



The “So What” Defense: Fair Use in Trademark Infringement Cases

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Key Takeaways

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

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Statutory Fair Use

Lanham Act

15 U.S.C.A. § 1115(b)(4)



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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.

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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

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543 U.S. 111, 125 S.Ct. 542 (2004).



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Nominative Fair Use

Nominative fair use requires three elements:

1. 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.



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”).



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ERIC TURKEWITZ, THE TURKEWITZ LAW FIRM, NEW YORK, NY

Monday, September 17, 2007

[Car Rental Immunity Law Held Unconstitutional By Federal Judge](#)

Late Friday, a federal judge held that the "Graves Amendment" is unconstitutional. The 2005 federal law abolished vicarious liability of long-term automobile lessors (edit and renters) based solely on ownership. Thus, states such as New York that hold the owners of cars vicariously liable for the negligence of people they permit to drive their cars, saw their state statutes or common law superseded by federal legislation. [One defense firm had written](#) when the law was passed that:

This law is sure to change the landscape of motor vehicle accident litigation throughout the United States.

One of the remarkable things about this landmark piece of legislation was that it was slipped into a 900-page bill in the wee hours



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Personal Names

Dolby

v.

“Thomas Dolby”

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

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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

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Appendix

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.