

15.26 Defenses—Nominative Fair Use

The [owner] [assignee] [licensee] of a trademark cannot exclude others from making a nominative fair use of that trademark. A defendant makes nominative fair use of a mark when the defendant uses it as other than a trademark, to accurately [describe] [name] [identify] the plaintiff's product, even if the defendant's ultimate goal was to describe its own product.

The defendant [name] contends that it did not infringe the trademark because the alleged infringement was a nominative fair use of the trademark to [describe] [name] [identify] the plaintiff [name]'s product. The plaintiff [name] has the burden of proving, by a preponderance of the evidence, that the defendant [name]'s use of the mark does not meet the requirements of nominative fair use.

A defendant makes nominative fair use of a trademark when:

First, the product in question was not readily identifiable without use of the trademark;

Second, the defendant used only so much of the trademark as was reasonably necessary to identify the product in question; and

Third, the defendant did not do anything in connection with the trademark that would suggest sponsorship or endorsement by the plaintiff.

[A product is not readily identified without use of its trademark when there would be no other effective way to compare, criticize, refer to, or identify it without using the trademark.]

[A reasonably necessary use of a trademark occurs when no more of the mark's appearance is used than is necessary to identify the product and make the reference intelligible to the consumer. For example, if a particular word is the plaintiff's trademark, the defendant reasonably uses it when the defendant does not use any distinctive color, logo, abbreviation, or graphic that the plaintiff uses to display the trademark.]

[A use of the plaintiff's trademark does not suggest sponsorship or endorsement of the defendant's product when the defendant does not attempt to deceive, mislead, or capitalize on consumer confusion, or when the defendant does not appropriate the cachet of the plaintiff's product for the defendant's.]

[The fact that the defendant's use of the trademark may bring the defendant a profit or help in competing with the mark owner does not mean the use was not a fair use.]

Comment

The Ninth Circuit identifies two types of fair use: classic and nominative. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002) (“We distinguish two types of fair use: ‘classic fair use,’ in which ‘the defendant has used the plaintiff’s mark to describe the defendant’s own product,’ and ‘nominative fair use,’ in which the defendant has used the plaintiff’s mark ‘to describe the *plaintiff’s* product’ for the purpose of, for example, comparison to the defendant’s product.”). See Instruction 15.25 (Defenses—“Classic” Fair Use).

The nominative fair use test is “designed to address the risk that nominative use of the mark will inspire a mistaken belief on the part of consumers that the speaker is sponsored or endorsed by the trademark holder.” *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1176 (9th Cir. 2010). The elements of the nominative fair use defense set out in this instruction are described in *Adobe Sys. Inc. v. Christenson*, 809 F.3d 1071, 1081 (9th Cir. 2015). If the nominative use elements are met, the nominative use does not infringe. *Toyota Motor Sales*, 610 F.3d 1176. If the nominative use does not satisfy all the elements, “the district court may order defendants to modify their use of the mark so that all three factors are satisfied; it may not enjoin nominative use of the mark altogether.” *Id.* “A defendant seeking to assert nominative fair use as a defense need only show that it used the mark to refer to the trademarked good . . . The burden then reverts to the plaintiff” to show that the nominative fair use elements are not met. *Id.* at 1183. The nominative fair use defense is unavailable if the marks are not identical. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002) (“When a defendant uses a trademark nominally, the trademark will be identical to the plaintiff’s mark, at least in terms of the words in question.”).

Earlier versions of this instruction placed the burden on the defendant to show that it made nominative fair use of the plaintiff’s trademark. Despite being frequently referred to as a “defense,” nominative fair use is an alternative test “to evaluate the likelihood of confusion” (an element of an infringement claim). *Adobe*, 809 F.3d at 1081. The nominative fair use analysis replaces the usual test for likelihood of confusion (the *Sleekcraft* factors) in cases where the defendant used the plaintiff’s trademark to “refer[] to the trademarked good itself.” *Toyota*, 610 F.3d at 1182; *Adobe*, 809 F.3d at 1081. Because it is the plaintiff’s burden to show likelihood of confusion, “[the plaintiff] must bear the burden of establishing that the [defendant’s] use of [the plaintiff’s] mark was *not* nominative fair use.” *Toyota*, 610 F.3d at 1182-83. See also 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:11 (5th ed. 2019).

The nominative fair use defense applies only if the defendant “does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.” *Horphag Rsch. Ltd. v. Pellegrini*, 337 F.3d 1036, 1041 (9th Cir. 2003) (holding nominative fair use defense unavailable where record showed that defendant’s use of plaintiff’s trademark suggested sponsorship or endorsement by trademark holder of defendant’s product) (citing *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 306 (9th Cir. 1992)); see also *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 905-08 (9th Cir.

2003) (discussing cases and application of nominative and classic fair use defenses, and holding neither were available because defendant’s use of trademark was not in primary descriptive sense, but instead suggested sponsorship or endorsement by trademark holder); *Cairns*, 292 F.3d at 1151 (“The nominative fair use analysis is appropriate where a defendant has used the plaintiff’s mark to describe the plaintiff’s product, even if the defendant’s ultimate goal is to describe his own product.” (emphasis omitted)); *Yuga Labs, Inc. v. Ripps*, 144 F.4th 1137, 1164 (9th Cir. 2025) (holding that nominative fair use did not apply when the defendants “used the [trademarks] to create, promote, and sell their own [nonfungible tokens] associated with the same artwork as plaintiff’s NFT collection”).

For application of fair use defense in trade dress cases or for application of First Amendment doctrines as a “fair use,” see Comment to Instruction 15.25 (Defenses—“Classic” Fair Use (15 U.S.C. § 1115(b)(4))).

Revised March 2024