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Trademark Fair Use: Braun® Versus the Bunny

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TRADEMARK FAIR USE: BRAUN® VERSUS THE BUNNY

VANESSA P. ROLLINS*

INTRODUCTION	285
I. TRADEMARKS—LOGOS AND PRODUCT DESIGN	289
A. <i>Descriptive Fair Use</i>	291
II. NOMINATIVE FAIR USE.....	295
III. APPLICATION OF NOMINATIVE FAIR USE BEYOND PLAIN- TEXT WORD MARKS.....	302
CONCLUSION.....	305

INTRODUCTION

The Author was rather tickled (no pun intended), by a story out of the United Kingdom concerning the confluence of two seemingly unrelated products—a vibrating toothbrush and plastic sex-toy shaped like a bunny.¹ The plastic bunny was designed specifically to work with a vibrating toothbrush, turning it into a vibrating bunny-shaped sex-toy. Some might regard this as a clever convergence of technologies.² Yet, a manufacturer of vibrating toothbrushes opposed the use of its products in association with the advertisements for the bunny.³ The toothbrush manufacturer claimed that such use could be misleading to the public

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1. See LoveHoney, Sex Toy Blog, <http://www.lovehoney.co.uk/sex-toys/blog/2007/06/11/proctor-and-gamble-gives-toothbrush-sex-toys-the-brush-off/> (June 11, 2007, 09:06).

2. See Money.cnn.com, 101 Dumbest Moments in Business, *available at* http://money.cnn.com/galleries/2007/fortune/0712/gallery.101_dumbest.fortune/33.html (last visited Jan. 24, 2009); *infra* text accompanying note 96.

3. See LoveHoney, *supra* note 1. Procter & Gamble asserted, “Our client’s trade marks should not be used to promote and sell third party products nor indeed should they be promoted by third parties for any purpose other than that for which they were intended.” *Id.* On LoveHoney’s website, the “Brush Bunny” Electric Toothbrush Rabbit Vibrator (aka the “Tingle Tip”) had been pictured next to a Braun® Oral-B® electric toothbrush. *Id.* The website also described the Brush Bunny as fitting on to an Oral-B electric toothbrush. *Id.*

and potentially injurious.⁴ The manufacturer of the bunny, on the other hand, claimed that it was simply telling the truth about its products.⁵

The vibrating bunny sex-toy is certainly not the first product to ride the coat-tails of another product, or even to depend on another product for its very utility. Many businesses offer products or services that complement the products or services of another business. For example, Apple's iPod line of digital music players spawned speakers, headphones, and carrying cases, all specifically designed to fit the shape and functionality of the iPod device.⁶ And many repair shops specialize in repairing specific brands of goods within a more general class.⁷ These businesses need to communicate the complementary relationship between the original, underlying product and their own goods or services, and sometimes there is simply no other *practical* way to communicate this relationship than to refer to the trademark⁸ representing that original product. For example, a car mechanic who specializes in repairing "Volkswagen" vehicles must necessarily refer to the Volkswagen trademark.⁹ It would be an exercise in futility for the mechanic to attempt to describe his services without referring to the trademark.¹⁰ Thus, in what has come to be known as "nominative fair use," one business may use the plain-text version of another's trademark when necessary to identify the trademark owner's goods and

4. See *id.* Procter & Gamble claimed, "Improper use of the trade marks BRAUN and Oral B in this manner is misleading to the public and could potentially result in injury." *Id.* (emphasis omitted).

5. See *id.* LoveHoney stated, "We're not suggesting that Oral B endorses the Tingle Tip (we wish!), but it's a statement of fact that the Tingle Tip does indeed fit directly on to your Oral B toothbrush, or any other electric toothbrush for that matter." *Id.*

6. See iStore.com, which specializes in accessories for all of the iPod devices. iStore, <http://www.theistore.com/> (last visited Jan. 24, 2009). See also David Zalubowski, *Couple make \$10 million on Crocs craze*, MSNBC, Oct. 3, 2006, <http://www.msnbc.msn.com/id/15121346/> (last visited Jan. 24, 2009) (Jibbitz, a small company, made accessories specifically designed and marketed for the holes in Crocs brand shoes. Crocs Inc. later purchased the Jibbitz company and endorsed the Jibbitz accessories.).

7. For example, see A & S Services, which specializes in the repair of Rolex watches. A & S Services, <http://www.as-services.com/index.html> (last visited Jan. 24, 2009). See also *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969).

8. See *infra* note 18. Trademarks identify and distinguish *goods*; service marks identify and distinguish *services*.

9. See *Volkswagenwerk*, 411 F.2d at 352.

10. Rather than simply identifying "Volkswagen" vehicles, the repair shop would have to describe the vehicles in a circuitous manner, such as by noting that the repair shop specializes in vehicles manufactured by a German company including various models that were widely popular in the late sixties, one model of which starred in its own movie.

services and to describe his own.¹¹ Courts have not extended the nominative fair use defense beyond plain-text versions of the trademark at issue to other trademark forms such as logos or product designs.

Manufacturers of “complementary” goods, such as protective covers for iPod mp3 players, and providers of “complementary” services, such as repair services for Volkswagen automobiles, however, often depict the “original” underlying product, rather than the plain-text version of the trademark, as a means to communicate the complementary relationship between that product and their own goods and services.¹² In depicting that original product, a manufacturer of complementary goods may also be depicting the trademark owner’s logo and/or protected product design. For example, the advertising and packaging of the many products spawned by the iPod digital music players often feature not only the iPod word mark, but also pictures of actual iPod devices or depictions of the iPod product design.¹³ To advertise the vibrating bunny, the manufacturer included a picture of an actual Oral-B toothbrush, with the Oral-B trademark clearly visible on the front of the toothbrush.¹⁴

Manufacturers of original products, on the other hand, tend to oppose the use of their products on packaging and in advertisements

11. See *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211, 224 (3d Cir. 2005).

12. This Article will use the term “original” to refer to the product of the trademark holder and “complementary” to refer to any goods or services that complement that product or that require that product for their very utility. Further, this Article will use the term “goods” to encompass both goods and services, unless otherwise indicated.

13. For example, the Author recently purchased an “iTrip.” Notwithstanding that the manufacturer failed to include any generic product description (it is a device that permits an iPod digital music player to be played remotely through a car stereo system), she knew that it applied to iPod devices in general because it included the iPOD plain-text trademark and a picture of an iPod device on the packaging. Furthermore, she knew it applied to a particular iPod device because it included the word mark iPOD MINI and a drawing of an iPod Mini device, among various other models also depicted. Apple has registered several trademarks for its plain text and product designs. See U.S. Trademark No. 2,835,698 (registered April 27, 2004) (“portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices”); U.S. Trademark No. 3,365,816 (registered January 8, 2008) (“[p]ortable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files”). See also David Orozco & James Conley, *Shape of Things to Come*, WALL ST. J., May 12, 2008, at R6, available at http://online.wsj.com/article/SB121018802603674487.html?mod=googlenews_wsj. However, there was no indication on the iTrip packaging that Apple had licensed the manufacturer to use any of its trademarks.

14. See LoveHoney, *supra* note 1.

relating to complementary products, and often assert trademark infringement under the Lanham Act to stop the practice.¹⁵ Because courts have limited nominative fair use to plain-text versions of trademarks, one's use of the original product on packaging for or in advertising of complementary goods may not fall within the nominative fair use defense and has been found to be impermissible under the Lanham Act.¹⁶ This Article examines whether nominative fair use could encompass such use.

First, in Part I, this Article provides background concerning federal protection for trademarks, specifically logos and product designs, and highlights why classic, descriptive fair use has not been available as a defense for cases involving complementary uses of logos and product designs. In Part II, this Article examines the nominative fair use defense, including, in particular, the Ninth and Third Circuits' divergent approaches regarding infringement liability. This Article suggests that any trademark infringement action relating to nominative uses should follow the Supreme Court's descriptive fair use analysis and require proof of likelihood of confusion as a prerequisite. Part III examines courts' applications of nominative fair use, which they have not extended to encompass logos or product designs. In the Conclusion, this Article ultimately concludes that the use of an original product, including any trademarked product design or logo, in conjunction with the sale of a complementary product (or provision of a complementary service) is a fair use that, even given some likelihood of confusion, may insulate a defendant from trademark infringement liability.¹⁷

15. The Lanham Act prohibits one's use of the trademark of another in a way that is likely to confuse the consuming public as to the source, sponsorship, or approval of the goods at issue. *See* Trademark (Lanham) Act of 1946 §§ 32, 43, 15 U.S.C. §§ 1114, 1125 (2000). Trademark owners have an obligation to police their trademarks and oppose potential unauthorized uses of those marks. *See* E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 512 (E.D.N.Y. 1975). With such an obligation, it is curious why a trademark holder who attempts to police its trademark from unauthorized uses would at the same time be making one of the "dumbest" financial moves of the year. *See supra* note 2 (Fortune Magazine voted Proctor and Gamble's actions in sending the cease and desist letter to LoveHoney as one of the dumbest moments in business.).

16. *See* Liquid Glass Enters. v. Dr. Ing. h.c.F. Porsche AG, 8 F. Supp. 2d 398 (D. N.J. 1998) (prohibiting the use of the PORSCHE logo and an actual Porsche automobile in advertising a car polish). When an original product is used in a complementary manner, trademark infringement liability would depend on whether a trademark is visible on the original product, or whether the product itself is a trademark. If no trademark is visible and the product is not a protected product design, then there would be no basis for a finding of trademark infringement.

17. This Article specifically addresses trademark *infringement* liability and leaves for

I. TRADEMARKS—LOGOS AND PRODUCT DESIGN

A trademark includes “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”¹⁸ Virtually anything that possesses the ability to distinguish and identify goods and to indicate source can serve as a trademark.¹⁹ Thus, to the extent that it possesses this ability, even the design of the good itself may become a trademark.²⁰ When any of the possible embodiments is capable of serving as a trademark, it is said to be “distinctive.” No singular basis exists, however, for determining when this exists for each of the different embodiments.

Words become trademarks, or “word-marks,” depending on where they fall along a spectrum of distinctiveness. An arbitrary, fanciful, or suggestive word is inherently distinctive; a descriptive word is capable of acquiring distinctiveness through secondary meaning; and a generic word is never distinctive.²¹ To apply the generic-descriptive-suggestive-arbitrary-fanciful “distinctiveness spectrum” effectively, one must be able to distinguish between generic, descriptive, and suggestive/arbitrary/fanciful words. Imprecise lines separate generic words from descriptive, and descriptive words from suggestive, yet the significance between these designations is critical.²² The determination

another day an exhaustive (and exhausting) evaluation of trademark dilution liability. For an exceptional analysis of modern trademark dilution, including underlying cognitive theories concerning consumer responses to trademarks, see Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2007-2008).

18. Lanham Act § 45, 15 U.S.C. § 1127 (2000). The Lanham Act provides a similar definition for service marks: “The term ‘service mark’ means any word, name, symbol, or device . . . used by a person . . . to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services, even if that source is unknown.” *Id.* For clarity and uniformity, the author has chosen to use the terms “trademark” and “goods” throughout the following discussion. Unless otherwise indicated, those terms include “service marks” and “services” respectively. The term “trademark” will be used hereinafter to designate both trademarks and service marks.

19. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (explaining, “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes”).

20. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000).

21. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976).

22. See *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297, 307-08 (3d Cir. 1986).

[T]hese distinctions are crucial. If we hold a term arbitrary or suggestive, we treat it as distinctive, and it automatically qualifies trademark protection If we hold a mark descriptive, a claimant can still establish trademark rights, but only if it proves

that a word is descriptive, for example, affects not only the acquisition of trademark rights for the trademark holder, but also the strength of any resulting trademark.²³

In a strict application of the traditional distinctiveness spectrum analysis, a fanciful, arbitrary, or suggestive logo or product design would be immediately protectable as inherently distinctive, a descriptive logo or product design would be protectable only upon acquiring distinctiveness, and a generic logo or product design would not be protectable. The traditional spectrum, however, ineffectually differentiates protectable logos and product designs from those that lack the ability to distinguish the goods of one manufacturer from those of another. From a strictly semantic perspective, the terms “descriptive” and “suggestive” denote underlying definitional capabilities that words clearly possess, but logos and product designs may not.²⁴ Descriptive terms, for example, are words that describe the characteristics of the goods at issue; suggestive terms call to mind the goods but do not describe them.²⁵ Inasmuch as it is difficult to demarcate word marks, it is even more difficult to demarcate logos and product designs into suggestive and descriptive categories.²⁶ On the other hand, logos and

that consumers identify the term with the claimant, for that identification proves secondary meaning Finally, if we hold a designation generic, it is never protectable because even complete “success . . . in securing public identification . . . cannot deprive competing manufacturers of the product of the right to call an article by name.”

Id. at 297 (quoting *Abercrombie & Fitch*, 537 F.2d at 9).

23. See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir. 1999) (rev’d on other grounds) (“Distinctiveness is a crucial trademark concept, which places marks on a ladder reflecting their inherent strength or weakness. The degree of distinctiveness of a mark governs in part the breadth of the protection it can command.”). See also *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

24. See Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach To Trademark Law*, 84 IOWA L. REV. 611, 658-59 (1999).

[T]he test is based on a linguistic reference between word and product and has (unsurprisingly) proved an unworkable formulation for directing our assessment of the distinctiveness of shapes outside of very obvious categories. Linguistically conditioned tests may enable courts to discern the meaning of textual matter, but such tests should not be mechanically applied to determine the meaning of matter for which they offer little evaluative assistance. Analytical devices should not frustrate the purposes of trademark protection by obscuring the reasons for denial or grants of protection.

Id.

25. See *Zatarains*, 698 F.2d at 790-91.

26. See *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267 (2d Cir. 1995), wherein the district court found a pine tree-shaped trademark to be suggestive, while on appeal, the Second Circuit Court of Appeals found it to be descriptive. The district court

product designs exist that seem either completely arbitrary or totally generic for the goods they represent. These symbols denote simple, unitary concepts. It is not difficult to imagine a generic symbol for a ball (a circle) versus an arbitrary one (a moose).²⁷

Further, standards for evaluating the distinctiveness of non-word trademarks like product designs have evolved in a manner that treats them *all* like descriptive word marks by requiring a showing of secondary meaning.²⁸ It is not the demarcation of a logo or product design as descriptive that is essential to this analysis, but rather the ability of the public to use it fairly in a descriptive manner.

A. Descriptive Fair Use

As explained *supra*, trademark protection is available for descriptive words that have acquired distinctiveness.²⁹ Due to the underlying

rejected the alleged infringer's claim of fair use and granted summary judgment to the trademark owner on that issue. *Id.* at 269. The district court further determined that the defense of fair use applied only when the trademark owner's mark was descriptive, and, thus was not applicable here because the pine tree-shaped mark was suggestive. *Id.* at 268. *See also* Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977) (evaluating distinctiveness of a design mark by considering "whether it was a 'common' basic shape or design, . . . unique or unusual in a particular field, . . . a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or . . . capable of creating a commercial impression distinct from the accompanying words").

27. *See* Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 28 (1st Cir. 2008) (citing 2 J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 12:34 (4th ed. 2008) ("A mark that consists of an illustration of the goods themselves may be 'generic,' and hence incapable of serving a trademark function at all."); Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042, 1049 (9th Cir. 1998) (finding that an image of a grape leaf on a wine bottle was not deemed sufficiently distinctive to be a source identifier)) (explaining that "[j]ust as a word or phrase may be classified as generic, so too can an image or logo that describes a category of goods or services rather than a specific source"). The court in *Boston Duck Tours* ultimately concluded, however, "that the image of a duck splashing in water . . . [was] highly descriptive for the parties' services." *Boston Duck Tours*, 531 F.3d at 28.

28. *See* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000).

The phrase "secondary meaning" originally arose in the context of word marks, where it served to distinguish the source-identifying meaning from the ordinary, or "primary," meaning of the word. "Secondary meaning" has since come to refer to the acquired, source-identifying meaning of a nonword mark as well. It is often a misnomer in that context, since nonword marks ordinarily have no "primary" meaning. Clarity might well be served by using the term "acquired meaning" in both the word-mark and the nonword-mark contexts—but in this opinion we follow what has become the conventional terminology.

Id. at 211 n. 4.

29. *See supra* text accompanying note 22.

expressive function of descriptive words that have acquired trademark status, trademark holders may not exclusively control them.³⁰ Competitors necessarily require such words to describe the nature and characteristics of their own goods. Thus, in what is known as classic, or “descriptive,” fair use, the Lanham Act permits one to employ the words of a descriptive trademark in their descriptive sense to describe one’s own goods.³¹ Even in the event that there is a likelihood of confusion³² between one’s descriptive use of a word and the trademark holder’s trademark use of it, descriptive fair use may insulate one from liability.³³ In fact, the Supreme Court roundly rejected the notion that descriptive fair use and likelihood of confusion were mutually exclusive.³⁴ In *KP Permanent Make-Up*, the Court clearly dictated that the trademark holder’s burden to prove likelihood of confusion was not subsidiary to the alleged infringer’s burden to prove descriptive fair use. The defense of descriptive fair use does not include a concomitant requirement to negate confusion. The Court described such a scenario as “incoherent.”³⁵

[A] look at the typical course of litigation in an infringement action points up the incoherence of placing a burden to show nonconfusion on a defendant. If a plaintiff succeeds in making out a prima facie case of trademark infringement, including the element of likelihood of consumer confusion, the defendant may offer rebutting evidence to undercut the force of the plaintiff’s evidence on this (or any) element, or raise an affirmative defense to bar relief even if the prima facie case is sound, or do both. But

30. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12-13 (2d Cir. 1976).

31. See Trademark (Lanham) Act of 1946 § 33(b)(4), 15 U.S.C. § 1115(b)(4) (2000).

32. The Lanham Act prohibits one’s use of another’s trademark in a way that “is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval” of his goods by another. 15 U.S.C. § 1125(a)(1)(A). See Lanham Act §§ 32, 43, 15 U.S.C. §§ 1114, 1125. Courts determine liability by evaluating various factors that tend to demonstrate whether confusion is likely. These “likelihood of confusion” factors vary slightly by circuit but ultimately focus on common analyses. See ANNE GILSON LALONDE ET AL., *TRADEMARK PROTECTION AND PRACTICE* § 5.02 (2008); William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 67 (2008) (“[M]ost trademark infringement cases turn on application of a complex multifactor test. Although its precise composition differs from one circuit to the next, the fundamental attributes remain the same.”).

33. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 123 (2004).

34. See *id.*

35. *Id.* at 120.

it would make no sense to give the defendant a defense of showing affirmatively that the plaintiff cannot succeed in proving some element (like confusion); all the defendant needs to do is to leave the factfinder unpersuaded that the plaintiff has carried its own burden on that point. . . . Put another way, it is only when a plaintiff has shown likely confusion by a preponderance of the evidence that a defendant could have any need of an affirmative defense, but under Lasting's [the trademark holder's] theory the defense would be foreclosed in such a case. It defies logic to argue that a defense may not be asserted in the only situation where it becomes relevant.³⁶

This affirmative defense logically extends beyond trademarks categorized as merely descriptive to suggestive and arbitrary trademarks.³⁷ It is the defendant's use of the trademark rather than the

36. *Id.* (internal citation omitted). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 (1995).

The fair use defense recognized in this Section can be applicable even if the trademark owner presents evidence sufficient to prove a likelihood of confusion. If the manner of use by the defendant is reasonable in light of the commercial justification for the use, the possibility or even certainty that some prospective purchasers will perceive the term as an indication of source despite the reasonableness of the defendant's use is not sufficient to deprive the defendant of the right to employ the term in its descriptive sense. Thus, a defendant who uses a descriptive term fairly and in good faith to describe its goods or services is not liable for infringement even if some residual confusion is likely. However, the strength of the plaintiff's mark and the extent of likely or actual confusion are important factors in determining whether a use is fair. Surveys and other evidence relating to the perceptions of prospective purchasers are thus relevant to the application of the defense, and a use that is likely to create *substantial* confusion will not ordinarily be considered a fair use.

Id. (emphasis added). See also McGeveran, *supra* note 32, at 84 (citing Shakespeare Co. v. Silstar Corp. of Am. Inc., 110 F.3d 234, 243 (4th Cir. 1997)) (Conditioning the defense on a negative confusion finding was absurd. "[T]he plaintiff has the burden to prove consumer confusion. In the words of the Fourth Circuit, '[A] defense which can be considered only when the prima facie case has failed is no defense at all.'").

37. Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 269 (2d Cir. 1995) ("Regardless whether the protected mark is descriptive, suggestive, arbitrary, or fanciful as used in connection with the product or service covered by the mark, the public's right to use descriptive words or images in good faith in their ordinary descriptive sense must prevail over the exclusivity claims of the trademark owner."). In contrast, Anne Gilson LaLonde takes the compelling view that fanciful trademarks are not capable of descriptive fair use. See LALONDE ET AL., *supra* note 32, §11.08[3][d][i] (2008) (claiming that "[w]hen a mark has no other meaning besides its use as a mark, it cannot qualify for the fair use defense because it has no descriptive meaning to monopolize"). Some courts even maintain that *only* descriptive trademarks are susceptible to the descriptive fair use defense. See National Football League Props. v. Playoff Corp., 808 F. Supp. 1288, 1293 (N.D. Tex. 1992).

trademark's classification along the distinctiveness spectrum that is significant.³⁸ Although BLACKBERRY is arbitrary for sophisticated cell phones, for example, it is descriptive as a flavor or even color designation for various products.³⁹ Thus, it is not only descriptive trademarks that are susceptible to the affirmative defense of classic, or "descriptive," fair use.⁴⁰ Similarly, non-word marks may be used descriptively, and as such would be susceptible to the fair use defense.⁴¹

A doctrine known as "nominative fair use"⁴² derives from the same

38. See *EMI Catalogue P'ship. v. Hill, Holliday, Connors, Cosmopolous Inc.*, No. 99-7922, 2000 U.S. App. LEXIS 30761, at *21 (2d Cir. Sept. 15, 2000) ("Whether a use is descriptive must be determined by assessing the manner in which the mark is used with respect to the product or service sold by the alleged infringer. How the senior mark holder used the mark in conjunction with its own product is not relevant to this inquiry."). See also *LALONDE ET AL.*, *supra* note 32, § 11.08[3][d][i][A] ("[I]n a fair use case, the mark being used *need not* be classified as 'descriptive' on the distinctiveness scale. A defendant should not need to show that the plaintiff's mark is descriptive but instead must show that its own use of the mark is descriptive of its products.").

39. For example, see *IZZE Sparkling Blackberry soda* or the 2009 *SCION xB* in *Blackberry Crush Metallic*.

40. *Car-Freshner Corp.*, 70 F.3d at 269 (explaining that one party's exclusive right to use a mark "will not prevent others from using the word or image [constituting the mark] in good faith in its descriptive sense, and not as a trademark").

41. See *id.* ("It is a fundamental principle marking an outer boundary of the trademark monopoly that, although trademark rights may be acquired in a word or image with descriptive qualities, the acquisition of such rights will not prevent others from using the word or image in good faith in its descriptive sense, and not as a trademark."). The court also noted the descriptive fair use doctrine could

apply only to marks consisting of terms or images with descriptive qualities. That is because only such terms or images are capable of being used by others in their primary descriptive sense. But it should make no difference whether the plaintiff's mark is to be classed on the descriptive tier of the trademark ladder (where protection is unavailable except on a showing of secondary meaning). What matters is whether the *defendant* is using the protected word or image descriptively, and not as a mark.

Id. Cf. *Herman Miller, Inc. v. A. Studio s.r.l.*, No. 1:04-CV-781, 2006 U.S. Dist. LEXIS 28647, at *19 (W.D. Mich. May 9, 2006) (concluding that the alleged infringer's "inability to satisfactorily articulate its descriptive use may be attributable to the fact that it is difficult to conceive how the design configuration of the lounge chair can be used descriptively").

42. Judge Kozinski coined the phrase "nominative fair use" in his decision in *New Kids on the Block v. News America Publ'g Inc.*, 971 F.2d 302, 308 (9th Cir. 1992), but the legal concept behind it was not novel. See, for example, *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924), wherein the alleged infringer, Prestonettes was permitted to use the plaintiff's trademark, COTY, on the label for Prestonettes' perfumes and powders. The Court maintained that "[w]hen the [trade]mark is used in a way that does not deceive the public . . . [there is] no such sanctity in the word as to prevent its being used to tell the truth." *Id.* at 368. Further, courts have long recognized that a defendant could use the plaintiff's trademark to identify the plaintiff's product for purposes of resale and comparative advertising. The resale doctrine permits one to use the trademark of another in selling authentic, trademarked goods,

underlying expressive and competitive principles as descriptive fair use.⁴³ Courts disagree, however, whether it is an affirmative defense like descriptive fair use, which necessitates a preliminary finding of likelihood of confusion, or whether it involves a “non-trademark use . . . to which the infringement laws simply do not apply.”⁴⁴

II. NOMINATIVE FAIR USE

Nominative fair use permits one to use the trademark of another to describe or identify the trademark holder’s goods.⁴⁵ Moreover, nominative fair use may exist in situations where one’s use of another’s trademark not only identifies the trademark holder’s goods but also aids in describing one’s own.⁴⁶ In fact, according to the Ninth Circuit, one’s use of another’s trademark to describe one’s own goods is “the standard case of nominative fair use: Only rarely, if ever, will a defendant choose to refer to the plaintiff’s product unless that reference ultimately helps to describe the defendant’s own product.”⁴⁷ Some even regard

even if the trademark owner has not authorized the sale. One may also use another’s trademark in truthful advertising comparing one’s product to that of the trademark owner. Yet many courts and commentators maintain such uses must not create any likelihood of confusion. Again, this misses the fundamental point that trademark infringement liability requires a finding a likelihood of confusion. Comparative advertising must accommodate some amount of confusion. *See infra* note 56 and accompanying text.

43. In *New Kids on the Block*, for instance, Judge Kozinski explained, “[m]uch useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.” *New Kids on the Block*, 971 F.2d at 307.

44. *Id.* *See* discussion *infra*, Part II.

45. *See* LALONDE ET AL., *supra* note 32, § 11.08 [3] [d] (explaining that “[s]ome courts recognize a judge-made variation on the statutory fair use doctrine, calling it ‘nominative fair use’ and allowing the use of another’s trademark under certain limited circumstances. In these cases, a defendant uses a trademark that *refers to* another party’s product . . .”). *See also* Century 21 Real Estate Corp. v. LendingTree, Inc., 425 F.3d 211, 224 (3d Cir. 2005) (explaining that “by definition, nominative use involves the use of *another’s* trademark in order to describe the trademark owner’s *own* product”).

46. *See* Cairns v. Franklin Mint Co., 292 F.3d 1139, 1151 (9th Cir. 2002). In *Ty, Inc. v. Publications Int’l Ltd.*, the court explained that nominative fair use “naturally extends to situations in which the defendant uses the plaintiff’s mark to describe the plaintiff’s product ‘even if the defendant’s ultimate goal is to describe his own product.’” *Ty, Inc. v. Publications Int’l Ltd.*, No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420, *15 (N.D. Ill. Feb. 25, 2005) (quoting *Cairns*, 292 F.3d at 1151). *See also* Century 21 Real Estate Corp., 425 F.3d at 214 (citing KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 328 F.3d 1061, 1072 (9th Cir. 2003)) (Nominative fair use exists “even if the alleged infringer’s ultimate goal is to describe his own product.”) (emphasis omitted).

47. *Ty, Inc.*, 2005 U.S. Dist. LEXIS 23420 at *15 (quoting *Cairns*, 292 F.3d at 1151, n.8).

nominative use as simply another form of descriptive use.⁴⁸

Nominative use is deemed permissible because there are circumstances when there is no other way to refer to another's goods without using the trademark associated with those goods.⁴⁹ Prohibiting one's use of the trademark in such situations would force one to describe the trademarked goods via a linguistically circuitous route.⁵⁰ Instead, nominative fair use permits one to describe a TIFFANY lamp, rather than a lamp "from a prestigious New York company where Audrey Hepburn once liked to breakfast."⁵¹ In turn, one's use of the simple, succinct language of the trademark rather than an oblique substitute improves communication and thereby provides an important commercial and social benefit.⁵²

Courts differ in their approaches to and applications of nominative fair use. Traditionally, courts determine trademark infringement liability by evaluating various factors that tend to demonstrate whether

48. See *Tiffany, Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463 (S.D.N.Y. 2008).

Under trademark law, trademark owners cannot prevent others from making a descriptive use of their trademark. 'While a trademark conveys an exclusive right to the use of a mark in commerce in the area reserved, that right generally does not prevent one who trades a branded product from accurately describing it by its brand name, so long as the trader does not create confusion by implying an affiliation with the owner of the product.' This type of descriptive use of a trademark is protected under the doctrine of nominative fair use.

Id. at 496 (citing *Dow Jones & Co. v. Int'l Sec. Exch., Inc.*, 451 F.3d 295, 308 (2d Cir. 2006)) (internal citation omitted). But see, *Cairns*, 292 F.3d at 1151 (maintaining that "the classic [descriptive] fair use analysis is appropriate where a defendant has used the plaintiff's mark only to describe his own product, and not at all to describe the plaintiff's product").

49. See *New Kids on the Block v. News America Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (explaining that sometimes it is "virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark").

50. See *id.*

With many well-known trademarks, such as Jell-O, Scotch tape and Kleenex, there are equally informative non-trademark words describing the products (gelatin, cellophane tape and facial tissue). But sometimes there is no descriptive substitute, and a problem closely related to genericity and descriptiveness is presented when many goods and services are effectively identifiable only by their trademarks. For example, one might refer to "the two-time world champions" or "the professional basketball team from Chicago," but it's far simpler (and more likely to be understood) to refer to the Chicago Bulls. In such cases, use of the trademark does not imply sponsorship or endorsement of the product because the mark is used only to describe the thing, rather than to identify its source.

Id.

51. *Tiffany, Inc.*, 576 F. Supp. 2d at 497.

52. See *supra* note 42.

confusion is likely. These “likelihood of confusion” factors vary slightly by circuit but ultimately focus on common analyses.⁵³ Many courts, however, consider nominative use to be at odds with traditional notions of trademark liability.⁵⁴ “Because [nominative use] does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder.”⁵⁵ Courts approaching nominative fair use from this jurisprudential perspective do not consider the traditional likelihood of confusion test to be relevant to the analysis. Instead, they favor the test that Judge Kozinski articulated in *New Kids on the Block*:

First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁵⁶

53. See LALONDE ET AL., *supra* note 32. See also McGeveran, *supra* note 32, at 67 (“Most trademark infringement cases turn on application of a complex multifactor test. Although its precise composition differs from one circuit to the next, the fundamental attributes remain the same.”).

54. See *New Kids on the Block*, 971 F.2d at 308 (explaining that “[s]uch *nominative use* of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law”).

55. *Id.*

56. *Id.* In terms of the first prong, courts tend to vacillate between evaluating the trademark owners product and the alleged infringer’s product, which raises the question, which product did Judge Kozinski intend? In *New Kids on the Block*, Judge Kozinski asserted, “[W]here the defendant uses a trademark to describe the *plaintiff’s product*, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense . . .” *Id.* (emphasis added). See also *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211, 224 (3d Cir. 2005) (explaining that “by definition, nominative use involves the use of *another’s* trademark in order to describe the trademark owner’s *own* product”). See also *Playboy Enters. v. Welles*, 279 F.3d 796 (9th Cir. 2002).

“There is no other way that Ms. Welles can identify or describe herself and her services without venturing into absurd descriptive phrases. To describe herself as the ‘nude model selected by Mr. Hefner’s magazine as its number-one prototypical woman for the year 1981’ would be impractical as well as ineffectual in identifying Terri Welles to the public. . . .” Just as the newspapers in *New Kids* could only identify the band clearly by using its trademarked name, so can Welles only identify herself clearly by using PEI’s trademarked title.

Id. at 802 (citation omitted). As indicated *supra* note 46 and accompanying text, nominative fair use

naturally extends to situations in which the defendant uses the plaintiff’s mark to describe the plaintiff’s product ‘*even if the defendant’s ultimate goal is to describe his*

This three-part test “replaces the ‘likelihood of confusion’ test for trademark cases where nominative fair use is asserted.”⁵⁷ The United States Court of Appeals for the Ninth Circuit later explained that “application of the [likelihood of confusion test], which focuses on the similarity of the mark used by the plaintiff and defendant, would lead to the incorrect conclusion that virtually all nominative uses are confusing” because “when a defendant uses a trademark nominally, the trademark will be identical to the plaintiff’s mark, at least in terms of the words in question.”⁵⁸ Instead, the third prong of the Ninth Circuit’s test requires that one alleging nominative fair use “must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”⁵⁹ A finding in favor of the plaintiff trademark holder under this prong destroys any nominative fair use defense. In other words, a finding that the defendant’s use of the trademark suggests sponsorship or endorsement by the trademark holder results in a finding of trademark infringement liability.⁶⁰

own product.’ The [Ninth Circuit] observed that ‘this is in fact the standard case of nominative fair use: Only rarely, if ever, will a defendant choose to refer to the plaintiff’s product unless that reference ultimately helps to describe the defendant’s own product.’

Ty, Inc. v. Publications Int’l, Ltd., No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420, at *15 (N.D. Ill. Feb. 25, 2005) (quoting *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151, n.8 (9th Cir. 2002)).

57. *Century 21 Real Estate Corp.*, 425 F.3d at 220 (emphasis omitted). See also *Playboy Enters.*, 279 F.3d at 801 (“In cases in which the defendant raises a nominative use defense, the [New Kids] three-factor test should be applied instead of the [Ninth Circuit’s traditional] test for likelihood of confusion The three-factor test better evaluates the likelihood of confusion in nominative use cases.”).

58. *Century 21 Real Estate Corp.*, 425 F.3d at 220.

59. *New Kids on the Block v. News America Publ’g Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). In *New Kids on the Block*, Judge Kozinski found that nothing in the polls at issue suggested “endorsement or joint sponsorship by the New Kids.” *Id.* at 308-09. He further explained that by asking whether any of the New Kids might be a “turn off,” the USA Today announcement implied “quite the contrary” to joint sponsorship or endorsement of the polls by the New Kids. *Id.*

60. The Lanham Act precludes a *likelihood* that consumers would be *confused* as to source or sponsorship; it does not preclude the *suggestion* of sponsorship or endorsement. The two are not necessarily equivalent. “Indeed, a defendant may have a *more* difficult time showing that it did *nothing* to cause confusion under the nominative fair use standard, rather than defeating a plaintiff’s *prima facie* showing that confusion was *likely* to result.” McGeeveran, *supra* note 32, at 96 (emphasis in original). But see *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 909, n.5 (9th Cir. 2003) (noting that “the third requirement of the nominative fair use defense—the lack of anything that suggests sponsorship or endorsement—is merely the other side of the likelihood-of-confusion coin”).

Notwithstanding Judge Kozinski's assertion that the traditional likelihood of confusion analysis does not properly deal with the specific issues concerning nominative fair use, courts have interpreted the Ninth Circuit's third prong, regarding suggestion of sponsorship or endorsement simply as a traditional likelihood of confusion test, using traditional likelihood of confusion factors.⁶¹ In *Liquid Glass*,⁶² for instance, the court recited the Ninth Circuit's three-part test as instructive to Liquid Glass's nominative fair use defense, but then, after evaluating prongs one and two, the court conflated prong three into its circuit's likelihood of confusion analysis.⁶³ In effect, the court performed its circuit's traditional likelihood of confusion analysis and simply added two additional factors—prongs one and two of the Ninth Circuit's test—to foreclose Liquid Glass's nominative fair use defense. Essentially, the court in *Liquid Glass* would find nominative fair use only in the absence of a likelihood of confusion *and* prongs one and two of the Ninth Circuit's test.⁶⁴

In contrast, other courts consider a finding of likelihood of confusion to be a prerequisite to any nominative fair use analysis.⁶⁵ According to this jurisprudential approach, which is similar to that articulated by the Supreme Court regarding descriptive fair use,⁶⁶ absent a finding a likelihood of confusion and concomitant liability, there is no need for the defendant to invoke a fair use defense. Accordingly, this approach recognizes that likelihood of confusion does not negate fair use. The

61. See *Liquid Glass Enters. v. Dr. Ing. h.c.F. Porsche AG*, 8 F. Supp. 2d 398, 402-04 (D.N.J. 1998). See also *Tiffany, Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 496-98 (S.D.N.Y. 2008). "Under the doctrine of nominative fair use, [a] defendant may use a plaintiff's trademark to identify the plaintiff's goods so long as there is no likelihood of confusion about the source of defendant's product or the mark-holder's sponsorship or affiliation." *Id.* at 496 (citations omitted).

62. See *Liquid Glass Enters.*, 8 F. Supp. 2d 398. See *infra* note 64 and accompanying text.

63. *Liquid Glass Enters.*, 8 F. Supp. 2d at 403 ("Finally, and most importantly in both defeating Liquid Glass's fair use defense and establishing Porsche's infringement and false designation claims, this court finds that Porsche will likely prevail in demonstrating that the use of Porsche's trademarks and trade dress in Liquid Glass's advertisements *would likely confuse* consumers as to Porsche's connection with Liquid Glass.") (emphasis added). See *infra* note 64 and accompanying text.

64. Prongs one and two, however, should be irrelevant absent a finding of likelihood of confusion. In other words, without a finding of likelihood confusion, one wonders what purpose is served by evaluating whether the product in question is readily identifiable without use of the trademark (prong one), and whether only so much of the mark is used as is reasonably necessary to identify the product (prong two).

65. See *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211 (3d Cir. 2005).

66. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

court in *Ty, Inc. v. Publications International* explained:

[B]oth the [Lanham Act] and the common law of unfair competition support the premise that fair use can occur along with some degree of confusion. While the Supreme Court specifically declined to address the nominative fair use defense [in *KP Permanent Make-Up*], I am persuaded that its logic applies with similar force to defendants pursuing the defense of nominative fair use despite the almost certain likelihood of confusion regarding the source of the mark. While this does not mean that consumer confusion is not relevant to the issue of fair use, it does suggest that I should not disregard a defense of nominative fair use simply because a likelihood of confusion exists. The *New Kids* test provides sound criteria for assessing when nominative use is fair or unfair, despite a likelihood of confusion among consumers.⁶⁷

In like manner, the Third Circuit Court of Appeals found no meaningful difference between nominative and classic fair use that would warrant excluding a likelihood of confusion analysis for one while requiring it for the other, and thus expressly disagreed with the Ninth Circuit that the likelihood of confusion test should be supplanted entirely in cases involving nominative fair use.⁶⁸ The Third Circuit concluded:

We adopt a bifurcated approach that tests for confusion and fairness in separate inquiries in order to distribute the burden of

67. *Ty, Inc. v. Publications Int'l, Ltd.*, No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420, at *19-20 (N.D. Ill. Feb. 25, 2005) (citations omitted).

68. *Century 21 Real Estate Corp.*, 425 F.3d at 219. The court stated, It must be recognized at the outset that 'fair use' presents a fact pattern different from that of a normal infringement suit. The typical situation in a trademark case involves the defendant's having passed off another's mark as its own or having used a similar name, confusing the public as to precisely whose goods are being sold. Likelihood of confusion is the sole issue. But the fair use defense, by reason of the circumstances giving rise to its applicability, alters the premise somewhat. The defendant is not purporting to be selling goods or services that the plaintiff has trademarked, but, rather, is using plaintiff's mark in order to refer to defendant's own goods or to the goods of the trademark owner in a way that might confuse the public as to the relationship between the two. Accordingly, the legal framework still involves a showing that A's reference to B's mark will likely confuse the public, but the analysis does not end there, for the use may nonetheless be permissible if it is 'fair.' *Id.* at 217 (citations omitted).

proof appropriately between the parties at each stage of the analysis. The defendant has no burden to show fairness until the plaintiff first shows confusion. Furthermore, by properly treating nominative fair use as an affirmative defense, our approach allows for the possibility that a district court could find a certain level of confusion, but still ultimately determine the use to be fair. By contrast, a unified likelihood of confusion test would require a defendant to negate likelihood of confusion by undercutting the [likelihood of confusion] factors. Because the Supreme Court explicitly rejected such a proposition in *KP Permanent Make-Up*, we decline to adopt it.⁶⁹

The position of the Third Circuit in this matter follows logical reasoning (and parallels the position of the Supreme Court in *KP Permanent Make-Up*).⁷⁰ The Lanham Act prohibits one's use of another's trademark in a way that "is likely to confuse, to cause mistake, or to deceive" "as to the origin, sponsorship, or approval" of his goods by another.⁷¹ As explained *supra*, courts determine liability by evaluating various factors that tend to demonstrate whether confusion is likely. If a use does not meet the threshold requirements for infringement liability under the Lanham Act, then the trademark holder has no federal remedy, and the alleged infringer need not invoke any fair use defense. Only when the trademark holder proves likelihood of confusion must the alleged infringer invoke a fair use defense to avoid infringement liability.⁷²

69. *Id.* at 232. The Third Circuit also formulated its own three-part test for evaluating a nominative fair use defense. The Third Circuit instructed:

Once plaintiff has met its burden of proving that confusion is likely, the burden then shifts to defendant to show that its nominative use of plaintiff's marks is nonetheless fair. In this Circuit, we have today adopted a test for nominative fair use in which a court will pose three questions: (1) Is the use of the plaintiff's mark necessary to describe both plaintiff's product or service and defendant's product or service? (2) Is only so much of the plaintiff's mark used as is necessary to describe plaintiff's products or services? (3) Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services? If each of these questions can be answered in the affirmative, the use will be considered a fair one, regardless of whether likelihood of confusion exists.

Id.

70. *KP Permanent Make-Up*, 543 U.S. 111.

71. See Lanham Act §§ 32, 43, 15 U.S.C. §§ 1114, 1125.

72. See McGeeveran, *supra* note 32, at 66 (explaining "breathing room for fair uses requires toleration, on the margins, of some degree of consumer confusion"). Yet, as this Article explains in more detail *infra* Part III, not all courts view trademark infringement liability and fair use in this manner.

That is not to say that Judge Kozinski was incorrect. In formulating the nominative fair use test, Judge Kozinski noted that uses that neither implicate the source-identification function of the trademark nor imply or suggest sponsorship or endorsement of the trademark holder lie “outside the strictures of trademark law.”⁷³ He employed what appears to be a heightened standard for liability, beyond that of likelihood of confusion: whether the defendant’s use *suggests or implies* source or sponsorship by the plaintiff.⁷⁴ In essence, this approach seems to acknowledge that likelihood of confusion may exist without a finding of liability. It is the subsequent courts (and commentators) that conflate “likelihood of confusion” with “implication of source or sponsorship” that are in error.⁷⁵

III. APPLICATION OF NOMINATIVE FAIR USE BEYOND PLAIN-TEXT WORD MARKS

Courts have limited nominative fair use to the plain-text, non-stylized versions of the word marks at issue. Judge Kozinski, in explaining the rationale behind the defense, noted that it applies “where the only *word* reasonably available to describe a particular thing is

73. *New Kids on the Block v. News America Publ’g Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

74. *See id.* at 306. Judge Kozinski asserted that one’s nominative use of a trademark would “not imply sponsorship or endorsement of the product because the mark is used only to describe the thing, rather than to identify its source.” *Id.* at 307. Judge Kozinski further explained that the trademark liability in this case

hinge[d] on one key factual allegation: that the newspapers’ use of the New Kids name in conducting the unauthorized polls somehow implied that the New Kids were sponsoring the polls. It is no more reasonably possible, however, to refer to the New Kids as an entity than it is to refer to the Chicago Bulls, Volkswagens or the Boston Marathon without using the trademark While plaintiffs’ trademark certainly deserves protection against copycats and those who falsely claim that the New Kids have endorsed or sponsored them, *such protection does not extend to rendering newspaper articles, conversations, polls and comparative advertising impossible.*

Id. at 308 (emphasis added).

75. *See* McGeeveran, *supra* note 32, at 89 (“Although *New Kids* itself engaged in common sense-analysis of the situation before it, the test created there has not fared as well. Courts following the footsteps of *New Kids* sowed confusion and seriously deformed the original proposal.”). *See, e.g.*, *Liquid Glass Enters. v. Dr. Ing. h.c.F. Porsche AG*, 8 F. Supp. 2d 398, 403 (D.N.J. 1998); LALONDE ET AL., *supra* note 32, § 11.08 [3] [k] (“[W]hen a defendant is using a plaintiff’s trademark to refer to the plaintiff’s goods or services, it should not be subject to liability under the Lanham Act, provided it is not misleading or untruthful and confusion is not likely.”) (emphasis added).

pressed into service.”⁷⁶ The various tests that courts have used to analyze nominative fair use reflect this need-based restriction. In *New Kids* for example, Judge Kozinski explained that the defendant newspapers referenced the New Kids on the Block “only to the extent necessary to identify them as the subject of the polls.”⁷⁷ In finding nominative fair use it was important to the court that the defendant newspapers had not used the New Kids’ distinctive logo or anything else that was unnecessary “to make the announcements intelligible to readers.”⁷⁸

Manufacturers of complementary goods, however, often depict the original, underlying product, rather than the plain-text version of the trademark, as a means to communicate the complementary relationship between that product and their own goods and services. In depicting that original product, a manufacturer of complementary goods or services may also be depicting the trademark owner’s logo or protected product design.

In *Liquid Glass*, the manufacturer of car cleaners and polishes, used a sleek, shiny Porsche 911 automobile, presumably polished to its shiny finish with Liquid Glass’s car polish, in various advertisements for that product. In the advertisements, both the Porsche logo and the PORSCHE trademark were visible on the car.⁷⁹ Porsche AG objected to Liquid Glass’s use of the Porsche 911 automobile, maintaining that such use was likely to cause consumers to believe that Porsche AG sponsored or in some way endorsed Liquid Glass’s product.⁸⁰ Liquid Glass claimed that its use of the Porsche 911 automobile was fair and non-infringing because it belonged to the “President of Liquid Glass” and he had the “right to use his privately owned Porsche to advertise his company’s car polish.”⁸¹

The court agreed with Porsche AG and prohibited as unnecessary defendant Liquid Glass’s use of an actual Porsche 911 automobile in advertisements for its car polish product.⁸² In evaluating the second prong of the Ninth Circuit’s nominative fair use test—whether only so

76. *New Kids on the Block*, 971 F.2d at 308 (emphasis added).

77. *Id.*

78. *Id.* See also *id.* at 308 n.7 (explaining that “a soft drink competitor would be entitled to compare its product to Coca-Cola or Coke, but would not be entitled to use Coca-Cola’s distinctive lettering”).

79. *Liquid Glass Enters.*, 8 F. Supp. 2d at 399-400.

80. *Id.* at 403.

81. *Id.* at 401-02.

82. *Id.* at 407-08.

much of the trademark has been used as is reasonably necessary to identify the product—the court cited as illustrative the *Volkswagenwerk* case, wherein the alleged infringing repair shop was permitted to use the word “Volkswagen” but not its distinctive lettering and color scheme or the encircled “VW” emblem to identify the vehicles that it serviced.⁸³ Without articulating what trademark uses might be permissible,⁸⁴ the court in *Liquid Glass* concluded that the manufacturer of the car polish did not *need* to use the Porsche 911 automobile to describe *its products*.⁸⁵

83. *Id.* at 402-03 (citing *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969)).

84. Many, if not most, automobiles, and especially sports cars, can be recognized from their over-all shape and appearance. One wonders how *Liquid Glass* could demonstrate the utility of its product on any automobile except the most “generic” looking models. Further, one’s use of one’s own car to advertise one’s own complementary product conveys myriad messages about the product, including, in particular, that the owner trusts in the quality and performance of the product by demonstrating it on his own, rather expensive, sports car. The Author maintains that consumers are far more discerning and sophisticated than courts make them out to be. *But see* Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 904 (2004).

[C]ourts’ assessment[s] of consumer responses [are] produced by a combination of different doctrinal concerns and a number of vague standards and judicial speculations that are structured by analyzing mostly circumstantial evidence under the various factors. These characteristics of trademark law provide significant scope for the generation of normative assumptions about what consumers are like and what they value. [Further], a number of important strands of trademark doctrine disclose that an “ordinarily prudent consumer” is someone who gets confused relatively easily, does not want to think very hard, and readily internalizes the messages trademark proprietors seek to convey about promotional and prestige goods.

Id.

85. *See Liquid Glass Enters. v. Dr. Ing. h.c.F. Porsche AG*, 8 F. Supp. 2d 398; *supra* note 61. In *Liquid Glass*, the court explained that

where *Liquid Glass* used Porsche’s trademark and trade dress to describe *Porsche’s product*, rather than its own, fair use can only be successfully invoked if (1) “the product or service in question [is] one not readily identifiable without use of the trademark;” (2) “only so much of the mark or marks is used as is reasonably necessary to identify the product or service;” and (3) “the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”

Liquid Glass Enters., 8 F. Supp. 2d at 403 (quoting *New Kids on the Block v. New America Pub’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)) (emphasis added). In the subsequent analysis, however, the court evaluated the *need* for *Liquid Glass* to use the Porsche automobile (including its trademark and trade dress) to describe *Liquid Glass’s products*. *See also World Impressions, Inc. v. McDonald’s Corp.*, 235 F. Supp. 2d 831 (N.D. Ill. 2002), wherein the court rejected the nominative fair use defense of *World Impressions* (the alleged infringer) because *World Impressions* had used the trademark holder’s stylized word mark (DISNEYLAND) and one of its logos (an image of the Cinderella Castle) on maps of California tourist attractions. The court explained that *World Impressions’*

In *Ty, Inc. v. Publications International*, however, the court suggested that the alleged infringer's use of Ty's Heart Logo in various publications and collectors' guides *did not bar* the nominative fair use defense.⁸⁶ Rather, the court questioned whether the alleged infringer used the logo more than was *reasonably necessary* to identify Ty's products—a question of fact that the court could not decide on a motion for summary judgment.⁸⁷ The court surmised:

[O]ne might reasonably expect that most collectors of Beanie Babies could recognize the plush toys without seeing the Ty han[g]tag displaying the Heart Logo. On the other hand, display of the logos might be reasonably necessary to assure customers that the pictured products were, in fact, Ty's products and not copycat products.⁸⁸

In other words, nominative use *might* permit one's use of a logo, given reasonable necessity to do so. "[W]hat is 'reasonably necessary to identify the [trademark holder's] product' differs from case to case."⁸⁹ And if nominative fair use *might* permit one's use of a trademarked logo, it might also permit one's use of any trademark embodiment, including a product design.

CONCLUSION

One's use of an original product, including any trademarked logo or product design, in advertising a complementary product *could* be fair.⁹⁰

use of the stylized form of the word 'Disneyland' and the castle design goes beyond mere nominative use. Although the Disney marks may not be larger than the other identifiers on [the] maps, [World Impressions] uses the stylized form of the word 'Disneyland' and the distinctive castle design as 'attention-getting symbol[s].' Moreover, [World Impression's] use of its own mark in conjunction with the Disney marks does not save [its] use from being a trademark use. By using the stylized form of the word 'Disneyland' and the castle design, rather than a plain rendition of the word 'Disneyland,' [World Impressions] does more than simply identify Disneyland's location on a map. Instead, it implies that Disney sponsored or endorsed its maps. The court finds that this use is a trademark use, and that accordingly the fair use defense is unavailable to [World Impressions].

Id. at 843 (citations omitted).

86. *Ty, Inc. v. Publications Int'l, Ltd.*, No. 99 C 5565, 2005 U.S. Dist. LEXIS 23420 (N.D. Ill. Feb. 25, 2005).

87. *Id.* at *32-35.

88. *Id.* at *34.

89. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1154 (9th Cir. 2002).

90. But see *Polyglycoat Corp. v. Environmental Chems., Inc.*, 509 F. Supp. 36, 39

Further, some likelihood of confusion is consistent with the manufacturer of a complementary product being able to communicate its complementary message.⁹¹ A simple disclaimer regarding the relationship between the trademark holder and the manufacturer of the complementary product should ameliorate that confusion.⁹² Even if a disclaimer does not do so, it should satisfy the third prong of the Third Circuit's nominative fair use test: "Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services?"⁹³

And, though trite, a picture is worth a thousand words. In a world that has become increasingly reliant on visual symbols as shortcut referents for more complex ideas, it may even be competitively impractical to limit complementary advertising to plain-text word marks.⁹⁴ Manufacturers of complementary products may *need* to use the

(S.D.N.Y. 1980), wherein the court maintained that "a reasonable likelihood of confusion is inferred from defendant's use of plaintiff's *exact* [stylized] trademark to promote its related product, the absence of a viable alternative explanation by defendant for its appropriation of the POLYGLYCOAT mark, and other circumstances of the relevant market." *Id.* at 39 (emphasis added).

91. See, e.g., Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007) (arguing against formalism in likelihood of confusion analyses and discussing the importance of the *context* of the alleged infringer's use in determining liability). A contextual analysis "allows trademark law to adapt and to deal comprehensively with the range of commercial settings to which it applies in modern economy." *Id.* at 1658. And frankly, are people really likely to be confused that Braun is the source of a bunny-shaped sex toy simply because an Oral-B toothbrush appears along side of it in an advertisement? The "relevant consuming public" is more likely to understand the context of the advertisement and the stark, if not humorous, contrast between the two products than it is to be confused.

92. See *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 803 (9th Cir. 2002) (intimating that a disclaimer may help an alleged infringer avoid a suggestion of sponsorship by the trademark holder). See also Carl Regelmann, *Trademark Nominative Fair Use: The Relevance of the "New Kids on the Block Factors" after the Supreme Court KP Permanent Make-Up v. Lasting Impression Decision*, 16 DEPAUL-LCA J. ART & ENT. L. & POL'Y 1, 30-31 (2005) (arguing that the Ninth Circuit implicitly may view the presence or absence of a disclaimer as dispositive in determining whether the alleged infringer has used the trademark holder's trademark in a way that suggests sponsorship or endorsement by the trademark holder).

93. *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211, 232 (3d Cir. 2005). "Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth." *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 119 (2004). With respect to toothbrush adaptors, mp3 accessories, and car polish, described above, the complementary manufactures are telling the truth even if it means they have used an original manufacturer's product to do so.

94. For example, the desktop of the author's computer includes a symbol (icon) shaped like a globe with another image of a yellow, red, and orange fox, the coloring and shape of which suggests flames, partially encircling the globe. This icon represents the "FIREFOX"

original product to succinctly and effectively advertise the complementary nature of the products. It seems far more communicative to depict the actual type of toothbrush that the bunny complements (or an actual shiny red sports car that the car polish complements) than to describe the relationship in words. While the trademark holder often would rather prohibit the use, the benefit to the public in obtaining concise visual commercial information outweighs the possible harm to the trademark holder.⁹⁵

Further, the alleged harm to the trademark holder may be highly subjective, reflecting the trademark holder's particular views about the characteristics of its brands; the public may not necessarily share these views. In the case of Braun (Oral-B brand toothbrushes) versus the Bunny (toothbrush tip accessory), at least one business community found Braun's response to be financially insipid. Fortune Magazine voted Procter and Gamble's actions in this matter (sending a cease and desist letter to the LoveHoney company) as one of the "101 Dumbest Moments in Business."⁹⁶ One wonders whether its actions were "dumb" because they fueled public interest in the controversy or because they potentially foreclosed a lucrative market. Either way, the manufacturer's subjective belief of harm leaves little room for consumer sensibility or sense of humor.

brand internet search engine and associated services. An icon resembling a bottle of ink and a pen represents the word processing program, "PAGES."

95. See Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1700 (2007) ("[I]f trademark law's goal is to improve the overall quality (not necessarily quantity) of information available to consumers, giving trademark holders unfettered control over their marks will impede rather than promote that objective. Trademark holders often have no incentive to inform consumers about compatible, complementary, or competing products in which the consumers may well have an interest, or about negative reviews or price comparisons featuring their own products."). See also, Dinwoodie & Janis, *supra* note 91, at 1659 (Asserting "the need for attention to context has only grown as trademarks have come to assume an even greater multitude of roles in contemporary society A review of recent trademark cases shows that disputes frequently involve a number of competing values and may require balancing of the gains of consumer avoidance with the competing social gains of free speech or some other public good.").

96. See *supra* note 2.