

No. 70593-2016

IN THE
Supreme Court of the United States

PATTEL, INC.,
Petitioner,

v.

CAMMY GARDASHYAN.
Respondent.

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

BRIEF FOR RESPONDENT

TEAM No. 119
COUNSEL FOR THE RESPONENT

QUESTIONS PRESENTED

1. Under a trademark infringement action based upon § 1114 of the Lanham Act, should a nominative fair use test be adopted when a defendant used the plaintiff's mark in reference to the plaintiff, and if so, should the nominative fair use test be adopted 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 case at hand?

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STATEMENT OF JURISDICTION

The United States Court of Appeals for the Fourteenth Circuit, entered judgment on June 5, 2016. The petition for writ of certiorari was granted by this Court pursuant to 28 U.S.C. § 1291. Section 1291 states, "The courts of appeals (other than the United States Court of Appeals for the Federal Circuit) shall have jurisdiction of appeals from all final decisions of the district courts of the United States . . . except where a direct review may be had in the Supreme Court. The jurisdiction of the United States Court of Appeals for the Federal Circuit shall be limited to the jurisdiction described in sections 1292(c) and (d) and 1295 of this title."

STATEMENT OF THE CASE

A. Statement of the Facts

Cammy Gardashyan is an American icon and fashionista, whose fame has been well recognized throughout her accomplishments as a reality television personality, socialite, businesswoman, model, social media celeb, and singer. Gardashyan, 1135 F.3d at 356. As a prominent business tycoon, Gardashyan ventured into the realm of fashion, which included goods and services pertaining to jewelry, clothing, cosmetics, perfumes, handbags, and footwear. Id. Signature styles that Gardashyan incorporated as her personal image include animal prints, knee-length skirts or dresses, and shiny high-heeled shoes; These apparels were combined with her distinct long, black, straight hair. These goods bear Gardashyan's name and mark, which consists of a stylized "CG" and the words

“CAMMY GARDASHYAN” located beneath the trademark in a standard block typeface. Id. Gardashyan’s total earnings accumulated from her personal brand exceeded fifty million dollars. Id. Furthermore, Gardashyan’s brand garnered further fame as a result of her wedding, which was viewed by millions of viewers including Pattel, Inc., a Bel Air Corporation. Id.

Pattel, Inc. is a toy manufacturing company, who annually integrates an intricate analysis of successful market trends for the purposes of concocting top-selling toys. Id. Following Gardashyan’s wedding, Pattel, Inc. decided to incorporate the 2015 “Bambi doll” as a direct inspiration of the Cammy Gardashyan aesthetic. Id. at 356-357. The features of this doll included the following: (1) Bambi’s standard height (11.5 inches); (2) similar body figure of previous Bambi dolls; (3) long, black, straight hair; (4) Gardashyan’s signature style with an animal (leopard) print top, knee-length skirt, sparkly high-heeled shoes; and (5) a talking feature with a recorded phrase, which says, “I want to be a fashionista, just like Cammy Gardashyan.” Id. at 357. However, Pattel, Inc. did not use the Cammy Gardashyan full logo. Id. Moreover, a disclaimer on the back, lower, portion of the box reads in a small, ten-point font: “Pattel, Inc. and Fashionista Bambi are not sponsored by or affiliated with Cammy Gardashyan.” Id. Regardless, the transparent box that the Bambi doll is packaged in labels the following: “I say: I want to be just like Cammy Gardashyan.” Id.

As a result, Pattel, Inc. had successfully accrued profits of forty-five million dollars from the thirty-five million Bambi dolls sold that year. Id. However, Gardashyan did not authorize Pattel, Inc.'s utilization of her name and mark. Id.

B. Procedural History

Gardashyan filed an action on February 9, 2015 against Pattel, Inc., claiming trademark infringement for use of the mark, "Cammy Gardashyan". Id. Gardashyan seeks a permanent injunction barring use of said mark. Id. Pattel, Inc. claims that use of Gardashyan's name was fair, as substantiated by the nominative fair use defense under the Lanham Act and any trademark infringement claims should therefore be dismissed. Id.

The District Court for the Central District of Bel Air held that nominative fair use applied to Pattel, Inc.'s use of the names and marks, thereby applying a two-step approach. Id. at 358. This two-step approach led the court to conclude that Pattel, Inc. is entitled to a nominative fair use defense and may apply it as an affirmative defense regardless of there being a finding of likelihood of confusion. Id. Consequently, the district court granted summary judgment on all counts in favor of Patel, Inc. Id.

Thereafter, the United States Court of Appeals for the Fourteenth Circuit reversed the decision of the district court. Id. In particular, The Court held that the nominative fair use test does apply to this particular case, but not as an affirmative defense, which Patel, Inc., failed to establish. Id. at 362. Moreover, the court held that a defendant may lawfully use a plaintiff's trademark if the application is

necessary to describe the plaintiff's product and does not imply false affiliation or endorsement by the plaintiff. *Id.* at 363. The appellate court concluded that Pattel, Inc.'s product constituted false affiliation. *Id.* at 365. The petitioner's writ of certiorari to the Supreme Court of the United States was granted.

STANDARD OF REVIEW

In review of the United States Court of Appeals for the Fourteenth Circuit, this Court should adopt a *De Novo* standard of review because the issue vests upon rendering a proper application of controlling law. Here, the controlling law at issue is deciding whether to adopt a nominative fair use standard or a classic fair use standard. Furthermore, *De Novo* standard would accurately determine whether to adopt a nominative fair use test as an affirmative defense and how to articulate and apply this test in the case at hand. In the trademark context, the *Polaroid* test, nominative, and classic fair use are questions of law, and therefore subject to *de novo* standard of review. Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 105 (2d Cir. 2009). This Court should affirm the Court of Appeals' judgment in reversing the District Court's holding based upon the foregoing.

SUMMARY OF ARGUMENT

Since the conception of our country, this nation has adopted a system that would allow innovators, entrepreneurs, inventors, and visionaries to use their trademark, or brand, as a distinctive symbol to drive free market society and culture into progress through their personal goals and achievements. A trademark has inherent value, reflective of a consumer's experience with a company, which

communicates a particular image, lifestyle, business, or aspiration to a prospective buyer. If a trademark was allowed to be easily espoused by third party infringers, this transgression would not only deprive an owner of their steadfast labor and toils, but also discourage future visionaries from contributing their ideas to American society. As a result, § 1114 of the Lanham Act was implemented to prevent confusion between the consumer and the goods/services of alleged third party infringers and trademark owners. The courts are often required to intervene whenever a trademark infringement of § 1114 has been alleged.

This Court should adopt a nominative fair use test, based upon § 1114 of the Lanham Act, in regards to this trademark infringement action. In order to institute a § 1114 claim based upon a nominative fair use test, a plaintiff must establish that the contested product or service is one that is not readily identifiable without use of the trademark, that only so much of the mark is used as is reasonably necessary to identify the product or service, or that the user did nothing to suggest sponsorship or endorsement by the trademark holder. A showing of sponsorship or endorsement by Pattel, Inc. has been clearly revealed, as evidenced by Petitioner's usage of Gardashyan's name and mark in addition to utilizing her distinctive, signature style without her approval. Furthermore, Pattel, Inc. exceeded the usage of Gardashyan's mark as is reasonably necessary to identify the Bambi doll by integrating her signature style and name interchangeably. These factors can be clearly seen, and a nominative fair use test should be applied in this case.

Next, the Respondent has sufficiently met her burden of proving a likelihood of confusion, which, consequently, prevents the Petitioner from asserting nominative fair use as an affirmative defense. A defendant will be barred from claiming a nominative fair use cause of action once a finding of likelihood of confusion has been established. Confusion exists when there is a mistaken notion of affiliation between the alleged infringer and trademark owner. Accordingly, because Gardashyan has appropriately established that Pattel, Inc. replicated the Bambi doll based upon Gardashyan's signature style, despite a disclaimer stating otherwise, the Respondent has thereby shown that a potential consumer is likely to be confused. Furthermore, the recorded phrase where the doll acknowledges a desire to "be a fashionista, just like Cammy Gardashyan," directly contradicts with said disclaimer, thereby substantiating a strong likelihood of confusion.

ARGUMENT

I. THIS COURT SHOULD AFFIRM THE FOURTEENTH CIRCUIT APPELLATE COURT'S DECISION THAT A NOMINATIVE FAIR USE TEST IN A TRADEMARK INFRINGEMENT ACTION UNDER § 1114 OF THE LANHAM ACT APPLIES WHEN A DEFENDANT USES A PLAINTIFF'S MARK IN REFERENCE TO THAT PLAINTIFF, AND, IN TURN, THIS SHOULD NOT BE ADOPTED AS AN AFFIRMATIVE DEFENSE

A. This Court Should Adopt a Nominative Fair Use Test, as Opposed to a Classic Fair Use Analysis, because this Case Involves a Situation in which a Defendant Uses the Plaintiff's Mark in Reference to the Plaintiff's Goods and Services

Under 15 U.S.C. § 1114, a trademark is protected by federal law, also known as the Lanham Act, against infringement. To show trademark infringement under 15 U.S.C. § 1114(1), a plaintiff must show that the defendant's use of the allegedly infringing trademark "is likely to cause confusion or to cause mistake or to deceive." Section 1114 provides that liability attaches when a defendant employs an infringing mark, which is "likely to cause confusion." Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 114 (2d Cir. 2009). The courts have adopted two types of fair use test, the first being the classic fair use test, and the second being the nominative fair use test. New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302, 308 (9th Cir. 1992).

1. The Classic Fair Use Test Should Not Apply In The Case At Bar Because Defendants Mark Was Not Used To Describe Defendant's Own Product.

The classic fair use (also known as the descriptive use), “the defendant has used the plaintiff’s mark to describe the defendant’s own product. New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302, 308 (9th Cir. 1992).

2. The Nominative Fair Use Test Should Apply because Pattel Inc. used Gardashyan’s Mark to Describe Pattel Inc.’s Good.

The Nominative Fair Use Test applies when a defendant uses the plaintiff’s mark to identify “not the defendant’s goods or services, but the plaintiff’s good or services.” Id. In the case at bar, the fourteenth circuit court of appeals appropriately applied the Nominative Fair Use Test. Here, the petitioner used the respondent’s mark and name to identify the petitioner’s good known as the Bambi Doll. Further, the petitioner has not used the respondent’s mark to describe defendant’s own product, to be classified under the Classic Fair Use Test. The respondent’s product has been around since 1961, and Respondent Cammy Gardashian has only recently skyrocketed to fame in 2007 after appearing on her hit Television series “Keeping up with the Gardashians.”

Necessity is focused upon the context of nominative fair use, in respect to a defendant using a plaintiff’s mark to describe the plaintiff’s goods or services. Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 229 (3d Cir. 2005). Necessity is established when a defendant’s product is dependent upon the ready identification of the plaintiff’s mark. Id. If a mark is generic in nature and resorts to words commonly used by the general public, the more likely it is that the use is a

fair one. Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938). Assuming that necessity has been established in conjunction to there being a likelihood of confusion under a *Polaroid* analysis, a defendant who uses the plaintiff's mark to identify the plaintiff's goods or services will be liable on grounds of nominative fair use. Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 229 (3d Cir. 2005).

The purpose of necessity is to determine whether the defendant's use of the mark is necessary to accurately describe what the defendant does or sells. Id. Trademarks that incorporate a specific word, which are reasonably available to identify a particular thing, "lie outside the strictures of trademark law." PACCAR, Inc. v. Telescan Technologies, LLC, 823 F.3d 153, 160-61 (2d Cir. 2016). If a mark is used in such a way that deceives or confuses the public because an infringer adopts an owner's distinctive word, which is not generic in nature, sanctity in the word will prevent it from being used to tell the truth. Prestonettes, Inc. v. Coty, 264 U.S. 359, 368 (1924).

In PACCAR Inc. v. TeleScan Technologies, the court ruled that the infringer's use of the trademarks, "Peterbilt" and "Kensworth" were not necessary to describe the plaintiff's trucks, parts, and dealers. In particular, the court held that, "using [the plaintiff's] trademarks in its domain names, repeating the marks in the main titles . . . mimicking distinctive [features like] fonts of the marks go beyond using the marks 'as is reasonably necessary to identify [the plaintiff's] trucks, parts, and dealers.'" PACCAR Inc. v. Telescan Techs., L.L.C., 319 F.3d 243, 255 (6th Cir. 2003)

abrogated by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 125 S. Ct. 542, 160 L.Ed. 2d 440 (2004). Like the trucks, parts, and names/marks that were unlawfully used in PACCAR Inc., Gardashyan’s signature style, accessories, and name/mark were not necessary for Pattel, Inc. to mimic via Bambi doll because this “goes beyond using the marks ‘as is reasonably necessary to identify [the plaintiff].” Id. Nominative fair use applies in this case because Pattel, Inc. has unlawfully used Gardashyan’s trademark to identify her signature style and products, which include animal prints, knee-length skirts/dresses, and shiny high-heeled shoes complimented by her long, black, hair. Under this standard, the petitioner has failed establish a lawful use of the respondent’s mark in reference to her goods and services because this use was not necessary to describe said product and distinguished style.

3. Nominative Fair Use Test Applies in this Case because Pattel, Inc.’s Use of Gardashyan’s Mark Implies False Endorsement or Affiliation by Petitioner of Respondent’s Product

Under 15 U.S.C. § 1114, nominative fair use provides that false endorsement or affiliation occurs when, “there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or indeed simply confused, as to the *source* of the goods in question.” Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 158 (2d Cir. 2016). “Source” refers to the designation of a trademark owner’s goods or services. Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 588 F.3d 97, 112 (2d Cir. 2009). In its broader sense, false endorsement or affiliation of an alleged infringer’s goods or services occurs merely by the public’s

belief that the mark's owner sponsored or otherwise approved the use of the trademark. Id.

The purpose of endorsement or affiliation is to establish whether an appreciable number of ordinarily prudent purchasers will be confused as to the source of the contested goods. Id. Indeed, endorsement or affiliation demands a more lenient standard of proof, which is not based upon consumers' false impressions of the trademark. Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 162 (2d Cir. 2016).

Nominative Fair Use is the appropriate standard to adopt for an endorsement or affiliation where the confusion of the source of the goods is called into question by a mindful consumer. Id. Such factors that assist in concluding a decision of false endorsement or affiliation include any "commercial advertising or promotion [that] misrepresents the nature, characteristics, qualities, [mark], or geographic origin of his or her or another person's goods or services or commercial activities..." Id. In PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003), the court stated:

The more distinct a mark, the more likely is the confusion resulting from its infringement, and therefore, the more protection it is due."

Certainly, trademarks that are distinguishable in nature alleviate confusion of false endorsement or affiliation. Nevertheless, cases that call into question endorsement or affiliation of this complexion must be contested under a Nominative Fair Use approach.

In the context of surnames, additional circumstances may warrant consideration, “because a surname “serve[s] the important function to its bearer of acting as a symbol of that individuals personality, reputation and accomplishments as distinguished from that of the business, corporation or otherwise, with which he has been associated.” JA Apparel Corp. v. Abboud, 682 F.Supp.2d 294, 311 (S.D.N.Y.2010). A disclaimer has little effect upon mitigating confusion when the message of such a disclaimer contradicts the presentation of an infringer’s product. “A disclaimer disavowing affiliation with the trademark owner read by a consumer . . . comes too late.” PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 253 (6th Cir. 2003) abrogated by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 125 S. Cit. 542, 160 L.Ed.2d 440 (2004).

In Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, the court reasoned that defendant’s disclaimers on their website such as, “SU CISSP® Prep classes are not endorsed, sponsored or delivered by (ISC) 2®”, did not remedy appropriation of plaintiff’s mark when a distinctive term strongly suggests affiliation. Id.

In JA Apparel Corp. v. Abboud, J.A. Apparel sued Mr. Joseph Abboud for using his name on advertisements after selling the brand for \$65 million. Id. at 294, 311. J.A. Apparel sued Mr. Abboud for Trademark Infringement. the court held that fair use of Joseph Abboud personal name provided the ad include a disclaimer of affiliation to be no smaller than the text of Abboud’s name. Id. Furthermore, the words “Joseph About” in some of these ads, are written in what appears to be the

identical font as one of JA Appearel's federal trademark registrations. Id. The court held that this name is used more as an attention-grabbing symbol. Id. The courts have further held, that in trademarks of names, it is not a given right to use one's own name. In Gucci America, Inc. v. Jennifer Gucci, the court held here that since she had no experience as a designer she could not use her family name in her businesses.

B. Nominative Fair Use Should Not Be Adopted as an Affirmative Defense, but Rather, become a Part of the Likelihood of Confusion Analysis because the Law does not Require a Defendant to Negate a Likelihood of Confusion Once it has been Established

1. The Lanham Act Does Not Provide an Opportunity for a Defendant to Rebut the Likelihood of Confusion Once Such Confusion has been Established

Pattel, Inc., or any defendant for that matter, should not be awarded the opportunity to raise Nominative Fair Use as an affirmative defense once a likelihood of confusion has been found. To do so otherwise would afford Pattel, Inc. broader protection to use such a defense, even after a likelihood of confusion has been established, thereby contradicting decades of Supreme Court and Circuit Court jurisprudence. Furthermore, the Lanham Act, in its language, makes no mention of a defendant being granted the opportunity to raise nominate fair use as an affirmative defense. As a result, a verdict in favor of Petitioner would thwart the sole purpose of trademark law, to prevent confusion amongst prospective purchasers.

Under a Nominative Fair Use analysis, based upon 15 U.S.C. § 1114 of the Lanham Act, “[a] competitor ha[s] no burden to negate any likelihood that the practice complained of would confuse consumers about the origin of the goods or services affected, and some possibility of consumer confusion about the origin of the goods or services affected was compatible with fair use of a mark.” KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004). It is the plaintiff, however, who bears the exclusive burden to prove confusion. Id. The defendant needs only to leave the court unpersuaded that the plaintiff has failed to establish confusion under a trademark infringement claim. Id. Therefore, confusion, under nominative fair use, is determined via the eight factor evaluation that the *Polaroid* test provides. Int’l Info. Sys. Sec. Cert. Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 160-61 (2d Cir. 2016).

Factors that are analyzed to determine a likelihood of confusion are: “(1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may “bridge the gap” by developing a product for sale in the market of the alleged infringer’s product; (5) evidence of actual consumer confusion; (6) evidence that the imitative mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.” Id. Accordingly, if such factors are present, based upon the applicable facts, nominative fair use applies when the likelihood of confusion among prospective purchasers has been established.

Although the *Polaroid* test is applied to determine confusion, it is not exclusive nor applied mechanically. Int'l Info. Sys. Sec. Cert. Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 160-61 (2d Cir. 2016). As stated in Starbucks Corp. v. Wolfe's Borough Coffee, Inc., “In assessing similarity [in the infringement context], courts look to the *overall impression* created by the logos and the context in which they are found and consider the *totality of factors* that could cause confusion among prospective purchasers.” As such, courts should consider these factors based upon the totality of the circumstances where no single factor is dispositive. Id. (emphasis added).

2. Nominative Fair Use should not be Adopted as an Affirmative Defense because Congress would have Expressly Mentioned this Intention Through the Language of the Act, Itself

Nominative fair use, in its language, makes no mention to apply such a test as an affirmative defense. If Congress had intended to apply this doctrine as a defense, then it would have provided express intention to do so, as exhibited through the language of the Lanham Act. Therefore, Pattel, Inc. should not be afforded the convenience to adopt the nominative fair use test as an affirmative defense.

As stated in Russello v. United States, 462 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.” If Congress makes no mention of treating a particular test, such as nominative fair use, as an

affirmative defense, then the presumption is that the omission of this intention, as evidenced through an Act's language does not apply. Id.

Unlike classic (i.e., descriptive) fair use, Congress did not clearly mention the intention to adopt nominative fair use as an affirmative defense. The historic background of the Lanham Act sheds light on the topic. In KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 120-121, 125 S. Ct. 542, 549, 160 L. Ed. 2d 440 (2004), the court stated:

[I]n 1988 Congress added the express provision that an incontestable markholder's right to exclude is "subject to proof of infringement," Trademark Law Revision Act of 1988, § 128(b)(1), 102 Stat. 3944. [N]o *121 requirement prior to 1988 stated that a markholder prove likelihood of confusion. Before 1988 . . . it was sensible to get at the issue of likely confusion by requiring a defendant to prove its absence when defending on the ground of fair use. When the 1988 Act saddled the markholder with the obligation to prove confusion likely, § 1115(b), the revision . . . relieve[d] the fair use defendant of the suddenly strange burden to prove absence of the very confusion that a plaintiff had a new burden to show in the first place.

If the Supreme Court intended to allow a defendant's ability to use this test as an affirmative defense, then the language of the Lanham Act would have expressly stated. As such, because of this absence of the affirmative defense in the Lanham Act's language, Congressional intent does not sponsor the notion of a defendant having the opportunity to raise nominative fair use as a defense.

II. NOMINATIVE FAIR USE SHOULD NOT BE APPLIED AS AN AFFIRMATIVE DEFENSE BECAUSE PATTEL, INC.'S USE OF GARDASHYAN'S MARK HAS CREATED A LIKELIHOOD OF CONFUSION, WHICH, CONSEQUENTLY, HAS MET THE THREE-PRONG NOMINATIVE FAIR USE FACTORS ADOPTED BY THE THIRD CIRCUIT COURT OF APPEALS

As previously argued in the first issue, nominative fair use should apply in the present case not as an affirmative defense, but as a part of the likelihood of confusion analysis. The burden of proof rests solely upon the plaintiff to show a likelihood of confusion. If said burden has been recognized, the defendant will not be awarded an opportunity to rebut or negate a finding of confusion. Therefore, confusion is analyzed through the eight factors the *Polaroid* test offers. The *Polaroid* factors should be considered in light of the factual circumstances a case presents. Analyzing every single factor may not be a necessary endeavor. Furthermore, the nominative fair use test also presents three additional factors, which, in essence, creates an eleven factor test. However, unlike the factors previously mentioned in the *Polaroid* test, a court should assess all three factors under nominative fair use.

This Court should adopt the nominative fair use factors applied in the Third Circuit Court of Appeals. Under this approach, the three-prong factors states:

(1) Is the use of plaintiff's mark *necessary* to describe [i] plaintiff's product or service and [ii] 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? (iii) Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products and services? Century 21 Real Estate Corp., 425 F.3d at 228.

This test drastically differs from the nominative fair use factors proposed by Pattel, Inc. and applied in the Ninth Circuit Court of Appeals. These ninth circuit factors consider:

(1) that the product or service in question is one not readily identifiable without use of the trademark; (2) that only so much of the mark or marks is used as is reasonably necessary to identify the product or service; and (3) that the user did nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. New Kids on the Block, 971 F.2d at 308.

The third circuit effectively raises the bar for those who claim nominative fair use as an affirmative defense by demanding the plaintiff to meet a higher standard of proof. Rather than resorting to lenient factors such as whether a good or service is readily identifiable, the third circuit approach requires a showing of necessity. Additionally, as opposed to the ninth circuit approach merely showing sponsorship or endorsement, the appropriate nominative fair use test goes one step further and asks whether the defendant's conduct reflect the true and accurate relationship between the parties. Therefore, because the third circuit approach focuses upon the strength of the language and accurately encompasses the full scope of a nominative fair use analysis, this Court should adopt the three factors offered and applied by the Third Circuit Court of Appeals.

A. The Lanham Act Does Not Provide an Opportunity for a Defendant to Rebut a Likelihood of Confusion Once Such Confusion has been Established

Pattel, Inc., or any defendant for that matter, should not be awarded the opportunity to raise nominative fair use as an affirmative defense once a likelihood

of confusion has been found. To do so otherwise would afford Pattel, Inc. broader protection to use such a defense after a likelihood of confusion has been established, which would inadvertently contradict decades of Supreme Court and Circuit Court jurisprudence. Furthermore, the Lanham Act, in its language, makes no mention of a defendant being granted the opportunity to raise nominative fair use as an affirmative defense. As a result, a verdict in favor of Petitioner would thwart the sole purpose of trademark law - to prevent confusion amongst prospective purchasers. Thus, this Court should affirm the Fourteenth Circuit Appellate Court's decision that nominative fair use should not be applied as an affirmative defense.

Under a nominative fair use analysis, based upon 15 U.S.C. § 1114 of the Lanham Act, “[a] competitor ha[s] no burden to negate any likelihood that the practice complained of would confuse consumers about the origin of the goods or services affected, and some possibility of consumer confusion about the origin of the goods or services affected was compatible with fair use of a mark.” KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004). It is the plaintiff, however, who bears the exclusive burden to prove confusion. Id. The defendant must only leave the court unpersuaded that the plaintiff has failed to establish confusion under a trademark infringement claim. Id. Therefore, confusion, under nominative fair use, is determined via the eight factor evaluation that the *Polaroid* test provides. Int’l Info. Sys. Sec. Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 160-61 (2d Cir. 2016).

Factors that are analyzed to determine a likelihood of confusion are: “(1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may “bridge the gap” by developing a product for sale in the market of the alleged infringer’s product; (5) evidence of actual consumer confusion; (6) evidence that the imitative mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.” Id.

The *Polaroid* test does not require a showing of every factor and should not be applied mechanically. Int’l Info. Sys. Sec. Cert. Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 160-61 (2d Cir. 2016). In Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., the court states, “In assessing similarity, courts look to the *overall impression* created by the logos and the context in which they are found and consider the *totality of factors* that could cause confusion.” Id. (emphasis added).

Nominative fair use should not apply as an affirmative defense, because a likelihood of confusion exists between Pattel, Inc.’s Bambi doll and Gardashyan’s mark. Because Gardashyan has appropriately established a likelihood of confusion, Pattel, Inc. should not be granted the opportunity to rebut or negate such confusion. To do so differently would allow Petitioner broader protection to which the law does not afford and allow an infringer a "second bite at the apple," which would create a likelihood of confusion. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 112, 125 S. Ct. 542, 545, 160 L. Ed. 2d 440 (2004). Therefore, confusion has been sufficiently met by Respondent based upon the following.

1. Strength of Gardashyan's Trademark

The strength and sufficiency of Gardashyan's trademark has been well-founded under the first factor of the *Polaroid* test. Assuming that Gardashyan has taken the necessary measures to appropriately file her trademark through first registration of the relevant country (in this case, the U.S.A), Respondent's name, "CG CAMMY GARDASHYAN™", has legal strength and is afforded higher protection. (R. at 356). "The more distinct a mark, the more likely is the confusion resulting from its infringement, and therefore, the more protection it is due." PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003). Because the name, "Cammy Gardashyan", is a unique, distinctive, and personal name, such as "Steve Madden", or "Calvin Klein", the strength of such a distinguishing name affords higher protection due to its authenticity. Because the name and mark, "Gardashyan", is a distinctive mark, and not a generic noun or verb, confusion is more likely to occur when Pattel, Inc. made reference to Respondent through use of the Bambi doll. Id.

2. Similarity of the Marks

Similarity of the marks is relevant and applicable under the circumstances presented. Pattel, Inc.'s use of plaintiff's mark bears the same pronunciation, appearance, and verbal translation that Gardashyan has commercially used. (R. at 357). "When analyzing similarity, courts should examine the pronunciation, appearance, and verbal translation of conflicting marks . . . the marks must be viewed in their entirety and in context [and a] court must determine, in light of

what occurs in the marketplace, whether the mark will be confusing to the public when singly presented.” PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003). Pattel, Inc. has incorporated Gardashyan’s name and mark on the cover of the Bambi doll’s transparent box, which is displayed in the same spelling, appearance, and therefore verbal translation of Respondent’s trademark. (R. at 357). Additionally, the recorded feature of the doll reiterates the name, “Gardashyan”, which also emphasizes the same pronunciation of Respondent’s mark and name. (R. at 357). Based upon the entirety of the circumstances, similarity and confusion between the marks exists and is therefore relevant.

3. Proximity of the Products and the Competitiveness with On Another

Proximity of the products and their competitiveness is an irrelevant fact to determine confusion in this case. Three categories are taken into account to identify this particular factor. “First, if the parties compete directly by offering their goods or services, confusion is likely if the marks are sufficiently similar; second, if the goods or services are somewhat related but not competitive, the likelihood of confusion will turn on other factors; third, if the goods or services are totally unrelated, confusion is unlikely.” PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003). Under these categories, proximity of the goods and services are unlikely to be confused because Pattel, Inc., a toy company, does not directly compete with OG CAMMY GARDASHYAN, a fashion company. (R. at 355-56). Second and third, the goods and services offered by the parties are completely unrelated due to the fact that Pattel, Inc. manufactures toys and Gardashyan

manufactures apparel and fashion/cosmetic designs such as jewelry, clothing, cosmetics, perfumes, etc.; competition is nonexistent between the parties insofar as the goods and services they produce. (R. at 356). Due to the foregoing, the third factor regarding proximity of the goods and services is irrelevant in this case.

4. Senior User May “Bridge the Gap” by Developing a Product for Sale in the Market of the Alleged Infringer’s Product

Similarly, the “Bridge the Gap” factor is irrelevant because Respondent and Petitioner are not in direct competition with each other. “When products are in direct competition, ‘there is really no gap to bridge, and [the bridging] factor is irrelevant to the *Polaroid* analysis.” Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 115 (2d Cir. 2009). Bridging the gap occurs when there is a probability that a senior user will venture into the junior user's line of business. Id. There is no direct competition between Pattel, Inc.’s toy product and Gardashyan’s clothing line. Furthermore, because it is unlikely that Gardashyan will expand into the toy manufacturing business and become a competitor of Pattel, Inc., making this factor irrelevant. (R. at 356).

5. Actual Confusion

Actual confusion is pertinent in this case because although specific circumstances have not yet arisen to indicate proof of confusion between the parties, a reasonably prudent purchaser would likely be confused by Petitioner's Bambi doll. “[T]he lack of evidence of actual confusion is not significant unless the circumstances indicated that such evidence should have been available . . . the

absence of actual confusion evidence is inconsequential.” PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003). Because this case immediately arose as a result of Gardashyan filing an action against Pattel, Inc. on February 9, 2015 in response to the release of the Bambi doll on January 2015, specific circumstances have not yet arisen to indicate evidence of actual confusion. (R. at 357). However, because a reasonably prudent purchaser would likely be confused by the drastic similarities between the Fashionista Bambi doll and Respondent's goods and services, actual confusion has been met as a relevant factor. The Bambi doll incorporates the same signature style, physical features, and name and mark of Respondent, which are located both on the front cover of the transparent box and voice recorded phrase. (R. at 357).

6. Adopted in Bad Faith

Adoption in bad faith is relevant in this case because Pattel, Inc. intended to use Gardashyan’s mark and trade name to create an association with the famous mark. “The determination of an ‘intent to associate,’ however, does not require the additional consideration of whether bad faith corresponded with that intent. The plain language of section 1125(c) requires only the consideration of ‘[w]hether the user of the mark or trade name intended to create an association with the famous mark.’” Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 109 (2d Cir. 2009). Due to Gardashyan’s vast, social media presence, this fame has appealed to consumers who have purchased products associated with her personal brand. Fans and viewers of Gardashyan's popular television show and high-profiled 2014

wedding reached millions across the nation. (R. at 356). Because Pattel, Inc. intended to associate Respondent's name and famous mark into the Bambi doll, as shown through the express name mentioned on the box and voice feature, Petitioner acted in bad faith under the *Polaroid* test. Bad faith is therefore relevant and a likelihood of confusion is evident, as demonstrated by this factor.

7. Quality of the Mark and Products

Quality of the mark and product is a relevant factor because Pattel, Inc. used Gardashyan's mark after it had become famous, which caused "dilution" of the distinctive quality of the mark. "The owner of a famous mark shall be entitled . . . to an injunction . . . if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 109 (2d Cir. 2009). Dilution occurs when the trademark owner and alleged infringer's mark are "substantially similar." Id. Here, Pattel, Inc. incorporated Gardashyan's trademark pursuant to her well-telerevised wedding, which attracted millions of viewers. (R. at 356). As a direct result of the wedding, Petitioner decided that the 2015 Bambi doll would embody the signature style and look of Cammy Gardashyan to promote female independence. (R. at 355). Not only does the Bambi doll and package make express reference to the trademark name, "Gardashyan", but it also mimics her signature style as evidenced by the apparel and distinctive cosmetic features the doll carries. As such, quality of the mark and products is a relevant factor and is likely to cause confusion because Pattel, Inc. used the mark after Gardashyan's dramatic rise to fame. As such, use of said

features, styles, name, and mark caused dilution to the distinctive quality of the mark.

8. Sophistication of the Customers

Sophistication of the customers would not apply in this case because a typical buyer would not exercise ordinary caution. “The standard used by the courts is the typical buyer exercising ordinary caution. However, when a buyer has expertise or is otherwise more sophisticated with respect to the purchase of the services at issue, a higher standard is proper . . . [w]hen services are sold to such buyers, other things being equal, there is less likelihood of confusion.” PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 251 (6th Cir. 2003). The Bambi dolls have attracted millions of customers of all ages, from three to one hundred. (R. at 355). Likewise, Gardashyan’s media attention has resulted in millions of consumers purchasing products associated with her brand. (R. at 356). Hence, because both parties’ products have indiscriminately appealed to millions of customers ranging in broad age groups, as opposed to a selective collection of individuals, there is likely to be a deficiency of sophistication amongst the general public. Accordingly, sophistication of the customer should not be a relevant factor because typical buyers are likely to exercise equal, ordinary, caution when purchasing either parties’ product.

Therefore, because there is strength to Respondent’s trademark; similarity of the parties’ marks; actual confusion; evidence that Pattel, Inc. adopted the mark in bad faith, and; respective quality of the mark and products, a likelihood of confusion has been established under the *Polaroid* test, given the totality of the circumstances

in this complicated case. As such, nominative fair use under section 1114 of the Lanham Act should not be applied as an affirmative defense due to the fact that a likelihood of confusion is visibly present and self-evident. To do so otherwise would defeat the very purpose of Trademark law, create confusion, and allow Pattel, Inc. and future defendants broader protection to which the law does not allow.

B. Nominative Fair Use Should Not Apply as an Affirmative Defense because Pattel, Inc. has Failed to Meet the Three-Prong Nominative Fair Use Factors Adopted by the Third Circuit Court of Appeals

1. The Use of Gardashyan's Name and Mark were Not Necessary to Describe Respondent's Products or Goods nor Pattel, Inc.'s Products or Goods

The ready identification of Pattel, Inc.'s Bambi doll is not necessary or dependent upon the description of Gardashyan's signature fashion style through use of Respondent's name and mark. Pattel, Inc. also unlawfully employed Gardashyan's trademark because, taken as a whole, they have failed to meet the criteria factors of the *Polaroid* test. In light of the fact that Petitioner has failed to ascertain necessity to describe Gardashyan or Pattel, Inc.'s goods or services, Petitioner failed to meet the first prong of nominative fair use. This failure to meet necessity thereby establishes a likelihood of confusion to which nominative fair use should not be applied as an affirmative defense.

The purpose of necessity is to determine whether the defendant's use of the mark is necessary to accurately describe what the defendant and plaintiff does or sells. Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 229 (3d Cir. 2005). Under nominative fair use, necessity involves an inquiry not only as to

whether a senior user's use of the mark needs to be described, but also whether the defendant's use of the mark is necessary to "accurately describe what [the] defendant does or sell[s]." Id. Therefore, if a mark is generic in nature and resorts to words commonly used by the general public, the more likely it is that the use is a fair one. Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938). Assuming that an absence of necessity and a likelihood of confusion has been established, a defendant who uses the plaintiff's mark to identify the plaintiff's goods or services will be liable. A defendant will not be afforded an opportunity to rebut such confusion under nominative fair use. Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 229 (3d Cir. 2005).

In sum, the first prong is an inquiry as to whether the plaintiff's mark was necessary to "accurately describe what the defendant does or sell, or whether its reference to plaintiff's mark is actually gratuitous." Century 21 Real Estate Corp., 425 F.3d at 228. Gratuitous, in this sense, translates as whether a user acted with good faith. Id. Necessity will appropriately be unascertained if a defendant fails to establish said factor. Id. Therefore, the infringer would be liable under section 1114.

In this case, Pattel, Inc. employed Gardashyan's name, mark, and signature style to identify the plaintiff's goods and services. However, the use of plaintiff's trademark was not "necessary to describe the plaintiff or defendant's product." Id. Pattel, Inc. unlawfully incorporated the distinctive, fashionista, image and mark, as evidenced by the particular apparel the Bambi doll presented in addition to Gardashyan's mark being explicitly present on the cover of the transparent box in

which the doll was packaged. (R. at 357). In essence, the adoption of Gardashyan's mark is not a gratuitous use, but it is an unnecessary use, which is not essential to describe the plaintiff and defendant's products or goods. Pattel, Inc. did not act gratuitously or with good faith due to the association between their product and Gardashyan's mark, as evidenced by the use of Respondent's signature style (animal top, knee-length skirt, sparkly high-heeled shoes) and her mark being both present on the front cover of the box and expressly stated through the doll's voice mechanism. (R. at 357). Thus, the name, mark, and signature style Pattel, Inc. has used exclusively relates to Gardashyan's goods and services and was not necessary to describe Respondent's product.

The court decided in PACCAR Inc. v. TeleScan Technologies that the infringer's use of the trademarks, "Peterbilt" and "Kensworth," used to describe the plaintiff's trucks, parts, and dealers were not necessary to describe plaintiff or defendant's products and services. Like the trucks, parts, and names/marks that were unlawfully used in PACCAR Inc., Gardashyan's signature style, accessories, and name/mark were not necessary for Pattel, Inc. to mimic through use of the Bambi doll product. This "goes beyond using the marks 'as is reasonably necessary to identify [the plaintiff or defendant].'" Id. Nominative fair use applies as a likelihood of confusion because Pattel, Inc. has unlawfully exploited Gardashyan's trademark to identify her signature style and products. The use of plaintiff's mark was not necessary to describe Gardashyan's or Pattel, Inc.'s goods and services. Pattel, Inc. could have easily incorporated a similar, yet less distinctive, fashion

style into their Bambi doll without using the Respondent's physical features, or more importantly, her name and mark as incorporated via talking feature and cover of the transparent box. Moreover, Pattel, Inc. could have still achieved their depiction of female independence by simply utilizing a female celebrity who does not have her name registered as a trademark. Under this factor, Petitioner has failed to establish a legal use of Respondent's mark in reference to Gardashyan because this unlawful adoption was not necessary to describe said products, goods, and services of either party.

Therefore, because Pattel, Inc.'s use of Gardashyan's mark was not necessary to identify either Petitioner or Respondent's goods and services, Petitioner is therefore liable under a nominative fair use standard.

2. Pattel, Inc. has Gone Beyond what is Reasonably Necessary to Describe Gardashyan's Products and Services

Pattel, Inc.'s use of Gardashyan's name and mark was not reasonably necessary to describe Gardashyan's products and services. The quantum of Gardashyan's mark used by Pattel, Inc. was not a legally appropriate use. Accordingly, under the second prong of nominative fair use, a likelihood of confusion has been shown because Pattel, Inc.'s overuse of Respondent's mark goes beyond what would be considered as reasonably necessary.

The second prong of the nominative fair use factors "tests only whether the quantum of the plaintiff's mark used by the defendant was appropriate." Century 21 Real Estate Corp., 425 F.3d at 230. A junior's use of a mark is appropriate when

that user has employed only so much of the senior's mark as is necessary to describe plaintiff's products or services. Id. As the Third Circuit Court of Appeals states, “[i]n analyzing this factor . . . [the court] essentially predetermined the outcome of the second prong by its finding as to the first prong.” Id. Ergo, a standard of reasonableness is applied to determine whether a defendant has gone beyond what is necessary when using a plaintiff's mark; the concentration of the second prong rests upon the amount, or quantity, of the plaintiff's mark that the defendant has used. Factors such as distinctive lettering, font, pronunciation of a name, stylistic features, etc. are taken into account to determine the second prong under a nominative fair use analysis. Id.

Pattel, Inc. has adopted Gardashyan's name and mark beyond the scope, or amount, of what is reasonably necessary. The quantity of Respondent's mark used is not necessary to identify Gardashyan's product and is, therefore, an inappropriate use. Here, Pattel, Inc. has adopted and implemented Cammy Gardashyan's signature style into their fashionista Bambi doll, as evidenced by the animal (leopard) print top, knee-length skirt, and sparkly, high-heeled shoes. (R. at 357). Furthermore, Petitioner incorporated Respondent's physical and cosmetic features into the doll's design; long, black, straight hair. (R. at 357). More importantly, the doll, itself, has a talking feature, which makes an express reference to Respondent, which states, “I want to be a fashionista, just like Cammy Gardashyan.” (R. at 357). The transparent box, itself, explicitly communicates in a

caption bubble using a twenty-point font size, "I say: I want to be just like Cammy Gardashyan." (R. at 357).

In Century 21 Real Estate Corp. v. Lendingtree, Inc., the court concluded that the proper focus rests upon whether only so much of the plaintiff's mark on their website was used as is reasonably necessary by the defendant. Factors in Century 21 include not only the mark, itself, but distinctive lettering, images, and visual styles used by the defendant. The mark and visuals at issue in this case include the following: (1) "For Sale" sign, (2) "Find a Realtor" statement, and (3) the plaintiff's mark, Century 21. Id. Similarly, Pattel, Inc.'s incorporation of Respondent's mark, taken as a whole, is a willful and unreasonable overuse as evidenced by the following adoptions: (1) signature style consisting of animal (leopard) print top, knee-length skirt, and sparkly, high-heeled shoes, (2) physical attributes such as long, straight, black hair, and (3) Respondent's name and mark that were integrated through the caption bubble and voice feature. (R. at 357).

Based upon the prominence of the use presented via Bambi doll, Pattel, Inc. "took too much" of Gardashyan's name and mark. As such, this willful overuse of Respondent's full name (Cammy Gardashyan), mark, signature style, and physical features evidence bad faith and is therefore more likely to confuse an ordinarily prudent purchaser.

As a result, Pattel, Inc.'s use of Gardashyan's signature style, physical appearance, and use of her name and mark were applied in excess and, therefore, were not reasonably necessary to identify Respondent's product.

3. The Conduct and Language that Pattel, Inc. Incorporated into the Bambi Doll Does Not Reflect a True and Accurate Relationship Between Respondent and Petitioner's Products and Services

Petitioner's conduct and language do not reflect the true and accurate relationship between Pattel, Inc. and Gardashyan's goods and services. Thus, the third prong under nominative fair use has been met because Pattel, Inc.'s Bambi doll inherently shows that an appreciable number of ordinarily prudent purchasers are likely to be misled as to the source of the goods in question. Based upon the affirmative actions of Pattel, Inc., a prospective buyer is likely to believe that the Bambi doll was endorsed or affiliated with Cammy Gardashyan. Therefore, because an appreciable number of reasonable prudent purchasers are likely to be misled by this false relationship between Pattel, Inc. and Gardashyan, the third prong under nominative fair use has been established.

False endorsement or affiliation is based upon the affirmative actions of an alleged infringer. Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456, 464 (7th Cir. 2000). If endorsement or affiliation is to cause confusion amongst ordinarily prudent purchasers as to the source of the goods at issue, the third prong under nominative fair use has been met. Id. Such factors that assist in concluding a decision of false endorsement or affiliation include any “commercial advertising or promotion [that] misrepresents the nature, characteristics, qualities, [mark], or geographic origin of his or her or another person’s goods or services or commercial activities...” Id. In sum, a court must consider not only the source of the confusion but also the affiliation, sponsorship, or endorsement that causes confusion. If a

court deems there to be a finding of false endorsement or affiliation, however, a likelihood of confusion has been shown and the user has infringed upon an owner's mark.

In the case at bar, Pattel, Inc. has distorted the true and accurate relationship between Petitioner and Respondent through Pattel, Inc.'s conduct and language. This dilution of the parties' relationship with each other was advertised by a showing of false endorsement and affiliation through use of the Bambi doll product. This good would cause an appreciable number of ordinarily prudent purchasers to be confused as to the source of Gardashyan's products and signature style. Due to the distinguishing features of Gardashyan's signature style, in addition to her trademark name, Pattel, Inc.'s extortion of such qualities and mark is likely to cause a false belief of sponsorship or endorsement that Respondent granted approval for Petitioner to use her mark. The characteristics at issue, which Pattel, Inc. unlawfully adopted, are Gardashyan's distinctive fashionista clothing design, hair style, and talking feature, which says in a caption bubble on the box, "I want to be a fashionista, just like Cammy Gardashyan." (R. at 357). Moreover, the disclaimer Pattel, Inc. includes is unlikely to diminish false endorsement or affiliation by an ordinarily prudent purchaser but, rather, encourages confusion.

In JA Apparel Corp. v. Abboud, the court stated that the font size of the disclaimer, in comparison to the advertised mark, must be taken into consideration as well as the location of the mark and disclaimer on a package or container. Id. at 568 F.3d 390, 403 (2d. Cir. 2009). Pattel, Inc.'s transparent box communicates a

false message to reasonably prudent purchasers, thereby misappropriating the parties' relationship. The message that Pattel, Inc. communicates is affiliation with Respondent, as evidenced by the distinctive full name and mark, "Cammy Gardashyan," located on the front cover of the box and featured in the voice mechanism. Furthermore, Gardashyan's mark was located on the front cover of the transparent box in large, twenty-point font size whereas the disclaimer was located on the back lower portion of the box, in small, ten-point font size. (R. at 357).

Pattel's disclaimer of non-affiliation to Cammy Gardashyan is not congruent to the appearance and mark of the Bambi doll's display. In spite of the disclaimer's repudiation of affiliation or endorsement with Cammy Gardashyan, the disclaimer, itself, is inconspicuous due to its considerable smaller font size and its location in an area on the box that a prospective buyer is unlikely to notice at first glance. The disclaimer drastically differs from the caption bubble, which is located on the front of the box in large, twenty-point font, and it incorporates Respondent's name and mark. The caption bubble, which states, "I say: I want to be just like Cammy Gardashyan," is conspicuous and more noticeable in the eyes of an ordinary customer. Due to the contradicting statements that the disclaimer and caption bubble communicates, this contravening information is likely to confuse an ordinary prudent purchaser and lead a purchaser into falsely believing that Gardashyan endorsed or is affiliated with Pattel, Inc. Consequently, this differentiation in font size and location reveals a higher emphasis and prominence upon the ready identification of Gardashyan's name and mark, which would likely confuse a

prospective buyer as to the true and accurate relationship between the parties. Therefore, this disclaimer has no legal merit because it goes contrary to what it purports to communicate. Pattel, Inc.'s presentation of the Bambi doll not only misappropriates Gardashyan's name and mark, it also misappropriates her signature style. Pattel, Inc. could have easily incorporated a similar, yet indistinctive, fashion design into their Bambi doll without making express reference to Cammy Gardashyan. Therefore, Pattel, Inc.'s use of Gardashyan's mark and signature style do not depict an accurate relationship between the parties because this presentation promotes false endorsement and affiliation, which ultimately presents a false and inaccurate relationship between the parties.

As a result, because an appreciable number of ordinarily prudent purchasers would believe the Bambi doll to be affiliated or endorsed by Respondent, Pattel, Inc.'s use of Gardashyan's mark does not portray a true and accurate relationship between the parties because Gardashyan never authorized the use of her mark and name.

C. This Court should Adopt Nominative Fair Use as Part of the Likelihood of Confusion Analysis, because to do so would Prevent the Misappropriation of Future Infringers from Exploiting Trademarks that Belong to Rightful Owners

This Court should affirm the Fourteenth Circuit's finding that nominative fair use applies as part of the likelihood of confusion analysis in order to prevent the future misappropriation of an owner's mark. To not affirm the Appellate Court's finding would deter inventors, entrepreneurs, innovators, and business men and

women from contributing their goods, services, and products to the American free market in fear that their trademark would be exploited by infringers. As a means of furthering our free market society and American business ethos, this Court should affirm the decision of the Fourteenth Circuit in order to encourage cultural growth by discouraging the misappropriation of trademarks, i.e., trademark infringement.

Misappropriation is “the common-law tort of using the noncopyrightable information, [marks], or ideas that an organization collects and disseminates for a profit to compete unfairly against that organization, or copying a work whose creator has not yet claimed or been granted exclusive rights in the work.” Int’l News Serv. V. Associated Press, 248 U.S. 215, 29 S.Ct. 68 (1918). If a user has engaged in trademark misappropriation, such action would therefore result in confusion and attach liability to that user. New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302, 305 (9th Cir. 1992). Therefore, trademark law aims to prevent unfair competition through misappropriated marks that are likely to cause confusion amongst prospective or actual purchasers. Id.

A trademark is a limited property right in a particular word, phrase, or *symbol* that conveys, or communicates, an intended meaning. Id. As such, trademark law provides protection for a user’s mark and deters the unlawful use of an infringer from exploiting their own goods and services through the use of another’s mark. Id. “Throughout the development of trademark law, the purpose of trademarks remained constant and limited: Identification of the manufacturer or sponsor of a good or the provider of a service. And the wrong protected against was

traditionally equally limited: Preventing producers from free-riding on their rivals' marks." Id. Fundamentally, trademark law creates accountability for trademark infringers by protecting the very symbol of an owner's ideas, goods, services, and products.

In the case at bar, Pattel, Inc. has accumulated a forty-five million dollar profit as a direct result of misappropriating Gardashyan's name, mark, and signature style into the Bambi doll. (R. at 357). This dissemination of this mark or symbol for profit was without approval by Respondent. As such, Pattel, Inc. should be held accountable for their affirmative actions and grant relief to Respondent. To not do so would set a precedent for future infringements to occur without just compensation. To prevent the free-riding profiteering of Gardashyan's name and mark and the marks of future trademark owners, this Court should grant a permanent injunction against Pattel, Inc.'s use of said mark in Bambi doll goods.

Therefore, this Court should affirm the Fourteenth Circuit Court of Appeals and thereby grant a permanent injunction on Pattel, Inc. from advertising her mark on their toy goods in order to protect and uphold Gardashyan's trademark symbol and contribution to the American free market.

CONCLUSION

Respondent has sufficiently shown that under § 1114 of the Lanham Act, nominative fair use applies in this case because Petitioner has used Gardashyan's mark in reference to Respondent. Furthermore, nominative fair use should be

analyzed strictly as a likelihood of confusion and not be adopted as an affirmative defense. The factors of nominative fair use, as interpreted by the Third Circuit Court of Appeals, is the proper test to apply under the given circumstances. In conclusion, Respondent has established a likelihood of confusion via the eight factors presented in the *Polaroid* test, met the three-prong test of nominative fair use, and has shown the dangers a ruling in favor of Petitioner can have upon an owner's right to be protected from trademark infringers. For the foregoing reasons, the judgment of the United States Court of Appeals for the Fourteenth Circuit should be affirmed and the Respondent should be granted a permanent injunction against Petitioner for trademark infringement.

Respectfully Submitted,

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October 21, 2016

CERTIFICATE OF SERVICE

This document certifies hand delivery of one copy of the foregoing brief to my opponent's mailbox on this twenty-first day of October, 2016.

Team 119

CERTIFICATE OF COMPLIANCE

This document certifies that this brief was complete using WordPerfect software, Courier New, in 12-point type. It contains 9,928 words. This brief complies with the length requirements of this Court.

This document further certifies that the author of this brief has complied with all applicable honor code requirements, including the requirement that the author may not consult briefs or memoranda prepared on behalf or amici to this case.

Team 119