

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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.,

4
5 *Plaintiff-Counter-Defendant-Appellant,*

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7 v.

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9 Security University, LLC, Sondra Schneider,

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11 *Defendants-Counter-Claimants-Appellees.*

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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.

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17 _____
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19
20 POOLER, *Circuit Judge:*

21 Plaintiff-appellant International Information Systems Security Certification
22 Consortium, Inc. (“ISC²”) filed suit against defendants-appellees Security
23 University (“SU”) and Sondra Schneider, alleging that SU’s use of ISC²’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. ISC²'s Mark

7 ISC² is a non-profit organization that was formed in 1989 to develop
8 standards for the information security industry. In March 1990, ISC² 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 ISC² administers.

13 On March 18, 1997, the United States Patent and Trademark Office
14 registered ISC²'s CISSP® certification mark. The registration stated: "The
15 [CISSP®] certification mark is used by persons authorized by the certifier [ISC²]
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 ISC²’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 ISC²’s certification mark, SU
12 instructors may accurately identify themselves as being CISSP®-certified, so long
13 as they follow ISC²’s regulations governing the use of the mark.¹

¹ Upon meeting ISC²’s certification standards, ISC² licenses an individual to use the CISSP® mark in accordance with the “(ISC)² ® 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, ISC² objects to some of SU's advertisements, run between 2010
2 and 2012, which, ISC² 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!" 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 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

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

1 SU began using the term "Master" in May 2010. On June 9, 2010, ISC²'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 ISC²'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, ISC²'s counsel "again wrote to Ms.
10 Schneider requesting that she and SU cease and desist their improper
11 advertising." *Id.* Although ISC²'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. ISC²' Claims**

3 On August 3, 2010, ISC² filed a complaint against SU, alleging that SU's
4 willful actions in refusing to cease its improper use of ISC²'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, ISC² 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 ISC²'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 ISC²'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 ISC²'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 ISC²'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 ISC²'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)² itself is offering the classes.” *Id.* at *5.²

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 ISC². 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)²®.
- 14
- 15 • CISSP® is a registered trademark of (ISC)²®.
- 16
- 17 • CISSP® is a registered trademark of (ISC)²® (International
18 Information Systems Security Certification Consortium) Inc.
- 19

² 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)².” *IISCCC*, 2014 WL 3891287, at *5 (emphasis added).

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

Id. at *7.

Without further analysis, the district court concluded that ISC²'s claims for false advertising or false designation of origin, in violation of 15 U.S.C. § 1125(a), similarly failed under the doctrine of nominative fair use. The district court then concluded that ISC²'s trademark dilution claims failed because ISC² had failed to raise a genuine dispute of material fact as to whether its CISSP® certification mark was sufficiently famous to warrant protection from trademark dilution. Finally, the district court dismissed the CUTPA claims as concededly derivative of the Lanham Act claims.

DISCUSSION

I. Certification Marks

A "certification mark," such as CISSP®, is a special sub-category of marks 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 ISC²’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 ISC²’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.³ 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

³ 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 ISC²'s certification mark by identifying its certified
2 instructor as "Master CISSP" and "CISSP Master."

3 Importantly, it is not a prerequisite to ISC²'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 ISC²'s certification mark, even if SU is
7 not attempting to compete with ISC² by offering its own "CISSP Master" or
8 "Master CISSP" certification. Nor is it required that ISC² 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 ISC² nor SU offers a
14 "Master CISSP" or "CISSP Master" certification, "customers [may] be led to
15 believe [ISC²] 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)).⁴ 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:

⁴ 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,⁵ 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

⁵ 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.⁶ 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

⁶ 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.⁷

9 **III. Remaining Claims**

10 We now turn to ISC²’s remaining claims. First, we affirm the district
11 court’s ruling on ISC²’s trademark dilution claims, which was not challenged on
12 appeal. ISC² 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

⁷ 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 ISC²'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 ISC²'s
11 trademark dilution claims.