



Berkman

The Berkman Center for Internet & Society
at Harvard University

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March 21, 2012

VIA EMAIL (bpareso@investigation.com)

Ms. Kelly Mattmuller
Assistant Vice President
Kessler International
World Headquarters
45 Rockefeller Plaza, Suite 2000
New York, New York 10111-2000

**Re: Response to Letter Dated March 14, 2012
Kessler International adv. Citizen Media Law Project**

Dear Ms. Mattmuller :

I write in response to your letter to Jeffrey Hermes, Director of the Citizen Media Law Project (“CMLP”), which is hosted at Harvard University’s Berkman Center for Internet & Society. The Cyberlaw Clinic at Harvard Law School assists the CMLP and herein responds on its behalf. As explained below, your allegations, and your demand that the CMLP delete a third-party account with the username “fraudbuster” based upon your registration of the mark FRAUDBUSTERS, are unfounded.

The CMLP is a non-profit educational project devoted to promoting freedom of expression on the Internet and to providing legal resources and education to online publishers to enable them to exercise their rights. Your letter alleges trademark infringement based upon nothing more than a username selected by one user out of over 30,000 registered on the CMLP’s website. In fact, the word “fraudbuster” appears only on the user’s own profile page and on one comment by this user on a page related to the CMLP’s coverage of a lawsuit wholly unrelated to Kessler or its business.

The CMLP is not itself using the word “fraudbuster” at all. Although your form letter bizarrely demands “those profits attributable to [CMLP’s] unauthorized use of Kessler’s mark,” the CMLP is certainly not using the word in any commercial way, to sell goods or

services or make a profit. Likewise, the user “fraudbuster” does not appear to be exploiting the username to advertise or sell any goods or services. It strikes the CMLP as absurd to allege that a third-party’s choice of a username constitutes an attempt by the CMLP “to trade off of the good will that Kessler International has built up in these trademarks.”

Trademark law provides no basis for suppressing the purely expressive selection of a username. Federal courts across the country have clearly stated that trademark law does not give a mark holder the ability to control all use of the subject term in public discourse. *See, e.g., L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (“Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.”); *U.S. Shoe Corp. v. Brown Group, Inc.*, 740 F. Supp. 196, 198 (S.D.N.Y. 1990) (“When the plaintiff chooses a mark with descriptive qualities, the fair use doctrine recognizes that he cannot altogether exclude some kinds of competing uses, particularly those which use words in their primary descriptive and non-trademark sense.” (internal quotation omitted)); *see also* 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:148 (4th ed. 2011) (“[U]se of a mark in a purely communicative, nontrademark setting should be permitted or else trademark law could be used as a vehicle to stifle unwelcome discussion.”).

The face of the web page that you cite makes plain that the user is using the name in a descriptive sense, to reflect the user’s experience exposing “fraud in the viatical and life settlements industry.” As the First Circuit has stated, “[i]n technical trademark jargon, the use of words for descriptive purposes is called a ‘fair use,’ and the law usually permits it even if the words themselves also constitute a trademark.” *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42, 46 (1st Cir. 1991); *see* 15 U.S.C. § 1115(b)(4). The descriptive use of terms is permitted even in titles and labels. *See, e.g., Dessert Beauty, Inc. v. Fox*, 568 F. Supp. 2d 416, 423 (S.D.N.Y. 2008) *aff’d* 329 Fed. App’x 333 (2d Cir. 2009) (owner of incontestable mark LOVE POTION for perfume could not stop company from using “love potion fragrance” on packaging of beauty product); *Wonder Labs, Inc. v. Proctor & Gamble Co.*, 728 F. Supp. 1058, 1064 (S.D.N.Y. 1990) (owner of incontestable mark DENTISTS CHOICE for toothbrushes could not prevent use of “the dentist’s choice” in describing toothpaste); *Kazmaier v. Wooten*, 761 F.2d 46, 50-51 (1st Cir. 1985) (putative owner of common law right for WORLD’S STRONGEST MAN could not stop use of “world’s strongest man, John Wooten,” in a television commercial); *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 643 (7th Cir. 2001) (owner of mark for THE JOY OF SIX could not prevent the Chicago Tribune from using “The Joy of Six” as a headline on its newspaper and assorted merchandise). “It is not a trademark infringement to use words in their ordinary, rather than in their special trademark, meaning.” *Louis Rich, Inc. v. Horace W. Longacre, Inc.*, 423 F. Supp. 1327, 1339 (E.D. Pa. 1976).

This user is hardly the only person to use “fraudbuster” in a descriptive sense. Indeed, “fraudbuster” and variants thereon are very common descriptive terms. A simple search online reveals hundreds of such uses, including the following news articles:

- Bruce Golding & Bob Fredericks, ‘Gekko’ Turns Rat for FBI’s Fraud-Buster Ad, Douglas on Other Side of ‘Street,’ N.Y. Post, Feb. 28, 2012, at 13.
- Glenn Bain, Cuomo Says Medicaid Fraudbusters Got 148 Convictions, Recouped 283M, N.Y. Daily News, April 13, 2010, at 14.
- Erin Einhorn & Mike Jaccarino, Home Fraud Busters, N.Y. Daily News, Feb. 19, 2010, at 52.
- Robert Mitchell, Fraudbusters: Breaking Up Interagency Data Silos Helps the State of Michigan Catch Cheaters, ComputerWorld, Feb. 20, 2007.
- Andrew Kantor, FRAUDBUSTERS: High-tech tools help insurers piece together a picture of costly scams, Columbus Dispatch, May 17, 2004, at 1C.
- Sharon Waters, Fraudbusters: Don’t Mess With this Office of the DMV, Home News Tribune, April 22, 2004, at H-7.

Your letter also ignores the fact that your FRAUDBUSTERS mark is registered for use in a different field from the use about which you complain. Your trademark registration describes your goods and services as “newsletters and questionnaires in the field of investigation, forensic accounting and crime,” “forensic accounting and business consulting services in the field of investigation, forensic accounting and crime,” an “online newsletter in the field of investigation, forensic accounting and crime,” and “private investigation services; and trademark monitoring investigation services.” As I am sure you are aware, there was an earlier, senior mark to yours, for FRAUDBUSTER (Federal Registration No. 1877140) for computer hardware and software in the field of telecommunications. The two marks can coexist because they are being used in different fields. The difference between your mark’s field of use and the use of “fraudbuster” about which you complain here – *i.e.*, the selection of the term as a username to register and make a single comment on the website of a non-profit organization dedicated to supporting online publishers – is greater still. Of course, the descriptive fair use of “fraudbuster” would still be proper even if there were some evidence of consumer confusion. *See KP Permanent Makeup, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121-22 (2004).

Your generic letter does not apply to this situation at all, because “fraudbuster” is being used in an expressive, descriptive, non-commercial way, by a user on a website in a wholly different field from that in which you use your mark. Kessler’s ownership of a registered trademark does not grant it a monopoly over a portion of the English language. *See Union Oyster House v. Hi Ho Oyster House*, 316 Mass. 543, 544 (1944) (“No one can altogether appropriate to himself any part of the English language as a trade-name . . .”). Excessive enforcement efforts, such as your letter and the steps you are suggesting you may take, are harmful to both trademark holders and the public at large. *See* 6 J.

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Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 31:100 (4th ed. 2012) (noting the negative consequences and legal risks for sending indiscriminate cease and desist letters).

We trust that this letter clarifies the use of “fraudbuster” in this case and why that use provides no factual or legal basis for your assertion that the CMLP must remove the word from the two places it appears on its website. If you have any questions regarding the above, please do not hesitate to contact me.

Nothing herein shall be deemed an admission or waiver of any rights, remedies, defenses, and/or positions of Citizen Media Law Project and/or its affiliates, all of which are expressly hereby reserved.

Very truly yours,

A handwritten signature in black ink, appearing to read "C. T. Bavitz", with a long horizontal flourish extending to the right.

Christopher T. Bavitz