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Barton Beebe
John M. Desmarais Professor of Intellectual Property Law
New York University School of Law

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Defenses to Trademark Infringement and Related Limitations on Trademark Rights

Trademark rights are subject to a number of limitations. Certain of these take the form of affirmative defenses on which the defendant bears the ultimate burden of persuasion. For example, even if a court finds that a defendant is causing a likelihood of confusion, the defendant may escape liability if it can show by a preponderance of the evidence that it was engaging in descriptive fair use (described below) or that the plaintiff has abandoned its mark (recall this from Class 2).

Other limitations on trademark rights are implemented through modifications to the likelihood of confusion test that tend to shield the defendant from liability. For example, if the defendant's conduct qualifies as a nominative fair use (Class 22) or an expressive use such as a parody (Class 23), a court may add additional, defendant-friendly factors to the standard multifactor test for the likelihood of consumer confusion or replace the multifactor test outright with an alternative test. Though trademark lawyers may speak loosely of these doctrines as "defenses," they are not true affirmative defenses. Instead they are modifications of the test for infringement. In such situations, the plaintiff typically continues to bear the ultimate burden of persuasion on the question of whether the defendant has infringed the plaintiff's mark.

Descriptive Fair Use

In a typical descriptive fair use situation, the plaintiff uses a term as a trademark (e.g., SWEETARTS for candy) that the defendant also uses merely to describe its own goods (e.g., "sweet-tart" to describe the taste of OCEAN SPRAY cranberry juice). See *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055 (7th Cir. 1995) (finding defendant's descriptive, non-trademark use of the term "sweet-tart" to be a descriptive fair use); *Sorensen v. WD-40 Co.*, 792 F.3d 712, 722 (7th Cir. 2015) ("The hypothetical producer of 'Crunchy' brand potato chips, for example, cannot block its competitors from describing their chips as crunchy. It may, though, be able to block its competitors from selling chips that are branded 'Crunchy.'"). The affirmative defense of descriptive fair use (sometimes called "classic" fair use) is based on Lanham Act §§ 33(b)(4), 15 U.S.C. § 1115(b)(4), which establishes a defense to trademark infringement on the ground:

- (4) 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;

We begin our review of descriptive fair use with *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004). *KP Permanent* does not apparently set forth any specific test that the circuits should apply to adjudicate a descriptive fair use claim. The opinion is included here primarily because of the importance of the Court's clear holding that in analyzing descriptive fair use, a court may find the defendant's conduct to be a descriptive fair use even if that conduct causes some degree of consumer confusion as to source.

We then turn to the basic three-step test that most courts apply to evaluate a claim of descriptive fair use.

1. Descriptive Fair Use and Consumer Confusion

In *KP Permanent*, the declaratory plaintiff KP Permanent Make-Up, Inc. used the term “microcolor” in advertisements for its “permanent makeup” (shown below on the right). The defendant had previously registered the trademark MICRO COLORS at the PTO (on the left). In the excerpt that follows, the Supreme Court finally overruled the Ninth Circuit’s bizarre doctrine that any likelihood of consumer confusion defeats a defense of descriptive fair use.

[The opinion in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.* is available separately.]

2. The Three-Step Test for Descriptive Fair Use

In your view, was summary judgment appropriate in both of the following cases?

[The opinion in *Solid 21, Inc. v. Breitling U.S.A., Inc.* is available separately.]

[The opinion in *SportFuel, Inc. v. Pepsico, Inc.* is available separately.]

3. Further Examples of Descriptive Fair Use Analyses

[The opinion in *International Stamp Art v. U.S. Postal Service* is available separately.]

[The opinion in *Bell v. Harley Davidson Motor Co.* is available separately.]

[The opinion in *Fortune Dynamic, Inc. v. Victoria's Secret* is available separately.]