

DOCKET No. 70593-2016

IN THE
SUPREME COURT OF THE UNITED STATES

CAMMY GARDASHYAN,

Respondent

v.

PATTEL, INC., A BEL AIR CORPORATION,

Petitioner

ON APPEAL FROM FOURTEENTH CIRCUIT COURT OF APPEALS

BRIEF FOR THE PETITIONER

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OCTOBER 21, 2016

QUESTIONS PRESENTED

- I. SHOULD WE ADOPT A NOMINATIVE FAIR USE TEST IN A TRADEMARK INFRINGEMENT ACTION UNDER § 1114 OF THE LANHAM ACT WHEN A DEFENDANT USED THE PLAINTIFF'S MARK IN REFERENCE TO THE PLAINTIFF, AND IF SO, SHOULD WE ADOPT IT AS AN AFFIRMATIVE DEFENSE THAT MAY BE ASSERTED BY THE DEFENDANT DESPITE A FINDING OF A LIKELIHOOD OF CONFUSION OR DOES IT BECOME A PART OF THE LIKELIHOOD OF CONFUSION ANALYSIS?

- II. ASSUMING A NOMINATIVE FAIR USE TEST IS ADOPTED, HOW SHOULD THE TEST BE ARTICULATED AND APPLIED TO THE PRESENT CASE?

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED.....	i
TABLE OF AUTHORITIES.....	iv
OPINIONS BELOW	1
JURISDICTION.....	1
STANDARD OF REVIEW.....	1
STATEMENT OF THE CASE.....	1
A. Cammy Gardashyan's Mark	1
B. Factual Background of the Fashionista Barbie	2
C. Procedural Posture.....	3
SUMMARY OF ARGUMENT	4
ARGUMENT	5
I. THIS COURT SHOULD ADOPT A NOMINATIVE FAIR USE TEST IN ACCORDANCE WITH A MAJORITY OF FEDERAL JUDICIAL DECISIONS.....	5
A. Pattel’s Use of Appellee’s Mark Was Nominative Rather Than Descriptive	6
B. This Court Should Employ a Nominative Fair Use Test Rather Than Descriptive Fair Use Analyses That Only Considers Likelihood of Consumer Confusion.....	10
NOMINATIVE FAIR USE SHOULD ALWAYS BE AVAILABLE AS AN AFFIRMATIVE DEFENSE UNDER THE LANHAM ACT.....	14
A. Fair Use, Whether Descriptive or Nominative in Nature, Is an Affirmative Defense to a Trademark Infringement Claim.....	14
B. Nominative Fair Use Is an Affirmative Defense, Even If Likelihood of Confusion Is a Factor	15

	<p>ASSUMING, <i>ARGUENDO</i>, NOMINATIVE FAIR USE IS NOT AN INDEPENDENT AFFIRMATIVE DEFENSE, IT MUST AT LEAST FACTOR INTO THE COURT'S LIKELIHOOD OF CONFUSION ANALYSIS.</p>	21
II.	<p>THE FOURTEENTH CIRCUIT OF THE UNITED STATES COURT OF APPEALS ERRONEOUSLY DISCARDED THE APPLICATION OF THE <i>NEW KIDS ON THE BLOCK</i> TEST, ELECTING INSTEAD TO APPLY THE <i>CENTURY 21</i> TEST FROM THE THIRD CIRCUIT.....</p>	22
	<p>WHEN APPLYING THE NINTH CIRCUIT'S THREE PRONG NOMINATIVE FAIR USE TEST, PATTEL, INC. SATSIFIES THE REQUIREMENTS OF ALL THREE PRONGS.</p>	29
	<p>CONCLUSION.....</p>	32

TABLE OF AUTHORITIES

Page(s)

U.S. Supreme Court Cases

<i>Church of the Holy Trinity v. United States</i> , 143 U.S. 457, 12 S. Ct. 511, 36 L.Ed. 226 (1892).....	20
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 111, 125 S. Ct. 542, 160 L.Ed.2d 440, 73 USLW 4029, 72 U.S.P.Q.2d 1833, 04 Cal. Daily Op. Serv. 10,722, 2004 Daily Journal D.A.R. 14,540, 18 Fla. L. Weekly Fed. S 28 (2004)	5, 6, 8, 10, 12-14, 17, 21
<i>Pickett v. United States</i> , 216 U.S. 456, 30 S. Ct. 265, 54 L.Ed. 566 (1910).....	20
<i>Pirie v. Chi. Title & Tr. Co.</i> , 182 U.S. 438, 21 S. Ct. 906, 45 L.Ed. 1171 (1901).....	20
<i>Prestonettes, Inc. v. Coty</i> , 264 U.S. 359, 368, 44 S.Ct. 350, 351,68 L.Ed. 731 (1924).....	8, 9, 21, 23
<i>Public Citizen v. United States Dep't of Justice</i> , 491 U.S. 440, 109 S. Ct. 2558, 105 L. Ed. 2d 377, 1989 U.S. LEXIS 3119, 57 U.S.L.W. 4793 (1989).....	20
<i>Russello v. United States</i> , 464 U.S. 16, 104 S. Ct. 296, 78 L.Ed.2d, 17 RICO Bus.Disp.Guide 6100 (1983).....	19
<i>United States v. Goldenberg</i> , 168 U.S. 95,18 S. Ct. 3,42 L.Ed. 394 (1897).....	20

U.S. Court of Appeals Cases

<i>Cairns v. Franklin Mint Co.</i> , 292 F.3d 1139, 63 U.S.P.Q.2d 1279, 02 Cal. Daily Op. Serv. 5402, 2002 Daily Journal D.A.R. 6841 (9th Cir. 2002).....	6, 7, 11, 12, 28
<i>Century 21 Real Estate Corp. v. Lendingtree, Inc.</i> , 425 F.3d 211, 76 U.S.P.Q.2d 1769 (3d Cir. 2005).....	4, 10, 11, 16-18, 21-24

<i>G.D. Searle & Co. v. Hudson Pharmaceutical Corp.</i> , 715 F.2d 837, 220 U.S.P.Q. 496 (3d Cir. 1983)	8, 9, 16
<i>Gardashyan v. Pattel, Inc.</i> , 1135 F.3d 759 (14th Cir. 2016).....	1, 6, 9, 13, 16, 18-21, 23, 25, 29, 30
<i>Int'l Info Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC</i> , 823 F.3d 153 (2d Cir. 2016).....	11, 19, 21, 26
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 328 F.3d 1061, 1072, 66 U.S.P.Q.2d 1509, 3 Cal. Daily Op. Serv. 3661, 2003 Daily Journal D.A.R. 4735 (9th Cir. 2003), <i>vacated</i> , 543 U.S. 111 (2004).....	6
<i>New Kids on the Block v. News America Pub, Inc.</i> 971 F.2d 302, 23 U.S.P.Q.2d 1534, 20 Media L. Rep. 1468 (9th Cir. 1992)	3, 4, 7, 10, 15, 23, 24, 29-31
<i>PACCAR Inc. v. Telescan Technologies, LLC</i> , 319 F.3d 243, 65 U.S.P.Q.2d 1761, 2003 Fed.App. 0040P (6th Cir. 2003).....	7
<i>Playboy Enters. v. Welles</i> , 279 F.3d 796, 197 A.L.R. Fed. 601, 61 U.S.P.Q.2d 1508, 30 Media L. Rep. 1282, 02 Cal. Daily Op. Serv. 975, 2002 Daily Journal D.A.R. 1253 (9th Cir. 2002).....	10, 15, 18, 21, 22
<i>Polaroid Corp. v. Polarad Elecs. Corp.</i> , 287 F.2d 492, 4 Fed.R.Serv.2d 81, 128 U.S.P.Q. 411 (2d Cir. 1961)	9, 22
<i>Rosetta Stone Ltd. v. Google, Inc.</i> , 676 F.3d 144, 102 U.S.P.Q.2d 1473 (4th Cir. 2012).....	11, 18, 21, 22
<i>Soweco, Inc. v. Shell Oil Co.</i> , 617 F.2d 1178, 207 U.S.P.Q. 278 (5th Cir. 1980).....	7
<i>Starbucks Corp. v. Wolfe's Borough Coffee, Inc.</i> , 588 F.3d 97, 92 U.S.P.Q.2d 1769 (2d Cir. 2009)	9, 22
<i>Swarovski Aktiengesellschaft v. Bldg. #19, Inc.</i> , 704 F.3d 44, 50, 105 U.S.P.Q.2d 1563 (1st Cir. 2013)	12, 21
<i>Tiffany (NJ) Inc. v. eBay Inc.</i> , 600 F.3d 93, 2010-1 Trade Cases P 77,013, 94 U.S.P.Q.2d 1188 (2d Cir. 2010).....	11, 21

<i>Toyota Motor Sales, U.S.A., Inc. v. Tabari</i> , 610 F.3d 1171, 95 U.S.P.Q.2d 1702, 10 Cal. Daily Op. Serv. 8670, 2010 Daily Journal D.A.R. 10,637 (9th Cir. 2010).....	14, 15
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U.S. District Court Cases

<i>Coldwell Banker Real Estate, LLC v. Brian Moses Realty, Inc.</i> , 752 F. Supp. 2d 148, 2010 DNH 176 (D.N.H. 2010)	25
<i>Dwyer Instruments, Inc. v. Sensocon, Inc.</i> , 873 F. Supp. 2d 1015 (N.D. Ind. 2012)...	27
<i>Express Welding, Inc. v. Superior Trailers, LLC</i> , 700 F. Supp. 2d 789, 94 U.S.P.Q.2d 1727 (E.D. Mich. 2010)	26
<i>Health Grades, Inc. v. Robert Wood Johnson University Hosp., Inc.</i> , 634 F. Supp. 2d 1226, 92 U.S.P.Q.2d 1583 (D. Colo. 2009).....	27
<i>Suntree Technologies, Inc. v. EcoSense Intern., Inc.</i> , 802 F. Supp. 2d 1273 (M.D. Fla. 2011), <i>aff'd on other grounds</i> , 693 F.3d 1338, 104 U.S.P.Q.2d 1307 (11th Cir. 2012)	7, 27
<i>Ty, Inc. v. Publ'ns Int'l, Ltd.</i> , 2005 U.S. Dist. LEXIS 23420 (N.D. Ill. Feb. 25, 2005)	11, 17
<i>Volkswagen AG v. Dorling Kindersley Pub., Inc.</i> , 614 F. Supp. 2d 793 (E.D. Mich. 2009).....	26

Statutory Provisions

15 U.S.C.A. § 1114 (West 2016).....	i, 5
15 U.S.C.A. § 1115 (West 2002).....	5, 7, 13, 14, 18, 20

Other Authorities

<i>Expressio unius est exclusio alterius</i> , BALLENTINE’S LAW DICTIONARY (3d ed. 1969)..	19
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Kalt, Brian C., Pardon Me?: The Constitutional Case Against Presidential Self-Pardons, 106 Yale L. Rev. 779, 791-92 (2008) (December 5, 2008). 19

OPINIONS BELOW

The Fourteenth Circuit's opinion is reported at 1135 F.3d 759. The district court's findings of fact are reflected in the Fourteenth Circuit's opinion.

BASIS FOR JURISDICTION

The judgment below was entered on June 5, 2016. This Court granted a timely petition for certiorari. This Court has jurisdiction pursuant to 28 U.S.C. § 1254 (1).

STANDARD OF REVIEW

The Court will review de novo any conclusions of law made by the Fourteenth Circuit in reversing the orders of the District Court.

STATEMENT OF THE CASE

A. Cammy Gardashyan's Mark

Appellant Pattel, Inc. ("Pattel," "Petitioner," or "Appellant") is a Bel Air Corporation that manufactures Bambi dolls and has sold over five million of them. *Gardashyan v. Pattel, Inc.*, 1135 F.3d 759, 355 (14th Cir. 2016). Bambi dolls are generally inspired by celebrities' original looks and promote female independence by depicting inspirational women known through popular culture. *Id.* Cammy Gardashyan ("Respondent" or "Appellee") is one such celebrity. Respondent is an American reality television personality, socialite, businesswoman, model, and singer. *Id.* at 356. She has a vast online and social media presence including tens of millions of followers across various popular social media platforms. *Id.* Her distinctive features, unique style, and famous sisters all contribute to her worldwide fame. *Id.*

Respondent owns the trademark "CG CAMMY GARDASHYAN TM." *Id.* Her trademark resides in a stylized version of the words:

CG

CAMMY GARDASHYAN TM

Id. Respondent uses the trademark to protect her lucrative personal brand and produces jewelry, clothing, cosmetics, perfumes, handbags, and footwear under the Mark. *Id.*

B. The Factual Background of the Fashionista Bambi Doll

When designing the Fashionista Bambi doll, Pattel used Cammy Gardashyan as inspiration. *Id.* at 357. The doll followed the traditional Bambi doll mold regarding height and body figure, but the doll adopted Appellee's straight, black hair, as well as her signature style of dress. *Id.*

The Fashionista Bambi doll also has a talking feature. *Id.* When activated by a button on its hand, the doll's lips move and a digital recording located in her abdomen says, "I want to be a fashionista just like Cammy Gardashyan." *Id.*

The packaging of the doll is transparent, making it possible to see the doll without opening the box. *Id.* On the top front cover of the box there is a caption bubble that reads: "I say: I want to be just like Cammy Gardashyan." *Id.* The caption bubble is twenty point font size. *Id.* Also on the packaging is a ten point font message on the back lower portion that reads: "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan." *Id.*

Pattel used the standard black block typeface when referring to “Cammy Gardashyan,” never using the full mark or logo. *Id.*

The doll was released in January 2015. Respondent did not authorize Pattel to use the portions of her mark that it did on the box and the doll itself. Nevertheless, within twelve months of its release, Pattel had profits of forty-five million dollars from the thirty five million units it sold. *Id.*

C. Procedural History

Gardashyan filed an action against Pattel on February 9, 2015. *Id.* She sought a permanent injunction on a claim of trademark infringement for use of the mark “Cammy Gardashyan.” *Id.* Pattel responded by the use of the mark fell under the nominative fair use defense and that Gardashyan’s claim should be dismissed. *Id.* The District Court for the Central District of Bel Air held that Pattel’s use fell under the nominative fair use defense. *Id.* at 358. The court used a two-step approach where Pattel was able to bring forth a nominative fair use defense despite there being a likelihood of confusion. *Id.* The court noted that it used the nominative fair use defense as an affirmative defense. *Id.*

In regards to the three prong test for nominative fair use, the court adopted the Ninth Circuit’s test from *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 23 U.S.P.Q.2d 1534, 20 Media L. Rep. 1468 (9th Cir. 1992). *Id.* In applying this test, the district court awarded summary judgment in favor of Pattel and Cammy Gardashyan appealed. *Id.*

SUMMARY OF THE ARGUMENT

Nominative fair use is a concept that arises frequently throughout trademark litigation, and all circuit courts have adopted some method to measure such an issue when the circumstances arise. When faced with the question, the majority of circuit courts elect to analyze through a lens that shows deference to the Ninth Circuit's three-prong analysis in *New Kids*, 971 F.2d 302. Most of the remaining circuits apply a similar, though more strict three part analysis found in *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211,76 U.S.P.Q.2d 1769 (3d Cir. 2005).

The lower court's ruling that the *New Kids* standard is too difficult to apply and should not be adopted here is erroneous. When answering their own nominative fair use questions, the majority of courts have shown deference to the *New Kids* test, even after the *Century 21* test was created. This trend seems to show that *Century 21* has a standard that is no more efficient.

Moreover, when applying the *New Kids* standard, the Petitioner, Pattel Inc, should find relief, as their business practices fall within the graces of the analysis. Pattel used the mark in order to describe its own product because the product was not readily identifiable without the mark. Additionally, Pattel only used as much of the mark as was reasonably necessary to describe its product, and did nothing to suggest sponsorship with the mark's owner.

Pattel used respondent's mark in a manner that was both nominative and fair. This court should require additional analysis beyond simply assessing whether a

defendant fairly used a plaintiff's mark based upon a likelihood of confusion analysis in instances of nominative fair use. Likelihood of consumer confusion should not factor into the Court's analysis of whether a nominative use was fair as it does with descriptive uses. Further, nominative fair use should be read as an affirmative defense under the Lanham Act. Even if this court fails to read the Lanham Act as permitting nominative fair use as an affirmative defense, and if it also fails to allow it as a defense under the weight of common law, it must at least factor into a court's likelihood of confusion analysis when determine if a use was infringing.

ARGUMENT

I.

THIS COURT SHOULD ADOPT A NOMINATIVE FAIR USE TEST IN ACCORDANCE WITH A MAJORITY OF FEDERAL JUDICIAL DECISIONS.

When acting without consent, a party may be held liable for trademark infringement by a trademark owner for “use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C.A. § 1114(1)(a) (West 2016). A defendant may defeat a trademark infringement claim by proving the registrant’s mark was used to “describe the goods or services of [the defendant].” 15 U.S.C.A. § 1115(b)(4) (West 2002); *see KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 115, 125 S. Ct. 542, 546, 160 L.Ed.2d 440, 73 USLW 4029, 72 U.S.P.Q.2d 1833, 04

Cal. Daily Op. Serv. 10,722, 2004 Daily Journal D.A.R. 14,540, 18 Fla. L. Weekly Fed. S 28 (2004).

A. Pattel's Use of Respondent's Mark Was Nominative Rather than Descriptive.

Courts generally distinguish between two types of fair use in trademark law: nominative fair use and descriptive/classic fair use. Nominative fair use occurs “when the alleged infringer uses the [registrant's] product, even if the alleged infringer's ultimate goal is to describe his own product. Nominative fair use also occurs if the only practical way to refer to something is to use the trademarked term.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1072, 66 U.S.P.Q.2d 1509, 3 Cal. Daily Op. Serv. 3661, 2003 Daily Journal D.A.R. 4735 (9th Cir. 2003), *vacated*, 543 U.S. 111 (2004). In instances of nominative fair use, the defendant has used plaintiff's mark to describe the plaintiff's product or service. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151, 63 U.S.P.Q.2d 1279, 02 Cal. Daily Op. Serv. 5402, 2002 Daily Journal D.A.R. 6841 (9th Cir. 2002). On the contrary, descriptive fair use occurs when a defendant uses a plaintiff's mark to describe that defendant's own marks. *Id.* Here, Pattel's use of respondent's mark was both nominative and fair.

The U.S. Court of Appeals for the Fourteenth Circuit was correct in upholding the District Court's determination that Pattel's use of the mark was nominative use rather than merely descriptive use. *See Cammy Gardashyan v. Pattel, Inc.*, 1135 F.3d 759, 359 (14th Cir. 2015). A defendant can only properly defend itself against an infringement claim under the Lanham Act when the court

applies a nominative fair use test to assess whether it fairly used the plaintiff's mark in reference to its own product. *See* 15 U.S.C.A § 1115(b)(4).

The heart of the nominative fair use doctrine is laid out in *New Kids on the Block v. News America Pub, Inc.* 971 F.2d 302, 23 U.S.P.Q.2d 1534, 20 Media L. Rep. 1468 (9th Cir. 1992). “The fair-use defense, in essence, forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods.” *New Kids*, 971 F.2d at 306, *quoting Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185, 207 U.S.P.Q. 278 (5th Cir. 1980). Title 15 of the United States Code, Section 1115(b)(4) recognizes a defense to trademark infringement when a defendant uses a plaintiff's mark “to describe the goods or services of the party or their geographic origin.” In essence, a plaintiff's mark can be so fundamental to the description of a defendant's product that to prohibit a defendant from using the mark to describe its product would force the defendant to mischaracterize its own product. Sometimes, there is simply “no descriptive substitute” for a plaintiff's mark. *New Kids*, 971 F.2d at 306. In *New Kids*, “application of the nominative fair use analysis was appropriate . . . because the defendants had used the plaintiff's mark to describe the plaintiff's product, even though the defendants' ultimate goal was to describe their own products.” *Cairns*, 292 F.3d at 1151.

“When only a specific word is reasonably available to identify a particular thing, it ‘lies outside the structures of trademark law.’” *Gardashyan*, 1135 F.3d at 360 *quoting PACCAR Inc. v. Telescan Technologies, LLC*, 319 F.3d 243, 256, 65

U.S.P.Q.2d 1761, 2003 Fed.App. 0040P (6th Cir. 2003), *abrogated by KP Permanent Make-Up, Inc.*, 543 U.S. 111. As such, “[w]hen [a] mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.” *Gardashyan*, 1135 F.3d at 360 *quoting Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368, 44 S.Ct. 350, 351, 68 L.Ed. 731 (1924). Further, this court has held that likelihood of confusion and fair use *can coexist*. *See KP Permanent Make-Up, Inc.*, 543 U.S. at 121 (“some possibility of consumer confusion must be compatible with fair use . . .”).

When determining whether a third party’s use of a registrant’s mark was *necessary* to describe its own product or service, the term “necessary” is not to be construed as meaning “indispensable.” *Gardashyan*, 1135 F.3d at 364 (citing *G.D. Searle & Co. v. Hudson Pharm. Corp.*, 715 F.2d 837, 842, 220 U.S.P.Q. 496 (3d Cir. 1983) (holding that defendants may fairly use a plaintiff’s mark if doing so is the best way to truthfully describe its product, and that this can be harmonized with the Lanham Act). Here, Pattel’s use of Appellee’s mark was sufficiently necessary to describe the product. Appellee’s name and mark are essentially synonymous with “Fashionista” due to the success of her branded jewelry, clothing, cosmetics, perfumes, handbags, and footwear, as well as international fame for her fashionable and ostentatious family. *Id.* at 356. Pattel’s use of the “Cammy Gardashyan” mark was essential to describe its product in the most accurate way possible. Moreover, the Lanham Act does not compel defendants to disadvantage themselves by

mandating their use of inferior or second-best communication. *Gardashyan*, 1135 F.3d at 364 (citing *G.D. Searle*, 715 F.2d at 842).

In assessing the fairness of that nominal use, whether the third party did, in fact, infringe upon the registrant's mark, the court must employ one of a number of tests. This Court has suggested, and the Fourteenth Circuit specifically stated, the necessity of taking nominative fair use into account when analyzing fair use in infringement cases where the defendant uses the plaintiff's mark to describe the plaintiff's own product. *See Prestonettes, Inc.*, 264 U.S. at 368; *Gardashyan*, 1135 F.3d at 359. While many circuits have adopted a version of the nominative fair use test, some circuits still apply multi-factor descriptive fair use tests such as the "Polaroid test" to determine likelihood of confusion to consumers and whether the defendant's use was fair. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 4 Fed.R.Serv.2d 81, 128 U.S.P.Q. 411 (2d Cir. 1961).

The eight *Polaroid* factors 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. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 115, 92 U.S.P.Q.2d 1769 (2d Cir. 2009).

In addition to the *Polaroid* likelihood of confusion test, another popular test—albeit less so than *Polaroid*—is the "*Sleekcraft* test." The *Sleekcraft* factors are:

(1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines.

AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

B. This Court Should Employ a Nominative Fair Use Test Rather Than Descriptive Fair Use Analyses That Only Considers Likelihood of Consumer Confusion.

The basis for the nominative fair use test derives from *New Kids on the Block*. The factors set out therein (hereinafter the “*New Kids* test”) are: “First, the product or service in question must be one *not readily identifiable* without use of the trademark; second, *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.” *New Kids*, 971 F.2d at 308 (emphasis added). The *New Kids* test eliminates likelihood of confusion tests with one that only analyzes fairness. The Second Circuit later modified this test to explicitly allow for the coexistence of likelihood of consumer confusion and fair use. *Century 21 Real Estate Corp.*, 425 F.3d 211, 76 U.S.P.Q.2d 1769 (3d Cir. 2005); *KP Permanent Make-Up, Inc.*, 543 U.S. 121.

The Ninth, Third, and Second Circuits continually hold, as did the Fourteenth Circuit, that in instances of nominative fair use, a separate test must be employed beyond that used for descriptive fair use. *See Playboy Enters. v. Welles*, 279 F.3d 796, 801, 197 A.L.R. Fed. 601, 61 U.S.P.Q.2d 1508, 30 Media L. Rep. 1282, 02 Cal. Daily Op. Serv. 975, 2002 Daily Journal D.A.R. 1253 (9th Cir. 2002)

(adopting *New Kid's* nominative fair use test verbatim, noting that “nominative use may also be a commercial one”); *Century 21 Real Estate Corp.*, 425 F.3d 211 (analyzing *New Kids* through the lens of *KP Permanent Make-Up* and expanding upon the *New Kids* test); *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 103, 2010-1 Trade Cases P 77,013, 94 U.S.P.Q.2d 1188 (2d Cir. 2010) (acknowledging the necessity of adopting a nominative fair use analysis when “a trademark conveys an exclusive right to the use of a mark in commerce in the area reserved,” because “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”) (internal citations omitted); *Int’l Info Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153 (2d Cir. 2016) (stating that both *Polaroid* and *New Kids* tests must be employed in instances of analyzing nominative fair use); *Cairns*, 292 F.3d 1139 (adopting the *New Kids* test).

While the Ninth, Third, and Second Circuits have tailored alternate tests to determine when to employ the nominative fair use doctrine, they all recognize it as a valid defense. Additionally, they are joined by other jurisdictions in recognizing nominative fair use as a doctrine in similar circumstances. *See Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 154, 102 U.S.P.Q.2d 1473 (4th Cir. 2012) (citing *New Kids* and noting that when analyzing likelihood of confusion in instances of nominative fair use, courts must give special consideration to defendants not intending to cause consumer confusion), *Ty, Inc. v. Publ’ns Int’l, Ltd.*, 2005 U.S.

Dist. LEXIS 23420, *14-15 (N.D. Ill. Feb. 25, 2005) (adopting the *New Kids* test); *Suntree Technologies, Inc. v. EcoSense Intern., Inc.*, 802 F. Supp. 2d 1273 (M.D. Fla. 2011), *aff'd on other grounds*, 693 F.3d 1338, 104 U.S.P.Q.2d 1307, 23 Fla. L. Weekly Fed. C 1497 (11th Cir. 2012) (adopting the *New Kids* test); *Swarovski Aktiengesellschaft v. Bldg. #19, Inc.*, 704 F.3d 44, 50, 105 U.S.P.Q.2d 1563 (1st Cir. 2013) (adopting *Century 21*'s nominative fair use test).

Circuits that merely apply multi-factor descriptive fair use analyses, such as the *Polaroid* and *Sleekcraft* factors, misinterpret this Court's holding in *KP Permanent Make-Up, Inc.* It is essential to primarily consider that a defendant's use of a mark might be both fair and nominal. In such a situation—where the use is both fair and nominal—it is possible that fair use can exist where there is a significant likelihood of confusion. *KP Permanent Make-Up, Inc.*, 543 U.S. at 121. For example, consider *Cairns*, where the defendant was entitled to assert nominative fair use as a defense for creating and selling products with Princess Diana's name *and* likeness, despite significant likelihood of confusion. 292 F.3d at 1114.

Because likelihood of confusion and fair use can coexist, utilizing a likelihood of confusion test without considering nominative fair use cuts directly against this Court's holding in *KP Permanent Make-Up, Inc.* Were this court to employ a descriptive fair use analysis here, and a likelihood of confusion was found under a test whose factors mirror *Polaroid*, it would completely rule out the possibility of fair use compatible with likelihood of confusion. *Id.* Further, respondent supposes

incorrectly that *KP Permanent Make-Up, Inc.* precludes defendants similarly situated to Pattel from bringing nominative fair use claims. In *KP Permanent Make-Up, Inc.*, this Court specifically states that it does not “address the Court of Appeals’ discussion of nominative fair use.” *KP Permanent Make-Up, Inc.*, 543 U.S. at 115 n.3 (internal quotations omitted). Accordingly, that question is an issue of first impression upon this court.

The *Gardashyan* dissent makes an important point regarding the coexistence of likelihood of confusion and nominative fair use. *Gardashyan*, 1135 F.3d at 166 (Peterson, J., dissenting). The Fourteenth Circuit precluded any real possibility of coexistence between the two by rejecting *New Kid’s* fairness test and *Century 21’s* two-step burden-shifting approach. *Id.* In doing so, the Fourteenth Circuit effectively prevented petitioner from asserting any real defense at trial. Although Pattel is entitled to fairly use plaintiff’s mark, merely applying a descriptive fair use likelihood of confusion test fails to take the potential fairness of Pattel’s use into account. 15 U.S.C.A. § 1115(b)(4). Without petitioner being able to assert a nominative fair use defense and claim that their use of respondent’s mark was descriptive and/or fair—even if there was some likelihood of consumer confusion—the Fourteenth Circuit effectively bars petitioner from introducing evidence at trial. *Id.*

Pattel’s use of respondent’s mark was nominal because there was no word available to better describe it than “Fashionista Bambi.” Respondent cannot succeed on a claim that there is a common law basis for precluding this court’s consideration

of nominative fair use in its analysis altogether; this court has held “that fair use can occur along with some degree of confusion [without] foreclos[ing] the relevance of the extent of any likely consumer confusion in assessing whether a defendant's use is *objectively* fair.” *KP Permanent Make-Up, Inc.*, 543 U.S. at 123 (emphasis added). Independent of whether Pattel’s use of the mark caused any consumer confusion, permitting it to use the mark may nonetheless be objectively fair. As such, this court must recognize Pattel’s nominative use by factoring it into its analysis.

NOMINATIVE FAIR USE SHOULD ALWAYS BE AVAILABLE AS AN AFFIRMATIVE DEFENSE UNDER THE LANHAM ACT.

Nominative fair use should not merely factor into a court’s likelihood of confusion defense, but rather should be available to defendants like Pattel so they may prove that their use was fair even if it caused a degree of consumer confusion.

A. Fair Use, Whether Descriptive or Nominative in Nature, Is an Affirmative Defense to a Trademark Infringement Claim.

Eliminating the inclusion of the likelihood of confusion analysis in infringement actions against defendants who claim they used the plaintiff’s mark in a manner that is both nominative and fair is essential to comply with the Lanham Act. A defendant may defeat a trademark infringement claim if their use “of a term or device . . . is descriptive . . . and used fairly and in good faith.” 15 U.S.C.A. § 1115(b)(4). Congress said nothing about likelihood of confusion in setting out the elements of the fair use defense in Section 1115(b)(4). *KP Permanent Make-Up, Inc.*, 543 U.S. at 118. It authorizes third parties to fairly use a registrant’s mark in certain situations. *See Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171,

1183 n.11, 95 U.S.P.Q.2d 1702, 10 Cal. Daily Op. Serv. 8670, 2010 Daily Journal D.A.R. 10,637 (9th Cir. 2010). Including likelihood of confusion in a court's fair use analysis is not authorized by the Lanham Act and, moreover, it interferes with a defendant's ability to assert that its use was fair.

The *New Kids* test allows for defendants to assert an affirmative defense against trademark infringement claims so long as three factors are met. A defendant's use was both nominative and fair if: (1) the product or service is not readily identifiable without defendant's use of the mark; (2) only so much of the mark is used as is necessary to identify the product or service; and (3) the defendant did nothing to suggest the plaintiff's sponsorship or endorsement. *New Kids*, 971 F.2d 302, 308. Likelihood of confusion is not to be considered at all under the *New Kids* test. Many courts hold that in instances of nominative fair use, a likelihood of confusion analysis is not necessary at all. See *Toyota Motor Sales, U.S.A., Inc.*, 610 F.3d at 1175 ("holding that the *Sleekcraft* analysis doesn't apply where a defendant uses the mark to refer to the trademarked good itself); see also *Playboy*, 279 F.3d at 801; *New Kids*, 971 F.2d at 308.

B. Nominative Fair Use Is an Affirmative Defense, Even If Likelihood of Confusion Is a Factor.

Rather than employing the *New Kids* test to determine whether a defendant's use was fair, the Third Circuit created its own two-step approach that distinguishes between likelihood of confusion and fairness tests while better allowing parties to defend against trademark infringement claims. While the *New Kids* Test is best suited to address questions of fair use under the Lanham Act, other circuits have

devised useful tests to deal with instances where likelihood of confusion is compatible with fair use.

In *Century 21*, the Third Circuit established that infringers may assert an *affirmative* defense against a trademark infringement claim that *even if* their use of a plaintiff's mark could have caused consumer confusion, their use was nonetheless nominative and fair. *Century 21 Real Estate Corp.*, 425 F.3d at 222. "The plaintiff must first prove that [consumer] confusion is likely due to the defendant's use of plaintiff's mark. . . . Once plaintiff has met its burden of proving that confusion is likely, the burden then shifts to defendant to show that its nominative use of plaintiff's mark is nonetheless fair." *Id.* The plaintiff then must satisfy a separate three-prong test to prove that the use was fair. Under that test a defendant must prove:

- (1) 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;
- (2) that the defendant uses only so much of the plaintiff's mark as is necessary to describe plaintiff's product; and
- (3) that the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services.

Id. Again, "necessary" in this context does not mean "indispensable." *G.D. Searle*, 715 F.2d at 842, *Gardashyan*, 1135 F.3d at 164.

The Third Circuit adopted this two-prong test ("*Century 21* test") because it found "broad based likelihood of confusion test[s] . . . misplaced for several reasons." *Century 21 Real Estate Corp.*, 425 F.3d at 222. It found multi-factor likelihood of confusion tests "largely out of sync with the existing jurisprudence on fair use, [allowing] no real possibility of the co-existence of fair use with some likelihood of

confusion, yet this is precisely what the Supreme Court's holding in *KP Permanent Make-Up* specifically contemplates.” *Id.*, citing *KP Make-Up*, 543 U.S. at 121 (“Some possibility of consumer confusion must be compatible with fair use”). It further notes that *KP Permanent Make-Up, Inc.* establishes fair use as an affirmative defense, although this Court only explicitly discussed descriptive fair use. *Id.*

The Third Circuit interpreted *KP Permanent Make-Up, Inc.* to stand for the proposition that “neither classic or nominative fair use should rise and fall based on a finding of likelihood of confusion.” *Id.*, at 223. The *Century 21* court recognized that the lines between descriptive and nominative fair use were indistinct, finding no reason to ask radically different questions when analyzing a third party’s ability to refer to a registrant’s mark in two totally non-relatable, unique contexts. *Id.*

At the time *Century 21* was decided, the only other court to analyze nominative fair use as an affirmative defense agreed with the Third Circuit that there is no significant distinction between the two kinds of fair use, and that the first step in the analysis should always be to analyze the likelihood of confusion. *Id.*; *Ty, Inc. v. Publ'ns Int'l, Ltd.*, No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420, at *19 (N.D. Ill. Feb. 25, 2005). The Third Circuit’s approach keeps the likelihood of confusion and fairness analyses separate, thus making it more workable than alternatives such as *Polaroid*. *Century 21 Real Estate Corp.*, 425 F.3d at 223-24. In instances of nominative fair use, applying traditional multi-factor tests to determine likelihood of consumer confusion “is difficult because often many of the factors are either unworkable or not suited or helpful as indicators of confusion in

this context.” *Rosetta Stone*, 676 F.3d at 144; *see also Century 21 Real Estate Corp.*, 425 F.3d at 224; *Playboy*, 279 F.3d at 801.

Eliminating the likelihood of confusion analysis in infringement actions against defendants who claim they used the plaintiff’s mark in a manner that is both nominative and fair is the best way to analyze fair use under the Lanham Act. *See Rosetta Stone*, 676 F.3d at 144; *Century 21 Real Estate Corp.*, 425 F.3d at 224; *Playboy*, 279 F.3d at 801. Even if this court were to adopt a test that factors in likelihood of confusion, maintaining fair use as an affirmative defense is essential. Nominative fair use as an affirmative defense does not, as opined by the *Gardashyan* majority, permit defendants a “second bite at the apple.” *Gardashyan*, 1135 F.3d at 361. Rather, it just allows for third party’s to be protected for nominal, fair use which is, by definition, permitted by the Lanham Act. 15 U.S.C.A § 1115(b)(4).

C. The Intermediate Court's Majority Incorrectly Interprets the Lanham Act as Prohibiting Nominative Fair Use an Affirmative Defense.

The Fourteenth Circuit erroneously interpreted the Lanham Act as intentionally ruling out nominative fair use as an affirmative defense. *Gardashyan*, 135 F.3d at 362. The Fourteenth Circuit seems to believe that their interpretation is constrained to a strict reading of the statute because the statute only explicitly mentions descriptive fair use. *Id.* By their interpretation, nominative fair use is not only excluded from the statute, but contradicts it. *Id.* It agrees with the Second Circuit’s holding that nominative fair use does not “fall within § 1115(b)(4)’s language, as nominative fair use is not the use of a name, term, or device otherwise

than a mark with is descriptive of and used merely to describe the goods or services of the alleged infringer.” *Gardashyan*, 135 F.3d at 362, citing *Int’l Info. Sys. Sec. Certification Consortium, Inc.*, 823 F.3d 153.

The Fourteenth and Second Circuits employ “*expressio unius est exclusio alterius*,” a canon of construction meaning that “the expression of one thing implies the exclusion of another thing.” *Expressio unius est exclusio alterius*, BALLENTINE’S LAW DICTIONARY (3d ed. 1969). If a certain person or thing is specified in a statute, one would read that statute to mean that the legislators intended to exclude all other things not listed. *Id.* The Fourteenth Circuit relied upon *Russello v. United States* to justify its limited interpretation of the statute. *Gardashyan*, 1135 F.3d at 362. It adopts the proposition that “[w]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” *Russello v. United States*, 464 U.S. 16, 23, 104 S. Ct. 296, 300, 78 L.Ed.2d 17, 24 RICO Bus.Disp.Guide 6100 (1983).

By interpreting the statute in this manner, the court imbibes its own external limit on the statute that simply is not there. Kalt, Brian C., *Pardon Me?: The Constitutional Case Against Presidential Self-Pardons*, 106 Yale L. Rev. 779, 791-92 (2008) (December 5, 2008). “Merely adding an exception immediately after a grant of power should not always be read as making the remainder of the power unlimited” *Id.* As per this critique of *expressio unius*, it is illogical to assume that because the language of the statute only mentions descriptive fair use, that

language has so much force as to rule out nominative fair use altogether. This approach affords far too much weight to legislative intent, for it assumes the mindful choices of legislators in terms of inclusions and omissions as well as imbuing them with extremely keen sense of foresight. By reading 15 U.S.C.A. § 1115(b)(4) too strictly, the *Gardashyan* majority grants itself more power than it may justly exert; the majority “relieves the plaintiff of the burden of proving likelihood of confusion as a precondition to a defendant’s assertion of nominative fair use.” *Gardashyan*, 1135 F.3d at 365 (Peterson, J., dissenting).

This Court has held that, “All laws should receive a sensible construction. General terms should be so limited in their application as not to lead to injustice . . . The reason of the law in such cases should prevail over its letter.” *Church of the Holy Trinity v. United States*, 143 U.S. 457, 461, 12 S. Ct. 511, 512, 36 L.Ed. 226, 228 (1892); *see also Public Citizen v. United States Dep’t of Justice*, 491 U.S. 440, 109 S. Ct. 2558, 105 L. Ed. 2d 377, 1989 U.S. LEXIS 3119, 57 U.S.L.W. 4793 (1989); *Pickett v. United States*, 216 U.S. 456, 461, 30 S. Ct. 265, 267, 54 L.Ed. 566, 569 (1910); *Pirie v. Chi. Title & Tr. Co.*, 182 U.S. 438, 21 S. Ct. 906, 45 L.Ed. 1171 (1901); *United States v. Goldenberg*, 168 U.S. 95, 103, 18 S. Ct. 3, 4, 42 L.Ed. 394, 398 (1897). By narrowly interpreting the statute and guessing at legislative intent, the Fourteenth Circuit unjustly robbed Pattel of the ability to defend its protected right of fair use. As such, the Fourteenth Circuit erred in adopting the Second Circuit’s unjustly strict interpretation of the Lanham Act.

ASSUMING, *ARGUENDO*, NOMINATIVE FAIR USE IS NOT AN INDEPENDENT AFFIRMATIVE DEFENSE, IT MUST AT LEAST FACTOR INTO THE COURT'S LIKELIHOOD OF CONFUSION ANALYSIS.

Nominative fair use should undoubtedly be considered an affirmative defense for reasons of consistency, predictability, and fairness. This Court has already established that a fair use defense is not precluded just because there is a likelihood of consumer confusion. *KP Permanent Make-Up, Inc.*, 543 U.S. at 121. It has also held that “[w]hen [a] mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.” *Prestonettes*, 264 U.S. at 368. The Fourteenth Circuit joined the majority of federal circuits that recognize the need for additional analysis beyond a mere likelihood of confusion analysis. *Gardashyan*, 1135 F.3d at 360 (referencing *Prestonettes* and *KP Permanent Make-Up, Inc.*).

A trend is becoming apparent that cannot be ignored; following the Ninth Circuit’s decision in *New Kids*, more and more jurisdictions are recognizing that nominative fair use must *at least* factor into a likelihood of confusion analysis, if not displacing it altogether. See *Playboy*, 279 F.3d at 801; *Century 21*, 425 F.3d 211; *Tiffany*, 600 F.3d at 103; *Int’l Info Sys.*, 823 F.3d 153; *Rosetta Stone*, 676 F.3d at 154; *Swarovski*, 704 F.3d 50. Again, whether or not this court decides to adopt the *Century 21* test, the seminal case undoubtedly illuminates that the likelihood of confusion test and fairness tests are completely distinct from one another, especially in instances of nominative fair use. *Century 21*, 425 F.3d 223-24.

Traditional multi-factor tests to determine likelihood of confusion, those that don’t take nominative fair use into account such as the *Polaroid* and *Sleekcraft*

tests, are difficult to apply and antiquated in nature. See *Rosetta Stone*, 676 F.3d at 144; *Century 21 Real Estate Corp.*, 425 F.3d at 224; *Playboy*, 279 F.3d at 801. When applying the *Polaroid* test, courts must apply it in a manner that is "not mechanical, but rather, focuses on the ultimate question of whether, looking at the products in their totality, consumers are likely to be confused." *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115, 92 U.S.P.Q.2d 1769 (2d Cir. 2009); see also *Polaroid Corp.*, 287 F.2d 492; *Gardashyan* 1135 F. 3d at 359. Applying such factors without leaving room for consideration of nominative fair use would undoubtedly fit into this category of mechanical application. Simply applying any multi-factor descriptive fair use test misconstrues the nature of a defendant's nominative use of a plaintiff's mark as fair. Accordingly, this Court should adopt nominative fair use, as articulated by the Third Circuit, and allow defendants to assert it as an affirmative defense at trial.

II.

THE FOURTEENTH CIRCUIT OF THE UNITED STATES COURT OF APPEALS ERRONEOUSLY DISCARDED THE APPLICATION OF THE *NEW KIDS ON THE BLOCK* TEST, ELECTING INSTEAD TO APPLY THE *CENTURY 21* TEST FROM THE THIRD CIRCUIT.

The general purpose of trademark law is to protect the owner of a mark from the encroachments of an outside party who has no rightful claim to the mark. However, there is another purpose which is inherently attached to trademark claims. That purpose is to protect those who may use another party's mark in the interest of fair entrepreneurship and commerce. The intention is to protect such a

party that uses the mark in good faith and with minimal trespasses on the interests of the true mark owner. The Supreme Court of the United States identified a need for such protection early on, explaining that “when the mark is used in a way that does not deceive the public, we see no such sanctity in the word as to prevent it from being used to tell the truth.” *Presstonettes*, 264 U.S. at 368.

In circumstances regarding such a claim, the Ninth Circuit fashioned an analysis in *New Kids* that requires: 1) that the product or service in question is one not readily identifiable without use of the trademark; 2) that only so much of the mark or marks is used as is reasonably necessary to identify the product or service; and 3) that the user did nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. *New Kids*, 971 F.2d at 308.

The court below held that the *New Kids* test is “too lenient,” and that the “Ninth Circuit Court of Appeals itself and other courts have sometimes had trouble applying it.” *Gardashyan*, 1135 F.3d at 759. This is an erroneous assertion by the Fourteenth Circuit, who instead relied upon the lucrative standards articulated in *Century 21*. In *Century 21*, the test articulated by the Third Circuit places too high a burden on the defendant. 425 F.3d 211. Additionally, the test adopted by the Third Circuit does not lead to a more clear understanding and outcome of nominative fair use claims.

Regarding the first prong adopted by *Century 21*, the Third Circuit explains that the use of the mark must be necessary to describe the product, as opposed to the “not readily identifiable” standard found in *New Kids*. However, this new

approach is far too rigid. Indeed, one could argue that use of a mark is never ultimately “necessary,” but rather “convenient.” This verbiage places an often unconquerable burden on the defendant to prove that there was no plausible way to convey a similar message without use of the mark. The court in *Century 21* provided a caveat that a competitor should never be required to “resort to second-best communication,” but is nonetheless precisely what the Third Circuit’s standard requires—that a defendant could not have resorted to anything else because its use was profoundly necessary. *Century 21*, 425 F.3d at 229. This matter will always be open-ended and, in that regard, the *Century 21* test brings no more clarity than that of *New Kids*. It merely creates a higher burden for the defendant, one that is nearly always refutable by the plaintiff. The third prong of the *Century 21* test also increases the burden on the defendant, requiring the defending party to, “reflect the true and accurate relationship between plaintiff and defendant’s products or services.” *Century 21*, 425 F. 3d at 228. In contrast, the Ninth Circuit requires only that the defending party did nothing to suggest sponsorship with the plaintiff when there was no such endorsement. *New Kids*, 971 F.2d at 308.

The standard set by the Third Circuit is both too rigid and difficult to analyze, thus refuting the lower court’s reasoning for adopting it as the appropriate test here. The test is far too inflexible in application, as it may require a defendant to incorporate within its product a lengthy summary of the true relationship between both parties. Not only is this a daunting task for those who use the mark within a brief or small advertisement, but it is also open-ended in that a plaintiff

may easily refute the defense's use, claiming that they are unsatisfied with the particular language or visuals adopted by the defendant's explanation on its product. Justice Peterson of the Fourteenth Circuit noted the unreasonably high burden the third prong of *Century 21* test places on a defendant, explaining in his dissent that this logic focuses on what the defendant did not do, rather than what they actually did, thus taking the focus of the analysis away from affirmative acts. *Gardashyan*, 1135 F.3d 759 at 366. In contrast, the standard set by the Ninth Circuit seeks only to ensure that the defendant did not step outside the bounds of good faith use of the mark. In this way, it accomplishes what trademark law seeks to govern.

Many other circuit courts show deference to the *New Kids* standard, despite the fact *Century 21* is a more recent decision. The First Circuit, though not directly ruling on the adoption of a nominative fair use defense, applied the *New Kids* test hypothetically in *Coldwell Banker Real Estate, LLC v. Brian Moses Realty, Inc.*, 752 F. Supp. 2d 148, 2010 DNH 176 (D.N.H. 2010). The court used the analysis to convey that if such a test were adopted, Brian Moses Realty's actions would be protected under the three prongs when the defendant used Coldwell's mark on his resume and website to state that he had been ranked in the top 10 worldwide for sales within the Coldwell Banker Real Estate Corporation. *Id.*

Likewise, the Second Circuit, though rejecting the outward adoption of a nominative fair use test, explained, "district courts within our Circuit frequently use the Ninth Circuit's formulation." *Int'l Info Systems Security Certification*

Consortium, Inc., 823 F.3d at 166. The court in that case never mentioned being displeased with the three-prong test, nor did it mention that the district courts have had difficulty applying the test to its cases. *Id.*

Though the Sixth Circuit has not adopted a nominative fair use test, their district courts have addressed the issue. In both *Volkswagen AG v. Dorling Kindersley Pub., Inc.*, 614 F. Supp. 2d 793 (E.D. Mich. 2009), and *Express Welding, Inc. v. Superior Trailers, LLC*, 700 F. Supp. 2d 789, 94 U.S.P.Q.2d 1727 (E.D. Mich. 2010), the defendants brought forth a nominative fair use argument that sought to apply the *New Kids* approach. Though the defendants in these cases were ultimately unsuccessful in their arguments, the district courts did not outwardly reject the arguments on the grounds that the *New Kids* test was an inappropriate standard. The court in *Volkswagen* merely denied summary judgment based on a nominative fair use argument because the Sixth Circuit had not yet adopted the doctrine. *Volkswagen AG*, 614 F. Supp. 2d at 811. While the district court in *Express Welding* noted that the defendant would not have met the burden brought by the *New Kids* test. 700 F. Supp. 2d at 803. It is significant that neither court rejected the Ninth Circuit test as too lenient or difficult to apply, as the lower court claims.

The Seventh Circuit has also failed to adopt a nominative fair use test, though its district courts have recently elected to incorporate aspects of *New Kids*. For example, in the recent case, *Dwyer Instruments, Inc. v. Sensocon, Inc.*, the district court adopted the *New Kids* approach and blended it with prior Seventh Circuit precedent to create a seven-prong equitable balancing test to determine a

likelihood of confusion. 873 F. Supp. 2d 1015 (N.D. Ind. 2012). This illustrates the various circuit courts' tendencies to embrace *New Kids* rather than *Century 21* when faced with similar questions.

The Tenth Circuit has firmly rejected the Third Circuit's approach, electing instead to apply *New Kids* whenever the question arises. One of the most recent of these applications came in *Health Grades, Inc. v. Robert Wood Johnson University Hosp., Inc.*, 634 F. Supp. 2d 1226, 92 U.S.P.Q.2d 1583 (D. Colo. 2009). In this case the court used the *New Kids* three-part analysis to analyze whether a hospital was guilty of trademark infringement. *Id.*

Likewise, the Eleventh Circuit also shows deference to the Ninth Circuit approach. For example, in *Suntree Technologies, Inc.*, the New Kids test was employed to find that a construction corporation used a mark truthfully and in good faith when it did so in order to place a bid for a construction contract. 802 F. Supp. 2d 1273.

Understandably, the Ninth Circuit maintains its usage of the *New Kids* test. However, what should be noted is that while being the court to create the *New Kids* test, the Ninth Circuit also has ruled on the case that is perhaps most analogous to our own. In *Cairns v. Franklin Mint Co.*, a memorabilia company used the mark owned by Princess Diana's estate to describe its own products, which included a Diana Doll created in the mark holder's likeness. 292 F.3d 1139. The court applied the *New Kids* test, and ultimately held that each of the three elements was met because:

(1) use of Princess Diana's name was the easiest way to refer to her, even though it was conceivably possible to describe her as "the English princess who died in a car crash in 1997"; moreover, there was no substitute for the manufacturer's use of the Princess's likeness on its Diana-related products or in its advertisements; and while it was possible for the manufacturer to explain that the "Diana, The People's Princess Doll" was dressed in the stylish light-blue suit that Diana wore when she was presented with her signature flower, and that the doll was also completely accessorized with a purse and tiny bouquet of Princess of Wales Roses that Diana carried on that same occasion, it was far simpler and "more likely to be understood" to juxtapose a picture of the doll and a photograph of Princess Diana wearing the same suit and carrying the same purse and bunch of flowers; (2) the fund executors had not alleged that the manufacturer used any distinctive lettering or particular image of Diana that was intimately associated with the fund, and the description of the manufacturer's products depended on the description of the fund executors' marks, so that more use of the trademark was reasonably necessary to identify the product than in cases where the description of the defendant's product does not depend on the description of the plaintiff's product, and it was "doubtful" whether the manufacturer in this case could sell its "Diana, Princess of Wales Porcelain Portrait Doll" without prominent reference to Princess Diana, particularly because not every customer could be expected to recognize Diana's features in the porcelain doll, and use of a photograph of Diana helped in this process; and (3) the manufacturer did nothing that would have suggested sponsorship or endorsement by the fund; moreover, because other products in the manufacturer's catalog affirmatively stated that they were authorized by the trademark holder, the absence of a similar statement in the case of the Diana products suggested that they were not sponsored or endorsed by the fund.

Nominative Fair Use Defense in Trademark Law, 84 A.L.R. Fed. 2d 217, *4 (originally published in 2014). The above case is a prime illustration that the *New Kids* standard is appropriate in cases of this nature. The Ninth Circuit had no trouble applying the standard to the issue and coming to sound judgment. Contrary

to what the Fourteenth Circuit held below, the *New Kids* test is not a test flawed by unjust leniency and misapplication. The majority of the circuits find its application still appropriate.

WHEN APPLYING THE NINTH CIRCUIT'S THREE PRONG NOMINATIVE FAIR USE TEST, PATTEL, INC. SATSIFIES THE REQUIREMENTS OF ALL THREE PRONGS.

The first prong of the Ninth Circuit's nominative fair use test seeks to ensure that the product or service in question was not readily identifiable without the use of the mark. *New Kids*, 971 F.2d at 308. In the interest of describing its own product efficiently and in good faith, Pattel used Respondent's mark on its packaging. *Gardashyan*, 1135 F.3d at 357. The respondent argues that Pattel did not have her permission to use her name on the packaging, but Pattel adopted Gardashyan's mark only because it was the most efficient way to describe their own product.

The correlation between the Fashionista Bambi doll and Cammy Gardashyan is best illustrated by using her mark. While it is true that the Bambi doll had a similar appearance to Gardashyan, adopting her signature style of animal print clothing with a knee-length skirt and sparkly heeled shoes; these distinctive features are not unique to Gardashyan alone. *Id.* at 356-357. Many other celebrities have a similar style, including Gardashyan's three sisters. *Id.* Therefore, the mere use of her likeness would not make Pattel's own product readily identifiable.

Additionally, it should be noted that it was Pattel's intention to create a Bambi doll that is inspired by the appearance and lifestyle of Cammy Gardashyan, and no other celebrity. Pattel regularly highlights characteristics of female

independence by paying homage to inspirational women in popular culture. *Id.* at 355. In recent years, Respondnet has risen to fame and has attracted millions of admirers ranging from ages five to one hundred years old. *Id.* at 356. This is within the target audience of Pattel's Bambi doll product line, and therefore it was quite necessary that Pattel specify the doll's inspiration by advertising her statement that she wished "to be just like Cammy Gardashyan" and no other celebrity. *Id.* at 355-357. The mark is exclusive to Respondent, just as the Fashionista Bambi doll's design was exclusive to Cammy and her role in popular culture.

The second prong to the test requires that only so much of the mark is used as is reasonably necessary. *New Kids*, 971 F.2d at 308. An analysis of Pattel's use of the mark will illustrate that they satisfy this aspect of the test as well.

It was the goal of the toy manufacturer to create a Bambi doll that was inspired by Cammy Gardashyan, her clothing, her accomplishments, and her lifestyle. *Gardashyan*, 1135 F.3d at 356-357. Pattel did not seek to make a doll of Gardashyan herself. This is why the doll's statement explains that she wishes to be "like" Cammy Gardashyan. *Id.* Moreover, Pattel advertises on the doll's packaging that the doll speaks, supplying the message, "I say: I want to be just like Cammy Gardashyan." *Id.* This is, of course, in the interest of further drawing attention to the likeness of Gardashyan as an inspiration for the Fashionista Bambi, but it is also serves the dual purpose of advertising the fact that the doll speaks. Surely it is an attractive feature for a toy to be able to talk to its collector. To require Pattel to omit this writing on the packaging, or to advertise the speaking feature

ambiguously by merely stating “I speak,” without making reference to Gardashyan, would not accurately describe the product.

Furthermore, Pattel’s use of the words “Cammy Gardashyan” on the back lower portion of the box was only to expressly state that there is no sponsorship or affiliation with the appellee. *Id.* Additionally, Pattel purposefully avoided the use of Cammy Gardashian’s entire mark, specifically avoiding the use of her stylized “CG” in its description. *Id.* Pattel only used the words “Cammy Cardashian” as a necessity to describe both Pattel’s own product and to accurately describe the true relationship between the parties. *Id.* They did not use the rest of the complete mark because the complete mark would not have been reasonably necessary.

The third prong to the *New Kids* test is also satisfied by Pattel’s usage of the mark. The prong requires that the mark user did nothing to suggest sponsorship with the mark’s owner. *New Kids*, 971 F.2d at 308. Pattel did not suggest such a relationship with Cammy Gardashyan. In fact, the words “Cammy Gardashyan” only appear on the Bambi doll’s packaging on two occasions. The first is to advertise that the doll wishes to be “like” Gardashyan, which is necessary as the doll is inspired by the respondent. *Id.* This does not suggest a sponsorship, but only serves to explain that Gardashyan is an inspiration to the doll. The second use of the mark comes in an explicit waiver in which Pattel explains, “Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan.” *Id.* Surely such a denial of sponsorship does nothing to claim an affiliation with the appellee.

Here, Pattel—a corporation known globally for producing Bambi dolls that have inspired feminism for over fifty years—simply used Gardashyan’s name to describe its own product. In particular, the name was used to describe their doll’s fashionista ambitions that seek to inspire consumers of all ages. The Fashionista Bambi doll’s purpose is to highlight female empowerment and independence and to reflect modern social values through a lens that draws inspiration from contemporary female role models. Cammy Gardashyan is a global icon and is widely recognized as a model of female independence. The way to most readily convey the Fashionista Bambi doll’s message is to use the mark of respondent in a fair way that does not seek to misinform the public or exploit the mark holder. This is the very purpose of the nominative fair use argument, and this is precisely what Pattel, Inc. did.

CONCLUSION

Accordingly, this court should recognize nominative fair use as an affirmative defense in trademark infringement cases. If it does not adopt it as an affirmative defense, it must adopt it as a component of the likelihood of confusion analysis. Moreover, the Fourteenth Circuit erred in discarding the *New Kids* standard. The test has withstood the test of time and is still preferred by most circuits instead of the Third Circuit’s similar test. Pattel satisfies all three prongs of the *New Kids* test, thus proving that their use of the appellee’s mark was fair. For the foregoing reasons, this Court should reverse the Fourteenth Circuit’s decision, and award summary judgment in favor of Pattel Inc. pursuant to its nominative fair use claim.