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Supreme Court Rules On Trademark Fair Use

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A CASE OF LASTING IMPRESSION: SUPREME COURT RULES ON TRADEMARK FAIR USE

By David R. Ellis, Attorney at Law Largo, Florida

On December 8, 2004, the U.S. Supreme Court issued a ruling interpreting the fair use defense in trademark cases. The case was a suit brought by a company that sells permanent makeup against a competitor for a declaratory judgment of no trademark infringement in connection with its use of the term "micro color." The Court ruled that the use of the term was a fair use, and that the finding of fair use removed any need to discuss the likelihood of confusion. KP Permanent Make-Up, Inc. v. Lasting Impression, Inc., U.S., No. 03-409.

In its decision, the Court ruled that a party raising the statutory affirmative defense of fair use to a claim of trademark infringement does not have the burden of negating any likelihood that the practice complained of will confuse consumers about the origin of the goods or services affected. Under Section 33(b) of the U.S. Trademark (Lanham) Act, 15 U.S.C. §1115(b), "fair use" is a defense to a suit by the owner of a registered trademark, where the defendant can show that it has used the plaintiff's mark in a non-trademark, descriptive sense to describe the defendant's own goods or services. This is called "classic fair use"; another kind is "nominative fair use," where a defendant uses the plaintiff's mark to identify plaintiff's, rather than defendant's, goods and services.

The case was a dispute between two companies that sell permanent makeup, a mixture of pigment and liquid for injection under the skin to camouflage injuries and modify nature's dispensations, and each used versions of the term "micro color" (singular or plural) in marketing and selling its product. KP Permanent Make-Up claimed to have used a singular version since around 1990 or 1991 on advertising flyers and pigment bottles. However, Lasting Impression registered the trademark "Micro Colors" with a distinctive design with the United States Patent and Trademark Office in 1993, and in 1999 the registration became "incontestable" under the provisions of the Trademark Act, Section 15, 15 U.S.C. §1065.

Under Section 33(b), an incontestable registration is conclusive evidence of the registrant's exclusive right to use its registered mark. In order to prevail in an infringement suit, the registrant must show that the defendant's unauthorized use of its trademark is "likely to cause confusion, or to cause mistake, or to deceive" consumers about the origin of the goods or services in question. Thus, a plaintiff claiming infringement of an incontestable mark must show a likelihood of consumer confusion as part of its prima facie case. However, the defendant is entitled to raise the defense that its use of the term is a fair use, that is, that its use of the term "is descriptive of and used fairly and in good faith only to describe the goods or services." Section 33(b)(4).

In an opinion by Justice Souter, the Court said that some possibility of consumer confusion is compatible with fair use, in that the Lanham Act was not meant to deprive commercial speakers of using descriptive words. However, he declined to go further in this case to find confusion irrelevant to fair use determinations. Justice Souter said that the fact that fair use can occur along with some degree of confusion means that a determination of whether there is consumer confusion may be relevant to assessing whether the term used is descriptive or the defendant's use is objectively fair.

In conclusion, the Court said that a plaintiff claiming infringement of an incontestable mark must show likelihood of consumer confusion as part of its prima facie case, while the defendant has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith. The Court thus reversed the ruling of the U.S. Court of Appeals for the Ninth Circuit that trademark fair use requires a consideration of likelihood of confusion, and remanded the case to the appellate court.

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