

You can use the mark | IP Frontiers

When reference, comparison, resale, criticism, parody, and functionality keep trademark use outside the Lanham Act's reach

A trademark registration is not a deed to a word. It does not let the owner cordon off a term, a product reference, a place name, or a cultural association and charge admission. The Lanham Act has a narrower job: it protects consumers from likely confusion about the source of a product, service, or message. Absent confusion, there may be room to use the mark without infringing it.



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That room is not a loophole large enough to drive a counterfeit truck through. But it is large enough for truthful reference, comparison, resale, criticism, parody, and the copying of useful product features. Consider the following examples.

YOU CAN NAME THE BRAND; JUST DON'T CROSS THAT LINE

Sometimes, there is no useful substitute for the brand name, it needs to be used to identify or describe something.

In *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992), USA Today and Star ran polls asking readers to vote for their favorite member of a band. They naturally used the group's name in the polls. The Ninth Circuit permitted the use because it was limited to what was necessary and did not suggest the band sponsored the polls.

Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350 (9th Cir. 1969), was similar, an independent repair shop was permitted to truthfully identify Volk-

swagen vehicles as the cars it serviced, short of making itself look like an authorized Volkswagen operation.

The practical rule is straightforward. "Compatible with Apple iPhone," and "Unofficial guide to Nike running shoes" may be permissible, and plain text is usually safer than the mark owner's logo, distinctive typography, or trade dress. A disclaimer can help, but it is not a legal air freshener. It will not cure an overall presentation that makes the business look affiliated.

Also, acceptable use to describe in ordinary language. In *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), a competitor's use of "microcolor" to describe permanent-makeup pigments was permitted despite the plaintiff's MICRO COLORS registration because a registration cannot remove ordinary descriptive terms from everyday language.

YOU CAN COMPARE THE COMPETITION, BUT BRING RECEIPTS

Trademark law also permits truthful comparative advertising. A company may identify the product it is comparing against, even if the comparison is unflattering.

In *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968), a perfume seller advertised its product as a lower-priced equivalent of Chanel No. 5. The Ninth Circuit held a seller may use another company's mark to identify an unpatented product it has copied, provided the advertising does not misrepresent the product or create confusion about source.

As always, source identification is key. The seller could not falsely market the perfume as "the same as Chanel No. 5". See *Chanel, Inc. v. R.G. Smith*, 528 F.2d 284 (9th Cir. 1975). Truthful comparative advertising is permissible.

The modern version of this dispute often appears in search advertising. In *1-800 Contacts, Inc. v. JAND, Inc.*, No. 22-1634 (2d Cir. 2024), the Second Circuit held that purchasing a competitor's trademark as a search-ad keyword did not establish trademark infringement since on the record there was no likelihood of confusion.

"Costs less than Tide," and "Compatible with Dyson vacuum cleaners" may be lawful. "Tide-approved," or "Dyson's preferred alternative" cross the line unless true.

YOU CAN RESELL THE REAL THING; TELL BUYERS WHAT YOU DID TO IT

The first-sale doctrine permits resale of genuine, branded goods. It does not permit a reseller to alter the product, then insist it remains untouched.

In *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924), Prestonettes purchased genuine Coty perfume and powder, rebottled it, and used Coty powder in independently made compacts. The Supreme Court permitted Prestonettes to use Coty marks, but only because its labels truthfully disclosed that Prestonettes had done the rebottling or compounding.

In *Bluetooth SIG Inc. v. FCA US LLC*, 30 F.4th 870 (9th Cir. 2022), FCA acquired genuine Bluetooth-enabled

components, incorporated them into vehicles, and identified Bluetooth technology in connection with that functionality. The Ninth Circuit held the first-sale doctrine could apply to genuine branded components included in a finished product.

Proper disclosure is essential. A seller may offer a “used Rolex,” “authentic LEGO bricks,” or a product containing a genuine Bluetooth component. The seller should be candid about preowned condition, repackaging, modification, warranty changes, independent repair, and lack of authorization. But material alterations and misleading “authorized dealer” claims can turn a routine resale into infringement.

YOU CAN SAY “FLORIBAMA.” THE BAR DOES NOT OWN THE COAST

A mark tied to a place does not necessarily give its owner control over every regional reference.

In *MGFB Properties v. 495 Productions Holdings*, 64 F.4th 1353 (11th Cir. 2022), Flora-Bama Lounge sued MTV for its reality show MTV Floribama Shore about young adults living in the Florida-Alabama Gulf Coast region. The Eleventh Circuit concluded “Floribama” had artistic relevance to the show and did not explicitly mislead viewers into believing that the Flora-Bama Lounge produced, sponsored, or endorsed it.

Not every use is safe though, a bar may own strong rights in a mark for bar and entertainment services without owning it as a geographic reference that has cultural meaning.

Similarly, trademark law generally does not allow one company to monopolize a truthful place name. *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311 (1871). Nor does it automatically prohibit a person from using his or her own name. *Taylor Wine Co. v. Bully*

Hill Vineyards, Inc., 569 F.2d 731 (2d Cir. 1978). But users should still avoid styling or promoting a mark such that it trades on a business’s goodwill.

YOU CAN CRITICIZE THE BRAND, BUT IT SHOULD BE OBVIOUS

Trademark law is generally built to protect consumers from confusion, not reputation, so honest criticism can be another acceptable use.

In *Radiance Foundation v. National Ass’n for the Advancement of Colored People*, 786 F.3d 316 (4th Cir. 2015), Radiance published an article titled “NAACP: National Association for the Abortion of Colored People,” criticizing the NAACP’s abortion-related advocacy. Radiance was not liable for trademark infringement or tarnishment by dilution because it used the marks to identify the target of criticism, not as a means to confuse readers into thinking the article originated or was sponsored by the NAACP.

A critical website, social-media account, or report should make its lack of affiliation clear either by the nature of the criticism or expressly. Official-looking logos, trade dress, and account names that look brand-owned may be problematic.

YOU CAN SELL THE JOKE BUT IT HAD BETTER READ LIKE A JOKE

Parody can be protected, including when it is sold. But parody is not a get-out-of-jail-free-card; calling something a joke does not always sidestep potential confusion.

In *Mattel v. MCA Records*, 296 F.3d 894 (9th Cir. 2002), Mattel sued over the song “Barbie Girl,” but, under the Rogers precedent, the use of Barbie was artistically relevant and did not mislead listeners into believing Mattel produced or endorsed the tune.

Jack Daniel’s v. VIP Products, 599 U.S. 140 (2023) recently supplied an important qualification. VIP’s Bad Spaniels dog toy parodied Jack Daniel’s bottle design and branding. The Court held that VIP could not automatically invoke Rogers because the use also served as VIP’s own source identifier, requiring a confusion analysis. On final remand, however, VIP ultimately prevailed because the court considered parody in the larger analysis.

The upshot is parody is not a bullet-proof defense, particularly when the joke is also the accused product’s brand.

YOU CAN COPY THE GADGET (EVENTUALLY); YOU CANNOT COPY THE GOODWILL

Trademark law is also not a patent substitute.

In *Traffix Devices v. Marketing Displays* 532 U.S. 23 (2001), a manufacturer sought trade-dress protection for a mechanism that kept portable road signs upright in the wind. The manufacturer’s utility patents on the mechanism expired, so it tried using trade dress as a workaround.

A useful item may be closely associated with one manufacturer and still free to copy if it is not or no longer patented. The association with the manufacturer is not a substitute for a trademark or a workaround for expired patent rights.

The root question in these cases is not whether there was use, but whether the use served as a source identifier. When the answer is no, the trademark owner often may have much less to say.

Disclaimer: This article is provided for general informational purposes and is not legal advice and does not create an attorney-client relationship.

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