

No.

IN THE
Supreme Court of the United States

SECURITY UNIVERSITY, LLC AND SONDRASCHNEIDER,
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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

For nearly a century, trademark law has recognized that a trademark holder cannot exclude others from using its mark to refer to, comment upon, or offer a comparison with the markholder's product or service. The doctrine that protects such conduct is known as "nominative fair use." But the courts of appeals have adopted disparate standards for analyzing nominative fair uses. And the Second Circuit in this case has deepened the conflict with a diluted version of the doctrine that offers virtually no predictability for defendants engaged in activities like comparative advertising, product review, or parody. The question presented is:

What is the proper standard under the Lanham Act for analyzing a defendant's nominative use of a plaintiff's trademark?

CORPORATE DISCLOSURE STATEMENT

Security University, LLC has no parent corporation, and no publicly held company owns 10% or more of its stock.

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INTRODUCTION

You can't stop others from talking about you. It's true in trademark law, too. Trademark holders can't stop everyone else from comparing their airline's prices to another's, claiming superior 4G coverage, grouching about the volcanic heat of the coffee they serve, or slamming them for sending American jobs abroad. This Court acknowledged the right to reference a trademark in two opinions by Justice Holmes, *Saxlehner v. Wagner*, 216 U.S. 375 (1910), and *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924). Nearly a century later, in a case called *New Kids on the Block*, Judge Kozinski synthesized the decades of case law into a three-part defense: As long as you need the mark to refer to the plaintiff, use no more of it than necessary, and do nothing to suggest the markholder's sponsorship or endorsement, you are not liable for trademark infringement. Clear. Simple. Directed right at what the doctrine is trying to protect. Judge Kozinski dubbed the defense "nominative fair use."

This Court has never addressed the doctrine as such, but nominative fair use has been applied in hundreds of cases. Over the years, even before the Second Circuit's decision here, some variation in the circuits' tests had developed. So had one sharp conflict—between the Ninth and Third Circuits—over whether the defense shows absence of a likelihood of confusion (the central element of an infringement claim) or instead serves as an affirmative defense that excuses liability even where a plaintiff does show confusion. But always, the three considerations outlined in *New Kids* had remained the touchstone.

Justice Holmes would call that a page of history. But the Second Circuit in this case dismissed it all with the scarcest of logic. “See[ing] no reason” to adopt the Ninth Circuit’s three-factor defense, it instead jumbled the traditional nominative fair use factors with the ordinary eight-factor test courts in the Second Circuit use to analyze the likelihood-of-confusion element of a plaintiff’s infringement claim. Pet. App. 33a-34a. That test focuses on whether the defendant’s use is so similar to the plaintiff’s mark that it will confuse consumers as to the source of the defendant’s product, or plaintiff’s affiliation, sponsorship, or endorsement. Pet. App. 27a-28a. So nominative fair use is now diluted with considerations—such as the “strength of a mark,” the “similarity” between the plaintiff’s mark and the challenged use, or the likelihood that the plaintiff will “bridge the gap” between its products and the defendant’s—which are irrelevant or unhelpful in a case where the *whole point* is to refer to the plaintiff’s mark. The upshot is that in the Second Circuit, a defendant *can still* be found liable for trademark infringement even if she has no choice but to use the mark to communicate something; uses no more of the mark than necessary to communicate it; and does nothing to mislead or misrepresent as to source, sponsorship, affiliation, or connection.

That is the prospect Petitioners Security University and Sondra Schneider (collectively referred to as Security University) face here. This case would almost certainly be over in the Ninth Circuit, Third Circuit, and several others that have applied the nominative fair use doctrine. Respondent International

Information Systems Security Certification Consortium (which calls itself (ISC)² for short) sued Security University for trademark infringement, claiming that Security University was not allowed to use its “CISSP” mark to advertise a class Security University was offering that prepped students for (ISC)²’s CISSP exam. The district court easily found that Security University satisfied the *New Kids* test. That has long been thought enough to defeat a trademark suit.

And it is vital to both the marketplace of goods and services and the marketplace of ideas that such a showing *is* enough. Nominative fair use protects a host of beneficial activities, like comparative advertising, product review, criticism, and parody. The doctrine is more important now than ever before. New media has yielded enormous benefits for consumers, in the form of online platforms for comparing and purchasing products (like Kayak or Expedia), product review websites (like Yelp), or online retailers (like eBay). And the many online fora are filled with criticism, exposé, or discourse about companies and their practices. These are goods that ought to be protected with a meaningful defense, lest the cease-and-desist letter become a muzzle.

It’s called a “nominative fair use defense” for a reason. Like other trademark or copyright fair use doctrines, nominative fair use developed to protect a class of activities that unchecked intellectual property rights might otherwise swallow. The Second Circuit’s test fails because it unduly dilutes protection for such uses. And in any event it is so convoluted that most litigants in the Second Circuit won’t know their fate until the jury comes back, if they aren’t pressured

into settlement long before. Any valid approach to nominative fair use must treat it as a freestanding defense calibrated to protect certain types of uses, just as it developed from *Saxlehner* and *Prestonettes* into the Ninth Circuit's time-honored defense. This "page of history is worth a volume of logic." *New York Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921) (Holmes, J.); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 394 (2006) (Roberts, C.J., concurring).

This Court should grant the petition, adopt the Ninth Circuit's traditional nominative fair use test, and reverse the Second Circuit's decision.

OPINIONS AND ORDERS BELOW

The court of appeals' decision (Pet. App. 1a-38a) is reported at 823 F.3d 153 (2d Cir. 2016). The district court's decision (Pet. App. 41a-74a) is not officially reported but can be found at 2014 WL 3891287.

JURISDICTION

The court of appeals entered judgment on May 18, 2016. Pet. App. 39a-40a. On August 2, 2016, Justice Ginsburg extended the time for filing a petition for a writ of certiorari to September 15, 2016. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

This case involves 15 U.S.C. §§ 1115(b), 1125(a), and 1125(c)(3), which are reproduced at Pet. App. 75a-80a.

STATEMENT OF THE CASE***Security University Advertises Training Courses For The CISSP Exam***

If you want a job in the information security field, you'd do well to become a "Certified Information Systems Security Professional," or "CISSP." App'x 63-65.¹ Respondent (ISC)², which sets competency standards for the information security industry, developed the CISSP certification in 1990. Pet. App. 6a. (ISC)² also created the CISSP exam, which it administers for a fee of \$599, <http://tinyurl.com/CISSPPricing>; Pet. App. 41a-43a. And it sells CISSP training materials and seminars to prepare students for the exam, App'x 63-68. In 1997, the U.S. Patent and Trademark Office issued (ISC)² a trademark registration covering the "CISSP" mark. Pet. App. 7a, 43a. The CISSP mark is a "certification mark" under the Lanham Act. Pet. App. 14a-15a. The point of a certification mark is that when someone meets certain eligibility requirements, she can use the mark to indicate her certification. *See* 15 U.S.C. § 1127. That is how the CISSP mark works: Once you pass the CISSP exam, (ISC)² lets you use the CISSP® mark to indicate your accreditation. Pet. App. 7a, 42a-44a.

Petitioner Sondra Schneider, herself a CISSP-certified expert, started Security University in 1999. Pet. App. 7a. Security University offers information

¹ App'x citations are to the Joint Appendix filed before the Second Circuit, Dkt. No. 28, *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 14-3526-cv (2d Cir.). Dkt. No. citations are to docket entries in the Second Circuit.

security training courses. *Id.* Among its offerings are CISSP prep courses that compete with (ISC)²'s courses. Pet. App. 7a, 44a. When Security University advertises its courses on its website, at conferences, or in brochures, it of course uses the CISSP[®] mark to indicate to prospective students what the course covers. Pet. App. 7a, 44a.

This case concerns some of Security University's advertisements. (ISC)² objects to use of the terms "Master CISSP[®]" or "CISSP[®] Master" in ads for prep courses taught by a particular Security University instructor, Clement Dupuis. Pet. App. 8a-9a. In August 2010, (ISC)² sued Schneider and Security University under the Lanham Act for trademark infringement, 15 U.S.C. § 1114, false designation of origin, *id.* § 1125(a) (Pet. App. 78a), false advertising, *id.*, and dilution, *id.* § 1125(c) (Pet. App. 79a), and under the Connecticut Unfair Trade Practices Act (CUTPA), Conn. Gen. Stat. § 42-110a *et seq.* for unfair competition. Pet. App. 10a.

Here's an excerpt of one of the ads:

MASTER THE 10 CISSP® DOMAINS and Stay for HACK IN THE BOX!

**Master CISSP® at
*HITBSecConf2010 - Amsterdam!***



MASTER THE 10 CISSP® DOMAINS with the Master CISSP® Clement Dupuis
Date: June 27-30, 2010
Venue: The Grand Krasnapolsky - Dam 9, 1012 JS Amsterdam, The Netherlands

[Register Now!](#)

Register Now to Master the CISSP® Certification with Master CISSP® Instructor Clement Dupuis of www.cccure.org!

Security University and HITB JOBS have joined together to provide you the June 27-30 CISSP® Prep Class at HackinTheBox Security Conference 2010 - Amsterdam (HITBSecConf2010 - Amsterdam).

The CISSP® certification is widely recognized as the "gold standard" of information security certifications. The SU CISSP® Prep class effectively prepares information security professionals to pass the rigorous six-hour Certified Information Systems Security Professional [CISSP®] examination. This SU CISSP®



Pet. App. 53a. (ISC)² contends that the various uses of the word "Master" in connection with the CISSP® mark "[are] likely to cause confusion, to cause mistake, or to deceive members of the public into believing that Plaintiff's mark is somehow capable of being 'mastered' and that such mastery is only available from Security University." App'x 18; *see* Pet. App. 10a.

The District Court Determines That The Ads Are Protected As Nominative Fair Use

Security University moved for summary judgment on each of (ISC)²'s claims. It argued that the challenged uses of (ISC)²'s "CISSP®" mark were protected by a nominative fair use defense. Pet. App. 46a-47a.

The district court agreed. It first acknowledged that the Second Circuit had not "formally adopted" a test for nominative fair use, and noted, in tracing the origins of the doctrine, the conflict of authority between the Ninth and Third Circuit's approaches to nominative fair use. Pet. App. 48a-49a. Following other district courts in the Second Circuit, the court opted for the Ninth Circuit standard, under which a "three-prong test ... substitutes for the likelihood of confusion inquiry." Pet. App. 49a.

The district court found all three components of the test satisfied. First, it determined that (ISC)²'s CISSP certification is "one not readily identifiable without use of the trademark." Pet. App. 50a (quoting *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)). "As a practical matter, Defendants have to reference the CISSP® mark when explaining that they offer a course aimed at permitting the consumer to pass the CISSP® examination" Pet. App. 50a-51a.

Second, Security University’s ads use “only so much of the mark or marks ... as is reasonably necessary to identify the product or service.” Pet. App. 50a (quoting *New Kids*, 971 F.2d at 308).

Third, the district court explained that Security University had “do[ne] nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.” *Id.* (quoting *New Kids*, 971 F.2d at 308). It pointed to “multiple references to Security University and SU” on the ads, “express statements that Security University and/or [a partnering job placement service] are offering the classes,” and additional “disclaimers” Pet. App. 53a, 57a.

On the basis of its conclusion that nominative fair use applied, the district court dismissed (ISC)²’s claims.

The Second Circuit Reverses And Announces A New Nominative Fair Use Standard

(ISC)² appealed to the Second Circuit. After the parties submitted their briefs, the Second Circuit sent a letter to the U.S. Patent and Trademark Office (PTO) requesting that it provide its views on the existence and application of a nominative fair use defense under the Lanham Act. Dkt. No. 59. The PTO’s response acknowledged that the nominative use of a mark presents a “unique context” for analyzing trademark infringement. Dkt. No. 70 at 13. It also recited considerable variation in the circuits’ approaches. Dkt. No. 70 at 8-13. Ultimately, it endorsed none of the tests applied by the circuits. Instead, it

said that courts should apply “[a]ll relevant factors probative of likelihood of confusion.” Dkt. No. 70 at 14-15.

The Second Circuit vacated and remanded the district court’s ruling, in the process mandating a novel nominative fair use standard. Like the PTO, the court noted extraordinary variation among circuits. It “reject[ed] the Third Circuit’s treatment of nominative fair use as an affirmative defense.” Pet. App. 31a-32a. But it also rejected the Ninth Circuit’s approach, “see[ing] no reason” to supplant its usual multi-factored likelihood-of-confusion test with a simpler three-factor analysis. Pet. App. 33a-34a. It held that “in nominative use cases, district courts are to consider the Ninth Circuit and Third Circuit’s nominative fair use factors, in addition to [the Second Circuit’s eight traditional likelihood-of-confusion] factors.” Pet. App. 34a. The court of appeals directed the district court to apply this new 11-part test on remand.

REASONS FOR GRANTING THE WRIT

This Court should grant review in this case to clarify the proper approach to nominative fair use. The Second Circuit’s decision deepens an entrenched conflict between the courts of appeals on the proper nominative fair use standard. The proper approach in nominative use cases is an extraordinarily important issue, directly implicating competition and speech interests. The Second Circuit’s approach is wrong. And this case is a perfect vehicle for a course correction.

I. The Courts Of Appeals Are Splintered Over The Proper Approach To Nominative Fair Use.

Before this case, there was already an acknowledged conflict between the Ninth and Third Circuits over nominative fair use. Now the Second Circuit has gone its own way, and there are at least three entrenched approaches. Add to that the First, Fourth, Fifth, Seventh, and Eighth Circuits—all of which have recognized nominative fair use or its underlying principles, but apply a case-by-case approach. And the Sixth Circuit has considered and rejected nominative fair use entirely. It's a mess only this Court can sort out.

Ninth Circuit. The place to start is the Ninth Circuit's opinion in *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992). Back in the early-'90s, musical group New Kids on the Block was hot. *Id.* at 304. The group sued two national newspapers, *USA Today* and *The Star*, for trademark infringement. Both had conducted fan polls, asking readers to call a 900 number (for a fee) and vote for their favorite New Kid—among Donnie, Jordan, Joey, Danny, and Jonathan. *Id.* The district court granted summary judgment for the defendant newspapers. *Id.*

The Ninth Circuit affirmed in an opinion by Judge Kozinski. Trademark law, the court explained, is focused principally on protecting a markholder's right to use its mark to "identif[y] ... the manufacturer or sponsor of a good or the provider of a service." *Id.* at 305. But the newspapers' use did not implicate that

interest, because the newspapers were plainly not trying to pass their product off as coming from the New Kids. Nor were the newspapers claiming a right to use the term “New Kids on the Block” to describe some quality of their own product, rather than referencing the musical group. *Id.* That would have implicated a *descriptive* fair use defense, available under the Lanham Act for a use “otherwise than as a mark, ... which is descriptive of and used fairly and in good faith only to describe” the defendant users’ own products. 15 U.S.C. § 1115(b) (Pet. App. 76a). (Think, for example, of use of the words “all bran” to describe a 100% bran cereal, despite Kellogg’s “All-Bran” trademark.) But the newspapers’ use didn’t fall within that rubric either.

Instead, “the New Kids trademark [was] used to refer to the New Kids themselves.” 971 F.2d at 308. And to refer to the New Kids, the newspapers had no choice but to use their mark—otherwise, “how could someone not conversant with the proper names of the individual New Kids talk about the group at all?” *Id.* *New Kids* was thus a case in which it was “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.” *Id.* at 306. In such circumstances, courts had repeatedly found that the defendant was entitled to make a “*nominative use* of a mark,” so long as the use was not “false or misleading.” *Id.* at 307-08 (emphasis in original).² The court understood these cases to involve “a

² The court cited *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969) (mechanic may use

use to which the infringement laws simply do not apply,” analogizing the principle to copyright’s fair use doctrine. *Id.* at 307. Hence the term the court applied: “nominative fair use.” *Id.* at 308.

Since *New Kids*, the Ninth Circuit has encountered dozens of nominative fair use cases in various factual contexts, and its approach has held up. “In cases where a nominative fair use defense is raised, [a court asks] whether (1) the product was ‘readily identifiable’ without use of the mark; (2) defendant used more of the mark than necessary; or (3) defendant falsely suggested he was sponsored or endorsed by the trademark holder.” *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175-76 (9th Cir. 2010). The leading treatises and texts on trademark law accept this three-factor test as the touchstone for nominative fair use, and the scholarly literature has repeated it over and over again.³

“Volkswagen” or “VW” to describe what it repairs); *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968) (maker of imitation perfume may use “Chanel No. 5” to compare products); and *WCVB-TV v. Bos. Athletic Ass’n*, 926 F.2d 42 (1st Cir. 1991) (TV station may use “Boston Marathon” to describe the event it will broadcast).

³ See, e.g., J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23.11 (4th ed. 2016); Anne Gilson Lalande, *Gilson on Trademarks* § 11.08[k] (2016); Jane C. Ginsburg et al., *Trademark and Unfair Competition Law: Cases and Materials* 592-600 (5th ed. 2013); Graeme B. Dinwoodie & Mark D. Janis, *Trademarks and Unfair Competition* 725, 736-37 (2010); Graeme B. Dinwoodie, *Developing Defenses in Trademark Law*, 13 Lewis & Clark L. Rev. 99, 110-11 (2009) (hereinafter Dinwoodie, *Developing Defenses*); Carl Regelman,

In the Ninth Circuit, the three-factor test’s function is to “evaluate[] the likelihood of confusion in nominative use cases,” *id.* at 1176—that is, it evaluates whether the plaintiff has established the central element of her infringement claim, 15 U.S.C. § 1125(a)(1)(A) (Pet. App. 78a). The test thus replaces the Ninth Circuit’s ordinary eight-factor test for likelihood of consumer confusion, 610 F.3d at 1182, which includes factors like the “strength of the mark,” “similarity of the marks,” and “type of goods” involved, *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). The Ninth Circuit has explained that in nominative use cases—where the very purpose of the use is to reference the mark itself—“[t]he three factor test ... better addresses concerns regarding likelihood of confusion.” *Playboy Enters. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002).

The burden remains at all times on the plaintiff to establish confusion, and hence infringement. Thus, nominative fair use in the Ninth Circuit operates as a defense, but not an *affirmative* defense. *Toyota*, 610 F.3d at 1176. It works like this: A plaintiff sues and alleges confusion; the defendant raises nominative fair use, triggering application of the nominative fair use test to analyze whether the use is confusing; and the plaintiff then, in order to both show a likelihood

Trademark Nominative Fair Use: The Relevance of the “New Kids on the Block” Factors, 16 DePaul J. Art & Eng. L. 1, 9 (2005); Jonathan Moskin, *Frankenlaw: The Supreme Court’s Fair and Balanced Look at Fair Use*, 95 Trademark Rptr. 848, 866 (2005).

of confusion and defeat the nominative fair use defense, must prevail on one of the three enumerated factors. *Id.*

Third Circuit. The Third Circuit’s approach differs in two ways. First, nominative fair use *is* an affirmative defense in the Third Circuit. Second, although the Third Circuit, like the Ninth Circuit, applies a three-factor test, the components of the test are somewhat different.

The Third Circuit announced its approach in *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211 (3d Cir. 2005). The plaintiffs were several well-known real estate brokers with franchises across the country. *Id.* at 215. The defendant, LendingTree, was an internet-based platform designed to “help[] consumers identify and select qualified lenders, real estate brokers, auto insurers, and other financial service companies.” *Id.* For example, if a user was looking to buy a home in a particular area, she could go to LendingTree’s website and enter her location, and LendingTree would then display an aggregated list of options for brokers serving that area. *Id.* This display included the plaintiff brokerage firms’ marks. *Id.* The district court granted a preliminary injunction, finding that these uses were likely to cause confusion and were not shielded by a nominative fair use defense. *Id.* at 216.

The Third Circuit reversed and remanded. *Id.* at 232. At the outset, the court “agree[d] with the Ninth Circuit ... that a distinct analysis is needed for nominative fair use cases.” *Id.* at 218-20. But it devoted the bulk of its opinion to whether it would adopt the

Ninth Circuit approach of replacing the likelihood-of-confusion test with the three-factor nominative fair use test, or instead would adopt a different three-factor test as an affirmative defense that a defendant could prevail upon *even if* the plaintiff showed a likelihood of confusion. *Id.* It opted to forge its own path. *Id.* at 220.

The Third Circuit based its decision on this Court's then-recent decision in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004). *KP Permanent* concerned descriptive fair use under § 1115(b)(4) (Pet. App. 76a)—i.e., classic fair use, like in the “all bran” example above (at 12). *KP Permanent*, the Third Circuit noted, held that the defendant can prevail on descriptive fair use grounds even when the plaintiff establishes likelihood of confusion. *Century 21*, 425 F.3d at 217 (citing *KP Permanent*, 543 U.S. at 121). The Third Circuit “d[id] not see nominative fair use as so different from classic fair use as to warrant such different treatment.” *Id.* at 220. Relatedly, the Third Circuit worried that the Ninth Circuit test, by supplanting the likelihood-of-confusion factors, “would relieve the plaintiff of the burden of proving the key element of a trademark infringement case—likelihood of confusion—as a precondition to a defendant’s even having to assert and demonstrate its entitlement to a nominative fair use defense.” *Id.* at 221. This too, in the Third Circuit’s view, was in tension with *KP Permanent*’s holding. *Id.*

To reconcile all this, the Third Circuit adopted a “two-step approach in nominative fair use cases.” *Id.* at 222. “The plaintiff must first prove that confusion

is likely due to the defendant's use of the plaintiff's mark." *Id.* At this first step, a district court should apply a slightly modified version of the Third Circuit's ordinary 10-factor test for analyzing likelihood of confusion, considering, for example, evidence of actual confusion or the defendant's intent. *Id.* at 225-26. Second, "[o]nce 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 mark is nonetheless fair." *Id.* at 222. The defendant can make out its defense by satisfying a three-prong test "derived to a great extent from the one articulated by the ... Ninth Circuit." *Id.*

Although the Ninth and Third Circuit tests aim at similar concepts, there are noteworthy differences. The Ninth Circuit's first factor asks only whether the use of a mark is necessary to describe *the plaintiff's* product. *Toyota*, 610 F.3d at 1175. The Third Circuit's, by contrast, asks whether "the use of plaintiff's mark is necessary to describe *both* the plaintiff's product or service *and* the defendant's product or service." *Century 21*, 425 F.3d at 222. The respective tests' second factors are the same—both require that "the defendant uses only so much of the plaintiff's mark as is necessary to describe the plaintiff's product." *Id.*; *Toyota*, 610 F.3d at 1175. But they diverge again on the third component. While the Third Circuit test requires a showing 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, the Ninth Circuit's third factor requires, more narrowly, that

the defendant does not “falsely suggest[] he was sponsored or endorsed by the trademark holder,” *Toyota*, 610 F.3d at 1176.

Thus the rift emerged over a decade ago, and it has persisted ever since.

Second Circuit. The Second Circuit in this case shunned both of these approaches. Instead of an independent inquiry, the Second Circuit diluted any consideration of nominative fair use with the eight-factors it traditionally uses to analyze likelihood of confusion, resulting in an 11-factor test.

After tracing the development of the nominative fair use doctrine, the Second Circuit considered and “reject[ed] the Third Circuit’s treatment of nominative fair use as an affirmative defense.” Pet. App. 31a-32a. In the Second Circuit’s view, the Third Circuit had put undue weight on the analogy between descriptive fair use and nominative fair use. Pet. App. 32a-33a. The Lanham Act expressly provides for descriptive fair use, the court pointed out. *See* 15 U.S.C. § 1115(b)(4) (Pet. App. 76a). The court opined that nominative fair use “cannot fall within § 1115(b)(4)’s language,” and it said that “[i]f Congress had wanted nominative fair use to constitute an additional defense, it would have provided as such.” Pet. App. 33a.

As for rejecting the Ninth Circuit approach, the court offered no reasoning other than that it “[saw] no reason to replace the [likelihood-of-confusion factors] in this context.” Pet. App. 33a-34a.

The court finished by announcing its new standard: “[D]istrict courts are to consider the Ninth Circuit and the Third Circuit’s nominative fair use factors, in addition to the [likelihood-of-confusion] factors.” Pet. App. 34a. The Second Circuit then melded together the differing phrasing of the Third and Ninth Circuits (discussed *supra* 17-18) to arrive at the following:

- (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 holder, that is, whether the defendant’s conduct or language reflects the true or accurate relationship between plaintiff’s and defendant’s products or services.

Pet. App. 35a.

It then dumped these factors in with the Second Circuit's eight other traditional factors (with the unexplained caveat that "many of th[ose] factors are a bad fit here"), Pet. App. 34a. So add in:

- (4) strength of the trademark;
- (5) similarity of the marks;
- (6) proximity of the products and their competitiveness with one another;
- (7) evidence that the senior user may "bridge the gap" by developing a product for sale in the market of the alleged infringer's product;
- (8) evidence of actual consumer confusion;
- (9) evidence that the imitative mark was adopted in bad faith;
- (10) respective quality of products; and
- (11) sophistication of consumers in the relevant market.

Pet. App. 27a-28a (quoting *Starbucks Corp., v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009)). The Second Circuit remanded for the district court to reconsider Security University's ads under this new 11-factor inquiry. Pet. App. 37a.

First, Fifth, Seventh, and Eighth Circuits. Four other Circuits have also adopted the nominative

fair use doctrine or its underlying principles, but appear to take things case-by-case, often referring to the Ninth Circuit’s *New Kids* factors without formally prescribing their use. *See* Pet. App. 29a (“Other circuits have adopted variations of [the Ninth Circuit’s] test.”).

The First Circuit has “recognized the ‘underlying principle’ of nominative fair use, but ... ha[s] never endorsed any particular version of the doctrine.” *Swarovski Aktiengesellschaft v. Bldg. No. 19, Inc.*, 704 F.3d 44, 50 (1st Cir. 2013). In *Swarovski*, the court appeared to endorse application of the Ninth Circuit factors. *Id.*; *see Universal Commc’n Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 424-25 (1st Cir. 2007).

The Fifth Circuit, meanwhile, has “held that a nominative fair use claim is a claim that a mark’s use is noninfringing and therefore creates no likelihood of confusion.” *Bd. of Supervisors for La. St. Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 488-89 (5th Cir. 2008). That circuit describes nominative fair use as a “defense” applicable where the defendant “only use[s] so much of the mark as necessary to identify the product or service” and does nothing “that suggests affiliation, sponsorship, or endorsement by the markholder”—i.e., the second and third *New Kids* factors. *Id.* at 489. And it has “said that ... court[s] ordinarily should consider a nominative fair use claim in conjunction with its likelihood-of-confusion analysis in order to avoid lowering the standard for confusion.” *Id.*; *see Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546-47 (5th Cir. 1998), *abrogated on other grounds by TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

Both the Seventh and Eighth Circuits have firmly held, in particular factual settings, that nominative-type uses are not actionable under the Lanham Act. *E.g., Ill. High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996) (Posner, J.) (citing *New Kids* and noting that the plaintiff could not have sued the defendant for use of its trademark “in advertising if the term were used merely for identification”); *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616 (7th Cir. 1995) (Easterbrook, J.) (endorsing defendant’s right to engage in comparative advertising); *Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc.*, 815 F.2d 500, 503-04 (8th Cir. 1987) (“[A]n imitator is entitled to truthfully inform the public that it believes ... it has produced a product equivalent to the original and that the public may benefit through lower prices by buying the imitation.”). These courts have not, however, adopted the nominative fair use doctrine by name.

Sixth Circuit. Finally, the Sixth Circuit has considered and categorically rejected nominative fair use as a defense. In *PACCAR Inc. v. TeleScan Technologies, L.L.C.*, the defendant raised a nominative fair use defense to an infringement suit concerning its use of the plaintiff’s mark in internet domain names and “metatags” (unseen reference words that allow search engines to find a website). 319 F.3d 243 (6th Cir. 2003), *abrogated on other grounds by KP Permanent Make-Up*, 543 U.S. 111 (2004). The Sixth Circuit said that it “has never followed the nominative fair use analysis” and that it was “not inclined to adopt the Ninth Circuit’s analysis.” *Id.* at 256.

Nominative fair use is a highly developed doctrine, but it is the subject of deep conflict. It's not going away—neither the doctrine nor the confusion over its place in trademark law. This Court should intervene to bring much-needed clarity to this important area of the law.

II. The Issue Is Extraordinarily Important To Competition And Speech Interests.

This case merits review because of the importance of the issue. Trademark rights are supposed to provide consumers with useful information; Apple®, “Got Milk?”, the are vessels for qualitative associations and reputational data that consumers use to decide how to spend their money. *See generally New Kids*, 971 F.2d at 305 & n.2 (citing William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & Econ. 265, 269 (1987)). But what if granting an exclusive right to use a mark winds up preventing others from even talking about the mark or what it represents? That would defeat the whole purpose.

Nominative fair use helps prevent that result. It is one of those crucial doctrines that keep intellectual property rights from cannibalizing the very interests they aim to advance. *Cf. Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429-33 (1984) (discussing copyright fair use); *id.* at 479 (Blackmun, J., dissenting) (same). It protects a whole range of communicative activities that properly promote competition and communication—activities almost universally acknowledged as public goods. *McCarthy*,

supra, at § 23:11 (nominative fair use “has been applied in a wide range of factual situations”); *Gilson, supra*, at § 11.08[k][iii] (describing range of protected activities). And the need for a clear, practicable nominative fair use standard is more pressing today than it has ever been, because of the proliferation of these activities on the internet.

Advertisement and Comparison. The activities most often associated with nominative fair use involve use of a trademark as a reference point for what the user is selling. The seller of a generic pain killer might invite a customer to “Compare active ingredients with Advil 500 Liqui-Gels.” Pepsi can name the vanquished in the Pepsi Challenge—it need not call Coke “that other cola in the red can.” And likewise a company like Security University is supposed to be able to tell prospective students what test it will prepare them to master.

When Congress enacted the Lanham Act in 1946, it was already firmly acknowledged that such uses of a mark are permissible. This Court first said so in *Saxlehner v. Wagner*, 216 U.S. 375 (1910), an unfair competition case. The plaintiff sold “bitter water” under the name “Hunyadi Janos.” *Id.* at 380. The defendants sold a copycat they labeled “W.T. Wagner’s Sons Artificial Hunyadi Janos.” *Id.* Writing for the Court, Justice Holmes held that the defendants “have a right to tell the public what they are doing, and to get whatever share they can in the popularity of the water by advertising that they are trying to make the same article, and think that they succeed.” *Id.*

Fourteen years later, Justice Holmes would reaffirm this notion, this time in a trademark case. In *Prestonettes, Inc. v. Coty*, the defendant purchased the plaintiff's "Coty" brand "toilet powder[]," repackaged it in a metal case, and advertised the case's contents as "Coty's ... independently rebottled in New York." 264 U.S. 359, 366-67 (1924). The court of appeals enjoined the reference to Coty's product, but this Court reversed. Justice Holmes explained that a trademark simply does not "confer a right to prohibit the use of the word or words." *Id.* at 368. There is "no ... sanctity in the word as to prevent its being used to tell the truth." *Id.*

The bottom line is that if you're allowed to sell something—that is, if you aren't prohibited by some other law—you can tell the public what you're selling. Trademark law won't stand in the way, nor does it demand tortured linguistic workarounds. And since *Saxlehner* and *Prestonettes* announced this principle, courts and commentators have repeatedly relied on nominative fair use as the doctrine that protects it. *Supra* 13 n.3 The Fifth Circuit summarized the authorities in *Pebble Beach Co.*, collecting cases, Restatement provisions, and treatise support for the related propositions that "one who has lawfully copied another's product can tell the public what he has copied," and that "one can use another's mark truthfully

to identify another's goods or services in order to describe or compare its product to the markholder's product." 155 F.3d at 545-46.⁴

Product comparison or reference is valuable for consumers. It is a "tried and true advertising tactic," Matthew A. Fischer & Jia-Ming Shang, *Trademark Infringement Claims Based on Nominative Fair Use Get Boost from Circuit Court Ruling*, 23 *Intell. Prop. & Tech. L.J.* 8, 9 (2011), which advertisers favor because "it provides more information about brands to the marketplace," Thomas E. Barry, *Comparative Advertising: What Have We Learned in Two Decades?*, 33 *J. of Advert. Res.*, Mar-Apr. 1993, at 19-29. Government agencies have endorsed comparative advertising, too, as Judge Easterbrook noted in *August Storck*, 59 F.3d at 618 ("Both the FTC and the FDA encourage product comparisons."). The FTC believes that comparative advertising "encourages product improvement and innovation, and can lead to lower prices in the marketplace." FTC, Statement of Policy Regarding Comparative Advertising (Aug. 13, 1979), <http://tinyurl.com/FTCPolicyStmt>. And both FTC and FDA regulations state a preference that comparisons be made by name. 16 C.F.R. § 14.15(b)

⁴ The Fifth Circuit cited *Saxlehner*, 216 U.S. at 380; *New Kids*, 971 F.2d at 306-09; *August Storck*, 59 F.3d at 618-19; *Calvin Klein Cosmetics*, 815 F.2d at 503; *Hypertherm, Inc. v. Precision Prods., Inc.*, 832 F.2d 697, 700-01 (1st Cir. 1987); *G.D. Searle & Co. v. Hudson Pharm. Corp.*, 715 F.2d 837, 842-43 (3d Cir. 1983); *Smith v. Chanel, Inc.*, 402 F.2d at 563; *Societe Comptoir De L'Industrie Cotonniere Etablissements Boussac v. Alexander's Dep't Stores, Inc.*, 299 F.2d 33, 35-37 (2d Cir. 1962); Restatement (Third) of Unfair Competition § 20 cmt. b (1995); and *McCarthy*, *supra*, at § 25:51-52.

(FTC regulation encouraging “the naming of, or reference to competitors”); 21 C.F.R. § 101.13(j)(1)(ii)(A) (FDA provision encouraging reference to a “market leader”).

Without a predictable nominative fair use defense, direct comparative advertising may be too risky. Inevitably, brands will protect market share not by innovating, but by using the threat of costly litigation to thwart unfavorable comparisons. This would impair competition and hurt consumers.

Critique, Criticism, and Parody. Nominative fair use also protects speech interests. As the Ninth Circuit explained in *Toyota*, trademarks are part of “our common language.” *Toyota*, 610 F.3d at 1185. Citizens use trademarks to talk about what the marks represent, whether to praise, criticize, or parody them. A displeased customer might start a “gripe site”—a website of grievances about a particular brand, where others may join the chorus. See <http://tinyurl.com/GripeSites> (listing such websites). An activist might parody a company by using its mark or some slight variation to criticize what she views as a misguided business practice or policy. Or a newspaper might invoke a mark to make a headline just a bit more evocative—like, say, the *New York Post*’s “Liar, liar Speedo on fire” headline in connection with the Ryan Lochte fiasco at the 2016 Rio Olympic Games. *New York Post*, August 19, 2016 (Back Cover), <http://tinyurl.com/SpeedoCover>. Nominative fair use ensures that a trademark holder may not use its trademark rights to impede rightful discourse, no matter how unflattering a particular use may be to

the brand. *See Gilson, supra*, at § 7A.10[2][b] (discussing nominative fair use’s role in this respect).

Courts have invoked the nominative fair use doctrine to protect speech interests. *Mattel, Inc. v. Walking Mountain Products*, 353 F.3d 792 (9th Cir. 2003), is illustrative. The defendant there made and sold “photos [that] portray[ed] a nude Barbie in danger of being attacked by vintage household appliances.” *Id.* at 796. Mattel—owner of the Barbie mark and trade dress—sued for trademark infringement. *Id.* The Ninth Circuit rejected the claims on nominative fair use grounds. *Id.* at 808-12. The Barbie trademark and trade dress, the court explained, “play[] a role in our culture ... —namely, symbolization of an unattainable ideal of femininity for some women.” *Id.* at 808. The defendant “used Mattel’s Barbie figure and head in his works to conjure up associations of Mattel, while at the same time to identify his own work, which is a criticism and parody of Barbie.” *Id.* at 810; *see New Kids*, 971 F.2d at 306 (nominative fair use protects use of mark “for purposes of comparison [and] criticism”); *see also Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 328 (4th Cir. 2015) (noting that parodic use of NAACP mark “resembl[es] ... nominative fair use”); *cf. WCVB-TV*, 926 F.2d at 46 (finding no confusion because TV news station used “Boston Marathon” largely “as a description,” and not as an “attention getting symbol”).

To be sure, some courts have applied a First Amendment defense to address speech-related concerns in the trademark context. *E.g., Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002)

(applying First Amendment balancing test and not reaching nominative fair use). But the nominative fair use doctrine remains highly relevant, and its application may help to avoid thorny First Amendment issues. As the *Walking Mountain* court put it, “employing the nominative fair use test ... follow[s] the time-honored tradition of avoiding constitutional questions where narrower grounds are available.” 353 F.3d at 808 n.14.

Like comparative advertising and competition, speech interests will suffer without a reliable nominative fair use defense. Backed by the threat of protracted litigation, a casual cease-and-desist letter can snuff out even the most earnest critique. See Corynne McSherry, *Avoiding Gripes About Your Gripe (or Parody) Site*, Electronic Frontier Foundation, at 1 (May 2009), <http://tinyurl.com/EFF> WhitePaper) (noting this risk and discussing nominative fair use). A simple and straightforward nominative fair use defense will help ensure that this does not happen.

A clear and predictable nominative fair use defense is critically important to competition and free speech because it protects the ability to speak good or ill of a brand without fear of liability for trademark infringement. Such assurance is all the more salient to the multiplied voices of new media. Upstart competitors promoting products on Twitter, internet aggregators offering one-stop shops, bloggers sorting the value buys from the rip-offs, and critics surfacing questionable business practices all depend on the

right to nominative use. This Court should take this case and embrace a useful standard that appropriately protects these fundamental interests.

III. The Second Circuit’s Approach Is Wrong.

The Second Circuit’s test is fundamentally flawed. It wrongly departs from decades of case law recognizing the need for a defense calibrated to protect the types of uses discussed above. It is also hopelessly impracticable, rendering an important defense worthless, and indeed unworthy of being called a defense at all. The Ninth Circuit’s three-factor test best reflects the nominative fair use doctrine’s historical foundation and function within the Lanham Act as a whole. And the Third Circuit’s variation—treating nominative fair use as an affirmative defense—is also far superior to the Second Circuit’s unwieldy standard.

A. The first problem with the Second Circuit’s standard is that it unduly dilutes protection of nominative uses. In the Second Circuit, a defendant can overwhelmingly satisfy the traditional factors—showing genuine need to use a mark, narrow limitation of that use, and the absence of any conduct that would mislead—and *still* face liability based on the outcome of the other factors. This gives the public’s right to a nominative use no independent role as a defense under the Act. A nominative use just triggers an even more kaleidoscopic confusion analysis that looks nothing like a fair use defense.

The title “nominative fair use defense” is not a misnomer. Indeed, nominative fair use, at least in its

traditional formulation, serves largely the same role as *descriptive* or “classic” fair use, an unmistakable link that speaks volumes about how courts ought to analyze nominative uses.

To begin with, the doctrines police essentially the same borders. Descriptive fair use protects the use of a trademarked term for its “primary descriptive meaning.” *McCarthy, supra*, at § 11:45. A juice company, for example, may use the term “sweet-tart” to describe the flavor of its own juice despite a candy company’s ownership of the mark “SweeTart.” *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055 (7th Cir. 1995). Nominative fair use rests on the same principle. Although a nominative use is designed to *refer* to another’s product, “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.” *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 n.8 (9th Cir. 2002) (emphasis added). Both doctrines prevent trademark holders from restricting a competitor’s ability to say what it sells.

Unsurprisingly, the doctrines also share the same goals. “The policies of free competition and free use of language dictate that trademark law cannot forbid the commercial use of terms in their descriptive sense.” *McCarthy, supra*, at § 11:45; *KP Permanent*, 543 U.S. at 122 (“[T]here [is] no indication that the statute was meant to deprive commercial speakers of the ordinary utility of descriptive words.”); Din-woodie, *Developing Defenses, supra*, at 132. As we

have explained (at 23-30), nominative fair use doctrine is animated by the same competition and speech interests.

If there were any doubt that nominative fair use truly is meant to be applied as a trademark fair use defense, Congress dispelled it in 2006 in the Trademark Dilution Revision Act (TDRA). Ten years earlier, in the Federal Trademark Dilution Act, Congress had created a cause of action for the “dilution” of “famous” marks, as well as defenses to that cause of action. Amending the provision setting out those defenses in the TDRA, Congress specifically listed “[a]ny fair use, including a nominative or descriptive fair use,” and likewise denoted “advertising or promotion that permits consumers to compare goods or services,” and “identifying and parodying, criticizing, or commenting upon,” the core activities nominative fair use protects. 15 U.S.C. § 1125(c)(3)(A). Congress is aware of the case law, and it plainly views nominative fair use as an independent, freestanding defense for particular uses trademark law ought not restrict.

It follows from all this that descriptive and nominative fair use should have similar formulations— and they do, at least traditionally. Descriptive fair use considers whether a mark is used (1) “otherwise than as a mark”; (2) in a “descriptive” sense; and (3) “fairly and in good faith.” 15 U.S.C. § 1115(b)(4) (Pet. App. 76a). The traditional nominative fair use standard likewise focuses (in factor 1) on descriptive necessity and (in factors 2 and 3) on the fairness and good faith of the use. *See supra* 13, 17. This is as it should be, and the Second Circuit was wrong to reduce the nominative fair use defense to a few extra factors a court

may—but need not necessarily—consider when weighing consumer confusion.

B. The Second Circuit’s approach is also hopelessly convoluted and bound to produce inconsistent results.

Litigants and courts must first contend with the Second Circuit’s new hybrid nominative use factors. Factor one asks whether a use is “necessary to describe *both the plaintiff’s product ... and the defendant’s product,*” then rephrases the inquiry as “whether the product ... is not readily identifiable without ... the mark,” but does not specify whose “product” is relevant for this supposedly equivalent inquiry. Pet. App. 35a (emphasis added). The third factor is just as puzzling, conflating whether “the defendant *did anything* that would ... suggest sponsorship or endorsement” with “whether the de-fendant’s conduct or language *reflects* the true or accurate relationship between plaintiff’s and defend-ant’s products.” Pet. App. 35a. So is it the defendant’s conduct that matters—which seemingly targets fairness and good faith—or simply the language and context—which seemingly drives at likelihood of confusion?

Then there are the other eight traditional likelihood-of-confusion factors, with the cryptic warning that “many ... are a bad fit here.” Pet. App. 34a. But the Second Circuit does not say which of the eight are the good fits and which are the bad, nor why its test should include the “many” that are bad. One might reason, for example, that the “similarity of the marks” would be an odd inquiry in the nominative fair use

context: If, as is always the case with nominative uses, the point of using the mark is to reference that very mark, *of course* they will be similar. But does that make that factor a “bad fit”? If so, does that mean it actually does not apply at all? Or is it not a bad fit, and instead it weighs in favor of confusion, simply weakening any potential nominative fair use defense? To take another example, in cases that do not concern nominative uses, the strength of the trademark typically weighs in favor of a finding of likelihood of confusion. *McCarthy, supra*, at § 23:40.50. But when it comes to nominative uses, the greater the commercial strength of a mark, the greater will be the need for a comparative advertiser to reference it or a critic to speak about it. This leads to the perverse result that the greater the need for nominative fair use the less available it becomes.

The solution to this problem is simple: Ditch the multi-factor test in nominative fair uses cases. As the Ninth Circuit has explained, “the three-factor test ... better addresses concerns regarding the likelihood of confusion” in such cases. *Playboy Enters.*, 279 F.3d at 796; *see Century 21*, 425 F.3d at 224 (explaining that many traditional confusion factors are “either unworkable or not suited or helpful as indicators of confusion in [the nominative fair use] context”). The Second Circuit’s novel test is simply too complicated and too contradictory to work.

IV. This Case Is An Ideal Vehicle For Resolving The Issue.

The parties thoroughly briefed the potential approaches to nominative fair use. If that were not enough, the Second Circuit requested and received briefing from the PTO on the proper approach to nominative fair use. In short, the question presented here was squarely in issue and was resolved for all future trademark cases in the Second Circuit. And if this Court grants review and adopts either the time-tested Ninth Circuit approach or the Third Circuit's affirmative defense rubric, it would restore the district court's decision and bring a favorable end to the case for Security University. This is a perfect vehicle for resolving the question presented.

What the Second Circuit's opinion appears to treat as independent grounds for reversal are both (a) largely illusory; and (b) logically dependent on the answer to the question presented in this petition. In other words, this Court's decision will be dispositive regardless.

The first supposedly independent error the Second Circuit purports to rely upon is that "[t]he district court held that the only type of confusion relevant in determining infringement is confusion as to *source*." Pet. App. 18a. According to the Second Circuit, the district court failed to consider whether Security University's uses were likely to confuse consumers as to (ISC)²'s "affiliation" with or "sponsorship" of Security University's courses. Pet. App. 19a.

The Second Circuit seems to have simply missed that the district court did consider and resolve confusion as to affiliation, endorsement, and sponsorship. The district court made the crystal clear determination that “there is nothing in Defendants’ marketing materials that suggests sponsorship or endorsement by [(ISC)²].” Pet. App. 52a. It then immediately supported this conclusion with the record—the advertisements’ multiple references to Security University and the absence of anything indicating (ISC)²’s affiliation—before again concluding that “no reasonable juror” would think that the “training courses were sponsored or endorsed by [(ISC)²].” Pet. App. 53a. And then again: “[A]ttaching the word ‘Master’ to ‘CISSP®’ does not ‘suggest sponsorship or endorsement’ by (ISC)².” Pet. App. 54a. And again: “[Security University] included disclaimers in their advertisements, which served to further reduce any suggestion of sponsorship or endorsement.” Pet. App. 57a. The point is not to relitigate this here; it is that the district court is virtually certain to adopt the exact same conclusions on remand. So this purported error makes no practical difference. The proper nominative fair use standard is what will decide this case.

In any event, bound up in the question of the proper nominative fair use standard is the question of how it interacts with the likelihood-of-confusion analysis. So although the Second Circuit seems to treat the purported error as to “sponsorship or affiliation” as an independent ground for reversal, it is actually logically dependent on the proper nominative fair use standard. Only if the nominative fair use standard incorporates the traditional likelihood-of-confusion

analysis (as the Second Circuit thinks) does the “sponsorship or endorsement” issue matter.

The same is true of another critique the Second Circuit seemed to advance as independent: the district court’s “skepticism that ‘it is possible for the CISSP® certification mark to be infringed by a party who has met all the requirements for certification.’” Pet. App. 24a (quoting Pet. App. 56a). (A certification mark, recall, is designed to be used by another upon meeting eligibility requirements set by the mar-kholder. *Supra* 5.) Again, this characterization of the district court’s analysis is highly questionable. The district court expressed the skepticism the Second Circuit references as a sort of coda after marching through the full nominative fair use analysis, and it specifically “d[id] not foreclose the possibility that the owner of a certification mark might successfully bring a trademark infringement suit against one who is entitled to use the certification mark.” Pet. App. 56a. It simply found that (ISC)² “failed to show why its claims may succeed under existing law.” Pet. App. 56a-57a. It is hard to see how that would change on remand. And in any event, whether it is relevant at all again depends on the proper nominative fair use standard.

In this case, the Second Circuit deepened an already entrenched Circuit conflict. That conflict is the heart of this case. That the Second Circuit referenced two logically subsequent—and rather dubious—grounds for reversal should not prevent this Court’s review.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for a writ of certiorari.

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