



Name Calling: Using Someone Else's Trademark

The Journal Record - November 12, 2009

By [Rachel Blue](#)

Calling your new soft drink formula Coca-Cola when it's not "the real thing" would be trademark infringement, which occurs when the same or similar mark is used in a way that would lead to consumer confusion. But that doesn't mean you can never use a trademark that belongs to someone else.



Fair use: Identifying the trademark owner's goods or their origin is what's known as fair use, as long as it doesn't suggest that the trademark owner sponsored or endorsed the use. For example, a court allowed USA Today's use of the name New Kids on the Block in a "fan vote" poll even without the group's OK, because the group couldn't be easily identified without using its name, it was only used as necessary, and the poll didn't falsely imply that New Kids had sponsored or endorsed the contest.

Criticism and parody: The doctrine of "fair use" also dictates that you may utilize another's trademark to criticize the products or services it identifies, as long as you do so truthfully. In general, a company's right to control its trademark can't interfere with First Amendment rights.

In other words, free speech wins ... within limits. We can't use trademarks to make false or misleading criticisms or use that criticism to turn our own profit. For example, "gripe sites" that use a portion of a trademark in their name are generally protected speech, but you can't turn a profit selling protest products for your own commercial gain. So, it's OK to blog your opinion about your insurance company's claim denial, but you can't sell a "Mutant of Omaha" T-shirt.

Parody: A variation on the free speech defense, parody can be tricky. Sometimes, it's legal to use another's trademark as a target for parody. Mattel wasn't pleased with Aqua's Barbie Girl hit, claiming the song lyrics depicted Barbie as a party girl and tarnished her image. The court advised Mattel to "chill," ruling that the use was fair. However, the First Amendment won't protect trademark use as a parody if it conveys a false message or confuses consumers.

Dealers, distributors, and repair/replacement outlets: It's fine to use another's mark to truthfully say you perform repairs or stock replacement or compatible parts (We fix iPods! This software is compatible with Windows 2003). It's also OK to use a trademark to let the public know that you are an authorized distributor or dealer (a Ford dealership). Dealership agreements usually require dealers to display a trademark properly, so a dealer must use the special Ford script and include the registration symbol. No agreement? The use is probably still lawful provided it's not misleading about the product or its source or sponsorship. Advertising truthfully that paper pads fit a Swiffer dust mop is fine, but saying consumers can ditch their Swiffer pads because another pad works better could be false advertising without proof of the "better" claim.

Comparative advertising: The Federal Trade Commission encourages using competitors' names in comparative advertising, since that can provide consumers with information and promote competition. You can compare competing products, just don't confuse the buyer. The copy in the advertisement must be truthful, e.g. Advil could legally make the claim "Advil contains a nonprescription strength of ibuprofen, the medicine found in Motrin" because that statement was truthful.

The keys to using a trademark that isn't yours: 1. Be truthful. 2. Use the bare minimum to reference the product. 3. Avoid confusing the consumer.

Contact your own attorney for advice when you plan to make use of another's trademark.

Rachel Blue is an intellectual property lawyer with McAfee & Taft and a former trademark examining attorney with the U.S. Patent and Trademark Office.

This article appeared in the November 12, 2009 issue of [The Journal Record](#). It is reproduced with permission from the publisher. © The Journal Record Publishing Co.

OKLAHOMA CITY
TENTH FLOOR
TWO LEADERSHIP SQUARE
OKLAHOMA CITY, OK 73102-7103
(405) 235-9621 office • (405) 235-0439 fax

TULSA
500 ONEOK PLAZA
100 WEST 5TH STREET
TULSA, OK 74103
(918) 587-0000 office • (918) 599-9317 fax