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No. 16-1225

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IN THE SUPREME COURT OF THE UNITED STATES

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PATTEL, INC.,

Petitioner,

v.

CAMMY GARDASHYAN,

Respondent.

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On Writ of Certiorari to the Fourteenth Circuit Court of Appeals

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**BRIEF FOR RESPONDENT**

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**ORAL ARGUMENT REQUESTED**

## **QUESTIONS PRESENTED FOR REVIEW**

1. Whether the Court should allow for fair use to be asserted as an affirmative defense when the use in question is nominative rather than descriptive, and, if not, whether the Court should use an existing test for nominative fair use or develop an entirely new one.
2. Whether the Court should use the nominative fair use test articulated by the Third Circuit or use a different test, and whether that test, when applied to our facts, proves infringement or fair use.

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## **OPINIONS BELOW**

The District Court for the Central District of Bel Air granted Petitioner's motion for summary judgment, holding that Petitioner's use of Respondent's mark constituted nominative fair use. R. at 358. The United States Court of Appeals for the Fourteenth Circuit reversed the District Court's Order granting summary judgment and remanded the case for further proceedings. R. at 365. The Supreme Court of the United States granted certiorari.

## **STATEMENT OF JURISDICTION**

The Supreme Court has jurisdiction over this matter pursuant to 28 U.S.C. §1331 and 28 U.S.C. §1254(1).

## **STATUTORY PROVISIONS**

The adjudication of this case involves the potential application of 15 U.S.C. § 1114 to trademark infringement cases involving nominative use.

## STATEMENT OF THE CASE

Respondent, Cammy Gardashyan (“Gardashyan”), is a world-renowned “reality television star, socialite, businesswoman, model, and singer.” R. at 356. Gardashyan’s successful career has earned her tens of millions of fans from around the world, which can be seen by her extraordinary popularity on social media including Fanbook, Witter, and Delaygram with followers from all ages. *Id.* Gardashyan’s mark, “CG CAMMY GARDASHYAN,” is a protected trademark associated with the goods and services she produces and provides under her personal brand. *Id.* Gardashyan’s mark consists of a stylized “CG” with her name “CAMMY GARDASHYAN” appearing underneath in capital, block letters. *Id.* Millions of consumers purchase items bearing Gardashyan’s name and mark, such as “jewelry, clothing, cosmetics, perfumes, handbags, and footwear,” which profited over fifty millions dollars in 2015 alone. *Id.*

Gardashyan’s popularity consistently lands her in headlines of major magazines, entertainment news websites, television shows, and other outlets. *Id.* Gardashyan’s signature style, praised by leading fashion magazines and fans alike, consists of “animal prints, knee-length skirts and dresses, and shiny high-heeled shoes.” *Id.* Gardashyan is also recognized for her distinctive long, black hair, often wearing it down and straight. *Id.* This distinctive, signature style is routinely portrayed by the entertainment media and widely recognized by consumers around the world. *Id.*

Petitioner, Pattel Inc. (“Pattel”), manufactures the popular Bambi Fashionista doll, of which five hundred million have been sold. *Id.* at 355. Each year Pattel creates a new Bambi doll that mimics the “original look” of an influential woman in film, television, music, or fashion. *Id.* Because of Gardashyan’s influence, Pattel designed its 2015 Bambi doll after Gardashyan. *Id.* at 357. The 2015 doll portrays Gardashyan’s signature style, wearing a “leopard print top, knee-length skirt, and sparkly high-heeled shoes” and “long, black, straight hair.” *Id.* The doll also says, “I want to be a fashionista, just like Cammy Gardashyan.” via digital recording. *Id.* Pattel referenced Gardashyan and consciously used her protected trademark on its Bambi doll packaging, particularly in large, twenty-point font on the front of its box. *Id.*

### **COURSE PROCEEDINGS AND DISPOSITION IN THE COURT BELOW**

Gardashyan brought suit against Pattel for trademark infringement on February 9, 2015. *Id.* Pattel filed for summary judgment, claiming nominative fair use. *Id.* The district court granted Pattel’s motion dismissing Gardashyan’s claim, and Gardashyan appealed. *Id.* The appellate court reversed the Order of the district court, holding that the district court erred in its analysis of the nominative fair use defense. *Id.* at 365. The Supreme Court granted certiorari.

### **SUMMARY OF THE ARGUMENT**

Nominative fair use differs from classic fair use in that the alleged infringer uses the protected mark to describe the *plaintiff’s* product rather than the

*defendant's* product. As such, nominative fair use as a defense does not operate in the same way that fair use as a defense in classic fair use cases does—that is, it cannot be asserted as an affirmative defense because it does not fit the language of the Lanham Act. Therefore, this Court should analyze whether Pattel's nominative use of Gardashyan's mark was fair in the light of a likelihood of confusion analysis. In doing so, it is critical to consider Pattel's intent, the amount of the mark used, and how "distant" they were when using the mark.

This Court should adopt the express language of the Third Circuit's nominative fair use test as articulated in *Century 21*. The language articulated in the Third Circuit nominative fair use test should be adopted because it is the strictest test offered by any court. Since nominative fair use is neither an affirmative nor statutory defense, both the test and analysis for achieving the so-called "defense" should be strict and narrowly construed. Further, this Court should adopt the *Century 21* nominative fair use test because the three factors are straightforward and relatively easy to apply. However, this Court should not follow the Third Circuit's application of its nominative fair use test. Rather, the three-factor test should be applied as a separate test for analyzing likelihood of confusion, with the burden remaining on the Plaintiff. When the facts are viewed in the light of a likelihood of confusion analysis, this Court will find in favor of the Respondents.

In the alternative, Respondent urges this Court to adopt a substitutive likelihood of confusion test for nominative fair use cases. Instead of trudging through the traditional eight-factor *Polaroid* analysis, or the appellate court's

eleven-factor test, Respondent suggests that this Court adopt a more precise analysis. Respondent proposes an alternative six-factor test, which focuses on likelihood of sponsorship, source, and endorsement confusion while dismissing immaterial factors to nominative fair use fact patterns.

## ARGUMENT

### **I. NOMINATIVE FAIR USE CANNOT BE RAISED AS AN AFFIRMATIVE DEFENSE AND WHEN IT IS PROPERLY ANALYZED IN THE LIGHT OF LIKELIHOOD OF CONFUSION, THIS COURT SHOULD FIND PETITIONERS LIABLE FOR INFRINGEMENT.**

To show trademark infringement under 15 U.S.C. § 1114(1), also known as the Lanham Act, a plaintiff must show that the defendant's use of the allegedly infringing trademark "is likely to cause confusion, or to cause mistake, or deceive." Circuit courts have often applied multi-prong tests to determine whether a likelihood of confusion exists. However, a finding of a likelihood of confusion does not mean that the defendant's use of the mark is abject trademark infringement.

The "Fair Use" doctrine allows, in certain situations, for a finding that a defendant's use of a trademark may well be an infringement, but allowable under the law nonetheless. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 123 (2004). Two types of fair use have been articulated by the courts: classic fair use, and nominative fair use; however, only classic fair use falls under the language of the Lanham Act. In classic fair use cases, "the defendant has used the plaintiff's mark to describe the defendant's *own* mark" *New Kids on the Block v. News America Publishing, Inc.*, 971 F. 2d 302 (9<sup>th</sup> Cir. 1992). In nominative fair use cases, however, the defendant uses the plaintiff's mark to identify "not the defendant's goods or services, but the plaintiff's goods or services." 4 McCarthy on Trademarks and Unfair Competition § 23:11 (4<sup>th</sup> ed.) In other words, if the defendant's use of the plaintiff's mark is the most informative way to describe the goods or services referenced, then the use would be allowed as nominative fair use.

The factors considered in classic fair use cases are laid out in the Lanham Act: “(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107. The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.” *Id.* While these factors make for a good test in classic fair use cases, nominative fair use is more complex because the defendant is using the mark to describe the *plaintiff’s* mark, and oftentimes, as is the case here, the defendant’s use of the mark can be construed as describing both the defendant and plaintiff’s product.

A nominative fair use defense is designed to avoid situations in which an individual or corporation is prevented from describing something because its name is trademarked, for “[i]f the trademark holder were allowed exclusive rights in such use, the language would be depleted in much the same way as if generic words were protectable.” *New Kids*, 971 F. 2d 302 at 306. Because Pattel’s use of Gardashyan’s mark is used to describe both the defendant’s and the plaintiff’s mark, the classic fair use analysis will not suffice. Therefore, this Court must apply further analysis in determining if Pattel’s nominative use of Gardashyan’s constitutes infringement.

**A. Nominative Fair Use Does Not Arise out of the Language of the Lanham Act and should be viewed in the Light of Likelihood of Confusion.**

The Lanham Act (15 U.S.C. § 1114) applies when a defendant has allegedly infringed on a trademark held by a plaintiff for the purpose of advancing or marketing the defendant's own product. The Supreme Court has only acknowledged classic fair use as an affirmative defense, not nominative fair use. Much in the way the classic fair use defense developed in the courts, cases dealing with nominative fair use as a defense have been cropping up across our federal court system. Because no statutory authority for using nominative fair use as an affirmative defense exists, we must develop and utilize a universal test in the courts.

The Lanham Act explicitly states that descriptive fair use (classic fair use) is an affirmative defense, explaining that if the registered mark is being used, so as to misrepresent the source of the goods or services on or in connection with which the mark is used, it is subject to a defendant's affirmative defense(s). 15 U.S.C. § 1115 (b)(3); 15 U.S.C. § 1115 (b)(4). If Congress also wanted to make nominative fair use an affirmative defense, they would have done so, and "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 (1983). The Circuit Court correctly held that nominative fair use does not fall within 15 U.S.C. § 1115 (b) (4)'s language because it is not the "use of a name, term, or device otherwise than as a mark which is descriptive of and used merely to describe the goods or services of the alleged infringer;" conversely, nominative fair use occurs when the mark at issue is used to describe the alleged infringer's goods or services because there is no better alternative but using the plaintiff's mark.

Because nominative fair use is not specifically provided for by statute, courts may find classic fair use despite proof of infringement because the Lanham Act, specifically 15 U.S.C. § 1115(b)(4), authorizes that result. Nominative fair use, on other hand, represents a finding of no liability under that statute's basic prohibition of infringing use pursuant to 15 U.S.C. § 1114. *Toyota Motor Sales, U.S.A., Inc. v Tabari*, 610 F.3d. 1171 (9th Cir. 2010) . Trademark law also seeks to prevent the dilution of a particular trademark, and “‘fair use,’ though not so labeled in the statute, essentially amounts to an affirmative defense against a claim of trademark dilution.” *KP Permanent Make-Up*, 543 U.S. 111 at 117-18. However, “[t]he contours of the fair-use defense in the infringement context are therefore instructive on the classic or descriptive fair-use defense to a dilution claim.” *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 149 (4th Cir. 2012). Once again, articulated here by the Fourth Circuit, fair use as an affirmative defense is only applicable in classic fair use cases, for extending the classic fair use affirmative defense to nominative use cases would be inherently ineffective because a defendant in a classic fair use case is defending its use of a protected mark as fair based on statutory language; whereas, no such language exists for nominative fair use.

Defendants should not be able to raise nominative fair use as an affirmative defense. Rather, in determining whether a defendant can successfully avoid liability because their nominative use is fair should be determined by using an adjusted likelihood of confusion analysis. This way, the burden of proving a likelihood of confusion and an unfair nominative use of the mark lies solely on the plaintiff.

Allowing a defendant to affirmatively defend itself against a proving a likelihood of confusion would be redundant and senseless:

It would make no sense to give the defendant a defense of showing affirmatively that the plaintiff cannot succeed in proving some element (like confusion); all the defendant needs to do is to leave the factfinder unpersuaded that the plaintiff has carried its own burden on that point. Nor would it make sense to provide an affirmative defense of no confusion plus good faith, when merely rebutting the plaintiff's case on confusion would entitle the defendant to judgment, good faith or not.

*KP Permanent Make-Up, Inc.*, 543 U.S. 111 at 114.

The Circuit Court correctly held that the District Court erred when it allowed Pattel to assert nominative fair use as an affirmative defense. R. at 359. It noted the aforementioned distinctions between classic and nominative fair use, its lack of fitness within the Lanham Act, and Pattel's misinterpretation of the Supreme Court's holding in *KP Permanent Make-Up* given that the Supreme Court addressed only classic fair use as an affirmative defense in that case. R. at 359, 360.

The Ninth, Second, Third, Fourth, and Fourteenth Circuits have all held that nominative fair use should be part of the likelihood of confusion test, which considers the *Polaroid* factors, with additional factors specific to nominative fair use being added to the standard likelihood of confusion test. The standard considerations (the *Polaroid* factors) for determining if there is a likelihood of confusion are eight factors that are weighed to make a determination about whether an alleged infringer's use of the protected mark was fair. *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009).

Those factors are weighed by the courts in making a likelihood of confusion determination; however, the Ninth, Second, Third, Fourth, and Fourteenth circuits all agree that additional analysis is needed in nominative use cases.

**B. Because the Lanham Act does not provide for Nominative Fair Use as an Affirmative Defense, the Court should use the Trademark Principles Developed by Case Law.**

It remains the fact that, in trademark infringement cases, “[t]he central inquiry is whether there is a ‘likelihood of confusion,’ a ‘likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.’” *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 502 (2d Cir. 1996). Therefore, the Court must adopt a test for nominative fair use that still effectively analyzes the likelihood of confusion, while, at the same time, allowing for a defendant to be relieved liability if the plaintiff cannot satisfy that test.

The Court must consider additional factors when dealing with this sort of nominative use. Unlike the classic fair use doctrine, which defendants largely apply as an affirmative defense, the Fourteenth Circuit correctly held that in cases dealing with such nominative use, the main question is one of likelihood of confusion rather than an affirmative defense. R. at 360. To hold otherwise would be counterintuitive to the principles of the Lanham Act as well as this Court’s holding in *KP Permanent Make-up, Inc.* This Court, in *KP Permanent Make-up Inc.*, determined that classic fair use is available as an affirmative defense; however, it

did not address whether nominative fair use should be available as an affirmative defense. *Id.* at 115 n.3.

To prove trademark infringement, a plaintiff must prove that such use is likely to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. § 1114(1). This Court in *KP Permanent Make-Up* stopped short of saying that nominative fair use is not an affirmative defense; however, several circuits, including the Fourteenth, Second, and Ninth Circuits have held just that. *See Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 156 (2d Cir. 2016) (“nominative fair use is not an affirmative defense to a claim of infringement under the Lanham Act”). These Circuits are correct in their holding that nominative fair use cannot be an affirmative defense because it falls outside the language of the Lanham Act.

**C. Because Nominative Fair Use cannot be Raised as an Affirmative Defense, the Court should Utilize a Likelihood of Confusion Analysis which Proves Petitioner’s Use of the Mark was Infringement.**

Trademark infringement can exist not only when there is a likelihood of confusion as to the *source*, but infringement can also exist when there is a likelihood of confusion as to the sponsorship, affiliation, or connection as to the mark’s connection with the product. McCarthy § 23:76 (emphasis added). This is the case here. Pattel’s use of Gardashyan’s mark is nominative because the use of the mark is the use of her name. When this occurs, a defendant is allowed “to use a plaintiff’s trademark to identify the plaintiff’s goods so long as there is no likelihood of confusion about the source of the defendant’s product or the mark-holder’s

sponsorship or affiliation.” *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 102 (2d Cir. 2010).

The traditional factors used in determining a likelihood of confusion in classic fair use cases are often difficult to apply, or incorrectly applied by the courts; therefore, this Court has even more incentive of scrapping the use of those factors in nominative use cases. In *New Kids*, the Ninth Circuit applied their own test to determine the existence of nominative fair use which considers whether the product is identifiable without the use of the trademark, whether the alleged infringer used also as much as the mark as necessary, and whether they did anything to suggest sponsorship or endorsement by the trademark holder. *New Kids*, 971 F. 2d 302 at 308.

While this test may not be the test that this Court, the Supreme Court of the United States, should use, the spirit of creating a new test in nominative use cases was well-reasoned. The Ninth Circuit explained that nominative use cases “fall outside the strictures of trademark law.” *Id.* As such, it is important to identify why nominative fair use could be grounds to relieve a defendant from liability. Such uses are permissible when “it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder.” *Id.* at 304. Here, it is clear that Pattel’s use *does* implicate the source-identification function that is the purpose of trademark law, and it *does* imply Gardashyan’s sponsorship and endorsement of the product. With this in mind, the Court must

focus on the correct analysis in confirming both the position of Gardashyan and the Fourteenth Circuit.

Determining the intent of the alleged infringer in nominative fair use cases is important because if the court finds that the defendant made use of the plaintiff's mark with the very purpose of causing consumers to think the plaintiff endorses or sponsors plaintiff's good or service, then the likelihood that consumers will be confused as to endorsement/affiliation is greater. *Id.* at 214. The Third Circuit correctly analyzes the idea of intent in nominative use cases, something that the Ninth Circuit failed to do:

[I]n traditional trademark infringement cases that a defendant's mere intent to copy, without more, is not sufficiently probative of the defendant's success in causing confusion to weigh such a finding in the plaintiff's favor. Rather, the plaintiff should make some showing that the defendant adopted its mark with the intent to confuse or deceive the public. A party's intentional use of another party's mark to cause confusion weighs in favor of finding likelihood of confusion.

*Id.*

Pattel's use of Gardashyan's mark was intentional, and Pattel used it to increase its own profits. Pattel follows a yearly practice of analyzing and assessing marketing trends for its toy products (R. at 356.) During that process, Pattel realized Gardashyan's rise to fame in 2014 was nearly unprecedented and they even admit they took Gardashyan in to consideration when designing the doll at issue. (R. at 357). Pattel's doll has several distinguishing characteristics that show their intent to suggest Gardashyan's support or affiliation with the product including: long black, straight hair, a leopard print top, a knee-length skirt, sparkly high-

heeled shoes, and a talking feature that says “I want to be a fashionista, just like Cammy Gardashyan.” Further evidence of Pattel’s intent to implicate Gardashyan’s affiliation or sponsorship with the product, while at the same time circumventing trademark laws, can be found by the fact that Pattel’s disclaimer against Gardashyan’s sponsorship or affiliation can only be found on the lower back portion of the box in a font half the size of the fonts on the rest of the box. (R. at 357).

Because we have established that it was Pattel’s intent to confuse the consumer in their favor, the Court now only must determine whether their purposeful use of Gardashyan’s mark and name was fair. This should be determined by analyzing the facts of the case at hand in the light of previous cases dealing with nominative fair use and the specific test laid out in Section II.

**D. Petitioner’s use of Respondent’s Mark does not Constitute Comparative Advertising.**

Nominative fair use is sometimes referred to as “comparative advertising.” This means that a defendant can use a protected mark in advertising if it is used in a comparative manner. For example, in *Merck & Co. v. Mediplan Health Consulting*, 425 F. Supp. 2d 402 (S.D.N.Y. 2006), the Federal Court for the Southern District of New York dealt with a medical company suing another medical company for the use of a trademarked name of a prescription drug. Under 15 U.S.C. § 1125 of the Lanham Act, businesses are permitted to use a trademarked name as a means to compare their product to the protected product. In that case, the court determined that the placement of the trademarked name around words such as “generic” was protected under 15 U.S.C. § 1125 because “plaintiffs cannot prove that

an appreciable number of reasonable consumers would be confused.” *Merck*, 425 F. Supp. 2d 402 at 414.

The facts in our case are distinguishable from *Merck*. At no point did Pattel indicate that their product was a “generic” version or unaffiliated with Gardashyan. Pattel blatantly used several aspects of Gardashyan’s protected mark as a means to attract consumers that could potentially be attracted by Gardashyan’s affiliation with the product. R. at 357. This is the exact type of use that is explicitly forbidden under 15 U.S.C. § 1125, which seeks to permit “fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.” *Merck*, at 417. Here, Pattel is not attempting to compare its product to Gardashyan. On the contrary, Pattel’s use seeks to take advantage of the popularity of Gardashyan herself. Therefore, the comparative advertising exception for nominative fair use does not apply in here, and should be ignored during the analysis of this case.

Another case that is distinguishable to the case at hand is *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93 (2d Cir. 2010). In that case, the Second Circuit found that the defendant was protected by nominative fair use when it sold counterfeit Tiffany (a protected mark) products on its site under the guise that they were true Tiffany products. The Second Circuit held that because eBay had not indicated that Tiffany was endorsing or was affiliated with their “products” being sold, the nominative use of the mark was fair. Here, Pattel overtly expresses that the toy is based on Gardashyan’s protected likeness and that they developed the doll based on her

signature look and fame. While it may be true that a lack of indication of affiliation could potentially give rise to nominative fair use protection, as was reasoned by the Second Circuit, it is reasonable to determine that multiple indications of affiliation both on the packaging, and the doll itself, would constitute the suggestion of unfair affiliation and endorsement that trademark principles seek to prevent.

**E. This Court Should Consider Whether Petitioner used only as much of the Mark as Necessary as to Avoid a Suggestion of Sponsorship or Affiliation.**

A nominative use is fair when it “does not try to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.” *New Kids*, 971 F. 2d 302 at 306, (quoting *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 (5th Cir. 1980)). It is acceptable for a defendant to refer to a trademark if it is necessary, that is, trademark law does not compel individuals to use “absurd turns of phrase” to avoid trademark liability. *Playboy Enterprises v. Welles*, 279 F.3d 796, 804-05 (9th Cir. 2002). For example, one could refer to the Chicago Bulls as “the professional basketball team from Chicago,” but it is far simpler to refer to them by their name. *New Kids*, 971 F. 2d 302 at 306. However, as soon as a defendant crosses line from what is necessary for description to what is advantageous for their product’s viability, they lose their ability to claim nominative fair use. Further analysis for determining if Pattel crossed that line is discussed in Section II; however, the following cases are illustrative of when defendants did and did not cross that line.

In *Playboy*, the Ninth Circuit determined that former playmate of the year Terri Welles’s creation of a website that used the trademarks “Playboy” and “Playmate of the Year 1981,” was nominative fair use, but her repeated use of the watermark “PMOY 1981” on the website was more than was necessary to describe herself and did not constitute fair use. *Playboy*, at 804-05. This Court should adopt the Ninth Circuit’s reasoning and determine that Pattel’s use of Gardashyan’s mark (the hair, the skirt, the leopard top, the high-heels, and the voice saying “I want to be a fashionista, just like Cammy Gardashyan”) was excessive and does not constitute fair use. This “more than necessary” analysis gets to the heart of what trademark law seeks accomplish—protecting the trademark holder and the trademark itself from being used in a manner that confuses the consumer as to the source of the product or an individual’s sponsorship or affiliation with that product.

It is also important to consider whether Pattel’s use was “distant” enough from the actual mark to be considered nominative fair use. For example, in *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913 (C.D. Ill. 2003), that court found that viewers of movie George of the Jungle II were unlikely to believe sponsorship or endorsement of Caterpillar as a result of the use of the Caterpillar’s earth-moving equipment in the movie because the images of the equipment were merely ancillary and in the background of very few scenes. This is distinguishable from our case. Here, Pattel has made Gardashyan and her protected mark the focal point of the product. Furthermore, Pattel designed the doll with the intent to capitalize on Gardashyan’s fame as a means to sell more products. In so doing,

Pattel suggests Gardashyan’s sponsorship and affiliation with the doll. It does not stand to reason that the Walt Disney Company intended to suggest Caterpillar’s sponsorship or affiliation with the film as a means to capitalize on people’s interest in Caterpillar tractors. Therefore, this Court should strongly consider whether Pattel’s use of Gardashyan’s mark was excessive and whether or not their use was “distant” enough to eliminate any suggestion of sponsorship or affiliation by Gardashyan.

While these cases demonstrate the importance of only using the amount of the mark necessary to convey a message and that remaining “distant” from the protected mark have a role in the likelihood of confusion analysis, the specific factors to be considered when making a likelihood of confusion determination in these types of cases are discussed, in detail, in Section II. Regardless, given Pattel’s excessive and not “distant” use of the mark, they are not able to successfully claim nominative fair use.

## **II. UNDER ANY STANDARD, PETITIONER’S USE OF THE MARK WAS NOT FAIR USE.**

Circuit courts are split in their articulation and application of the nominative fair use test. However, this Court should find that the test articulated by the Third Circuit embodies the true meaning and scope of the nominative fair use “defense” established by the Ninth Circuit. Although the Third Circuit improperly applies its nominative fair use test as an affirmative defense, the *language* of the test is particularly relevant and should be adopted by this Court.

**A. This Court Should Adopt The Express Language Of The Third Circuit Because It Raises The Bar For Achieving The Non-Statutory Nominative Fair Use Defense.**

Most courts, along with the Fourteenth Circuit below, “recognize that defendants may lawfully use a plaintiff’s trademark where doing so is necessary in order to describe the plaintiff’s product and does not imply false affiliation or endorsement by the plaintiff of the defendant.” R. at 363 (*See also New Kids*, 971 F.2d 302 at 308.) As such, this Court must determine whether it should adopt a nominative fair use test articulated by one of the circuit courts or fashion an entirely new test to analyze the nominative fair use defense. Respondent first argues that this Court should adopt the express language of the nominative fair use test articulated by the Third Circuit in *Century 21*, 425 F.3d 211 at 228.

The nominative fair use test articulated by the Third Circuit asks a series of three distinct questions:

1. Is the use of plaintiff’s mark necessary to describe (1) plaintiff’s product or service and (2) defendant’s product or service?
2. Is only so much of the plaintiff’s mark used as is necessary to describe plaintiff’s products or services?
3. Does the defendant’s conduct or language reflect the true and accurate relationship between plaintiff and defendant’s products or services?

*Century 21*, 425 F.3d 211 at 228. Each question must be answered affirmatively in order for nominative fair use to exist. *Id.*

This Court should adopt the express language of the Third Circuit *Century 21* nominative fair use test for several reasons. First, Third Circuit’s test should be adopted because it is the strictest test offered by any court. As previously mentioned in Section I of this argument, nominative fair use is not a statutory defense. The defense is neither expressly stated nor implied in any section of the Lanham Act. 15 U.S.C. § 1051 *et seq.* Rather, the nominative fair use defense developed at common law by the Ninth Circuit. *New Kids*, 971 F. 2d 302 at 308. In fact, nominative fair use is not a “defense” in the true sense of the word. McCarthy § 23:11. Rather, “the ‘nominative fair use’ analysis is a ‘defense’ only in the sense that an accused infringer in certain cases can use the analysis to argue that there will be no infringement because there will be no likelihood of confusion.” *Id.* Consequently, Professor McCarthy explains that nominative fair use was created by the Ninth Circuit “to be an alternative method for analyzing if there is the kind of likelihood of confusion that constitutes trademark infringement.” *Id.*

Since nominative fair use is neither an affirmative nor statutory defense, both the test and analysis for achieving the so-called “defense” should be strict and narrowly construed. R. at 363. *See also Int’l Info. Sys.*, 823 F.3d 153 at 168. However, the Ninth Circuit test encompasses three lenient factors for analyzing the nominative fair use defense. (R. at 363). The Fourteenth Circuit agrees and appropriately noted that a stricter test is appropriate because it “raises the bar for nominative fair use defense.” R. at 363. Therefore, the three-factor test articulated by the Third Circuit in *Century 21* should be adopted because is simply more

difficult to meet the three-factor test articulated by the Third Circuit. Such language is appropriate because it disallows a defendant from more easily satisfying the requirements of a non-affirmative “defense;” a defense in which the legislature never intended, created nor implemented.

Second, this Court should adopt the *Century 21* nominative fair use test because the three factors articulated by the Third Circuit are straightforward and easy to apply. R. at 364. This is of utmost importance, as the test adopted by this Court will establish the standard by which courts across the nation must follow. Of the tests available for this Court to adopt, the language of Third circuit test is the most appropriate. The appellate court below agrees, and noted in its opinion that it adopted the language of the Third Circuit test in part because “the Ninth Circuit Court of Appeals itself and other court have sometimes had trouble applying [the Ninth Circuit test].” R. at 363-364.

The Fourteenth Circuit is not alone in its reasoning, as “[c]ourts in other circuits have been slow to embrace ... the three-factor nominative fair use non-infringement standard of the Ninth Circuit.” J. David Mayberry, *TRADEMARK NOMINATIVE FAIR USE: TOWARD A UNIFORM STANDARD*, 102 Trademark Rep. 820, 833 (2012). In fact, most circuits have not adopted the nominative fair use test created by the Ninth Circuit. *Id.* The Second Circuit is the most recent court to join the ranks and refuse to adopt the Ninth Circuit nominative fair use three-factor test. *Int’l Info. Sys.*, 153 F.3d at 168. There, the Second Circuit adopted reasoning similar to that of the Fourteenth Circuit below. *Id.* Instead of adopting the Ninth

Circuit test, the Second Circuit chose the factors articulated by the Third Circuit *Century 21* test. *Id.* Courts are continually recognizing the faults in the Ninth Circuit's approach, further illustrating why this Court should adopt the language of the Third Circuit.

**B. This Court Should Apply The Third Circuit's Three Prong Test As A Separate Analysis For Likelihood Of Confusion.**

This Court should adopt the three-factor test articulated by the Third Circuit. However, although the language of the Third Circuit test is proper, this Court should not follow the Third Circuit's application of its nominative fair use test. Rather, the three-factor test should be applied as a part of the likelihood of confusion test. As such, the burden of disproving nominative fair use remains on the Plaintiff. *KP Permanent Make-Up*, 543 U.S. 111 at 114. This is the application used by the Ninth Circuit, and this Court should follow by replacing the likelihood of confusion test with the nominative fair use test articulated herein.

Simply put, "the whole purpose of the three-part nominative fair use analysis is to determine if there will be a likelihood of confusion, mistake or deception." McCarthy § 23:11. Thus, the three-factor test should stand alone as a separate test for analyzing the likelihood of confusion in nominative fair use cases. This will prevent courts from sifting through the litany of likelihood of confusion factors in addition to the three nominative fair use factors. Such an application would do nothing but overcomplicate the issue by forcing courts to consider a multitude of factors, including several which courts have already deemed inappropriate for

nominative fair use analyses. *Century 21*, 425 F.3d 211 at 224-25. (See also *Mayberry, supra*).

In accordance with the Fourteenth Circuit’s prior ruling in this case and the reasoning stated above, the three-factor nominative fair use test should be applied to the present case as follows:

**1. The Petitioner Did Not Need to Use The Mark at All.**

The first factor of the nominative fair use test is determining whether “the use of plaintiff’s mark [is] necessary to describe (1) plaintiff’s product or service and (2) defendant’s product or service.” *Century 21*, 425 F.3d 211 at 228. Therefore, courts are required to examine not only the defendant’s product, but also to examine plaintiff’s products. R. at 364. Courts must inquire first whether the defendant truly *needs* to use plaintiff’s mark to describe defendant’s product. *Id.* Then, courts must consider whether defendant’s use of plaintiff’s mark is truly *necessary* to “accurately describe what defendant does or sells.” *Century 21*, 425 F.3d 211 at 229. For example, the Third Circuit explains that “the more dependent the ready identification of defendant’s product is on the description of plaintiff’s product through the employment of plaintiff’s mark, the more likely it is that the use is a fair one.” *Century 21*, 425 F.3d 211 at 229. The use will not be fair if defendant’s product is “readily identifiable” without the use of plaintiff’s mark. *Int’l Info. Sys.*, 823 F.3d 153 at 168.

In the instant case, the applicable court should determine whether the Pattel brand and Bambi doll product line would be “readily identifiable” without the use of

the Gardashyan mark. The court should consider the history of the Bambi doll product line, overall Bambi sales including the number of units sold, Pattel's consumer base, the design of the Gardashyan Bambi doll, the popularity of Gardashyan among consumers, and consumer's familiarity with Gardashyan's brand. The court must then determine, based upon foregoing inquiries, whether Pattel truly *needed* to use Gardashyan's mark in order to describe its Bambi doll product.

In applying this factor to the present case, Pattel's use of Gardashyan's mark was not necessary to describe Pattel's 2015 doll. First, the use of Gardashyan's mark was not necessary because Pattel's doll is "readily identifiable." Pattel has sold over five hundred million Bambi dolls to customers of all ages since the company's founding in 1961. R. at 355. Bambi dolls are inspired by and modeled after modern-day female celebrities and socialites. *Id.* Pattel creates a new Bambi doll each year and analyzes market trends to design the Bambi doll that will garner the most sales. R. at 356. Since Pattel only creates a top-selling Bambi doll each year, the dolls are considered collectables and are increasingly valuable. R. at 355. Therefore, the Pattel's Bambi dolls are "readily identifiable" among consumers. Over five hundred million Bambi dolls have been have been sold. Therefore, it is nearly impossible to conclude that the Bambi doll is not "readily identifiable" among consumers. Moreover, more than thirty five million Gardashyan Bambi dolls were sold in 2015 alone, profiting forty five million dollars for Pattel. R. at 357.

Second, the use of Gardahsyan's mark was not necessary because Gardashyan, her personal brand, and her various products are "readily identifiable"

among consumers. Gardashyan's personal brand garners worldwide recognition, drawing tens of millions of fans and supporters from across the globe. R. at 356. Gardashyan has become a household name as an extraordinarily successful "reality television personality, socialite, businesswoman, model, and singer." *Id.* Gardashyan's fame earned her over fifty million dollars in 2015 from products associated with her Gardashyan personal brand. *Id.* Products such as "jewelry, clothing, cosmetics, perfumes, handbags, and footwear" are produced under Gardashyan's brand and bear her name and protected trademark. *Id.* As a result, it is clear that consumers "readily identify" Gardashyan and her lucrative personal brand.

Further, Gardashyan is famous for her celebrated, signature style. R. at 356. Leading fashion magazines and entertainment news outlets have heralded her signature look, which includes "animal prints, knee length skirts or dresses, and shiny high-heeled shoes." *Id.* Gardashyan is also well known for her long, black, and straight hairstyle. *Id.* Pattel appreciated Gardashyan's style in designing its 2015 Bambi doll, as the 2015 Bambi doll portrays Gardashyan's famous look. The doll wears an animal print top, a knee-length skirt, sparkly high-heeled shoes, and has Gardashyan's long, black, straight hairstyle. R. at 357. Therefore, it was not necessary for Pattel to use Gardashyan's mark. Consumers across the globe knew of Gardashyan's style and signature look. Since the doll mimicked Gardashyan in nearly every way, Pattel did not need to use Gardashyan's mark to describe that its 2015 Bambi doll was inspired by Gardashyan herself. The entire purpose of the doll

is to mimic inspiring celebrity women to convey to its purchasers female power, independence, and influence. R. at 355. It is apparent, therefore, that when looking to the basic principles of the Bambi doll, one may easily conclude that the doll was inspired by one of the most famous female celebrities in 2015: Gardashyan. Therefore, Pattel did not truly *need* to use Gardashyan's mark to describe its Bambi doll product.

Moreover, not only did the doll look like Gardahsyan by portraying her signature appearance, but the doll also had a push-to-talk activating feature. R. at 357. The Gardashyan Bambi doll had a button on its hand, and when pushed the doll would say: "I want to be a fashionista, just like Cammy Gardashyan." *Id.* Nevertheless, Pattel still believed it necessary to use Gardashyan's protected mark on its box to convey to consumers that the doll was inspired by Gardashyan. R. at 357. Pattel included in the front of its 2015 Bambi doll box the following message: "I want to be just like Cammy Gardashyan" in large twenty point font. *Id.*

However, this was not necessary. Pattel could have easily avoided using Gardashyan's mark. Rather than using Gardashyan's mark on its box, Pattel could have designed the box with a small opening so that consumers could press the button on the doll's hand and hear the talking feature. Further, instead of including the message, "I say: I want to be just like Cammy Gardashyan" on its box, Pattel could have included a common phrase such as, "Press me, I talk!" Consumers would have had the opportunity to determine that the doll was mimicking Gardashyan without Pattel having to use Gardashyan's mark prominently on the front of its box.

For the foregoing reasons, the use of Gardashyan’s was not necessary to describe Gardashyan’s products or Pattel’s Bambi doll. Although this Court cannot determine whether Pattel infringed upon Gardashyan’s trademark at the present time, the applicable court on remand should find that nominative fair use does not exist in conjunction with the foregoing analysis of factor one.

**2. The Petitioner Used More of the Mark than was Necessary.**

The second factor of the nominative fair use test asks, “[i]s only so much of the plaintiff’s mark used as is necessary to describe plaintiff’s products or services?” *Century 21*, 425 F.3d 211 at 228. This factor “tests only whether the quantum of the plaintiff’s mark used by the defendant was appropriate.” *Century 21*, 425 F.3d at 230. If the “description of the defendant’s product does *not* depend on the description of the plaintiff’s product,” then only a small amount, if any, of plaintiff’s mark should be deemed “necessary” under this inquiry. *Century 21*, 425 F.3d at 230. Furthermore, in reviewing the quantum of plaintiff’s mark used by the defendant in nominative fair use cases, courts must consider “the manner in which [plaintiff’s] mark is portrayed.” *Century 21*, 425 F.3d 211 at 230. Courts should therefore consider whether the defendant used the distinctive lettering or stylization of plaintiff’s mark in determining whether the second factor of this test is satisfied. *Century 21*, 425 F.3d 211 at 230.

In the instant case, the applicable court should examine closely Gardashyan’s mark and determine how much of her mark was used by Pattel. The court should determine whether Pattel used more of Gardashyan’s mark than was necessary to

identify her own goods and services. Further, in conjunction with factor one, Pattel may not use much, if any, of Gardashyan's mark if Gardashyan's mark was not truly *needed* to describe its Bambi doll product. Therefore, the court must determine if Pattel used too much of Gardashyan's mark to describe its Bambi product by considering the number, manner in which the mark was used, and how it was conveyed to consumers.

On remand, the district court should find that this second prong of the nominative fair use test is not satisfied. Simply put, the quantum of Gardashyan's mark, as used by Pattel, was inappropriate. Gardashyan's mark consists of two parts: (1) a stylized "CG" and (2) the words "CAMMY GARDASHYAN" in capital letters in a standard block font. The "CAMMY GARDASHYAN" portion of the trademark is substantially larger than the "CG" portion of the mark. Therefore, the words "CAMMY GARDASHYAN" make up the majority of Gardashyan's mark. Unfortunately for Petitioner, Pattel made the conscious decision to use the majority of Gardashyan's mark. Pattel used the entire "CAMMY GARDASHYAN" portion of Gardashyan's protected mark not once, but twice on its Bambi doll packaging. Pattel could have easily used a smaller quantum of Gardashyan's mark, such as the minimal "CG" portion of the logo. Such a use would have been more appropriate under this prong.

Further, Pattel used the exact styling of the "CAMMY GARDASHYAN" portion of Gardashyan's mark in its use on the Bambi doll box. Rather than using a different font, typeface, or sentence case, Pattel replicated the "CAMMY

GARDASHYAN” portion verbatim. This verbatim copying of Gardashyan’s mark wrongfully portrays and implies that a relationship exists between Gardashyan and Pattel. As a result, the applicable court on remand should find that nominative fair use does not exist in conjunction with the foregoing analysis.

### **3. The Petitioner’s Conduct Does Not Reflect Their Relationship with the Respondent.**

The third factor of the nominative fair use test asks, “[d]oes the defendant’s conduct or language reflect the true and accurate relationship between plaintiff and defendant’s products or services?” *Century 21*, 425 F.3d 211 at 228. The crux of this factor is determining whether plaintiff’s relationship with defendant is portrayed accurately. *Century 21*, 425 F.3d 211 at 231. Courts must determine whether defendant did anything that would “suggest endorsement by the [plaintiff] trademark holder.” *Century 21*, 425 F.3d 211 at 231. Courts should consider not only the affirmative actions taken by defendant to suggest sponsorship or endorsement, but may also consider a defendant’s “failure to state or explain some aspect” of sponsorship or endorsement between defendant and plaintiff. *Century 21*, 425 F.3d 211 at 231. However, “a defendant’s purposeful portrayal of plaintiff’s endorsement of its product through defendant’s conduct or language does not necessarily render the use unfair, as long as the *depiction* of the endorsement is accurate.” *Century 21*, 425 F.3d 211 at 231 (emphasis added). Therefore, as the Fourteenth Circuit appropriately noted below, courts “must not only consider source confusion, but must also consider confusion regarding affiliation, sponsorship, or endorsement by the mark holder.” R. at 365.

In the instant case, the applicable court should examine Pattel's Bambi doll product and determine whether its use of Gardashyan's mark suggests sponsorship or endorsement on behalf of Gardashyan. The court must examine any and all affirmative actions taken by Pattel to portray the true and accurate relationship between the two parties. This requires the court to consider if Pattel used any disclaimers regarding Gardashyan's mark, and whether such a disclaimer overcomes any of Pattel's actions that may suggest or reflect an inaccurate relationship between the two parties. This is because the court must consider whether Pattel's product, taken as a whole, accurately depicts Gardashyan and Pattel's business relationship.

In applying this third and final nominative fair use factor, the applicable should find that Pattel's use of Gardashyan's mark does not reflect the true and accurate relationship between its company and Gardashyan. Respondent acknowledges that Pattel included a small disclaimer on the back of its packaging stating that Pattel is "not sponsored by or affiliated with Cammy Gardashyan." R. at 357. However, Pattel's disclaimer does not overcome its purposeful portrayal and prominent use of Gardashyan's mark on the front of the Bambi doll box. As illustrated through its packaging, Pattel's product is likely to cause confusion by depicting affiliation, sponsorship, and endorsement by Gardashyan. Not only does the doll portray Gardashyan's signature style and look, but also the packaging prominently displays Gardashyan's mark on the front of the Bambi doll box in large, twenty point font. R. at 357. An ordinary consumer will likely be deceived as

to the true and accurate relationship between Gardashyan and Pattel. Although the Bambi doll depicts some sort of sponsorship, affiliation, or other mutually benefitting relationship between the two parties, Gardashyan and Pattel, are in no way associated with one another and Gardashyan never authorized the use of her mark. Moreover, Pattel copied and replicated a majority of Gardashyan's mark. This suggests that Gardashyan permitted Pattel to use her protected mark on its Bambi doll products, furthering the belief among consumers that Gardashyan and Pattel are reciprocally affiliated with one another.

Therefore, the applicable court on remand should find that Pattel's use of Gardashyan's mark does not portray the true and accurate relationship between the two parties. As a result, nominative fair use does not exist, as the third factor of the three-part nominative fair use test is not satisfied in conjunction with the aforementioned analysis.

**C. In the Alternative, a Test More Directly Tailored to Nominative Fair Use Cases Should Also Lead the Court to Determine Petitioner's use of the Mark was not Fair Use.**

If this Court chooses to reject the Third Circuit test as applied above, Respondent offers two alternative approaches. First, Respondent proposes that this Court simply affirm the appellate court below and hold that the three-factor Third Circuit test be adopted in conjunction with the eight-factor *Polaroid* likelihood of confusion test to create one large, all-encompassing eleven-factor nominative fair use test. R at 365.

However, Respondent questions whether the approach adopted by the appellate court below is truly the best approach for nominative fair use cases. A nominative fair use case exists when a defendant uses plaintiff's mark to refer to the plaintiff. *New Kids*, 971 F. 2d 302 at 308. The focus of trademark infringement is determining whether there is a likelihood of confusion among consumers. *KP Permanent Make-Up*, 543 U.S. 111 at 117. As such, because there is no true nominative fair use "defense," the question becomes whether defendant's use of plaintiff's mark is likely to cause confusion. R. at 363. (*See also* Chad J. Doellinger, *NOMINATIVE FAIR USE: JARDINE AND THE DEMISE OF A DOCTRINE*, 1 Nw. J. Tech. & Intell. Prop. 66 (2003)). While some nominative fair uses will likely cause confusion, others simply will not. Therefore, "nominative fair use should be nothing more than a term used to describe a peculiar fact pattern that, given the specific facts of the case, does not lead to a likelihood of confusion." *Id.*

Following this theory, Respondent argues that this Court should adopt an alternative likelihood of confusion test. Instead of trudging through the traditional eight-factor *Polaroid* analysis, or the appellate court's latest eleven-factor test, Respondent suggests that this Court adopt a more precise analysis. Such an alternative test will include only the applicable likelihood of confusion factors for determining whether infringement exists in nominative fair use cases.

**1. This Court Should Adopt the Alternative Six-Factor Likelihood of Confusion Test.**

Respondent argues that a traditional likelihood of confusion test, such as the *Polaroid* eight-factor test, may not be appropriate in a nominative fair use case.

This is because several of the *Polaroid* factors are irrelevant and not applicable to nominative fair use cases. Mayberry, *supra* at 843–44. Rather, an alternative likelihood of confusion test will better suit this Court and others in analyzing cases involving nominative fair use fact patterns. *Id.*

Respondent suggests that this Court adopt the nominative fair use approach proposed by J. David Mayberry, a well-respected and nationally renowned trademark litigation attorney. Mayberry suggests in his recent article that the crux of the nominative fair use analysis should focus on the likelihood of “sponsorship confusion or source confusion.” Mayberry, *supra* at 843–44. Mayberry states that nominative fair use involves a defendant using plaintiff’s mark, not necessarily as an indication of source of defendant’s products, but for advertising, labeling, or descriptive purposes. *Id.* at 843. Respondent agrees, and suggests that this Court adopt his proposed six-factor test for nominative fair use cases:

In determining whether a defendant's use of a plaintiff's mark is likely to cause sponsorship confusion or source confusion, the court should consider the following factors:

- (1) The manner in which the defendant uses the plaintiff's mark, including such things as size, placement, and stylization;
- (2) The proximity of the plaintiff's and defendant's goods or services, including the likelihood of expansion of the parties' product or service lines;
- (3) Whether the defendant's advertising truthfully describes the relationship between the parties;
- (4) The type of goods or services and the degree of care likely to be exercised by the purchaser;

- (5) The defendant's intent; and
- (6) Evidence of actual confusion.

*Id.* at 843–44. None of the aforementioned factors are dispositive. *Id.* Rather, all six factors should be weighed collectively to determine whether there is a likelihood of confusion, or a nominative fair use, of plaintiff's mark. *Id.* Mayberry's proposed factors find support in several circuits, as they encompass the applicable inquiries of the *Polaroid* test to provide a truncated analysis for nominative fair use cases. Such an analysis is beneficial, as it properly focuses on likelihood of sponsorship, source, and endorsement confusion while dismissing immaterial factors to nominative fair use fact patterns.

**2. When the Six-Factor Test is applied, the Result Favors the Respondent.**

Mayberry's six-factor test should be applied similarly to the traditional likelihood of confusion test. In regards to the first factor, "the use of a plaintiff's mark in its stylized form may well connote sponsorship." Mayberry, *supra* at 844. The court should consider the manner in which Gardashyan's mark was portrayed to consumers, and whether Pattel's use of Gardashyan's mark duplicated any distinctive lettering or styling of Gardashyan's mark.

Here, Gardashyan's mark consists of two parts: (1) a stylized "CG" and (2) the words "CAMMY GARDASHYAN" in capital letters in a standard block font. The "CAMMY GARDASHYAN" portion of the trademark is substantially larger than the "CG" portion of the mark. Therefore, the words "CAMMY GARDASHYAN" are the

majority of Gardashyan's mark. Pattel used the entire "CAMMY GARDASHYAN" portion of Gardashyan's protected mark not once, but twice, on its doll packaging.

Further, Pattel used the exact styling of the "CAMMY GARDASHYAN" portion of Gardashyan's mark in its use on the Bambi doll box. Rather than using a different font, typeface, or sentence case, Pattel replicated the "CAMMY GARDASHYAN" portion verbatim. This verbatim copying of Gardashyan's mark wrongfully portrays and implies that a relationship exists between Gardashyan and Pattel. Such a portrayal would have been avoided had Patel altered Gardashyan's mark on its product packaging. However, Pattel unfairly duplicated a majority of Gardashyan's mark in order to bolster the sale of its own product.

Moreover, Pattel prominently displayed Gardashyan's mark in large, twenty-point font on the front of the Bambi doll box. This prominent display of Gardashyan's mark further suggests that consumers will likely be confused as to the sponsorship or source of defendant's product. As a result, this factor weighs heavily in favor of Gardashyan. Petitioner copied a majority of Gardashyan's mark verbatim. Pattel neither altered Gardahyan's mark nor displayed the mark discreetly on its Bambi doll packaging.

In regards to the second factor of Mayberry's test, likelihood of sponsorship or endorsement confusion may exist where there is a close "proximity of the plaintiff's and defendant's goods or services to one another or [a] perceived likelihood of bridging the gap." Mayberry, *supra* at 844. The court should consider the similarity

between plaintiff's products and defendant's products and their respective place in the market. *Id* at 844-45.

Here, neither Pattel's products nor Gardashyan's products are particularly similar or dissimilar to one another. Pattel sells toys and dolls, while Gardashyan sells a variety of different products in various different markets including purses, handbags, jewelry, clothing, cosmetics, etc. R. at 355-56. Although Gardashyan does not sell dolls, it is a market in which consumers may believe Gardashyan has entered because Gardashyan's brand is so widespread. Therefore, this factor cuts slightly in favor of Gardashyan. While the products are not strikingly similar, the markets are similar enough that consumers are likely to be confused by Pattel's conduct.

In regards to the third factor, the more accurate defendant's advertising, marketing, and portrayal of its product, the less likely it is that consumers will perceive sponsorship, endorsement, or affiliation between plaintiff and defendant. *Id* at 845. This factor is essentially identical to the third factor in the Third Circuit's nominative fair use test. As such, the court should determine whether defendant did anything that would "suggest endorsement by the [plaintiff] trademark holder." *Century 21*, 425 F.3d 211 at 231.

In the present case, Gardashyan acknowledges that Pattel included a small disclaimer on the back of its packaging stating that Pattel is "not sponsored by or affiliated with Cammy Gardashyan." R. at 357. However, Pattel's disclaimer does not overcome its purposeful portrayal and prominent use of Gardashyan's mark on

the front of the Bambi doll box. As illustrated through its packaging, Pattel's product is likely to cause confusion by depicting affiliation, sponsorship, and endorsement by Gardashyan. Not only does the doll portray Gardashyan's signature style and look, but also the packaging prominently displays and advertises Gardashyan's mark on the front of the Bambi doll box in large, twenty point font. R. at 357. Even though no relationship exists between these two parties, Pattel's excessive use of Gardashyan's mark would lead an ordinary consumer to be deceived as to the true and accurate relationship between Gardashyan and Pattel. As a result, this factor weighs heavily in favor of Gardashyan.

In regards to the fourth factor, "focusing on the type of goods or services advertised and the degree of purchasing care makes sense in determining affiliation or sponsorship confusion." Mayberry, *supra* at 845. "The inclusion of this factor is relevant because the less care that the target consumer is likely to invest in the purchase, the more likely a consumer would perceive that the plaintiff has authorized or approved the defendant's services from the defendant's mere use of, or reference to, the [plaintiff's] mark." *Id.*

Here, consumers purchasing Pattel's Bambi dolls are not sophisticated because they do not exercise a high degree of purchasing care. Bambi dolls attract consumers from ages three to one hundred. R. at 355. As such, much of the consumer block is uninterested and unable to invest the requisite sophistication or care. Rather, it is likely that Pattel's consumers will perceive that Gardashyan authorized or approved the Bambi doll by Pattel's mere use of Gardashyan's mark.

Further, toys and dolls such as the Bambi doll are affordable. As such, consumers need not invest as much care when purchasing Pattel's products as compared to expensive, luxury items. As a result, this factor weighs heavily in favor of Gardashyan.

In regards to the fifth factor, "courts long have held that likelihood of confusion may be inferred from proof that the actor used a designation resembling another's trademark with the intent to cause confusion or to deceive." Mayberry, *supra* at 846. This is because "courts will assume that businesspeople usually succeed when they intend to cause confusion." *Id.* As such, the court should review any evidence suggesting that a defendant intended to cause sponsorship, endorsement, affiliation, or source confusion among consumers. Given the analysis of Pattel's intent when designing the doll as discussed in Section I of this argument, it is clear that this factor weighs in favor of Gardashyan.

Finally, in regards to the sixth factor, actual consumer confusion as to sponsorship, endorsement, or source of the products will most likely constitute trademark infringement. *Id.* at 846. The court should therefore consider any probative evidence suggesting that actual confusion exists among consumers. Here, however, there is no evidence of actual confusion among consumers. As such, this factor is not applicable to the case at bar.

When considering the foregoing, this Court should find that when the proper law is applied to the facts of this case, Respondent has successfully alleged trademark infringement.

## CONCLUSION

WHEREFORE, Respondent prays the Court find that Petitioner's use of Respondent's mark was not fair use, and, therefore, affirm the Fourteenth Circuit's Judgment.

Respectfully Submitted,

/s/ Team 111

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