

No. 16-1225

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 PETITIONER

—————
TEAM NO. 121

COUNSEL FOR PETITIONER

QUESTIONS PRESENTED

- I. Whether this Court should adopt nominative fair use as an affirmative defense when this Court held, in previous jurisprudence, fair use as an affirmative defense and provide guidance and clarity to the warring circuits.
- II. Whether this Court should find that Pattel Inc. fairly used Ms. Gardashyan's trademark when it clearly disassociated with her on the packaging of the Fashionista Bambi doll and only used points of her style, as portrayed by other celebrities, to reference the toy.

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The opinion of the Fourteenth Circuit is reported at 1135 F.3d 759.

STATEMENT OF JURISDICTION

In February 2015, Under 15 *U.S.C.A.* 1114 (West), Respondent filed a trademark infringement action against Petitioner. The District Court for the District of Bel Air ruled in favor of Petitioner, in accordance with the Ninth Circuit, citing that their use of the nominative fair use as an affirmative defense precluded Respondent from recovering.

Respondent appealed this matter to the Fourteenth Circuit of the United States Court of Appeals. The Fourteenth Circuit decided to adopt the Second Circuit's iteration of nominative fair use, where defendants in trademark infringement cases do not have access to this defense, and adopted the Second Circuit's view for determining trademark infringement involving a nominative use of the mark.

Under 28 *U.S.C.A.* 1254 (West), The United States Supreme Court granted writ of certiorari to hear arguments pertaining to nominative fair use with regard to trademark infringement.

STATEMENT OF THE CASE

Pattel, Inc. ("Petitioner"), a Bel Air corporation, manufactures and sells the Bambi doll, one of Petitioner's most lucrative products. Since it hit the shelves, the

doll sold more than five hundred (500) million units. (R. 1). Petitioner designs the Bambi doll by basing them on the “original look” of the dolls coupled with modern day celebrities. (R. 1). These celebrities include movie and television stars, musicians, and fashion models. Petitioner purports a message of female independence and inspiration with producing the Bambi dolls. (R. 1).

Cammy Gardashyan (“Respondent”); an American socialite, businesswoman, model, and reality television star; skyrocketed to stardom in 2007 after appearing on the show, “Keeping Up with the Gardashyans.” (R. 2). Due to her appearance on the show, Respondent’s personal life garnered media attention from all over the world and from her fame, resulted in a consumer base wanting to buy products associated with her. (R. 2). Consumers usually associate her particular style with long straight black hair, animal print clothing, shiny heels, and a curvy figure. (R. 2). And the age of her fans range from five to one hundred. (R. 2). Consumers, however, also associate this type of style with her family members and other celebrities, referred to as Fashionistas. (R. 2).

In light of her recent superstardom, Respondent trademarked her name in order to profit from consumers purchasing her fashion, jewelry, and cosmetic products. (R. 2). The trademark includes her initials, stylized back to back, and her full name, “CAMMY GARDASHYAN,” in bold print. (R. 2).

In 2015, Petitioner, based on market trends for the toy industry, created the Fashionista Bambi doll (“Doll”). (R. 2). The market research, conducted by Petitioner in 2015, helped inspire the Doll. (R. 3). Although the Doll emulates

Respondent's style and the Doll's voice feature says, "I want to be just like Cammy Gardashyan," its basic measurements still follow the original Bambi doll design. (R. 3). Furthermore, Petitioner expressly included a disclaimer on the packaging, explaining its disaffiliation with Respondent, and expressly stating that Respondent did not sponsor this product. (R. 3).

STANDARD OF REVIEW

This Court reviews questions of law *de novo*. See, *Highmark Inc. v. Allcare Health Mgmt. Sys.*, 134 S. Ct. 1744, 1748 (2014). However, because likelihood of confusion lies in the realm of fact bound inquiry, the courts must apply a clear error standard of review. See, *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 120 (1st Cir. 2006).

Due to the unique situation of this case, this Court should review the issue of whether to adopt a nominative fair use test *de novo*. The Court must apply the standard of clear error in deciding the trademark infringement issue brought by the Respondent.

STATEMENT OF THE ARGUMENT

This Court should adopt the nominative fair use test as an affirmative defense because previous jurisprudence, by this Court, allowed fair use as a defense. Furthermore, adopting nominative fair use as an affirmative defense will stabilize the confusion amongst the courts and give the parties a chance to fairly litigate trademark infringement.

This case forces this Court to view Petitioner's use of Respondent's trademark as nominative, because Petitioner merely used a necessary amount, of the owner's mark, to reference their product. In following the doctrine of *stare decisis*, this Court must adopt nominative fair use. On a policy basis, this court must provide guidance to the lower courts on this emerging area of law. Lastly, the Fourteenth Circuit further complicated area of law and greatly burdened future litigants by following the standard set by the Second Circuit.

This Court should rather apply the methods prescribed by the Third Circuit. Under the Third Circuit, the plaintiff makes their prima facie case for trademark infringement. Regardless of whether plaintiff makes a prima facie case, a defendant may raise nominative fair use as an affirmative defense precluding him or her from liability. As applied to this case, Petitioner fairly used Respondent's mark, in a nominative way, because it only used a necessary amount needed to reference Petitioner's product. And, Petitioner clearly disassociated from Respondent's trademark by expressly putting a waiver on the packaging.

ARGUMENT

I. By Adopting Nominative Fair Use as an Affirmative Defense, This Court Will Stabilize the Confusion Amongst the Courts and Allow the Parties to Fairly Litigate Trademark Infringement.

In *KP Permanent Make-Up*, this Court held that a defendant could raise fair use as an affirmative defense. See, *KP Permanent Make-Up, Inc. v. Lasting Impressions I, Inc.*, 543 U.S. 111, 118 (2004). Petitioner's use of Respondent's trademark was nominative because her mark was used to reference Petitioner's product. Establishing nominative fair use as an affirmative defense will end the confusion amongst the courts and create an environment of fair litigation.

a. This Case Requires the Court to View the Usage of the Trademark as Nominative Because Petitioner Used the Mark to Reference Its Own Product.

The Ninth Circuit previously explained the difference between descriptive and nominative fair use. See, *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992). Descriptive fair use occurs when the infringer uses the owner's mark to *describe* infringer's product. *Id.* at 306. Nominative fair use occurs when the infringer uses the trademark to *reference* their product. *Id.* at 306. Additionally, the Ninth Circuit stated that some products do not have other suitable substitutions to describe them and require using other trademarks in order to effectively do so. *Id.* at 306.

In this case, Petitioner used the Respondent's mark because there was no other way to describe their doll as a Fashionista with straight, black hair, animal print clothing, and shiny heels. This shows the District Court was correct in holding that Petitioner's use was nominative because the claim of infringement relates to using the mark to reference Respondent's alternative products in order to showcase her status as a Fashionista. The public idealizes Respondent for her specific traits and Petitioner merely uses those traits, associated with her mark, to reference the Doll. Under the descriptive method, seeing the difference between the two allows the infringer to use the owner's trademark to describe his or her goods. On the other hand, to classify the usage of the mark as nominative, the infringer must have no other way to reference or describe his or her product other than utilizing the owner's mark.

b. This Court Should Adopt Nominative Fair Use as an Affirmative Defense because of Stare Decisis and provide guidance to the Lower Courts on this emerging area of law.

In a previous case, this Court held that the defendant might raise fair use as an affirmative defense to defend against a claim of trademark infringement. *KP Permanent Make-Up*, 543 U.S. at 118. An affirmative defense allows a defendant to assert new facts that can defeat plaintiff's claim, even if found truthful. See, *LG Philips LCD Co. v. Tatung Co.*, 243 F.R.D. 133, 137 (D. Del. 2007). Usually, this Court follows the policy of *stare decisis* to foster reliance on judicial decisions. See, *Payne v. Tennessee*, 501 U.S. 808, 827 (1991). This Court should establish an

affirmative defense because it ruled in its favor in past cases. And, on a policy level, establishing this defense will not only quell the confusion among the circuits, but also provide fairness to the parties in adjudicating their respective case-in-chiefs.

i. This Court, In Past Cases, Already Established Fair Use as an
Affirmative Defense.

The Lahman Act precludes the plaintiff from recovering against a defendant for trademark infringement if defendant's use existed in the realm of fair use. 15 U.S.C.A. §1115(b)(4) (West). This Court held a defendant can use fair use as an affirmative defense if the infringer used the owner's mark to describe or reference infringer's products. See, *KP Permanent Make-Up*, 543 U.S. at 118; see also, *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924). Moreover, this Court established, "a principle of policy... of adherence to the latest decision." *Payne*, 501 U.S. at 828.

In *KP Permanent Make-Up* and *Prestonettes*, plaintiffs brought claims against defendants for using their trademark to reference or describe defendant's own products on the market. *KP Permanent Make-Up*, 543 U.S. at 118; and see also, *Prestonettes*, 264 U.S. at 367. In *Prestonettes*, this Court held the defendant fairly used the mark because owners of trademarks should not preclude their use by others if other users do not deceive the public with their usage of the mark. *Prestonettes*, 264 U.S. at 369. Although in *KP Permanent Make-Up*, this Court remanded the case back to the lower court to allow a defendant to raise fair use as a defense. *KP Permanent Make-Up*, 543 U.S. at 123.

Following this Court's previous decision, this Court should allow Petitioner to raise a nominative fair use defense, because the Court previously interpreted the statute to allow fair use as an affirmative defense. Moreover, use of this defense is entitled to Petitioner since it did not use the mark for malicious or deceptive purposes.

- ii. By Adopting a Nominative Fair Use Defense, the Court Will End Confusion Among the Circuits in this Area of Law and Provide Guidance for Future Matters.

The Ninth Circuit became the first circuit to establish nominative fair use as a defense. See, *New Kids on the Block*, 971 F.2d at 308. The New Kids Court formulated the factors, if met, grants an affirmative defense for the defendant's use of plaintiff's trademark. *Id.* at 308. The three prongs are: (1) the product must not be readily identifiable without use of plaintiff's mark, (2) defendant only used as much as necessary to identify the product, and (3) defendant must not do anything to suggest associating or sponsorship with the plaintiff. *Id.* at 308. The Court in this case ruled that defendant's use was nominative because they had no other way to describe their product without referencing to the plaintiff's mark. *Id.* at 309.

The First and Third Circuits, moreover, under the direction of *KP Permanent Make-Up*, established their own version of the nominative fair use affirmative defense against a plaintiff's claim of likelihood of confusion. See, *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (2nd Cir. 2005); See also, *Swarovski Aktiengesellschaft v. Bldg. #19, Inc.*, 704 F.3d 44, 53 (1st Cir. 2013).

However, the Second Circuit chose not to follow their fellow circuits and confusingly combined the factors for determining nominative fair use into the likelihood of confusion test, creating a lengthy eleven-factor analysis. See, *Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 156 (2nd Cir. 2016).

Therefore, this Court should adopt a nominative fair use test as an affirmative defense to a claim of trademark infringement for the following reasons set below. First, it would create a uniform standard applied by all circuits. And second, it would eliminate confusion about what procedure to apply to this expanding area of law.

For policy reasons, the Court is additionally encouraged to adopt the nominative fair use test, set forth by the third circuit, as an affirmative defense. The majority of the Circuit Courts found a defendant's use of nominative fair use, as an affirmative defense, as valid. Moreover, this encourages the Court to create one solidary rule for future cases that address the same issues, in order to end all of the confusion and discrepancies among the Circuits. One rule would lift the burden on other circuits deciding this issue and lessen the difficulty of adjudicating trademark infringement in their circuits.

- iii. The Fourteenth Circuit Wrongfully Adopted the Second Circuit's Holding Because It Placed a More Complex Burden on the Parties, Reduced Fairness Among the Parties, and Placed a Bigger Burden on the Court.

Under *KP Permanent Make-Up*, this Court explained that Congress specifically assigned fair use as a defense to trademark infringement cases that cause a likelihood of confusion. *KP Permanent Make-Up*, 543 U.S. at 118. The Fourteenth Circuit, in applying the Second Circuit's rationale, caused more confusion among the courts and detrimentally burdened future parties litigating this issue.

Due to adopting the Second Circuit's method, the Fourteenth Circuit placed many encumbrances on the parties adjudicating this issue. First, to place an eleven factor test on the plaintiff creates a very high burden on the plaintiff, only comparable to the widely known, highly supernumerary and muddled test of classification between independent contractor and employee. See, *Cnty. For Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989). In combining the two tests, The Fourteenth Circuit created an immoderate and undesirable situation for both parties, notwithstanding the judge who must go through the eleven factors for both parties and their analysis of each factor to their subsequent case.

Second, to combine the initial eight factors to the only three relevant factors for the defense would be vacuous since the remaining three factors, required for the plaintiff to analyze, will only be relevant to the defense. The three extra factors

would be required of the plaintiff to analyze will be to compare the range of how the plaintiff's mark was used. These factors will always be weighted in the plaintiff's favor, even though it should not be their analysis to make, because the plaintiff would have to satisfy a majority of the factors to have a valid trademark infringement case. It is not in the Court's best interest to allow the plaintiff to argue against the defendant's prospective arguments because it does not give a fair trial to the defense. Moreover, to allow the plaintiff to argue the defendant's three factors to prove the use was fair proves to be redundant and inefficient, as explained above.

In conclusion to combine the two separate tests that should remain separate is impractical and illogical. The Court's ability to create a precedent that will produce a test that is easier to follow and will be less burdensome on not only the representing attorneys, but also on the judges that will be hearing the cases. Currently, this Court is at a crossroads. This is a one time opportunity at creating a law that can be used widely and uniformly and it is vital that this Court implements the accurate test, which is proposed below. The more logical way to address these issues would be to keep them separated and have the likelihood of confusion test remain with its eight factors, resting on the plaintiff to make their prima facie case for trademark infringement.

II. This Court Should Follow the Nominative Fair Use Test, as Articulated Under The Third Circuit, and In Doing So, Find That Petitioner Fairly Used Respondent's Trademark, in a Nominative Way.

Under the Third Circuit's procedure, the nominative fair use defense requires the plaintiff to make a prima facie case for trademark infringement by showing a likelihood of confusion when defendant used their mark. *Century 21*, 425 F.3d at 223. Regardless of whether the plaintiff proves a likelihood of confusion, defendant can show it fairly used the mark, in a nominative way, to avoid liability. *Century 21*, 425 F.3d at 225. Petitioner used Respondent's mark in a nominative fair way because Petitioner only used the mark as necessary to reference their Doll and included a waiver on the packaging to show its disassociation with Respondent and her trademarked products.

a. The Nominative Fair Use Test Should First Require the Plaintiff to Prove a Likelihood of Confusion Through the Infringer's use of the Trademark, and Then Defendant Can Show the Usage Fair, in a Nominative Sense, By Proving Three Factors.

In proposing to follow the Third Circuit's interpretation, this Court should lay out the following procedure. First, the plaintiff presents a prima facie case for trademark infringement against the defendant. *Century 21*, 425 F.3d at 223. Defendant may avoid liability by proving the use of the mark was nominative fair use by showing he or she used only the necessary amount to reference their product and actively disassociating with the owner. *Century 21*, 425 F.3d at 225.

- i. Plaintiff Must First Try to Make a Prima Facie Case for Likelihood of Confusion, In Order for Defendant to Use the Affirmative Defense of Nominative Fair Use.

Plaintiff makes a prima facie case for likelihood of confusion by arguing eight distinct factors, through a totality of the circumstances, in favor of defendant's use of plaintiff's trademark causing confusion in the marketplace. See, *Century 21*, 425 F.3d at 222. In *Century 21*, the Court outlined the following factors: (1) strength of the trademark; (2) similarity of the mark; (3) proximity of the products and their competitiveness with one another; (4) evidence showing trademark's owner may develop a product to sell in the infringer's market; (5) evidence of consumer confusion; (6) evidence that defendant adopted the mark in bad faith; (7) the quality of the products; (8) consumer sophistication in relevant market. *Century 21*, 425 F.3d at 224.

In *Century 21*, plaintiff brought suit against defendant for continued use of their mark on their website. *Id.* at 216. Defendant continued to use plaintiff's trademark on their website, after plaintiff ended their partnership, to advertise defendant's continued association with plaintiff's real estate firm. *Id.* at 215. In creating the new test, the Court remanded the case back to the lower court to determine whether a fair use did exist based on the new approach the Court adopted. *Id.* at 232.

The new nominative fair use test requires a similar analysis. When a plaintiff claims trademark infringement against defendant, the crux of their argument

requires showing the defendant's products and acts confuse the consumers in their respective markets. Regardless for whether a defendant chooses to raise the defense of nominative fair use, plaintiffs must still state a reason for litigating against the adverse party.

- ii. After Plaintiff Presents His or Her Claim for a Likelihood of Confusion, Defendant May Present His or Her Case that the Use was Nominative.

Defendant will successfully show the use of the trademark was nominative through swaying the following three factors in his or her favor: (1) is the use of plaintiff's mark necessary to describe the plaintiff's and defendant's product; (2) did the defendant use only as much as necessary of the plaintiff's mark to describe their products; and (3) did defendant's conduct reflect the true relationship between plaintiff's and defendant's products. *Century 21*, 425 F.3d at 228.

Similar to the Third Circuit's interpretation, the defendant will explain how minimal the use is and the steps taken to properly distinguish itself from the plaintiff's mark. In doing so, the defendant will show that, although it used the mark to reference its product, the usage was fair because there is no other way to properly describe or even reference it.

b. Under the Nominative Fair Use Test, The Defense Precludes Respondent from Succeeding on a Claim of Likelihood of Confusion Because Petitioner Clearly Warned Consumers of the Disassociation Between Itself and Respondent and Only Used As Much As Necessary to Reference Its Product.

Under the Third Circuit, a defendant may raise the nominative fair use affirmative defense after the plaintiff makes a claim for likelihood of confusion. See, *Century 21*, 425 F.3d at 221. Respondent, under the eight-factor test for likelihood of confusion, will likely fail in showing confusion due to the differences in Petitioner's products and Respondent's mark. Regardless of finding a likelihood of confusion, Petitioner will succeed on a showing of nominative fair use because it used only as much as necessary of the mark and clearly distinguished itself from Respondent.

i. This Court Should Find No Likelihood of Confusion Between Respondent's Trademark and Petitioner's Use of the Mark for their Product.

In order to determine whether the trademark use would confuse consumers, a plaintiff must show a likelihood of confusion through a totality of the following eight factors: (1) strength of the trademark, (2) similarity of the marks, (3) proximity of the products and their competitiveness with one another, (4) evidence that the mark's holder 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, (8) and sophistication of consumers in the relevant market. See, *Int'l Info.*, 823 F.3d at 160.

This court will find it highly unlikely that even a likelihood of confusion exists between Petitioner and Respondent's products. Petitioner's products target children and collectors ranging among all ages. Consumers, additionally, recognized Petitioner and the goods it produced to relate to the toy industry. Respondent, meanwhile, also influences those of the same range as Petitioner, but targets a different market. Her target market includes the fashion, jewelry, and cosmetic industry. Respondent, additionally, made no reference to want to enter the toy industry. Furthermore, the use of the mark on Petitioner's product extends only to her full name used twice; once on the waiver and once in a thought bubble to illustrate what the Doll says when it speaks. Petitioner did not use the full mark by excluding her stylized initials on the product. Consumers of Respondent's products would clearly recognize that the Doll does not symbolize her products for the lack of the visible trademark on it.

Taking all of the facts into consideration, this Court should find no likelihood of confusion between the trademark and Petitioner's use. Although the strength of Respondent's mark is great, due to her outreach to millions of fans across the world and use of her name on the dolls packaging, one can clearly see that Petitioner did not act in bad faith because it manufactures toys, and Respondent manufactures fashion, jewelry and cosmetic items. Moreover, this shows the wide proximity between the markets for their respective products. And, since 1961, Petitioner

followed its original design for producing the Bambi dolls. Respondent has a distinct mark and labels it accordingly on her products. Without the particular mark on the packaging, confusing consumer will likely not occur.

Respondent may argue that Petitioner now competes in the same market by selling the Doll because both parties sell their products to a similar age range. However, no evidence of competitiveness exists since Respondent's products include those in the fashion, jewelry, and cosmetic industry, while Petitioner only manufactures toys.

Hence, this Court will likely find no likelihood of confusion between Petitioner's product and Respondent's trademark because consumers will likely tell the difference between Petitioner's toys and Respondent's fashion items.

- ii. Petitioner Successfully Raises the Defense of Nominative Fair Use because It Only Used the Necessary Amount of the Trademark and Clearly Labeled Its Disaffiliation with Respondent.

Regardless of a finding of nominative fair use, the defendant can show a nominative fair use of the mark if: necessary to even use the mark to reference his or her product; defendant only used so much as necessary to reference his or her product, and defendant reflected the true and accurate relationship, through conduct or language, between plaintiff and defendant's products or services. *Keurig, Inc. v. Strum Foods, Inc.*, 769 F.Supp.2d 699, 707 (D. Del. 2011).

In *Keurig*, plaintiff claimed trademark infringement against defendant due to defendant's selling of coffee cartridges, "K-cups," for plaintiff's coffee machine. *Id.* at

703. Defendant put on the packaging that it had no affiliation with plaintiff's product, merely advertised the K-cups were meant for usage with the plaintiff's machine. *Id.* at 704. The Court held that defendant's use was nominative because of the clear disassociation with plaintiff's mark, and defendant only used the mark as necessary to reference their product. *Id.* at 710.

Similarly to *Keurig*, Petitioner considers celebrities and other important people of its time when designing new Bambi dolls. The Bambi doll, referenced in this dispute, has straight long black hair; wears animal print clothing; and shiny heels. Although the Doll references Respondent's name when it speaks, Petitioner specifically wrote on the doll's packaging that it did not affiliate with Respondent in the creating this Doll. It also packaged a different style of shoe, specifically sparkly shoes, than what Respondent associates with. Respondent, furthermore, does not produce any commercial products in the toy industry, but rather the clothing, jewelry, and cosmetics industry and the public associates Respondent's predominate features with her family members and other celebrities widely portrayed in the media.

This shows that Petitioner fairly used the mark in a nominative fashion because Respondent inspired Petitioner in creating this particular style of doll; Petitioner did not use Respondent's name, but only features with no other way to describe them in the world; and specifically mentioned, on the Doll's packaging that Respondent did not affiliate with Petitioner on this venture, even though the Doll emulates Respondent's style and its voice references Respondent herself.

Petitioner used her mark because Respondent is not the only celebrity to associate with that particular style; her family is as well; and this Doll's history encompasses emulating other celebrities in the past. Petitioner, moreover, used as much as necessary by only utilizing her particular fashion features and naming the doll, "Fashionista Bambi." Lastly, Petitioner clearly establishes a distinction between the doll and Respondent through the waiver listed on the toy's packaging and Respondent does not create products in the toy industry, rather the cosmetics, jewelry, and fashion industry.

Petitioner, therefore, used the trademark in accordance with nominative fair use because the features borrowed from Respondent merely referenced her, since, in the known world, there did not exist another method to describe this doll to the consumer.

CONCLUSION

For the reasons stated above, this Court should reverse the ruling of the Fourteenth Circuit.