

14-3456-cv

International Information Systems Security Certification Consortium, Inc. v. Security University, LLC

UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT

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August Term, 2015

(Argued: August 19, 2015

Decided: May 18, 2016)

Docket No. 14-3456-cv

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3 International Information Systems Security Certification Consortium, Inc.,

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5 *Plaintiff-Counter-Defendant-Appellant,*

6  
7 v.

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9 Security University, LLC, Sondra Schneider,

10  
11 *Defendants-Counter-Claimants-Appellees.*

12  
13  
14  
15 Before: CALABRESI, STRAUB, and POOLER, *Circuit Judges.*

16  
17 Appeal from United States District Court for the District of Connecticut

18 (Michael P. Shea, J.) granting Security University, LLC, and Sondra Schneider's

19 motion for summary judgment on International Information Systems Security

20 Certification Consortium, Inc.'s claims of violations of the Lanham Act, 15 U.S.C.

1 § 1051 et seq., including infringement, false designation of origin and false  
2 advertising, and trademark dilution, and on its claims for violations of the  
3 Connecticut Unfair Trade Practices Act, Conn. Gen. Stat. § 42-110a et seq., on the  
4 grounds that defendants' use of the certification mark was permissible under the  
5 doctrine of "nominative fair use" and that plaintiff's mark is not famous for the  
6 purpose of trademark dilution.

7 We hold that the district court erred in considering source confusion to be  
8 the only type of confusion relevant in an infringement claim, and failing to give  
9 serious consideration to, for example, confusion as to sponsorship, affiliation, or  
10 connection. We hold that the district court further erred in failing to consider that  
11 a certification mark can be infringed by a duly certified individual. Finally, we  
12 hold that the district court erred in applying solely the Ninth Circuit's test for  
13 nominative fair use, instead of applying our Court's *Polaroid* test. Having  
14 considered other circuits' nominative fair use tests, as well as our own prior  
15 treatment of cases involving nominative use of marks, we hold that nominative  
16 fair use is not an affirmative defense to a claim of infringement under the  
17 Lanham Act. We further hold that in nominative use cases, in addition to

1 considering the *Polaroid* factors, courts are to consider (1) whether the use of the  
2 plaintiff's mark is necessary to describe both the plaintiff's product or service  
3 and the defendant's product or service, that is, whether the product or service is  
4 not readily identifiable without use of the mark; (2) whether the defendant uses  
5 only so much of the plaintiff's mark as is necessary to identify the product or  
6 service; and (3) whether the defendant did anything that would, in conjunction  
7 with the mark, suggest sponsorship or endorsement by the plaintiff holder, that  
8 is, whether the defendant's conduct or language reflects the true or accurate  
9 relationship between plaintiff's and defendant's products or services.

10 Accordingly, we vacate the district court's grant of summary judgment on  
11 the infringement, false designation of origin and false advertising, and unfair  
12 competition claims, and remand for further proceedings consistent with this  
13 opinion. We affirm the grant of summary judgment on the trademark dilution  
14 claims, which ruling was not challenged on appeal.

15 Affirmed in part, vacated in part, and remanded.

16 \_\_\_\_\_  
17 FATIMA LAHNIN (DAMIAN K. GUNNINGSMITH, *on*  
18 *the brief*), Carmody Torrance Sandak & Hennessey LLP,

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2 *Appellant.*

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11 United States Department of Justice, Washington, DC;  
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17 Patent and Trademark Office, Alexandria, VA, *for*  
18 *Amicus Curiae United States Patent and Trademark Office.*

19  
20 POOLER, *Circuit Judge:*

21 Plaintiff-appellant International Information Systems Security Certification  
22 Consortium, Inc. ("ISC<sup>2</sup>") filed suit against defendants-appellees Security  
23 University ("SU") and Sondra Schneider, alleging that SU's use of ISC<sup>2</sup>'s  
24 certification mark violated the Lanham Act, 15 U.S.C. § 1051 et seq., and  
25 constituted infringement under 15 U.S.C. § 1114, false designation of origin and  
26 false advertising under 15 U.S.C. § 1125(a), and trademark dilution under 15  
27 U.S.C. § 1125(c), and that SU's use of the mark constituted unfair competition

1 under the Connecticut Unfair Trade Practices Act, Conn. Gen. Stat. § 42–110a et  
2 seq. (“CUTPA”). Following cross-motions for summary judgment, the district  
3 court granted summary judgment to defendants on all grounds, holding that  
4 defendants’ use of the certification mark constituted nominative fair use under  
5 the Ninth Circuit’s test, which our Court has not, to this point, adopted. Critical  
6 to its determination that defendants’ use of the mark constituted nominative fair  
7 use under the Ninth Circuit’s test were the district court’s misperceptions that  
8 the only type of confusion relevant to an infringement claim was confusion as to  
9 source and that a certification mark could not be infringed by a duly certified  
10 individual.

11       Having considered other circuits’ nominative fair use tests as well as our  
12 own prior treatment of claims involving nominative use, we hold that  
13 nominative fair use is not an affirmative defense to a claim of infringement under  
14 the Lanham Act. We further hold that in cases involving nominative use, in  
15 addition to considering the *Polaroid* factors, courts are to consider (1) whether the  
16 use of the plaintiff’s mark is necessary to describe both the plaintiff’s product or  
17 service and the defendant’s product or service, that is, whether the product or

1 service is not readily identifiable without use of the mark; (2) whether the  
2 defendant uses only so much of the plaintiff's mark as is necessary to identify the  
3 product or service; and (3) whether the defendant did anything that would, in  
4 conjunction with the mark, suggest sponsorship or endorsement by the plaintiff  
5 holder, that is, whether the defendant's conduct or language reflects the true or  
6 accurate relationship between plaintiff's and defendant's products or services.  
7 When considering these factors, courts must be mindful of the different types of  
8 confusion relevant to infringement claims, including confusion as to  
9 sponsorship, affiliation, or connection, as well as, when considering a  
10 certification mark, the various ways such a mark can be infringed.

11 Because the district court failed to consider the *Polaroid* factors and because  
12 its consideration of the relevant nominative fair use factors was based on  
13 incorrect assumptions, we vacate the district court's grant of summary judgment  
14 on the infringement claims. Accordingly, we also vacate the grant of summary  
15 judgement on the false designation of origin and false advertising claims, which  
16 the court decided on the same grounds as the infringement claims, and the  
17 CUTPA claims, which were dismissed because they were derivative of the

1 Lanham Act claims. We affirm the grant of summary judgment on the dilution  
2 claims, which ruling was not challenged on appeal. We remand for further  
3 proceedings consistent with this opinion.

## 4 BACKGROUND

### 5 I. The CISSP® Mark

#### 6 A. ISC<sup>2</sup>'s Mark

7 ISC<sup>2</sup> is a non-profit organization that was formed in 1989 to develop  
8 standards for the information security industry. In March 1990, ISC<sup>2</sup> developed a  
9 certification program and began using the certification mark "CISSP®" to denote  
10 a "Certified Information Systems Security Professional" who has met certain  
11 requirements and standards of competency in the information security field,  
12 including passing the CISSP® certification examination that ISC<sup>2</sup> administers.

13 On March 18, 1997, the United States Patent and Trademark Office  
14 registered ISC<sup>2</sup>'s CISSP® certification mark. The registration stated: "The  
15 [CISSP®] certification mark is used by persons authorized by the certifier [ISC<sup>2</sup>]  
16 to certify completion of appropriate work experience and/or successfully passing

1 examinations as established by the certifier in the field of security of information  
2 systems.” App’x at 30.

3 **B. SU’s Alleged Infringement**

4 SU is a for-profit company that was formed in 1999 by defendant-appellee  
5 Sondra Schneider, a CISSP®-certified individual, to provide information security  
6 training. SU offers various classes, including a class to prepare individuals for  
7 ISC<sup>2</sup>’s CISSP® certification examination. SU has used the CISSP® mark in  
8 connection with certification-specific training courses since 2001. It is undisputed  
9 that SU is allowed to use the CISSP® certification mark to indicate that its  
10 services are directed at preparing students for the CISSP® certification  
11 examination. Furthermore, given the nature of ISC<sup>2</sup>’s certification mark, SU  
12 instructors may accurately identify themselves as being CISSP®-certified, so long  
13 as they follow ISC<sup>2</sup>’s regulations governing the use of the mark.<sup>1</sup>

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<sup>1</sup> Upon meeting ISC<sup>2</sup>’s certification standards, ISC<sup>2</sup> licenses an individual to use the CISSP® mark in accordance with the “(ISC)<sup>2</sup> ® Regulations Governing Use of Certification/Collective Marks.” The Regulations provide that, in using the mark, certified individuals “*may not combine the Logo with any other object, including, but not limited to, other logos, icons, words, graphics, photos, [or] slogans . . . (i.e., Mixing another Logo with the CISSP[®] Logo to create a variation.)*” *Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, No. 3:10-CV-01238 (MPS), 2014 WL 3891287, at \*2 (D. Conn. Aug. 7, 2014) (alterations in original) (emphasis

1           However, ISC<sup>2</sup> objects to some of SU's advertisements, run between 2010  
2 and 2012, which, ISC<sup>2</sup> argues, misleadingly suggested that SU's instructor,  
3 Clement Dupuis, had attained some higher level of certification as a "Master  
4 CISSP" or "CISSP Master." These advertisements include the following  
5 statements:

- 6       • "MASTER THE 10 CISSP DOMAINS with the Master CISSP®  
7       Clement Dupuis." App'x at 71.
- 8
- 9       • "REGISTER NOW to Master the CISSP® Certification with Master  
10       CISSP® Instructor Clement Dupuis of [www.ccure.org](http://www.ccure.org)!" App'x at 71.
- 11
- 12       • "Register for CISSP® Prep class with Master CISSP Clement Dupuis  
13       today!" App'x at 76.
- 14
- 15       • "You are taught by CISSP Master Clement Dupuis, the father of  
16       [www.ccure.org](http://www.ccure.org) website." App'x at 76, 83.
- 17
- 18       • "Security University's CISSP® Prep Class[.] Register for CISSP®  
19       Prep class with Master CISSP Clement Dupuis today!" App'x at 78,  
20       83.
- 21
- 22       • "Attend the BEST CISSP® Prep Class in Europe[.] Master CISSP  
23       June 27-30 AMERSTERDAM with MASTER CISSP® Instructor  
24       Clement Dupuis[.]" App'x at 88-89.
- 25

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added). Another rule provides that "[t]he Logo may not be used in any manner that expresses or might imply (ISC)<sup>2</sup>'s affiliation, sponsorship, endorsement, certification, or approval, other than as set forth by the (ISC)<sup>2</sup> Application Agreement." *Id.* (alteration in original).

1 SU began using the term "Master" in May 2010. On June 9, 2010, ISC<sup>2</sup>'s  
2 counsel wrote to Schneider asking that she cease using the phrase "Master  
3 CISSP" in SU's advertisements. On June 13, 2010, Schneider emailed Marc  
4 Thompson, an employee of a third party entity that oversees seminars on ISC<sup>2</sup>'s  
5 behalf, stating that "SU will continue to use the word Master. Master Clement  
6 Dupuis is a Male Teacher [and] thus he is a Master according to the dictionary."  
7 *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC* [hereinafter  
8 *IISCCC*], No. 3:10-CV-01238 (MPS), 2014 WL 3891287, at \*2 (D. Conn. Aug. 7,  
9 2014) (alteration in original). On July 15, 2010, ISC<sup>2</sup>'s counsel "again wrote to Ms.  
10 Schneider requesting that she and SU cease and desist their improper  
11 advertising." *Id.* Although ISC<sup>2</sup>'s exhibits reveal that SU continued using this  
12 terminology at least through February of 2012, SU submitted declarations in  
13 support of its motion for summary judgment stating that it no longer uses these  
14 terms in its advertising materials.

1 **II. Proceedings Below**

2 **A. ISC<sup>2</sup>' Claims**

3 On August 3, 2010, ISC<sup>2</sup> filed a complaint against SU, alleging that SU's  
4 willful actions in refusing to cease its improper use of ISC<sup>2</sup>'s CISSP® mark  
5 constituted infringement under 15 U.S.C. § 1114, false designation of origin and  
6 false advertising under 15 U.S.C. § 1125(a), trademark dilution under 15 U.S.C.  
7 § 1125(c), and unfair competition under CUTPA. Specifically, ISC<sup>2</sup> alleged that  
8 SU's advertisements: (1) "have the likelihood of deceiving or confusing the  
9 public," in violation of 15 U.S.C. § 1114, by suggesting that ISC<sup>2</sup>'s mark is  
10 somehow capable of being "mastered"; (2) constitute a false designation of origin  
11 or false advertising by deceiving the public into believing that "Security  
12 University's training courses originate with or are sponsored or otherwise  
13 approved by the Plaintiff," in violation of 15 U.S.C. § 1125(a); and (3) dilute the  
14 CISSP® mark, in violation of 15 U.S.C. § 1125(c). App'x at 19-24. SU filed  
15 counterclaims denying each of these allegations and alleging antitrust violations  
16 due to ISC<sup>2</sup>'s alleged misuse of its certification mark.

1           **B.     Summary Judgment Motions**

2           In December 2013, the parties cross-moved for summary judgment. On  
3 August 7, 2014, the district court granted summary judgment to SU on all counts.  
4 In sum, the district court found that ISC<sup>2</sup>'s claims of infringement and false  
5 designation of origin failed under the doctrine of nominative fair use because  
6 SU's alleged misuse of ISC<sup>2</sup>'s certification mark could not give rise to confusion  
7 as to the source of SU's services. In conducting its analysis, the district court did  
8 not assess likelihood of confusion from Defendants' use of ISC<sup>2</sup>'s mark based on  
9 our Court's test, but rather applied the Ninth Circuit's doctrine of nominative  
10 fair use, according to which "[n]ominative fair use applies when all three of the  
11 following requirements are met: '[1] the product or service in question must be  
12 one not readily identifiable without use of the trademark; [2] only so much of the  
13 mark or marks may be used as is reasonably necessary to identify the product or  
14 service; and [3] the user must do nothing that would, in conjunction with the  
15 mark, suggest sponsorship or endorsement by the trademark holder.'" *IISCC*,  
16 2014 WL 3891287, at \*4 (quoting *New Kids on the Block v. News Am. Publ'g Inc.*, 971  
17 F.2d 302, 308 (9th Cir. 1992)). Finding that Defendants had succeeded on all three

1 elements, the district court ruled that, “[e]ven after drawing all inferences in  
2 Plaintiff’s favor, . . . no reasonable juror could find that [Defendants’ uses] of the  
3 CISSP mark suggest that Defendants’ training courses were sponsored or  
4 endorsed by Plaintiff.” *Id.* at \*5.

5 Central to the district court’s analysis was its conclusion that “Defendants’  
6 addition of the word ‘Master’ before or after ‘CISSP®’ . . . . does not implicate the  
7 protection afforded by trademark *infringement* laws, which are concerned with  
8 ‘whether there exists a likelihood that an appreciable number of ordinarily  
9 prudent purchasers will be misled, or indeed simply confused, as to the *source* of  
10 the goods in question.’” *Id.* at \*5-6 (quoting *Thompson Med. Co. v. Pfizer Inc.*, 753  
11 F.2d 208, 213 (2d Cir. 1985)); *see also id.* at \*6 (“There is no allegation and no  
12 evidence in the record that anyone was or could have been misled or confused  
13 about the identity of the entity offering the ‘goods in question,’ namely, training  
14 courses designed to prepare consumers for Plaintiff’s certification exam and  
15 taught by Master CISSP® Clement Dupuis or CISSP® Master Clement Dupuis.”);  
16 *id.* (“Because a certification mark is intended to signal a quality-related  
17 characteristic of the good, rather than source or origin, . . . it is hard to imagine a

1 case in which use of a certification mark by a person who has met the  
2 requirements for certification would likely lead to confusion as to source or  
3 origin, or would not be a nominative fair use.”). Indeed, although the district  
4 court asserted that no reasonable juror could find sponsorship or endorsement,  
5 its conclusion was based entirely on the fact that the advertisements did not  
6 “suggest[] that (ISC)<sup>2</sup> itself is offering the classes.” *Id.* at \*5.<sup>2</sup>

7 Although not necessary to its conclusion, the district court reasoned that  
8 the disclaimers SU placed at the bottom of some of its advertisements further  
9 served to reduce any suggestion that their classes were sponsored or endorsed  
10 by ISC<sup>2</sup>. Several, but not all of SU’s advertisements, included one or more of the  
11 following disclaimers:

- 12 • SU CISSP® Prep classes are not endorsed, sponsored or delivered by  
13 (ISC)<sup>2</sup>®.
- 14
- 15 • CISSP® is a registered trademark of (ISC)<sup>2</sup>®.
- 16
- 17 • CISSP® is a registered trademark of (ISC)<sup>2</sup>® (International  
18 Information Systems Security Certification Consortium) Inc.
- 19

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<sup>2</sup> Our analysis is not changed by the district court’s passing note that “attaching the word ‘Master’ to ‘CISSP®’ does not ‘suggest *sponsorship or endorsement*’ by (ISC)<sup>2</sup>.” *IISCC*, 2014 WL 3891287, at \*5 (emphasis added).

- 1 • CISSP® is a registered trademark of (ISC)<sup>2</sup>® Inc. (International  
2 Information Systems Security Certification Consortium) Inc. The  
3 materials for the Security University classes have been developed  
4 specifically for SU and are not endorsed, sponsored or delivered by  
5 (ISC)<sup>2</sup>®. The goal of the course is to prepare security professionals  
6 for the CISSP® exam by covering the ten domains defined by  
7 (ISC)<sup>2</sup>®.

8  
9 *Id.* at \*7.

10 Without further analysis, the district court concluded that ISC<sup>2</sup>'s claims for  
11 false advertising or false designation of origin, in violation of 15 U.S.C. § 1125(a),  
12 similarly failed under the doctrine of nominative fair use. The district court then  
13 concluded that ISC<sup>2</sup>'s trademark dilution claims failed because ISC<sup>2</sup> had failed to  
14 raise a genuine dispute of material fact as to whether its CISSP® certification  
15 mark was sufficiently famous to warrant protection from trademark dilution.  
16 Finally, the district court dismissed the CUTPA claims as concededly derivative  
17 of the Lanham Act claims.

## 18 DISCUSSION

### 19 I. Certification Marks

20 A "certification mark," such as CISSP®, is a special sub-category of marks  
21 which, unlike other trademarks, is intended to be used by those *other than its*

1 *owner*, to indicate the quality, accuracy, or other characteristics of the goods or  
2 services. See 15 U.S.C. § 1127 (defining “certification mark” as “any word, name,  
3 symbol, or device, or any combination thereof-- (1) used by a person other than  
4 its owner, or (2) which its owner has a bona fide intention to permit a person  
5 other than the owner to use in commerce and files an application to register on  
6 the principal register established by this chapter, to certify regional or other  
7 origin, material, mode of manufacture, quality, accuracy, or other characteristics  
8 of such person’s goods or services or that the work or labor on the goods or  
9 services was performed by members of a union or other organization”). The  
10 CISSP® mark is meant to certify quality and characteristics, that is, that the  
11 security information professional bearing the CISSP® mark meets ISC<sup>2</sup>’s  
12 standards and has passed its competency test.

13 In spite of the differences between certification marks and other types of  
14 marks, the Lanham Act provides that certification marks are generally entitled to  
15 the same protection from infringement as are trademarks.

16 [S]o far as they are applicable, . . . certification marks, . . . shall be  
17 registrable under this chapter, in the same manner and *with the same*  
18 *effect* as are trademarks, by persons . . . exercising legitimate control  
19 over the use of the marks sought to be registered, even though not

1 possessing an industrial or commercial establishment, and when  
2 registered they *shall be entitled to the protection provided in this chapter*  
3 *in the case of trademarks*, except in the case of certification marks  
4 when used so as to represent falsely that the owner or a user thereof  
5 makes or sells the goods or performs the services on or in connection  
6 with which such mark is used.

7  
8 15 U.S.C. § 1054 (emphases added); *see also Am. Bd. of Psychiatry and Neurology,*  
9 *Inc. v. Johnson-Powell*, 129 F.3d 1, 3 (1st Cir. 1997) (“A registered certification mark  
10 receives the same protection as a trademark.”); *Levy v. Kosher Overseers Ass’n of*  
11 *Am., Inc.*, 104 F.3d 38, 39 (2d Cir. 1997) (stating that “[c]ertification marks are  
12 generally treated the same as trademarks for purposes of trademark law”).

## 13 **II. Infringement Claims**

14 To prevail on a claim of certification mark infringement, “a plaintiff must  
15 show, first, that its mark merits protection, and, second, that the defendant’s use  
16 of a similar mark is likely to cause consumer confusion.” *Brennan’s, Inc. v.*  
17 *Brennan’s Rest., L.L.C.*, 360 F.3d 125, 129 (2d Cir. 2004). Defendants do not dispute  
18 that ISC<sup>2</sup>’s mark merits protection; they merely argue that their use of the mark is  
19 non-infringing.

20 “A plaintiff’s trademark is protected by federal law against infringement  
21 by use of colorable imitations of the mark which are ‘likely to cause confusion, or

1 to cause mistake, or to deceive.'" *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73  
2 F.3d 497, 502 (2d Cir. 1996) (quoting 15 U.S.C. § 1114(1)). In determining whether  
3 there is a likelihood of consumer confusion for trademark infringement, we  
4 apply the eight-factor balancing test set forth in *Polaroid Corp. v. Polarad*  
5 *Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961).

6 The eight factors are: (1) strength of the trademark; (2) similarity of the  
7 marks; (3) proximity of the products and their competitiveness with one  
8 another; (4) evidence that the senior user may "bridge the gap" by  
9 developing a product for sale in the market of the alleged infringer's  
10 product; (5) evidence of actual consumer confusion; (6) evidence that the  
11 imitative mark was adopted in bad faith; (7) respective quality of the  
12 products; and (8) sophistication of consumers in the relevant market.

13  
14 *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009). "The  
15 application of the *Polaroid* test is not mechanical, but rather, focuses on the  
16 ultimate question of whether, looking at the products in their totality, consumers  
17 are likely to be confused." *Kelly-Brown v. Winfrey*, 717 F.3d 295, 307 (2d Cir. 2013)  
18 (internal quotation marks omitted) (quoting *Starbucks Corp.*, 588 F.3d at 115). As  
19 we stated in *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384 (2d Cir. 1995),

20 the *Polaroid* factors are not, of course, "exclusive" and should not be  
21 applied "mechanically." No single factor is dispositive, and cases may  
22 certainly arise where a factor is irrelevant to the facts at hand. But it is

1 incumbent upon the district judge to engage in a deliberate review of each  
2 factor, and, if a factor is inapplicable to a case, to explain why.

3  
4 *Id.* at 400 (citations omitted) (quoting *Paddington Corp. v. Attiki Imps. & Distributions,*  
5 *Inc.*, 996 F.2d 577, 584 (2d Cir. 1993)) (reversing judgment because district court  
6 “did not always articulate the basis for its conclusions regarding the various  
7 *Polaroid* factors or whether it considered all factors relevant to the case”).

#### 8 **A. Types of Confusion Relevant to Infringement Claims**

9 The district court held that the only type of confusion relevant in  
10 determining infringement is confusion as to *source*. This is incorrect; protection is  
11 not exclusively limited for any type of mark to cases in which there may be  
12 confusion as to source.<sup>3</sup> Rather, “[t]he modern test of infringement is whether the  
13 defendant’s use [is] likely to cause confusion *not just as to source*, but also as to  
14 sponsorship, affiliation or connection.” 4 McCarthy on Trademarks and Unfair  
15 Competition [hereinafter “McCarthy”] § 23:76 (4th ed.) (emphasis added).

16 Indeed, our Court has previously observed that in 1962 Congress amended 15  
17 U.S.C. § 1114, the Lanham Act provision that provides penalties for

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<sup>3</sup> Indeed, considering only source confusion would make little sense in the context of certification marks, as certification marks are generally not used to designate source at all.

1 infringement, to “broaden liability” from the prior “statutory requirement [that]  
2 confusion, mistake, or deception applied only with respect to purchasers as to  
3 the source of origin of such goods or services.” *Rescuecom Corp. v. Google Inc.*, 562  
4 F.3d 123, 136 (2d Cir. 2009) (internal quotation marks omitted). That provision  
5 now penalizes a person who

6 use[s] in commerce any reproduction, counterfeit, copy, or colorable  
7 imitation of a registered mark in connection with the sale, offering for sale,  
8 distribution, or advertising of any goods or services on or in connection  
9 with which such use *is likely to cause confusion, or to cause mistake, or to*  
10 *deceive . . . .*

11  
12 15 U.S.C. § 1114(1)(a) (emphasis added). As is plain from this statutory text, the  
13 Act’s protection against infringement is not limited to any particular type of  
14 consumer confusion, much less exclusively to confusion as to source. Rather, the  
15 Lanham Act protects against numerous types of confusion, including confusion  
16 regarding affiliation or sponsorship. *See Rescuecom Corp.*, 562 F.3d at 128  
17 (“Sections 32 and 43 of the Act, which we also refer to by their codified  
18 designations, 15 U.S.C. §§ 1114 & 1125, *inter alia*, impose liability for unpermitted  
19 ‘use in commerce’ of another’s mark which is ‘likely to cause confusion, or to  
20 cause mistake, or to deceive,’ § 1114, ‘as to the affiliation . . . or as to the origin,

1 sponsorship or approval of his or her goods [or] services . . . by another person.’  
2 § 1125(a)(1)(A).” (alterations in original)); *Hormel Foods Corp.*, 73 F.3d at 502 (“The  
3 central inquiry is whether there is a ‘likelihood of confusion,’ a ‘likelihood that  
4 an appreciable number of ordinarily prudent purchasers are likely to be misled,  
5 or indeed simply confused, as to the source of the goods in question,’ or that  
6 there may be confusion as to *plaintiff’s sponsorship or endorsement of the junior*  
7 *mark.*” (emphasis added) (quoting *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580  
8 F.2d 44, 47 (2d Cir. 1978))); *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d  
9 Cir. 1981) (“On the question of competition and the likelihood of confusion, it is  
10 not necessary that Warner Bros. actually manufacture the toy cars, but merely  
11 that a confusion as to manufacture *or sponsorship* result.” (emphasis added)); *Dall.*  
12 *Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir.  
13 1979) (“Appellants read the confusion requirement too narrowly. In order to be  
14 confused, a consumer need not believe that the owner of the mark actually  
15 produced the item and placed it on the market. The public’s belief that the  
16 mark’s owner sponsored or otherwise approved the use of the trademark  
17 satisfies the confusion requirement.” (citations omitted)); *see also Team Tires Plus,*

1 *Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 835 (10th Cir. 2005) (“[T]he relevant confusion  
2 under trademark law is not limited to confusion of consumers as to the source of  
3 the goods, but also includes confusion as to sponsorship or affiliation, such as a  
4 consumer’s mistaken belief that a retailer is part of a larger franchising  
5 operation.”); *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1228-29 (7th Cir. 1993)  
6 (“[C]ustomer ‘confusion’ need not be restricted to a mistake regarding the source  
7 of the goods; the court should also consider whether the customer would believe  
8 that the trademark owner sponsored, endorsed or was otherwise affiliated with  
9 the product.”).

10 This broader prohibition on consumer confusion as to sponsorship or  
11 approval is also made explicit in Section 43 of the Lanham Act, which prohibits  
12 false advertising and false designation of origin by providing for civil penalties  
13 to a person injured by:

14 Any person who, on or in connection with any goods or services, . . .  
15 uses in commerce any word, term, name, symbol, or device, or any  
16 combination thereof, or any false designation of origin, false or  
17 misleading description of fact, or false or misleading representation  
18 of fact, which—

19  
20 (A) is likely to cause confusion, or to cause mistake, or to  
21 deceive as to the *affiliation, connection, or association* of such

1 person with another person, or as to the origin, *sponsorship*,  
2 *or approval* of his or her goods, services, or commercial  
3 activities by another person, or  
4

5 (B) in commercial advertising or promotion, misrepresents the  
6 nature, characteristics, qualities, or geographic origin of his  
7 or her or another person's goods, services, or commercial  
8 activities . . . .  
9

10 15 U.S.C. § 1125(a)(1) (emphases added).

11 Indeed, our case law demonstrates that consumer confusion is plainly not  
12 limited to source confusion. For example, in *Weight Watchers International, Inc. v.*  
13 *Luigino's, Inc.*, 423 F.3d 137 (2d Cir. 2005), we recognized that Weight Watchers  
14 was likely to succeed on its claim that a frozen food manufacturer had infringed  
15 its registered trademark in the term "Points" by prominently displaying the  
16 Weight Watchers points value on the packages of its frozen meals. In that case, it  
17 was clear from the packaging that Luigino's was the source of the actual goods—  
18 i.e. the frozen meals. Nonetheless, Weight Watchers could succeed on its claim  
19 for trademark infringement by showing "that the use of the term 'Points' on the  
20 front of the package was likely to confuse consumers into believing that Weight  
21 Watchers had determined the point values or *otherwise endorsed* the Luigino's  
22 products." *Id.* at 144 (emphasis added). Moreover, we have held that there may

1 be consumer confusion based on the misuse of a trademark, even where it is  
2 conceded that the plaintiff's mark accurately designated the source of goods. *See*  
3 *Original Appalachian Artworks, Inc. v. Granada Electronics, Inc.*, 816 F.2d 68, 73 (2d  
4 Cir. 1987) (holding unauthorized importation and sale of Cabbage Patch dolls  
5 manufactured in Spain with the foreign language adoption papers and birth  
6 certificate infringed the plaintiff's trademark in Cabbage Patch dolls "even  
7 though the goods do bear [plaintiff's] trademark and were manufactured under  
8 license with [the plaintiff]," because plaintiff's "domestic good will is being  
9 damaged by consumer confusion caused by the importation of the [Spanish]  
10 dolls," which were materially different from American dolls). The district court  
11 therefore erred in applying its narrow conception of confusion relevant to  
12 infringement claims.

### 13 **B. Infringement of Certification Marks**

14 In addition to erroneously treating source confusion as the only relevant  
15 type of confusion, the district court also took an erroneously narrow view of how  
16 certification marks can be infringed. There are numerous ways in which a  
17 certification mark can be infringed. Two of the most well-established "[e]xamples

1 of infringement of a certification mark are: the use of the mark in a resume of a  
2 professional who is in fact not certified by the organization that is the owner of  
3 the mark; and the use of the mark on goods that have not in fact been certified.”  
4 McCarthy § 19:92.50 (footnotes omitted); *see, e.g., Am. Bd. of Psychiatry and*  
5 *Neurology, Inc.*, 129 F.3d at 6 (holding that defendant, a physician and psychiatrist  
6 who claimed in a resume and in court that she was certified by the American  
7 Board of Psychiatry and Neurology, but was not in fact certified, likely infringed  
8 plaintiff’s registered certification mark). In addition, it is clear that a competing  
9 certifier may infringe a certification mark by using a certification mark  
10 confusingly similar to the certification mark of another certifying body. *See, e.g.,*  
11 *Levy*, 104 F.3d at 39 (reasoning that “[b]ecause the various kosher certification  
12 agencies employ their own standards for accepting products as kosher, according  
13 to their particular interpretation of Judaism’s dietary requirements, it is  
14 important for a consumer to recognize the marks of the certification agencies that  
15 he trusts,” and discussing whether the alleged infringing mark is “confusingly  
16 similar” to the plaintiffs’ mark); *Am. Angus Ass’n v. Sysco Corp.*, 829 F. Supp. 807,  
17 819 (W.D.N.C. 1992) (enjoining defendant’s use of “Supreme Certified Angus

1 Beef” as likely to cause confusion with plaintiff’s certification “Certified Angus  
2 Beef,” because “there is almost a certainty that customers will be led to believe  
3 [Certified Angus Beef] has introduced a new line”).

4 But these are not the exclusive means of infringing on a certification mark.

5 Although the district court expressed skepticism that “it is possible for the  
6 CISSP® certification mark to be infringed by a party who has met all the  
7 requirements for certification,” *see IISCC*, 2014 WL 3891287, at \*6, the  
8 Trademark Board has previously considered almost precisely this issue and  
9 determined that infringement is possible under these circumstances. The  
10 Trademark Board reviews applications to register or cancel trademarks,  
11 including certification marks, and it therefore considers whether an application  
12 for a new, or junior, mark should be denied on the ground that it is likely to  
13 cause confusion with a preexisting, or senior, mark. The context in which the  
14 Trademark Board considers likelihood of confusion is therefore somewhat  
15 different. *See Levy*, 104 F.3d at 41-42 (explaining that the Trademark Board  
16 considers only the “registrability of the applicant’s mark exactly as shown in the  
17 application and only as to the goods listed, *regardless of actual usage*,” and

1 determinations are often made “only upon a limited comparison of the registered  
2 or applied-for format and goods without regard for their marketplace manner of  
3 use,” whereas the *Polaroid* factors apply in actions for trademark infringement  
4 (quoting *Jim Beam Brands Co. v. Beamish & Crawford Ltd.*, 937 F.2d 729, 734 (2d Cir.  
5 1991))). Nonetheless, the Trademark Board’s reasoning is instructive.

6         The Trademark Board has determined that the junior user’s certification  
7 status is irrelevant to whether it causes a likelihood of confusion with a senior  
8 certification mark. The Trademark Board “has indicated that even where a  
9 defendant’s product contains ingredients which have been certified by the owner  
10 of a certification mark, the defendant’s incorporation of that certification mark  
11 into its own composite trademark might be likely to cause confusion as to  
12 sponsorship, affiliation or connection.” McCarthy § 19:92.50 (citing *Institut Nat’l*  
13 *Des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875 (T.T.A.B.  
14 1998) (denying summary judgment because it is possible that the applicant’s  
15 “Canadian Mist and Cognac” trademark for a blend of Canadian whiskey and  
16 genuine Cognac brandy would create a likelihood of confusion with a  
17 preexisting certification mark for “Cognac”)). For example, in a precedential

1 decision, the Trademark Board refused to register a new certification mark  
2 “Darjeeling Nouveau” for tea, because it was likely to cause consumer confusion  
3 with the preexisting, registered certification mark “Darjeeling,” for tea certified  
4 from the Darjeeling District of West Bengal, India. *See Tea Bd. of India v. Republic*  
5 *of Tea, Inc.*, 80 U.S.P.Q.2d 1881 (T.T.A.B. 2006). The Trademark Board held that  
6 the fact that applicant’s “Darjeeling Nouveau” tea was, in all circumstances,  
7 made entirely of genuine, certified “Darjeeling” tea, and merely purported to  
8 meet *higher* standards as the “first press,” was irrelevant. *Id.* (“[T]he fact that a  
9 user’s products may be genuine, whether in whole or in part, is simply irrelevant  
10 and is not a defense to a likelihood of confusion claim.”).

11 Accordingly, although a person who is not certified can infringe a  
12 certification mark by engaging in unlicensed use of the mark, this is not the only  
13 manner of misusing a certification mark that is cognizable in an infringement  
14 suit. Just as it would infringe the “Darjeeling” certification mark for a competitor  
15 to identify genuine, certified Darjeeling tea with its own composite mark  
16 “Darjeeling Nouveau,” *id.*, the district court erred in failing to consider that SU

1 may have infringed on ISC<sup>2</sup>'s certification mark by identifying its certified  
2 instructor as "Master CISSP" and "CISSP Master."

3       Importantly, it is not a prerequisite to ISC<sup>2</sup>'s claim of infringement "that  
4 the defendant was using the allegedly infringing content 'as a [certification]  
5 mark.'" *Kelly-Brown*, 717 F.3d at 308. Accordingly, SU's use of the terms "CISSP  
6 Master" and "Master CISSP" can infringe ISC<sup>2</sup>'s certification mark, even if SU is  
7 not attempting to compete with ISC<sup>2</sup> by offering its own "CISSP Master" or  
8 "Master CISSP" certification. Nor is it required that ISC<sup>2</sup> actually offer a "CISSP  
9 Master" or "Master CISSP" certification to succeed. *See Gay Toys, Inc.*, 658 F.2d at  
10 79 ("On the question of . . . the likelihood of confusion, it is not necessary that  
11 [the plaintiff] actually manufacture the toy cars [the defendant created to  
12 resemble the cars in the plaintiff's movie], but merely that a confusion as to . . .  
13 *sponsorship* result." (emphasis added)). Even though neither ISC<sup>2</sup> nor SU offers a  
14 "Master CISSP" or "CISSP Master" certification, "customers [may] be led to  
15 believe [ISC<sup>2</sup>] has introduced a new line" of certifications. *Am. Angus Ass'n*, 829  
16 F. Supp. at 819; *see also* McCarthy § 23:50 ("The Trademark Board has said that  
17 the general rule is that a subsequent user may not avoid likely confusion by

1 appropriating another's entire mark and adding descriptive or non-distinctive  
2 matter to it." (footnote omitted)).<sup>4</sup> As in all infringement suits in this Circuit, the  
3 relevant inquiry is simple: whether there is "a likelihood that an appreciable  
4 number of ordinarily prudent purchasers are likely to be misled, or indeed  
5 simply confused, as to the source of the goods in question, or that there may be  
6 confusion as to plaintiff's sponsorship or endorsement of the junior mark."  
7 *Hormel Foods Corp.*, 73 F.3d at 502 (internal quotation marks omitted).

8 **C. Likelihood of Confusion in Nominative Use Cases**

9 Having determined that the district court erred in considering only source  
10 confusion and erroneously limiting the ways in which certification marks can be  
11 infringed, we turn to the question of how the district court should assess  
12 likelihood of confusion on remand.

13 As discussed above, our Court's test for assessing likelihood of confusion  
14 is the *Polaroid* test. As noted, courts are to consider the following eight non-  
15 exclusive factors:

---

<sup>4</sup> On the other hand, these facts might be taken into account in assessing such *Polaroid* factors as "proximity of the products and competitiveness with one another" and the possibility that the "senior user may 'bridge the gap' by developing a product for sale in the market of the alleged infringer's product." *Starbucks Corp.*, 588 F.3d at 115.

1 (1) strength of the trademark; (2) similarity of the marks; (3) proximity of  
2 the products and their competitiveness with one another; (4) evidence that  
3 the senior user may “bridge the gap” by developing a product for sale in  
4 the market of the alleged infringer’s product; (5) evidence of actual  
5 consumer confusion; (6) evidence that the imitative mark was adopted in  
6 bad faith; (7) respective quality of the products; and (8) sophistication of  
7 consumers in the relevant market.

8  
9 *Starbucks Corp.*, 588 F.3d at 115. This Court has repeatedly urged district courts to  
10 apply the *Polaroid* factors even “where a factor is irrelevant to the facts at hand.”  
11 *Arrow Fastener Co.*, 59 F.3d at 400 (“[I]t is incumbent upon the district judge to  
12 engage in a deliberate review of each factor, and, if a factor is inapplicable to a  
13 case, to explain why.”).

14 The district court, rather than applying the *Polaroid* factors, applied the  
15 Ninth Circuit’s test which applies in cases of nominative use of marks.  
16 Nominative use is a “use of another’s trademark to identify, not the defendant’s  
17 goods or services, but the plaintiff’s goods or services.” *McCarthy* § 23:11. It is  
18 called “nominative” use “because it ‘names’ the real owner of the mark.” *Id.* “The  
19 doctrine of nominative fair use allows a defendant to use a plaintiff’s trademark  
20 to identify the plaintiff’s goods so long as there is no likelihood of confusion  
21 about the source of the defendant’s product or the mark-holder’s sponsorship or

1 affiliation." *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 102 (2d Cir. 2010) (alterations  
2 and internal quotation marks omitted). Because the *Polaroid* factors—or their  
3 analogues in other circuits—are not easily applied in cases of nominative use,  
4 various courts have created new tests to apply in such circumstances. The Ninth  
5 Circuit's nominative fair use doctrine stems from its decision in *New Kids on the*  
6 *Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992). In that case, a  
7 newspaper conducted a survey in connection with a story about a concert by the  
8 pop music group "New Kids on the Block," asking readers "Which of the five is  
9 your fave?" and invoking the name of the group. *Id.* at 304. The Ninth Circuit  
10 held that this was a non-infringing "nominative use of a mark" which did not  
11 imply sponsorship or endorsement by the trademark owner. The Ninth Circuit  
12 adopted the following test for nominative fair use:

13 First, the product or service in question must be one not readily  
14 identifiable without use of the trademark; second, only so much of  
15 the mark or marks may be used as is reasonably necessary to  
16 identify the product or service; and third, the user must do nothing  
17 that would, in conjunction with the mark, suggest sponsorship or  
18 endorsement by the trademark holder.

19  
20 *Id.* at 308 (footnote omitted). Other circuits have adopted variations of this test.

21 See, e.g., *Universal Commc'n Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 424 (1st Cir. 2007);

1 *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 220-22 (3d Cir. 2005);  
2 *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546-47 (5th Cir. 1998), *abrogated on*  
3 *other grounds by Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

4 In the Ninth Circuit, nominative fair use is not an affirmative defense  
5 because it does not protect a defendant from liability if there is, in fact, a  
6 likelihood of consumer confusion. Rather, the nominative fair use test replaces  
7 the multi-factor test that the Ninth Circuit typically employs to determine  
8 consumer confusion, i.e., it replaces the Ninth Circuit's analogue to the *Polaroid*  
9 test. *See Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150-51 (9th Cir. 2002); *accord*  
10 *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010); *Mattel,*  
11 *Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003); *see also*  
12 McCarthy § 23:11 (“The Ninth Circuit, in crafting a separate category of a  
13 ‘nominative fair use’ analysis, created a specialized tool to analyze a certain class  
14 of cases of alleged infringement. . . . The Ninth Circuit did not intend nominative  
15 fair use to constitute an affirmative defense.”).

16 By contrast, the Third Circuit, another court to have developed a  
17 nominative fair use doctrine, affords defendants broader protection. The Third

1 Circuit treats nominative fair use as an affirmative defense that may be asserted  
2 by the defendant despite a likelihood of consumer confusion. To be entitled to  
3 protection based on the affirmative defense, a defendant must show

4 (1) that the use of plaintiff's mark is necessary to describe both the  
5 plaintiff's product or service and the defendant's product or service;  
6 (2) that the defendant uses only so much of the plaintiff's mark as is  
7 necessary to describe plaintiff's product; and (3) that the defendant's  
8 conduct or language reflect the true and accurate relationship  
9 between plaintiff and defendant's products or services.

10

11 *Century 21 Real Estate Corp.*, 425 F.3d at 222.

12 To this point, this Court has not adopted either the Ninth Circuit or the  
13 Third Circuit's rule on nominative fair use. *See Tiffany (NJ) Inc.*, 600 F.3d at 102  
14 (affirming the district court's decision that applied the doctrine of nominative  
15 fair use on other grounds); McCarthy § 23:11. Nonetheless, district courts within  
16 our Circuit frequently use the Ninth Circuit's formulation. *See, e.g., Car-Freshner*  
17 *Corp. v. Getty Images, Inc.*, 822 F. Supp. 2d 167, 177-78 (N.D.N.Y. 2011); *Audi AG v.*  
18 *Shokan Coachworks, Inc.*, 592 F. Supp. 2d 246, 269-70 (N.D.N.Y. 2008) (collecting  
19 cases); *Yurman Studio, Inc. v. Castaneda*, 591 F. Supp. 2d 471, 500-02 (S.D.N.Y.  
20 2008); *M. Shanken Commc'ns, Inc. v. Cigar500.com*, No. 07 CIV. 7371 (JGK), 2008  
21 WL 2696168, at \*11 (S.D.N.Y. July 7, 2008); *Merck & Co. v. Mediplan Health*

1 *Consulting, Inc.*, 425 F. Supp. 2d 402, 413 (S.D.N.Y. 2006). Further, as discussed  
2 below we have endorsed the principles underlying the nominative fair use  
3 doctrine. *See Tiffany (NJ) Inc.*, 600 F.3d at 102-03; *Dow Jones & Co. v. Int'l Sec. Exch.*,  
4 *Inc.*, 451 F.3d 295, 308 (2d Cir. 2006).

5 Having considered the case law, as well as the positions of the United  
6 States Patent and Trademark Office,<sup>5</sup> we reject the Third Circuit's treatment of  
7 nominative fair use as an affirmative defense. The Lanham Act sets forth  
8 numerous affirmative defenses to infringement claims that can be asserted even  
9 if the plaintiff has established likelihood of confusion. *See* 15 U.S.C. § 1115(b). The  
10 Third Circuit's basis for treating nominative fair use as an affirmative defense is

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<sup>5</sup> We invited the United States Patent and Trademark Office to submit a letter brief regarding several issues to be decided in this appeal. It did so on August 14, 2015 and August 31, 2015, through submissions signed by the United States Patent and Trademark Office and the Department of Justice. "We consider the views expressed therein for persuasive value." *Serricchio v. Wachovia Sec. LLC*, 658 F.3d 169, 178 (2d Cir. 2011); *see also Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) ("We consider that the rulings, interpretations and opinions of the [agency], while not controlling upon the courts by reason of their authority, do constitute a body of experience and informed judgment to which courts and litigants may properly resort for guidance. The weight of such a judgment in a particular case will depend upon the thoroughness evident in its consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade, if lacking power to control.").

1 that the Supreme Court has treated classic, or descriptive, fair use as an  
2 affirmative defense. *See Century 21 Real Estate Corp.*, 425 F.3d at 222 (citing *KP*  
3 *Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118-20 (2004)).  
4 But in treating descriptive fair use as an affirmative defense, the Supreme Court  
5 was interpreting a provision of the Lanham Act which provided that claims of  
6 infringement are subject to various defenses, including

7 That the use of the name, term, or device charged to be an  
8 infringement is a use, otherwise than as a mark, of the party's  
9 individual name in his own business, or of the individual name of  
10 anyone in privity with such party, or of a term or device which is  
11 descriptive of and used fairly and in good faith only to describe the  
12 goods or services of such party, or their geographic origin . . . .

13  
14 15 U.S.C. § 1115(b)(4); *see KP Permanent Make-Up, Inc.*, 543 U.S. at 118-20  
15 (analyzing 15 U.S.C. § 1115(b)(4) and ultimately concluding that Congress  
16 intended descriptive fair use to be an affirmative defense). That is, under the  
17 Supreme Court's interpretation, the Lanham Act explicitly provides that  
18 descriptive fair use is an affirmative defense. And nominative fair use cannot fall  
19 within § 1115(b)(4)'s language, as nominative fair use is not the use of a name,  
20 term, or device otherwise than as a mark which is descriptive of and used merely  
21 to describe the goods or services of the alleged infringer. *See Cosmetically Sealed*

1 *Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997) (finding  
2 descriptive fair use when the alleged infringer engaged in a “non-trademark use  
3 of words in their descriptive sense”). Nominative use involves using the mark at  
4 issue *as a mark* to specifically invoke the mark-holder’s mark, rather than its use,  
5 other than as a mark, to describe the alleged infringer’s goods or services. If  
6 Congress had wanted nominative fair use to constitute an additional affirmative  
7 defense, it would have provided as such. We therefore hold that nominative fair  
8 use is not an affirmative defense to an infringement claim.

9       We turn next to the question of whether we should adopt a nominative fair  
10 use test, either to supplant or to replace the *Polaroid* test. Although we see no  
11 reason to replace the *Polaroid* test in this context, we also recognize that many of  
12 the *Polaroid* factors are a bad fit here and that we have repeatedly emphasized  
13 that the *Polaroid* factors are non-exclusive. And although we have not expressly  
14 rejected or accepted other circuits’ nominative fair use tests, we “have recognized  
15 that a defendant may lawfully use a plaintiff’s trademark where doing so is  
16 necessary to describe the plaintiff’s product and does not imply a false affiliation  
17 or endorsement by the plaintiff of the defendant.” *Tiffany (NJ) Inc.*, 600 F.3d at

1 102-03. *See also Dow Jones & Co.*, 451 F.3d at 308 (“While a trademark conveys an  
2 exclusive right to the use of a mark in commerce in the area reserved, that right  
3 generally does not prevent one who trades a branded product from accurately  
4 describing it by its brand name, so long as the trader does not create confusion  
5 by implying an affiliation with the owner of the product.”).

6 Because we believe that the nominative fair use factors will be helpful to a  
7 district court’s analysis, we hold that, in nominative use cases, district courts are  
8 to consider the Ninth Circuit and Third Circuit’s nominative fair use factors, in  
9 addition to the *Polaroid* factors.<sup>6</sup> When considering a likelihood of confusion in  
10 nominative fair use cases, *in addition to* discussing each of the *Polaroid* factors,  
11 courts are to consider: (1) whether the use of the plaintiff’s mark is necessary to  
12 describe both the plaintiff’s product or service and the defendant’s product or  
13 service, that is, whether the product or service is not readily identifiable without  
14 use of the mark; (2) whether the defendant uses only so much of the plaintiff’s  
15 mark as is necessary to identify the product or service; and (3) whether the  
16 defendant did anything that would, in conjunction with the mark, suggest

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<sup>6</sup> As we have emphasized with reference to the *Polaroid* factors, this combination of factors is not exclusive, and other factors may be considered where relevant.

1 sponsorship or endorsement by the plaintiff holder, that is, whether the  
2 defendant's conduct or language reflects the true or accurate relationship  
3 between plaintiff's and defendant's products or services.

4       When assessing the second nominative fair use factor, courts are to  
5 consider whether the alleged infringer "step[ped] over the line into a likelihood  
6 of confusion by using the senior user's mark too prominently or too often, in  
7 terms of size, emphasis, or repetition." McCarthy § 23:11; *see, e.g., PACCAR Inc. v.*  
8 *TeleScan Technologies, L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003) ("Using [the  
9 plaintiff's] trademarks in its domain names, repeating the marks in the main  
10 titles of the web sites and in the wallpaper underlying the web sites, and  
11 mimicking the distinctive fonts of the marks go beyond using the marks 'as is  
12 reasonably necessary to identify' [the plaintiff's] trucks, parts, and dealers."),  
13 *abrogated on other grounds by KP Permanent Make-Up, Inc.*, 543 U.S. at 116-17;  
14 *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 908 (9th Cir. 2003) (considering the  
15 fact that the defendant used the mark "'The Beach Boys' more prominently and  
16 boldly" than the rest of its name "The Beach Boys Family and Friends" such that  
17 event organizers and members of the audience were confused about who was

1 performing); *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 804 (9th Cir. 2002)  
2 (holding that defendant's repeated use of the abbreviation "PMOY '81" meaning  
3 "Playmate of the Year 1981" on the background/wallpaper of her website failed  
4 to establish nominative fair use because "[t]he repeated depiction of "PMOY '81'  
5 is not necessary to describe [the defendant]"), *abrogated on other grounds by Miller*  
6 *v. Gammie*, 335 F.3d 889 (9th Cir. 2003); *cf. Swarovski Aktiengesellschaft v. Building*  
7 *No. 19, Inc.*, 704 F.3d 44, 51-52 (1st Cir. 2013) (reversing preliminary injunction  
8 restricting discount retailer from using large size font in advertising sale of  
9 "Swarovski" crystal figurines because lower court erred by assuming that retailer  
10 used "more of the mark than necessary" without determining if large size font  
11 was likely to cause consumer confusion).

12         Additionally, when considering the third nominative fair use factor, courts  
13 must not, as the district court did here, consider only source confusion, but  
14 rather must consider confusion regarding affiliation, sponsorship, or  
15 endorsement by the mark holder. *See Courtenay Commc'ns Corp. v. Hall*, 334 F.3d  
16 210, 213 n.1 (2d Cir. 2003) (vacating dismissal of Lanham Act claims and holding  
17 nominative fair use did not supply alternative grounds for dismissal because

1 defendant's "hyperlink connection to a page of endorsements suggests  
2 affiliation, sponsorship, or endorsement by" the plaintiff (internal quotation  
3 marks omitted)).

4 We therefore remand for reconsideration of the *Polaroid* factors in addition  
5 to the nominative fair use factors, keeping in mind the numerous types of  
6 confusion that are relevant to an infringement analysis other than mere source  
7 confusion and the numerous ways in which a certification mark may be  
8 infringed.<sup>7</sup>

### 9 **III. Remaining Claims**

10 We now turn to ISC<sup>2</sup>'s remaining claims. First, we affirm the district  
11 court's ruling on ISC<sup>2</sup>'s trademark dilution claims, which was not challenged on  
12 appeal. ISC<sup>2</sup> argues that the district court's rulings on the other claims—the false  
13 designation of origin and the CUTPA claims—should be vacated for the same  
14 reasons as the court's ruling on the infringement claims. We agree. The district  
15 court decided the false designation of origin claims in the same erroneous  
16 manner in which it decided the infringement claims, and its ruling must

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<sup>7</sup> The district court may, in its discretion, invite further briefing on these issues before ruling again on summary judgment.

1 therefore be vacated. Finally, the district court held that the CUTPA claims were  
2 derivative of the Lanham Act claims and, because the Lanham Act claims failed,  
3 so did the CUTPA claims. Because we reinstate the Lanham Act infringement  
4 and false designation of origin claims, we also vacate the district court's  
5 summary judgment ruling on the CUTPA claims.

### 6 CONCLUSION

7 For the foregoing reasons, we VACATE the district court's grant of  
8 summary judgment on ISC<sup>2</sup>'s infringement, false designation of origin, and  
9 CUTPA claims, and REMAND for further proceedings consistent with this  
10 opinion. We AFFIRM the district court's grant of summary judgment on ISC<sup>2</sup>'s  
11 trademark dilution claims.

**United States Court of Appeals for the Second Circuit  
Thurgood Marshall U.S. Courthouse  
40 Foley Square  
New York, NY 10007**

**ROBERT A. KATZMANN**  
CHIEF JUDGE

Date: May 18, 2016  
Docket #: 14-3456cv  
Short Title: International Information Syst v. Security  
University, LLC

**CATHERINE O'HAGAN WOLFE**  
CLERK OF COURT

DC Docket #: 10-cv-1238  
DC Court: CT (NEW HAVEN)  
DC Judge: Shea

**BILL OF COSTS INSTRUCTIONS**

The requirements for filing a bill of costs are set forth in FRAP 39. A form for filing a bill of costs is on the Court's website.

The bill of costs must:

- \* be filed within 14 days after the entry of judgment;
- \* be verified;
- \* be served on all adversaries;
- \* not include charges for postage, delivery, service, overtime and the filers edits;
- \* identify the number of copies which comprise the printer's unit;
- \* include the printer's bills, which must state the minimum charge per printer's unit for a page, a cover, foot lines by the line, and an index and table of cases by the page;
- \* state only the number of necessary copies inserted in enclosed form;
- \* state actual costs at rates not higher than those generally charged for printing services in New York, New York; excessive charges are subject to reduction;
- \* be filed via CM/ECF or if counsel is exempted with the original and two copies.

**United States Court of Appeals for the Second Circuit  
Thurgood Marshall U.S. Courthouse  
40 Foley Square  
New York, NY 10007**

**ROBERT A. KATZMANN**  
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**VERIFIED ITEMIZED BILL OF COSTS**

Counsel for

\_\_\_\_\_

respectfully submits, pursuant to FRAP 39 (c) the within bill of costs and requests the Clerk to prepare an itemized statement of costs taxed against the

\_\_\_\_\_

and in favor of

\_\_\_\_\_

for insertion in the mandate.

Docketing Fee \_\_\_\_\_

Costs of printing appendix (necessary copies \_\_\_\_\_ ) \_\_\_\_\_

Costs of printing brief (necessary copies \_\_\_\_\_ ) \_\_\_\_\_

Costs of printing reply brief (necessary copies \_\_\_\_\_ ) \_\_\_\_\_

**(VERIFICATION HERE)**

\_\_\_\_\_  
Signature