

IN THE
Supreme Court of the United States

PATTEL, INC., A BEL AIR CORPORATION,

Petitioner,

v.

CAMMY GARDASHYAN, AN INDIVIDUAL,

Respondent.

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

BRIEF FOR PETITIONER

TEAM No. 115
COUNSEL FOR PETITIONER
OCTOBER 21, 2016

QUESTIONS PRESENTED

1. Should we adopt a nominative fair use test in a trademark infringement action under § 1114 of the Lanham Act when a defendant used the plaintiff's mark in reference to the plaintiff, and if so, should we adopt it as an affirmative defense that may be asserted by the defendant despite a finding of a likelihood of confusion or does it become a part of the likelihood of confusion analysis?
2. Assuming a nominative fair use test is adopted, how should the test be articulated and applied to the present case?

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OPINIONS AND ORDERS BELOW

The final judgment for the Fourteenth Circuit Court of Appeals is reported and appears at *Gardashyan v. Pattel, Inc.*, 1135 F.3d 759 (14th Cir. 2016) and in the Record at pages 355 to 366.

STATEMENT OF JURISDICTION

This Court has jurisdiction to review the final judgement of the Fourteenth Circuit Court of Appeals under 28 U.S.C.A. § 1254(1) (West, Westlaw through P.L. No. 114-229).

STATUTORY PROVISIONS INVOLVED

15 U.S.C.A. § 1114 (West, Westlaw through Pub. L. No. 114-229).

15 U.S.C.A. § 1115 (West, Westlaw through Pub. L. No. 114-229).

28 U.S.C.A. § 1254(1) (West, Westlaw through Pub. L. No. 114-229).

STATEMENT OF THE CASE

Since 1961, Petitioner Pattel, Inc. has designed and manufactured toys, including Bambi dolls, the product at issue here. Rec. at 355. Consumers of all ages are attracted to Bambi dolls; Pattel thus targets consumers ranging from ages three to one hundred. *Id.* The design of Bambi dolls typically incorporates both the “original look” of its original dolls and characteristics inspired by modern-day celebrities, such as movie and television stars, musicians, and fashion models. *Id.*

One such inspiration for Pattel’s Bambi doll was Respondent Cammy Gardashyan, a reality television star, model, singer, businesswoman, and socialite. *Id.* at 356. Gardashyan garnered tens of millions of followers on various social media and online outlets after her success in the TV! Network’s reality television series “Keeping Up with the Gardashyans.” *Id.* Gardashyan is a household name, and her products as well as her fan base reach people from ages five to one hundred. *Id.* As a businesswoman, Gardashyan has successfully produced a variety of goods associated with her mark, a feat that has earned her over fifty million dollars in 2015 alone. *Id.*

The goods Gardashyan produces include jewelry, clothing, and cosmetics, among others, all which bear her name and mark. *Id.* Gardashyan owns the trademark CG CAMMY GARDASHYAN™, a mark she utilizes to protect her personal brand. *Id.* Her mark is a stylized “CG” displayed back to back, and the words “CAMMY GARDASHYAN” underneath in capital letters and in standard, block typeface. *Id.*

Gardashyan’s overall style is comparable to many of her celebrity contemporaries, such as her three sisters. *Id.* Her style includes animal prints, knee-length skirts or dresses, and shiny high-heeled shoes, her hair is usually worn long, black, and straight, and she is known for her “curvy” figure. *Id.* While Gardashyan’s “look” does have distinctive characteristics, various celebrities, who are also widely recognized portrayed in the entertainment media, have a similar sense of style and look. *Id.*

Pattel analyzes style and market trends each year in order to create a product that will be highly profitable. *Id.* Following Gardashyan’s raise to fame, Pattel decided the 2015 Bambi doll would utilize Gardashyan’s look—a look that was ever-increasing in the fashion and entertainment industry. *Id.* at 356–57.

Pattel named the 2015 Bambi doll “Fashionista Bambi.” *Id.* at 357. The doll has the height and body figure of standard Bambi dolls. *Id.* Additionally, the Fashionista doll has long, black, straight hair and wears a leopard print top, knee-length skirt, and sparkly high-heeled shoes. *Id.* Fashionista Bambi also has a voice feature that, upon activation, projects the recorded phrase, “I want to be a fashionista, just like Cammy Gardashyan.” *Id.*

Fashionista Bambi comes in the standard Bambi box, which displays Pattel’s standard messages, warnings, recommendations, and the Bambi trademark. *Id.* The box also displays the doll’s name and a caption bubble reading, “I say: I want to be just like Cammy Gardashyan,” in size twenty-point font. *Id.* Also included on the box is a disclaimer, in ten-point font size, which reads: “Pattel, Inc. and Fashionista

Bambi are not sponsored by or affiliated with Cammy Gardashyan.” *Id.*

Furthermore, the Cammy Gardashyan logo was not fully utilized, and both times “Cammy Gardashyan” was referred to on the box, Pattel used a standard black block typeface. *Id.*

The Fashionista Bambi doll was released for nationwide sale in January 2015, without seeking Gardashyan’s approval to use her name and a portion of her trademark. *Id.* Shortly thereafter, on February 9, 2015, Gardashyan sought a permanent injunction against Pattel for trademark infringement of the “Cammy Gardashyan” mark. *Id.* Pattel responded that the claim should be dismissed because its use of Gardashyan’s name on the Fashionista Bambi dolls was fair under the nominative fair use defense. *Id.*

The District Court for the Central District of Bel Air granted summary judgment in favor of Pattel after finding that its use of Gardashyan’s name and mark constituted nominative fair use. *Id.* at 358. On appeal, the Fourteenth Circuit Court reversed. *Id.*

SUMMARY OF THE ARGUMENT

I. In nominative fair use cases where a defendant has used a plaintiff's mark to describe the plaintiff's product, this Court should adopt a nominative fair use test as an affirmative defense.

This Court should adopt a test separate from classic fair use for nominative fair use; this separate test involves two-step approach: first, the plaintiff must prove that the defendant's use of the plaintiff's mark is likely to cause consumer confusion; and second, after the plaintiff has shown a likelihood of confusion, the defendant may assert an affirmative defense demonstrating that the use of plaintiff's mark is fair despite the likelihood of confusion.

A separate test should be adopted for nominative fair use. Numerous circuit courts have agreed that nominative fair use should be analyzed beyond merely likelihood of confusion. Furthermore, the nominative fair use test should be a two-step approach, where the defendant may assert nominative fair use as an affirmative defense, because: (1) it follows the Lanham Act; (2) the tests for classic and nominative fair use are very similar; (3) it places a reasonable burden on the defendant; (4) fair use and likelihood of confusion can coexist; and (5) it is a simpler and more manageable test.

II. This Court should adopt the Ninth Circuit's three-pronged nominative fair use defense and should hold in favor of Pattel, Inc.

The Ninth Circuit's three-pronged test for a nominative fair defense includes: (1) the product is not readily identifiable without the defendant's use of the plaintiff's mark; (2) only so much of the mark was used as is reasonably necessary

to identify the product; and (3) the defendant did nothing that would, in conjunction with the mark, indicate the plaintiff's sponsorship or endorsement.

First, the Fashionista Bambi doll is not readily identifiable without the use of Gardashyan's name because many celebrities have a similar style as Gardashyan. Second, Pattel only used Gardashyan's mark to the extent reasonably necessary to identify the doll; Pattel did not use the entire mark and used a minimum of Gardashyan's characteristics. Third, Pattel did nothing to suggest that Gardashyan sponsored or was affiliated with the doll, as demonstrated by the use of Pattel's disclaimer on the doll's box.

Even if this Court applies the Third Circuit's stricter three-pronged test, Pattel still satisfies all three prongs because the use of the mark is necessary to describe both Gardashyan's and Pattel's product, only so much of the mark was used as is necessary to describe Gardashyan's product, and Pattel's conduct accurately described its relationship with Gardashyan.

Accordingly, this Court should adopt a separate nominative fair use test as an affirmative defense, adopt the Ninth Circuit's three-pronged test, and hold in favor of Petitioner Pattel, Inc.

ARGUMENT

The Lanham Act is a federal law that protects a plaintiff's trademark against infringement. 15 U.S.C.A. § 1114 (West, Westlaw through Pub. L. No. 114-229). In order to be successful under the Act, the plaintiff must show that the defendant's use of the plaintiff's mark "is likely to cause confusion, or to cause mistake, or to deceive." *Id.* Essentially, "if the [defendant's] use causes confusion among consumers regarding the origin of the goods, then a party is protected under [the Act]." *Rec.* at 358. Here, Gardashyan alleges that Pattel used her name and mark on the Fashionista Bambi doll and box, subsequently creating a likelihood of confusion in consumers that Gardashyan's mark was affiliated with the doll. *Id.*

The issues presented are: (1) should the Court adopt a nominative fair use test in a trademark infringement action under § 1114 of the Lanham Act when a defendant used the plaintiff's mark in reference to the plaintiff, and if so, should the Court adopt it as an affirmative defense that may be asserted by the defendant despite a finding of a likelihood of confusion or should it become a part of the likelihood of confusion analysis; and (2) assuming the Court does adopt a nominative fair use test, how should the test be articulated and applied to the present case?

I. This Court should adopt a nominative fair use test as an affirmative defense in trademark infringement actions where a defendant used a plaintiff's mark to describe the plaintiff's product.

Pattel is entitled to a nominative fair use defense for its references to Respondent Cammy Gardashyan to describe Pattel's product, a Gardashyan-related Bambi doll, regardless of there being a finding of likelihood of confusion. Even if Gardashyan proves that Pattel's use of Gardashyan's name and mark on the Bambi Fashionista dolls resulted in a likelihood of confusion among consumers, Pattel should nonetheless be afforded the chance to bring forth a nominative fair use defense.

A. This Court should affirm the Fourteenth Circuit's decision to adopt a separate test for nominative fair use.

Nominative fair use should be a separate analysis from classic fair use. There are two types of fair use, classic fair use and nominative fair use. In classic (or descriptive) fair use cases, a defendant has utilized a plaintiff's mark to describe the defendant's own product. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). However, the circuit courts are split as to whether a separate fair use test—nominative fair use—should be adopted for infringement claims when a defendant used a plaintiff's mark to describe the trademark holder's goods, rather than the defendant's goods. *See id.* at 308.

In classic fair use cases, the Lanham Act specifically enumerates the available affirmative defenses that a defendant is afforded. *See* 15 U.S.C.A.

§ 1115(b) (West, Westlaw through Pub. L. No. 114-229). However, in 1992, the Ninth Circuit Court of Appeals judicially created a defense, dubbed the “nominative fair use defense,” which was to be applied in trademark infringement suits where a defendant used the plaintiff’s mark in a way to refer to the plaintiff’s goods in a manner not designed to cause confusion. *See New Kids*, 971 F.2d 302. Broadly speaking, nominative fair use is the non-trademark use of another mark. *Id.* at 307. The use is one “where the only word reasonably available to describe a particular thing is pressed into service.” *Id.* at 308. This type of fair use is the utilization of a mark in a way that does not venture to exploit consumer confusion or to appropriate the distinction and reputation of one product or service for a different one. *Id.* at 307–08. Furthermore, nominative fair use “lies outside the strictures of trademark law,” as it does not implicate or associate the “source-identification function” that was the purpose of the trademark. *Id.* at 308. Ultimately, nominative use is fair and it does not constitute unfair competition because such minimal use of the mark “does not imply sponsorship or endorsement by the trademark holder.” *Id.*

The Second, Third, Ninth, and Fourteenth Circuit Courts of Appeals have all specified that in cases regarding nominative fair use, an additional analysis beyond likelihood of confusion is required. *Rec.* at 360. The Sixth Circuit, however, has declined to recognize a separate nominative fair use test, stating that the likelihood of confusion test is adequate, even in cases where a defendant used the plaintiff’s mark to describe the plaintiff’s own products, as we have here. *Rec.* at 360. The Sixth Circuit furthermore contends that it will not adopt a nominative fair use test

because it was created judicially, unlike the classic fair use test, which is outlined in the Lanham Act.

As demonstrated by the circuit courts, the nominative fair use defense is mirrored in confusion. However, if a court only applied likelihood of confusion, the result “would lead to the incorrect conclusion that virtually all nominative uses are confusing” because “[w]hen a defendant uses a trademark nominally, the trademark will be identical to the plaintiff’s mark, at least in terms of the words in question.” *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002). Ultimately, “the likelihood of confusion test as applied in nominative fair use cases would disadvantage the defendant by making confusion an all but foregone conclusion.” *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211, 220 (3d Cir. 2005). While incorrect in its adoption of the nominative fair use analysis, the Fourteenth Circuit was correct in indicating that “there needs to be an additional analysis beyond likelihood of confusion when assessing nominative fair use.” Rec. at 360. Thus, this Court should adopt a separate nominative fair use test.

B. This Court should reverse the Fourteenth Circuit’s decision to adopt nominative fair use as part of the likelihood of confusion analysis and should instead adopt the nominative fair use test as an affirmative defense that may be asserted by the defendant despite a likelihood of confusion.

Typically, trademark infringement analyses focus on whether a defendant’s use of a plaintiff’s mark, or a similar mark, is likely to cause consumer confusion. Despite a finding of likelihood of confusion, however, a defendant may assert an

affirmative defense that its use of the plaintiff's mark is fair. "Fair use" is a concept sometimes confused because the term refers to both classic and nominative fair use.

In nominative fair use cases, a two-step approach should be employed. *Id.* at 222. First, the plaintiff must "prove that confusion is likely due to the defendant's use of plaintiff's mark." *Id.* Second, and after plaintiff has proved that confusion is likely, "the burden then shifts to defendant to show that its nominative use of plaintiff's mark is nonetheless fair." *Id.*

Likelihood of confusion is the foundation of the analysis for trademark infringement. It serves the twofold purpose of trademarks by balancing the security provided to producers in the goodwill entrusted in a mark with the possibility of deceiving consumers. There is no need for an infringement defense if there is confusion. However, if there is confusion or the potential for confusion, the nominative fair use defense can be used as a tool for determining if the use of the mark was fair, notwithstanding confusion. This defense is necessary for the continued flow of information in the market, a feat which ultimately benefits consumers. The nominative fair use test should be adopted as an affirmative defense and should not be incorporated into the likelihood of confusion analysis for five main reasons.

First, disallowing a defendant the opportunity to bring forth an affirmative defense based on nominative fair use contravenes the Lanham Act. In classic fair use cases, the likelihood of confusion analysis remains necessary and the classic fair use analysis merely complements the likelihood of confusion analysis. *See Cairns v.*

Franklin Mint Co., 292 F.3d 1139, 1151 (9th Cir. 2002). Furthermore, in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, this Court held that, while the Lanham Act requires the plaintiff to show likelihood of confusion, the Act is silent as to the elements of confusion with respect to the § 1115(b)(4) “fair use” defense. *KP Permanent Make-Up*, 543 U.S. at 118. This statute simply affords the defendant an affirmative defense when the plaintiff’s mark is “used fairly and in good faith only to describe the goods or services.” § 1115(b)(4). Thus, it follows that this same approach should be utilized when faced with a nominative fair use defense.

Second, nominative fair use is similar to classic fair use and should thus also be adopted as an affirmative defense once likelihood of confusion has been proven by the plaintiff. Section 1115(b)(4) of the Lanham Act outlines the classic fair use defense, which provides the defendant with an affirmative defense for the use of a mark that is descriptive and used “fairly and in good faith” to describe the defendant’s own goods or services. § 1115(b)(4). In *KP Permanent Make-Up*, this Court determined that likelihood of confusion and fair use can coexist, stating that “[s]ince the burden of proving likelihood of confusion rests with the plaintiff, and the fair use defendant has no free-standing need to show confusion unlikely . . . it follows that some possibility of consumer confusion must be compatible with fair use.” *Century 21*, 425 F.3d at 217 (quoting *KP Permanent Make-Up*, 543 U.S. at 121).

In *KP Permanent Make-Up*, this Court reversed the Ninth Circuit’s holding because it incorrectly applied the classic fair use doctrine. *See KP Permanent Make-Up*, 543 U.S. 111. There, the court was considering classic fair use but incorrectly applied the likelihood of confusion test when it merged the likelihood of confusion analysis with the classic fair use analysis. The Ninth Circuit in *KP Permanent Make-Up* incorrectly applied the fair use doctrine and here, too, the Fourteenth Circuit misapplied the test for nominative fair use. Because the tests for classic and nominative fair use are very similar, the two tests should be interpreted the same.

When comparing the factors used in the classic and nominative fair use, there is a clear correlation between the two defenses. As stated above, when determining classic fair use, courts look to whether the mark was used “fairly and in good faith.” § 1115(b)(4). This good-faith requirement was adopted by both the Third and Ninth Circuits in the second and third prongs of the nominative fair use test, *infra* pt. II, which focus on the necessity of using the mark in whole or in part and on the relationship that was implied by the use of the mark. *See New Kids*, 971 F.2d at 308; *Century 21*, 425 F.3d at 228. These two prongs center on the “fairness” and “good faith” use of the mark. While the distinguishing characteristic of nominative fair use is that the mark’s use is to describe the plaintiff’s good rather than the defendant’s, the overwhelming similarities between a classic fair use defense and a nominative fair use defense demonstrate that nominative fair use should be available as an affirmative defense. Thus, based on the similarity

between the two tests and this Court's decision regarding classic fair use in *KP Permanent Make-Up*, nominative fair use should also be an affirmative defense.

Third, the two-step approach places a reasonable burden on the defendant. In *KP Permanent Make-Up*, this Court rejected the proposition to incorporate the factors for determining fairness into the likelihood of confusion test because "a plaintiff's showing of confusion might overwhelm a defendant's showing of fair use," which would effectively "force a defendant asserting nominative fair use to negate all likelihood of confusion to succeed." *Century 21*, 425 F.3d at 223; *see also KP Permanent Make-Up*, 543 U.S. at 125. In the two-step approach proposed here, the defendant does not have the duty to refute confusion, but must establish that its use of the plaintiff's mark is fair regardless of a finding of confusion. *Century 21*, 425 F.3d at 223; *see also KP Permanent Make-Up*, 543 U.S. at 125.

Furthermore, because this bifurcated approach separately analyzes likelihood of confusion and fairness, the burden is consequently allocated appropriately between the parties at each step of the test. *Century 21*, 425 F.3d at 232. By allowing a defendant to utilize nominative fair use as an affirmative defense, courts have the possibility to find a certain degree of confusion, yet could ultimately conclude the use to be fair. *Id.* Should a court use the unified likelihood of confusion test, a defendant would be required to disprove any likelihood of confusion by undermining the factors for showing likelihood of confusion. Because this Court explicitly rejected such a proposition in *KP Permanent Make-Up*, this Court should hold similarly and adopt nominative fair use defense. *Id.*

Fourth, the test promulgated by the Fourteenth Circuit does not account for the possibility that fair use and likelihood of confusion can coexist. Rec. at 366 (Circuit Judge Peterson, dissenting); *see also Century 21*, 425 F.3d at 222. This Court has stated that confusion and fair use can coexist. *KP Permanent Make-Up*, 543 U.S. at 121. From common law, it is clear that there can be a certain degree of consumer confusion in order to avoid a monopoly on the use of a descriptive term that is used as a trademark. *Id.* at 122. Furthermore, the Lanham Act offers no indication of its intention to deny entities the opportunity to utilize the “ordinary utility of descriptive words.” *Id.* “If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well-known descriptive phrase.” *Id.* The Lanham Act was intended to prevent commercial monopolization of ordinary language in addition to protecting an individual’s right to use words in their primary descriptive sense. *Id.*

Finally, the proposed two-step approach is a simpler and largely accepted test for determining nominative fair use. This approach “considers distinct factors that are readily susceptible to judicial inquiry.” *Century 21*, 425 F.3d at 224. The Fourteenth Circuit’s approach incorporated and introduced numerous considerations into an extensive eleven-part analysis for confusion, an approach which would require courts to balance a plaintiff’s finding of confusion against a defendant’s showing of fair use. Rec. at 360–62 (“when considering nominative fair use cases, courts are to consider the [eight] *Polaroid* factors . . . plus the three nominative fair use factors.”); *see also Century 21*, 425 F.3d at 224. However, this

approach is convoluted and “much less manageable” because it blends confusion and fairness together into one test, which are two separate and distinct concepts that coexist, but should not be blended. *See Century 21*, 425 F.3d at 224.

The Fourteenth Circuit held that the district court used a flawed approach to nominative fair use because the bifurcated approach “affords defendants broader protection by allowing them a second bite at the apple, and misinterprets the Supreme Court’s ruling in *KP Permanent Make-Up*, on § 1115(b).” Rec. at 361. However, the Fourteenth Circuit incorrectly assumes that the two-step test gives defendants “a second bite at the apple”; this test merely allows the defendant to properly assert that the use of the plaintiff’s mark is fair. The Fourteenth Circuit furthermore inappropriately believes that nominative fair use cannot be brought forth when there is a showing likelihood of confusion. *Id.* Yet even in cases where a court could determine that nominative use was fair, there is still potential for consumer confusion. *Century 21*, 425 F.3d at 221. Nevertheless, based on this Court’s ruling in *KP Permanent Make-Up* and the Third Circuit’s ruling in *Century 21*, “confusion and fairness are separate and distinct concepts that can co-exist.” *Id.* at 224.

Moreover, the Fourteenth Circuit’s test relieves plaintiffs of the burden of proving likelihood of confusion as a precondition, which is an incorrect interpretation of this Court’s ruling in *KP Permanent Make-Up*. *See id.* at 221. This Court plainly stated that in fair use, “if a plaintiff succeeds in making out a prima facie case of trademark infringement, including the element of likelihood of

consumer confusion, the defendant may offer rebutting evidence to undercut the force of the plaintiff's evidence on this (or any) element, or raise an affirmative defense to bar relief even if the prima facie case is sound, or do both." *KP Permanent Make-Up*, 543 U.S. at 120. The Fourteenth Circuit also noted that this Court specifically clarified in *KP Permanent Make-Up* that it was only addressing classic fair use, stating, "it would be improvident to go further in this case, for deciding anything more would take us beyond the Ninth Circuit's consideration of the subject." *KP Permanent Make-Up*, 543 U.S. at 123; *see also id.* at n.3 (refusing to address the discussion of nominative fair use made by the Ninth Circuit in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1071–72 (9th Cir. 2003), *rev'd on other grounds*, 543 U.S. 111 (2004)). Thus, this Court should adopt the nominative fair use test as an affirmative defense.

II. This Court should reverse the Fourteenth Circuit's decision to use the Third Circuit's version of the three-pronged nominative fair use factors and should instead adopt the Ninth Circuit's three-pronged, age-old test.

In using the two-step approach from part I, *supra*, a plaintiff must first prove there is a likelihood of confusion. *See Century 21*, 425 F.3d at 231–32. It is then appropriate to continue to the Ninth Circuit's three-pronged nominative fair use test. *See id.*

A. Pattel satisfies all three prongs of the Ninth Circuit’s nominative fair use test.

This Court should adopt the Ninth Circuit’s three-prong test in nominative fair use cases because it has withstood the test of time, is consistent with the Court’s holding in *KP Permanent Make-Up*, and places a reasonable burden on the defendant.

A defendant who has used a plaintiff’s trademark to describe the plaintiff’s product, rather than to describe the defendant’s product, is entitled to a nominative fair use defense upon satisfying the following three requirements: (1) the product in question is not readily identifiable without use of the trademark; (2) only so much of the mark or marks was used as is reasonably necessary to identify the product; and (3) the user did nothing that would, in conjunction with the mark, indicate the trademark holder’s sponsorship or endorsement. *New Kids*, 971 F.2d at 308.

1. The Fashionista Bambi doll is not readily identifiable without use of the Gardashyan’s name.

The product or service in question must be one not readily identifiable without the use of the trademark. *Id.* In *New Kids on the Block v. News America Publishing Inc.*, the Ninth Circuit held that the two newspaper companies could not have identified the music group without the use of their name. *Id.* Similarly, the Ninth Circuit concluded in *Playboy Enterprises, Inc. v. Welles* that the defendant’s use of the terms “playboy” and “playmate” on her website was nominal use because identifying the defendant as a “nude model” rather than a “playmate” would be ineffective. *Playboy Enters.*, 279 F.3d at 802–04. In *Arenas v. Shed Media U.S. Inc.*,

the district court held that it would be “virtually impossible” for the media company to refer to the plaintiff athlete in its television show without using his name. *Arenas v. Shed Media U.S. Inc.*, 881 F. Supp. 2d 1181, 1193 (C.D. Cal. 2011).

Here, similar to the newspaper companies in *New Kids* and the media company in *Arenas*, Pattel could not have effectively referred to Gardashyan without the use of her name and mark. Additionally, just as there are numerous magazines and websites whose purpose is to feature nude women, there are numerous fashion icons that permeate society and the entertainment culture. In *Playboy Enterprises*, the only way to refer to Playboy was to use the Playboy mark; likewise, the only way to refer to Gardashyan was to use her name and mark.

Further, Pattel’s use of Gardashyan’s name would be ineffectual if it had only used the term “Fashionista,” similar to the defendant in *Playboy Enterprises* who could not identify herself as a playmate using just the term “nude model,” because many other celebrities, including Gardashyan’s three sisters, have similar features and a similar sense of style. Rec. at 356. Gardashyan would not have been readily identifiable without the use of her name and mark. Thus, Pattel satisfied the first prong.

2. Pattel only utilized Gardashyan’s mark to the extent that was reasonably necessary to identify the Fashionista Bambi doll as Gardashyan.

Only so much of a mark or marks may be used as is reasonably necessary to identify the product or service. *New Kids*, 971 F.2d at 308. In *Playboy Enterprises*, for example, the defendant model’s use of trademarks in her website’s headlines

and banner advertisements was held to be reasonably necessary to refer to the Playboy trademark. *Playboy Enters.*, 279 F.3d at 802. Also, in *Mattel, Inc. v. MCA Records, Inc.*, the district court held that a record company who created the song *Barbie Girl* constituted nominative fair use of the Barbie doll manufacturer's trademark because the use of the term "Barbie" was deemed necessary to effectively parody the image of the doll. *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1141–42 (C.D. Cal. 1998). The record company in *Mattel* only used the term "Barbie" to the extent necessary to identify and parody the doll. *Id.* at 1142.

Here, Pattel's use was aligned with case law that looks to the reasonable amount necessary to refer to the trademark in question. Similar to *Mattel*, Gardashyan's mark was only used to the extent necessary to identify the doll as Gardashyan. The Fashionista Bambi doll was dressed in clothes of the same style generally worn by Gardashyan, the doll's recording said, "I want to be a fashionista, just like Cammy Gardashyan," and only used the Gardashyan logo to the extent necessary to identify the doll. Pattel only used the likeness of Gardashyan's clothing, name, and block lettering on the package that was necessary for the purpose of identifying the doll. Furthermore, Pattel used the standard Bambi doll height and body shape, rectangular box, messages, disclaimers, warnings, and Bambi trademark. While "Cammy Gardashyan" was both times displayed using the mark's standard black block typeface, it is a standard font that is generic enough to be replicated by anyone who were to print the name. Thus, the second prong is met.

3. Pattel did nothing, in conjunction with Gardashyan’s mark, to suggest Gardashyan’s sponsorship or endorsement of the Fashionista Bambi doll.

The user of a trademark must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. *New Kids*, 971 F.2d at 308. In *KP Permanent Make-Up*, the Court held that the third prong must show that the defendant affirmatively acted in a way that would suggest to consumers that the trademark owner endorsed the defendant’s product, not just a showing of some consumer confusion. *KP Permanent Make-Up*, 543 U.S. at 120.

Furthermore, in *Mattel*, the record company defendant printed a statement on the CD case that the *Barbie Girl* song “was not created or approved by the makers of the doll.” *Mattel*, 28 F. Supp. 2d at 1142. While the warning did not appear on all versions of the CD single, the warning suggested that the record company attempted to disassociate from the Barbie doll manufacturer and at least ventured to demonstrate that the song was not endorsed by the manufacturer. *Id.* at 1142–43.

Contrarily, there was a genuine issue of fact regarding the third prong in *Abdul-Jabbar v. General Motors Corporation* because there was no showing that the defendant had affirmatively acted in a way to suggest that the plaintiff did not endorse the use of his name in a television car commercial. *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 412–13 (9th Cir. 1996). In *Abdul-Jabbar*, a car manufacturer aired a television commercial during a basketball event of the plaintiff, a professional basketball athlete, advertising that the manufacturer’s car

was a “Champ” and “A Definite First Round Pick.” *Id.* at 409. While the first and second prongs of the *New Kids* test were met, the third prong was not satisfied because, as celebrities are often in the business of endorsing products, it was necessary for the car manufacturer to inform consumers that the plaintiff athlete was not endorsing the manufacturer’s products. *Id.* at 413.

Here, Pattel did nothing to suggest that Gardashyan sponsored or endorsed the Fashionista Bambi doll. Similar to the CDs in *Mattel*, the Fashionista Bambi doll packages included a disclaimer stating, “Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan.” Rec. at 357. The disclaimer on the CDs in *Mattel* were not, however, displayed on every record and the Ninth Circuit still found there was sufficient evidence that the record company affirmatively attempted to avoid linking the song to the Barbie manufacturer. Here, Pattel’s disclaimer was on every Fashionista Bambi box and thus adequately establishes an attempt to show that Gardashyan did not sponsor or endorse the doll.

Furthermore, the doll says the words, “I want to be a fashionista, just *like* Cammy Gardashyan.” Rec. at 357 (emphasis added). Nothing suggests sponsorship or endorsement by Gardashyan, and the phrase merely draws a comparison to the celebrity, not an actual impersonation or affiliation with her. While the caption bubble is in twenty-point font and the disclaimer is in ten-point font, the disclaimer was the same type of standard messaging included on the box. The third prong in *KP Permanent Make-Up* is thus satisfied because, regardless of some consumer

confusion, Pattel affirmatively acted in a way that suggests Gardashyan *did not* endorse the Fashionista Bambi.

Finally, unlike the car manufacturer in *Abdul-Jabbar*, Pattel explicitly informed consumers the Gardashyan did not endorse the Fashionista Bambi doll. Thus, because Pattel did nothing to suggest sponsorship by Gardashyan and affirmatively acted in a way that displays the lack of affiliation between Pattel and Gardashyan, the Pattel satisfied the third prong.

B. In the alternative, if this Court adopts the Third Circuit’s three-pronged nominative fair use test, Pattel nevertheless satisfies each of the three prongs.

In the alternative where the Third Circuit’s stricter three-pronged test from *Century 21* is used, Pattel still satisfies the nominative fair use test. In *Century 21*, two real estate companies brought a trademark infringement action against the operator of an Internet real estate referral service that used the plaintiffs’ marks on its website. *Century 21*, 425 F.3d at 214. There, the Third Circuit adjusted the Ninth Circuit’s *New Kids* test to include narrower provisions:

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?

Id. at 228.

In regards to the first prong, the use of the Gardashyan's mark is necessary to describe both Gardashyan's and Pattel's product. In *Volkswagenwerk Aktiengesellschaft v. Church*, the Ninth Circuit held that the car manufacturer Volkswagen could not preclude the defendant, an auto repair shop, from using the word "Volkswagen" and its abbreviation "VW" because it would be nearly impossible for the defendant to avoid the terms altogether in order to advertise the types of cars that he repaired. *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969). Here, merely naming the Bambi "Fashionista" and dressing the doll in a certain style is insufficient to refer to Gardashyan; doing so is analogous to trying to identify Volkswagen by only calling it a German automobile company. Just as it is necessary to specifically refer to Volkswagen by its name, it is necessary to use Gardashyan's name and mark to refer to Gardashyan. Thus, the first prong is met.

Second, only so much of Gardashyan's mark was used as is necessary to describe her product. The Fourteenth Circuit's majority opinion focused on the quantity of Gardashyan's mark that was used on Pattel's product; nothing in the Record indicates that Pattel's use of Gardashyan's name was more than necessary. Rec. 364–65. Under the *Century 21* test, Pattel nevertheless satisfies the second prong.

Lastly, Pattel's conduct and language reflect the true and accurate relationship between Gardashyan and Pattel's product. The Record does not indicate any affirmative acts by Pattel that suggest Gardashyan's sponsorship.

Moreover, Pattel’s affirmative acts, particularly the disclaimer on the box, demonstrate that the doll was in no way “sponsored by or affiliated with Cammy Gardashyan.” Rec. at 357. Pattel thus satisfies the third prong.

Gardashyan’s argument was that the Ninth Circuit’s test lacks clarity and is too lenient. Rec. at 363–65. However, this test, as conceded by the Third Circuit, “has withstood the test of time[and] has been tinkered with in no less than seven opinions.” *Century 21*, 425 F.3d at 228. While the Third Circuit’s stricter, higher-burden test may seem to bring clarity to the nominative fair use test, it in reality requires that a defendant show what he *should* have done. Effectively, the Third Circuit’s test removes the focus away from affirmative acts and is likewise too high of a burden on the defendant.

Regardless of the test used, Pattel clearly did not infringe upon Gardashyan’s mark because its use was nominative and fair. Nevertheless, this Court should adopt the Ninth Circuit’s nominative use test.

CONCLUSION

It is for these reasons that this Court should reverse the decision of the Fourteenth Circuit Court of Appeals.

Respectfully Submitted,

/s/ Team No. 115
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