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## Trademark Abuse by Jones Day to Suppress Free Speech

by Paul Alan Levy

A new entry in the contest for “grossest abuse of trademark law to suppress speech the plaintiff doesn’t like” comes from Chicago, where the giant law firm Jones Day has sued BlockShopper.com, a web site that reports on real estate purchases in two upscale specific Chicago neighborhoods, as well as in Las Vegas, Palm Beach, and St. Louis. The defendant’s crime? In discussing condo purchases by Jones Day associates Dan Malone and Jacob Tiedt [here](#) and [here](#), BlockShopper used the name “Jones Day” to identify the employer of each of the two associates, and linked from each associate’s name to Jones Day’s own web site [here](#) and [here](#).

According to Jones Day, linking to its web site dilutes its trademark and creates a likelihood of confusion. But that is preposterous. The link is in connection with a comment on Jones Day; when a trademark is used to comment on the trademark holder, the use reinforces the association with the trademark holder, rather than blurring it, and besides use for commentary is expressly protected as fair use under the Lanham Act as amended in 2006. Moreover, nobody could visit the BlockShopper web site and think that it is sponsored by or affiliated with Jones Day, even if they follow the links from BlockShopper’s mention of Jones Day associates to Jones Day’s own web site. That is what web sites do – they link to other web sites (that’s what makes it a “World Wide Web”).

Indeed, throughout the first paragraph above, I used Jones Day’s name (because I am writing about that firm) and linked to Jones Day’s web site and elsewhere. Is Public Citizen equally liable for trademark infringement and dilution? If Jones Day is right here, it is hard to see how the Web could survive.

Since the theory of the law suit is so silly, one has to wonder why Jones Day brought this suit. I called two of the Jones Day lawyers on the case, but one of them did not return my call, while the other said “we don’t comment on matters in litigation.” A story in the National Law Journal suggests that there may have been privacy concerns about identifying associates and showing where they live, but there is no hint of a privacy cause of action in the complaint. The complaint does mention that the associates’ photographs on BlockShopper appear to be taken from the Jones Day web site, but no copyright claim is alleged, and besides it is hard to believe that Jones Day would go to such great lengths to protect its copyright in photographs of its associates. The conclusion follows that Jones Day is simply using an unsustainable legal theory, as well as the threat of ruin by litigation against a huge law firm, to try to bully Blockshopper.com into submission.

Regrettably, the trial judge himself reportedly played into this strategy at the hearing on the temporary restraining order. Judge Darrah reportedly tried to encourage the defendants to give up their rights by saying “Do you know, young man, how much money it’s going to cost you to defend yourselves against Jones Day?” Not surprisingly after the judge announced what side he was on, BlockShopper stipulated to a TRO barring any links to Jones Day’s web site or mentions of Jones Day on BlockShopper’s web site.

It’s bad enough the big law firms throw their weight around to intimidate those who exercise their free speech rights, and any litigator knows that judges often try to “assist” the parties to settle their cases to avoid unnecessary litigation, but such comments, if actually made, suggest that Judge Darrah’s further dealings with this case will require public scrutiny.

Jones Day’s papers in the case make other curious points.

1. Jones Day brings a federal dilution claim even though it would seem to be quite a stretch to characterize Jones Day as a “famous” mark. (As amended in 2006, the Lanham Act requires that a mark be “widely recognized by the general consuming public of the United States.” Jones Day is certainly well-known in the legal community, but it is doubtful that most consumers have ever heard of it).
2. Jones Day apparently argues that the use of its trademarks is an improper “commercial” use of its trademarks because BlockShopper.com carries advertising. Perhaps Jones Day would argue that my linking to its web site in this blog post is different from what BlockShopper.com did. But on that same theory, a report on Jones Day in the

New York Times would also be commercial speech, actionable under the trademark laws, because the Times carries advertising. That cannot be right.

3. Jones Day's complaint also recites other cases in which Jones Day has taken action against use of its trademark online, and mentions a 2005 case brought in the Northern District of Ohio against a cybergriper who "was using [www.jonesdays.com](http://www.jonesdays.com) to disparage Jones Day." One certainly wonders how Jones Day could have prevailed in such a case, because the Sixth Circuit ruled both in 2003, in Taubman Company v. WebFeats, and in 2004, in Lucas Nursery v Grosse, that the use of a trademark in a domain name for a web site that comments on the trademark holder is not actionable. Sure enough, the docket in that case, Jones Day v. Pankajkumar Patel, reveals a case in which Jones Day abused its reputation and its status as a huge hometown firm to obtain results to which it was not entitled. First, Jones Day filed suit and obtained an ex parte ruling granting a temporary restraining order based on a brief in which Jones Day failed to disclose either of these controlling appellate decisions. The pro se defendant, who lived in England, filed an "answer" and motion to dismiss raising the issues of fair use and lack of jurisdiction; the judge dismissed that motion and, on the same day, issued a permanent injunction. So, Jones Day did win that case, but in the circumstances one wonders why it is calling attention to the case.

It thus appears that Jones Day is a serial abuser of the trademark laws to suppress commentary that it does not like. Bullies like this need to be resisted. We can only hope that Judge Darrah gets past Jones Day's reputation and gives fair consideration to the First Amendment and the pure silliness of the trademark claim.

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