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FIXING NOMINATIVE FAIR USE: AN ANALYSIS OF NOMINATIVE USE JURISPRUDENCE AND A SUGGESTION ON HOW TO RESOLVE ITS CONFLICTS

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I. INTRODUCTION

Trademarks are highly beneficial tools. They allow producers to indicate to consumers the quality of their goods and permit those producers to build valuable brand recognition through investments and years of service. Conversely, trademarks are important to consumers in that a mark has the ability to convey information to a potential buyer without that buyer knowing anything more about a product than a positive association with its trademark.

There are, however, limitations on what a producer may choose as his trademark. Words that have plain language meanings have limited potential as marks. There is a categorical bar on the use of a generic term as a trademark.¹ A company cannot claim rights in the word “chair” to sell chairs it might make. Descriptive words, though not completely barred from trademark usage, are given a smaller area of protection, as a competitor would be permitted to use that word in its ordinary language meaning to describe its own product.² Trademark law is not meant to monopolize the descriptive aspect of our language,³ and as such, when there is a conflict between the two, the use is generally permitted.

What then happens when a television channel wants to broadcast the Boston Marathon? Is that channel allowed to display the name “Boston Marathon,” a trademark of the Boston Athletic Association, on screen while broadcasting the event?⁴ What happens if a mechanic who specializes in

¹ 15 U.S.C. § 1064(3)(2005).

² 15 U.S.C. 1115(b)(4)(2006)(defining “classic fair use”).

³ See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 122, 118 (2004) (holding that a trademark may not create “a complete monopoly on use of a descriptive term”).

⁴ See *WCVB-TV v. Boston Athletic Ass'n.*, 926 F.2d 42, 44 (1st Cir. 1991).