

Insights: Publications

Nominative Trademark Use: Affirmative or Negative Defense to Infringement?

Landslide, Vol. 14, No. 3, March/April 2022

April 1, 2022

Written by **J. David Mayberry**

"One genre of trademark infringement cases has bedeviled the federal courts for years. This recurring situation has not prevented courts from reaching a just result, but it has created unnecessary work in addressing the proper legal standard to judge these cases. The troublesome facts presented by these cases are that the accused infringer uses the trademark owner's mark to identify the trademark owner's goods or services by their trademarked name. For example, a real estate company might advertise the services of various mortgage companies on its website using those companies' trademarks as follows: "Let us find you the perfect home. If you need financing, check out the favorable rates provided by the lenders Money Tree, First Mortgage Company, and Second Mortgage Company."

This use of the lenders' trademarks to refer to them by name, dubbed "nominative use" or "referential use," has not just split but has splintered the federal courts. Indeed, one court of appeals treats such nominative use as an affirmative defense that the defendant must prove. Under this court's view, nominative use is like descriptive fair use and can avoid liability even if the use of the trademark is likely to cause confusion—so long as such nominative use is "fair."¹ Another court of appeals treats nominative use as a special type of noninfringing use that must be judged by its own exclusive set of factors² that differs from the usual multifactor likelihood of confusion test.³

Related People



J. David Mayberry

t 212.775.8830

dmayberry@ktslaw.com