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#113

No. 16-1225

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 2016

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PATTEL, INC., a Bel Air Corporation,

*Petitioner,*

v.

CAMMY GARDASHYAN,

*Respondent.*

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

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BRIEF FOR RESPONDENT

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COUNSEL FOR RESPONDENT  
OCTOBER 21, 2016

## QUESTIONS PRESENTED

### I. NOMINATIVE FAIR USE ADOPTION

- A. Under the Lanham Act, is the adoption of a separate nominative fair use test necessary when all circuits for the past fifty years embrace a form of the flexible, multifactor likelihood of confusion test, have successfully addressed nominative uses with that test, and the adoption of an alternative test creates needless confusion in trademark law?
- B. Alternatively, assuming this Court adopts a nominative fair use test, is it an affirmative defense when trademark law does not list it with other affirmative defenses, it would render a judicially unmanageable application, and courts that adopt it do so based on misinterpreted case law?

### II. NOMINATIVE FAIR USE APPLICATION

- A. Again, assuming this Court adopts a nominative fair use test, under the Lanham Act, does adding the Third Circuit's articulation of the nominative fair use factors in conjunction with the eight factors of the likelihood of confusion test create the most equitable analysis when this would require the court to look at the most factors and the clearest language?
- B. Assuming this Court chooses to apply the nominative fair use test as a part of the newly created eleven-factor likelihood of confusion analysis, does Pattel's use of Cammy Gardashyan's mark cause a likelihood of

confusion when Pattel could describe the Bambi Doll as a fashionista without the mark, the front top of the box displayed Cammy's mark in twenty-point font, the back bottom of the box displayed the disclaimer in tiny ten-point font, and Pattel chose to use this celebrity's mark based on their analysis of Cammy's popularity with the purpose of increasing profitability?

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## **STATEMENT OF JURISDICTION**

Cammy Gardashyan brought this action against Pattel, Inc. under 15 U.S.C. § 1114 (2012) (“Lanham Act”). Under 28 U.S.C. § 1338 (2012), the district court had original jurisdiction because this is a claim arising under federal law, namely the Lanham Act.

The Fourteenth Circuit Court of Appeals’ jurisdiction rested on 28 U.S.C. § 1291 (2012). This Court’s jurisdiction rests on 28 U.S.C. § 1254 (2012).

## **CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED**

The following constitutional and statutory provisions are relevant to this action’s determination:

15 U.S.C. § 1114 (2012).

15 U.S.C. § 1115 (2012).

15 U.S.C. § 1125 (2012).

## STATEMENT OF THE CASE

**Cammy’s Trademark.** This is a case about one party riding the train built by the hard work of another without paying for a ticket. Respondent, Cammy Gardashyan (“Cammy”)—an American reality television star, socialite, businesswoman, model, and singer—skyrocketed her career in 2007 when she started appearing on “Keeping up with the Gardashyans.” *Gardashyan v. Pattel*, 135 F.3d 759, 356 (14th Cir. 2016). Now, national and worldwide fans from ages five to one hundred acknowledge her as a household name. *Id.*

To protect her famous brand, Cammy retains a registered trademark that consists of a stylized “CG” displayed back to back with the words “CAMMY GARDASHYAN” underneath in standard, block typeface. *Id.* Under her trademark, she produces jewelry, clothing, cosmetics, perfume, handbags, and footwear, which in 2015 earned more than fifty million dollars. *Id.*

**Cammy’s Signature Style.** Fashion magazines highly rate Cammy for her signature style, which includes: her long, black straight hair, animal print attire, knee-length skirts or dresses, and shiny high-heeled shoes. *Id.* Her three sisters maintain a similar look and style. *Id.*

**Bambi Doll.** Pattel, Inc. (“Pattel”), a toy manufacturing company, produces Bambi dolls “usually inspired by the ‘original look’ of its original dolls” and inspired by celebrities. *Id.* at 355. Pattel “targets consumers ages three to one hundred” by selling their dolls as collectables. *Id.* To enhance profitability, Pattel analyzes market trends before drafting their design. *Id.* at 356. Analyzing the 2015 market

trends, Pattel recognized the popularity Cammy gained following her wedding in 2014 and mimicked Cammy’s signature style in the 2015 Bambi doll. *Id.*

**Fashionista Bambi Doll Bearing Cammy’s Mark.** Pattel’s 2015 Bambi doll possesses long, black straight hair, wears a leopard print top, knee-length skirt, and sparkly high-heels. *Id.* at 357. When consumers activate a button on the doll’s hand, the doll repeats, “I want to be a fashionista, just like Cammy Gardashyan.” *Id.* Pattel sells the doll in a standard box with a transparent film on the front. *Id.* The top front cover displays the name: “Fashionista Bambi.” *Id.* Under the name, a caption bubble reads in twenty-point font, **“I say: I want to be just like Cammy Gardashyan.”**<sup>1</sup> *Id.* Nonetheless, Pattel did include a tiny disclaimer in ten-point font on the lower back corner of the box that read, “Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan.”<sup>2</sup> *Id.* Whenever Pattel referred to Cammy on the box, they used “standard black block typeface.” *Id.*

In January 2015, Pattel released the Fashionista Bambi doll for sale nationwide, and within twelve months they had profited forty-five million dollars on just the thirty-five million Fashionista Bambi dolls. *Id.*

**The Complaint.** On February 9, 2015, Cammy filed a claim of trademark infringement against Pattel for their use of “Cammy Gardashyan,” seeking a

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<sup>1</sup> This is twenty-point font.

<sup>2</sup> This is ten-point font.

permanent injunction. *Id.* Pattel argued that the court should dismiss the claims because their use was fair under the nominative fair use defense. *Id.*

**Nature of the Proceedings.** Following cross-motions for summary judgment, the District Court for the Central District of Bel Air held Pattel’s use of the names and marks constituted nominative fair use and granted summary judgment in favor of Pattel. *Id.* at 358. The district court adopted a two-step approach and held that Pattel qualified for a nominative fair use defense, even with a finding of a likelihood of confusion. Cammy appealed. *Id.*

The Fourteenth Circuit reversed and remanded for further proceedings consistent with their holding that instructed the lower court to apply the Third Circuit's three nominative fair use factors in conjunction with the multifactor likelihood of confusion test (“Polaroid test”) to create an eleven-factor test. *Id.*

The Supreme Court has granted certiorari to hear Petitioner’s appeal.

## SUMMARY OF THE ARGUMENT

### I.

The Fourteenth Circuit correctly reversed the district court's grant of summary judgment for Pattel, and this Court must affirm. But unlike the Fourteenth Circuit, this Court should not adopt a nominative fair use test because all circuit courts unanimously adopt an iteration of the multifactor likelihood of confusion test, and this test sufficiently upholds an equitable analysis under § 1114 of the Lanham Act. Over fifty years of precedent exists supporting the flexibility of the multifactor likelihood of confusion analysis, including in the nominative use context. Conversely, since the Second Circuit's adoption of nominative fair use in 1992—over twenty years ago—the majority of circuits have not adopted the analysis and the few who have significantly altered its application. Thus, this Court should not adopt the gratuitous nominative fair use test because it would further complicate trademark law.

Alternatively, assuming this Court adopts a nominative fair use test, mandatory precedent, legislative intent, and the fundamental pillars behind trademark law demand that this Court not apply the test as an affirmative defense. Congress easily could have included nominative fair use with the affirmative defenses to trademark infringement. They did not. Next, application of the test as an affirmative defense creates a circular argument that makes its application nonsensical for the judiciary. Last, when the Third Circuit decided to employ nominative fair use as an affirmative defense, it misinterpreted the applicability of this Court's precedent in *KP Permanent Make-up, Inc. v. Lasting Impressions I, Inc.*, 543 U.S. 111, 117 (2004).

## II.

On the other hand, this Court should affirm the Fourteenth Circuit's articulation of the test because the language most thoroughly evaluates the circumstances and provides the most clarity. The test that the Fourteenth Circuit applies includes the Second Circuit's eight-factor likelihood of confusion test, called the *Polaroid* test, in conjunction with the nominative fair use factors drafted with the Third Circuit's stricter language.

No matter which application of the test applies, Pattel's use of Cammy's trademark on their Bambi Doll does not qualify as nominative fair use; thus, their use caused a likelihood of confusion. Pattel could describe the fashionista nature of their Bambi doll without the use of Cammy's mark. Moreover, Pattel knew the popularity of Cammy and her goods, and they intentionally chose to apply her trademark, essentially free-riding on the business Cammy built to enhance their own profitability. Last, the prominent size of the celebrity's mark on the front of the box paired with a tiny disclaimer on the lower back portion of the box deceives consumers into believing Cammy Gardashyan endorsed Pattel's Fashionista Bambi doll. Therefore, this Court should uphold the strong precedent supporting the likelihood of confusion test and not apply a nominative fair use test; however, if they apply a nominative fair use test, fairness demands that they affirm the Fourteenth Circuit's articulation and find that Pattel's use of Cammy's mark violated her trademark rights.



## ARGUMENT

This Court should affirm the Fourteenth Circuit only in holding because it erred in adopting a nominative fair use analysis; however, if this Court chooses to adopt a nominative fair use standard, they must affirm the Fourteenth Circuit's standard and articulation. The Fourteenth Circuit held that the nominative fair use test is not an affirmative defense but instead an addition to the likelihood of confusion factors. Additionally, Pattel's use of Cammy's mark on the Fashionista Bambi Doll box breeds a likelihood of confusion, even when applying a nominative fair use analysis. Motions for summary judgment are reviewed *de novo*, including cross-motions for summary judgment. *JL Beverage Company, LLC v. Jim Beans Brand Co.*, 828 F.3d 1098, 1104 (9th Cir. 2016). The pleadings are viewed in the light most favorable to the nonmoving party. *Id.* The issues in this case are separate because this Court could choose to adopt the nominative fair use test as an affirmative defense, but still find Pattel's use was not a nominative fair use.

Pattel infringed on Cammy's trademark rights because (1) Pattel cannot assert a nominative fair use defense and (2) even if they could, Pattel's usage does not pass the nominative fair use analysis, let alone the likelihood of confusion test. Therefore, if this Court elects not to adopt a nominative fair use test, it should affirm the Fourteenth Circuit only in holding; alternatively, if this Court does adopt a nominative fair use test, fairness demands that this Court affirm the Fourteenth Circuit's articulation of the test and remand not inconsistent with the proceedings of this Court.

**I. THIS COURT SHOULD NOT ADOPT A NOMINATIVE FAIR USE DEFENSE.**

This Court should not adopt a nominative fair use defense OR test because the likelihood of confusion analysis is sufficiently flexible and the adoption of a new test will only further complicate trademark law. Congress created the Lanham Act—a key underpinning of trademark law—to “secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *See also* S. Rep. No. 1333, 79th Cong., 2d Sess., 3–5 (1946). Under the Lanham Act, an individual holding a registered trademark “has a civil action against anyone employing an imitation of it in commerce when ‘such use is likely to cause confusion, or to cause mistake, or to deceive.’” *KP Permanent Make-up*, 543 U.S. at 117 [*“KP Permanent Make-up”*] (quoting 15 U.S.C. § 1114(1)(a) (2012)). A plaintiff must demonstrate that the defendant’s use of the trademark “is likely to produce confusion in the minds of consumers about the origin of the goods or services in question.” *Id.* The Lanham Act “intend[s] to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992) (quoting § 45, 15 U.S.C. § 1127 (2012)). Courts must balance the policy of preventing confusion among prudent purchasers and protecting free speech “in both the commercial and expressive use of trademarks.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:11 (4th ed. 2016).

Nominative use is the “use of another’s trademark to identify, not the defendant’s goods or services, but the plaintiff’s goods or services.” McCarthy, *supra*, § 23:11. In 1992, the Ninth Circuit created a nominative fair use analysis in *New Kids on the Block v. News Am. Pub., Inc.* for cases where the competitive need for the trademark exists, and its application will rarely confuse consumers. 971 F.2d 302, 307–10 (9th Cir. 1992). The court held the defendants’, two newspapers, use of the New Kids on the Block’s mark was a nominative use and not trademark infringement because the newspapers’ ultimate goal was to describe its own telephone poll. *Id.* at 304. In essence, when an individual uses another’s trademark “in a non-confusing way to identify the senior user’s goods or services . . . [s]uch use is fair because it does not imply sponsorship or endorsement by the trademark holder.” McCarthy, *supra*, § 23:11 (quoting *New Kids*, 971 F.2d at 308). The *New Kids*’ court identified three elements required to show nominative fair use:

- (1) the product or service in question must be one not readily identifiable without the use of the trademark;
- (2) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and
- (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

971 F.2d at 308.

However, adoption of the nominative fair use analysis creates a problematic circuit split. The Second, Fifth, and Fourteenth Circuits apply the nominative fair

use factors in conjunction with the likelihood of confusion factors. *Gardashyan*, 1135 F.3d at 363; *Int'l Info. Sys. Sec. Cert. Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 156 (2d Cir. 2016); *Pebble Beach Co. v. Tour 18, I Ltd.*, 155 F.3d 526, 545–547 (5th Cir. 1998). On the other hand, the Ninth Circuit substitutes the nominative fair use factors for the likelihood of confusion factors. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175–76 (9th Cir. 2010). The Third Circuit applies nominative fair use as an affirmative defense. *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (3d Cir. 2005). Last, the Sixth Circuit rejects the nominative fair use test as a substitute for the likelihood of confusion test. *PACCAR, Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003). This Court should not adopt a nominative fair use analysis; however, if they do, by no means should they apply it as an affirmative defense because legislative history implies that it is not, and it would unfairly sway the balance in favor of defendants.

**A. THE FLEXIBILITY OF THE LIKELIHOOD OF CONFUSION TEST DEEMS A NOMINATIVE FAIR USE TEST UNNECESSARY AND CONFUSING.**

This Court must not adopt the gratuitous nominative fair use test because it would only further complicate trademark law. The famous *Polaroid* test from the Second Circuit, adopted by the Fourteenth Circuit, specifies eight factors to analyze in determining likelihood of confusion: (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. *Gardashyan*, 1135 F.3d at 359; *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009). The plaintiff has the burden to show likelihood of confusion. *KP Permanent Make-up*, 543 U.S. at 124.

The flexible likelihood of confusion test does not apply the factors in a mechanical way. *Century 21*, 425 F.3d at 224; *Pebble Beach*, 155 F.3d at 543. The factors are “merely ‘helpful guidelines’” and courts do not need to apply every factor. *Wolfard Glassblowing Co. v. Vanbragt*, 118 F.3d 1320, 1323 (9th Cir. 1997). Additionally, the test is not exhaustive, and the court may evaluate other factors. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, n. 11 (9th Cir. 1979). Ultimately, this flexible, balancing test determines “whether in the totality of the circumstances marketplace confusion is likely.” *Checkpoint Sys., Inc. v. Checkpoint Software Techs., Inc.*, 269 F.3d 270, 297 (3d Cir. 2001). This Court should not adopt a nominative fair use test because the flexible likelihood of confusion test is (1) universally accepted and (2) courts have evaluated nominative uses without adopting a new test.

**1. Departure from the likelihood of confusion test is departure from a unanimously adopted multifactor factor test supported by fifty years of precedent.**

The precedent is clear—every single circuit has adopted a form of the likelihood of confusion analysis for infringement cases. McCarthy, *supra*, § 24:30. Over fifty years ago, courts recognized the use of a factor test in analyzing the likelihood of confusion. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). All circuits have adopted the multifactor likelihood of confusion test, each with its

own flexible iteration. The First, Second, Sixth, Ninth, Fourteenth, and D.C. Circuits have all adopted eight factor tests.<sup>3</sup> Additionally, the Fifth, Seventh, and Eleventh Circuits have applied seven-factor tests.<sup>4</sup> The Tenth adopted a six-factor test, the Third, a ten-factor test, and the Fourth, an eleven-factor test.<sup>5</sup> Last, the Federal Circuit uses a thirteen-factor test, of which the last factor is “[a]ny other established fact probative of effect of use.” *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Thus, all circuits boarded the multifactor likelihood of confusion train, making it weighty precedent to overcome if this Court chooses to adopt a new test.

But no such recognition of a nominative fair use test prevails. In fact, the Ninth Circuit fashioned the test over twenty years ago; nonetheless, the vast majority of courts ignore it or refuse to adopt it. *Health Grades v. Robert Wood Johnson Univ. Hosp.*, 634 F. Supp. 2d 1226, 1241 (D. Colo. 2009) (“The Ninth Circuit’s ‘nominative fair use’ analysis has not been widely adopted. In fact, all of the circuit courts that have considered it to date have either rejected the Ninth Circuit’s approach outright . . . or modified it in some fashion to allow likelihood of confusion to be determined

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<sup>3</sup> See *Gardashyan*, 1135 F.3d at 359; *S.p.A. v. Basile*, 899 F.2d 35, 37 (D.C. Circuit 1990) (citing with approval *Polaroid*, 287 F.2d at 495); *Frisch’s Rests., Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *AMF*, 599 F.2d at 348–49; *Polaroid*, 287 F.2d at 495.

<sup>4</sup> *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1514 (11th Cir. 1984); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330 (7th Cir. 1977); *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 45 (5th Cir. 1975).

<sup>5</sup> *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1089–90 (10th Cir. 1999); *Shakespeare Co. v. Silstar Corp. of Am.*, 110 F.3d 234, 241–42 (4th Cir. 1997); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983).

based largely on the traditional multi-factor analysis of this element.”). The Ninth Circuit felt that a replacement test was necessary in the case of nominative use because it believed the likelihood of confusion test unduly prejudiced defendants. *See New Kids*, 971 F.2d at 307–08. Yet other circuits reject that the multifactor test prejudices defendants based upon its broad flexibility. *See A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 212 (3d Cir. 2000) (the court held that the multifactor test was applicable for competing goods and did not prejudice one party); *Pebble Beach*, 155 F.3d at 546 (rejecting a similar argument for unfair prejudice because it was implicit on “a misunderstanding of the likelihood-of-confusion analysis,” since courts can apply the factors with different weights, even adding additional factors based on the case). Clearly, this Court should decide this is the end of the line for a nominative fair use test because the courts universally adopt the flexible likelihood of confusion test, which renders the nominative fair use test gratuitous.

## **2. Courts address nominative uses without adopting a nominative fair use test, including this Court.**

Courts reach consistent results without using a separate nominative fair use test. First, this Court, in *Prestonettes v. Coty*, addressed a nominative use issue involving a defendant, who bought genuine perfume, repackaged it in smaller bottles, and used a disclaimer saying that the plaintiff was not connected to the new bottling. 264 U.S. 359, 367 (1924). In this case, the Court held that “[w]hen the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.” *Id.* at 368. Although this Court decided this

case in 1924, it involves what the Ninth Circuit defined as nominative use; this court did not determine it was necessary to draft a new test. *Id.*; *See New Kids*, 917 F.2d at 307–08. Adopting a nominative fair use test is inappropriate, and the Ninth Circuit disregarded mandatory precedent by drafting a new test for nominative use cases, ironically using *Prestonettes*. *New Kids*, 971 F.2d at 307–08 (quoting *Prestonettes*, 264 U.S. at 368).

Furthermore, other courts found a nominative fair use test unnecessary. *G.D. Searle & Co. v. Hudson Pharm. Corp.*, 715 F.2d 837, 843 (3d Cir. 1983); *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969). In *Volkswagenwerk*, a Volkswagen repair serviceman advertised his business using the term “Volkswagen” or “VW” along with the prominent use of the word “independent.” 411 F.2d at 352. Here the Ninth Circuit did not apply the nominative fair use test, but instead held that if “another uses the marks in a manner which tends to deceive the public, [the plaintiff] is entitled to protection.” *Id.* Similarly, in *G.D. Searle & Co.*, Hudson claimed that its product was an “equivalent to METAMUCIL,” and the Third Circuit held “whether one is entitled to refer to a competitor’s trademark depends not on where the reference appears but on whether the reference is truthful.” 715 F.2d at 842–43. The court held the use of the mark was approved “so long as it [did] not contain misrepresentations or create a reasonable likelihood that purchasers will be confused as to the source, identity, or sponsorship of the advertiser’s product.” *Id.* at 841.



In addition, some courts apply both the likelihood of confusion test and the nominative fair use test, achieving the same outcome, which portrays the trivial nature of a nominative fair use test. *PACCAR*, 319 F.3d at 257–58; *Cairns v. Franklin Mint Co.*, 292 F.2d 1139, 1144 (9th Cir. 2002) [*“Cairns”*]. In *PACCAR*, the Sixth Circuit applied both tests and found trademark infringement under each test. 319 F.3d at 257–58. The court concluded that they “[were] not inclined to adopt the Ninth Circuit’s analysis here” because the same factors were determinative. *Id.* at 256. Similarly, in *Cairns*, the executors of Princess Diana’s estate sued Franklin Mint for false endorsement under § 1125(a)(1) of the Lanham Act based on the defendant’s use of the name and likeness of Princess Diana on products and advertisements after her death. 292 F.2d at 1144. The court applied the likelihood of confusion test in the lower court and found no confusion. *Cairns v. Franklin Mint Co.*, 107 F. Supp. 2d 1212, 1216–1221 (C.D. Cal. 2000) [*“Cairns III”*]. Then, the Ninth Circuit applied the nominative fair use test and found the defendant’s use permissible. *Cairns*, at 1149–50. *Cairns* and *PACCAR* show that applying either test renders the same outcome. This Court should not adopt a pointless nominative fair use test because it disregards mandatory, applicable precedent.

**B. EVEN IF THIS COURT ADOPTS A NOMINATIVE FAIR USE TEST, THEY SHOULD NOT APPLY IT AS AN AFFIRMATIVE DEFENSE BECAUSE IT DISREGARDS LEGISLATIVE INTENT, YIELDS A JUDICIALLY UNMANAGEABLE APPLICATION, AND MISINTERPRETS THIS COURT’S CASE LAW.**

This Court should not follow the Third Circuit’s treatment of nominative fair use—applying nominative fair use as an affirmative defense—because it strays from the legislative history of the Lanham Act, the court relies on misinterpreted case law,

and this approach unfairly awards defendants a second chance. The Third Circuit adopted a two-step approach to analyze nominative fair use. *Century 21*, 425 F.3d at 222. In this test, a plaintiff must “first prove that confusion is likely due to the defendant’s use of plaintiff’s mark” and after having done so, “the burden then shifts to the defendant to show that its nominative use of the plaintiff’s mark is nonetheless fair.” *Id.* A nominative fair use affirmative defense applies only when the defendant proves all factors. *Id.* This essentially gives defendants broader protection by “allowing [them] a second bite at the apple.” *Gardashyan*, 1135 F.3d at 361.

This Court should affirm the Fourteenth Circuit's reversal of the District Court's holding that nominative fair use is an affirmative defense to avoid overstepping their power by judicially creating law not proscribed by the legislature, and to uphold the fair balance inherent in the Lanham Act.

**1. Congress did not include nominate fair use with the other affirmative defenses to trademark infringement.**

Categorizing nominative fair use as an affirmative defense confuses its original purpose and Congress's intent for the Lanham Act. The Ninth Circuit designed the nominative fair use analysis, not to form an affirmative defense, but to replace the traditional likelihood of confusion test. *KP Permanent Make-up, Inc. v. Lasting Impressions I, Inc.*, 328 F.3d 1061, 1072 (9th Cir. 2003) *rev'd on other grounds*, 543 U.S. 111 (2004) [*Lasting*] (holding that “[w]hen analyzing nominative fair use, it is not necessary to address likelihood of confusion because the nominative fair use analysis replaces the likelihood of confusion analysis.”). As Judge Fisher explains in his dissent to the Third Circuit’s opinion in *Century 21*, “[T]he question of nominative

use is a question of likely confusion and not an affirmative defense . . . . The Ninth Circuit’s decisions make it clear that the test is nothing more than a likelihood of confusion substitute, making it an inappropriate foundation for an affirmative defense.” 425 F.3d at 233. Furthermore, to find a nominative fair use is to find that there was no “likelihood of confusion as to sponsorship or endorsement . . . .” *Toyota Motor Sales*, 610 F.3d at 1182.

Under 15 U.S.C. § 1115, the Lanham Act creates multiple affirmative defenses to trademark infringement. If Congress intends nominative fair use to operate as an affirmative defense, no plausible explanation exists for why they would not explicitly label it as such, like they did for classic fair use. *Russello v. United States*, 464 U.S. 16, 23 (1983) (“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.”). Moreover, § 1115 of the Lanham Act was amended in 2002, but Congress did not add nominative fair use as an affirmative defense. *See* 21st Century Dep’t of Justice Appropriations Authorization Act, Pub. L. No. 107–273, Div. C., tit. III, § 13207(b)(7), 116 Stat. 1908 (Nov. 2, 2002) (codified at 15 U.S.C. § 1115 (2012)). Courts dealt with nominative fair use well before 2002, and yet Congress elected not to include nominative fair use as an affirmative defense. *See* discussion *supra* Part I. The Lanham Act does in fact codify nominative fair use, but only in the context of trademark dilution, which further proves Congress’s intent to not include it as an affirmative defense for trademark infringement. 15 U.S.C. § 1125(c)(3) (2012). To

choose to apply it as an affirmative defense blatantly contradicts Congress's desires for the Lanham Act.

**2. Nominative fair use as an affirmative defense produces a circular application which results in a judicially unmanageable standard.**

To apply the nominative fair use factors as an affirmative defense is problematic because it “requires the court to address identical factors on both sides of the equation.” *Century 21*, 425 F.3d at 232 (Fisher, J., dissenting). Courts review “purpose, prominence, and truthfulness” in a plaintiff’s case in the likelihood of confusion analysis with respect to evidence that the imitative mark was adopted in bad faith and the similarity of the marks. *Id.* at 243; *Starbucks*, 588 F.3d at 115. The first prong of the nominative fair use defense analyzes “purpose,” the second prong “prominence,” and the third prong “truthfulness.” *Century 21*, 425 F.3d at 243 (Fisher, J., dissenting). To require an analysis of the same facts a second time in determining nominative fair use simply “makes no sense.” *Id.* If a court finds a likelihood of confusion, there could be no successful nominative fair use defense, and if no likelihood of confusion exists, the need for the defense becomes a moot point. *Id.* Moreover, this Court holds that the defendant has no burden to negate the likelihood of confusion, precisely what the Third Circuit’s application of nominative fair use proscribes. *KP Permanent Make-up*, 543 U.S. at 124. Thus, this Court must find nominative fair use is not an affirmative defense because turbulence in judicial application would ensue.

### **3. Courts that apply nominative fair use as an affirmative defense do so based on misinterpreted case law.**

The Third Circuit supports nominative fair use as an affirmative defense due to the holding in *KP Permanent Make-up, Century 21*, 425 F.3d. at 222-24. However, the Third Circuit incorrectly interprets the holding in that case because it lumps nominative fair use with the affirmative defense of classic fair use. *Century 21*, 425 F.3d at 221–23. But in fact, this Court in *KP Permanent Make-up* expressly refuses to address nominative fair use in the slightest. 543 U.S. at n. 3. The Supreme Court’s inclusion of the express distinction would be unnecessary if it intended for nominative fair use to be lumped in with classic fair use.

Furthermore, using *KP Permanent Make-up* at all as justification to extend an affirmative defense to defendants in *Century 21* plainly violates the actual intent of the Supreme Court’s ruling that states “the defendant has no independent burden to negate the likelihood of any confusion.” 543 U.S. at 124. Nominative fair use may be “analogous to the statutory-fair use defense,” but it is not an affirmative defense, rather it is “a claim that the use is noninfringing and thus creates no likelihood of confusion.” *Pebble Beach*, 155 F.3d at 545. Thus, applying nominative fair use as an affirmative defense places the burden on the defendant to negate likelihood of confusion. The Third Circuit’s requirement that the defendant prove the affirmative defense of nominative fair use violates *K.P. Permanent Make-up*’s main holding. 543 U.S. at 124.

Clearly, courts did not intend nominative fair use to give a defendant a second chance to prove non-infringement. To rule otherwise places significant strain on the

existing precedent and oversteps judicial authority. This court should not adopt a nominative fair use test, but if they do, judicial precedent and legislative intent demand it is not an affirmative defense but is a part of the likelihood of confusion analysis.

**II. ALTERNATIVELY, IF THIS COURT ADOPTS A NOMINATIVE FAIR USE TEST, IT MUST AFFIRM THE FOURTEENTH CIRCUIT’S ARTICULATION OF THE TEST AND FIND THAT PATEL’S USE VIOLATED CAMMY’S TRADEMARK RIGHTS.**

Assuming this Court adopts a nominative fair use test, fairness demands this Court affirm the Fourteenth Circuit’s articulation because it is the most thorough. The Fourteenth Circuit’s test incorporates nominative fair use factors—using the Third Circuit’s clearer language—as additional factors to the *Polaroid* test. *Gardashyan*, 1135 F.3d at 363. In trademark infringement, courts look at the “products in their totality” to determine the existence of a likelihood of confusion. *Int’l Info. Sys. Sec. Cert. Consortium*, 823 F.3d at 160. To fairly balance the protection of Cammy’s trademark rights with free speech rights this Court should (1) affirm the Fourteenth Circuit’s thorough application and (2) find Patel’s use caused a likelihood of confusion.

**A. THE FOURTEENTH CIRCUIT’S ARTICULATION OF THE TEST ADMINISTERS THE GREATEST FAIRNESS.**

This Court should adopt the Fourteenth Circuit’s nominative fair use test because that test offers the most clarity and thorough evaluation of the circumstances. *See Gardashyan*, 1135 F.3d at 363; *Int’l Info. Sys. Sec. Cert. Consortium*, 823 F.3d at 168. Its eleven-factor test is the fairest method.

The Third Circuit's language articulates nominative fair use factors with the most clarity and raises the bar for those claiming a nominative fair use defense. *Gardashyan*, 1135 F.3d at 364. These nominative fair use factors are:

1. Is the use of the 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 product or service?
3. Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products and services?

See *Century 21*, 425 F.3d at 228. The Ninth Circuit's language of the nominative fair use factors "suffers from a lack of clarity" and applying the Third Circuit's language "would aid in reaching the right result." *Id.*

Conversely, applying ONLY the nominative fair use factors disregards other relevant factors to determine a likelihood of confusion, making this test superficial. The Ninth Circuit's nominative fair use test contains only three prongs. *New Kids*, 971 F.2d at 308. And the third prong of the test shifts the entire focus of the likelihood of confusion test from consumer perception to the defendant's actions, which is a departure from the fundamental purpose of trademark law. Chad J. Doellinger, *Nominative Fair Use: Jardine and the Demise of A Doctrine*, 1 Nw. J. Tech. & Intell. Prop. 5 (2003) ("Professor McCarthy explains '[u]nder the Lanham Act, the only test of infringement is likelihood of confusion, which is a factual issue focusing upon the probable reaction of buyers, not the subjective state of mind of the

defendant seller.”). Therefore, the shift in focus from consumer perception to defendant’s actions paired with the elimination of the other likelihood of confusion factors leaves gaps in the totality of the circumstances analysis. This Court should affirm the Fourteenth Circuit’s thorough formulation and articulation of the nominative fair use test in order to align with the fundamental pillars of trademark law.

**B. PATEL’S USE OF CAMMY’S MARK CAUSED A LIKELIHOOD OF CONFUSION EVEN WHEN THE COURT EMPLOYS THE NOMINATIVE FAIR USE FACTORS IN THE ANALYSIS.**

This Court should affirm the Fourteenth Circuit’s reversal because Patel’s use of the trademark “CAMMY GARDASHYAN” caused a likelihood of confusion. In applying the factors to the alleged pilfering of a trademark, the factors are neither “exclusive” nor “dispositive.” *Int’l Info. Sys. Sec. Cert. Consortium*, 823 F.3d at 160. “[S]ome of the eight factors might not be used,” but “court should assess all three [nominative fair use] factors.” *Gardashyan*, 1135 F.3d at 363. Looking at all the combined factors, Patel’s use of Cammy’s mark created a likelihood of confusion and derailed her protection against infringement.

**1. Patel's use of Cammy's mark caused a likelihood of confusion based upon the application of the *Polaroid* test.**

**Strength of the Marks.** Patel’s use caused a likelihood of confusion because the strength—or inherent distinctiveness—of Cammy’s mark makes it suggestive. The “inherent distinctiveness” and “marketplace recognition value of the mark” determine the mark’s strength. *McCarthy*, *supra*, § 11:83; *Star Indus. v. Bacardi & Co.*, 412 F.3d 373, 384–86 (2d Cir. 2005). The likelihood of confusion increases if a



junior user (one who uses a trademark that is not theirs) takes a more well-known mark because consumers will associate the mark with the senior user (the holder of the trademark). *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 164 (2d Cir. 2004). Moreover, in false endorsement cases under § 1125 of the Lanham Act, courts also apply the same likelihood of confusion test, and, when applying this prong in the celebrity context, the level of the celebrity’s recognition in society correlates to the strength. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

Courts categorize four degrees of inherent distinctiveness—or strength—from weakest to strongest: generic, descriptive, suggestive, and arbitrary or fanciful. *Star Indus.*, 412 F.3d at 384. Suggestive marks intimate qualities of a product “through the use of imagination, thought and perception” without explicitly describing the product. *Id.* at 385; *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 74 (2d Cir. 1988). The Court should categorize Cammy’s mark strength as suggestive.

The Second Circuit holds that suggestive marks weigh towards a likelihood of confusion. *Star Indus.*, 412 F.3d at 385; *Hasbro*, 858 F.2d at 75. In *Hasbro*, the court held that the strong, suggestive mark of “GUNG-HO” inherently described “elements of the personality attributed to the toy” without describing the particular toy’s qualities. 858 F.2d at 75. Not only did the mark require imagination to connect the fantasy personality to the toy action figure, but the mark also served the purpose of “distinctly identifying” its action figure in the market place. *Id.* at 75, 77. Conversely, in *Star Indus.*, the court determined the “O” mark on a bottle of orange flavored

alcohol required minimal imagination and thus barely suggestive when the bottle label also depicted an orange slice. 412 F.3d at 385.

Additionally, courts find the market recognition of the mark correlates to its strength. *Playtex*, 390 F.3d at 164; *Cairns III*, 24 F. Supp. 2d at 1216-21. In *Playtex*, the court held that the mark of "'Wet Ones' . . . without more" did not "conjure up the image of a towelette," thus it was a suggestive mark. 390 F.3d at 164. Additionally, the court classified the mark as suggestive because the market considered it "well-established" and "famous." *Id.* In *Cairns III*, the district court applied the likelihood of confusion analysis for a false endorsement claim when merchandise sold by Franklin Mint depicted the name and likeness of Princess Diana. 107 F. Supp. 2d at 1216-21. The court held that the strength of the mark factor strongly favored the plaintiff since "Princess Diana [was] known throughout the world." *Id.* at 1220.

Cammy's trademark requires customers to take mental strides to connect her world famous mark with her brand, which, paired with her market recognition, establishes a suggestive mark. This favors finding strongly favoring finding a likelihood of confusion. Similar to "GUNG-HO" in *Hasbro*, "CAMMY GARDASHYAN" possesses inherent distinctiveness because the mark suggests elements of Cammy's personal fashionista brand without merely describing her as an individual person. *Gardashyan*, 1135 F.3d at 356; see *Hasbro*, 858 F.2d at 75. Unlike in *Star Indus.*, Cammy's mark does not obviously point to the product behind the mark, rather consumers must imaginatively travel along the winding rail of Cammy's mark to her fashionista brand. *Gardashyan*, 1135 F.3d at 356; see *Star Indus.*, 412 F.3d at 385.

Moreover, like Princess Diana and Wet Ones, Cammy and her mark have become world-famous and people of all ages recognize her. *Gardashyan*, 1135 F.3d at 356; *see Playtex*, 390 F.3d at 164; *Cairns III*, 107 F. Supp. 2d at 1038–39. The strength of Cammy’s suggestive mark is supported by the thought process required to connect the mark with the brand and her market recognition, which weighs heavily towards a likelihood of confusion.

**Similarity of the Marks.** Pattel’s hijacked mark’s similar appearance, sound, and meaning to Cammy’s produce a likelihood of confusion. The Supreme Court has long held “exact similitude is not required” to infringe on a trademark. *McLean v. Fleming*, 96 U.S. 245, 253 (1877). The court must analyze the similarity of the marks and the similarity of the goods and services to determine if a likelihood of confusion exists to a reasonable consumer. McCarthy, *supra*, § 23:20.50. Similarity of the marks is based on the “sight, sound, and meaning” as encountered in the marketplace. *AMF*, 599 F.2d at 351. The greater the similarity in marks, the less similar the goods and services must be to avoid finding a likelihood of confusion. *Bd. of Regents v. S. Ill. Miners, LLC*, 110 U.S.P.Q.2d 1182 (T.T.A.B. Mar. 13, 2014).

A mark’s appearance creates a likelihood of confusion when a junior user applies a substantially similar mark to a product similar to the senior user’s product. *Dorpan, S.L. v. Hotel Melia, Inc.*, 728 F.3d 55, 66 (1st Cir. 2013); *Starbucks*, 588 F.3d at 106; *Volkswagenwerk*, 411 F.2d at 352. In *Dorpan*, a reasonable fact finder could conclude similarity in the junior hotel’s use of the senior hotel’s mark when the most salient word for trademark purposes was “essentially identical” and they offered

overlapping core services to similar customers. 728 F.3d at 66. Conversely, in *Starbucks*, the court held that a mark was minimally similar when the junior user's coffee packaging was different in "imagery, color, and format" from the senior user's coffee packaging. 588 F.3d at 106. Additionally, in *Volkswagenwerk*, a junior user's mark lacked similarity when it did not use the senior user's distinctive lettering, style, or color scheme. 411 F.2d at 352.

The similarity of Pattel's mark weighs toward a likelihood of confusion because Pattel applied a mark nearly identical to Cammy's to its product, and both have the same customer base. *Gardashyan*, 1135 F.3d at 356-57. Pattel progressed full steam ahead by copying the exact standard block style and black coloring of the "CAMMY GARDASHYAN" mark. *Id.*; *but see Starbucks*, 588 F.3d at 106; *but cf. Volkswagenwerk*, 411 F.2d at 352. Furthermore, like in *Dorpan*, Pattel not only commandeered the most salient part of Cammy's mark—her name—but both Pattel and Cammy sell merchandise to customers ranging in age from five to one-hundred. *Gardashyan*, 1135 F.3d at 356; *see Dorpan*, 728 F.3d at 66. This shared customer base hitched with the exactness of the mark heavily favors a likelihood of confusion.

**Evidence that the imitative mark was adopted in bad faith.** This Court should find a likelihood of confusion because Pattel stole Cammy's mark in bad faith. An infringer "exploiting the good will and reputation" of the mark holder to "sow confusion" and deceive consumers on the relationship between the two products constitutes bad faith. *Starbucks*, 588 F.3d at 117–18. Deliberate copying of the mark helps lead to the conclusion the infringer acted in bad faith. *Id.* at 118. Courts infer

bad faith from an infringer's "actual or constructive knowledge" of the trademark. *Star Indus.*, 412 F.3d at 389.

Courts find bad faith weighs toward a likely confusion when the junior user openly admits it intended to capitalize on the senior user's reputation or the junior user knew of the senior user's mark and continued to use it. *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 1056 (8th Cir. 2005); *PACCAR*, 319 F.3d at 254. In *Kemp*, the court found the bad faith factor weighed heavily on a likelihood of confusion when the seafood producer "openly admitted his intention to market his products to take advantage" of the considerable brand equity of the senior seafood producer's investments. 398 F.3d at 1056. Moreover, in *PACCAR*, the court held that a website owner's knowledge that the plagiarized marks were associated with the truck manufacturer indicated the website owner intended to create an impression that its products was associated with the truck manufacturer. 319 F.3d at 254. This weighed toward finding a likelihood of confusion. *Id.*

In contrast, a junior user lacked bad faith when the junior user did not intend to capitalize on the senior user's mark. *Starbucks*, 588 F.3d at 118; *Star Indus.*, 412 F.3d at 389. In *Starbucks*, the court held the alleged infringer did not intend to mislead the public that their company was a part of the Starbucks brand when they called the product "Charbucks," the packaging used different graphics, and the company's small operation had a localized customer base. 588 F.3d at 118. This customer based also held a "large disdain" for large corporations, proving that Charbucks did not intend to exploit Starbucks' large corporation reputation. *Id.*

Furthermore, in *Star Indus.*, the court did not find bad faith because a premier international company would not likely desire to confuse its products with those of the alleged senior user's relatively obscure company, and the premier company completed a trademark search, failing to find the alleged infringed trademark. 412 F.3d at 389.

This Court should find that Pattel acted in bad faith, weighing towards a likelihood of confusion, because Pattel openly admits they based the doll design on Cammy to enhance its profitability by capitalizing on Cammy's dramatic rise in fame following her wedding. *Gardashyan*, 1135 F.3d at 356–57; *see Kemp*, 398 F.3d at 1056. Pattel bummed their way onto Cammy's personal brand, which she built from the ground up. *Gardashyan*, 1135 F.3d at 356. Pattel cannot claim ignorance of Cammy's mark because they actually analyzed "market trends" to pick Cammy as the inspiration for the doll. *Gardashyan*, 1135 F.3d at 356–57; *see Star Indus.*, 412 F.3d at 389. Moreover, Pattel knew the mark was associated with Cammy because Cammy's mark was on all her products, including: jewelry, clothing, cosmetics, perfumes, handbags, and footwear. *See Gardashyan*, 1135 F.3d at 356; *PACCAR*, 319 F.3d at 254. Unlike the junior user in *Starbucks*, customers expect Cammy to attach her mark to a wide variety of goods and her customers would not hold a large disdain for Cammy to attach her mark to a doll. *Gardashyan*, 1135 F.3d at 356; *see 588 F.3d* at 118. Pattel's use of Cammy's mark sows confusion and suggests that Cammy sponsors or produces the Fashionista Bambi doll, which strongly favors finding a likelihood of confusion.

**Proximity of the products and their competitiveness with one another.** The proximity of Cammy's and Pattel's products weigh toward a likelihood of confusion as both sell fashionista themed products. *Gardashyan*, 1135 F.3d at 355–56. Courts find proximity when the marks are linked with the same products. *See Starbucks*, 588 F.3d at 115 (stating both coffee companies use the marks in connection with the sale of the coffee products); *see also Dorpan*, 728 F.3d at 66 (holding "substantial overlap in the core services" existed, even though each user offered some extra amenities that the other did not). The core of Cammy's brand is selling fashion items and the core of Pattel's business is selling a fashion doll to customers. *Gardashyan*, 1135 F.3d at 356–57. Fashion, the core of both parties' products, causes a likelihood of confusion. Pattel is unfairly riding on Cammy's fashionista train, their products are just in different cars.

**Sophistication of consumers in the relevant market.** Unsophisticated consumers exacerbate the likelihood of confusion, especially with similar marks in competitive proximity. *Hasbro*, 858 F.2d at 79. However, even a sophisticated purchaser such as a one hundred dollar premium tequila consumer may “assume nonetheless that the seller is affiliated with or identical to the other party” that contains “[c]onfusingly similar marks.” *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 424 (6th Cir. 2012). Both Cammy's and Pattel's unsophisticated and sophisticated consumers chug toward a likelihood of confusion because the nearly identical marks and the close competitive proximity of the products. *See Maker's Mark Distillery*, 679 F.3d at 424; *Hasbro*, 858 F.2d at 79.

**Other *Polaroid* Factors.** Actual confusion, bridging the gap, and quality factors are neutral to Cammy and Pattel. A likelihood of confusion does not require "actual confusion." *Starbucks*, 588 F.3d at 117. However, a court declined to weigh this factor against a senior user when the junior user's product had only been on the market for around eleven months. *See Hasbro*, 858 F.2d at 78. Therefore, this factor is irrelevant as Pattel's product had only been on the market around one month when Cammy brought suit. *See Gardashyan*, 1135 F.3d at 357. Bridging the gap is neutral to Cammy and Pattel since the products are already in competitive proximity. *Star Indus.*, 412 F.3d at 387 (holding since the "products are already in competitive proximity, there really is no gap to bridge, and this factor is irrelevant to the *Polaroid* analysis."). Similar in *Star Indus.*, quality is irrelevant because "[t]he record is insufficient to support a finding that either product is markedly superior in quality to the other. *Id.* at 389.

**2. Pattel's use of Cammy's mark caused a likelihood of confusion based upon the application of the nominative fair use factors.**

**Necessity of the mark.** Pattel's use of Cammy's mark was unnecessary. Courts look at whether the use is necessary to accurately describe the junior user's product or if the reference to the mark is gratuitous. *Century 21*, 425 F.3d at 229. The less the junior user needs to use the senior's mark to identify its product, the more likely that the use is not fair. *See id.*

A junior user lacked necessity when enough information existed for a customer to identify what the product referenced. *Playboy Enter., Inc. v. Welles*, 279 F.3d 796,



802–05 (9th Cir. 2002) [*Playboy*]; *Pierre & Carlo, Inc. v. Premier Salons, Inc.*, 713 F. Supp. 2d 471, 486 (E.D. Pa. 2010). It was completely unnecessary to use a senior user’s salon name when a junior user could easily advertise its own status as a salon and its location. *Pierre & Carlo*, 713 F. Supp. 2d at 486. Furthermore, a former playmate ran afoul when she unnecessarily used the Playboy’s trademark “PMOY ‘81” to describe her brand and she already sufficiently portrayed this throughout the website by her use of the non-infringing phrase “Playmate of the Year 1981.” *Playboy*, 279 F.3d at 802–05. The mark was used to draw Playboy’s consumers and not to actually describe the product. *See id.* at 804.

Courts find necessity when there is no possible way for the junior user to describe its product without referencing the senior user. *Toyota Motor Sales*, 610 F.3d at 1181; *Cairns*, 292 F.3d at 1153; *Smith v. Chanel, Inc.*, 402 F.2d 562, 567 (9th Cir. 1968). In *Toyota Motor Sales*, the court determined an auto broker could only show that they specialized in selling Lexus cars by using Toyota’s trademarked Lexus name. *See* 610 F.3d at 1181. Next, the Ninth Circuit held no substitute for the use of Princess Diana’s name and likeness existed when a merchant modeled their products specifically on her and the distinct outfits she wore to actual events. *See Cairns*, 292 F.3d at 1153. Thus, no simpler manner to identify her remained because the products centered on the celebrity’s name and likeness. *See id.* Furthermore, a perfume seller needed to use the “Chanel No. 5” trademark because the perfume consisted of “complex ch[em]ical compositions sold under trade names” and using the “Chanel No.

5” trademark was the only way the seller could compare its similar perfume. *Smith*, 402 F.2d at 567.

This Court should find a likelihood of confusion because Pattel pointlessly swiped Cammy's mark. Merely having the doll say, “I want to be a fashionista,” easily conveys the fashion-related message. *Gardashyan*, 1135 F.3d at 355, 357; *see Playboy*, 279 F.3d at 802–05; *see also Pierre & Carlo*, 713 F. Supp. 2d at 486. Like the reconstruction era carpetbaggers, Pattel hopped on the train built by Cammy without her permission. Unlike in *Cairns*, Pattel designed a doll named “Fashionista Bambi,” conveying *characteristics* of female independence, and did not design “The Cammy Gardashyan Doll,” conveying Cammy’s likeness. *Gardashyan*, 1135 F.3d at 357; *see* 292 F.3d at 1153. In addition, the doll did not imitate a specific outfit worn by Cammy at an actual event, but copied her signature style. *Gardashyan*, 1135 F.3d at 356-57; *see Cairns*, 292 F.3d at n.12. It was more profitable for Pattel to hitch a ride on Cammy's train, but it was neither necessary nor fair and they should have only referred to their doll as a fashionista. *See Playboy*, 279 F.3d at 802–05. Unlike the complex, chemical composition of a perfume, fashionista is the only descriptor crucial to distinguish this Bambi doll. *See Smith*, 402 F.2d at 567. Thus, this Court should hold that Pattel’s avoidable use of Cammy’s mark caused a likelihood of confusion.

**Only so much of the mark used as is necessary.** Even if Pattel needed to use Cammy’s mark to describe its product, they excessively used Cammy’s mark. In analyzing this prong of the nominative fair use test, courts must determine if the

infringer “step[ped] over the line into a likelihood of confusion by using the senior user’s mark too prominently or too often, in terms of size, emphasis, or repetition.” *Int’l Info. Sys. Sec. Cert. Consortium*, 823 F.3d at 168. Courts evaluate “the manner in which the mark is portrayed.” *Century 21*, 425 F.3d at 230.

An automobile lube business used Pennzoil’s motor oil brand mark more than necessary when it listed the oil brand on both interior and exterior signs and the very visible, five foot wide, exterior sign featured the stolen “PENNZOIL” mark in all capitals, unlike the rest of the sign’s content. *See Pennzoil-Quaker State Co. v. Smith*, No. 2:05CV1505, 2008 WL 4107159, at \*30 (W.D. Pa. 2008). Conversely, a coffee machine producer did not contest a coffee cartridge producer’s use was more than necessary when the cartridge producer used the mark only twice: (1) to indicate the cartridge’s compatibility with the machine and (2) to disclaim their accurate relationship. *Keurig, Inc. v. Straum Foods, Inc.*, 769 F. Supp. 2d 699, 704, 709 (D. Del. 2011).

Pattel used Cammy’s mark more than necessary, causing a likelihood of confusion. Pattel placed Cammy’s mark on the interior of the doll in the voice recording and on the exterior of the Bambi doll’s packaging, like in *Pennzoil-Quaker State. Gardashyan*, 1135 F.3d at 357; *see* 2008 WL 4107159, at \*30. Unlike in *Keurig*, Pattel did not use Cammy’s mark to indicate compatibility or to merely disclose its relationship. *Gardashyan*, 1335 F.3d at 357; *but see* 769 F. Supp. 2d at 704, 709. This court must find Pattel used Cammy’s mark more than necessary because of the amount of marks applied.

**Reflection of the relationship between the parties.** Pattel’s use of Cammy’s mark falsely implies the doll’s endorsement by Cammy. This prong favors the senior user when the junior user creates confusion “regarding affiliation, sponsorship, or endorsement by the mark holder.” *Int’l Info. Sys. Sec. Cert. Consortium*, 823 F.3d at 169. According to a Merchandising Reporter study, over ninety percent of the public believes “no product can bear the name of an entertainer, cartoon character, or some other famous person unless permission is given by the owner of the name or character.” Matt Whibley, *Celebrity and Trademarks: Why Courts Should Recognize a Celebrity-Likeness-Mark*, 43 Sw. L. Rev. 121, 142 (2013). The use of a celebrity’s likeness suggests she approves the product. *Id.* A disclaimer’s existence is important, but more important is how an alleged infringer applies the disclaimer to reflect the relationship. *Century 21*, 425 F.3d at 231.

Courts find a deceiving relationship between parties when the trademarked name is prominent, the mark is that of a celebrity, and a disclaimer is placed in an easily overlooked manner. *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 908 (9th Cir. 2003); *Abdul-Jabbar v. GMC*, 85 F.3d 407, 412-13 (9th Cir. 1996); *Elec. Arts, Inc. v. Textron Inc.*, No. C 12-00118 WHA, 2012 WL 3042668, at \*\*12–13 (N.D. Cal. July 25, 2012). A Beach Boys cover band—“Beach Boys Family and Friends”—implied a false sponsorship with the Beach Boys when they used their mark in their band name “more prominently and boldly” than the rest of the name. *Brother Records*, 318 F.3d at 908. This confused consumers about who was performing. *Id.* Next, in *Abdul-Jabbar*, a genuine issue of material fact existed when celebrity Kareem Abdul-

Jabbar's mark was used in a television commercial and many assumed he endorsed the product. 85 F.3d at 412-13. In *Electronic Arts*, issues of material fact existed regarding false endorsement, even though the infringer included a disclaimer on the video game packaging, because "plausibly" an eager consumer "anxious to rip open the package" might not see the disclaimer on the back. *Elec. Arts*, 2012 WL 3042668 at \*\*12-13.

On the other hand, courts hold that an obvious disclaimer implies an accurate relationship between the two parties. *Playboy*, 279 F.3d at 796, 803; *Keurig*, 769 F. Supp. 2d at 709; *Playboy Enter., Inc. v. Welles*, 78 F. Supp. 2d 1066, 1072 (S.D. Cal. 1999) [*Welles*]. In *Keurig*, the court held that a coffee cartridge producer accurately and clearly portrayed the parties' true relationship when they placed a disclaimer on the back of the packaging "directly across" from directions that consumers would likely read; thus, they would "easily see the disclaimer." *Keurig*, 769 F. Supp. 2d at 709. Similarly, a Playmate included a "clear statement disclaiming any connection" to Playboy on nearly every webpage, which depicted her true relationship with Playboy. *Playboy*, 279 F.3d at 803; *Welles*, 78 F. Supp. 2d at 1072.

Pattel deceptively implies Cammy's endorsement by prominently displaying her mark on the front of the box, constructing a doll that exclusively says, "I want to be a fashionista, just like Cammy Gardashyan," and only including a tiny disclaimer on the "back lower portion of the box." *Gardashyan*, 1135 F.3d at 357. The caption bubble on the package's front only mentions Cammy, and completely leaves off "a fashionista," misquoting the Bambi Doll's actual words and inappropriately fast-

tracking consumers toward assuming Cammy's endorsement. *Gardashyan*, 1135 F.3d at 357; see *Brother Records*, 318 F.3d at 908. Plus, using Cammy's name in a voice recording of the doll is similar to a television commercial referencing a celebrity's name along with a product. See *Abdul-Jabbar*, 85 F.3d at 412–13. Pattel's customers would not easily find its disclaimer as most would not have a reason to look on the lower back of the box to read the tiny print. See *Keurig*, 769 F. Supp. 2d. at 709. Similar to *Electronic Arts*, consumers, eager to start playing with the Pattel's fun doll, will excitedly rip open the package and not see the tiny disclaimer in ten-point font on the back. See 2012 WL 3042668 at \*\*12–13. This Court must find that Pattel's use violated Cammy's trademark right because their use implies a false relationship.

**C. CAMMY SUCCEEDS EVEN IF THIS COURT CHOOSES TO APPLY THE NINTH CIRCUIT'S FLAWED NOMINATIVE FAIR USE TEST.**

Even if this Court decides to apply the Ninth Circuit's nominative fair use test, Cammy must succeed. The Third Circuit, in *Century 21*, clarified the nominative fair use test to reduce the confusion in the lower courts. 425 F.3d at 228. The Ninth Circuit's nominative fair use test is merely a substitute to the multi-factor likelihood of confusion tests and is applied in the same manner as the Third Circuit's nominative fair use test. *McCarthy*, *supra*, § 23:11. Therefore, the application of the Second Circuit's *Polaroid* factors and the Third Circuit's nominative use factors serve to answer the Ninth Circuit's test. Pattel's use of Cammy's mark caused a likelihood of confusion thus unethically infringing on the fundamental rights protected by her registered trademark.

## CONCLUSION

Pattel, focusing on profit, deceitfully violated Cammy's trademark rights, essentially free riding on the brand fostered by Cammy's hard work. This Court should affirm the Fourteenth Circuit in holding only because it incorrectly adopted a nominative fair use test, and the flexibility innate in the multifactor likelihood of confusion test fairly regulates trademark infringement claims even in the context of nominative uses. However, if this Court chooses to adopt a nominative fair use test, it should affirm the Fourteenth Circuit's articulation of the test—the nominative fair use factors in conjunction with the *Polaroid* test.

To apply nominative fair use as an affirmative defense would violate judicial precedent, legislative intent, and cause chaos in judicial application. Similarly, to follow the Ninth Circuit and apply nominative fair use as a substitution for the likelihood of confusion test would disregard important factors in evaluating the totality of the circumstance and improperly sway the focus of the analysis from consumer confusion to the defendant's affirmative actions. No matter which test is applied, Pattel's unauthorized use of Cammy's mark causes a likelihood of confusion and violates her rights under § 1114 of the Lanham Act. For these reasons, this Court should affirm the Fourteenth Circuit and hold that Pattel's use of Cammy's mark constitutes a trademark infringement, not a nominative fair use.

WHEREFORE, PREMISES CONSIDERED, Respondent respectfully requests that this Court affirm the decision of the Fourteenth Circuit.

Respectfully Submitted,

/s/ Team # 113

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