

# Classic vs. Nominative Fair use

- U.S. trademark law provides for two forms of “fair use”
  - “Classic” or descriptive fair use, in which the defendant uses the plaintiff’s mark to describe the defendant’s goods
    - Statutory basis: 33(b)(4)
  - “Nominative” fair use, in which the defendant uses the plaintiff’s mark to refer to the plaintiff
    - Statutory basis: 43(c)(3)(A)
      - Problem: “under this subsection”

# “Classic” Fair Use

## 33(b)(4) (15 USC 1115(b)(4))

- [The registration shall be subject to the following defenses of defects:] “That 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, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin,”

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## Court parsing

- The fair use defense requires that the Defendants show that their use of the Phrase was “(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith.” EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos Inc., 228 F.3d 56, 64 (2d Cir. 2000)

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

APPENDIX A

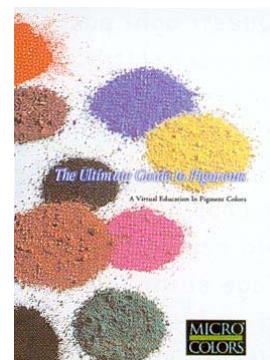


APPENDIX B



## KP Permanent Make-Up v. Lasting Impression (U.S. 2004)

- KP alleged microcolor use since 1990/91
- Lasting 1992 application for Micro Colors, issued in 1993, "incontestable" in 1999
- In 1999, KP's use of microcolor in ad brochure
- Dist. Ct. – on S/J, descriptive fair use, no confusion inquiry
- 9<sup>th</sup> – KP must also prove absence of confusion?
- Supreme Court?



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

“[I]t 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 theory the defense would be foreclosed in such a case. '[I]t defies logic to argue that a defense may not be asserted in the only situation where it even becomes relevant.' Shakespeare Co. v. Silstar Corp., 110 F. 3d, at 243.” Id. at 118

Dessert Beauty, Inc. v. Fox, 568 F.Supp.2d 416  
(S.D.N.Y. 2008)



to avail itself of the fair use defense, DBI must have made use of Fox's LOVE POTION mark

- (1) other than as a mark,
- (2) in a descriptive sense, and
- (3) in good faith

## Sorensen v. WD-40 Company (7th Cir. Feb. 25, 2015)

- Sorensen mark for corrosion inhibitor product:
  - THE INHIBITOR
    - Contains VCI substance
- Defendant's use of mark:
  - "WD-40 Specialist Long-Term Corrosion Inhibitor"
- And cross-hair symbol
- 7<sup>th</sup>
  - Descriptive fair use available for incontestable marks
  - Was this use descriptive fair use?



Items in THE INHIBITOR Line



## International Stamp Art, Inc. v. United States Postal Service (11th Cir. 2006)



**Goods and Services** IC 016, US 002 005 022 023 029 037 038 050, G & S: printed note cards and greeting cards. FIRST USE: 19870304. FIRST USE IN COMMERCE: 19870304

**Mark Drawing Code** (2) DESIGN ONLY

**Design Search Code** 20.03.05 - Bar code labels; Bingo cards; Cards, computer punch; Cards, credit; Cards, greeting; Cards, index; Cards, post cards; Charge cards; Christmas cards; Credit cards; File (index) cards; Greeting cards; Index cards; Postcards  
20.03.07 - Postage stamps; Postmarks; Stamps, postage

**Serial Number** 74583278

**Filing Date** October 7, 1994

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** April 16, 1996

**Registration Number** 1985056

**Registration Date** July 9, 1996

**Owner** (REGISTRANT) International Stamp Art, Inc. CORPORATION SOUTH CAROLINA 3865 Ryans Run Way, SW Lilburn GEORGIA 30047

**Description of Mark** The mark consists of a perforation design, placed along the edge of printed note cards and greeting cards. The matter shown by dotted lines is not part of the mark and serves merely to indicate the position of the mark on the goods.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)

**Affidavit Text** SECT 15, SECT 8 (6-YR), SECTION 8(10-YR) 20060929

**Renewal** 1ST RENEWAL 20060929

**Live/Dead Indicator** LIVE

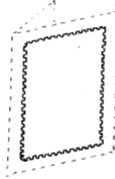
Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

Reg. No. 1,985,056  
Registered July 9, 1996

United States Patent and Trademark Office

TRADEMARK  
PRINCIPAL REGISTER



INTERNATIONAL STAMP ART, INC. (SOUTH CAROLINA CORPORATION)  
ART CRAFT & FRAME BUILDING  
FINEMOOD SHOPPING CENTER 1000 NORTH PINE STREET  
SPARTANBURG, SC 29303

FOR PRINTED NOTE CARDS AND GREETING CARDS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).  
FIRST USE 3-4-1987; IN COMMERCE 3-4-1987.

THE MARK CONSISTS OF A PERFORATION DESIGN, PLACED ALONG THE EDGE OF PRINTED NOTE CARDS AND GREETING CARDS. THE MATTER SHOWN BY DOTTED LINES IS NOT PART OF THE MARK AND SERVES MERELY TO INDICATE THE POSITION OF THE MARK ON THE GOODS.  
SEC. 2(f).

SER. NO. 74-583278, FILED 10-7-1994.  
KATHLEEN COONEY-PORTER, EXAMINING ATTORNEY



## Bell v. Harley Davidson Motor Co. (S.D.C.A. 2008)

- Mark registrations by Bell for:
  - RIDE HARD
  - Apparel, decals, other merchandise
- Use as a mark?
- Use in descriptive sense?
- Good faith?



T-Shirt Front Detail



## Fortune Dynamic, Inc. v. Victoria's Secret (9th Cir. 2010)

- Fortune
  - Mark: DELICIOUS
  - Product: women's shoes
- Victoria's Secret
  - Mark: BEAUTY RUSH
  - Promotional shirts for that product line
- 9<sup>th</sup> reverses the district court's grant of summary judgment for Victoria's Secret descriptive fair use defense

*Delicious*



## Simple examples of classic fair use

- Wonder Labs, Inc. v. Procter & Gamble Co., 728 F. Supp. 1058, 14 U.S.P.Q.2d 1645 (S.D.N.Y. 1990) (“The dentists' choice for fighting cavities” for toothbrushes is fair use of plaintiff's trademark DENTIST'S CHOICE for toothbrushes)
- Western Publishing Co. v. Rose Art Industries, Inc., 733 F. Supp. 698, 14 U.S.P.Q.2d 2059 (S.D.N.Y. 1990) (“golden” describing the gold color of children's writing slate not an infringement of plaintiff's mark GOLDEN for children's books and toys)
- Playboy Enterprises, Inc. v. Terri Welles, Inc., 78 F. Supp. 2d 1066 (S.D. Cal. 1999), aff'd in part, rev'd in part on other grounds, 279 F.3d 796 (9th Cir. 2002) (Defendant Terri Welles was Playboy “Playmate of the Year” in 1981. Court held that her use of the words “Playmate of the Year 1981” in her title on her homepage and “Playboy Playmate of the Year 1981” and ‘Playmate of the Year 1981’ in her advertising banners fell within the classic fair use defense. “Her public persona is based on these titles and ... [they] accurately describe her... . [T]he court cannot say that Ms. Welles took more than was necessary to merely identify herself or her goods.”)