

# Trademark Law

Prof. Madison

**Today: Descriptive fair use**

**Key concepts from Class 15:**

Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

Forward confusion and reverse confusion.

Sources of evidence.

Intersections between trademark and copyright: *Dastar*.

### **The plaintiff alleges (the prima facie case):**

1. Trademark validity (distinctiveness)
2. Trademark ownership (use by the owner, and priority)
3. Infringing acts (use by the accused infringer, and likelihood of confusion)
4. Harm (confusion? loss of goodwill?) (The necessary harm may consist of likelihood of confusion itself!)

### **The defendant counters (in addition to contesting 1-4 above):**

The affirmative defense of fair use of the plaintiff's mark.

### Flavors of Trademark Fair Use:

- 1. “Classic” Fair Use** (unlike fair use in copyright): the defendant/accused infringer uses the mark owner’s mark to refer to the *deft’s* own product or service.
- 2. (New / relatively well-established) Nominative Use:** the *deft/accused* infringer refers to the *mark owner’s* product or service
- 3. (New / unclear standards) First Amendment / Parody:** referring to something else entirely (or nothing at all) (perhaps combined with (1) or (2))

### Recall different public policies behind trademark protection & infringement:

- [1] Protect mark owner's goodwill from appropriation and/or free-riding (*the unfair competition rationale*). Consumer confusion is evidence of mis-appropriation.
- [2] Protect consumers themselves (from inaccurate / misleading information) (*the protect consumer interests in quality and source rationale*; “search costs” reduction is part of this). Consumer confusion may be a harm in itself.

**Do the defenses reflect failure of the *prima facie* case (no likelihood of confusion), or independent interests in free competition, consumer information, and/or free speech?**

### Trademark (“Classic” or “Descriptive”) Fair Use:

Lanham Act Section 1115(b)(4) ((33(b)(4)):

“That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, ... 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.”

The mark is used (i) other than as a mark, (ii) descriptively (and accurately) with respect to the goods or services or geographic origin of the goods or services of the defendant, *and* (iii) in good faith.

Usually refers to use of a descriptive mark for its primary meaning rather than its secondary meaning.

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*Ex: A cereal manufacturer sells a product that consists entirely of bran and uses the phrase “all bran” to advertise the product. That may be fair use and therefore noninfringing despite the rights of Kellogg in the mark “All Bran” for cereal.*

Nb.: Could the accused infringer have chosen a different mark or design? Do other considerations suggest a lack of consumer confusion?

The fair use defense may be proved even if the defendant has not negated the elements of a claim for infringement. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.* (US 2004). **In other words: some measure of confusion is compatible with noninfringing fair use.**





IN-HOUSE

MEN'S GOLD WATCH - AIRE  
CAPITOL HILL WATCH SWISS  
MADE 18 KARAT SOLID  
GOLD POWER RESERVE

LUXURY RARE WATCH - RED  
GOLD®

\$ 48,000.00

The Aire Capitol Hill Watch is an extraordinary timepiece with a very limited production of only ten pieces.

Features:

- 18 karat amber hue gold
- Sapphire crystal exhibition case back
- Black enamel dial
- Black crocodile leather strap
- Soprod Self-winding power reserve
- Anti-glare, scratch-resistant sapphire crystal face
- Water-resistant up to 30 meters

Solid 21, Inc. v.  
Breitling U.S.A., Inc.  
(2d Cir. 2024)

Plaintiff's watch: \$48,000

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US ENGLISH +1 203-456-2458

BREITLING  
1884

140  
YEARS  
OF FIRSTS



COLLECTIONS WATCHES STRAPS SERVICES STORES ABOUT 140 YEARS

## THE STORY

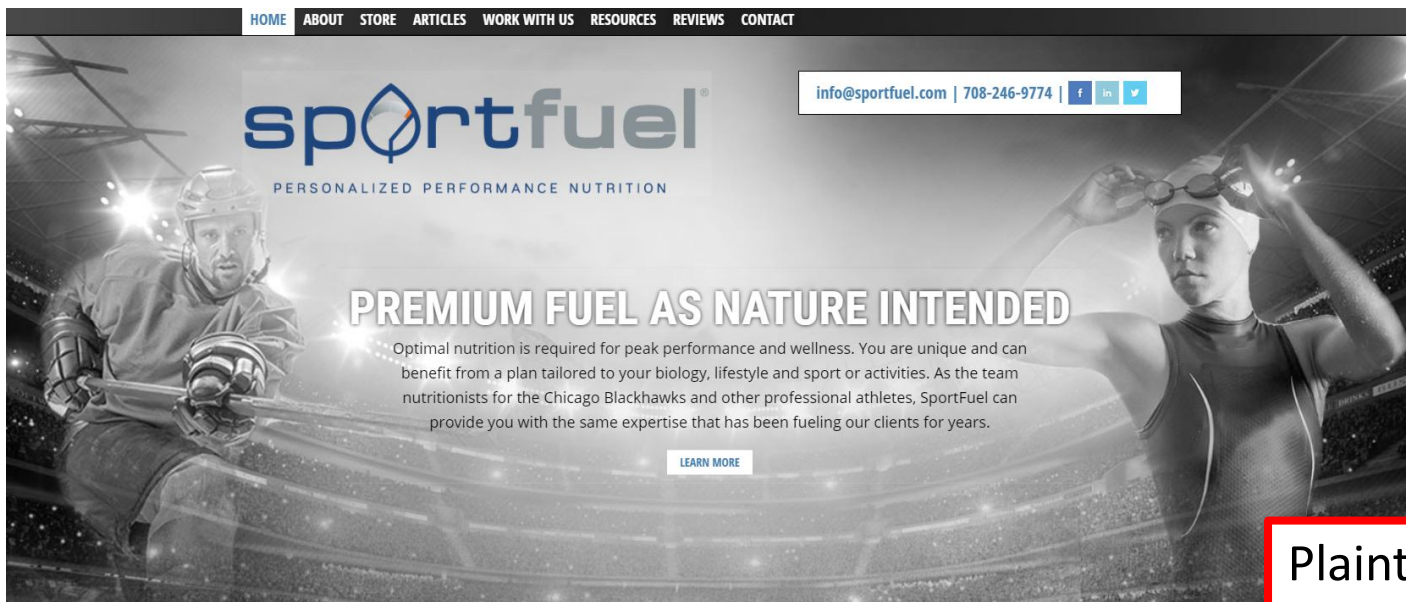
Breitling's all-purpose watch for your every pursuit. The Chronomat holds a significant place in Breitling's history. Introduced in 1984, at a time where extra-thin quartz timepieces were the order of the day, Breitling placed a bold bet on an impressively proportioned mechanical watch. Based on the Freccie Tricolori chronograph, which had been developed and launched in 1983 in collaboration with the famed Italian aerial squadron, the Chronomat celebrated Breitling's centenary in style and marked the return of the mechanical chronograph to its rightfully prominent place at the brand which had built its global reputation on these incredible watches. Available in a variety of materials from stainless steel to luxurious 18 k red gold, the Chronomat features a 42 mm case and the iconic bezel with the four rider tabs. Available in a range of colorful dials, the Chronomat is matched to the signature "Rouleaux" bracelet in metal or rubber and is powered by the in-house Breitling Manufacture Caliber 01, a COSC-certified chronometer.



Solid 21, Inc. v.  
Breitling U.S.A., Inc.  
(2d Cir. 2024)

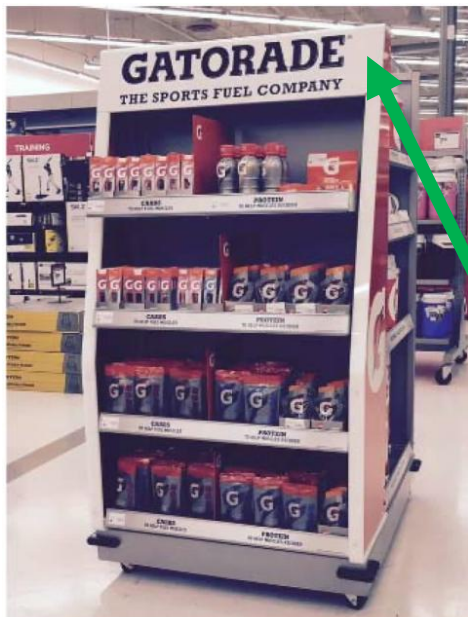
Defendant's watch:  
\$10,500





Plaintiff

Defendant



**“House mark”**



**SportFuel, Inc. v. PepsiCo, Inc. (7<sup>th</sup> Cir. 2019) (summary judgment!)**

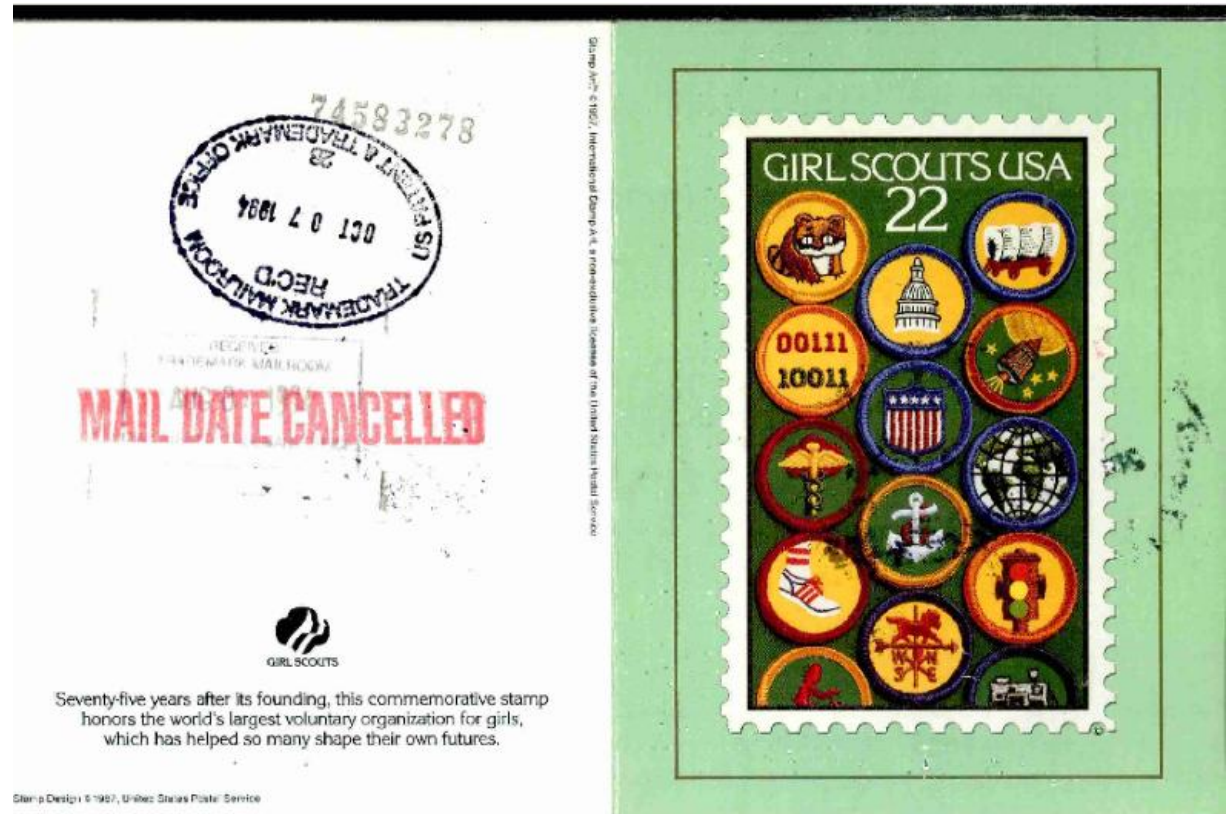
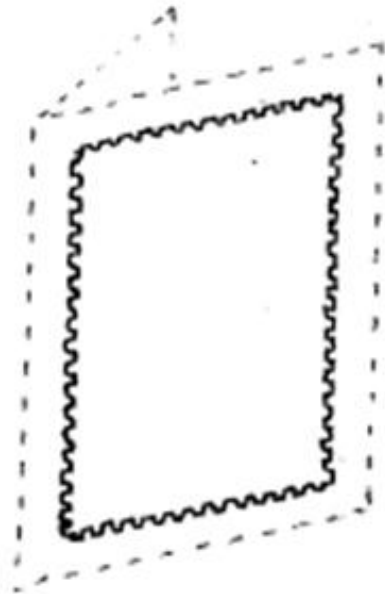
## Trademark Law

RIDE  
HARD

*Ride  
Hard*



Bell v. Harley Davidson Motor Co. (S.D. Cal. 2008)

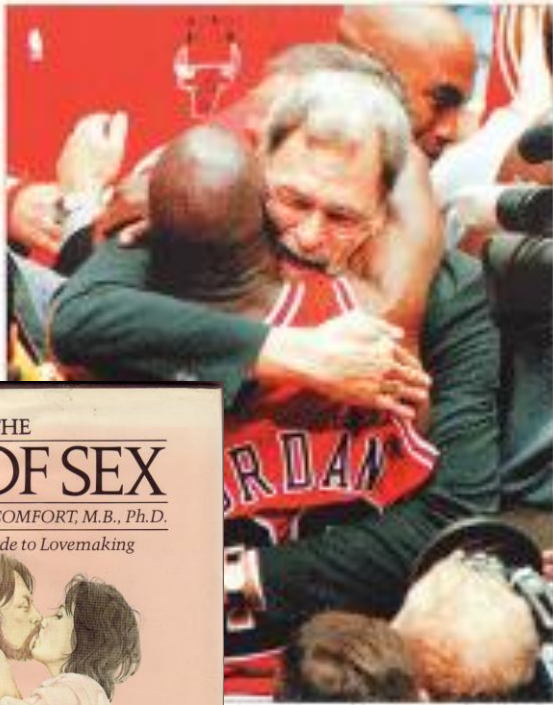


# International Stamp Art, Inc. v. United States Postal Service (11<sup>th</sup> Cir. 2006)





**THE DYNASTY**  
Awesome run appears to be on last legs  
By Mike McCarthy  
Chicago Bulls beat the odds



**BUILT BY, BACK BY**  
Jordan  
seizes title  
with late heroics

By Mike McCarthy  
Chicago Bulls beat the odds

After a season of ups and downs, the Chicago Bulls have won the NBA championship for the second time in three years. Michael Jordan, the team's star player, led the team to victory with his late heroics in the final game.

**Chicago Bulls**  
The Bulls have won the NBA championship for the second time in three years. Michael Jordan, the team's star player, led the team to victory with his late heroics in the final game.

## GOP wooing Main St., not Wall St.

With its party emphasis, supporting big business.

By Mike McCarthy

The Republican Party is wooing Main Street, not Wall Street. The party's new platform, which emphasizes big business and big government, is a clear signal that the party is looking for a new direction.



Packman v. Chicago Tribune Co.  
(7<sup>th</sup> Cir. 2001)



# THE END



MADE IN HOLLYWOOD, U. S. A.

BY

*Metro-Goldwyn-Mayer*