

No. 16-352

IN THE
Supreme Court of the United States

SECURITY UNIVERSITY, LLC, *et al.*,
Petitioners,

v.

INTERNATIONAL INFORMATION SYSTEMS SECURITY
CERTIFICATION CONSORTIUM, INC.,
Respondent.

**On Petition for a Writ of Certiorari to the United
States Court of Appeals for the Second Circuit**

**BRIEF OF THE INTERNATIONAL
TRADEMARK ASSOCIATION AS *AMICUS
CURIAE* IN SUPPORT OF PETITIONERS**

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INTERESTS OF *AMICUS CURIAE*¹

Founded in 1878, *amicus curiae* The International Trademark Association (“INTA”) is a not-for-profit global organization dedicated to the support and advancement of trademarks and related intellectual property. INTA has more than 6,700 member organizations from more than 190 countries. Its members include trademark and other brand owners, as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. All INTA members share the goal of promoting an understanding of the essential role that trademarks play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA was founded in part to encourage the enactment of federal trademark legislation following invalidation on constitutional grounds of the United States’ first trademark act. Since then,

¹ Pursuant to Supreme Court Rule 37.6, this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel for a party. No party or counsel for a party, nor any other person or entity other than *amicus curiae*, its members, and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.2, counsel for all parties were provided appropriate notice of the filing of this *amicus curiae* brief, and letters from the parties consenting to the filing of this brief are being submitted herewith.

INTA has been instrumental in making recommendations and providing assistance to legislators in connection with major trademark and related legislation, and has participated as *amicus curiae* in numerous cases in this Court and other courts across the country involving significant Lanham Act issues.² Moreover, INTA's members frequently participate in judicial proceedings and in administrative proceedings before the United States Patent and Trademark Office and the Trademark Trial and Appeal Board in actions brought under the Lanham Act. INTA and its members therefore are acutely interested in the development of clear, consistent, and equitable principles of trademark law.

² Recent Supreme Court cases in which INTA has filed amicus briefs include, without limitation: *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015) (decided Mar. 24, 2015); *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015) (decided Jan. 21, 2015); *POM Wonderful LLC v. Coca-Cola Co.*, 134 S. Ct. 2228 (2014) (decided June 12, 2014); *Lexmark International, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014) (decided Mar. 25, 2014); *Already, LLC v. Nike, Inc.*, 133 S. Ct. 721 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000); *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627 (1999); and *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

INTA and its members have a particular interest in this case. The circuit court's decision widens an existing split of authority among the Courts of Appeals on the issue of nominative fair use of trademarks. This split has caused tremendous confusion among courts and litigants with respect to: (1) whether the doctrine of nominative fair use is recognized at all; (2) what the applicable test for nominative fair use is; and (3) whether nominative fair use should be treated as a separately analyzed affirmative defense (over which the defendant bears the burden of proof), or as part of plaintiff's demonstration of a likelihood of consumer confusion (over which plaintiff bears the burden of proof). This circuit split has led to, and will continue to cause, forum shopping, inconsistent outcomes, and a lack of clarity or certainty among trademark owners and consumers alike.

I. INTRODUCTION: THE ROLE OF TRADEMARK LAW AND THE FAIR USE DOCTRINE.

As courts and commentators have recognized, trademark law serves two principal purposes: (1) to protect consumers from deception and confusion as to the source or sponsorship of goods and services in the marketplace; and (2) to protect the efforts of brand owners and the goodwill they have established in their trademarks. *See, e.g.*, 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2:2 & n.1 (4th ed. 2016) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855 (1982)). The Lanham Act prohibits the use in commerce of a trademark if the use is

likely to confuse or deceive consumers as to the source, sponsorship, or affiliation of goods or services offered under the trademark. See 15 U.S.C. §§ 1114(1), 1125(a)(1).

Nevertheless, in certain instances, the use of a trademark without a trademark owner's permission is permissible. Two of the most commonly recognized types of legal, non-infringing uses are "descriptive fair use" (also referred to as "classic fair use") and "nominative fair use." See 4 McCarthy, *supra*, § 23:11.

A. The Descriptive Fair Use Doctrine

"Descriptive fair use" refers to a defendant's good faith use of a term, which also happens to be a trademark, not as a source identifier, but to describe an aspect of the *defendant's* goods or services. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004); see also 4 McCarthy, *supra*, § 23:11. For example, a company that provides real-time video monitoring of law enforcement might describe its services as letting users "watch the police live, in action." Although the term THE POLICE is, of course, a registered trademark of the rock band "The Police,"³ its use by the video monitoring company likely would not run afoul of established trademark law because the term was not used to describe or refer to the musical group. Rather, the term was used to describe accurately the live video feed

³ THE POLICE, U.S. Registration No. 3715671.

services offered by the monitoring company. In such a circumstance, use of the term “the police” would be merely descriptive of an aspect of defendant’s own service, and therefore likely to implicate the descriptive fair use doctrine.

The Lanham Act expressly recognizes descriptive fair use as a defense to a trademark infringement claim where “the use . . . charged to be an infringement is a use, otherwise than as a mark, of . . . a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of [a] party, or their geographic origin.” 15 U.S.C. § 1115(b)(4).

Before 2004, there had been uncertainty as to the proper application of the descriptive fair use doctrine. For example, in the Ninth Circuit, a party asserting a defense of descriptive fair use had the burden to demonstrate an absence of a likelihood of consumer confusion. *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1072 (9th Cir. 2003), *vacated*, 543 U.S. 111 (2004). Similarly, in the Sixth Circuit, a finding of likelihood of consumer confusion foreclosed a descriptive fair use defense. *See PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 255-56 (6th Cir. 2003), *abrogated by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004). In contrast, in the Second and Fourth Circuits, even if a likelihood of confusion had been established by the plaintiff, the defense of descriptive fair use would still be available to the defendant. *See Cosmetically Sealed*

Indus., Inc. v. Chesebrough-Pond's USA Co., 125 F.3d 28, 30-31 (2d Cir. 1997); *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 110 F.3d 234, 243 (4th Cir. 1997).

This Court has previously resolved a circuit split regarding the proper application of the descriptive fair use doctrine. In *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), the Court confirmed that descriptive fair use is an affirmative defense to an infringement claim under the Lanham Act. *See id.* at 124. The Court further held that before consideration of the defense, plaintiff bears the burden of demonstrating a likelihood of consumer confusion over use of the trademark in question, and that once such confusion has been established, the defendant bears the burden of establishing descriptive fair use. *See id.*

B. The Nominative Fair Use Doctrine

The second type of fair use is “nominative fair use,” which is the type at issue here. Nominative fair use refers to a situation where the defendant, in connection with providing its goods and services, is using the plaintiff’s trademark to describe *plaintiff’s* goods or services. *See* 4 McCarthy, *supra*, § 23:11. This situation typically arises where the defendant’s goods or services are somehow related to goods or services sold under the plaintiff’s trademark, or in the context of comparative advertising.

For example, a repair shop that services Volkswagen, Toyota, and Lexus cars must be able to describe to consumers the types of cars that it repairs. In order to do so, the shop likely would need to refer to the trademarks of Volkswagen, Toyota, and Lexus in signage, marketing material, or advertising. Although some nominative use is necessary for this purpose, the repair shop cannot have free rein to use the manufacturers' trademarks in any way it sees fit because of the risk that consumers could be confused into thinking that the shop is authorized, sponsored, or licensed by the trademark owners. For example, if the repair shop advertised its services using the stylized marks or logos of the car manufacturers, consumers could be led to believe they were dealing with an authorized service of the manufacturer. *See Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1181 (9th Cir. 2010). Such use would not be fair. *Cf. id.* at 1181-82

In order to avoid consumer confusion while striking a balance between the needs of companies like the service shop on the one hand, and the underlying brand owners on the other, several Courts of Appeals have adopted the nominative fair use doctrine. As shown below, however, the doctrine has developed inconsistently across several circuits, with other circuits (and district courts within those circuits) refusing to adopt the nominative fair use doctrine at all.

Just as this Court's intervention was necessary to resolve the circuit split as to proper application

of the descriptive fair use doctrine, the present case demonstrates the need for Supreme Court guidance as to the proper application of the nominative fair use doctrine.

SUMMARY OF ARGUMENT

Before the Second Circuit's opinion below,⁴ a multi-circuit split existed regarding: (1) whether the doctrine of nominative fair use is recognized at all; (2) what the test for nominative fair use should be; and (3) whether nominative fair use should be treated as an affirmative defense or should be evaluated as part of the likelihood of confusion analysis as part of the plaintiff's case-in-chief.

The Second Circuit has now offered yet a further approach to nominative fair use that draws from the approaches of the Ninth and Third Circuits, but actually applies neither. Thus, the Second Circuit's decision brings an additional test to an already fractured circuit approach to the issue of nominative fair use. The Court should grant the petition for a writ of certiorari in order to decide the appropriate standard for nominative fair use and whether it should be an affirmative defense or incorporated into a likelihood-of-confusion analysis.

⁴ *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153 (2d Cir. 2016), *petition for cert. filed*, 2016 WL 5048645 (U.S. Sept. 15, 2016) (No. 16-352).

ARGUMENT

I. PRIOR TO THE SECOND CIRCUIT’S DECISION, A SPLIT OF AUTHORITY ALREADY EXISTED AMONG THE COURTS OF APPEALS REGARDING NOMINATIVE FAIR USE.

Although the Ninth and Third Circuit tests for nominative fair use are the most well-known, other circuit courts have opined on the doctrine as well. Predictably, these myriad opinions offer no uniformity or consensus regarding the proper application of the nominative fair use doctrine.

A. In the Ninth Circuit, the Test for Nominative Fair Use Replaces the Test for Likelihood of Consumer Confusion.

It is axiomatic that the plaintiff in a trademark infringement action has the burden of showing that the defendant’s use of the trademark confuses consumers under the “digits of confusion” test for likelihood of confusion. *See AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 & n.11 (9th Cir. 1979) (establishing the Ninth Circuit’s “digits of confusion” test, known as the “*Sleekcraft* factors”), *abrogated in part on other grounds by Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002). However, when a defendant in the Ninth Circuit claims to have referred to the trademarked good or service itself, the nominative fair use test replaces the test for likely consumer confusion. *See, e.g., Toyota Motor Sales*, 610 F.3d at 1182 (citing *Sleekcraft* likelihood-of-confusion test).

In such circumstances, the court considers whether (1) the defendant's product or service "was 'readily identifiable' without use of the mark"; (2) the "defendant used more of the mark than necessary"; or (3) the "defendant falsely suggested he was sponsored or endorsed by the trademark holder." *Toyota Motor Sales*, 610 F.3d at 1175-76. This test is often referred to as the "*New Kids* test," having been first adopted by the court in *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992). *See id.* at 308. Under the *New Kids* test, when nominative fair use is raised in response to an infringement allegation, it is the burden of the plaintiff to show that the defendant's use does not constitute nominative fair use. *See Toyota Motor Sales*, 610 F.3d at 1182. The Ninth Circuit does not treat nominative fair use as an affirmative defense to a claim of trademark infringement over which the defendant bears the burden. *See id.*

B. The Third Circuit Recognizes Nominative Fair Use as an Affirmative Defense, to Be Considered Only if the Plaintiff Has First Established a Likelihood of Confusion.

The Third Circuit, unlike the Ninth Circuit, considers the nominative fair use doctrine an affirmative defense over which the defendant bears the burden of proof. This burden is only triggered after the plaintiff meets its own burden of proving that a consumer is likely to be confused by "the defendant's use of plaintiff's mark." *Century 21*

Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 222 (3d Cir. 2005).

In a typical trademark infringement case, courts in the Third Circuit employ a ten-factor test in assessing likelihood of confusion. *See Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462-63 (3d Cir. 1983). Where nominative fair use is asserted, however, the Third Circuit has directed courts to focus on four of those ten factors:

- (1) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (2) the length of time the defendant has used the mark without evidence of actual confusion;
- (3) the intent of the defendant in adopting the mark; and
- (4) the evidence of actual confusion.

Century 21, 425 F.3d at 225-26 (listing four of the ten factors for determining likelihood of confusion announced in *Lapp*, 721 F.2d at 463). Thus, in the context of a nominative fair use defense, the Third Circuit deemphasizes other traditionally accepted likelihood-of-confusion factors such as strength of the owner's mark, similarity, marketing channels, and sales efforts. *Compare Century 21*, 425 F.3d at 225-26, *with Lapp*, 721 F.2d at 463.

Once a plaintiff in the Third Circuit has met its initial burden of proving likely confusion, the burden shifts to the “defendant to show that its nominative use of the plaintiff’s mark is nonetheless fair,” and thus, not actionable. *Century 21*, 425 F.3d at 222. In a variation of the Ninth Circuit’s original *New Kids* test, the

defendant must show: (1) that the use of plaintiff’s mark is necessary to describe both the plaintiff’s product or service and the defendant’s product or service; (2) that the defendant uses only so much of the plaintiff’s mark as is necessary to describe plaintiff’s product; and (3) that the defendant’s conduct or language reflect the true and accurate relationship between plaintiff and defendant’s products or services.

Century 21, 425 F.3d at 222.

C. The Sixth Circuit Does Not Recognize the Nominative Fair Use Doctrine.

In its only case addressing nominative fair use, the Sixth Circuit in 2003 expressly rejected the Ninth Circuit’s approach and declined to recognize the defense: “This circuit has never followed the nominative fair use analysis We are not inclined to adopt the Ninth Circuit’s analysis here.” *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003), *abrogated on other grounds by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

D. The Fourth and Fifth Circuits Consider Nominative Fair Use, Although in Different Ways.

Both the Fourth and Fifth Circuits consider nominative fair use as part of their infringement analysis, but have different approaches to doing so. In the Fourth Circuit, nominative fair use does not formally alter the likelihood-of-confusion test. *See Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 328 (4th Cir. 2015) (“It remains essential in any analysis of confusion to consider fully the purpose with which the mark was being used.”); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 154 (4th Cir. 2012) (“In the context of a referential or nominative type of use, the application of the traditional multi-factor [likelihood-of-confusion] test is difficult because often many of the factors ‘are either unworkable or not suited or helpful as indicators of confusion in this context.’” (citation omitted)); *id.* at 155 (“We . . . are not adopting a position about . . . whether [the nominative fair use] doctrine should formally alter our likelihood-of-confusion test in some way.”). As in the Third Circuit, nominative fair use is an affirmative defense in the Fourth Circuit. *See Radiance Found.*, 786 F.3d at 330. However, the Fourth Circuit has not formally adopted a specific test for determining whether an affirmative defense of nominative fair use has been established.

The Fifth Circuit incorporates two of the Ninth Circuit’s *New Kids* factors into its analysis. Unlike the Ninth Circuit, however, the Fifth Circuit

considers nominative fair use factors in conjunction with, rather than instead of (as in the Ninth Circuit), the digits of confusion factors. *See Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 489 (5th Cir. 2008). “In order to avail oneself of the nominative fair use defense ‘the defendant (1) may only use so much of the mark as necessary to identify the product or service and (2) may not do anything that suggests affiliation, sponsorship, or endorsement by the markholder.’” *Id.* (citation omitted).

E. The First Circuit Has Recognized the Underlying Principle of Nominative Fair Use Without Endorsing Any Particular Approach.

The First Circuit has considered the different approaches of the Ninth and Third Circuits, and appears to have concluded, like the Third Circuit, that nominative fair use should be considered only after a plaintiff meets its burden of establishing likely confusion. *See Swarovski Aktiengesellschaft v. Bldg. No. 19, Inc.*, 704 F.3d 44, 53 (1st Cir. 2013). Specifically, the First Circuit observed:

Without at this time endorsing any particular approach to the nominative fair use doctrine, it is enough to observe that whether the factors serve as the plaintiff’s case-in-chief (as appears to be true in the Ninth Circuit) or as an affirmative defense (as in the Third), a trademark defendant has no burden to prove anything until the

plaintiff has first met its responsibility to show infringement by demonstrating that the defendant's use of its mark is likely to confuse consumers.

Id.

However, the First Circuit did not have an opportunity to articulate any particular test for nominative fair use. The district court in *Swarovski* had not made any findings with respect to whether the advertisement at issue was likely to confuse consumers, and accordingly, the case was remanded. *See id.* at 53, 55.

F. The Remaining Courts of Appeals Have Not Addressed Nominative Fair Use, and District Courts in Those Circuits Have Applied Varying Tests.

The Courts of Appeals for the Seventh, Eighth, Tenth, Eleventh, District of Columbia, and Federal Circuits have not expressly adopted the doctrine of nominative fair use nor have they offered any guidance as to its proper application. As a result, district courts in those circuits have addressed cases involving nominative fair use in an inconsistent manner.

For example, some district courts in the Eighth Circuit have applied the Ninth Circuit's *New Kids* test, others have adopted the Third Circuit's *Century 21* test, and others have relied instead on the Eighth Circuit's traditional likelihood of confusion analysis. *See Cheval Int'l v. Smartpak*

Equine, LLC, No. CIV. 14-5010, 2016 WL 1064496, at *8-9 (D.S.D. Mar. 15, 2016) (applying the Eighth Circuit’s traditional likelihood-of-confusion analysis); *Select Comfort Corp. v. Baxter*, 156 F. Supp. 3d 971, 987 (D. Minn. 2016) (adopting the Ninth Circuit’s *New Kids* nominative fair use test); *Infogroup, Inc. v. DatabaseLLC*, 95 F. Supp. 3d 1170, 1188-89 (D. Neb. 2015) (considering facts under both the Ninth Circuit’s nominative fair use test and the Eighth Circuit’s traditional likelihood of confusion factors); *Edina Realty, Inc. v. TheMLSonline.com*, No. Civ. 04-4371JRTFLN, 2006 WL 737064, at *6 (D. Minn. Mar. 20, 2006) (adopting the Third Circuit’s *Century 21* nominative fair use test); *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1156 (W.D. Mo. 2010) (acknowledging the Third Circuit’s and Ninth Circuit’s recognition of nominative fair use, but declining to apply either).

Some district courts in the Seventh Circuit have applied the Ninth Circuit’s *New Kids* test but have noted that the Seventh Circuit has not endorsed nominative fair use. *See Slep-Tone Entm’t Corp. v. Coyne*, 41 F. Supp. 3d 707, 717 (N.D. Ill. 2014) (noting that no other circuit “has joined the Ninth Circuit’s recognition of the nominative fair use defense”); *Slep-Tone Entm’t Corp. v. Elwood Enters., Inc.*, No. 13-7346, 2014 WL 1612891, at *4-5 (N.D. Ill. Apr. 21, 2014) (applying *New Kids* test). At least one other court within the circuit has adopted a hybrid approach. *See Dwyer Instruments, Inc. v. Sensocon, Inc.*, 873 F. Supp. 2d 1015, 1030-31 & n.4 (N.D. Ind. 2012) (considering

the Ninth Circuit’s nominative fair use test and “various relevant factors from the Seventh Circuit’s” likelihood of confusion test, “modified for nominative fair use in the context of comparative advertising”).

A Colorado district court has noted that the Tenth Circuit had not yet addressed the doctrine of nominative fair use, and held that it should not be treated as an affirmative defense. *See Health Grades, Inc. v. Robert Wood Johnson Univ. Hosp., Inc.*, 634 F. Supp. 2d 1226, 1241-42 (D. Colo. 2009) (acknowledging that the “Tenth Circuit has not yet addressed” nominative fair use, and stating: “[T]he nominative fair use doctrine, if applied here, would supplement [the Tenth Circuit’s] traditional six-factor test for assessing the likelihood of confusion element of a plaintiff’s prima facie trademark claim. The defendant does not bear the burden of proving nominative fair use, and nominative use of a mark is not an affirmative defense to liability.”).

II. THE COURT SHOULD GRANT REVIEW BECAUSE THE SECOND CIRCUIT’S DECISION WIDENS THE ALREADY EXISTING SPLIT OF AUTHORITY.

A. The Second Circuit’s Holding Is Novel.

In the decision below, the Second Circuit considered, in light of the treatment of nominative fair use in the Ninth and Third Circuits, whether to replace the digits-of-confusion test adopted by the Second Circuit in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961). *See*

Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153, 160, 165-67 (2d Cir. 2016) (“ISC²”), *petition for cert. filed*, 2016 WL 5048645 (U.S. Sept. 15, 2016) (No. 16-352).⁵ The Second Circuit determined that when nominative fair use is at issue, courts must continue to consider the digits-of-confusion factors. *See id.* at 168. The court held, however, that in *addition* to addressing each of the confusion factors, courts must consider, as part of the plaintiff’s showing, the following nominative fair use factors:

(1) whether the use of the plaintiff’s mark is necessary to describe both the plaintiff’s product or service and the defendant’s product or service, that is, whether the product or service is not readily identifiable without use of the mark; (2) whether the defendant uses only so much of the plaintiff’s mark as is necessary to identify the product or service; and (3) whether the defendant did anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the plaintiff [trademark] holder, that is, whether the defendant’s conduct or language reflects the true or accurate relationship

⁵ We note that this case involves certification marks, a unique form of trademark in which a person other than the trademark holder uses in commerce a certification mark to certify that the user’s goods or services meet certain standards established by the trademark owner. *See ISC²*, 823 F.3d at 159 (citing 15 U.S.C. § 1127); *see also* 15 U.S.C. § 1054. However, the Second Circuit’s nominative fair use test is not limited to certification marks.

between plaintiff's and defendant's products or services.

Id. at 168.

In reaching its holding, the Second Circuit expressly rejected the Third Circuit's treatment of nominative fair use as an affirmative defense. The Second Circuit reasoned that the Third Circuit treats nominative fair use as an affirmative defense because the Supreme Court has treated descriptive fair use as an affirmative defense. *Id.* at 167; *see also Century 21*, 425 F.3d at 222 (citing *KP Permanent Make-Up*, 543 U.S. at 118-20). The Second Circuit explained that although the Lanham Act explicitly provides that descriptive fair use is an affirmative defense, the same is not true of nominative fair use. *See ISC²*, 823 F.3d at 167-68. The court reasoned that nominative use "involves using the mark at issue *as a mark* to specifically invoke the mark-holder's mark, rather than its use, other than as a mark, to describe the alleged infringer's goods or services." *Id.* at 167. The Second Circuit vacated the district court's grant of summary judgment for defendants, and it remanded the case for reconsideration of the *Polaroid* and nominative fair use factors in conjunction with each other. *Id.* at 169.

B. The Second Circuit Has Exacerbated the Circuit Split.

The Second Circuit's approach attempts to incorporate elements of the Third and Ninth

Circuits' tests, but it is in harmony with neither. Instead, its approach is closest to the Fifth Circuit's, in that it adopts additional factors to be considered as part of the digits of confusion analysis, although those additional factors differ from those used in the Fifth Circuit. As a result, the Second Circuit's decision creates yet another test—a combination of the *Polaroid*, *New Kids*, and *Century 21* factors—to consider in analyzing likelihood of confusion.

Moreover, in contrast to the Third Circuit, the Second Circuit does not treat nominative fair use as a true affirmative defense. In so holding, the Circuit puts the burden of establishing nominative fair use not on the party asserting the defense, but instead evaluates the doctrine as part of the likelihood of confusion analysis, over which *plaintiff* bears the burden.

This new test will exacerbate the already present forum shopping that the current split foments, and will inevitably lead to inconsistent outcomes among the Circuits, uncertainty for trademark owners, and confusion among consumers. For example, a defendant who uses a trademark owner's mark in a nationwide advertising campaign could face a different result in an infringement action in a district court in New York than in New Jersey. If the defendant's use is likely to cause confusion under the Second Circuit's new eleven-factor test in New York, the use cannot be "fair," and is therefore infringing. However, in New Jersey, even if the use of the trademark is

confusing, a defendant may still assert nominative fair use as an affirmative defense under *Century 21*. And of course, the defendant cannot assert nominative fair use at all for any advertising in Ohio or Michigan, and he has no certainty as to what defense he can have in Maine or Massachusetts.

CONCLUSION

In light of the foregoing, the Court should grant the petition to decide (1) whether to recognize the doctrine of nominative fair use; (2) what the test for nominative fair use should be; and (3) whether nominative fair use should be treated as an affirmative defense or should be evaluated as part of the likelihood of confusion analysis as part of the plaintiff's case-in-chief.

Respectfully submitted,

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