarly, has still posed several issues for the courts.

The second prong of both the Third and Ninth Circuit test is articulated as follows: “is only so much of the mark or marks may be used as is reasonably necessary to identify the product or service?” *Century 21*, 425 F.3d at 222; *New Kids*, 971 F.2d at 308. Although both courts have enumerated this prong in the

same way, they have still had to distinguish this prong from the first prong. The first prong clearly identifies the defendant's need to use the trademark. However, prong two must, "test only whether the quantum of the plaintiff's mark used by the defendant was appropriate." *Century 21*, 425 F.3d at 230. The Third Circuit viewed this second prong as essentially "predetermined" by the first prong, but also stating that it could also give insight into a separate question. *Id.* That "separate question" could be viewed as inquiring into exactly how much of the plaintiff's mark is necessary to identify the plaintiff's product. In short, this prong exists in order to provide an underlying sense of fairness to the test. If only a small amount of a given trademark was necessary to identify the product and the defendant used more than that amount, then the defendant would likely have exceeded the nominative fair use allowed by the test. However, unlike the second prong, the Third and Ninth circuits have adopted different articulations of the third prong of the Nominative Fair Use test.

The Third Prong of the Nominative Fair Use test, as articulated by the Ninth Circuit, says 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 308. Therefore, in order for a defendant to stay within the nominative fair use of a trademark, the defendant would merely have to show that they have not done anything that suggests sponsorship or endorsement, giving virtually no

protection to the trademark owner.⁹ Because of that articulation, this appears to be too easy of a hurdle to overcome for a defendant.

The Third Circuit, in its articulation of the third prong, decided to make that hurdle a little higher for the defendant. The Third Circuit prong is articulated as, “does the defendant’s conduct or language reflect the true and accurate relationship between plaintiff and defendant’s products or services? *Century 21*, 425 F.3d at 228. With this articulation, it serves to further the general purpose of trademark law and the possibility of fair use. As noted by the Ninth Circuit, “trademark protection, like other legal protections of property rights, guards against the overuse of resources while also providing incentives for the creation of new combinations of resources.” *G.S. Rasmussen & Assocs. Inc. v. Kaitta Flying Serv. Inc.*, 958 F.2d 896, 900 (9th Cir. 1992). Looking at this quote and the course of trademark case history, it is clear that the underlying purpose is to provide protection for creations while also preventing trademarks from monopolizing innovation. Looking back at the Ninth Circuit articulation, a party must only show the court that they are not implying any sort of endorsement from the trademark holding party. However, the Third Circuit clearly furthers the point of trademark law and provides the fairest approach to the third prong.

⁹ See 4 McCarthy on Trademarks and Unfair Competition § 23:76 (4th ed.) stating that, “Rather, ‘the modern test of infringement is whether the defendant’s use is likely to cause confusion not just as to source, but also to sponsorship, affiliation or connection.’” See *Nike, Inc v. “Just Did It” Enters.*, 6 F. 3d 1225, 1228-29 (7th Cir. 1993). (“customer confusion need not be restricted to a mistake regarding the source of the goods; the court should also consider whether the customer would believe that the trademark owner sponsored, endorsed or was otherwise affiliated with the product.”)

The Third Circuit articulation gives the court more latitude to look at the totality of the circumstances surrounding the infringement. This type of judicial freedom allows for the most thorough inquiry into the purpose behind the defendant's use of the plaintiff's trademark. If the court only needed to look at, "if the defendant did something that suggested sponsorship", then a defendant could easily prove their innocence and continue use of the trademark. In other words, the Ninth Circuit articulation creates an extremely easy burden for the defendant to meet. And when the point of the Nominative Fair Use test is to provide the plaintiff with the most thorough inquiry into a party's use of their trademark, the Ninth Circuit cannot supply this type of protection. However, the Ninth Circuit test's inadequacies are not simply theoretical. Rather, these inadequacies can clearly be seen and, when applied to the current case, the Third Circuit approach continues to yield the fairest approach.

B. When Applied to the Current Case, Gardashyan Can Prove that the Third Circuit Approach Clearly Establishes that Pattel's Use of Her Trademark was not Fair Use.

In the present case, Pattel unfairly and illegally used Gardashyan's trademark for its own profit. Pattel did this by creating a series of fashion dolls that so closely resembled Gardashyan's appearance, no ordinary person would be able to tell if these dolls were manufactured by Gardashyan herself or by a different company. When this is the case, trademark law exists to provide recourse for a party such as Gardashyan. It exists to provide Gardashyan with the monetary compensation she deserves for being the creative party behind the trademark. And

ultimately, it exists to provide fairness to an economic system that is full of people and companies that have worked hard to trademark their creations. In this case, fairness is the outcome that this Court should seek to invoke. To do this, this Court should affirm the court below and employ the Third Circuit test. In following this test, this Court would need to first analyze the facts using the *Polaroid* confusion factors and then use the three-pronged Nominative Fair Use test. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007 (9th Cir. 2001).

First, Gardashyan will need to show that the *Polaroid* factors point in the direction of confusion. As established earlier, the idea behind the eight *Polaroid* factors is to decide if the use of the plaintiff's trademark is enough to cause confusion within an ordinary consumer. If this Court can determine that Pattel's use of Gardashyan's trademark would cause an ordinary consumer to be confused as to the origin of the product, then the court should hold that the use of the trademark was not fair use.

Looking at the *Polaroid* factors, Gardashyan will be able to show that Pattel's use of her trademark would cause confusion in an ordinary consumer. The eight facts that we use 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 bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.

Starbucks Corp., 588 F.3d at 115. However, “these factors are not exclusive and should not be applied mechanically. Also no single factor is dispositive...”

Gardashyan v. Pattel Inc., 1135 F. 3d 759 (14th Cir. 2016). Interpreting this language, this Court should hold that the factors undoubtedly point in the direction of consumer confusion.

Looking at the current case, the eight factors clearly point in the direction of confusion. However, when the circuit courts have dealt with these factors, rarely have they gone into detail as to how they are applied. Rather, they have left the analysis up to the respective district courts because, “the Lanham Act’s likelihood of confusion standard is predominantly factual in nature.” *Wendt v. Host Int’l. Inc.*, 125 F.3d 806, 812 (9th Cir. 1997). In following with this style, Gardashyan’s argument will be based on a pure application of the factors to the present facts of this case.

Factor one of the *Polaroid* test is the “strength of the plaintiff’s mark.” *Downing*, 265 F.3d at 1007. When dealing with a celebrity such as Gardashyan, this seems to allude to the “level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended.” *Id.* In the present case, it is clear from the facts that Gardashyan is a very well-known celebrity with a worldwide presence. This is a clear indication that the strength of Gardashyan’s trademark is very strong and consequently, the risk of the consumer thinking that this was actually her product is very high. Even with this factor pointing clearly towards confusion, the *Polaroid* test still gives us seven more factors to look at.

The second factor is the “relatedness of the goods.” *Downing*, 265 F.3d at 1007. This factor essentially deals with the “relatedness of the fame or success of the plaintiff to the defendant’s product.” *Id.* Gardashyan became famous due to her lavish lifestyle and fashion sense. The success of Pattel’s product is directly related to the fame and notoriety of Gardashyan as a person. Because the product’s success and Gardashyan’s popularity are so closely related, this second factor clearly points to confusion. The third factor in the analysis continues to point towards confusion.

The third factor is the “similarity of the marks.” *Downing*, 265 F.3d at 1007. This factor looks at the “similarity of the likeness used by the defendant to the actual plaintiff.” *Id.* The facts of this case clearly illustrate that the doll closely resembled Gardashyan’s appearance in almost every way. Pattel’s doll had long dark hair just like Gardashyan and it also wore Gardashyan’s signature style, which was an animal print top, knee-length skirt, and sparkly high-heeled shoes. Further, the doll had a voice feature that, when activated, said, “I want to be a fashionista, just like Cammy Gardashyan.” *Gardashyan*, 1135 F. 3d 759. Pattel’s creation of a doll that is so similar to Gardashyan would clearly confuse an ordinary consumer. And naturally, it would confuse the consumer to the point where they would not be able to tell if this product was created by Gardashyan herself or a third party company. Having clearly established confusion from the first three factors, the court should next consider the factual consideration of the fourth factor.

The fourth factor is an inquiry into what has actually happened since the defendant placed the infringing product in the market. Here, we look at “evidence of

actual confusion.” *Downing*, 265 F.3d at 1007. However, in this case we do not have evidence of actual confusion. Rather, all we know is that the doll appeared extremely similar to the look of Gardashyan. Any claim regarding actual confusion would be an inference. However, even with this factor not necessarily lending itself towards confusion, courts have previously held that, “they are not necessarily of equal importance, nor do they necessarily apply to every case.” *Id.* at 1008. Because of this lack of application to all cases, this Court’s analysis can proceed to the fifth factor.

The fifth factor is stated as, “marketing channels used.” *Id.* at 1007. However as the courts have stated, not all factors will be relevant in every case. *Id.* In the present case, the primary issue revolves around the infringing product itself and how it unlawfully uses Gardashyan’s trademark. We are not necessarily concerned with the marketing channels that Pattel used and therefore, this factor is not relevant to the current factual analysis. However, there are still three more factors that can be used to further prove the confusion that Pattel caused by using Gardashyan’s mark.

The sixth factor is the “likely degree of purchaser care.” *Id.* Here, the courts should look at how careful a consumer is in determining who actually created the product in question. In the current case, the only way that the customer could have known that the doll was not created by Gardashyan would have been to look at the small disclaimer on the lower, back of the packaging in ten point font. Although Pattel may argue that this disclaimer is enough to rid the consumer of confusion,

the Sixth Circuit has addressed that argument precisely. The court in *PACCAR Inc.* said that, “a disclaimer disavowing affiliation with the trademark owner read by a consumer after reaching the web site comes too late. This ‘initial interest confusion’ is recognized as an infringement under the Lanham Act.” *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 253 (6th Cir. 2003).¹⁰ Nonetheless, the last two factors would still point any court to hold that Pattel’s use of the trademark established confusion.

The seventh factor is listed as the, “defendant’s intent in selecting the mark.” *Downing*, 265 F.3d at 1007. The primary inquiry here is whether or not Pattel unlawfully used Gardashyan’s trademark in order to maximize profits by confusing consumers regarding the creator of the doll. Ultimately, this is a subjective inquiry into the mind of the defendant at the time of the infringing use. And one would be foolish to think that Pattel blatantly used Gardashyan’s mark for any purpose other than maximizing profits. Nonetheless, even with the seventh factor still undoubtedly pointing the court towards a finding of confusion, the eighth factor further bolsters that finding.

The eighth factor is one that is often skipped over in courts’ analyses. However, that is only because it is rarely an issue in the original trial and both parties rarely present evidence to support their position. Regardless, the eighth

¹⁰ See *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456 (7th Cir. 2000). (holding that “such confusion, which is actionable under the Lanham Act, occurs when a consumer is lured to a product by its similarity to a known mark, even though the consumer realizes the true identity and origin of the product before consummating a purchase.” *Id.*)

factor is, “likelihood of expansion of the product lines.” *Downing*, 265 F.3d at 1007. Although neither Pattel nor Gardashyan presented this issue in the court below, that does not mean that it shouldn’t be a contributing factor in this Court’s decision. When dealing with the concept of future actions (such as expanding product lines), this Court needs to look at the purpose behind the defendant’s product or company. In the present case, we know that Pattel is a toy company – and a very big one at that. Toy companies, in order to make money, will inevitably expand on their successful, existing product lines. With a successful Gardashyan-doll product line, and if this Court rules that Pattel did not infringe on Gardashyan’s mark, then I wonder what Pattel will continue to do with Gardahyan’s mark?

Ultimately, the confusion analysis boils down to the totality of the circumstances. It boils down to whether or not Pattel’s use of Gardashyan’s mark would have confused a consumer. And if that consumer was confused as to the origin of the doll, this Court must hold that the *Polaroid* factors point to the conclusion that Pattel’s use was infringement and not fair use. However, after Gardashyan proves that Pattel’s use of her trademark is likely to confuse a consumer, she still must prove, and will be able to prove, that the nominative fair use prongs also point towards infringement.

Gardashyan will be able to prove that Pattel’s actions do not meet the standard for the first prong of nominative fair use. As stated earlier, the first prong says, “is the use of the plaintiff’s mark necessary to describe: (a) the plaintiff’s product or service *and* (b) the defendant’s product or service?” *Century 21*, 425 F.3d

at 228. Here, Gardashyan must prove that Pattel's use of her mark was necessary to describe both Gardashyan's product (her trademark) and also to describe Pattel's product (the Gardashyan doll).

With a lack of case law analyzing the individual prongs of the test, this Court will have to apply the language of the prong itself and establish its own conclusion. Here, it is clear that Gardashyan can show that the use of the mark is completely necessary to describe her own product. It is her brand, it is her image, it is her likeness and ultimately, it is her trademark that Gardashyan can use as she pleases. Conversely, Pattel's use of Gardashyan's mark was not necessary. Pattel could have avoided the use of the name "Cammy Gardashyan" by simply allowing the distinct clothing and hair of the doll to suffice. It seems clear that Pattel did not need to use Gardashyan's mark in order to create an acceptable product. Rather, Pattel chose to use Gardashyan's likeness in order to maximize profits and confuse the consumer. However, it is the amount of the Gardashyan's trademark that Pattel used that brings into question the second prong.

The second prong of the test is, "is only so much of the plaintiff's mark used as is necessary to describe the plaintiff's product or services?" *Century 21*, 425 F.3d at 228. Looking at this factor, this Court must decide whether the amount of Gardashyan's mark that was used by Pattel was fair or unfair. The Third Circuit stated that this prong, "tests only whether the quantum of the plaintiff's mark used by the defendant was appropriate." *Century 21*, 425 F.3d at 230. Looking at this restatement of the prong, this Court cannot say that Pattel only used the amount of

the mark necessary. Similarly to prong one, Pattel could have created a simple doll with long black hair and an animal print skirt. This type of doll would have provided the consumer exactly what they needed. However, once again, Pattel chose to blatantly display Gardashyan's name on the front of the box in order to drum up popularity for the doll. This type of marketing was deceitful and should ultimately be viewed by this Court as unlawful for misappropriating the use of Gardashyan's trademark. However, even when this second factor leans in favor of Gardashyan, Gardashyan can still prove that the third factor would also push the court in the direction of holding that Pattel's use was unlawful trademark infringement.

The third factor is, "does the defendant's conduct or language reflect the true and accurate relationship between the plaintiff and defendant's product or service?" *Century 21*, 425 F.3d at 228. The answer to this question should be unequivocally clear; however to analyze it, two questions must be looked at: (1) What was the relationship between Pattel and Gardashyan, and (2) would a consumer think that the actual relationship was correct based on looking at the product? The answers to these questions are just as easy to articulate.

To the first question, the answer is none. There was zero relationship between the parties. Gardashyan had not given Pattel any permission to use any part of her trademark or likeness. To the second question, the answer is no. The consumer would not have realized that this was the real relationship between the parties after looking at the product. An ordinary consumer would immediately think that a doll such as this one would've had Gardashyan's express permission to

use her likeness and her trademark. And that is not the case here. Ultimately, a consumer would be confused as to what the true relationship between Pattel and Gardashyan was, and why Pattel was even allowed to produce this doll without Gardashyan's approval. ¹¹

¹¹ *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F. 2d 44, 47 (2d Cir. 1978); *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F. 2d 76, 79 (2d Cir. 1981). (“On the question of competition and the likelihood of confusion, it is not necessary that Warner Bros. actually manufacture the toy cars, but merely that a confusion as to manufacture and sponsorship result.” Showing that it is clear that the primary inquire is to see if there is consumer confusion in the production of the product and the relationship between the parties.

CONCLUSION

The facts from the current case are clear. Pattel desperately sought to create a new product that could increase their bottom line. They decided to unlawfully use the likeness of Cammy Gardashyan in order to obtain these desired profits. There was no discussion between the parties. There was no contract between the parties. Nothing transpired between these parties that would give Pattel any indication that they could lawfully use Gardashyan's name for their new doll. This use would clearly create confusion within a consumer and further, it does not hold up when put up against the Third Circuit's Nominative Fair Use test.

This Court should affirm the decision of the 14th Court of Appeals and reinforce the decision that Pattel unlawfully infringed upon Gardashyan's trademark.