

In The
Supreme Court of the United
States

November Term, 2016

Pattel, Inc.,

Petitioner,

v.

Cammy Gardashyan,

Respondent,

On Writ of Certiorari to the
Fourteenth Circuit of Appeals

BRIEF FOR PETITIONER

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Cover Page Color: Light Blue
October 21, 2016
Team 104

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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?

STATUTORY PROVISIONS

The following provisions from the United States Code are relevant to this case: 15 U.S.C. § 1114(1)(a); 15 U.S.C. § 1115(b)(4).

STATEMENT OF JURISDICTION

The United States Court of Appeals for the Fourteenth Circuit entered its judgment on June 5, 2016. Pattel, Inc. filed its petition and this Court granted certiorari. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

Factual Background

The Television Personality Star and the Fashionista Bambi Doll.

Pattel Incorporated is a toy manufacturing company that was founded in 1961. R. at 355. Pattel designs and makes a number of products, including the Bambi Doll. Typically, the dolls are inspired by the original Bambi “look,” as well as modern day celebrities, such as musicians, fashion models and famous actors. R. at 355. The dolls are designed to reflect modern social values, but most importantly to convey the characteristics of female independence by depicting inspirational women who are familiar through popular culture. R. at 355. To date, Pattel has sold over five hundred million Bambi dolls. Pattel’s target demographic ranges from ages three to one hundred, since the dolls are considered valuable collectibles. R. at 355.

One of Pattel’s dolls is known as the Fashionista Bambi doll. R. at 357. When the designers created the Fashionista Bambi doll they took into consideration Cammy Gardashyan. R. at 357. Gardashyan is famous for her reality television show, along with being a businesswoman, model and singer. R. at 356. Due to her growing celebrity persona and vast online and social media presence, Gardashyan has been able to successfully release a variety of products tied to her mark. The trademark CG CAMMY GARDASHYAN™ has been used on her line of jewelry, clothing, cosmetics, perfumes, handbags and footwear. R. at 356. Gardashyan is known for her “curvy” figure and her long, black straight hair. R. at 356. Gardashyan’s signature style consists of animal prints knee length skirts, dresses

and shiny high heeled shoes. R. at 356. The mark that Cammy Gardashyan uses is a stylized “CG,” with the C and G reversed, so that each letter is back to back and with the words “CAMMY GARDASHYAN” in capital letters, in standard block typeface. R. at 356.

In creating the Fashionista Bambi Doll, Pattel’s designers used a standard brand dimension for the doll’s body figure and height. R. at 357. The Fashionista doll has long back straight hair. R. at 357. The doll’s clothing consists of an animal leopard print top, a knee length skirt, and sparkly high heel shoes. R. at 357. The Fashionista doll also has a talking feature that is activated by a button located on its hand. R. at 357. When the button is pushed a digital recording from inside the doll says, “I want to be a Fashionista, just like Cammy Gardashyan.” R. at 357.

The Fashionista Bambi doll is packaged in a rectangular box that has a transparent cover, allowing for the doll to be seen without opening the box. R. at 357. Standard messages, including warnings and recommendations, and the Pattel trademark, are located on the front and back of the doll’s box. R. at 357. The top front cover displays the name “Fashionista Bambi.” R. at 357. Below the “Fashionista Bambi” name, there is a caption bubble which reads the message, “I say: I want to be just like Cammy Gardashyan,” in 20-point font size. R. at 357. In addition, Pattel included a disclaimer on the back lower portion of the box, which reads: “Pattel, Inc. and Fashionista Bambi are not sponsored or affiliated with Cammy Gardashyan,” in 10-point font size. R. at 357. Additionally, Pattel did not use the Cammy Gardashyan full logo. R. at 357. Both times “Cammy Gardashyan”

is referenced on the doll's box, standard black block typeface is used. R. at 357. The Fashionista Bambi doll was released for sale nationally, in January of 2015. R. at 357. The Cammy Gardashyan mark was not authorized by Gardashyan for use by Pattel. R. at 357. Within twelve months of the doll's manufacturing, Pattel had amassed sales of forty-five million dollars and sold thirty-five million Fashionista Bambi Dolls. R. at 357.

PROCEDURAL HISTORY

District Court for the Central District of Bel Air. Cammy Gardashyan filed an action seeking a permanent injunction against Pattel, Inc. on a claim of trademark infringement for use of the mark "Cammy Gardashyan". R. at 357. Pattel claimed in response that the use of the mark was fair use under the nominative fair use defense. R. at 357. Pattel argued to the court that Gardashyan's trademark infringement claims under 15 U.S.C. §1114 (Lanham Act) should be dismissed. Judge Alexi M. Frazre of the United States District Court for the Central District of Bel Air, held that Pattel's use of the names and marks on their products constituted nominative fair use. R. at 357. The court adopted a two-step approach, holding that Pattel is entitled to a nominative fair use defense for its references to Cammy Gardashyan to describe its own product. R. at 358. The court also held that Pattel is entitled to this defense regardless of there being any finding of a likelihood of confusion. R. at 358.

The court noted that it adopted the nominative fair use defense as an affirmative defense. R. at 358. In weighing its decision, Judge Frazre looked to

language from the Ninth Circuit Court of Appeals in regards to the three-prong test for nominative fair use. R. at 358; New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302 (9th Cir. 1992). After hearing cross-motions for summary judgment by the parties, the district court granted summary judgment on all counts in favor of Pattel, Inc. Cammy Gardashyan appealed and the Fourteen Circuit reversed and remanded, and this Court granted certiorari. R. at 358.

SUMMARY OF THE ARGUMENT

Evaluating Nominative Fair Use as applied in trademark infringement claims and the ability to establish an affirmative defense.

Under 15 U.S.C. §1114(1) of the Lanham Act, to show trademark infringement a plaintiff must show that the defendant’s use of the alleged infringing mark is “*likely to cause confusion, or to cause mistake, or to deceive.*” Cammy Gardashyan claims that Pattel, Inc.’s use of her name and mark on the packaging of the Fashionista Bambi Doll create a likelihood of confusion for consumers. Gardashyan alleges such use suggests some form of affiliation between herself and Pattel. Gardashyan is a well-known television personality and has her own line of products, however, as of this date, she has not currently produced or created a doll. The alleged infringement in this case revolves around the use of the mark “CAMMY GARDASHYAN” both on the box of the Fashionista Bambi doll and through an audio recording that is played when a button on the doll’s hand is pressed.

The issue of nominative fair—when a defendant uses a mark to describe a trademark holder’s goods, rather than the defendant’s goods—was a matter of first

impression for the Fourteenth Circuit. There, the court held that nominative fair use is not an affirmative defense but rather is an inquiry for the likelihood of confusion analysis. The Fourteenth Circuit narrowly interpreted this Court's holding in KP Permanent Make-up Corp., with regards to its application to nominative fair use, when in reality this Court's decision was much broader than that. KP Permanent Make-up Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004). This Court noted that likelihood of confusion and fair use can coexist, a vast contrast with the Fourteenth Circuit's approach. By conflating the likelihood of confusion analysis with the nominative fair use test the Fourteenth Circuit has effectively shifted the burden to the defendant negate confusion, which is contrary to this Court's reasoning in classic fair use cases. The key element of trademark infringement—in a classic or nominative fair use case—is a showing of a likelihood of consumer confusion. Had Congress believed that there was a need to form a distinction between the two types of fair use, they would have amended the language in the Lanham Act. We contend, that fair use is fair use. Furthermore, if a defendant can prove upon a showing of consumer confusion that their use of the mark was indeed fair, such a finding should be treated as an affirmative defense as applied in classic fair use cases.

Assuming This Court Adopts a Nominative Fair Use Test, Such an Analysis Would Only be Proper by Applying a Two-Step Approach. By combining the likelihood of confusion analysis and the nominative fair use test as a singular approach, the Fourteenth Circuit asks us to apply an eleven factor test.

The Fourteenth Circuit adopted the Second Circuit's eight Polaroid factors and additionally created their own three-part examination of nominative fair use, which they extracted from several other circuits. Not only is this approach unnecessary, but it stands directly in conflict with this Court's precedent. Although we concede that the Polaroid factors are an appropriate place to begin the inquiry as to a showing of likelihood of confusion, we rather believe in a departure from the Fourteenth Circuit's approach where it applied all eight factors. The application of the first and second Polaroid factors—degree of similarity of the marks and strength of the trademark holder's mark—are inappropriate for nominative fair use cases, as such factors will always indicate a likelihood of confusion. Since in nominative fair use cases the plaintiff's mark and defendant's mark will always be similar, if not identical, and the defendant's need to use the mark lies directly in its strength.

Furthermore, we respectfully urge this Court to adopt a two-step approach that begins with a likelihood of confusion analysis which is best assessed through a modified version of the Polaroid factors. In addition, upon a showing of a likelihood of consumer confusion, an alleged infringer may then assert the affirmative defense of nominative fair use. This defense should consist of the Third Circuit's three-factor nominative fair use test and it should be applied as a bifurcated approach. The three-factor test focuses on whether the use of plaintiff's mark is necessary to describe the plaintiff and defendant's product, and if only so much of the plaintiff's mark is used as is necessary, and finally, whether or not the defendant's conduct or language reflects the true and accurate relationship between the plaintiff and

defendant's product. Such an approach is consistent with the plain language of the Lanham Act and holds true to this Court's precedent.

STANDARD OF REVIEW

Whether a person's trademark is protected under 15 U.S.C. §1114 of the Lanham Act presents a question of statutory interpretation that is reviewed *de novo*. See, e.g., North American Medical Corp. v. Axiom Worldwide, Inc., 522 F.3d 1211, 1216 (11th Cir. 2008); Survivor Media, Inc. v. Survivor Productions, 406 F.3d 625, 630 (9th Cir. 2005). See also Homeowners Group, Inc. v. Home Marketing Specialists, Inc., 931 F.2d 1100, 11104 (6th Cir. 1991) (applying *de novo* standard of review to grant of summary judgment on federal trademark claim).

ARGUMENT

I. The Fourteenth Circuit Erred When It Failed To Establish An Affirmative Defense Of Nominative Fair Use Despite A Finding Of Likelihood Of Confusion In A Claim For Trademark Infringement.

An understanding of trademark infringement requires fundamental knowledge of what trademark registration is designed to protect. Trademark laws do not forbid a party from using particular words. Trademark protection merely provides a right to prohibit the use of a word or words in order to protect the goodwill of another's product. Prestonettes, Inc. v. Coty, 264 U.S. 359, 368 (1924). These laws, as currently constructed, serve two important purposes. The first purpose ensures that owners of a trademark are able to benefit from the goodwill vested in their marks. The second purpose provides a way for consumers to distinguish between two competing producers. Thane Int'l v. Trek Bicycle Corp. 305

F.3d 894, 901 (9th Cir. 2002). The law protects not only the holder of the registered trademark from unfair competition, but also shields consumers from fraudulent misrepresentations of products.

Congress understands the importance in ensuring protection against infringing uses that are likely to cause confusion amongst consumers. Under the Lanham Act, a party claiming trademark infringement bears the burden of proof that the infringer's use of the mark, without the consent of the registrant, is likely *to cause confusion*, mistake, or to deceive. 15 U.S.C. § 1114(1)(a). Upon a showing of likelihood of confusion, the Lanham Act provides a list of affirmative defenses. If a party can show that the use of the name, term, or device charged to be an infringement is a use otherwise than as a mark of the party's individual name in his own business, if the individual name of anyone in privity with such party, *or of a term or devise which is descriptive of and used fairly and in good faith only to describe the goods or services of such party*, at which point the alleged infringer may assert the affirmative defense. 15 U.S.C. § 1115(b)(4)(*emphasis added*).

Despite these affirmative defenses, there are situations in which competitive uses of another's mark is permitted under the statute. A party may bring an affirmative defense of fair use to combat any allegation of infringement. Under a claim of fair use, there are two separate –yet closely related– types of fair use. The first type is a statutory defense known as “classic” fair use, which may be raised when a defendant uses a plaintiff's mark in describing the defendant's own products. The second type of fair use is known as “nominative” fair use; unlike

classic fair use, normative fair use is a judicially created defense that can be raised when a defendant uses a trademark in an attempt to describe a plaintiff's goods or services, even if the ultimate goal is to describe the defendant's product. This Court has already addressed the issue of classic fair use in its holding in KP Permanent Make-up Inc. where a permanent make-up manufacturer's competitor brought an action against a manufacturer, alleging that the manufacturer's registered "Micro Colors" mark was not entitled to protection under the Lanham Act. KP Permanent Make-up, Inc., 543 U.S. at 111 (2004). Further, this Court held that "in asserting the statutory affirmative defense of fair use to a claim of trademark infringement, a competitor has no burden to negate any likelihood that the practice complained of would confuse consumers of the origins of goods or services affected." Id. Although KP Permanent Make-up assists in assessing the application of classic fair use, this Court did not address the application of nominative fair use as an affirmative defense in infringement actions. Without a Supreme Court authority on this issue, courts have disagreed over the proper analysis of normative fair use, resulting in a circuit split on this issue.

The matter before this Court today is whether nominative fair use may be raised as a separate affirmative defense *after* the plaintiff has met its burden of showing a likelihood of confusion in a trademark infringement claim. Pattel Inc. contends that its use of Cammy Gardashyan's name and likeness falls into the category of nominative fair use and was therefore not an infringement of her trademark. Pattel Inc. concedes its use of the name Cammy Gardashyan, however,

the use was not intended to confuse or mislead, but to describe its own product. The Fourteenth Circuit was incorrect in denying Pattel the right to assert the affirmative defense of “nominative fair use” and instead incorporated a test that ignores both this Court’s prior holdings and Congress’ statutory guidelines. The Fourteenth Circuit recognizes that defendants may lawfully use a plaintiff’s trademark when doing so is necessary to describe the plaintiff’s product and does not imply the trademark owner’s false affiliation or endorsement of the defendant’s product. Additionally, the Fourteenth Circuit’s holding is flawed because it relieves the plaintiff of the burden of proving a likelihood of confusion as a prerequisite to a defendant’s assertion of the nominative fair use defense. A plaintiff must always show a likelihood of confusion before asserting a nominative fair use defense. By relieving the plaintiff of this burden, the circuit court has ignored what the Lanham Act has clearly elucidated.

The Fourteenth Circuit based their opinion on a narrow reading of this Court’s reasoning in KP Permanent Make-up, specifically regarding its application of nominative fair use, but since this Court stopped short of addressing the issue of normative fair use altogether, the foundation of this opinion is erroneous. The Fourteenth Circuit’s reasoning suggests that the use of another’s mark cannot be fair if there is any likelihood of consumer confusion. This approach to nominative fair use, as provided by the Fourteenth Circuit, unfairly imbalances the task of the parties by lessening the plaintiff’s burden in infringement assertions, thereby

stripping defendants of adequate protection in cases where they have acted in good faith when using the plaintiff's trademark.

A. A lack of consistency within the circuits has resulted in arbitrary rulings that lack uniformity and clarity, leaving the question of how best to apply a nominative fair use test unresolved.

Trademark infringement claims must first require the plaintiff to show the requisite point of likelihood of confusion. This properly balances the dual goals of protecting a party's goodwill in a trademark while simultaneously ensuring that the use of such marks will not harmfully mislead consumers. Confusion by itself is not enough to show actual infringement. Without a foundation of confusion, there is no obligation for the opposing party to raise a defense. If, however, confusion does exist, nominative fair use provides a defendant a way to show that their use of the mark is fair and therefore does not infringe on the plaintiff's expectation vested in their mark. The majority of circuits have adopted a list of factors to determine a likelihood of confusion in infringement cases, but the lack of cohesion among circuits has created an environment lacking in concrete judicial authority regarding the proper test of its application to determine nominative fair use.

In Starbucks v. Wolfe Borough Coffee Inc., the Second Circuit applied an eight factor test, adopted from Polaroid, to analyze the presence or absence of a likelihood of confusion. Starbucks Corp. v. Wolfe Borough Coffee Inc., 588 F.3d 97, 115 (2d Cir. 2009). (Citing Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961)). This Polaroid test considers the following factors: (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. See Starbucks Corp., 588 F.3d at 97 (only addressing the issue of likelihood of confusion).

Similarly, in International Information Systems Security Certification Consortium Inc., the Second Circuit expanded its likelihood of confusion analysis in nominative fair use cases by combining the Polaroid factors with the Ninth Circuit’s nominative fair use analysis. Int’l Info. Sys. Sec. Certification Consortium Inc. v. Security University, LLC., 823 F.3d 153, 168 (2d Cir. 2016). In this case, International Information Systems (“ISC”) developed a program and used the certification mark “CISSP.” Int’l Info. Sys. Sec. Certification Consortium Inc., 823 F.3d at 156. The defendant became “CISSP” certified and thereafter started a company, Security University L.L.C. (“SU”), which provided training for individuals preparing for the certification program. Id. ISC brought suit against SU for the use of the “CISSP” mark in SU’s advertisements. Id. at 157. The Second Circuit held that in nominative fair use cases, district courts were to use the Ninth and Third Circuit’s different three-factor tests, in conjunction with the Second Circuit’s Polaroid factors to determine whether there was a likelihood of consumer confusion and whether defendant’s use of the mark was fair. Id. at 168. Although the court saw no reason to replace the Polaroid factors that were already in place, they also

recognized that many of the factors were ill fit for the facts of that case, emphasizing that the Polaroid factors are not exclusive. Id. Finally, the court reasoned that even if there is a likelihood of confusion, defendant's use of plaintiff's mark may nonetheless be fair. Id.

In New Kids on the Block, two newspapers had reserved a 900 phone number designed to conduct polls asking readers to cast votes for their favorite member of the musical group "New Kids on the Block." New Kids on the Block had their own 900 number for fans to call and interact with the band or hear pre-recorded messages for a small fee. New Kids on the Block v. News America Publishing, Inc. 971 F.2d 302, 304 (9th Cir. 1992). The band filed many claims against both newspapers, alleging violation of trademark and unfair competition under the Lanham Act. New Kids on the Block, 971 F.2d at 304. The court held that the defendants were entitled to a nominative fair use defense because the newspapers' reference to New Kids on the Block was only used to the extent necessary to identify the band as the subject of their polls. Id. at 308. The court reasoned that the newspapers did not use the band's distinctive logo or anything else that was unnecessary to make the announcement intelligible to readers. Id. at 308. Finally, the court found that nothing in the announcements suggested sponsorship or endorsement by the band. Id. Furthermore, in reaching its decision, the court purported to abandon the likelihood of confusion analysis and replaced it with the nominative fair use test to determine whether the defendant's use of the plaintiff's mark was fair. *But see* PACCAR Inc. v. TeleScan Technologies L.L.C., 319 F.3d 255

(6th Cir. 2003)(Sixth Circuit has never followed the nominative fair use analysis and when given the opportunity, the court declined to adopt the Ninth Circuit's approach).

In Century 21 Real Estate Corp., a real estate company oversaw a system of franchisees operating by reference to the franchisor's trademark. Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 214 (3d Cir. 2005). Franchisees were only able to refer to themselves in conjunction with their d/b/a name, (e.g., Century 21 Smith Realty). Id. at 215. Century 21 brought an infringement claim asserting that the defendant's use of its mark was unauthorized. Id. at 216. In determining whether the defendant's use of the mark was fair, the court used a bifurcated approach analyzing both confusion and fairness, correctly distributing the burden of proof between the parties at each stage of the analysis. Id. at 232. The court held that in nominative fair use cases the plaintiff must first prove the key element of likelihood of confusion and only after that does the burden shift to the defendant to assert an affirmative defense of nominative fair use. Id. at 211. Although the court adopted the Ninth Circuit's nominative fair use analysis, it disagreed with the Ninth Circuit's distinction between classic and nominative fair use. Id. at 221. The Third Circuit correctly modified the Ninth Circuit test to provide clarification for when a defendant raises a nominative fair use defense after a showing of likelihood of confusion.

B. Nominative fair use is not an inquiry for likelihood of confusion, but rather requires its own separate analysis

The matter before this Court today addresses the circuit split regarding the application of the likelihood of confusion analysis and whether or not it deserves its own separate test, apart from the normative fair use analysis. This Court in KP Permanent Make-up Inc., held that in order to prevail on a claim for trademark infringement, there must be a showing of likelihood of confusion, the burden of which lies with the plaintiff. KP Permanent Make-up Inc., 543 U.S. at 111. Further, only after the plaintiff has met its burden will a defendant be in need of an affirmative defense. Id. In other words, if a plaintiff cannot show the key element of their prima facie case for consumer confusion, it is pointless to look any further and ask a defendant to raise a defense. The Fourteenth Circuit incorrectly stated that nominative fair use is not an affirmative defense, but is instead an inquiry into likelihood of confusion. The Fourteenth Circuit fails to recognize this Court's decision in KP Permanent Make-up Inc., which explicitly addresses the issue of classic fair use without touching on the separate issue of nominative fair use. Id. at 124, n.3. Further, the court mistakenly interprets the KP Permanent Make-up Inc. holding and lack of discourse on nominative fair use, as grounds for denying parties an affirmative defense in nominative fair use cases.

In addition, the Fourteenth Circuit not only makes the argument that nominative fair use is not an affirmative defense, but also erroneously promotes adoption of the court's own concoction of law – neither supported by the Lanham Act nor this Court's precedent— which suggests that the burden of confusion must

always remain with the plaintiff. The only semblance of support that the Fourteenth Circuit leans on is the Second Circuit's misguided analysis, which conflates the plaintiff's burden of showing a likelihood of confusion with a defendant's burden of showing that the use of plaintiff's mark was fair. Instead of combination, analysis should be separate and distinct from one another. This Court has already established in KP Permanent Make-up Inc., that there can be both a likelihood of consumer confusion and fair use by a defendant. Id. at 111. Further, this Court reasoned that likelihood of confusion and some degree of fair use must be compatible in order to prevent a party from obtaining a monopoly of a term "simply by grabbing it first." Id. at 122. In the current case, respondent is trying to do exactly what this Court directly attempted to prevent: the monopolization of a term such as "Fashionista" by Cammy Gardashyan.

It is imperative that this Court provide a firm, clear, guiding principle for the circuit courts to follow to distinguish and identify nominative fair use. One need not look further than the Ninth Circuit to see the arbitrary manner in which a court can pick and choose which test or factors they prefer to follow. In New Kids on the Block, the Ninth Circuit replaced its established likelihood of confusion test for a nominative fair use analysis. The Court reasoned that each test's factors were redundant and unnecessary in determining whether a defendant's use of a plaintiff's mark was fair. New Kids on the Block, 971 F.2d at 308. However, the Ninth Circuit failed to acknowledge that such an approach also relieves the plaintiff of their burden of definitively showing an example of consumer confusion. By

lessening a plaintiff's burden of proving the main element of trademark infringement, the Ninth Circuit does a disservice to parties who use the mark of another in good faith by disallowing an adequate defense. Dissimilarly, in PACCAR Inc. the Sixth Circuit declined to adopt the Ninth Circuit's three factor test, stating it had never adopted a nominative fair use analysis in such cases. PACCAR Inc., 319 F.3d at 256.

Considering the abundant disagreement among the circuit courts on this topic, it is clear that the Third Circuit's grasp of nominative fair use analysis is the most reasonable and advanced method of assessing trademark infringement claims. In Century 21 Real Estate Corp., the Third Circuit adopted an affirmative defense for nominative fair use cases. Century 21 Real Estate Corp., 425 F.3d at 211. The court reasoned that the likelihood of confusion analysis was separate and distinct from an inquiry as to whether a defendant's use of the plaintiff's mark is fair. Id. at 232. The Third Circuit uses a two-step approach, first requiring the plaintiff to make a prima facie case showing a likelihood of consumer confusion and then, once that element is satisfied, then allowing a defendant to rebut the plaintiff's assertions by showing a case for fair use. Id. This approach is most consistent with the language of the Lanham Act and the precedent of this Court. Since there must be a showing of consumer confusion in all trademark claims it is improper to supplement the test for infringement merely because there is a slight variation in the way in which the defendant refers to the plaintiff's mark.

Furthermore, the Fourteenth Circuit's act of improperly conflating the two analyses for likelihood of confusion and nominative fair use drastically alters the traditional litigation process for a trademark infringement claim. The fundamental purpose of trademark protection is to protect the consumer from confusing fraudulent misrepresentations of a known brand or product. Respondent should be required to definitively prove that Pattel's use of her mark is *likely* to cause consumer confusion, because without this showing, there is no infringement under trademark protection law. Furthermore, as the district court in this case held: it is only after demonstrating requisite consumer confusion that the burden shall shift to Pattel to show that the use of Gardashyan's mark is actually fair use. R. at 358. This two-step approach is the most effective and will continue to be so in future litigation; if a plaintiff is unsuccessful in meeting its burden, there will be no need to inquire further into a defendant's use of a particular mark. The Fourteenth Circuit's confusing conflation of multiple tests will undoubtedly lead to situations in which factors are improperly assessed, resulting in punishment of innocent defendants for using the mark of another, when they have actually acted in good faith. This Court has already made clear that some amount of confusion and fair use can co-exist. KP Permanent Make-up Inc., 543 U.S. at 121. To prevent the shifting of the plaintiff's burden and to ensure that good faith defendants are granted rightful protection, this Court must find that the nominative fair use test is not an inquiry into a likelihood of confusion. As this Court held in KP Permanent Make-up, the burden of showing likelihood of confusion must always remain with

the plaintiff and it is only after this is adequately shown that a defendant should be required to bring a defense.

C. The fourteenth circuit misinterpreted the plain language of the lanham act and read kp permanent make-up far too narrowly when it incorrectly precluded pattel inc. From asserting the affirmative defense of nominative fair use.

The plain language of the Lanham Act could not be clearer in its requirement of the plaintiff to make a case for a likelihood of confusion in infringement actions. The statute provides for a cause of action against a party who attempts to use a trademark in an unauthorized manner. 15 U.S.C. § 1114(1)(a) states that any person who shall, without the consent of the registrant, advertise any goods or services on or in connection with which such use is *likely to cause confusion*, or to cause mistake, or to deceive. Furthermore, the Lanham Act is clear that before a registrant will be entitled to recover profits or damages, it must be shown that the alleged infringer's acts have been committed with knowledge that such imitation is *intended* to be used to cause confusion. 15 U.S.C. § 1114(1)(b).

In this case, Petitioner never intended for its use of Respondent's name and likeness to any way cause consumer confusion when it created the "Fashionista Bambi Doll." The Bambi dolls that Pattel Inc. creates are often inspired by a combination of the "original look" of its own dolls and also by contemporary movie and television stars, musicians, and fashion models. R. at 355. Furthermore, the record clearly shows multiple instances in which Petitioner accurately placed consumers on notice that their doll has only been designed to mimic the style and look of Cammy Gardashyan. The voice of the doll in question can be activated by the

push of a button, located on its hand. Once activated, a recorded message can be heard emanating from the doll's abdomen saying, "I want to be a Fashionista just like Cammy Gardashyan." R. at 357. If Petitioner's intentions were to convince consumers that this doll was somehow endorsed or affiliated with Respondent, it would have never used the phrase "like Cammy Gardashyan" in the pre-recorded audio. If Petitioner's intentions were truly nefarious, the statement spoken by the doll would likely claim to *be* Cammy Gardashyan, rather than a statement aspiring to fit into the same category (Fashionista) in which Respondent belongs. Additionally, Petitioner's product packaging immediately discredits any allegations of infringement by overtly showing that no consumer could confuse the doll for a representation or endorsement by Respondent because it clearly draws a distinction between the identity of the doll and the identity of the Respondent. The top front cover of the package displays the name: Fashionista Bambi; the caption beneath the product name says: "I say: 'I want to be just like Cammy Gardashyan.'" R. at 357. To further extinguish allegations of Petitioner's wrongdoing and further show that consumer confusion was explicitly avoided by Petitioner, Pattel included a disclaimer on the outside packaging reading, "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan." R. at 357. Finally, Cammy Gardashyan's trademarked logo (consisting of her full name and stylized "CG" initials) were never used by Pattel – a fact further affirming that no infringement had occurred. R. at 356-57.

This Court has already resolved that the Lanham Act requires a showing of likelihood of confusion in trademark dispute actions is incontrovertible. KP Permanent Make-up Inc., 543 U.S. at 118. The Fourteenth Circuit attempted to bolster its argument by pointing to KP Permanent Make-up Inc. where it misunderstood this Court’s application in a classic fair use case for what is actually a nominative fair use matter. Additionally, the court’s opinion fails to mention proper handling of nominative fair use as an affirmative defense. Furthermore, the only actual mention of anything related to nominative fair use is in footnote three of the KP Permanent Make-up Inc. opinion, where the Court states that they decline to “address the Court of Appeals discussion of nominative fair use.” KP Permanent Make-up Inc., 543 U.S. at n.124. 124.

The Lanham Act also lays out a list of defenses that can be raised after a showing of likelihood of confusion, even though the Act does not mention the different elements of confusion used to analyze fair use. 15 U.S.C. § 1115(b)(4). If read properly, the Fourteenth Circuit could have deduced that the Lanham Act does provide an affirmative defense that applies in situations like the facts of this case – when a trademark is used fairly and in good faith only to describe the goods and services of the plaintiff. Id. We are befuddled at how the Fourteenth Circuit can fail to apply an affirmative defense that is so clearly laid out for classic fair use, and strip Petitioner’s right to protection merely on a technicality that fails to show any merit when looking at the uses ultimate purpose. This judicially created

“nominative” label was never intended to withhold a good faith user from the ability to explain why their use is actually fair.

As previously stated, courts have distinguished two types of fair use: (1) classic fair use – where the defendant has used the plaintiff’s mark to describe the defendant’s own product, and (2) nominative fair use – where a defendant has used the plaintiff’s mark to describe the plaintiff’s product usually in cases of competitive or comparative advertising. Cairns v. Franklin Mint Co. 292 F.3d 1139, 1150 (9th Cir. 2002). The Ninth Circuit provides two reasons for drawing a distinction between the two uses: “(1) classic and nominative fair use are governed by different analyses; and (2) the classic fair use analysis only complements the likelihood of customer confusion analysis.” New Kids on the Block, 971 F.2d at 306. The Ninth Circuit erroneously believes that only a classic fair use analysis, not extended to nominative use, complements the likelihood of customer confusion analysis, whereas the nominative fair use analysis *replaces* the likelihood of confusion analysis. Id. at 308. However, whether Petitioner is using Respondent’s mark to describe its own product or whether it is using Respondent’s mark to describe Respondent’s product makes no difference as to the ultimate finding of likelihood of confusion. The use is either fair or it is not.

This Court has already guided us to the conclusion that a showing of likelihood of confusion and fair use can coexist in a *classic* fair use case – where a plaintiff’s mark is used to describe a defendant’s product. If this is true, why should any less protection be extended to a party whose use is no less fair and the only

difference is that the plaintiff's mark is used to describe the plaintiff's good? It is undoubtedly clear that the ultimate goal is to describe the defendant's product – the mode of doing so should be of no consequence in analyzing the fairness of the use.

Furthermore, Petitioner's use of the mark is unquestionably fair because it only the smallest amount of the mark necessary to convey the idea – in the form of a mere reference to Respondent. There is no other practical or logical manner in which Petitioner, or anyone else, may make reference of Cammy Gardashyan than to use her name. To give Respondent such rights that were never granted nor created by this Court or Congress would go against centuries worth of precedent and case law. If Congress had intended for nominative fair use to be distinguishable and therefore require a completely different analysis than classic fair use, why has Congress not made this distinction explicitly clear in the statute? It is unreasonable to believe that Congress failed by accident to explicitly lay out two different types of approaches for the two types of fair use. The Fourteenth Circuit cites Russello v. United States, where the court stated, "Where 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 purposefully* in the disparate inclusion or exclusion." Russello v. United States, 464 U.S. 16, 23 (1983). The Fourteenth Circuit justified their flawed logic on the condition that since the Lanham Act makes no mention of nominative fair use as an affirmative defense, the court has the authority to decide the proper application of the defense. Nominative fair use, unlike classic fair use, is a judicially created doctrine. It is unreasonable to

expect Congress to have prepared a statutory regulation regarding judicial doctrine that had originated in the courtroom. Based on this reasoning, the Fourteenth Circuit could craft a third or even fourth type of fair use that ultimately would end in the same result as its predecessors, simply because Lanham is silent on the possibility of future judicially created concepts. Further, in this scenario, the court could prevent a party from raising an affirmative defense that this Court and Congress clearly intended for that party to have.

Pattel Inc. has been in the business of producing and creating a wide variety of products including those at issue today: Bambi dolls. To reiterate, the Bambi dolls that Pattel has created draw inspiration from many sources, including current movie and television stars, musicians, and fashion models. Cammy Gardashyan is known nationwide as a television personality, socialite, business woman, model, and singer. Although she has released a variety of products tied directly to her mark, dolls are not featured among her products. Petitioner concedes that Gardashyan's trademark is vital to protecting her personal brand and line of goods, including jewelry, clothing, cosmetics, perfumes, handbags and footwear – all of which bear the Gardashyan name and mark and none of which specifically target the toy market. It is clear that Cammy Gardashyan and Pattel are not competitors, since their channels of focus are entirely different and do not overlap. This unquestionably indicates that there cannot be any likelihood of consumer confusion. The Fourteenth Circuit is threatening to restrain Pattel's trade and well-established product designs simply because Cammy Gardashyan's trademark logo

explicitly includes her name. Pattel has not used the CG logo, but merely stated the Respondent's name which *happens to be* a part of her registered trademark. Clearly, there is no other way for Pattel to reference this television personality other than to use her name. Allowing Respondent to restrict the use of any unauthorized platform that bears reference to her name would cause a chilling effect on the free market, thereby setting a precedent that would regrettably stifle innovation and creation by good faith producers in society.

For the aforementioned purpose, we ask that this Court adopt a nominative fair use test under §1114 of the Lanham Act to analyze Petitioner's use of Respondent's mark made in reference to the Respondent. We believe that this Court should grant, as it has for classic fair use cases, the ability for Pattel to raise an affirmative defense of fair use, despite a finding a likelihood of confusion. Accordingly, this Court should affirm in part the judgment of the district court for the Central District of Bel Air when it adopted a two-step approach, holding that Pattel Inc. is entitled to a nominative fair use defense for its references to Cammy Gardashyan to describe its Cammy Gardashyan inspired products, regardless of there being a finding of likelihood of confusion and using that fair use as an affirmative defense.

ii. The Proper Application Of A Nominative Fair Use Test Is One Which Follows This Court's Precedent In Classic Fair Use Analyses.

The Fourteenth Circuit, although flawed in approach, was correct in looking to the Polaroid factors for a determination of likelihood of confusion. Where their methodology falls short is their conflation of both the Polaroid factors and the

nominative fair use test. In Polaroid Corp. v. Polarad Elecs. Corp., the Second Circuit laid out an eight-part test to determine whether *actual* consumer confusion had occurred. Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 495 (2d Cir. 1961). The court's eight factor test, which has stood the test of time, consists of: (1) the strength of the mark; (2) the degree of similarity between the two marks; (3) proximity of 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) the quality of defendant's product; (8) sophistication of consumers in the relevant market. Polaroid, 287 F.2d at 495. Although the circuits have used different tests to begin a likelihood of confusion analysis, this Court should adopt a variation of the Polaroid factors to establish a sound starting point for future litigation. See Interpace Corp. v. Lapp Inc., 721 F.2d 460, 463 (3d 1983). The Fourteenth Circuit incorrectly and hastily applied all eight factors instead of subjectively analyzing the factors and joining them to the facts of this case. As the Third Circuit did in its likelihood of confusion analysis in Century 21 Real Estate Corp the Court should exclude the first two Polaroid factors. Century 21 Real Estate Corp. 425 F.3d at 224. As the Third Circuit has already observed the first two factors deserve no special focus or analysis in nominative fair use cases. Id. The first factor, the strength of the mark, is inappropriate on its face when used in a nominative fair use analysis. It goes without saying that a party trying to make reference to the mark of another would

likely only need to do that if that mark was reasonably strong; as the court stated, “in reality... the use of the name may be the only way for [a] defendant to easily and precisely refer to plaintiff’s product in a way that will be understood by consumers.” Id. at 224. The second factor, similarity of the marks, will automatically lead to a finding that there is a likelihood of confusion since the mark is not only similar, but identical. Id. The Third Circuit reasoned that there should be room in the analysis to consider the context of the mark’s use, focusing not on whether the defendant is trying to pass off the plaintiff’s mark as his own, but instead questioning if the mark is being used to describe the plaintiff’s product; this is an essential element in a finding of consumer confusion. Id. at 225. The first two factors of the Polaroid test are only appropriate when used in a *classic* fair use case, where it is necessary to evaluate the similarity between the defendant and plaintiff’s mark; in that particular scenario, unlike the facts of this case, the defendant is attempting to pass off the plaintiff’s mark as his own. Id.

If this Court followed the Fourteenth Circuit and applied the first two factors to this case, there would be no dispute by Petitioner that Respondent’s mark is, in fact strong. Of course, Pattel also does not dispute that there is similarity between the marks, as the doll’s packaging clearly states that the doll wants to be “like Cammy Gardashyan,” further clarifying our above position that any court applying the first two factors would automatically find a showing of consumer confusion. Such a finding would effectively do nothing more than result in a false positive, since the

mere referencing of another user's product does not allow us to jump immediately to a finding of consumer confusion.

A. The likelihood of confusion analysis deserves its own separate and distinct treatment before any discussion in regards to the nominative fair use test.

As previously mentioned, we ask this Court to exclude the first two Polaroid factors. A legal phenomenon such as the subjective inquiry of likelihood of confusion cannot be so easily identified through a "one size fits all" analysis. The six remaining factors that we ask this Court to use are intended as a starting point, rather than an end goal, into the inquiry of potential consumer confusion. This Court, in its wisdom, should use these six factors and apply them to the Petitioner's case in the following manner.

Factor 1: Proximity of the Products and Competitiveness of the Parties

Although Respondent has used her fame and capitalized on her success with an impressive line of products including jewelry, clothing, cosmetics, perfumes, handbags and footwear. R. at 356. Respondent has yet to design, create, and produce anything remotely resembling a doll. Over the course of five decades Petitioner has built up its own level of recognition and popularity within the toy industry – a market entirely untapped by Respondent. R. at 355. Petitioner however, does not create nor market any of the same products that Respondent currently has in her portfolio. Since Cammy Gardashyan does not have a doll, or any other product remotely similar, this Court should find that there is no

possibility for proximity, confusion, or competition between Gardashyan's products and that of Pattel's Fashionista Bambi Doll.

Factor 2: Evidence That the Senior User May “Bridge the Gap”

Petitioner concedes that Respondent is an incredibly well-known television personality whose name and likeness have afforded her the ability to monetize her fame in the form of successful products. Respondent suggests that somehow Petitioner's doll forecloses any potential ability of Cammy Gardashyan one day creating her own doll. There is nothing in the record that shows that Respondent has ever desired, researched, or attempted to create a “Cammy Gardashyan” figurine or doll. Respondent wants to preclude any bona fide producer from ever making any type of product that may nominatively reference her name and likeness. Respondent's desire is completely contrary to a number of circuits' holdings in regards to this specific type of reference. The Third Circuit, has already stated that the Lanham Act does not compel a competitor to resort to second-best communication. G.D. Searle & Co. v. Hudson Pharmaceutical Corp., 715 F.2d 837, 843 n.12 (3d Cir. 1983). In G.D. Searle & Co. v. Hudson Pharmaceutical Corp., plaintiff manufactured a vegetable laxative, psyllium hydrophilic mucilloid called Metamucil. G.D. Searle & Co. Hudson Pharmaceutical Corp., 715 F.2d at 838. This product was incredibly successful and compiled \$275,000,000 in sales. *Id.* Three decades later, defendant began producing its own psyllium hydrophilic mucilloid, Regacilium. *Id.* Plaintiff alleged trademark infringement due to defendant's use of a similar cylindrical shaped bottle, embellished with defendant's logo, printed on a

green and white stylized background, similar to the style used by Metamucil. Id. at 839. The Regacilium bottle also included a reference to plaintiff by including the phrase, “Equivalent to Metamucil.” Id. The court held that “one is not barred from making reference on its own product packaging to a competitor’s product.” Id. at 837.

Unlike in G.D. Searle, where the alleged infringer replicated the plaintiff’s product and its packaging style completely, here, no package exists to imitate, as Respondent does not even manufacture toy dolls. Furthermore, there is no concern that Cammy Gardashyan is precluded from creating her own doll, because Petitioner’s product packaging merely states, “I want to be just like Cammy Gardashyan,” which leaves ample room for Cammy Gardashyan herself to create a doll that may be even more successful than the Fashionista Bambi. R. at 357. Her “vast online and social media presence” and her tens of millions of fans on Fanbook, Witter, and Delaygram is a resource that Petitioner could never dream of having access to when it created the Fashionista Bambi Doll. R. at 356.

Factor 3: Evidence of Actual Consumer Confusion

Unlike in Starbucks Corp., where a coffee manufacturer’s telephone survey found that roughly 30% of respondents “immediately thought of ‘Starbucks’” upon hearing the defendant’s name “Charbucks,” our record indicates no evidence of actual consumer confusion presented to this Court by Respondent. Starbucks Corp., 588 F.3d at 117. Petitioner concedes that the mere lack of evidence presented in support of this factor for Respondent does not preclude a finding of likelihood of

consumer confusion. As mentioned earlier these factors are not designed to be applied mechanically nor should they constitute an exhaustive list.

Factor 4: Evidence that the Imitative Mark was Adopted in Bad Faith

There is ample evidence in the record to show that Pattel Inc. did not intend to suggest endorsement or sponsorship by Cammy Gardashyan by merely referring to her name on their product's packaging. Pattel explicitly included a disclaimer on the outside of the box that read, "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated by Cammy Gardashyan." Furthermore, Pattel did not use Cammy Gardashyan's full logo which consists of a stylized "CG" displayed back to back with the words "CAMMY GARDASHYAN" underneath, but instead merely used her name – the most direct platform to identify a public figure such as Respondent. It is worth reiteration that Respondent's primary complaint in this case is the language on the top front cover of the product packaging featuring a caption bubble which reads, "I say: I want to be just like Cammy Gardashyan," since there is not a single other reference to Respondent anywhere else on the product's packaging. R. at 357. If Petitioner had acted in bad faith, a reasonable person could assume that the word "like" would have been omitted and a phrase would have simply read something such as, "I say: I am Cammy Gardashyan and I am a Fashionista!!" Surely, the latter slogan would suggest endorsement or sponsorship by Gardashyan herself – unlike the actual slogan, as used by Petitioner in good faith.

Factor 5: Respective Quality of the Products

In Starbucks Corp., the court determined both Starbucks and the Charbucks line of products were high quality coffee, rejecting Starbuck's theory that such a finding of "comparability of goods" would favor Starbucks in the analysis of likelihood of confusion. Here, there is no issue regarding the respective quality of the products, since the record is clear that Respondent does not in fact manufacture toy dolls. Starbucks Corp., 588 F.3d at 118.

Factor 6: Sophistication of Consumers in the Relevant Market

This final Polaroid factor examines the sophistication of the consumers in the relevant market. The record is silent as to whether or not consumers of both Petitioner and Respondent's distinctively different products are sophisticated – this is a purely subjective inquiry. However, the record does state that amongst Pattel's wide range of consumers, they commonly attract older customers who purchase the Bambi dolls as collectibles. R. at 355. Furthermore, this same batch of customers would likely be aware of Pattel's traditional business practices of seeking inspiration from modern-day movie and television stars, musicians, and fashion models. The dolls are known to reflect modern social values, most importantly by conveying the characteristics of female independence through the depiction of inspirational women known throughout popular culture. R. at 355. These same collectors can identify the distinction between Cammy Gardashyan's characteristics used on the doll from any implication that the doll is endorsed or sponsored by, or otherwise affiliated with Gardashyan. Absent these collectors, whose sophistication

can be inferred, it is too great a leap to ask this Court to assume that *all* of Pattel's consumers are equally sophisticated.

Where there are two similar products in competition, analyzing the sophistication of the buyers is relevant to a finding of a likelihood of confusion. We do not believe that this factor deserves any increased weight because, as discussed previously, this sophistication should only be considered where the specific facts of a case invite such an inquiry. Here, this kind of inquiry would be futile. An attempt to compare Petitioner and Respondent's dissimilar products and the sophistication level of their consumers—who are likely not even the same type of customers—would be a fruitless endeavor.

B. Providing defendant the right of an affirmative defense through a separate nominative fair use analysis upholds the framework established by the lanham act and precedent established by the supreme court.

Statutory guidance combined with the case law of this Court and other circuits confirms that a showing of a likelihood of consumer confusion is necessary to satisfy a claim for trademark infringement. In the judicial system, if a plaintiff cannot prove the elements of its prima facie case, the case is dismissed without ever requiring a defendant to raise an affirmative defense. Proving the prima facie case—here, a likelihood of confusion— is required to be shown before the defendant need ever raise an affirmative defense. This test evaluates nominative fair use cases and is designed to address the risk that a minor use of a mark will inspire an unfounded belief on the part of the consumer that the alleged infringer, in this case, Petitioner, is somehow sponsored or endorsed by the trademark holder. The Fourteenth Circuit

holds steadfast in its beliefs that a separation of the analysis would provide Petitioner broader protection by allowing Pattel, Inc. to bring forth the nominative fair use defense even if a likelihood of confusion has been established. R.-361. Furthermore, the Fourteenth Circuit erroneously believes that such a practice would give Petitioner a “second bite of the apple.” *Id.* Both the Ninth and Second Circuits are at odds with one another regarding the proper fair use analyses in Nominative cases, yet the Fourteenth Circuit leans on them when creating its own test.

As earlier discussed, the Fourteenth Circuit erroneously believes that nominative fair use is an inquiry into likelihood of confusion, but this thinking is flawed. The Fourteenth Circuit’s test unfairly balances the resources available for the plaintiff and defendant in this infringement inquiry by forcing defendants to negate confusion as the only way to show that their use was, in fact, fair. We urge this Court to adopt the Third Circuit’s three-prong test as detailed below.

1. Is the use of plaintiff’s mark necessary to describe: (1) plaintiff’s product or service; and (2) defendant’s product or service?

The Fourteenth Circuit requires an examination to find whether Respondent’s product must be described when using her “Cammy Gardashyan” mark and whether use of that mark is necessary to accurately describe what Petitioner sells, or whether its reference to Respondent’s mark is actually gratuitous. We replace this factor by asking whether Gardashyan’s mark is necessary to describe: (1) Cammy Gardashyan; and (2) Petitioner’s Fashionista Bambi Doll.

Here, it is exceedingly difficult to describe Gardashyan without the use of her name. Without such reference, Petitioner is left with the daunting task of describing Respondent's mark by her style and characteristics alone – features which, in isolation, are not easily identifiable. For Petitioner to advertise on the exterior product packaging using a slogan reading, “I say: I want to be just like the girl with long, black hair and that curvy figure” is not only confusing and uninteresting to the consumer, but would not be nearly as effective as a mere nominative reference to her name alone.

2. Is only so much of the plaintiff's mark used as is necessary to describe the defendant's products or services?

Petitioner concedes that the Fourteenth Circuit's approach to the second prong is appropriate. The court departed from the Ninth Circuit's language and adopted the Third Circuit's second prong when it formulated its nominative fair test. The court relied on the Third Circuit's reasoning that the Ninth Circuit's assessment as to defendant's “need” to use the plaintiff's mark would be decided after completion of the first prong. Century 21 Real Estate Corp., 425 F.3d at 230. Under this approach we will “eliminate the confusion inherent in inquiring into “need” at the second step.” Id.

Here, Gardashyan's mark consists of a stylized “CG” displayed back to back and the words “CAMMY GARDASHYAN” appearing below. R. at 356. However, Petitioner did not use this logo explicitly or any variation of the logo, but instead, only used the smallest amount of Respondent's mark that was reasonably necessary to convey the design idea – the amount used was so trivial that it simply referenced

the television reality star and public figure by her name. R. at 357. Petitioner did not use the stylized “CG” that Respondent uses on her line of products and thus damaging the credibility of a potential claim for infringement.

3. Does the defendant’s conduct or language reflect the true and accurate relationship between plaintiff and defendant’s products or services?

The third prong of the Fourteenth Circuit’s test analyzes a defendant’s failure to state or explain an aspect of the relationship of the parties; where a disclaimer exists, the court determines whether the infringer’s portrayal of the relationship between plaintiff and defendant is indeed accurate. We suggest replacing this factor with an inquiry into whether Pattel’s conduct or language reflects the true and accurate relationship between Gardashyan and Pattel’s Fashionista Bambi doll. Like the Third Circuit, we believe the appropriate question as to this final factor should be a bit broader. Century 21 Real Estate Corp., 425 F.3d at 231.

The Ninth Circuit, who developed the nominative fair use test in New Kids on the Block, requires that “the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.” New Kids on the Block, 971 F.2d at 308. We believe that the Fourteenth Circuit was correct when it found that the Ninth Circuit’s third prong was inadequate, because a focus on suggestion of sponsorship alone may possibly indicate that infringement of a mark has occurred, when in reality, it has not. In other words, in a situation where a plaintiff has endorsed a defendant’s product, a court will need to assess the

appropriate degree of the mark's use in order to determine whether infringement has indeed occurred.

Here, Petitioner's conduct and product clearly never implied that Cammy Gardashyan has in any way sponsored, endorsed, or affiliated herself with Pattel, Inc. On the front cover of the doll's packaging, a caption bubble reads: "I say: I want to be just like Cammy Gardashyan." R. at 357. This language does nothing more than accurately show that Petitioner's doll is merely seeking to emulate the characteristics and style of Cammy Gardashyan – a style that is very influential and easily recognizable in society today. Furthermore, by focusing on the top front cover of the doll's packaging—when Petitioner has the greatest opportunity to exceed the fair use threshold—Pattel, Inc. chose to simply illustrate the name "Fashionista Bambi." R. at 357. Also featured on the exterior of the box is a fully legible statement explicitly indicating that Cammy Gardashyan's name and image are *not* affiliated with Pattel, Inc. in any way through a statement which reads: "Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan." Id. This explicitly contradicts Respondent's argument that a consumer would likely confuse the product's endorsement by Respondent.

CONCLUSION

This Court should reverse the judgment of the Court of Appeals for the Fourteenth Circuit and remand with further instructions on the proper adoption of a nominative fair use test in a trademark infringement action under §1114 of the Lanham Act.

Respectfully Submitted,

/s/ Team 104