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Introduction

Plaintiffs Jenzabar, Ling Chai, and Richard Maginn brought this defamation and trademark action against Long Bow Group because of their displeasure with Long Bow's portrayal of Chai in a documentary film, and of Chai and the other plaintiffs in newspaper articles that appear on part of Long Bow's web site at www.tsquare.tv. Despite dismissal of the defamation claims, Jenzabar persists in pursuing a trademark claim because keyword meta tags on pages discussing Jenzabar include "Jenzabar" and "Jenzabar.com" (the "Marks"), and one of those pages is among the first ten Google search results when "Jenzabar" is used as a Google search term. Invoking the doctrine of "initial interest confusion," Jenzabar claims that the meta tags infringe and dilute the Marks.

As shown below, the lawsuit is frivolous. First, Jenzabar relies only on uninformed speculation to argue that the keyword meta tags caused Long Bow's Jenzabar-related page to appear high on the Google search results; in fact Google itself has stated in no uncertain terms that it does not consider keyword meta tags in determining search rankings, and stopped taking those meta tags into account "many years ago." Thus, the central factual premise of Jenzabar's case is false. Second, even were there a factual basis to assert that meta tags caused this one page to appear among the first ten search results, the meta tags correctly portray the content of that web page as being about Jenzabar. Jenzabar's invocation of government authority (that is, this Court) to suppress the communication of truthful, non-commercial speech about the presence of Jenzabar-related information on that page runs afoul of the First Amendment. Third, construing the trademark laws in light of the First Amendment to avoid needless adjudication of First Amendment questions, neither the doctrine of initial interest confusion nor any of Jenzabar's other theories form a sound basis for allowing Jenzabar's claim to proceed to trial. Fourth, even considering this case in ordinary trademark terms, such as the "likelihood of confusion" factors and the defense of fair use, summary

judgment should be granted dismissing this action.

In opposition to Long Bow's motion to dismiss, Jenzabar argued principally that it would be "premature" to reject the trademark claims at the pleading stage. Because Jenzabar's complaint used labels, conclusions, and allegations that the Court felt rule-bound to accept, the Court declined to dismiss the trademark claims but noted the likelihood that Jenzabar's claims would fail. Discovery has since shown that Jenzabar cannot prevail. The allegations that led this Court to decline dismissal under Rule 12(b)(6) are false, and Jenzabar no longer can plead for patience. The Court should enter summary judgment in Long Bow's favor and dismiss Jenzabar's remaining claims.

BRIEF SUMMARY OF MATERIAL UNDISPUTED FACTS

Long Bow is a non-profit corporation that makes award-winning documentary films about China. SF 1-2. Its most notable film, the 1995 documentary *The Gate of Heavenly Peace* (the "Film"), studied the 1989 Tiananmen Square student protests. SF 2. Long Bow operates a web site at www.tsquare.tv that serves as a resource for viewers interested in information about China, the Film, the protests, and the key figures from the protests. SF 5.

One of the key figures from the protests, and one of the key characters in the Film, is Ling Chai ("Chai"). SF 8. In 1998, almost 10 years after the protests, Chai founded Jenzabar, a computer software company that sells complex enterprise software solutions to colleges and universities. SF 24-25. Chai now serves as Jenzabar's President and Chief Operating Officer. SF 24. Her husband, Robert Maginn ("Maginn"), is Chairman and Chief Executive Officer. *Id.* Since at least 1999, Chai and Jenzabar have received considerable attention from the news media. SF 8, 14. Much of that attention has focused on Chai's unique biography, controversy over Chai's efforts to promote Jenzabar using her biography, and a series of lawsuits, disputes, and allegations concerning Jenzabar's business practices. SF 14, 16.

Because Chai was a key figure in the protests and one of the key figures in the Film, Long Bow's web site includes pages that provide publicly available information about her and Jenzabar. SF 8. This information includes quotes from and links to a few of the news articles that report on some of the lawsuits, disputes, and controversies that have involved Jenzabar, including articles from the *Boston Globe*, *Forbes*, and the *Chronicle of Higher Education*. SF 8, 14, 16.

A meta tag is hypertext markup language ("HTML") code, invisible to the Internet user, that permits web designers to describe their web page. SF 9. Four of the pages that were on Long Bow's web site at the time of the complaint have, among their keyword meta tags, the words "jenzabar" or "jenzabar.com," which are Jenzabar's trademarks (the "Marks"). SF 9-10. All four pages (the "Jenzabar-related pages") report information about Jenzabar, and use the Marks as keyword meta tags to describe and index the pages' contents. SF 10. There are no references to Jenzabar in the meta tags of any pages that do not discuss Jenzabar. SF 12.

A link to one of these pages (the "main Jenzabar-related page" or "MJP") shows up among the first several results when a person uses the search engine Google and the word "jenzabar" to search the Internet for information about Jenzabar. SF 19-21. However, keyword meta tags are not considered in determining Google search rankings. SF 22. On the same list of search results, the first entry and several others lead directly to Jenzabar's own web sites, and another leads to a web page where this lawsuit is discussed. SF 19. None of the other pages about Jenzabar appear in even the first 100 search results for Internet users searching for information about Jenzabar. SF 23. Long Bow has operated the MJP since September 2001, and it operated a precursor to that page even earlier. SF 13. Long Bow has used the words "jenzabar" and "jenzabar.com" as keyword meta tags for that page for this entire period. *Id.* Long Bow did not know that Google listed the MJP as a top search result until August 2006, when a Jenzabar employee informed Long Bow of this fact. SF 20.

Jenzabar claims that Long Bow's use of the Marks in meta tags for pages about Jenzabar is trademark infringement, trademark dilution, and an unfair and deceptive business practice in violation of M.G.L. c. 93A. Summary judgment should be granted dismissing all of Jenzabar's claims.

STANDARD OF REVIEW

Summary judgment is required where "there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law." Mass. R. Civ. P. 56(c) "A party moving for summary judgment in a case in which the opposing party will have the burden of proof at trial is entitled to summary judgment if he demonstrates . . . that the party opposing the motion has no reasonable expectation of proving an essential element of that party's case." *Lambert v. Fleet National Bank*, 449 Mass. 119, 123 (2007). The record is examined in the light most favorable to the non-moving party, but "[c]onclusory statements, general denials, and factual allegations not based on personal knowledge [are] insufficient to avoid summary judgment." *Cullen Enters. v. Mass. Prop. Ins. Underwriting Ass'n*, 399 Mass. 886, 890 (1987).

ARGUMENT

I. THE FIRST AMENDMENT BARS JENZABAR'S CLAIMS BECAUSE THEY ARE DIRECTED TO LONG BOW'S TRUTHFUL AND NONCOMMERCIAL SPEECH.

Ordinarily, courts consider statutory issues first to avoid constitutional issues. However, trademark laws are customarily construed in light of the First Amendment, particularly insofar as it distinguishes between commercial and non-commercial speech. Accordingly, this brief begins with the First Amendment.

By asking the Court for an injunction and damages, Jenzabar is invoking government power to forbid expression by defendant Long Bow and to impose monetary remedies because of Long

Bow's expression. A court's orders are state action, and hence subject to the limitations of the First Amendment. *New York Times v. Sullivan*, 376 U.S. 254, 265-266 (1964); *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 418 (1971). Where a defendant is engaged in noncommercial speech, the application of trademark law may violate the First Amendment. *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 32-33 (1st Cir. 1987). Even when trademarks are used in a commercial context, courts construe the trademark laws narrowly to avoid impinging on First Amendment rights. E.g., *Cliffs Notes v. Bantam Doubleday*, 886 F.2d 490, 494 (2d Cir. 1989).¹

Ordinary trademark law standards cannot readily apply to noncommercial speech. The fundamental precept of infringement claims is that misleading trademark uses should be barred, because they are "likely" to "confuse" consumers. Use of the mark need not be deliberately confusing — intent is just one of several factors, *Machinists v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996) — and it need not actually constitute a "false" statement of origin. Trademark dilution claims do not even require confusion, but provide for relief when a rival use is "likely" to "tarnish" the reputation of the mark.

However, the First Amendment does not authorize regulating noncommercial speech simply because it is misleading or hurtful. For example, a political flyer or a newspaper article about a public figure could not be enjoined, or made the basis for an award of damages, simply because some readers would likely find it confusing. *O'Connor v. Superior Court*, 177 Cal.App.3d 1013, 1019, 223 Cal.Rptr 357, 361 (1986). The concept of regulating speech that has the potential to be misleading, even though it is not strictly speaking false, has developed over the thirty years since the Supreme Court first extended First Amendment protection to commercial speech. *Thompson v.*

¹All federal and other cases cited here, except published SJC and Appeals decisions, are in the attached Appendix of Authorities.

Western States Medical Center, 535 U.S. 357, 367 (2002); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001). Unlike noncommercial speech, commercial speech can be regulated even if it is “not provably false, or even wholly false, but only deceptive or misleading.” *Friedman v. Rogers*, 440 U.S. 1, 9 (1979). Thus, although “[a] company has the full panoply of protections available to its direct comments on public issues, . . . there is no reason for providing similar constitutional protection when such statements are made in the context of commercial transactions.” *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60 (1983).

Recognizing the First Amendment’s constraints, both the language of trademark statutes and the cases construing those laws limit the application of trademark law to noncommercial speech. Under the Federal Trademark Dilution Act, “any noncommercial use of the mark . . . shall not be actionable under this section.” 15 U.S.C. § 1125(c)(3)(C). See *Universal Communication Syst. v. Lycos*, 478 F.3d 413, 424 (1st Cir. 2007). And an infringement claim may be brought only against use of the mark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services.” 15 U.S.C. § 1114(1)(a). Courts have repeatedly held that this language limits the trademark laws to “commercial” uses and hence avoids conflict with First Amendment protection of noncommercial speech. *Bosley Medical v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003); *CPC Int’l v. Skippy*, 214 F.3d 456, 461 (4th Cir. 2000). When state trademark laws do not expressly exempt noncommercial speech, they should be read in pari materia with the federal statutes that do protect such speech; otherwise, they would be unconstitutional as applied to noncommercial parodic or critical uses of protected marks. *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987); *ACLU of Georgia v. Miller*, 977 F.Supp. 1228, 1233 (N.D. Ga. 1997); *Lighthawk v. Robertson*, 812 F.Supp. 1095, 1097-1101 (W.D. Wash. 1993).

Long Bow sells its film, *The Gate of Heavenly Peace*, and the web site links to the film’s

distributors, but those facts neither makes the expression in the film commercial speech, nor authorize application of commercial speech standards to limit its expression on pages of its web site — like the pages that use Jenzabar in the meta tags — that simply provide information about Jenzabar. Commercial speech is speech that proposes a commercial transaction. *United States v. United Foods*, 533 U.S. 405, 409 (2001); *Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 66 (1983); *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455-456 (1978). The fact that noncommercial statements are made in a medium which is itself sold does not mean that the content may be regulated under the standards that apply to commercial speech. “It is well settled that a speaker’s rights are not lost simply because compensation is received.” *Riley v. Nat’l Fed’n of Blind*, 487 U.S. 781, 801 (1988). After all, it was a paid advertisement that was held to be protected, noncommercial speech in *New York Times v. Sullivan*, 376 U.S. at 265-266 (1964).

For example, in *Ayres v. Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997), the court held that “T-shirts are a medium of expression prima facie protected by the . . . First Amendment, and they do not lose their protection by being sold rather than given away.” *Id.* at 1015. The court distinguished government limitations on “the sale of goods that are not themselves forms of protected speech.” *Id.* Accordingly, the court enjoined an ordinance barring sale of goods in Grant Park. Similarly, a law restricting noncommercial billboards more than commercial billboards was struck down because noncommercial speech doctrine protects billboards containing noncommercial messages, even if billboard space is sold. *KH Outdoor v. Trussville*, 458 F.3d 1261, 1269-1271 (11th Cir. 2006). And in *LL Bean*, 811 F.2d at 33, the First Circuit applied noncommercial speech standards to reject a trademark claim against a magazine that was sold to its readers.

In this case, the pages containing Jenzabar in their meta tags contain purely non-commercial speech reporting information and expressing opinions about Jenzabar and its principals. Even if

Jenzabar had evidence establishing that search engines pay attention to keyword meta tags, the meta tags at issue simply tell search engines that the pages where they are mounted include discussion of the owner of the Jenzabar marks, that they are among the more than sixty thousand web pages with content related in some way to “Jenzabar,” and hence that they should be listed as a relevant search result when a search engine user enters “jenzabar” as a search term. This speech is both truthful and noncommercial. Jenzabar’s claim that the Court should prevent Long Bow from engaging in such speech, or should award damages based on such speech, violates the First Amendment. For this reason alone, summary judgment should be entered against Jenzabar’s claims.

II. THE UNDISPUTED FACTS BAR JENZABAR’S TRADEMARK INFRINGEMENT CLAIMS.

Jenzabar claims that Long Bow’s use of the Marks in meta tags constitutes infringement. Summary judgment should be granted dismissing this claim for at least four independent reasons. First, Jenzabar’s claims cannot meet the special requirements that are imposed under the Lanham Act as construed to avoid the First Amendment questions that would be raised under Long Bow’s first argument, above. Second, Jenzabar cannot demonstrate a likelihood of confusion among “an appreciable number of reasonably prudent purchasers exercising ordinary care.” *Machinists v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996) (affirming summary judgment against plaintiff in trademark infringement case) (“*Winship Green*”). Third, Jenzabar has no reasonable prospect of proving that Long Bow’s use of the Marks in meta tags actually causes any confusion, either real confusion or so-called “initial interest confusion.” Fourth, the undisputed facts show that Long Bow’s use of the Marks in meta tags within a web page about Jenzabar is a fair use.

A. Construing the Lanham Act in Light of the First Amendment, Jenzabar’s Infringement Claims Cannot Stand.

Recognizing the need to avoid the conflict with the First Amendment that would result if the

trademark laws were applied to noncommercial speech, even by companies that engage in commercial activities, courts of appeals have developed various approaches to accommodate such concerns. For example, in *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 552-553 (5th Cir. 2001), the court drew a distinction based on whether speakers had an economic motive for the speech, holding that the Lanham Act could apply if the purpose of the speech itself was to sell more products, but not if the primary purpose of the speech was to express criticism of the trademark holder. And *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), accommodated the First Amendment interests of authors and artists through a rule governing infringement claims against artistic or literary products made for sale, such as mass publications, movies and musical recordings. Under this approach, the Lanham Act cannot be applied unless the trademark in the title “has no artistic relevance to the underlying work whatsoever or, if it has some artistic relevance, unless the title **explicitly** misleads as to the source or the content of the work.” *Id.* (emphasis added); *Mattel v. Walking Mt. Prods.*, 353 F.3d 792, 807(9th Cir. 2003), *ETW Corp. v. Jireh Pub.*, 332 F.3d 915, 920 (6th Cir. 2003); *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 664 (5th Cir. 2000).

Here, these standards apply not just because First Amendment protection for the right to comment on the affairs of a company that is undisputedly a public figure is at least as great as the protection for artistic works, but also because tsquare.tv is a web site **about** an artistic work — Long Bow’s documentary film about the events in Tiananmen Square twenty years ago and the subsequent trajectory of its main characters. Application of a standard that rests on the speaker’s subjective intent and on the noncommercial nature of the content of the speech is particularly appropriate in a case like this one, given the huge expense of standard trademark litigation, *see* American Intellectual Property Law Association, *Report of the Economic Survey* 25 (2007), and the danger that an individual could be worn down by the cost of litigating against a big company. “A lawsuit no doubt

may be used as a powerful instrument of coercion or retaliation.” *Bill Johnson’s Restaurants v. NLRB*, 461 U.S. 731, 440 (1983). *Cf. Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 214 (2000) (need for clear rules in trademark law to allow summary disposition of anti-competitive strike suits). This concern demands clear rules protecting documentary filmmakers like Long Bow who create works that comment on public figures and that constitute noncommercial speech.

Under either the *Amway* standard or the *Rogers* line of cases, the undisputed facts require that summary judgment be granted in Long Bow’s favor. Taking first the *Amway* standard, Long Bow believes that Chai and her company are a legitimate subject for public discussion, and the Jenzabar-related pages on the tsquare web site simply discuss the software company that she founded and reproduce information about that company from respected media sources, without selling any goods or services. Moreover, the trademark use in question — the keyword meta tags — denotes the subject matter of the web pages, and Long Bow certainly has no intent to mislead search engine users about the subject of the web pages. Indeed, as soon as Long Bow learned about Jenzabar’s concerns, it added a prominent disclaimer of affiliation. Similarly, applying the *Rogers* standard, because the web pages are about Jenzabar, there is no way that Long Bow could discuss Jenzabar without using Jenzabar’s name. The undisputed facts thus show no explicit deception, and, indeed, painstaking care **not** to deceive. Long Bow is thus entitled to summary judgment dismissing all of Jenzabar’s claims — for infringement as well as for dilution — on this standard as well.

B. Jenzabar Cannot Show a Likelihood of Confusion About Product Origin or About Affiliation Between Jenzabar and Long Bow.

To avoid summary judgment, Jenzabar must show a genuine issue about whether Long Bow’s use of the Marks is likely to cause confusion about source. *K.P. Permanent Make-up v. Lasting Impression I*, 543 U.S. 111, 117 (2004) (infringement “requires a showing that defendant’s

actual practice is likely to produce confusion in the minds of consumers about the origin of the goods or services in question”). Speculation and theories about the possibility of confusion do not suffice; the law requires a substantial likelihood of confusion. *Winship Green*, 103 F.3d at 200 (“[A] markholder . . . must show more than the theoretical possibility of confusion.”); *Star Fin. Servs., Inc. v. AASTAR Mortg. Corp.*, 89 F.3d 5, 10 (1st Cir. 1996) (“We require evidence of a “substantial” likelihood of confusion — not a mere possibility.”) Moreover, Jenzabar must show “that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care.” *Winship Green*, 103 F.3d at 201.

Trademark infringement requires a specific type of confusion: confusion about the origin, sponsorship, or approval of goods and services or about an affiliation, connection, or association between two persons. *See* 15 U.S.C. § 1125(a)(1)(A). This specific type of confusion ties into the purpose of trademark law: “to prevent the use of the same or similar marks in a way that confuses the public about the actual source of the goods or service.” *Star Fin. Servs.*, 89 F.3d at 9; *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42, 44 (1st Cir. 1991) (“Trademark law prohibits the unauthorized use of such a mark, but only where doing so creates a ‘likelihood of confusion’ about who produces the goods or provides the service in question.”). “It is the source denoting function which trademark laws protect, and nothing more.” *Anti-Monopoly v. General Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979). Meta tags do not denote the **source** of web pages — they index subject matter. For example, meta tags on Jenzabar’s own web site formerly included names of twenty popular schools with whom Jenzabar either did business or hoped to do business. SF 32. Summary judgment thus is necessary unless a genuine factual dispute exists about whether Long Bow’s meta tags are likely to cause an appreciable number of reasonable consumers exercising ordinary care to believe that Jenzabar created, sponsors, or approves of Long Bow’s documentaries or that Jenzabar is affiliated

with Long Bow. As shown below, there is no likelihood of confusion.

1. Jenzabar Cannot Prove Confusion as to Product Origin or Affiliation.

Jenzabar's stated theory of confusion in this case is that the meta tags cause consumers to be exposed to the content of Long Bow's web site, which Jenzabar claims will mislead consumers into believing that Jenzabar has been involved in numerous lawsuits, disputes, and controversies about its business practices. SF 41. Apart from being untrue, this theory of confusion has nothing to do with trademark law. Jenzabar does not even claim, much less have ability to prove, that reasonable consumers viewing the MJP are likely to think that Jenzabar created, sponsors, or approves of Long Bow's film. This hole in Jenzabar's infringement claim alone warrants summary judgment.

A claim that the MJP is likely to produce relevant consumer confusion would be frivolous on its face. The undisputed record shows that the page excerpts from and links to an assortment of major media news articles that are critical of Jenzabar. SF 14, 16. The information on the MJP includes public reporting about Jenzabar's many legal disputes, controversial business practices (including giving \$300 cash cards to college presidents), and long-time strategy of exploiting Chai's unique biography (as a student leader at Tiananmen Square) in its marketing efforts. *Id.* No reasonable consumer — much less an “appreciable number” of them — could read this information and be confused about whether Jenzabar created, sponsored, or approved of Long Bow's goods or services or is affiliated in any way with Long Bow.

Moreover, since before this lawsuit was filed, Long Bow has displayed a prominent disclaimer on the Jenzabar-related pages. SF 15. Other aspects of the website make it even more obvious that Jenzabar and Chai have nothing to do with Long Bow. The web site reports the fact that Jenzabar is suing Long Bow. SF 16-17. Long Bow has posted to the web site all of Jenzabar's cease-and-demand correspondence, Jenzabar's complaint in this case, and a variety of other

documents detailing this dispute between Long Bow and Jenzabar. *Id.* Elsewhere on the web site, Long Bow quotes Chai criticizing the Film and attacking the film-makers as “pro-Communist.” SF 5, 17. No reasonable consumer exposed to the Web site could be confused about whether Jenzabar created, sponsored, or approved of Long Bow’s films or is somehow affiliated with Long Bow.

Jenzabar’s preoccupation with the content of Long Bow’s web site — content originally targeted by the defamation claims the Court dismissed — highlights the disturbing First Amendment implications of Jenzabar’s claims:

[P]rotections against unfair competition cannot be transformed into rights to control language. Such a transformation would raise serious First Amendment concerns because it would limit the ability to discuss the products or criticize the conduct of companies that may be of widespread public concern and importance. Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.

Lamparello v. Falwell, 420 F.3d 309, 313 (4th Cir. 2005) (internal citations and quotation marks omitted).

2. Jenzabar’s Claims Fail Under a Traditional Confusion Analysis

Similarly, consideration of the traditional “likelihood of confusion” factors strongly supports Long Bow’s contention that there is no likelihood of confusion. These factors include: (1) the similarity of the marks; (2) the similarity of the goods; (3) the relationship between the parties’ channels of trade; (4) the juxtaposition of their advertising; (5) the classes of prospective purchasers; (6) the evidence of actual confusion; (7) the defendant’s intent in adopting its allegedly infringing mark; and (8) the strength of the plaintiff’s mark. *See Winship Green*, 103 F.3d at 201.

Similarity of marks Long Bow uses the Marks themselves on its web page about Jenzabar. It naturally uses the word “Jenzabar” in connection with that page, including in meta tags that index and describe the contents of the page. However, when a trademark claim is brought against a parody

that uses the mark to comment on the trademark holder, courts hold that similarity between the parties' two marks does not support finding a likelihood of confusion, because "similarity is an essential part of a parody." *Louis Vuitton v. Haute Diggity Dog*, 464 F. Supp.2d 495, 499 (E.D. Va. 2006), quoting *PETA v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001). Similarly, when the purpose of using the mark is to denote a page that discusses the trademark holder, only the mark itself will serve that legitimate purpose, and so the identity between Long Bow's use of the mark and the mark itself does not support Jenzabar here.

Similarity of goods Long Bow's "goods" — documentary films about China — have no similarity whatsoever to Jenzabar's computer software, which Jenzabar describes as "complex enterprise software solutions." SF 4, 25.

Overlap of channels of trade and advertising The parties' channels of trade and their advertising do not overlap. Long Bow's films are available through distributors like the Center for Asian-American Media ("CAAM"), which sell the films to museums, libraries, and schools. SF 3. Jenzabar has produced no evidence that it sells computer software through CAAM or any other channel for distribution of documentary films. To the contrary, Jenzabar clearly is a profit-seeking enterprise that sells its products through traditional commercial channels, including through a sales force. SF 25. Jenzabar does not sell or advertise through Long Bow's web site. *Id.*

Prospective purchasers With respect to prospective purchasers, colleges and universities may purchase "complex enterprise software solutions" from Jenzabar and also may acquire copies of Long Bow's documentary films to show to students in classrooms. However, although IT professionals make decisions about computer software, professors and librarians decide to purchase Long Bow's films for use in classrooms. A corporation or non-profit institution cannot be treated as an undifferentiated whole; it is the particular purchasers within the entity that matter. *Astra*

Pharm. Prod. v. Beckman Instruments, 718 F.2d 1201, 1206-1207 (1st Cir. 1983). Moreover, because Jenzabar software is an expensive product aimed at professional buyers who take great care in their purchase decisions, SF 27-28, confusion is very unlikely. *Merchant & Evans v. Roosevelt Bldg Prods.*, 963 F.2d 628, 636-637 (3d Cir. 1992).

Actual confusion No evidence exists of actual confusion of any kind, much less confusion as to affiliation or confusion as to product origin, sponsorship, or approval. SF 34-38. The absence of such evidence, with respect to a web page and meta tag use that has been ongoing for more than ten years, is very strong evidence of no likelihood of confusion. *A&H Sportswear v. Victoria's Secret Stores*, 237 F.3d 198, 227 (3d Cir. 2000); *Kendall-Jackson Winery v. E&J Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir. 1998); *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

Defendant's intent Long Bow's intent in using the Marks as meta tags since 1999 was merely to refer to Jenzabar and to index and describe the contents of web pages about Jenzabar. SF 11, 18. Long Bow did not seek to cause confusion. SF 18. In fact, Long Bow did not even know of its prominence among Google search results until August 2006, when Jenzabar first complained. SF 18. Moreover, the fact that Long Bow added a disclaimer of affiliation as soon as it learned that Jenzabar was objecting to its web page shows lack of intent to confuse. *Smith v. Wal-Mart Stores*, 537 F. Supp.2d 1302, 1338 (N.D. Ga. 2008). Indeed, the First Amendment requires consideration of the use of disclaimers when they can dispel confusion. *Consumers' Union v. General Signal Corp.*, 724 F.2d 1044, 1053 (2d Cir. 1983).

Strength of marks Jenzabar's Marks are not strong, for several reasons. First, the word "jenzabar" is the foreign equivalent of the English phrase "the best and the brightest," which is the subject of other trademarks and uses in commerce that predate Jenzabar's. SF 29. "Under the 'doctrine of foreign equivalents,' a foreign word is ordinarily translated into English to determine

whether it is suggestive or descriptive.” *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 38 (1st Cir. 2006). Second, Jenzabar admits that it never enforced the Marks against any party other than Long Bow, including against Forbes and CNN, both of which currently use the Marks in meta tags on web pages that report information about Jenzabar. SF 30. In addition, the federal registration for one Mark was cancelled, the other temporarily was abandoned, and neither Mark is registered in Massachusetts. SF 31. And even a strong mark would not support a claim of likelihood of confusion where the use is for the purpose of denoting a subject for commentary or criticism. Consumers of goods with a strong trademark are less likely to be confused about whether the critic is affiliated with the trademark owner. *Hormel Foods Corp. v. Jim Henson Productions*, 73 F.3d 497, 503 (2d Cir. 1996).

In short, a traditional analysis strengthens the conclusion compelled by common sense: no likelihood of confusion exists, and Long Bow is entitled to summary judgment.

3. Jenzabar’s Initial Interest Confusion Theory Has No Merit.

Jenzabar has also argued that the meta tags cause “initial interest confusion” because people who type the word “jenzabar” into Google receive a menu of options that include a link to the MJP. Opposition to Dismissal at 21-22. The Court previously noted that “Jenzabar seems unlikely to prevail on this claim because of the dissimilarity of Long Bow’s business.” Decision and Order at 7. On the undisputed facts, Jenzabar’s initial interest confusion theory fails as a matter of law.

In the Internet context, some courts say that initial interest confusion occurs when a consumer looking for a trademark holder is drawn by use of the mark in a domain name, meta tags, or keyword advertising, to a site that is **not**, once viewed, confusing about source. Nonetheless, the consumer may decide that he is interested in the goods or services marketed there, and thus stay and look further **despite** the lack of confusion. *Brookfield Communications v. West Coast Entertainment*, 174

F.3d 1036, 1062 (9th Cir. 1999). The hypothetical user decides not to continue to look for the trademark holder, not because of any illusions about who sponsors the website, but because the website provides other attractive inducements. For example, the consumer may perceive that the current website offers cheaper prices for functionally equivalent goods, or higher quality goods. However, this analysis does not support Jenzabar here, for several reasons.

First, initial interest confusion has its most important application when two commercial competitors are selling similar goods to the same set of consumers, *Nissan Motor v. Nissan Computer*, 378 F.3d 1002, 1019 (9th Cir, 2004); *Checkpoint Sys. v. Check Point Software Tech.*, 269 F.3d 270, 296-297 (3d Cir. 2001), and has less force when customers are likely to exercise care in making their final purchasing decisions. *Id.* Both the First and Fourth Circuits, while expressing considerable skepticism about whether the doctrine of initial interest confusion is ever valid, avoided deciding that question “[w]hen an alleged infringer does not compete with the markholder for sales.” *Lamparello v. Falwell*, 420 F.3d 309, 317 (4th Cir. 2005); *Hasbro, Inc. v. Clue Computing*, 232 F.3d 1, 2 (1st Cir. 2000). *See also Hearts on Fire Co. v. Blue Nile*, 603 F. Supp. 2d 274, 287 (D. Mass. 2009) (“[I]nitial interest confusion can support a claim under the Lanham Act — but only where the plaintiff has plausibly alleged that consumers were confused, and not simply diverted.”). Here, Long Bow does not sell rival goods but simply sets forth historical facts and opinions about Jenzabar. Long Bow does not sell “complex enterprise software.” SF 4. Jenzabar has not made documentary films about China. SF 25. They do not compete. Moreover, it is undisputed that potential customers for Jenzabar’s products exercise great care before making purchases. SF 27-28. In these circumstances, the possibility of initial interest confusion is virtually non-existent.²

² The meta tag cases Jenzabar cited in opposing dismissal involved competitors using rivals’ marks to divert consumers away from their rivals’ goods and services. *See, e.g., Australian Gold, Inc. v. Hatfield*, 436 F.3d 1228, 1238 (10th Cir. 2006) (“a consumer . . . is lured to the product of a

Second, developments in both law and technology call into question the applicability of initial interest confusion to web sites that accurately use trademarks online to denote web sites' subjects. The early Internet cases spoke with assurance of the supposed lack of sophistication of Internet viewers and the absence of a reliable index of websites. *E.g.*, *Panavison v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998); *Jews for Jesus v. Brodsky*, 993 F.Supp. 282, 303 (D.N.J. 1998). Courts assumed that a customer who got to the wrong website would just give up "due to anger, frustration or the assumption that plaintiff's homepage does not exist." *Id.* at 307. In this context, the doctrine of initial interest confusion protected the consumer against unduly high search costs that would have been incurred as a consequence of the temporarily confusing use of the mark.

This analysis has become outdated through both changes in the sophistication of Internet viewers and developments in search technology. Although it authored *Brookfield*, the Ninth Circuit has repudiated the view that Internet viewers are naive or unsophisticated. *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002). And in *Interstellar Starship Serv. v. Epix*, 304 F.3d 936, 942 (9th Cir. 2002), that court retreated from the suggestion that initial interest confusion was an independent violation that could be found without reference to other factors. And many courts recognize that search engines now provide an excellent index for the World Wide Web, or at least large portions of it, and acknowledge the diminution of the consequences of landing at the "wrong" website as a result of initial interest confusion. *E.g.*, *Strick Corp. v. Strickland*, 162 F. Supp.2d 372

competitor"); *Playboy Enter. v. Netscape Commc 'ns Corp.*, 354 F. 3d 1020, 1024-25 (9th Cir. 2004) ("initial interest in a competitor's product"); *Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 812 (7th Cir. 2002) ("direct competitors in the [specified] market.") *See also* *Venture Tape Corp. v. McGills Glass Warehouse*, 540 F.3d 56, 60 (1st Cir. 2008) (seller of goods "which directly compete with" plaintiff's tapes intentionally used plaintiff's marks in both meta tags and invisible text); *North Am. Med. Prods., Inc. v. Axiom Worldwide*, 522 F.3d 1211, 1222 (11th Cir. 2008) ("a company's use in meta tags of its competitor's trademarks"). None of these involved use of trademarks in meta tags on a site providing critical information about the trademark owner.

(E.D. Pa. 2001); *Bihari v. Gross*, 119 F. Supp.2d 309, 320 n.15 (S.D.N.Y. 2000). As *Strick* stated:

[A]ny initial confusion that arises from Defendant's use of his strick.com domain site, specifically, that consumers will realize that they are at the wrong site and will go to an Internet search engine to find the right one, is not enough to be legally significant. . . . It is clear that Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded, or unnerved, when, after taking a stab at what they think is the most likely domain name for particular web site [they] guess wrong and bring up another's webpage.

162 F.Supp.2d at 377 (quotation marks and citations omitted).³

In any event, the stale rationale of earlier Internet cases does not apply here, where Jenzabar's own corporate website appears as the very first result in response to a Google search. SF 19. No one who lands at the MJP is going to assume the software company Jenzabar lacks its own homepage.

Third, an injunction against noncommercial use of the trademark pursuant to the doctrine of initial interest confusion, or an award of damages based on profits lost because the critic was too persuasive, would be inconsistent with the First Amendment. Even if a compelling government interest were served by forbidding mere "likelihood of confusion," and there were thus a constitutionally permissible basis for issuing an injunction against noncommercial speech, the constitutional basis for the injunction is even more problematic if the confusion caused by the trademark is merely ephemeral. If, for example, the confusion caused by use of the trademark in a meta tag is dispelled as soon as the viewer begins to read the web page and recognizes that the site comments on the markholder, rather than promoting the markholder's viewpoint, no "compelling government interest" would be served by enjoining use of the meta tag. *Cf. Northland Ins. Co. v. Blaylock*, 115 F. Supp.2d 1108, 1119-1121 (D. Minn. 2000) (declining to apply initial interest

³David Bernstein, a prominent trademark enforcement lawyer, stated in 2003 that "99 times out of 100, consumers are able to find the site they are looking for." Loomis, *Domain Name Disputes Decline as Internet Matures*, New York Lawyer, February 6, 2003, <http://nylj.com/nylawyer/news/03/02/020603c.html>.

confusion absent proof of commercial motive).

Finally, Jenzabar's claims rest on flawed assumptions about why and how people use Internet search engines. Jenzabar's premise is that people who type the word "jenzabar" into a search engine seek only the Jenzabar corporate website and other self-serving materials churned out by Jenzabar's public relations apparatus. Nothing supports that speculation. *See* Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L.J. 507, 521-525 (2005) (there are no "legally-supportable inferences about searcher objectives based on the keywords used"). In fact, many people who type the word "jenzabar" into a search engine are looking for information **about** Jenzabar. *See, e.g., Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998) ("[T]he user may also want to be apprised of the opinions of others about Bally.") The MJP provides such information. No confusion is likely. *See, e.g., Bihari v. Gross*, 119 F. Supp. 2d 309, 320 (S.D.N.Y. 2000) ("Far from diverting 'people looking for information on Bihari Interiors,' as plaintiffs allege . . . the Gross websites provide users with information about Bihari Interiors.") Many courts have held that the use of meta tags for sites about the trademark holder is entirely proper. *Faegre & Benson v. Purdy*, 367 F. Supp.2d 1238, 1247 (D. Minn. 2005); *J.K. Harris & Company v. Kassel*, 253 F.Supp.2d 1120 (N.D. Cal. 2003).

Jenzabar's desire to choke off access to such information highlights the First Amendment concerns raised when companies try to use trademark law to limit commentary and criticism:

Applying the initial interest confusion theory to gripe sites like [defendant's] would enable the markholder to insulate himself from criticism — or at least to minimize access to it. We have already condemned such uses of the Lanham Act, stating that a markholder cannot "shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct." "Just because speech is critical of a corporation and its business practices is not a sufficient reason to enjoin the speech."

Lamparello, 420 F.3d at 317-18 (quoting *CPC Int'l v. Skippy*, 214 F.3d 456, 462 (4th Cir. 2000), quoting *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987).

Moreover, prospective customers may highly value an information source like Long Bow's website that collects major news reporting about Jenzabar from the *Boston Globe*, *Forbes*, the *Chronicle of Higher Education*, and others; such reporting is not available from Jenzabar itself. Jenzabar's Rule 30(b)(6) witness, Robert Maginn, testified that customers in the "nonprofit world of higher education . . . care about who they are doing business with." SF 28. It thus makes no sense to assume that people broadly searching for the word "jenzabar" have no interest in the information about Jenzabar that is available on the MJP.

Jenzabar's theory also ignores the fact that people who search the Internet using the term "jenzabar" receive a menu of options in response to each search request. That menu includes, in every instance, the Jenzabar corporate website as the very first option. SF 19. Web searchers cannot end up on the main Jenzabar-related page without making a conscious choice to view it either in addition to or instead of the Jenazbar corporate web site. *Cf. Winship Green*, 103 F.3d at 201 ("Confusion resulting from the consuming public's carelessness, indifference, or ennui will not suffice."). And even if there were a class of "reasonable consumers exercising ordinary care" who did so mistakenly, those unfortunate few can correct their error simply by hitting the "BACK" button on their web browsers or by renewing their search. Indeed, Jenzabar states that its "customers typically engage in extensive due diligence over a period of months or years" prior to making a purchase decision. SF 27. A hypothetical, momentary misstep during an extensive due diligence process does not produce actionable confusion.

B. Jenzabar Cannot Prove Causation.

Finally, even if Jenzabar could show that initial interest confusion is theoretically possible, Jenzabar's burden at this stage is to point to evidence a fact-finder could rely on to conclude that the meta tags are likely to cause an appreciable number of reasonable consumers to be confused as to

affiliation or product origin. Jenzabar cannot carry this burden.

Jenzabar's theory is that Long Bow's use of the Marks in meta tags causes search engines to find the MJP or, stated differently, that the meta tags explain the MJP's presence among Google search results for the word "jenzabar." *See* Complaint 24-26. Jenzabar has no evidence, expert or otherwise, to substantiate its allegation of causation. To the contrary, through the testimony of Maginn, Jenzabar's CEO and sole Rule 30(b)(6) witness, Jenzabar admitted repeatedly that it has no idea why search engines find the MJP and no idea what role, if any, meta tags might play:

MR. ZIEGLER: So what impact, if any, do you believe Long Bow's use of the Jenzabar name as a meta tag has on its presence on the Internet on search engines?

MR. MAGINN: What impact? I don't know. It's a great mystery and everybody on the Web closely guards, like the secret formula for Coca-Cola, how exactly on a day-by-day basis Google does its rankings. (Maginn Dep. 32-33)

...

MR. MAGINN: I don't know Google's algorithms. I don't know the search engine algorithms. I've never worked for those guys. I can't testify as to how they do it. (Maginn Dep. 69)

...

MR. ZIEGLER: You don't know the algorithm for any [search engine]?

MR. MAGINN: No.

Maginn Dep. 75; SF 21.

These admissions are fatal to all of Jenzabar's trademark claims, because all of the claims rest on the unproven theory that meta tags explain the MJP's presence amid some search engine results. Indeed, after Maginn testified, he got his wish for a clear explanation from Google, but that explanation contradicted Jenzabar's claims in this case. Google issued a statement that it does not currently consider key word meta tags in determining search rankings, and that it stopped considering them "many years ago." <http://googlewebmastercentral.blogspot.com/2009/09/google-does-not-use-keywords-meta-tag.html>. SF 22. Accord, Decision and Order on Motion to Dismiss, at 2 n.2 (citing 4 McCarthy on Trademarks § 25.69) ("modern search engines make little

if any use of meta tags”).

Finally, if Jenzabar claims damages based on Long Bow’s use of meta tags “many years ago,” the Court should apply the four year statute of limitations to hold that Jenzabar’s trademark action is untimely. *Kusek v. Family Circle*, 894 F. Supp. 522, 530 (D. Mass.1995). Indeed, because the single publication rule applies to Internet communications, the entire suit should be dismissed as untimely. *Abate v. Maine Antique Digest*, 2004 WL 293903, at *1-2 (Mass. Super., Jan. 26, 2004); *Christoff v. Nestle USA*, 47 Cal.4th 468, 213 P.3d 132 (Cal. 2009), *Nationwide Bi-Weekly Admin. v. Belo Corp.*, 512 F.3d 137, 144 (5th Cir. 2007).

C. Long Bow’s Use of the Marks is Protected as Nominative Fair Use.

Even if Jenzabar had a reasonable prospect of proving confusion and causation, summary judgment is necessary because Long Bow’s use of the Marks as meta tags on a web page about Jenzabar is protected fair use.

The nominative fair use doctrine permits Long Bow to use the Marks to refer to Jenzabar and to index and describe the contents of a web page about Jenzabar. *See, e.g., Century 21 Real Estate Corp. v. LendingTree*, 425 F.3d 211, 228-31 (3d Cir. 2005); *Playboy Enters. v. Welles*, 279 F.3d 796, 803-04 (9th Cir. 2002); *New Kids on the Block v. New Am. Publ’g.*, 971 F.2d 302, 308 (9th Cir. 1992); *Tiffany, Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 496-501 (S.D.N.Y. 2008); *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120 (N.D. Cal. 2003); *Bihari*, 119 F. Supp. 2d at 321-24; *cf. WCBV-TV*, 926 F.3d at 46. This doctrine rests on the premise that

[i]t is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark. . . . Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.

New Kids on the Block, 971 F.2d at 306-07.

Thus, “[u]ses that neither implicate the source-identification function of the trademark nor imply sponsorship or endorsement of the trademark holder lie ‘outside the strictures of trademark law.’” *Savin Corp. v. Rayne*, Case No. 00-CV-11728, 2001 WL 34815751, at *9 (D. Mass. Mar. 26, 2001) (quoting *New Kids on the Block*, 971 F. 2d at 308).

The First Circuit has not adopted this doctrine explicitly but twice has recognized the underlying principle in cases analogous to this one. See *Universal Commc’ns Sys. v. Lycos, Inc.*, 478 F.3d 413, 424-25 (1st Cir. 2007) (rejecting trademark claim by company criticized on internet message board) (“[T]rademark law should not prevent Lycos from using the ‘UCSY’ mark to indicate that a particular company is the subject of a particular message board.”); *WCBV-TV*, 926 F.2d at 46 (affirming denial of injunction against TV station’s use of “Boston Marathon” mark to describe broadcast of the event) (station’s use of the mark “would not confuse” the typical viewer because the “words do more than call attention to Channel 5’s program; they also describe the event that Channel 5 will broadcast”).

The nominative fair use test — which has been applied favorably to meta tags — requires: (1) that the product or service in question must be one not readily identifiable without use of the trademark; (2) that only so much of the mark is used as is reasonably necessary to identify the product or service; and (3) that the user do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. See *Playboy Enters.*, 279 F.3d at 801 (affirming summary judgment in defendant’s favor on grounds that use of trademarks in meta tags was nominative fair use). Long Bow’s use of the Marks in meta tags satisfies all three conditions of this test, as a matter of law. First, the company Jenzabar is not readily identifiable without using the word “Jenzabar.” See *New Kids on the Block*, 971 F.2d at 307 (music group New Kids on the Block not readily identifiable without using trademark); *WVCB-TV*, 926 F.2d at 46 (event Boston

Marathon not readily identifiable without using the trademark). Second, Long Bow uses only the words of the Marks; Long Bow does not use Jenzabar's logo, coloring, or tagline. SF 16. Third, Long Bow does nothing to suggest sponsorship or endorsement by Jenzabar. To the contrary, not only through the disclaimer, but also by highlighting the fact that Jenzabar is suing over the web site, the MJP makes it obvious that no sponsorship, endorsement, or approval exists. The nominative fair use doctrine protects Long Bow's use of the Marks in meta tags.

In addition, the federal trademark statute contains an explicit fair use defense that applies when the "name, term, or device charged to be an infringement is a use, otherwise than as a mark, ... of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin." 15 U.S.C. § 1115(b)(4). Long Bow's meta tags qualify for this statutory defense because the meta tags are used, in good faith, to describe and index the contents of web pages which themselves discuss Jenzabar. *Bihari*, 119 F. Supp. 2d at 321-22 ("Even if the [defendant's] websites cause consumer confusion, use of the [plaintiff's] mark in the metatags is protected as a fair use.") ("The [fair use] requirement that a trademark be used in its descriptive sense is met where the mark is used in an index or catalog.").

III. JENZABAR'S TRADEMARK DILUTION CLAIMS FAIL AS A MATTER OF LAW.

Jenzabar also contends that Long Bow's use of the Marks in meta tags constitutes trademark dilution. This claim has no merit.

Dilution laws protect a small class of very well-known marks — household names — against specific harms that can occur even when confusion is unlikely. Dilution laws, however, "are not intended to serve as mere fallback protection for trademark owners unable to prove trademark infringement." *I.P. Lund Trading Co. v. Kohler Co.*, 163 F.3d 27, 48 (1st Cir. 1998).

The federal anti-dilution statute, codified at 15 U.S.C. § 1125(c)(1), authorizes courts to

award relief to the owner of a “famous mark” in order to prevent dilution of that mark:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, can obtain to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

This statute protects only famous marks, and it requires proof of likelihood of dilution by blurring or dilution by tarnishment. *See id.*; *I.P. Lund Trading*, 163 F.3d at 47. Jenzabar cannot survive summary judgment without evidence that the Marks were famous before Long Bow first used them in meta tags, and that those tags are likely to cause dilution, either by blurring or by tarnishment.

A. Jenzabar’s Marks Are Not Famous.

The federal anti-dilution statute applies only to “famous mark[s]” and only when the allegedly dilutive use of the mark commenced “after the owner’s mark has become famous.” 15 U.S.C. § 1125(c)(1). A trademark is “famous” only if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). A court “may” consider four factors identified in the statute if there is doubt about whether a given mark enjoys the requisite degree of recognition. §§ 1125(c)(2)(A)(i) - (iv).

“Famous” is a very high standard. *See I.P. Lund Trading Co.*, 163 F.3d at 46 (statutory text and legislative history make clear that “courts should be discriminating and selective in categorizing a mark as famous”). The Ninth Circuit, for example, has said that “famousness is . . . a hard standard to achieve” and that a trademark achieves fame “only if a large portion of the general consuming public recognizes the mark. Put another way, . . . the mark must be a household name.” *Thane Intern., Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir. 2002) (affirming summary judgment

against trademark owner due to failure to create triable issue of “famousness”). Specifically, the standard requires wide recognition of the trademark “by the general consuming public of the United States.” 15 U.S.C. § 1125(c)(2)(A). This means that:

The mark must be famous to the whole consuming public of all of the United States. Fame in just one geographic region is not sufficient. Fame in just one industry or line of business or only to professional buyers in one market niche is not sufficient.

4 McCarthy on Trademarks § 24:105.

Jenzabar has made no effort to show that either of the Marks satisfies this rigorous standard and thus could qualify for protection under the dilution laws. Long Bow specifically asked Jenzabar in interrogatories to disclose the basis for the allegation that the Marks are famous. Jenzabar’s response actually demonstrated that the Marks are not famous as a matter of law:

Jenzabar’s long involvement and active participation **in the higher education software industry** has resulted in widespread recognition of the Jenzabar marks in the higher education community, including the receipt of numerous awards.

SF 26 (emphasis added).

Recognition in this narrow industry fails as a matter of law to show that the Marks are “widely recognized by the general consuming public of the United States.” 15 U.S.C. § 1125(c). Jenzabar’s unspecified press coverage — much of it critical and negative — does not create a triable issue with respect to the statutory famousness factors. And the Court should ignore Jenzabar’s assertion that it has spent “millions of dollars on marketing efforts,” because Jenzabar steadfastly refused to produce its financial statements and because there is no evidence about the nature, purpose, targeted audience, or actual effect of Jenzabar’s marketing expenditures. Simply put, no evidence exists that would permit the inference that either “Jenzabar” or “Jenzabar.com” are household names.

Moreover, Jenzabar cannot show that the Marks were famous by 1999, when Long Bow first began using the Marks as meta tags. SF 13. None of Jenzabar’s proofs show its marks’ prominence

ten years ago. Indeed, its own federal registration for the Mark “Jenzabar” states that Jenzabar first used the Mark in commerce on September 1, 2001, SF 31.

B. There Is No Likelihood of Dilution.

A dilution claim can proceed on one of two theories — blurring or tarnishment. Even assuming that its marks met the high standard for famousness under dilution law, Jenzabar’s dilution claims fall far short.

Dilution by blurring refers to “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). “The basic idea of blurring is that the defendant’s use of the plaintiff’s mark causes the public no longer to think only of the plaintiff’s product upon seeing the famous mark, but rather to associate both the plaintiff and the defendant with the mark.” *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 134 (D. Mass. 1999), *aff’d*, 232 F.3d 1 (1st Cir. 2000). A classic example of dilution by blurring would be the use of a famous mark (like Coca-Cola) to signify goods that are dissimilar to those with which the famous mark is associated (like shoes): “Coca-Cola Shoe Co.” An association between the mark and shoes in the minds of consumers might impair the Coca-Cola mark’s distinctiveness and diminish its ability to serve as a singular identifier of source. But nominative use of a trademark to criticize the trademark owner does not lead to blurring; quite to the contrary, it reinforces the association between the mark and the markholder. *See Hormel Foods Corp. v. Jim Henson Productions*, 73 F.3d 497, 506 (2d Cir. 1996), citing *Jordache Enterprises v. Hogg Wyld*, 828 F.2d 1482, 1489-1490 (10th Cir. 1987).

Even if the Marks were famous, no evidence exists that Long Bow’s use of the Marks as meta tags on a web-page about Jenzabar could impair their ability to identify Jenzabar’s products. Jenzabar has no evidence — expert testimony, consumer surveys, or otherwise — to support a claim

of dilution by blurring. Nor is such a claim even theoretically possible given the undisputed nature of Long Bow's use of the Marks as meta tags on a webpage about Jenzabar. People viewing the MJP will continue to associate the Marks exclusively with "complex enterprise software solutions"; they will not perceive the Marks as identifying documentary films about China. Jenzabar has no prospect of proving that the meta tags are likely to cause dilution by blurring.

Dilution by tarnishment refers to "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C). But tarnishment cannot be found based on mere criticism. 4 McCarthy on Trademarks and Unfair Competition § 24:90 (4th ed. 2009); *Mattel v. Walking Mt. Prod's*, 353 F.3d 792, 812 (9th Cir., 2003). The First Circuit describes tarnishment as follows:

Neither the strictures of the first amendment nor the history and theory of anti-dilution law permit a finding of tarnishment based solely on the presence of an unwholesome or negative context in which a trademark is used without authorization. Such a reading of the anti-dilution statute unhinges it from its origins in the marketplace. A trademark is tarnished when consumer capacity to associate it with the appropriate products or services has been diminished. The threat of tarnishment arises when the goodwill and reputation of a plaintiff's trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner's lawful use of the mark.

L.L. Bean, Inc., 811 F.2d at 31.

For example, when people attach the Coca-Cola marks to products suggesting illegal drug use (such as t-shirts bearing the phrase "Enjoy Cocaine"), Coca-Cola has prevailed on tarnishment claims. *See* 4 McCarthy on Trademarks § 24.89. Tarnishment claims often involve the association of famous marks with unsavory or degrading activities like adult entertainment or illegal drugs. *See id.*

As with blurring, no evidence exists that Long Bow's use of the Marks as meta tags is likely to cause dilution by tarnishment. Long Bow simply has not "linked [the Marks] to products" at all, much less to products "which are of shoddy quality or which conjure associations that clash with the

associations” generated by Jenzabar’s own efforts. *L.L. Bean*, 811 F.2d at 31. Jenzabar’s feeble interrogatory response on this point demonstrates the misguided nature of its dilution claims:

[T]he negative association that a visitor to the Long Bow site is likely to make based upon the negative, inaccurate, and misleading information set forth there is likely to damage Jenzabar’s marks by tarnishment.

SF 36.

Again, Jenzabar is harping on the content of the pages about Jenzabar and its worry that readers of news articles about Jenzabar that those pages cite will form a negative impression of Jenzabar. This concern simply is not a trademark claim. *L.L. Bean*, 811 F.2d at 31. As the First Circuit explained recently in a closely analogous context, the injury Jenzabar asserts is not a trademark injury:

Trademark injury arises from an improper association between the mark and products or services marketed by others But any injury to UCS ultimately arises from its being criticized on the Raging Bull site. To premise liability on such criticism would raise serious First Amendment concerns.

UCS, 478 F.3d at 423 (citation omitted)

This Court rejected Jenzabar’s defamation claims as a matter of law over a year ago, and Jenzabar cannot use a trademark dilution theory to try to revive those defeated claims. *See id.* at 423-24 (“To be sure, UCS does allege that in this case the criticism is false and misleading. But while such an allegation might be relevant to a defamation claim, it is not determinative of whether UCS’s allegations can support a trademark claim.”)

C. Jenzabar Cannot Prove Causation.

As demonstrated above, Jenzabar has no prospect of proving that Long Bow’s use of the Marks in meta tags actually caused any conceivable confusion among reasonable consumers. See *infra* at 14-15. Likewise with Jenzabar’s dilution claims: no basis exists for a fact-finder to draw a causal connection between Long Bow’s meta tags and any theoretical dilution.

D. Long Bow's Use of the Marks is Protected as Nominative Fair Use and Non-Commercial Use.

As demonstrated above at pages 23-25, Long Bow's use of the Marks in meta tags to refer to Jenzabar and to describe and index the contents of a web page about Jenzabar is protected as fair and non-commercial use, which expressly apply to dilution claims under 15 U.S.C. § 1125(c)(3).

IV. JENZABAR'S CHAPTER 110H AND CHAPTER 93A CLAIMS FAIL AS A MATTER OF LAW.

Jenzabar's state-law claims fail as well. M.G.L. c. 110H § 13 authorizes injunctions against three types of trademark harm that duplicate the claims discussed above: (1) injury to a mark's value caused by actual or potential confusion; (2) diminution in uniqueness and individuality of a mark; or (3) injury from use of a mark in a manner that tarnishes or appropriates the goodwill and reputation associated with plaintiff's mark. See *Astra Pharm. Prod.*, 718 F.2d 1201, 1209 (1st Cir. 1983); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 494-95 (1st Cir. 1981); *Bay State Sav. Bank v. Baystate Fin. Servs.*, 484 F. Supp. 2d 205, 219 (D. Mass. 2007) (“[F]ederal and state [infringement] law are essentially identical. . . .The state-law anti-dilution statute is likewise similar to its federal counterpart.”); *Hasbro*, 66 F. Supp. 2d at 137 (federal and state dilution standards are “very similar”).

Jenzabar's chapter 93A claim is also derivative of its trademark claims. With no prospect of showing that Long Bow's use of the Marks is unlawful, much less a product of bad faith, Jenzabar cannot prevail on its chapter 93A claim. Moreover, proof of “loss of money or property” is an explicit statutory requirement for a claim under c. 93A § 11. See *Lumbermans Mut. Cas. Co. v. Offices Unlimited*, 419 Mass. 462, 468 (1995) (affirming summary judgment based on failure to prove loss); *Fruzzo v. Landenberger*, 61 Mass. App. Ct. 814, 823 (2004). Jenzabar has no evidence

of “loss of money or property” resulting from Long Bow’s use of the Marks as meta tags. SF 33-34.

CONCLUSION

Long Bow’s motion for summary judgment should be granted.

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