

# An Open-Access Casebook

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## The Actionable Use Requirement

In order to prove infringement, a plaintiff is required to show that the alleged infringer made an “actionable use” of the plaintiff’s trademark (or of a confusingly-similar approximation of the mark). Specifically, the plaintiff must show that the defendant made a “use in commerce” of the mark “in connection with” goods or services. We saw various statements of this requirement above. See, e.g., *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 152 (4th Cir. 2012) (citations omitted) (“(2) that the defendant used the mark ‘in commerce’ and without plaintiff’s authorization; (3) that the defendant used the mark (or an imitation of it) ‘in connection with the sale, offering for sale, distribution, or advertising’ of goods or services”).

The statutory basis for this requirement is found in Lanham Act § 32 and § 43(a), in the italicized language:

### Lanham Act § 32, 15 U.S.C. § 1114

(1) Any person who shall, without the consent of the registrant (a) *use in commerce* any reproduction, counterfeit, copy, or colorable imitation of a registered mark *in connection with the sale, offering for sale, distribution, or advertising of any goods or services* on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.

### Lanham Act § 43(a), 15 U.S.C. § 1125(a)

(1) Any person who, *on or in connection with any goods or services, or any container for goods, uses in commerce* any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which— (A) is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

In a high proportion of trademark infringement disputes, the plaintiff easily meets the actionable use requirement, and courts often do not even bother mentioning it. But in some cases, the actionable use requirement can be dispositive of the outcome of the dispute. Consider, for example, a defendant who is a political speaker making information freely available online that refers to the plaintiff by its trademark. This defendant is not selling goods or services and so would likely fall outside of the statutory language quoted above. Or consider a defendant who is an artist selling a painting that includes an image of the

plaintiff's trademark but the artist is not using that mark as a designation of source for the painting. Relatedly, consider a newspaper who refers to the plaintiff by the plaintiff's trademark in an editorial critical of the plaintiff. Here, the artist and the newspaper may be able to avoid liability on the basis that they are not making a "trademark use" of the plaintiff's trademark—that is, use of the mark as a designation of source of the defendant's goods.

In circumstances like these, the actionable use requirement allows courts to decide a case without ever having to proceed to the potentially messy, expensive, and fact-intensive issue of whether the defendant's conduct confuses consumers as to source. In other words, if the defendant can prevail on the actionable use issue, it will not need to expend the resources necessary to contend with "(4) that the defendant's use of the mark is likely to confuse consumers." *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 152 (4th Cir. 2012) (citations omitted). The actual use requirement can thus be especially helpful (perhaps even at the motion to dismiss stage) for defendants making artistic, expressive, or political uses of others' trademarks.

We consider below two forms of the actionable use requirement. We turn first to the "in connection with" goods or services requirement, which is sometimes called the "commercial use" requirement. We then turn to a troubled area of trademark doctrine known as the "trademark use" requirement.

## 1. The Commercial Use Requirement

As the following opinion explains, during the early days of the internet courts expanded what qualified as a commercial use by a defendant—that is, what qualified as an actionable use in connection with goods or services under Lanham Act § 32 or § 43(a). They did so in order to enjoin the conduct of clearly bad faith internet defendants. Courts bent the doctrine to reach what they thought was the right result. For example, in *People for Ethical Treatment of Animals, Inc. v. Doughney*, 263 F.3d 359 (4th Cir. 2001), the defendant owned a wide variety of domain names, including many that resembled others' trademarks. He registered peta.org and created a website entitled "People Eating Tasty Animals." The organization People for the Ethical Treatment of Animals sued for trademark infringement. The defendant claimed no use of the mark "in connection with the sale" of goods or services because he sold no goods or services on his website. The Fourth Circuit found such a connection on the ground that the defendant's use interfered with internet users' efforts to reach PETA's website. *Id.* at 365. Furthermore, the defendant's website linked to "more than 30 commercial operations offering goods and services." *Id.* at 366. See also *Planned Parenthood Federation of America, Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313 (S.D.N.Y. 1997), aff'd without opinion, 152 F.3d 920 (2d Cir. 1998) (reasoning similarly with respect to defendant's domain name plannedparenthood.com); *Jews For Jesus v. Brodsky*, 993 F. Supp. 282, 46 U.S.P.Q.2d 1652 (D.N.J. 1998), judgment aff'd, 159 F.3d 1351 (3d Cir.

1998) (reasoning similarly with respect to defendant's domain names *jewsforjesus.org* and *jews-for-jesus.org*).

*Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316 (4th Cir. 2015), finally presented circumstances that forced a retreat from this previous case law's overly expansive, plaintiff-friendly reading of the "in connection with the sale" requirement.

[The opinion in *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People* is available separately.]

### Questions and Comments

1. *The difference in the language of Lanham Act § 32 and § 43(a)*. You may have noticed that the two likelihood of confusion sections formulate the commercial use requirement slightly differently. Compare Lanham Act § 32(1)(a), 15 U.S.C. § 1114(1)(a) (establishing liability for "[a]ny person who shall use in commerce" the plaintiff's mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services" in a manner that is confusing) to Lanham Act § 43(a)(1), 15 U.S.C. § 1125(a)(1) (establishing liability for "[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce" the plaintiff's mark in a manner that is confusing). In practice, courts have read both statements of the commercial use requirement to mean the same thing.

## 2. The "Use as a Mark" Requirement



THE COURIER-JOURNAL  
Chocolate-walnut bourbon pie from Captain's Quarters.

*Bourbon makes this Derby pie a state original*

THE COURIER-JOURNAL

When you're headed on a vacation, the destination is what it's all about. The destination, in this case, is dessert.

This recipe from the The Courier-Journal archive — provided years ago by the fine folks up river at Captain's Quarters — it is a simple — piece of, um, pie.

It doesn't even require that you make your own pie crust.

But don't even think about using Scotch, Tennessee whisky or that stuff from north of the border in this dessert.

**Derby chocolate-walnut pie**

1½ cups sugar  
6 tablespoons flour  
3 eggs, beaten  
½ cup (1½ sticks) butter, melted  
1½ cups chopped walnut pieces  
1½ cups chocolate chips  
1½ ounces bourbon  
10-inch pastry shell

Heat oven to 350 degrees  
Combine sugar with flour. Beat eggs. Add to sugar mixture. Melt butter. Slowly add to sugar mixture so as not to cook eggs. Add walnut pieces, chocolate chips and bourbon. Stir to combine.  
Pour into unbaked pastry shell. Bake for about 50 minutes. Pie crust will be golden brown.

*Makes 1 10-inch pie*

We now briefly turn to a considerably more unsettled—and in the view of some, incoherent—area of actionable use doctrine known as the “trademark use” or “use as a mark” requirement. The Sixth Circuit is the only circuit that has consistently applied this requirement. See *Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853 (6th Cir. 2018); MCCARTHY § 23:11.50. Other circuits have explicitly rejected it. See, e.g., *Kelly-Brown v. Winfrey*, 717 F.3d 295, 308 (2d Cir. 2013). The leading treatise on trademark law and leading trademark commentators strongly criticize the doctrine. See MCCARTHY § 23:11.50. (“The Sixth Circuit’s eccentric and peculiar view is erroneous. It has no support in either the Lanham Act or in precedent.”); Graeme Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007) (criticizing the doctrine); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773 (2009) (same). But it is necessary to be familiar with the doctrine because, as discussed below, the Supreme Court recently relied heavily on it in *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023), and the Court further committed itself to the doctrine in *Abitron Austria GmbH v. Hetronic International, Inc.*, 143 S.Ct. 2522 (2023).

According to “use as a mark” doctrine, to prove infringement, the plaintiff must show as a threshold matter that the defendant is using the accused designation “as a trademark,” that is, as a designation of source of the defendant’s goods or services. See Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 Hous. L. REV. 777 (2004). Thus, for example, in *Rupp v. Courier Journal, Inc.*, No. 18 Civ. 277, 2020 WL 1310491 (W.D. Ky. Mar. 19, 2020), the plaintiff owned the mark DERBY-PIE for chocolate nut pies. The defendant newspaper used the term “Derby pie” in the title of a recipe for chocolate-walnut pies, as shown above. The newspaper moved for dismissal of the plaintiff’s claim of trademark infringement on the ground that the newspaper did not use the term as a designation of source for its own goods or services. The court granted the motion, finding that “the Complaint fails to plausibly establish that Defendant used Plaintiff’s Mark in any other way than a non-trademark one.” *Id.* at \*3. See also *Rigsby v. GoDaddy Inc.*, 59 F.4th 998, 1005 (9th Cir. 2023) (in case in which defendant domain name registrar transferred plaintiff’s lapsed domain name to a third party, granting motion to dismiss trademark infringement claim on ground that plaintiff “has not adequately alleged that {defendant} ‘used’ his mark, let alone ‘in commerce,’ sufficient to state a claim under § 1125(a)’’); *Naked Cowboy v. CBS*, 844 F. Supp. 2d 510, 515 (S.D.N.Y. 2012) (granting defendant’s motion to dismiss in part on the ground that defendant’s references to Times Square’s Naked Cowboy in connection with soap opera *The Bold and the Beautiful* did not constitute “use in commerce” as defined in § 45); *id.* at 515 (“None of the contents of the Episode could have violated Plaintiff’s trademark rights because the word mark ‘Naked Cowboy’ does not appear anywhere in it. Similarly, inclusion of ‘naked’ and ‘cowboy’ as separate tags associated with the YouTube video clips is not ‘use’ of Plaintiff’s word mark ‘Naked Cowboy.’”).

In theory, the use as a mark requirement is separate from the requirement that the plaintiff also show that the defendant's accused use is likely to confuse consumers as to the source of the defendant's goods or services. As the Sixth Circuit has explained:

In our circuit, plaintiffs carry a threshold burden to show that the defendant is using a mark "in a '[ ]trademark' way" that "identifies the source of their goods." *Interactive Prods. Corp. v. a2z Mobile Office Sols., Inc.*, 326 F.3d 687, 695 (6th Cir. 2003); see *Grubbs v. Sheakley Grp., Inc.*, 807 F.3d 785, 793–94 (6th Cir. 2015); *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 610–12 (6th Cir. 2009). Otherwise the "trademark infringement and false designation of origin laws do not apply." *Interactive Prods. Corp.*, 326 F.3d at 695. Only if the plaintiff clears this threshold test do we proceed to the conventional likelihood-of-confusion analysis and fair use defense, among other defenses.

*Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853, 859 (6th Cir. 2018). On this reasoning, if the plaintiff is unable to prove that the defendant's accused use constitutes a "use as a mark" for its own goods or services, then that would decide the case. There would thus be no need to move on to the often more difficult, unpredictable, and costly-to-litigate question of whether that use is likely to confuse consumers. As in *Rupp v. Courier Journal*, courts and defendants could utilize the use as a mark requirement to quickly dispense with especially dumb claims of infringement.

For its advocates, the statutory basis for the use as a mark requirement is found in Lanham Act § 32(1), 15 U.S.C. § 1114(1), ("Any person who shall . . . use in commerce"), and in Lanham Act § 43(a)(1), 15 U.S.C. § 1125(a)(1), ("Any person who . . . uses in commerce"). As we saw above, the Lanham Act defines "use in commerce" in Lanham Act § 45, 15 U.S.C. § 1127:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

For advocates of the use as a mark requirement, a defendant can be held liable only if its conduct satisfies the terms of the Lanham Act § 45 definition of “use in commerce.” See, e.g., *Naked Cowboy*, 844 F. Supp. 2d at 515 (“The purchase from YouTube of adword advertising for the term ‘naked cowboy’ likewise does not constitute ‘use in commerce’ because Defendants did not place [the ‘naked cowboy’ term] on any goods or containers or displays or associated documents, nor do they use them in any way to indicate source or sponsorship.” (citation omitted)).

Critics of use as a mark doctrine have identified significant problems with it. First, they argue that there is in fact no statutory basis for it. In their view, the § 45 definition of “use in commerce” describes the kind of “use in commerce” necessary to *establish* trademark rights rather than the kind of “use in commerce” necessary to *infringe* those rights. Cf. *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 134–39 (2d Cir. 2009) (reviewing the legislative history of the Lanham Act to determine that “Congress did not intend that this definition apply to the sections of the Lanham Act which define infringing conduct,” but nevertheless expressing doubt as to whether at least part of the definition should apply to defendants’ conduct). Second, if the § 45 definition of “use in commerce” applies to defendants’ conduct, then defendants could escape liability by avoiding the conduct described in the definition, for example, by using the accused mark in advertising but not placing the mark on its goods. See *Rescuecom*, 562 F.3d at 139 (“It is easy to imagine perniciously confusing conduct involving another’s mark which does not involve placement of the mark in the manner specified in the definition.”). See also *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74, 95 (2d Cir. 2020) (“Terms not used as a mark may still generate confusion as to ‘affiliation, connection, . . . association[,] . . . sponsorship or approval,’ § 1125(a)(1)(A), and therefore constitute trademark infringement.”). Third and more fundamentally, to determine if a defendant’s use qualifies as a “use as a mark,” a court must ask: do consumers perceive the defendant’s use as a designation of the source of the defendant’s goods? But this question comes very close to the question of whether consumers are confused as to source by the defendant’s use. The “use as a mark” test purports to be a threshold requirement prior to the fact-intensive confusion inquiry, but in operation, it typically simply begs the question of whether consumers are confused. See McKenna, *Trademark Use and the Problem of Source*, at 777 (“[P]recisely because trademark use is not separable from consumer understanding, proponents cannot articulate the doctrine without lapsing into claims about likelihood of confusion”).

Because of these and other problems with the use as a mark requirement, the doctrine appeared to have fallen into disfavor in recent years and, outside of the Sixth Circuit, it was appearing less and less in recent case law. Then came two Supreme Court cases, *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023), and *Abitron GmbH v. Hetronic International, Inc.*, 143 S.Ct. 2522 (2023), which have given new life to use as a mark doctrine.

We will devote substantial attention to *Jack Daniel's* in Class 24, but it is enough to explain here that in *Jack Daniel's* VIP produced a dog toy mimicking the shape and appearance of a Jack Daniel's whiskey bottle. Jack Daniel's sent a cease-and-desist letter. VIP then sued for a declaratory judgment of non-infringement. VIP argued that its conduct should be analyzed under the *Rogers v. Grimaldi* test, which, as we will see, is an extremely parodist-friendly test for whether an expressive use of a mark is infringing. The Supreme Court held otherwise. It reasoned that “the *Rogers* test has applied only to cases involving ‘non-trademark uses’—or otherwise said, cases in which ‘the defendant has used the mark’ at issue in a ‘non-source-identifying way.’” *Jack Daniel's*, 590 U.S. at 155 (citation omitted). The problem for VIP was that in its complaint seeking declaratory judgment it had asserted trademark rights in the appearance of its dog toy. *Id.* at 150. More generally, *Jack Daniel's* now stands for the proposition that for a defendant to benefit from the *Rogers v. Grimaldi* test, the defendant must not be using the accused expression “as a mark.” As explained below, the “use as a mark” inquiry has now come to play a central role in trademark infringement litigation over unauthorized expressive uses of marks.

*Abitron* then followed *Jack Daniel's*. *Abitron* held that the main infringement sections of the Lanham Act (§§ 32(1)(a) & 43(a)(1)) do not apply extraterritorially. In the opinion for the Court, Justice Alito read the Lanham Act § 45 definition of “use in commerce” to apply to the type of conduct necessary to *infringe* trademark rights. (Recall that this was the definition that most lower courts had recognized applied only to the type of conduct necessary to *establish* trademark rights.) Thus, *Abitron* now apparently stands for the proposition that for a defendant to be liable for trademark infringement, its conduct must fulfill the various requirements built in to the definition of “use in commerce” quoted above—including apparently that it be making a “bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”

It is not clear that the Court in *Jack Daniel's* or *Abitron* was aware of all the past controversy that has swirled around the doctrines it was resuscitating. Cf. *Lerner & Rowe PC v. Brown Engstrand & Shely LLC*, 119 F.4th 711, 727 (9th Cir. 2024) (Desai, J., concurring) (fully aware of the past controversy but urging the Ninth Circuit “to reconsider whether keyword bidding and purchasing constitutes a ‘use in commerce’ under the Lanham Act. Our binding precedent says it does, *Network Automation, Inc. v. Advanced Systems Concepts, Inc.*, 638 F.3d 1137, 1144–45 (9th Cir. 2011), but I am not convinced that we got it right or that our holding withstands the test of time and recent advancements in technology.”).

In conclusion: first, lest the student lose hope, it is worth remembering that in the vast majority of trademark cases, it is obvious that the defendant is making a “use as a mark” of its accused designation, so the “use as a mark” doctrine plays no significant role and typically is not even referenced. But second, in a small subset of fact patterns—Involving, for example, parodic or other expressive uses, keyword advertising, uses in computer code,

and uses outside of the United States—“use as a mark” or “use in commerce” doctrine may play a role. In these situations, the defendant may seek to show that its conduct is a “non-trademark use” or does not constitute “use in commerce” as that term is defined in Lanham Act § 45.

### **Questions and Comments**

1. The leading advocates of the use as a mark requirement are Professors Stacey Dogan and Mark Lemley. They argue that the doctrine serves a crucial limiting function:

The speech-oriented objectives of the trademark use doctrine protect more than just intermediaries; they prevent trademark holders from asserting a generalized right to control language, an interest that applies equally—and sometimes especially—when the speaker competes directly with the trademark holder. The trademark use doctrine has broad application—because of it, newspapers aren’t liable for using a trademarked term in a headline, even if the use is confusing or misleading. Writers of movies and books aren’t liable for using trademarked goods in their stories. Makers of telephone directories aren’t liable for putting all the ads for taxi services together on the same page. Marketing surveyors aren’t liable for asking people what they think of a competitor’s brand-name product. Magazines aren’t liable for selling advertisements that relate to the content of their special issues, even when that content involves trademark owners. Gas stations and restaurants aren’t liable for locating across the street from an established competitor, trading on the attraction the established company has created or benefiting from the size of the sign the established company has put up. Individuals aren’t liable for their use of a trademark in conversation, even in an inaccurate or misleading way (referring to a Puffs brand facial tissue as a “Kleenex,” or a competing cola as a “Coke,” for example). Generic drug manufacturers aren’t liable for placing their drugs near their brand-name equivalents on drug store shelves, and the stores aren’t liable for accepting the placement. They may be making money from their “uses” of the trademark, and the uses may be ones the trademark owner objects to, but they are not *trademark* uses and therefore are not within the ambit of the statute.

Dogan & Lemley, *Trademarks and Consumer Search Costs*, *supra*, at 809. What is your intuition as to what drives non-liability in the scenarios Dogan & Lemley set out? Are the potential defendants not liable because, as a formal matter, they do not use the mark “as a mark” or because, as an empirical matter, their use would simply not cause confusion as to source?