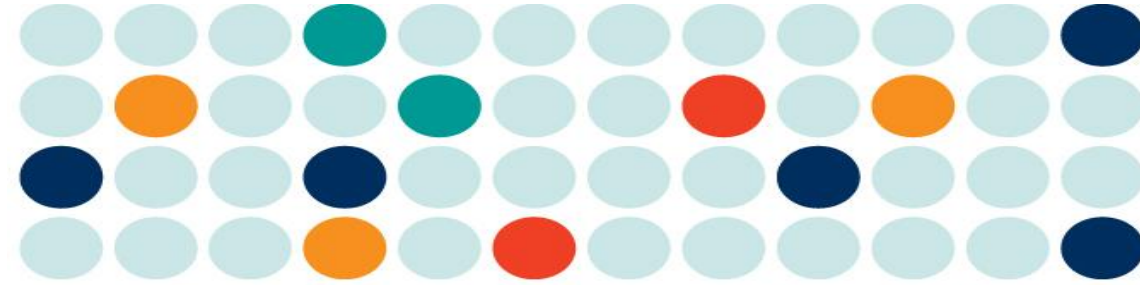


DRAWING THE LINE BETWEEN TRADEMARK USE AND FAIR USE IN THE CONTEXT OF STYLE AND PRODUCT NAMES



STATUTORY BACKGROUND



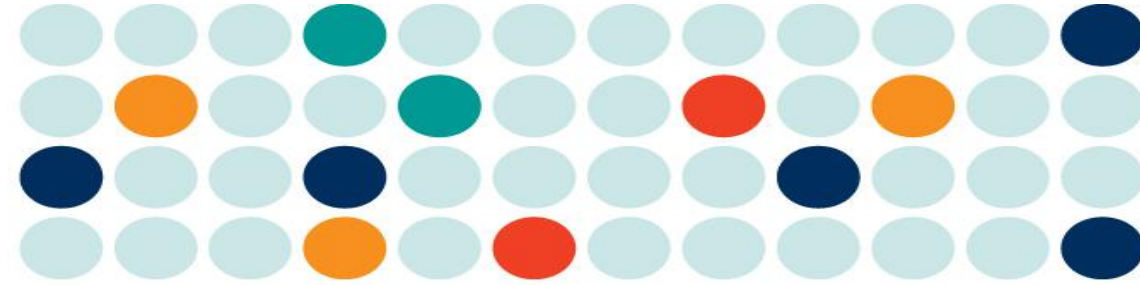
The Lanham Act protects “any word, name, symbol, or device, or any combination thereof” that a person or business uses in commerce **to distinguish** their product or service from others” (“Mark”).

“Distinguish” = Distinctiveness

Descriptiveness = Secondary Meaning

15 U.S.C. § 1127

TRADEMARK INFRINGEMENT

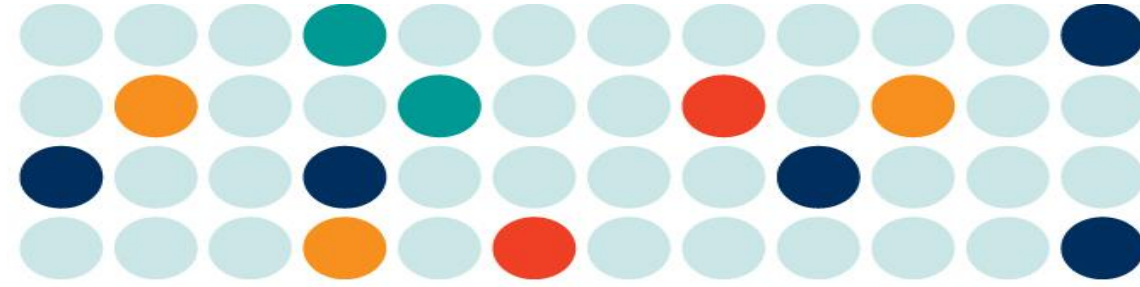


Likelihood of Confusion

The Act protects against any third party “reproduction, counterfeit, copy, or colorable imitation” in order to sell or advertise goods or services, and which “is likely to cause confusion, or to cause mistake, or to deceive”

15 U.S.C. § 1114

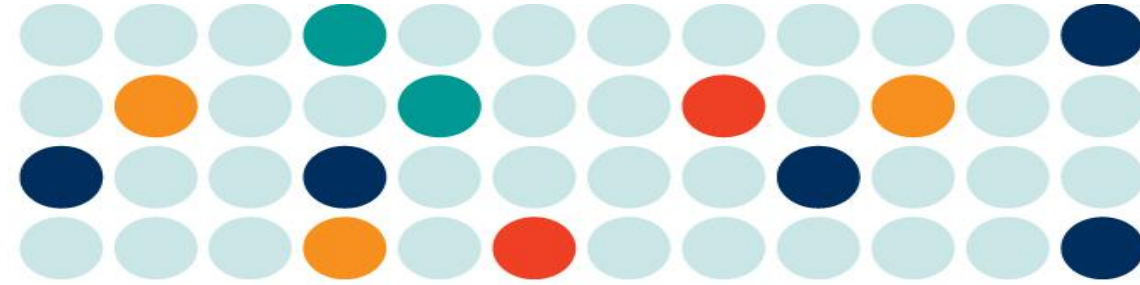
LIKELIHOOD OF CONFUSION FACTORS



- Strength of the mark
- Similarity of the marks
- Channels of trade/ target audience
- Similarity of products or services
- Actual Confusion
- Consumer Sophistication
- Intent

Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961)

DEFENSES: THE DOCTRINE OF FAIR USE



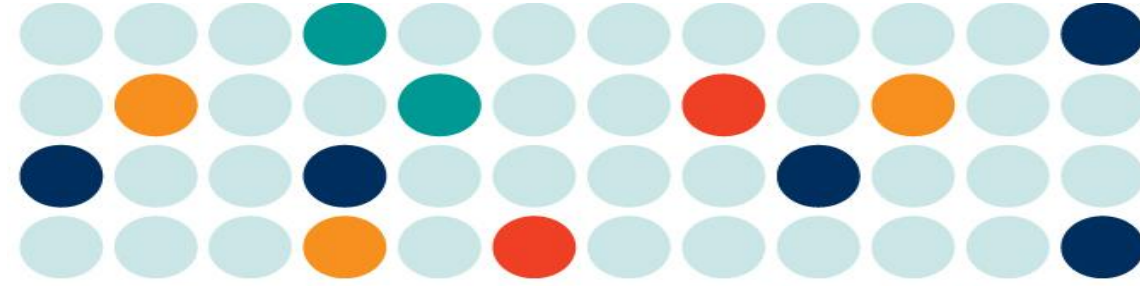
“Classic fair use defense protects the rights of society at large to use words or images in *their primary descriptive sense.*”

A “use other than as a mark” which describes a:

- place
- person
- thing

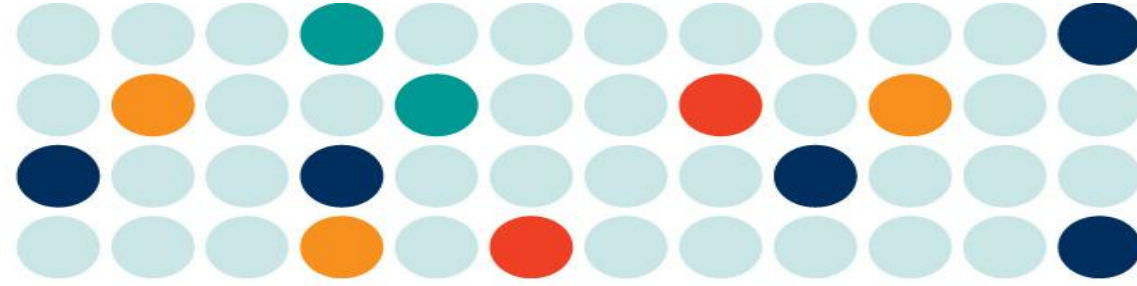
15 U.S.C. § 1115(b)(4)

DESCRIPTIVE FAIR USE EXAMPLES



- SEALED WITH A KISS v. “seal it with a kiss”
- SWEET TARTS v. “sweet tart” Cranberry Juice
 - HYGRADE v. “high grade food stores”

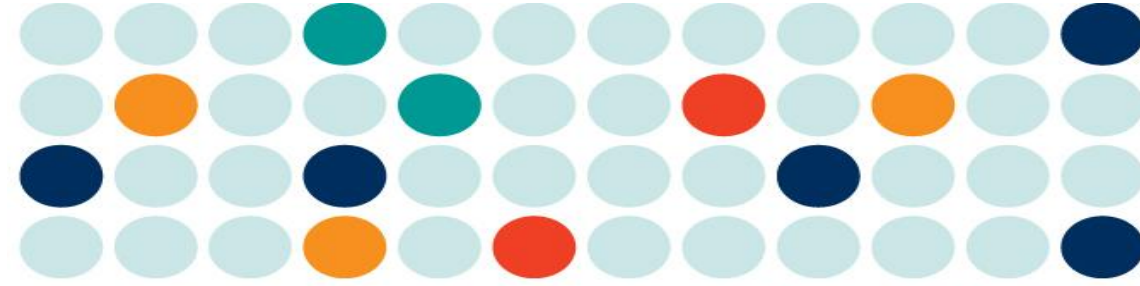
DESCRIPTIVE FAIR USE PER SCOTUS



- An Affirmative Defense to Infringement
- A Defendant not have a burden to negate any likelihood that the practice complained of will confuse consumers
- “Some Degree of confusion is compatible with fair use”-- it is an assumption of risk by the owner of a descriptive mark

KP Permanent Make-Up, 543 U.S. at 123.

DESCRIPTIVE FAIR USE RATIONALE

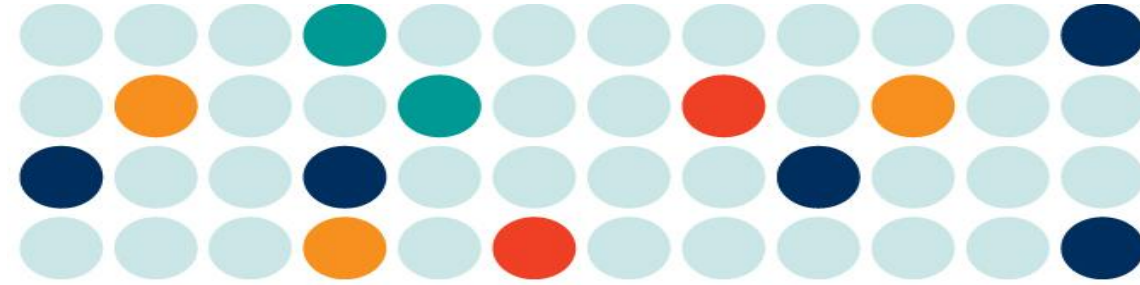


- “A mark owner has no legal claim to the primary descriptive meaning of the term used as a Mark.”
- Descriptive Marks have two meanings: Primary and Secondary
- “Protects the right of society at large to use words or images in their primary descriptive sense, as against the claims of a trademark owner to exclusivity.”

KP Permanent Make-Up, 543 U.S. at 122.

Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 269 (2d Cir. 1995)

WHAT IS DESCRIPTIVE



- “Used fairly” means only “describe the goods accurately”
- “The original, descriptive primary meaning”
- 9th Cir: Scope of Fair Use Defense varies with the degree of “Descriptive Purity” (question of fact whether DELICIOUS on garments conveyed “I’m delicious” in a fair use descriptive sense)
- 2nd Cir: Fair use is not a defense to Infringement of a Suggestive Mark

KP Permanent Make-Up, 543 U.S. at 123.

Id.

Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Management, Inc., 618 F.3d 1025 (9th Cir. 2010)

Cullman Ventures, Inc. v. Columbian Art Works, Inc., 717 F. Supp. 96 (S.D.N.Y. 1989)

WHAT IS FAIR?

He took up two spaces but bought two tickets:



Hard Candy, LLC v. Anastasia Beverly Hills, Inc., 921 F.3d 1343 (11th Cir. 2019)



V.



HARD CANDY v. ANASTASIA

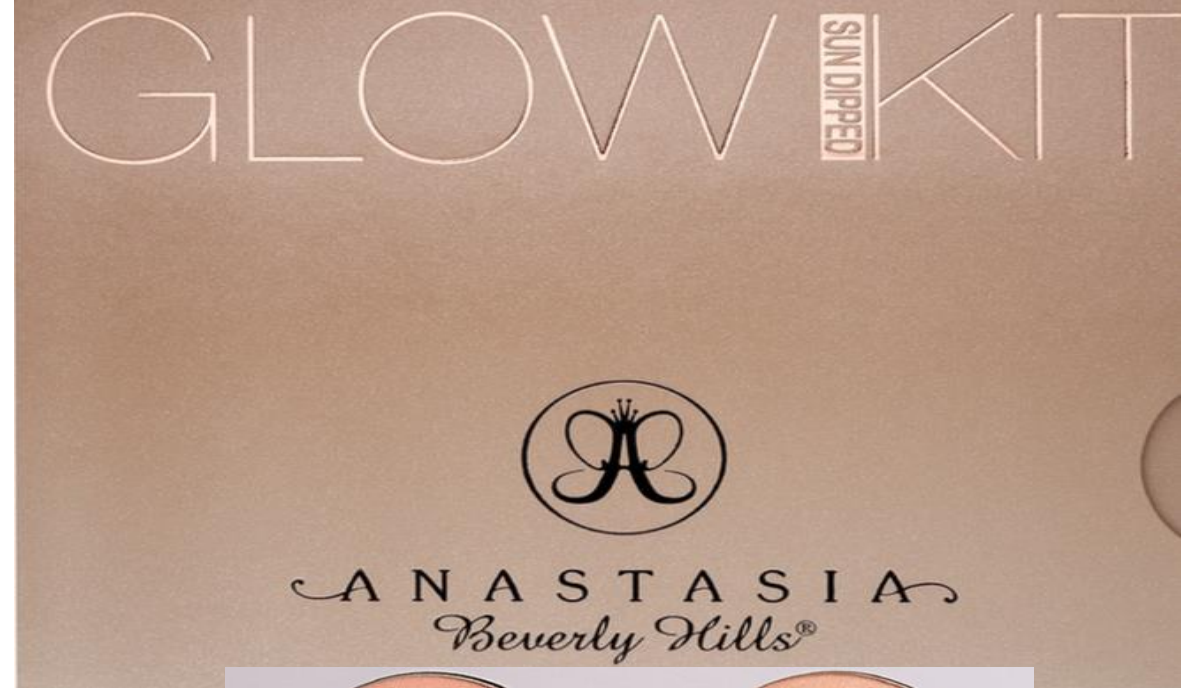
FACTS

- HC has 14 incontestable trademark registrations with an earliest date of first use of HARD CANDY on cosmetics of 1995
- Only sold in Wal-Mart stores and its website as of the date of the litigation
- Women: 18-35
- Ad: trade shows, social, print
- Its HARD CANDY mark is prominently featured not just on packaging but also on the makeup products themselves, including Palettes



HARD CANDY v. ANASTASIA **FACTS**

- Anastasia commenced use of HARD CANDY in 2015
- Uses HARD CANDY on the product itself, the marketing materials and social media posts
- Sold in retail stores and online at a slightly higher price point than HC's goods
- Women 18-40
- Ad: trade shows, social and print
- “Hard Candy” ‘shimmery light orange color;’ the kind of candy her grandmother kept

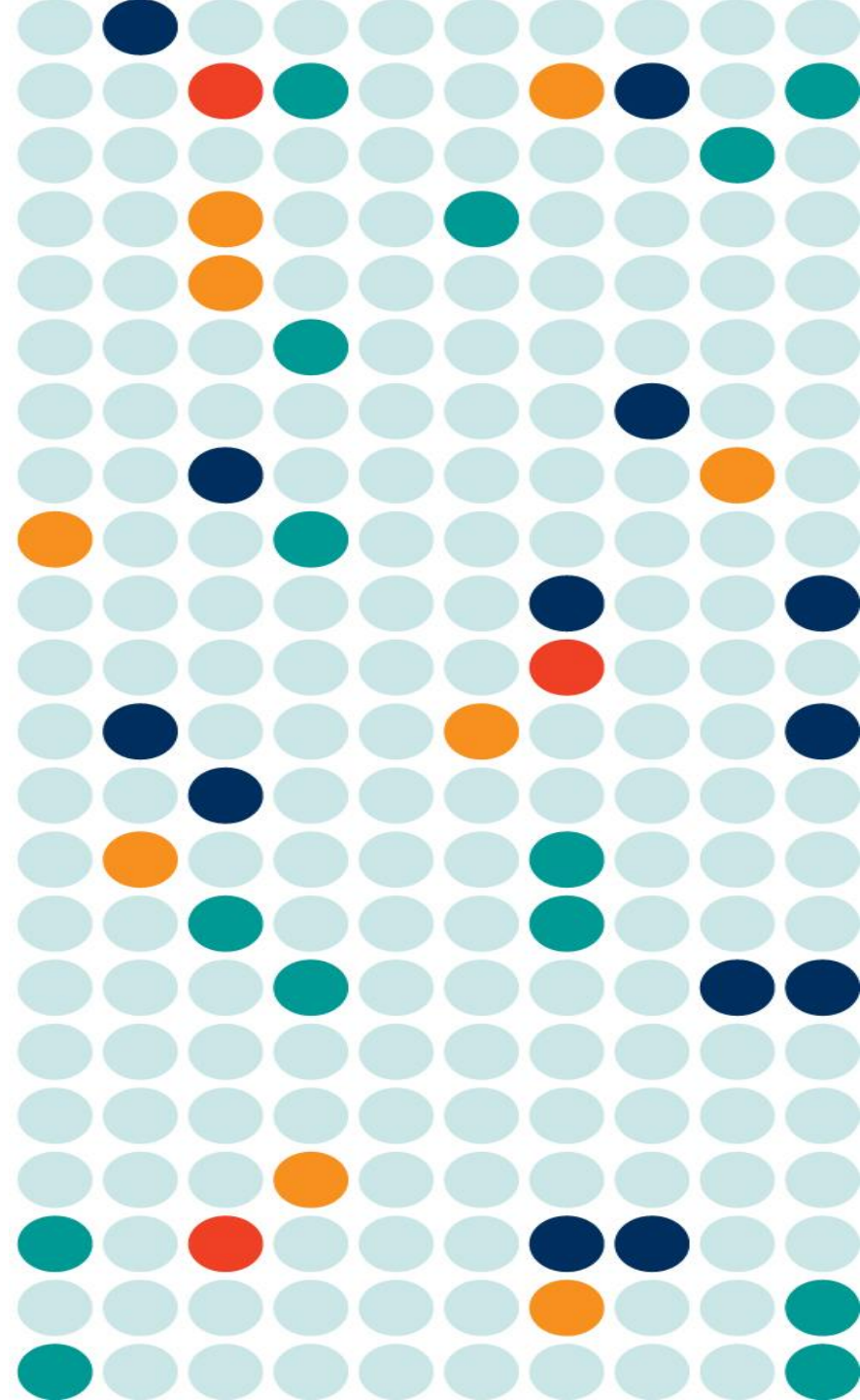


HARD CANDY v. ANASTASIA
HOLDING

**No Likelihood Of Confusion
and
Anastasia's Use Is Fair**



HARD CANDY v. ANASTASIA
REASONING



HARD CANDY v. ANASTASIA HOLDING

Fair enough... What's Interesting About that?

Isn't "descriptive use other than as a mark"
supposed to be an affirmative defense to
confusion/infringement?

How then can it be the reason for no likely
confusion?



**IF YOU SAY SOMETHING IS
"INDESCRIBABLE"**



**THEN ARE YOU
DESCRIBING IT?**

HARD CANDY v. ANASTASIA

Confusion Analysis

- In favor of HC:
 - HARD CANDY is arbitrary
 - Channels of trade and audience are similar
 - Sophistication of consumers is similar
 - Advertising media is similar
- In Favor of Anastasia:
 - No actual Confusion
 - **Similarity of the marks** – “identical but not used as a mark”



HARDCANDY V. ANASTASIA

Similarity Of The Marks

“Anastasia’s use of ‘Hard Candy’ does not create a likelihood of confusion [because] while Anastasia uses the same words, all in capital letters, the court must consider the overall impression created by the use of the mark as a whole.” **In this case, that use is descriptive of the goods and therefore, “fair.”**

Plaintiff provided no evidence that “use as a mark” is not a factor to consider in the LOC analysis



HARDCANDY V. ANASTASIA

Holding

Based on Anastasia’s “use as a shade name” and the lack of actual confusion, the court found the factors to weigh against a likelihood of confusion.



HARD CANDY v. ANASTASIA

FAIR USE DEFENSE

1. Not used as a mark
2. Descriptive
3. Good faith



HARD CANDY v. ANASTASIA

Defining Descriptiveness

Never looked at the definition of “Hard Candy” itself, *i.e.* the primary meaning of the term

[BTW: Merriam Webster says it’s “*a candy made of sugar and corn syrup boiled without crystallizing*”]



HARD CANDY v. ANASTASIA

Defining Descriptiveness

Instead, the court relied on:

- The definition of descriptive “trademarks” – (*i.e.* a mark which describes “a quality, characteristic or feature” about the product)
- Evidence that cosmetics companies regularly describe shades with words that are “***not literal color descriptions,***” like the other three shades in the GlowKit



HARDCANDY V. ANASTASIA
Defining Descriptiveness

“[I]t is not necessary that a descriptive term depict the [product] itself, but only that the term refer to a characteristic of the [product], which would be the shimmer in this case.”



HARDCANDY V. ANASTASIA

Conclusions and Remaining Questions

- Fair Use: an affirmative defense or a factor in the confusion analysis?
- Should industry practice matter when determining if something is descriptive?
- Descriptiveness: Does ignoring the “primary meaning” rule for descriptive fair use run counter to the policy underlying its existence?
- Did the case just create a *de facto* “suggestive” fair use standard?



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