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Banner & Witcoff Ltd

Ninth Circuit refuses to swallow nominative fair use defence

In [Horphag Research Ltd v Garcia](#), the Ninth Circuit Court of Appeals has upheld a district court's trademark infringement decision, holding that the defendant's unauthorized use of Horphag's PYCNOGENOL mark in the text and metatags of his website was not a fair use. However, the appellate court reversed and remanded the lower court's ruling on Horphag's dilution claim.

[Horphag](#), a UK-based manufacturer of nutritional products, owns the pharmaceutical trademark PYCNOGENOL for dietary supplements made from the bark of French maritime pine trees. Larry Garcia was using the term 'pynogenol' and the phrase 'Masquelier's: the original French pynogenol' in the text and metatags of a website selling various pharmaceutical products. Horphag filed for summary judgment against Garcia, alleging trademark infringement, dilution and false designation of origin.

Garcia contended that he was simply using the mark to compare his product to Horphag's, and pointed to a number of nominative fair use cases in which the unauthorized use of another party's trademark in comparative advertising had not resulted in trademark infringement. The district court rejected Garcia's defence and granted Horphag summary judgment on all counts. Garcia appealed.

The Ninth Circuit affirmed the lower court's finding on the trademark infringement issues, but reversed and remanded the dilution claims for re-determination in light of the Supreme Court's findings in [Moseley v V Secret Catalogue Inc](#) (for discussion of this case, see [Federal Trademark Dilution Act requires proof of actual harm](#)). The Ninth Circuit rejected Garcia's nominative fair use defence to the trademark infringement claims, stating that he had failed to satisfy the three factors that must be taken into consideration when assessing the defence, namely:

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

The court held that although Garcia could satisfy the first factor, he was unable to meet the second or third. His use of Horphag's mark and variants thereof on his website, said the court, was (i) in excess of reasonable necessity for such use, and (ii) likely to suggest that Horphag sponsored or was associated with his website or products.

Brian Banner, Banner & Witcoff Ltd, Washington DC