The "So What" Defense: Fair Use in Trademark Infringement Cases

January 23, 2008

David M. Lilenfeld David @ManningLilenfeld.com





- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - Lasting Impression
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases



- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases

Statutory Fair Use

Lanham Act 15 U.S.C.A. § 1115(b)(4)





- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases

м

Elements of Fair Use Defense

- Plaintiff satisfies its prima facie case of trademark infringement.
- Defendant raises fair use defense by showing that its use is:
 - 1. other than as a mark,
 - 2. in a descriptive sense, and
 - 3. in good faith.





- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases

Lasting Impression









Lasting Impression 9th Circuit Ruling

- 1. other than as a mark,
- 2. in a descriptive sense, and
- 3. in good faith.
- 4. likelihood of confusion.

KP Permanent Make-up, Inc. v. Lasting Impression, Inc., 328 F.3d 1061, 1065 (9th Cir. 2001).





Lasting Impression U.S. Supreme Court Ruling

- 1. other than as a mark,
- 2. in a descriptive sense, and
- 3. in good faith.
- 4. likelihood of confusion.

KP Permanent Make-up, Inc. v. Lasting Impression, Inc., 543 U.S. 111, 125 S.Ct. 542 (2004).



r.

- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases

×

Nominative Fair Use

Nominative fair use requires three elements:

- owner's product cannot be identified without use of its mark;
- 2. defendant used only so much of owner's mark as was necessary; and
- 3. defendant's use of owner's mark does not suggest sponsorship by owner.



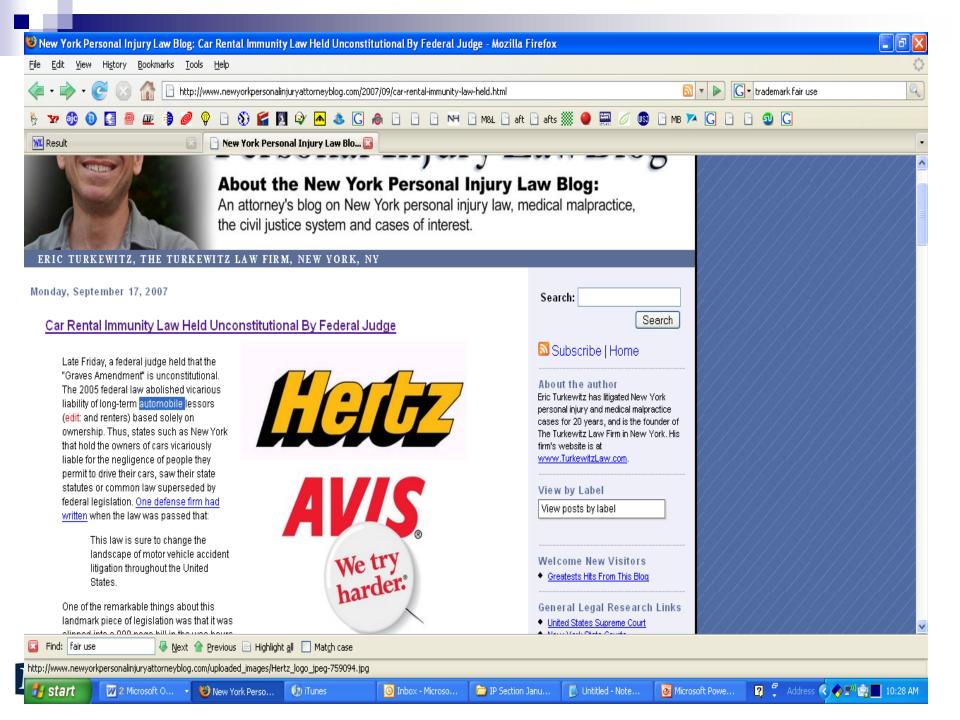
M

Nominative Fair Use Cases

New Kids on the Block, 971 F.2d 302 (9th Cir. 1992) ("New Kids on the Block survey).

Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002) ("Playmate of the Year").





1

- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Statutory Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases



Personal Names

Dolby

V.

"Thomas Dolby"

<u>Dolby v. Robertson</u>, N.D.Cal.1986, 654 F.Supp. 815, 1 U.S.P.Q.2d 1041 – court required disclaimer

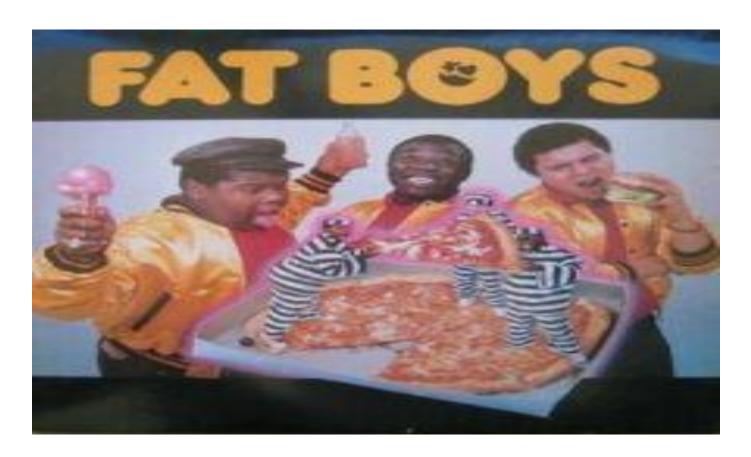


1

- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Statutory Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases



<u>Parodies</u>



Parodies



1

- 1. Statutory Fair Use (a/k/a "classic fair use")
 - Elements of Fair Use defense
 - <u>Lasting Impression</u>
- 2. Nominative Fair Use
- 3. Personal names
- 4. Parodies
- 5. Other Cases



7

Other Cases

- San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee, 483 U.S. 522 (1987) (use of "Olympic" mark).
- International Stamp Art, Inc. v. U.S. Postal Service, 456 F.3d 1270 (11th Cir. 2006) ("fair use" of design for greeting card where greeting card featured postage stamp).

Thank you

David M. Lilenfeld

David@ManningLilenfeld.com

www.ManningLilenfeld.com



<u>Appendix</u>

F.I.R.E. v. fire

■ Far Infrared Energy (F.I.R.E.)

versus

■ FIRE





Personal Names

- Musician with stage name of "Thomas Dolby" would infringe upon trademark "Dolby," process for noise reduction in audio recording, in promoting sound equipment if he used name "Thomas Dolby" without clearly explaining that he was not connected with Dolby laboratories.
- Dolby v. Robertson, N.D.Cal.1986, 654 F.Supp. 815, 1 U.S.P.Q.2d 1041.

