

ARNOLD & PORTER LLP

Nominative Fair Use: Legitimate Advertising or Trademark Infringement?



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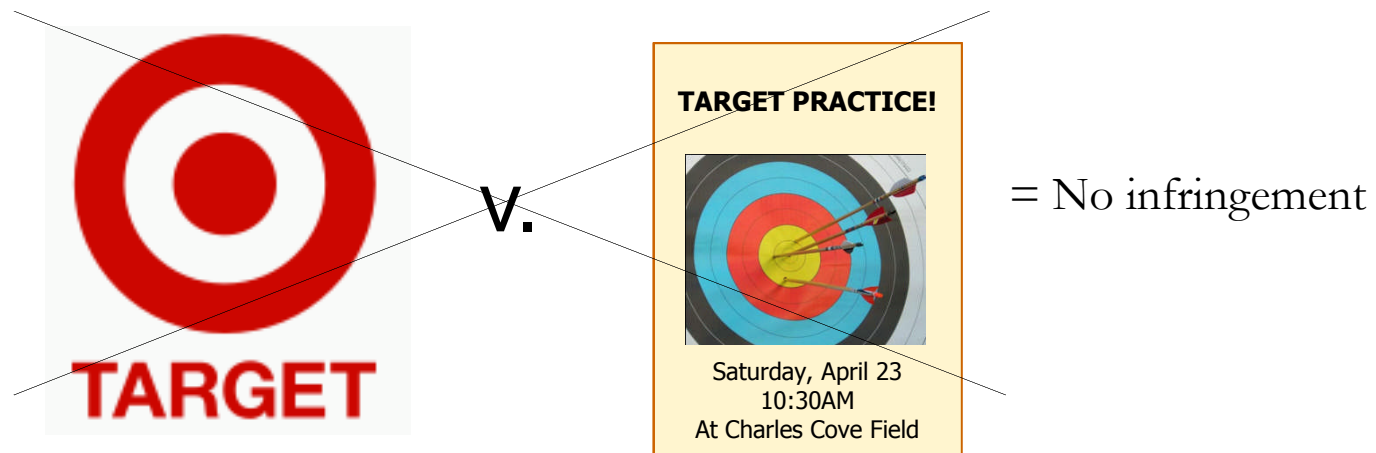
Classic Statutory Fair Use:

Defense to Trademark Infringement Under The Lanham Act

Under the Lanham Act, the **Fair Use Doctrine** protects certain uses of registered trademarks from infringement claims when *the use of the name, term, or device is “a use, otherwise than as a mark, of a term or device that is descriptive of and used fairly and in good faith only to describe goods or services of [a] party, or their geographic origin.”*

15 U.S.C. § 1115(b)(5)(A)-(C) (2006) (emphasis added).

In other words. . .



Nominative Fair Use:

Nominative Fair Use versus Classic Fair Use

- **Classic fair use** is where the junior user (e.g., *the Target Practice advertiser*) uses someone else's mark not as a trademark (e.g., *not to refer to the mega-brand Target*), but merely to describe its own goods or services.
- **Nominative Fair Use**, on the other hand, is where the junior user uses another's trademark deliberately to refer to that party, for purposes such as:

- News Reporting
- Commentary
- Parody
- Advertising (particularly comparative advertising)



Nominative Fair Use: Limitations

So, what happens when a party seeks to advertise its goods or services by referring to another party's mark?

Is it trademark infringement?

Or legitimate advertising?

Nominative Fair Use: Early & Seminal Case Law

New Kids on the Block v. News Am. Publishing, Inc., 971 F.2d 302 (9th Cir. 1992).



**“Who is your favorite *New Kids on the Block* member?
Call 1-900-555-5555 to cast your vote!”**

The New Kids claimed that the use of their name in connection with this contest was an infringement, because consumers would think the band had sponsored or approved the contest.

Nominative Fair Use:

What constitutes “nominative fair use” of a mark?

Holding: New Kids Prevail

1. The product or service being referred to must be one not readily identifiable without use of the other’s mark;

How do you advertise a New Kids on the Block contest without using the name “New Kids on the Block”?

2. Only so much of the mark may be used as is reasonably necessary to identify the product or service; *and*



vs. “New Kids on the Block”

3. The user must do nothing that would suggest sponsorship or endorsement by the mark holder.

What if the prize were *New Kids* concert tickets with backstage passes?

Nominative Fair Use Post-*New Kids*: Metatags & Websites

Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002).



← www.terriwelles.com ☆ ▾

Terri Welles, Playmate of the Year, 1981 FAN CLUB!!



You guys make me feel so special!!!! I hope you like what I've come up with:

- A quarterly newsletter from me, including the latest happenings;
- An 8x10 personally autographed never-before seen picture of me....

"This site is neither endorsed, nor sponsored by, nor affiliated with Playboy Enterprises, Inc. PLAYBOY, PLAYMATE OF THE YEAR and PLAYMATE OF THE MONTH are registered trademarks of Playboy Enterprises, Inc."

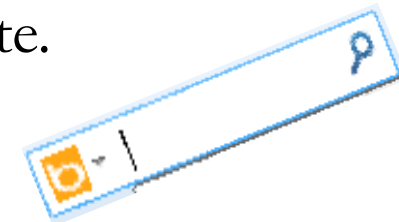
Nominative Fair Use: Metatags & Websites

Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002)

Playboy sues to enjoin **Welles'** use of the following:

1. **Website Header & Link Pages:** The registered term “Playmate of the Year” in the title of Welles’ fan club home page and the link page;
2. **Website Substance:** The watermark “PMOY '81” in the background of Welles’ fan website; and
3. **Meta-Tags:** The registered terms “Playboy” and “Playmate” in the meta-tags of defendant's site.

Playmate of the
Year™ '81, FAN
CLUB!!



Nominative Fair Use: Metatags & Websites

Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002)

Holding: Terri Welles Prevails

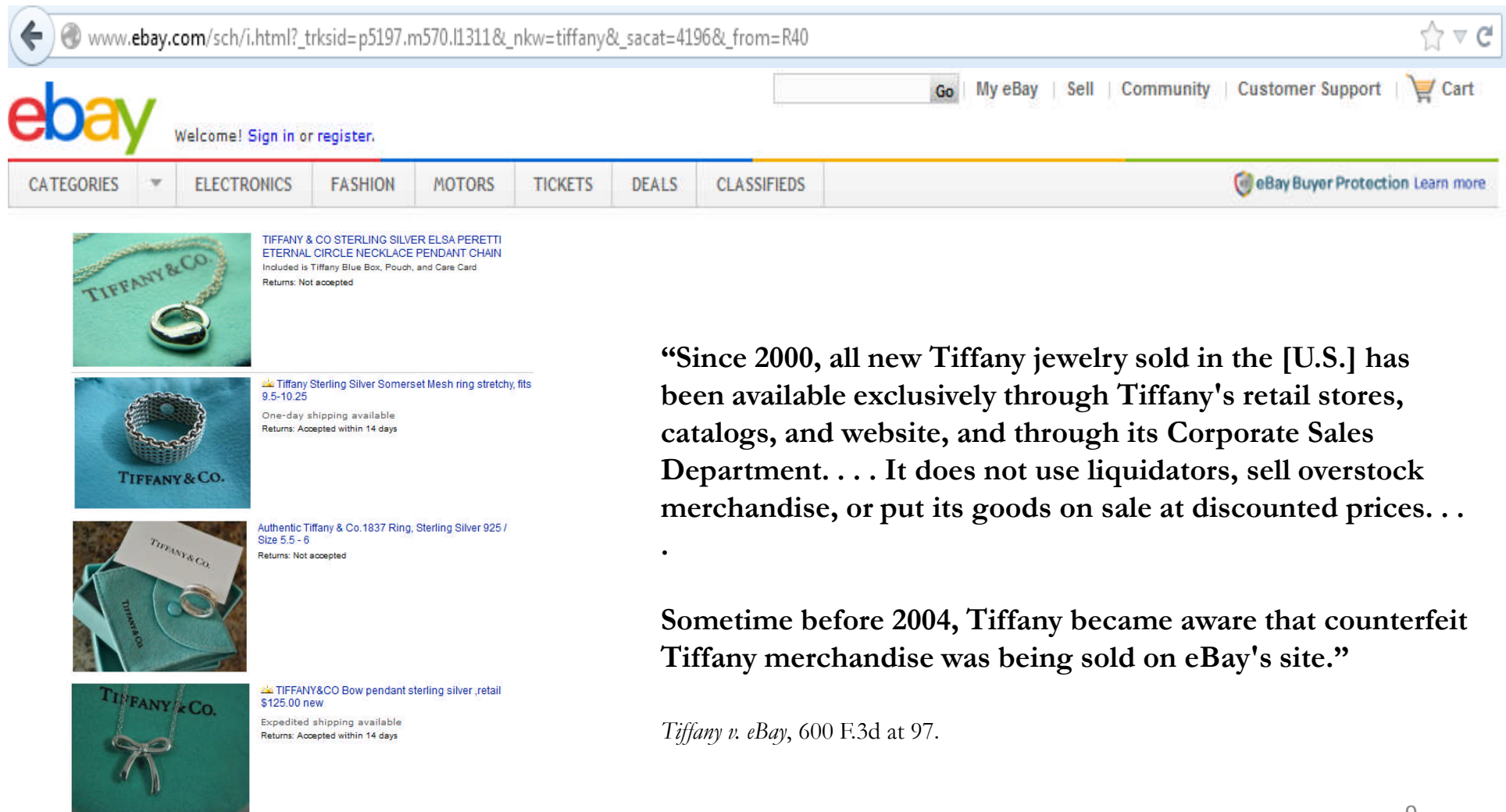
“Ms. Welles. . . has not attempted to trick consumers into believing that they are viewing a Playboy-endorsed website. . . . [S]he does not use the *classic Playboy bunny logo*, she inserted *disclaimers* which clearly state that the website is not endorsed by PEI, and *the font of the Playmate of the Year 1981* title is not...[the] Playboy magazine font.”



- ✓ **Website Title & Link Pages:** “[Welles] use of the term Playmate of the Year 1981 ‘is descriptive of and used fairly and in good faith. . . .’ to describe her own accomplishments.
- ✓ **Website Substance:** “The use of the abbreviation PMOY '81 is also permissible.”
- ✓ **Meta-Tags:** “...[N]o trademark infringement where defendant has used plaintiff’s trademarks in good faith to index the content of her website. The meta tags are not visible to the websurfer....”

Nominative Fair Use on the Internet:

Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010) *cert. denied*, 131 S. Ct. 647 (U.S. 2010)



www.ebay.com/sch/i.html?_trksid=p5197.m570.l1311&_nkw=tiffany&_sacat=4196&_from=R40

ebay Welcome! Sign in or register.

Go My eBay Sell Community Customer Support Cart

CATEGORIES ELECTRONICS FASHION MOTORS TICKETS DEALS CLASSIFIEDS eBay Buyer Protection Learn more

TIFFANY & CO STERLING SILVER ELSA PERETTI ETERNAL CIRCLE NECKLACE PENDANT CHAIN
Included is Tiffany Blue Box, Pouch, and Care Card
Returns: Not accepted

👑 Tiffany Sterling Silver Somerset Mesh ring stretchy, fits 9.5-10.25
One-day shipping available
Returns: Accepted within 14 days

Authentic Tiffany & Co. 1837 Ring, Sterling Silver 925 / Size 5.5 - 6
Returns: Not accepted

👑 TIFFANY&CO Bow pendant sterling silver ,retail \$125.00 new
Expedited shipping available
Returns: Accepted within 14 days

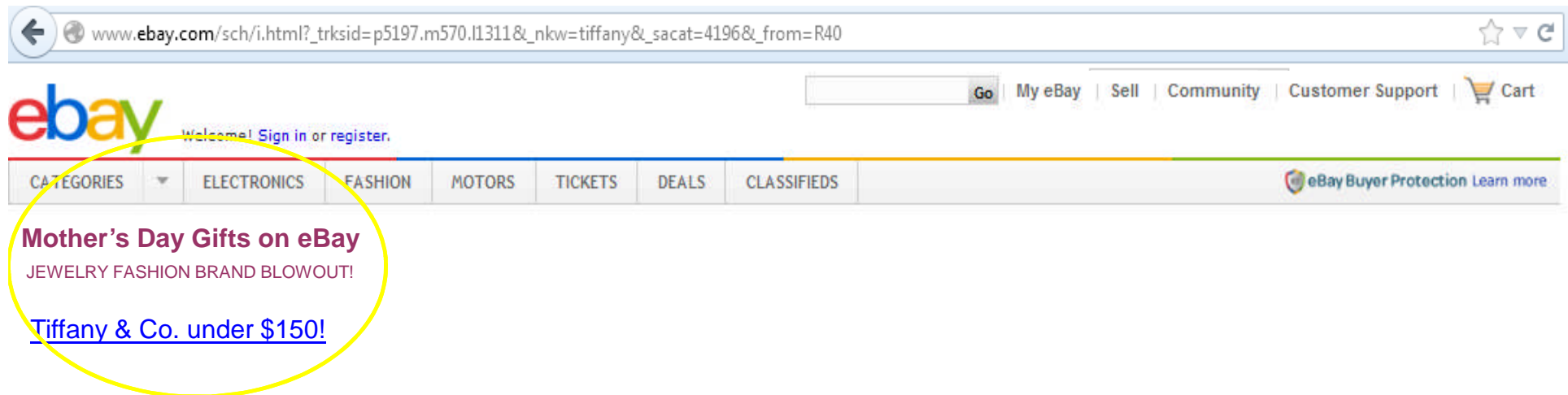
“Since 2000, all new Tiffany jewelry sold in the [U.S.] has been available exclusively through Tiffany's retail stores, catalogs, and website, and through its Corporate Sales Department. . . . It does not use liquidators, sell overstock merchandise, or put its goods on sale at discounted prices. . . .”

Sometime before 2004, Tiffany became aware that counterfeit Tiffany merchandise was being sold on eBay's site.”

Tiffany v. eBay, 600 F.3d at 97.

Nominative Fair Use on the Internet:

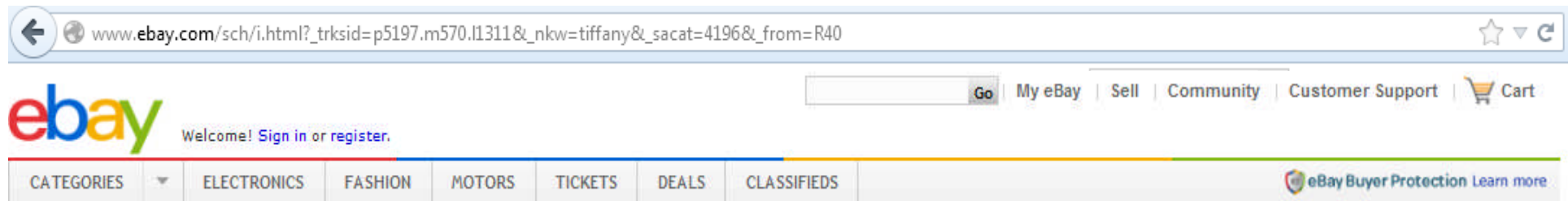
Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010) *cert. denied*, 131 S. Ct. 647 (U.S. 2010)



Separate and apart from the issue of vicarious trademark infringement, should eBay be allowed to “actively...promote sales” of Tiffany merchandise through advertisements and hyperlinks when it knows its website offers counterfeit Tiffany items?
Is this use fair and in good faith?

Nominative Fair Use on the Internet

Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010) *cert. denied*, 131 S. Ct. 647 (U.S. 2010)



According to the Second Circuit Court of Appeals, YES!

eBay Holding: No Vicarious Liability Infringement

“To impose liability because eBay cannot guarantee the genuineness of all of the purported Tiffany products offered on its website would unduly inhibit the lawful resale of genuine Tiffany goods.”

- ✓ **Nominative Fair Use:** Use of the TIFFANY mark described accurately the genuine TIFFANY goods offered for sale on the website;
- ✓ **Advertisements:** None of eBay's uses of the mark suggested that plaintiff Tiffany affiliated itself with eBay or endorsed the sale of Tiffany's products through the eBay website;
- ✓ **Knowledge of Counterfeit Goods:** eBay was not a direct infringer just because it knew that some of the TIFFANY goods listed on the eBay Web site were counterfeit, so long as it did not know in advance which specific goods were counterfeit.

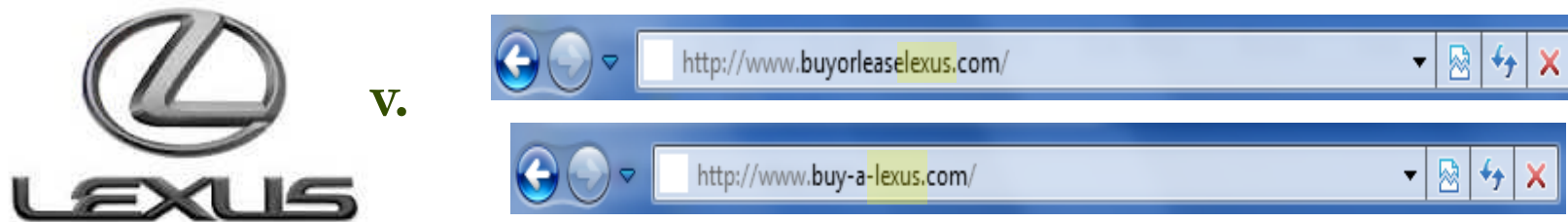
Nominative Fair Use: Limitations

- **NO STATUTORY PROVISION:** The Lanham Act *does not contain* any statutory nominative fair use provision. The doctrine is all case-made.
- **INCONSISTENT CASE LAW:** Federal appellate courts have developed widely diverging procedural rules around the application of the nominative fair use defense:



Nominative Fair Use:

Domain Names & Other Modern Developments



In *Toyota Motor Sales, Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010), LEXUS challenged defendant's use of domain names which contained the word "lexus", and led to an independent auto broker website which specialized in selling Lexus cars.

Nominative fair use or trademark infringement?

Nominative Fair Use: Domain Names

Toyota Motor Sales, Inc. v. Tabari, 610 F.3d 1171 (9th Cir. 2010)

- ✓ **Non-Misleading Use in Domain Names**: “A trademark injunction, particularly one involving nominative fair use, can . . . interfere with truthful communication between buyers and sellers in the marketplace. . . .” *Toyota Motor Sales*, 610 F.3d at 1176.

“Trademarks are part of our common language, and we all have some right to use them to communicate in truthful, non-misleading ways.” *Id.* at 1185.

TM

TM

TM

TM

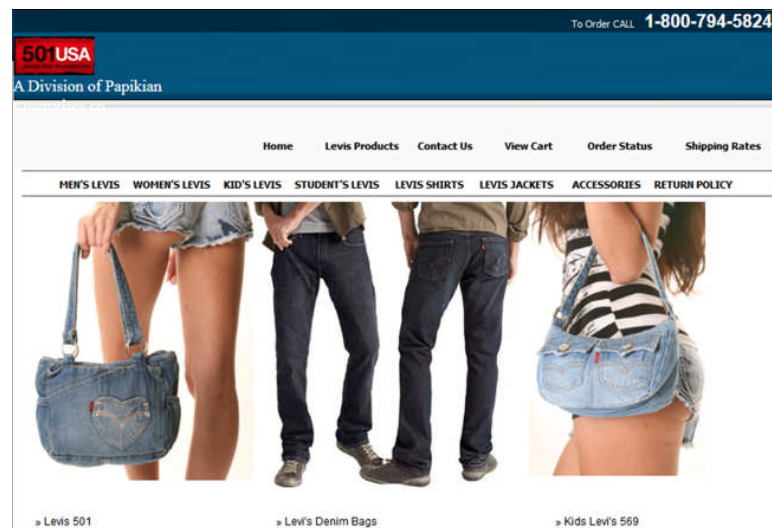
But how far is too far?

Nominative Fair Use: Recent Developments

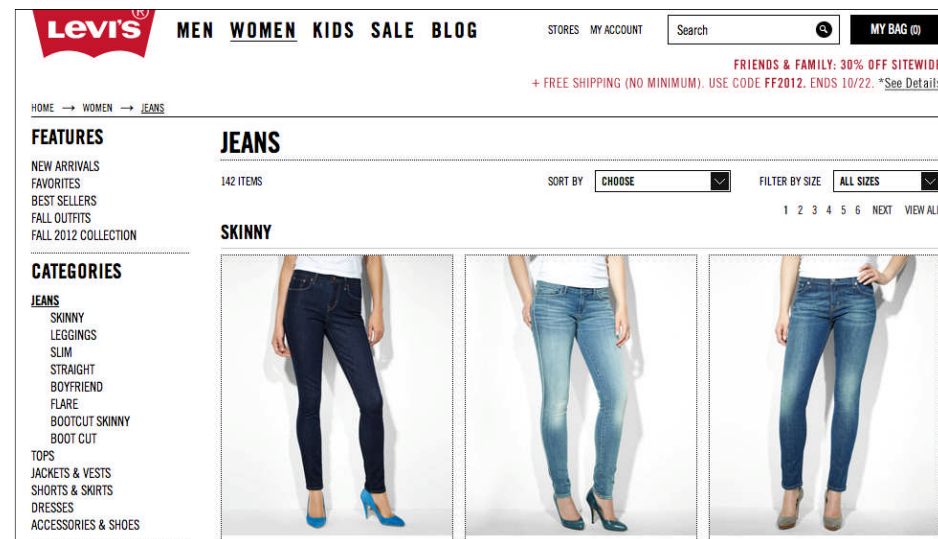
Domain Names & the Internet

Levi Strauss & Co. v. Papikian Enterprises, Inc., 2011 WL 5192237 (N.D. Cal. 2011)

www.501usa.com



www.levi.com



Are you confused?

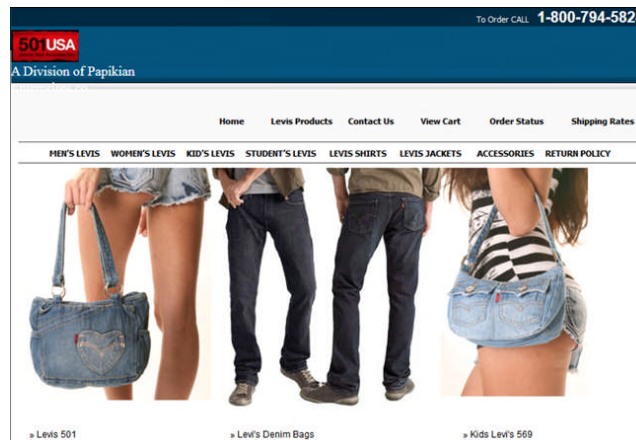
Is this simply communicating that Levi's jeans are being sold?

Or does this look like an authorized Levi's site?

Nominative Fair Use: Recent Developments

Domain Names & the Internet

At www.501usa.com, consumers can buy discounted Levi's jeans sold by *unauthorized* retailer Papikian.



Even in light of the use of the LEVI'S mark ("501") in Papikian's **domain name and on the retailer's website**, the Northern District of California found, on Levi's motion to strike Papikian's nominative fair use defense, that Papikian's use of Levi's "501" mark may be permissible under the nominative fair use doctrine, and declined to strike the defense.

Levi Strauss & Co. v. Papikian Enterprises, Inc., 10 Civ. 05051, 2011 WL 5192237 (N.D. Cal. Nov. 1, 2011)

Nominative Fair Use: Recent Developments

Note on Disclaimers

www.501usa.com
AS OF TODAY

The screenshot shows the 501USA website. At the top left, the logo "501USA" is displayed. Below it, a disclaimer reads "Not sponsored or authorized by Levi Strauss & Co." which is circled in yellow. To the right of the logo, the text "To Order CALL 1-800-794-5824" is visible. Below the disclaimer, the text "Levi's On Sale Every Day!" is written in red. Further down, promotional text states "Levi's 512 Liquidation Sale \$14.95" and "Levi's 569 Jeans on Sale \$26.95 to \$34.95 Limited Sizes Available." Below this, there are logos for VISA, MasterCard, DISCOVER, and American Express. A navigation menu includes links for Home, Levi's Products, Contact Us, View Cart, Order Status, and Shipping. A secondary menu lists categories: LEVIS ON SALE, MEN'S LEVIS, WOMEN'S LEVIS, KID'S LEVIS, STUDENT'S LEVIS, LEVIS SHIRTS, LEVIS JACKETS, ACCESSORIES, and RETURN POLICY. The main content area features images of a woman's legs in denim shorts holding a denim bag, and two men wearing denim jeans. To the right, there is a graphic of a road sign for "501" and "701" with a world map below it. Text at the bottom of the graphic reads: "We Ship all Continental US And most parts of the world. As of Jan 1, 2013 We will not ship Levi's products to..."

Is it enough to just stick on a disclaimer?

Is that what the nominative fair use defense has come down to?

Nominative Fair Use: Recent Developments

Advertising by Unauthorized Retailers on the Internet


The screenshot shows the Beyond the Rack website interface. At the top, the logo 'Beyond the Rack' is displayed with navigation links for 'Welcome Arnold', 'Account', 'Help', and 'Sign out'. Below the logo are category tabs: 'ALL EVENTS', 'WOMEN', 'MEN', 'KIDS / BABIES', 'MY CURVY CLOSET', and 'IBTR home'. A shopping cart icon with a '0' and a 'B' logo is visible. A promotional banner on the right says 'INVITE FRIENDS GET \$10 Click here' with an image of a man and a woman. The main content area features a large banner for 'PRE-OWNED LOUIS VUITTON' with the tagline 'The ultimate in luxury'. Below this banner are four product tiles:

- Tile 1 (Left):** '1000 TC WRINKLE-FREE SHEET SETS' for 'only \$59⁹⁹' (with a '\$300 value' crossed out). A yellow 'LIMITED QUANTITY' banner is overlaid on the image of red sheets.
- Tile 2 (Right):** 'OLYMPIA LUGGAGE' featuring a '3-piece ABS spinner set' for 'as low as \$99⁹⁹' (with a '\$160 value' crossed out). A blue 'FLAT-FEE SHIPPING' banner is overlaid on the image of three suitcases.
- Tile 3 (Bottom Left):** Shows a bed with white and black patterned bedding.
- Tile 4 (Bottom Right):** Shows two glasses, one with red liquid and the other with 'Noel' written on it.

Is Beyond the Rack's ad for "Pre-Owned Louis Vuitton" misleading?
 Does this look like an authorized reseller?
 What if it said "New Louis Vuitton"?

Nominative Fair Use: Recent Developments

Advertising by Unauthorized Retailers on the Internet



The image shows a screenshot of the Beyond the Rack website. The header includes the logo "Beyond the Rack" with navigation links: "Welcome Arnold", "Account", "Help", and "Sign out". Below this is the customer service number "1-877-733-4660". A menu bar contains categories: "ALL EVENTS", "WOMEN", "MEN", "KIDS / BABIES", "MYCURVY & CLOSET", and "home". On the right, there is a blue shopping bag icon with a "0" and a pink button that says "INVITE FRIENDS GET \$10 Click here" next to a photo of a man and a woman. Below the header is a banner for "PRE-OWNED LOUIS VUITTON" with the tagline "The ultimate in luxury" and an image of a Louis Vuitton bag.

About Us:

All other trade-marks not owned by Beyondtherack.com that appear on this website are the property of their respective owners, who may or may not be affiliated with, connected to, or sponsored by Beyondtherack.com.

Is this enough? Who even sees this?

Nominative Fair Use: Domain Names & Competitor Gripe Sites

Aviva USA Corp. v. Vazirani, 11 Civ. 0369 (D. Ariz. 2012)

www.avivausa.com



www.avivauncovered.com



Nominative Fair Use?
Initial Interest Confusion?
Should trademark law be used to
silence criticism by competitors?

Nominative Fair Use: Domain Names & Competitors' Gripe Sites

Aviva USA Corp. v. Vazirani, 11 Civ. 0369 (D. Ariz. 2012)



**According to the District of Arizona,
NO!**

Anil Vazirani, an independent insurance broker, was once authorized to sell Aviva Insurance. After being terminated, he created the gripe site, “avivauncovered.com”.

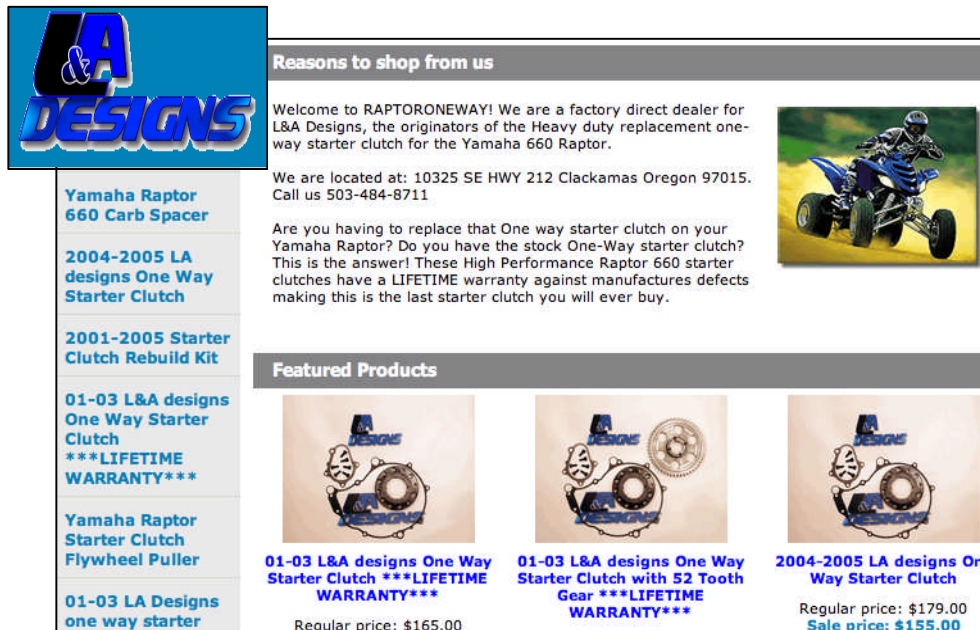
Even though Vazirani’s site promoted his own insurance brokerage, and thus might be seen as competitive or comparative advertising, the court treated the site as entirely noncommercial; that is, one “directed solely at criticizing” Aviva.

Thus, the use of Aviva’s mark was protected as nominative fair use, i.e., was not seen as authorized.

Nominative Fair Use: Metatags & the Internet

L&A Designs v. Xtreme ATVs, Inc., 03:10 Civ. 627 (D. Or. Apr. 30, 2012)

L&A Designs sued XTREME for infringement based on XTREME’s reference to “the designers of the L&A Designs starter clutch” on its website.



LA DESIGNS

Reasons to shop from us

Welcome to RAPTORONEWAY! We are a factory direct dealer for L&A Designs, the originators of the Heavy duty replacement one-way starter clutch for the Yamaha 660 Raptor.

We are located at: 10325 SE HWY 212 Clackamas Oregon 97015. Call us 503-484-8711

Are you having to replace that One way starter clutch on your Yamaha Raptor? Do you have the stock One-Way starter clutch? This is the answer! These High Performance Raptor 660 starter clutches have a LIFETIME warranty against manufactures defects making this is the last starter clutch you will ever buy.

Featured Products

- Yamaha Raptor 660 Carb Spacer
- 2004-2005 LA designs One Way Starter Clutch
- 2001-2005 Starter Clutch Rebuild Kit
- 01-03 L&A designs One Way Starter Clutch ***LIFETIME WARRANTY***
- Yamaha Raptor Starter Clutch Flywheel Puller
- 01-03 LA Designs one way starter

01-03 L&A designs One Way Starter Clutch *LIFETIME WARRANTY*****
Regular price: \$165.00

01-03 L&A designs One Way Starter Clutch with 52 Tooth Gear *LIFETIME WARRANTY*****

2004-2005 LA designs One Way Starter Clutch
Regular price: \$179.00
Sale price: \$155.00



“From the designers of the L & A Designs starter clutch, this is the same dependable product built to endure Xtreme riding conditions.”

Is this Nominative Fair Use? Infringement? What?

Nominative Fair Use: Recent Developments

Metatags & the Internet

L & A Designs v. Xtreme ATV (2012):



- X **Website Substance:** Court refused to dismiss the case based on Xtreme's nominative fair use defense because the phrase "From the designers of the L & A Designs starter clutch, this is the same dependable product..." may suggest sponsorship or endorsement by L & A Designs
- X **Meta-Tags:** "use of the mark as a metatag is substantially different from using the mark in a phrase" and does not implicate nominative fair use analysis, i.e., "whether the mark was used to refer to the trademarked good"

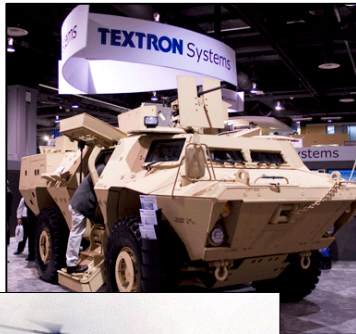
Nominative Fair Use: Recent Developments

Use in Video Games & Movies

Electronic Arts, Inc. v. Textron Inc., 12 Civ. 00118 (N.D. Cal. July 25, 2012)

THE PLAYERS

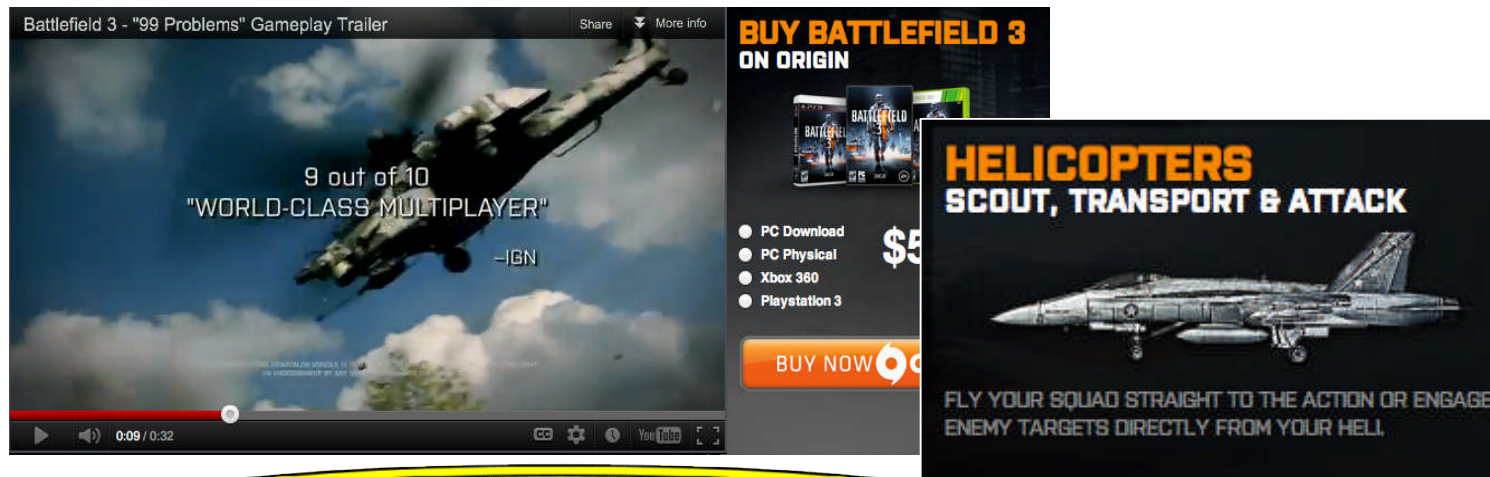
- **Textron, Inc.** was ranked the 220th largest company on the Fortune 500 list in 2010. It owns companies like Bell Helicopters and Cessna Aircrafts.
- **Electronic Arts (EA)** is the #1 publisher of games in the United States & Europe.
- **Battlestar 3:** a realistic, multi-platform, first person shooter video game released in Oct. 2011 by EA.
 - Features images of real-life modern weaponry & equipment such as Textron's Bell Helicopters.
 - 3M pre-orders; 5M sold in week 1; 8M sold in month 1.
- **U.S. Military:** the military has published countless images and data about its machinery—including the Bell Helicopters at issue—placing them squarely in the public domain.



Nominative Fair Use: Video Games & Movies

Electronic Arts, Inc. v. Textron Inc. (N.D. Cal. 2012)

Advertisements from EA's Website



Battlefield 3 - "99 Problems" Gameplay Trailer

Share More info

9 out of 10
"WORLD-CLASS MULTIPLAYER"

-IGN

BUY BATTLEFIELD 3
ON ORIGIN

PC Download
PC Physical
Xbox 360
Playstation 3

BUY NOW

HELICOPTERS
SCOUT, TRANSPORT & ATTACK

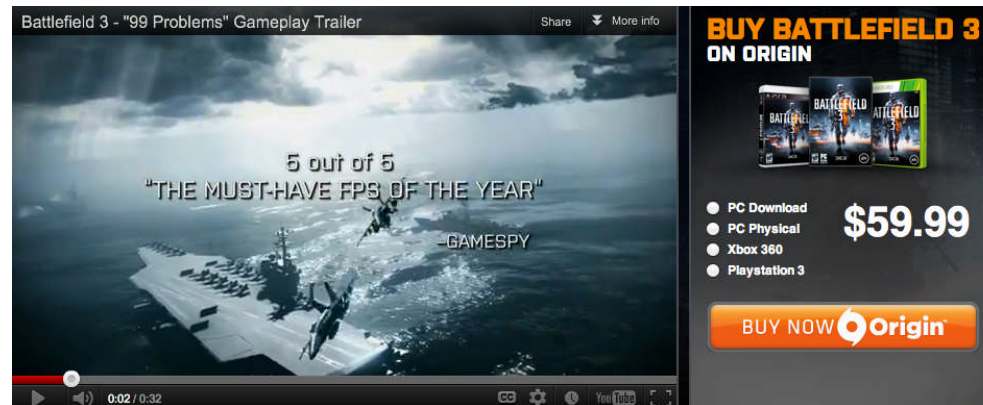
FLY YOUR SQUAD STRAIGHT TO THE ACTION OR ENGAGE
ENEMY TARGETS DIRECTLY FROM YOUR HELI.

IN BATTLEFIELD 3, PLAYERS STEP INTO THE ROLE OF THE ELITE U.S. MARINES. AS THE FIRST BOOTS ON THE GROUND, PLAYERS WILL EXPERIENCE HEART-POUNGING MISSIONS ACROSS DIVERSE LOCATIONS INCLUDING PARIS, TEHRAN AND NEW YORK. AS A U.S. MARINE IN THE FIELD, PERIODS OF TENSION AND ANTICIPATION ARE PUNCTUATED BY MOMENTS OF COMPLETE CHAOS. AS BULLETS WHIZ BY, AS WALLS CRUMBLE, AS EXPLOSIONS FORCE PLAYERS TO THE GROUND, THE BATTLEFIELD FEELS MORE ALIVE AND INTERACTIVE THAN EVER BEFORE.

According to Textron, the appearance of the Bell Helicopter is protectable trade dress, so advertisements constitute trade dress infringement, and “collectively support an inference that *Battlestar 3* and its advertising are misleading as to source or content”.

Nominative Fair Use: Video Games & Movies

Electronic Arts, Inc. v. Textron Inc. (N.D. Cal. 2012)



- **The Question:** Is there even a claim here for protectable trade dress? If so, is the use of images taken from the public domain fair or unfair? Is fair use even implicated here?

This question remains to be answered. . .

- **What We Do Know:** EA can proceed with a nominative fair use defense, but if this is protectable trade dress, it is unclear whether EA can satisfy the *New Kids on the Block* elements:
 - On the one hand, are the helicopters **readily identifiable** as Bell Helicopters?
 - On the other hand, did EA use **more of the mark than necessary** to identify the helicopters? Put another way, does anyone think EA's use was authorized or sponsored by Bell?
 - Does this claim even make sense? Will anyone think this was authorized by Textron?**

Nominative Fair Use: Recent Developments

Use in Video Games & Movies

Louis Vuitton v. Warner Bros., 11 Civ. 9436 (S.D.N.Y. June 15, 2012)



In *The Hangover: Part II*, the character played by Zach Galifianakis carries a bag marked LVM, and when it gets bumped, he admonishes: "Be careful, that is a Lewis Vuitton."

Last year, LVMH sued Warner Brothers, alleging that this 25-second scene harmed its brand by infringing its marks and creating consumer confusion. LVMH asserted that the bag featured in the film was actually made by the Chinese-American company Diophy, and demanded millions of dollars in damages.

**Is this infringement?
Nominative Fair Use?
Anything?**

Nominative Fair Use: Recent Developments

Use in Video Games & Movies

Louis Vuitton v. Warner Bros. (S.D.N.Y. June 15, 2012)



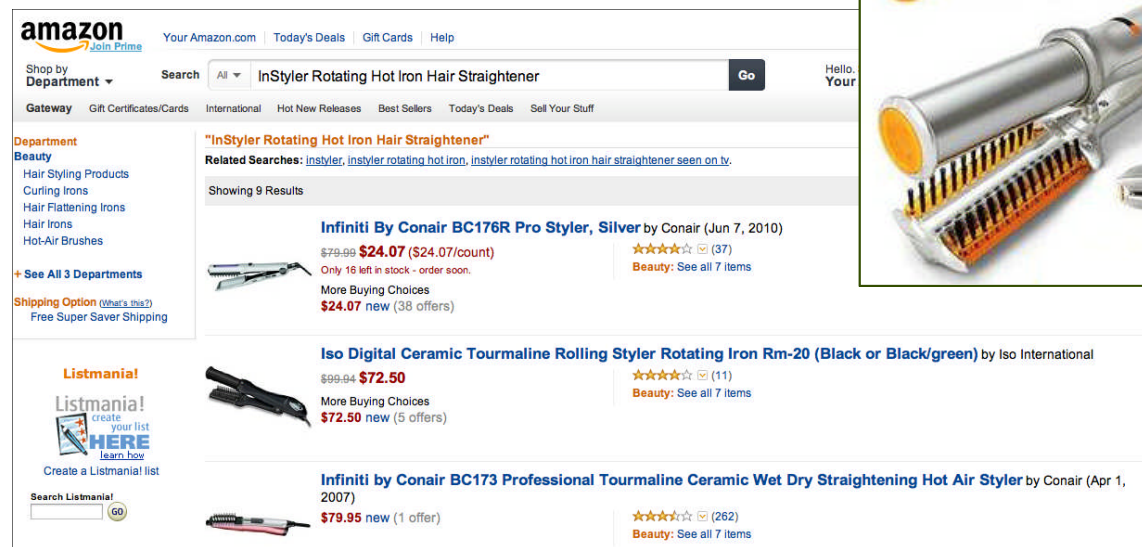
According to the SDNY, it's nothing!

"The court concludes that Louis Vuitton's allegations of confusion are not plausible, let alone 'particularly compelling...'. "

Nominative Fair Use: Recent Developments

Third-Party Advertising & Sales on the Internet

Tre Milano, LLC v. Amazon.Com, Inc., B234753 (Cal. Ct. App. Aug. 22, 2012),
review filed (Oct. 2, 2012) (unpublished)



The screenshot displays an Amazon search results page for "InStyler Rotating Hot Iron Hair Straightener". The search bar shows the query "InStyler Rotating Hot Iron Hair Straightener". The results list three products:

- Infiniti By Conair BC176R Pro Styler, Silver** by Conair (Jun 7, 2010): \$79.99 **\$24.07** (\$24.07/count). Only 16 left in stock - order soon. More Buying Choices: **\$24.07 new** (38 offers). Rating: 3.5 stars (37 reviews). Beauty: See all 7 items.
- Iso Digital Ceramic Tourmaline Rolling Styler Rotating Iron Rm-20 (Black or Black/green)** by Iso International: \$99.94 **\$72.50**. More Buying Choices: **\$72.50 new** (5 offers). Rating: 3.5 stars (11 reviews). Beauty: See all 7 items.
- Infiniti by Conair BC173 Professional Tourmaline Ceramic Wet Dry Straightening Hot Air Styler** by Conair (Apr 1, 2007): **\$79.95 new** (1 offer). Rating: 3.5 stars (262 reviews). Beauty: See all 7 items.

To the right of the search results is a separate image of the InStyler product, a silver rotating hot iron hair straightener with a black handle and a silver barrel.

Should Amazon be vicariously liable for infringement because its website uses the INSTYLER mark in promoting the sale of counterfeit goods?
 Does anyone think such use is approved by Tre Milano?

Nominative Fair Use: Recent Developments

Tre Milano, LLC v. Amazon.Com, Inc.

NO! According to the California Court of Appeals NO!



Amazon is a merely a *transactional intermediary*, not the *actual seller* of counterfeit goods; therefore, it is not liable for third-party sales of counterfeit goods on its website.

The court states: “[Tre Milano’s] argument ignores the holding of *Tiffany II*, that a service provider’s use of a registered mark to describe a product is protected by the nominative fair use doctrine. The doctrine would apply here, since there is no evidence of a ‘likelihood of confusion about the source of [the] defendant’s product or the mark-holder’s sponsorship or affiliation.’” *Id.* at *12.

In other words, no one would think these sales are sponsored by the trademark owner.

Nominative Fair Use: Recent Developments

Third-Party Advertising on the Internet

Even if this is nominative fair use, does this excuse the host website from vicarious liability for infringement?

In *Amazon.com*, the Court applied the same legal standards applied by the Second Circuit in *Tiffany v. eBay*, even though:

1. Amazon may have done less to police counterfeits than eBay;
2. Amazon was the payment service provider for its merchants; and
3. Amazon did not always remove items in response to takedown notices.

After *eBay & Amazon*, should the service provider be responsible for trademark infringement/counterfeiting on retail websites?

What should the test be?

Going Forward. . .

**Should the Lanham Act's statutory exception
for nominative fair use in the context of
dilution be extended to infringement?**

Why wasn't this done when the dilution statute was amended?



Nominative Fair Use Exception for Dilution: § 15 U.S.C. 1125(c)(3)(A)-(c)(3)(C):

“The following shall *not be actionable* under this subsection:

- (A) Any fair use, *including nominative or descriptive. . .*, including use in connection with:
 - (i) *Advertising or promotion that permits consumers to compare goods or services; or*
 - (ii) Identifying or parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.
- (B) All forms of news reporting and news commentary.
- (C) Any noncommercial use of a mark.”

Lessons Learned:

- Don't be piggish. Use only so much of the mark as needed.
- Do not use the mark “as a mark”. Use in narrative form if at all possible.
- Disclaimer, disclaimer, disclaimer.
- Show it to counsel before publication. At least you can claim the infringement wasn't willful!

Anything Else?

Fair Use: Personal Names

Lanham Act § 1115

Under the Lanham Act, the statutory Fair Use Doctrine also protects certain uses of registered trademarks from infringement claims when *the use of the name, term, or device charged to be an infringement is “a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party.”*

15 U.S.C. § 1115(b)(4) (2006) (emphasis added).

So, can you use your own personal name in business to identify and promote yourself, even if someone else owns your name as a trademark? If so, where do you cross the line into trademark infringement?

Fair Use: Personal Names

J.A. Apparel v. Abboud, 568 F.3d 390 (2d Cir. 2009), *on remand*, 682 F. Supp. 2d 294 (S.D.N.Y. 2010)



Joe sold his brand name JOSEPH ABBOUD for the tidy sum of \$65.5 million. Should he still be allowed to use his own name to refer to himself as the designer? JA Apparel says **“NO!”** — he should be the **“designer formerly known as ...”**

Fair Use: Personal Names

J.A. Apparel v. Abboud, 568 F.3d 390 (2d Cir. 2009), *on remand*, 682 F. Supp. 2d 294 (S.D.N.Y. 2010)

Court-Disapproved Advertisement:



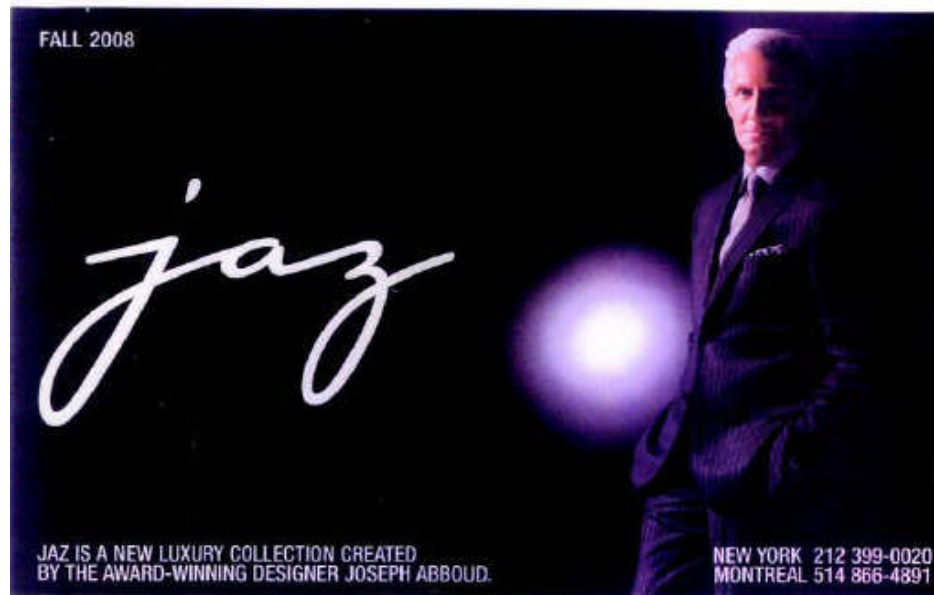
Why? Because the name was in larger type?

Agree or Disagree?

Fair Use: Personal Names

J.A. Apparel v. Abboud, 568 F.3d 390 (2d Cir. 2009), *on remand*, 682 F. Supp. 2d 294 (S.D.N.Y. 2010)

Court-Approved Advertisement:



Court holds this is fair use of the Joseph Abboud personal name, provided the ad includes a disclaimer of affiliation with JA Apparel and the JOSEPH ABBOUD brand. Disclaimer is to be no smaller than the text of Abboud name.

Fair Use: Personal Names

J.A. Apparel v. Abboud, 568 F.3d 390 (2d Cir. 2009), *on remand*, 682 F. Supp. 2d 294 (S.D.N.Y. 2010)

Court-Approved Advertisement (Version 2):

DESIGNER JOSEPH ABBoud
IN A 2 BUTTON SUPER 120'S
CHARCOAL CHALKSTRIPE
FROM HIS FALL 2008 JAZ COLLECTION

DESIGNER JOSEPH ABBoud IS NO LONGER
ASSOCIATED OR AFFILIATED WITH
JA APPAREL CORP, THE OWNER OF THE
TRADEMARK "JOSEPH ABBoud."™

DESIGNER JOSEPH ABBoud
IN A 2 BUTTON SUPER 120'S
CHARCOAL CHALKSTRIPE
FROM HIS FALL 2008 JAZ COLLECTION

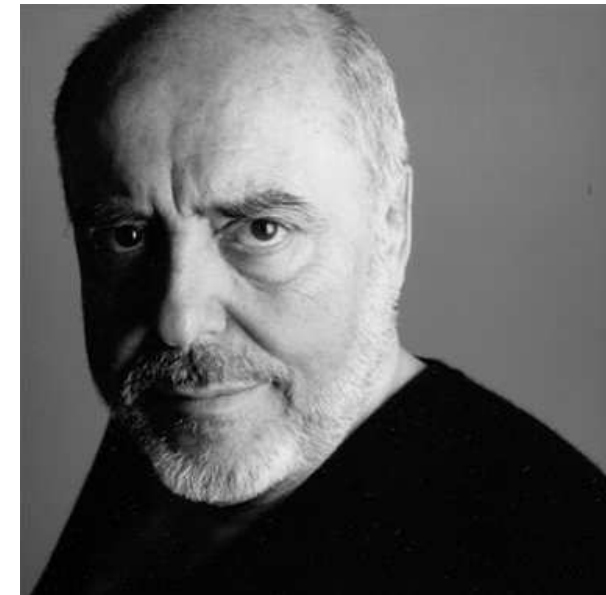
DESIGNER JOSEPH ABBoud IS NO LONGER
ASSOCIATED OR AFFILIATED WITH
JA APPAREL CORP, THE OWNER OF THE
TRADEMARK "JOSEPH ABBoud."™

TAILORING BY JACK WINTER NEW YORK 212.359.0028 BOSTON 617.485.4401 INFO@JAPPCORP.COM

It didn't matter — the line was a complete flop!!!

Fair Use: Personal Names

Edwin Co. Ltd. v. H&M Hennes & Mauritz LP, No. 05 civ. 4435 (JSR) (S.D.N.Y. May 16, 2005) (unpublished)



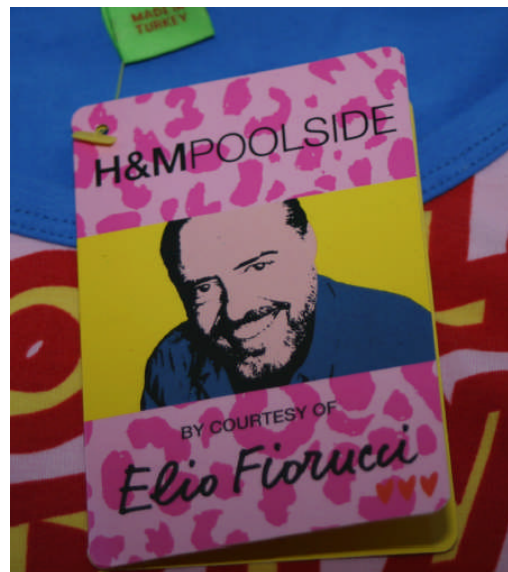
Elio Fiorucci

Fiorucci brand acquired by Edwin Jeans from designer Elio Fiorucci in 1990 for \$25 million.
H&M sued by Edwin over a swimwear line designed by Elio Fiorucci in summer of 2005.

Fair Use: Personal Names

Edwin Co. Ltd. v. H&M Hennes & Mauritz LP, No. 05 civ. 4435 (JSR) (S.D.N.Y. May 16, 2005) (unpublished)

Proposed H&M Use:

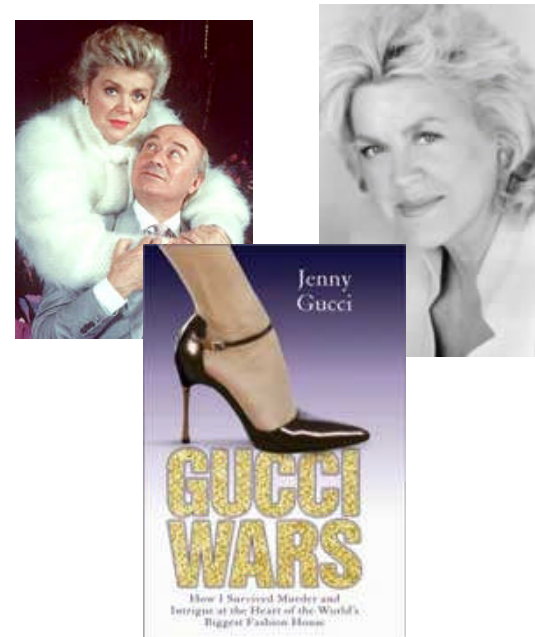


Settled Before Decision: H&M agrees to pull line from U.S.

W h a t d o y o u t h i n k ?

Fair Use: Personal Names

Gucci America, Inc. v. Jennifer Gucci, No. 07 Civ. 6820 (RMB) (JCF)



Should Jennifer Gucci, (former) Gucci family member, be able to use her family name in business? If so, how?

Fair Use: Personal Names

Gucci America, Inc. v. Jennifer Gucci, No. 07 Civ. 6820 (RMB) (JCF)



Answer: A resounding “NO!”

Jennifer argues she’s the designer, so she can use her name. Court doesn’t buy it. No experience as a designer. Broad injunction against Jennifer’s use of her name.

Court also awards \$2 million in attorneys fees!!!

Fair Use: Personal Names

Gucci America, Inc. v. Jennifer Gucci, No. 07 Civ. 6820 (RMB) (JCF)

Proposed packaging designs:



What do you think? Is there anything she could have done?