

COMMONWEALTH OF MASSACHUSETTS
APPEALS COURT

No. 2011-P-1533

SUFFOLK COUNTY

JENZABAR, INC.,
PLAINTIFF-APPELLANT,

v.

LONG BOW GROUP, INC.,
DEFENDANT-APPELLEE.

ON APPEAL FROM JUDGMENT OF THE SUPERIOR COURT

**BRIEF *AMICUS CURIAE* OF DIGITAL MEDIA LAW PROJECT
IN SUPPORT OF DEFENDANT-APPELLEE**

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CORPORATE DISCLOSURE STATEMENT

In accordance with S.J.C. Rule 1:21, *Amicus Curiae* Digital Media Law Project hereby states that it has no parent corporation and no publicly held corporation owns 10% or more of its stock.

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INTERESTS OF *AMICUS CURIAE*

As set forth more fully in the accompanying Motion of Digital Media Law Project for Leave to File Brief as *Amicus Curiae* in Support of Defendant-Appellee Long Bow Group, Inc., the Digital Media Law Project ("DMLP") (formerly known as the Citizen Media Law Project) provides legal assistance, training, and other resources for online and citizen media. DMLP regularly contributes to *amicus curiae* briefs in cases with important implications for online speech, journalism, and the public good.

This appeal addresses issues of direct interest to all members of the news media and, indeed, the public as a whole. Those issues are of particular interest to DMLP and its constituency of citizen journalists, new media startups, and others who engage in online journalism. The case raises fundamental questions about protections for critical speech and the extent to which a body of intellectual property or unfair competition law can be used to circumvent such protections. While reasonable protections for trademarks may help to prevent confusion among consumers as to the source of goods or services, it is imperative that trademark law not be applied in a

distinctly non-trademark context and used to impede the free flow of information.

As an advocate for the rights of those who gather and disseminate news and information, DMLP has a strong interest in ensuring that journalists, media organizations, and others are able to perform these functions effectively. DMLP is thus concerned by the implications of the arguments advanced by plaintiff-appellant Jenzabar, Inc. ("Jenzabar"). Those arguments suggest that directing Internet users to critical speech about an organization, using that organization's business name, causes cognizable trademark injury. Such arguments raise concerns that are particularly acute for independent reporters and smaller local news organizations such as those whose interests DMLP represents. The lower court correctly granted summary judgment in favor of defendant-appellee Long Bow Group, Inc. ("Long Bow"), dismissing Jenzabar's claims, and this Court should affirm that ruling.¹

¹ No party's counsel authored this brief in whole or in part, and no party or its counsel or any other person contributed money intended to fund preparing or submitting the brief. The Cyberlaw Clinic, counsel for DMLP herein, provided limited assistance to counsel for Long Bow in connection with certain

STATEMENT OF FACTS AND PROCEDURAL HISTORY

DMLP relies on the facts as set forth in the Superior Court's December 10, 2010 Memorandum of Decision and Order on Defendant's Motion for Summary Judgment (the "SJ Order"). *Jenzabar, Inc. v. Long Bow Group, Inc.*, No. 2007-02075-H (Mass. Super. Ct. Dec. 7, 2010). By way of a very brief summary, and as set forth in the Order, Long Bow produced a documentary about the 1989 Tiananmen Square protests and maintains a website that provides information about the documentary and the protests. SJ Order at 2.

Jenzabar alleged that the film and website contained information critical of its principal, Ling Chai ("Chai"). *Id.* Jenzabar further alleged that Long Bow improperly used metatags containing Jenzabar's trademarked name to draw readers to its website, where they encountered "false content containing false impressions about Jenzabar [and Chai]." *Id.* at 2-3.

Jenzabar and Ling asserted defamation claims seeking redress for such allegedly "false content," and those claims were dismissed early in the case in an August 5, 2008, Memorandum of Decision and Order on

submissions to the lower court in the case. DMLP had no direct involvement in the case.

Defendant's Motion to Dismiss. *Jenzabar, Inc. v. Long Bow Group, Inc.*, No. 2007-2075H (Mass. Super. Ct. Aug. 5, 2008). Jenzabar continued to press its trademark claims, based on Long Bow's use of Jenzabar's name in metatags, and the lower court granted summary judgment in favor of Long Bow dismissing those claims. SJ Order at 12. The instant appeal concerns the lower court's dismissal of Jenzabar's trademark claims.

SUMMARY OF ARGUMENT

Purely communicative uses of trademarks - uses that simply convey information about products or services - do not give rise to claims cognizable under trademark law (*infra*, pp. 8-14). The classic likelihood of confusion test employed by courts to evaluate claims of trademark infringement in cases involving competing goods and services is ill-equipped to address claims directed at the content of critical speech, even if that speech happens to concern a protected mark (*infra*, pp. 14-20). Given the extraordinary burdens and costs associated with trademark cases, courts addressing claims targeted at speech should resolve those claims on free speech and not trademark grounds and thus spare defendants the time and expense associated with litigating and trying

disputes in this area (*infra*, pp. 21-24). The First Amendment provides strong protections for speech - including critical speech - and courts in the Commonwealth and beyond are extraordinarily reluctant to allow a claimant to use trademark as an end run around the limitations associated with defamation or other bodies of law (*infra*, pp. 24-26).

The First Amendment's protections for speech extend to metadata that describe or identify the content of a web page and thus help readers to find information (*infra*, pp. 26-34). Speech requires an audience, and First Amendment jurisprudence conceives of a right to receive information along with the right to speak (*infra*, pp. 28-29). While some of the metadata at issue in this case is of questionable utility, those who create content must be allowed to structure their websites, craft URLs, and otherwise use metadata to reflect and describe the content on those sites and make them visible to search engines and readers alike (*infra*, pp. 29-34).

The modern realities of how Internet search engines work and how Internet users conduct online searches underscore the fact that the type of confusion that trademark law seeks to prevent simply

does not happen in cases such as this one (*infra*, pp. 34-42). Sophisticated search engines look well beyond simple metatags to index sites, and savvy Internet users understand how to press the "back" button on their browsers in the event they reach content that does not meet their search criteria (*infra*, pp. 35-40). Jenzabar's claims in this case conceive of the Internet as a conduit for commerce, when it is - in fact - a conduit for information (*infra*, pp. 34-35). Limiting the use of metatags as Jenzabar suggests would improperly impede the free flow of information (*infra*, pp. 40-42).

ARGUMENT

I. Introduction.

In a free and open society, every individual, corporation, and government entity is and must be subject to comment and criticism for their public actions. The First Amendment and Article 16 of the Massachusetts Declaration of Rights² ensure that open

² The Massachusetts Supreme Judicial Court has held that Article 16 is to be interpreted at least as broadly as the cognate provision of the United States Constitution. See *Hosford v. School Comm. of Sandwich*, 421 Mass. 708, 712 n.5 (1996); *Lyons v. Globe Newspaper Co.*, 415 Mass. 258, 268-69 (1993); *Colo v. Treasurer and Receiver Gen.*, 378 Mass. 550,

communication about civic affairs is protected by guaranteeing the right to speak on matters of public interest. An essential element of this right is the ability to identify people and entities involved in such matters by name. Without that right, freedom of expression would be meaningless; audiences would be unable to identify speech that is of interest or understand what the speaker is saying.

This is exactly what Jenzabar seeks to achieve in this case: to force the removal of labels and tags that may enable the public to find speech by Long Bow about Jenzabar, so that any criticism by Long Bow of Jenzabar is lost in digital limbo.³ Having failed before the trial court in its direct challenge by means of a defamation claim to Long Bow's criticism, Jenzabar now attempts to use trademark law to block Long Bow's efforts to make its content locatable online. But, allowing a corporation to banish

558 (1979); *Commonwealth v. Sees*, 374 Mass. 532, 536-37 (1978).

³ As described herein, major search engines (including, most notably, Google) likely do not even consider metatags of the specific type at issue in this case when responding to search queries by users. See discussion, *infra*, Section IV. Nevertheless, nothing should preclude a party like Long Bow from attempting to attract readers to its content by using metadata on its website.

criticism to the hinterlands of the Internet because its name happens to be a trademark would grant that corporation - without any conceivable or rational policy justification - an exclusive ability to censor speech to which no one else in our society is entitled and which runs contrary to long-standing constitutional speech doctrines.

Allowing trademark law to be applied in such a manner would have a catastrophic effect on public speech - particularly online speech - about corporate affairs, at a time when corporate activity has never been more newsworthy and the Internet is the primary method by which citizens communicate with one another. For that reason, DMLP urges this Court to affirm the trial court's dismissal of Jenzabar's trademark claims and to craft its decision in a way that recognizes the clear delineation between valid uses of trademark law (to avoid consumer confusion) and invalid ones (to suppress critical speech).

II. Communicative uses of trademarks are substantively outside the scope of trademark doctrine.

DMLP asks this court not just to affirm the trial court's grant of summary judgment in favor of Long Bow but to clarify that the constitutional protections

afforded to speech place communicative uses of trademarks - uses that simply identify goods, services, or trademark owners for the purpose of setting the context for comment or criticism - beyond the reach of individual trademark holders. Trademark law exists within constitutional constraints and is intended to remedy harms occurring from unfair competition in the marketplace; it does not recognize injuries to reputation that may result from purely communicative uses. Indeed, trademark law's central test - the traditional multifactor evaluation of likelihood of confusion - cannot be applied to communicative uses of trademarks without reaching absurd results. This forces courts to massage or contort the test in order to avoid silencing speech. The failings of the likelihood of confusion test in this context support the conclusion that communicative uses of trademarks should fall outside of trademark law altogether.

This is not simply a matter of the rubric under which these cases are considered. Given the duration and cost of the typical trademark case, the risk of litigation can create a chilling effect on speech that goes well beyond the outcome of any specific case.

Plaintiffs cannot be allowed to embroil defendants in costly trademark litigation to accomplish what they cannot through defamation claims because of the important protections afforded by the First Amendment.

A. Injuries like those alleged here are not properly assessed by use of a trademark analysis.

Communicative uses of trademark are protected speech, and they are threatened by the misuse of trademark law to silence free expression. *Cf. Cohen v. California*, 403 U.S. 15, 26 (1971) (stating one cannot "forbid particular words without also running a substantial risk of suppressing ideas in the process"); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996) (applying *Cohen* in intellectual property claims to bar trademark and right of publicity claims against criticism of professional baseball players through parody baseball cards). Courts and commentators have recognized the potential for abuse of trademark law to suppress ideas and expressions that a markholder simply dislikes. *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."); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) ("[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."); 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.").

An individual's right to criticize a commercial entity is indisputably protected under the First Amendment. See, e.g., *Bakery and Pastry Drivers, Local 802 v. Wohl*, 315 U.S. 769 (1942); see also *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 513 (1984) (applying fault standard to criticism of product). Courts protect commentary on branded products and trademark owners because "robust criticism" of the goods and services that populate the marketplace serves "the public interest." *SNA, Inc. v. Array*, 51 F. Supp. 2d 554, 566 (E.D. Pa. 1999), *aff'd sub nom. Silva v. Karlsen*, 259 F.3d 717 (3d Cir. 2001).

To combat potential misuse, courts have declared that injuries to reputation, even if they arise from the use of a trademark, are outside of trademark law. If criticism could be enjoined because it employed a trademark, then "a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct." *L.L. Bean*, 811 F.2d at 29; see also *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) ("[J]ust because speech is critical of a corporation and its business practices is not a sufficient reason to enjoin the speech.").

To avoid this form of censorship, courts insist that trademark law does not recognize all injuries that may result from the use of a trademark. See *Universal Commc'n Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 423 (1st Cir. 2007) ("The injury that [plaintiff] alleges . . . is not a form of trademark injury."). In particular, critical commentary that injures reputation "falls outside trademark law." *Id.* at 424; see also Harvey S. Perlman, *The Restatement of the Law of Unfair Competition: A Work in Progress*, 80 Trademark Rep. 461, 482 (1990) ("[W]here the trademark owner alleges injury to reputation from the non-

trademark use of its mark, trademark law . . . should not apply.”). Reputational injuries do not become cognizable as trademark injuries merely because critical speech has an attenuated connection to commercial activity, such as appearing on a website that generates revenue through advertising, within a for-profit magazine, or in the lyrics of a commercially marketed song. See *Lycos*, 478 F.3d at 424 (revenue-generating website); *L.L. Bean*, 811 F.2d at 32 (magazine); *Mattel*, 296 F. 3d at 907 (song).

Some courts have recognized a cause of action when a defendant uses a plaintiff’s mark solely for its goodwill, to improperly divert traffic to the defendant’s unrelated service or message, rather than to identify the target of criticism. See, e.g., *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 779, 786, 792 (8th Cir. 2004) (affirming injunction against bad faith use of mark in domain names such as “mycoca-cola.com” and “mymcdonalds.com” to lure Internet users to antiabortion website unrelated to the mark or markholder); *Hearts on Fire Co., LLC v. Blue Nile, Inc.*, 603 F. Supp. 2d 275, 288 (D. Mass. 2009) (denying motion to dismiss where defendant allegedly used plaintiff’s trademark to generate search results

for its own services and nothing on defendant's website would alert users that defendant had no connection to plaintiff). Such misuse of goodwill is plainly distinct from identifying the target of criticism by name, which does not cause trademark injury.

As the court noted below, Jenzabar initially claimed that Long Bow caused it "reputational injury" and "loss of business opportunities." SJ Order at 3. Even though Jenzabar now wishes this Court to focus on how Long Bow finds its audience rather than Long Bow's message, it remains plain that this case involves allegations of harm that are not properly remedied by application of trademark law.

B. The likelihood of confusion test should not apply in trademark cases based on communicative, critical speech.

That trademark law is not intended to prevent the communicative and critical use of trademarks is further demonstrated by the fact that its cornerstone doctrine - the likelihood of confusion test - is neither designed nor equipped to analyze the communicative use of marks. The test was designed to address the paradigmatic trademark dispute in which a

trademark owner's direct competitor "dup[es] consumers into buying a product they mistakenly believe is sponsored by the trademark owner." *Mattel*, 296 F.3d at 900. The test contemplates an examination of two similar but distinct marks used by two different players in the marketplace; in evaluating the likelihood of confusion, courts explore, among other things, the similarity of the marks, the similarity of the goods or services in question, and the strength of the plaintiff's mark. See *Planned Parenthood Fed'n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 398 Mass. 480, 488 (1986); *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 29 (1st Cir. 1989).⁴

Shoehorning a communicative use into a traditional confusion analysis requires treating that use as though it was akin to mislabeling a product.

⁴ A total of nineteen factors are considered by the various Federal Courts of Appeals as part of the likelihood of confusion test. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581, 1591 (2006). Professor Beebe states in particular that "[t]he similarity of the marks factor is by far the most influential." *Id.* at 1600; see also *Brookfield Commc'ns v. West Coast Entm't Corp.*, 174 F.3d 1036, 1054 n. 16 (9th Cir. 1999) (holding most relevant factors for confusion in Internet trademark cases to be similarity of the marks, the relatedness of goods, and the simultaneous use of the Internet as a marketing channel).

This, in turn, distorts trademark law as courts try to preserve outcomes consistent with the First Amendment while clearing doctrinal hurdles. See William McGeeveran, *Rethinking Trademark Fair Use*, Iowa L. Rev. 49, 51 (2008) (“[D]octrines to accommodate free speech values that may arise in trademark cases are overlapping, confusing, volatile, and cumbersome.”). By forthrightly addressing speech interests using applicable doctrines (such as defamation law), a court can and should avoid these esoteric contortions of trademark law.

- 1. Courts that purport to use the likelihood of confusion test in cases of critical speech generally do not actually apply the test.**

A number of courts have attempted to balance the free speech concerns inherent in trademark law by purporting to apply some form of the standard likelihood of confusion test. But, though courts that claim to apply a likelihood of confusion test to critical speech may discuss that test's various factors, they often base their decisions on the strength of the defendant's speech interests separate and apart from the strictures of the test.

In *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1317 (N.D. Ga. 2008), after finding that defendant's use of Walmart's marks constituted parody, the court purported to apply the likelihood of confusion test while holding that parodies "influence the way the likelihood of confusion factors are applied." This led the court to apply two of the most important factors - similarity of the marks and strength of the senior mark - in a manner fundamentally different from how they would be applied in a standard trademark case. See *id.* at 1335 (noting that "a parodist must use at least some of the mark he criticizes" and that use of a strong mark makes a parody more recognizable); see also *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 225 (3d Cir. 2005) (noting the "need to use the actual mark to describe the plaintiff's product because of its very strength and what it has come to represent"). Significantly, the *Smith* court rejected the trademark dilution claims by straightforwardly asserting the defendant's First Amendment right to critique Walmart through parody. *Smith*, 537 F. Supp. 2d at 1339.

In *Lamparello v. Falwell*, 420 F.3d 309, 315 (4th Cir. 2005), the United States Court of Appeals for the

Fourth Circuit purported to apply the likelihood of confusion test to a dispute over the plaintiff's domain name "falwell.com" and the defendant's "fallwell.com." Yet, in its discussion of the similarity of goods and services, the court stated that the critical commentary meant that no one "would be misled by the domain name," even though their domain names are one letter apart. *Id.*

SMJ Group, Inc. v. 417 Lafayette Restaurant LLC, 439 F. Supp. 2d 281 (S.D.N.Y. 2006) - a case relied on by both Jenzabar and *amicus curiae* Boston Patent Law Association for the proposition that the First Amendment has no role in trademark cases - is, in fact, an excellent example of this phenomenon. There, the district court assumed confusion because the parties did not appear to dispute that issue. *Id.* at 288. The court then stated that the First Amendment provided no defense when the use caused confusion as to source. *Id.* at 291. Nevertheless, the court returned to First Amendment principles in denying an injunction, finding that no harm could be proven that did not flow from the defendants' "substantive message," and that "such 'harm' is not the concern of the Lanham Act, which protects against unfair use of

trademarks, not against competition in the marketplace of ideas." *Id.* at 295; *cf. Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting) (introducing the "free trade in ideas . . . in the competition of the market" as a fundamental theory of the First Amendment); *see also* McGeeveran, *supra*, *Rethinking Trademark Fair Use*, *supra*, at 59 n. 44 (noting *SMJ Group* as a case that had a "positive outcome, but . . . for troubling reasons").

The results of these cases do not vary: courts consistently allow critical speech that uses trademarks. But, the courts' disparate ways of handling the traditional likelihood of confusion analysis underscores the fact that the test can produce absurd results when applied in such cases. Both the similarity of the marks and the strength of plaintiff's mark - two of the three factors which the Massachusetts Supreme Judicial Court focuses in its own formulation of the likelihood of confusion test - are rendered nugatory in such cases. *See Planned Parenthood*, 398 Mass. at 488 ("[S]imilarity of the mark, strength of the mark, and similarity of services are important in establishing . . . the likelihood of confusion."). The very point of using a trademark in

critical speech is for that mark to be similar - indeed, identical - to the mark that is the subject of criticism, and the fact that plaintiff's mark is strong means that the general public is likely to refer to the company by its mark. See *Century 21 Real Estate Corp.*, 425 F.3d at 225 (3d Cir. 2005) ("[T]he use of the name may be the only way for defendant to easily and precisely refer to plaintiff's product in a way that will be understood by consumers."); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) ("[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.").⁵

⁵ Attempting to resolve the issue of communicative uses of trademarks, the Ninth Circuit articulated a three-pronged "nominative fair use" doctrine in *New Kids on the Block*. 971 F.2d at 308. Use of a mark is a nominative fair use if the product or service cannot be identified without using the mark, no more of the mark is used than necessary, and the use does not imply sponsorship. *Id.* While nominative fair use avoids the problems of analyzing similarity of the marks and the strength of the plaintiff's mark, the third factor reintroduces likelihood of confusion analysis, with its attendant flaws. See *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 909 (9th Cir. 2003) (calling third factor "merely the other side of the likelihood-of-confusion coin"). Furthermore, *New Kids on the Block* did not concern critical speech; it concerned a call-in poll asking which "New Kid" was most popular. 971 F.2d at 304. A popularity contest,

2. Requiring defendants to defend against a likelihood of confusion claim is tremendously costly and creates an impermissible chilling effect on speech.

The application of trademark law to communicative uses is not only inappropriate and unwieldy; the misuse of trademark law can extend litigation and have a chilling effect on speech. The fact-sensitive determinations required in assessing the likelihood of confusion between two marks turns the threat of litigation into an economic weapon. See McGeveran, *Rethinking Trademark Fair Use, supra*, at 70 ("Much of the high cost of trademark litigation can be explained by the fact-intensive nature of the likelihood of confusion inquiry."). The length and cost of traditional trademark analysis – regardless of what outcome is ultimately reached – thus "creates a classic chilling effect upon the unlicensed use of trademarks to facilitate speech." *Id.* at 52.

Two primary factors contribute to the high cost of trademark litigation: surveys and experts. See McGeveran, *Rethinking Trademark Fair Use, supra*, at

even when it appears on the pages of a newspaper, may raise a potential for confusion that is absent in a critical speech case. See *Lamparello*, 420 F.3d at 315 (holding critical nature of speech eliminated any implication of sponsorship).

70. Plaintiffs, in order to show a likelihood of confusion, often hire experts to design and conduct a survey of consumer responses to the trademark use. See *Indianapolis Colts, Inc. v. Metro. Balt. Football Club Ltd. P'ship*, 34 F.3d 410, 414 (7th Cir. 1994) ("the parties to trademark disputes frequently as here hire professionals in marketing or applied statistics to conduct surveys of consumers"). A defendant has little choice but to enlist its own expert to create a competing survey. This battle of the experts is of questionable utility but is nonetheless "hideously expensive." McGeveran, *Rethinking Trademark Fair Use*, *supra*, at 70; see also *Indianapolis Colts*, 34 F.3d at 415 ("The battle of experts that ensues is frequently unedifying.").

These trademark-specific costs associated with surveys and experts are in addition to legal fees that mount as litigation continues. The end result is that even a "small" trademark case carries a median price tag of \$300,000; for a "large" trademark case, that figure is \$1.25 million. See Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 Iowa L. Rev. 1669, 1695 (2006-2007) (citing American Intellectual Property Law Association, *Report*

of the Economic Survey 22 (2005)). When the cost of trademark defense can run into seven-figures, "many people who have the right to make a use may give in rather than fight to protect their rights." *Id.* at 1696.

To apply costly and convoluted tests in cases that involve purely communicative uses of trademarks, and to allow those cases to proceed to trial, only empowers trademark owners who would misuse trademark law to silence their critics. A preferable route would be to resolve this under the rubric of defamation law, with its First Amendment protections and strong preference for early dismissal. See *King v. Globe Newspaper Co.*, 400 Mass. 705, 708 (1985) (favoring summary judgment in defamation cases to avoid the impact on speech of the costs of trial). Thus, this Court should take advantage of the opportunity to end this lawsuit in a way that makes clear that the kinds of uses at issue fall outside the ambit of trademark law. Affirming summary judgment will protect speech in this case and prevent future litigants from using the threat of a lengthy trial to provoke capitulation by defendants making communicative uses of trademarks.

C. Massachusetts and federal law prohibit using alternative claims to make an end run around the First Amendment protections built into defamation law.

If critical speech about a trademark owner is false and damaging, defamation law provides the appropriate remedy. See *Lycos*, 478 F.3d at 423-24 (“[Plaintiff] does allege that . . . the criticism is false and misleading. But while such allegation might be relevant to a defamation claim, it is not determinative of whether [plaintiff’s] allegations can support a trademark claim.”). The law of defamation has developed built-in safeguards to guarantee that speech rights are not casually set aside and places a heavy burden on defamation plaintiffs to prove that the speech at issue has lost its constitutional protection. Moreover, the protections of defamation law are not purely formalist, and a claimant cannot circumvent them through artful pleading.

Defamation law has internalized the protections of the First Amendment by, *inter alia*, requiring a plaintiff to show both fault and falsity. See *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988) (noting the “constitutional rule” requiring public figures to prove falsity and culpability); *Gertz v.*

Robert Welch, Inc., 418 U.S. 323, 347 (1974)
(requiring proof of fault in defamation cases concerning private figures). Plaintiffs are not relieved of proving these elements by casting defamation claims in different terms. *Hustler*, 45 U.S. at 56 (pleading an emotional distress claim does not relieve a plaintiff who is a public figure from the requirement of showing that "the publication contains a false statement of fact which was made with 'actual malice'").

The Supreme Judicial Court and the United States Court of Appeals for the First Circuit have consistently rejected attempts by plaintiffs to avoid the First Amendment protections inherent in defamation law by dressing up their defamation claims in the garb of some other species of tort. See *Yohe v. Nugent*, 321 F.3d 35, 44 (1st Cir. 2003) ("[A] plaintiff cannot evade the protections of [defamation doctrine] merely by re-labeling his claim."); *Brown v. Hearst Corp.*, 54 F.3d 21, 27 (1st Cir. 1995) ("it is not imaginable that [a false light claim] could escape the same constitutional constraint as [a] defamation claim"); see also *Correllas v. Viveiros*, 410 Mass. 314, 324 (1991) ("A privilege which protected an individual

from liability for defamation would be of little value if the individual were subject to liability under a different theory of tort"). A plaintiff's effort to attack criticism through a trademark claim should be equally ineffective in evading constitutional hurdles.

III. The First Amendment protects use of trademarks in metadata to make speech about the trademark owner accessible to the public.

The promise of free speech is that one has the right to listen and the right to be heard in the marketplace of ideas. See *Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n of Cal.*, 475 U.S. 1, 8 (1986) (plurality opinion) ("By protecting those who wish to enter the marketplace of ideas from government attack, the First Amendment protects the public's interest in receiving information."). Metadata bring ideas into this marketplace by enabling speech to reach the audience that seeks it through search engines; to remove a statement from search results is to expel it from this marketplace.⁶

⁶ "'Metadata' refers to content about the web page that describes or summarizes the page, such as the page title, the page URL or domain name, and 'metatags.'" Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L.J. 507, 529 (2005). See Sections IV(A) and IV(B), *infra*, for a discussion of the role of metadata in search results.

The Internet allows speakers with vastly disparate financing and public visibility to reach the public in a way that commercial advertisements, mass mailings, and other forms of non-digital speech do not. See *Reno v. ACLU*, 521 U.S. 844, 853 (1997) (“[The Internet] constitutes a vast platform from which to address and hear from a worldwide audience of millions of readers, viewers, researchers, and buyers. Any person or organization with a computer connected to the Internet can ‘publish’ information.”). Moreover, the First Amendment protects this important aspect of the Internet not only for those who “speak” online, but for those who receive such. Metadata - including tags such as those employed by Long Bow in this case - benefit from this protection not only because they are essential to ensure that speech reaches interested listeners, but because they are protected expressions of a website’s significance or gist. When the summarization of a web page’s content embodied in that page’s metadata rightfully includes a trademarked term, as it often does, trademark law should not provide a means by which that content can be sequestered.

A. The First Amendment gives website operators the right to reach an audience, and the audience has a right to receive that speech.

Censorship of websites that make use of trademarks in metadata violates not only the First Amendment right to free speech but also the reciprocal right to hear that speech. See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (noting "the right of the public to receive suitable access to social, political, esthetic, moral, and other ideas and experiences"). It follows that website operators such as Long Bow should be free to configure their websites so that search engines are able to recognize their content – content that often relates to companies with trademarked names – and website audiences should be able to rely upon search engines without interference.

Environmental groups, consumer protection organizations, and others with legitimate reasons to speak about the activities of corporations have just as much right to reach their audience as the corporations themselves.⁷ But, Jenzabar's novel

⁷ Top results for a Google query of "Walmart" include both WalmartWatch.org and PeopleOfWalmart.com, which both either criticize or parody Walmart. Querying "Monsanto" returns links to EthicalInvesting.com and MonsantoSucks.com, both highly critical of Monsanto, and both using Monsanto's marks in its metatags.

trademark theory demands that a court intervene directly in the relationship between speaker and audience, mandating that search results of speech not authorized by trademark holders be scrubbed.

B. Metadata are communicative speech, protected by the First Amendment.

Metadata embedded in a website's code communicate information just like the visible content on a web page itself. They help search engines discover the subject matter of a website in order to reach interested users, and reflect the website operator's editorial choice regarding the site's meaning and the relative importance of the topics addressed. Metadata - whether consisting of title tags, description tags, keyword tags, or anything used by a web page's creator to reflect and describe the contents of that page - represent a speaker's assessment of the core message being spoken and an attempt to reach the audience for whom that message is most relevant. Accordingly, metadata are as much a part of the communicative message as the viewable content of the website itself and are thus subject to the same First Amendment protections.

1. Use of metadata is speech.

Metadata convey a "communicative message" that is protected by the First Amendment, and courts have acknowledged the protected nature of particular forms of online code. See *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016-17 (9th Cir. 2004) (reasoning that if critical speech is protected, links to critical speech are also protected); *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 588 (2d Cir. 2000) ("[D]omain names may be sufficiently expressive to constitute protected speech."). The *Nissan* and *Name.Space* courts focused on a discrete type of metadata, but their reasoning extends to any metadata that help a website express its meaning and reach an audience.

Courts have specifically recognized the importance of trademarks in one form of metadata – keyword metatags – as a way to enable online speakers to reach an audience. See *Bihari v. Gross*, 119 F. Supp. 2d 309, 323 (S.D.N.Y. 2000) ("use of the [plaintiff's] mark in the metatags of his websites is the only way [defendant] can get his message to the public"); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998)

("Prohibiting [the defendant] from using [plaintiff's] name in the machine readable code would effectively isolate him from all but the most savvy of Internet users."). The same rationale extends to other metadata that search engines now (or might in the future) use to guide web surfers to relevant pages. See Goldman, *Deregulating Relevancy*, *supra*, at 534.

2. If the use of a trademark in metadata is an accurate, communicative use, such speech should not be silenced by application of trademark law.

Jenzabar's proposed remedy would bar all others from referring to the company by name in any metadata, whether a domain name, the title of a web page, or a keyword metatag. Depending on how a particular search engine considers metadata in formulating search results, this might effectively remove any critic's web page from such results. News accounts or consumer reviews concerning Jenzabar would not be seen by Internet searchers interested in Jenzabar. Visible, on-the-page content could remain, but only so long as it remained inaccessible to all but the most persistent of Internet users. Such large-scale silencing of critical speech would be completely inconsistent with the First Amendment. See, e.g., *CPC*

Int'l, 214 F.3d at 462 (holding First Amendment protects "our ability to discuss the products or criticize the conduct of companies that may be of widespread public concern and importance").

Jenzabar's conception of how trademark law interacts with Internet search "illustrate[s] how trademark law could jeopardize the Internet's potential as an information resource." Goldman, *Deregulating Relevancy, supra*, at 509. Trademarks used in metatags play an essential role in expressing the content, relevance, or meaning of a website to search engines (and, by extension, to searchers). A trademark regime that finds infringement when website publishers use accurate trademarks in metadata threatens to choke off Internet search as a conduit of speech.⁸

Consider, for example, a high school student assigned to research how oil companies provide compensation to those affected by oil spills. The student might well begin his research by querying "BP spill" or "BP spill compensation." The results currently provided by Google include news stories like

⁸ See discussion, *supra*, pp. 13-14.

"BP Oil Spill Payments Stalled in Wrinkle over Fees,"⁹
"BP Says Halliburton 'Intentionally Destroyed
Evidence' after Gulf Oil Spill,"¹⁰ and "Halliburton
Sues BP for Defamation over Gulf Spill."¹¹ These sites
all use trademarks in metadata to identify their
content.¹² Under Jenzabar's conception of trademark
law, both BP and Halliburton would have cause to sue
the operators of these websites for using their trade
names in those pages' URLs, website title tags, and
metatags. If they were allowed to do so, Halliburton
and BP could ensure that only official press releases
appear in response to Internet searches containing
their trademarks. The student would have no access to
speech critical of these organizations.

⁹ Cain Burdeau, *BP Oil Spill Payments Stalled in Wrinkle over Fees*, Huffington Post (Jan. 4, 2012, 6:26 PM), http://www.huffingtonpost.com/2012/01/04/bp-oil-spill-payments_n_1183793.html.

¹⁰ Vivian Kuo, *BP Says Halliburton 'Intentionally Destroyed Evidence' after Gulf Oil Spill*, CNN (Dec. 6, 2011, 5:26 AM), <http://www.cnn.com/2011/12/05/us/bp-halliburton/>.

¹¹ Reuters, *Halliburton Sues BP for Defamation over Gulf Spill*, Fox Business (Sep. 2, 2011), <http://www.foxbusiness.com/industries/2011/09/02/halliburton-sues-bp-for-defamation-over-gulf-spill/>.

¹² The Huffington Post uses the BP mark in its keywords metatag, its title tag, and its URL; CNN uses the BP and Halliburton marks in its title tag and description metatag; and Fox Business used both marks in its URL, keywords metatag, and title tag.

IV. The modern realities of the Internet obviate any potential confusion in cases like this one.

Unlike a mall or grocery store, the Internet is not merely a conduit for shopping; it is the essential conduit of communication and information in the twenty-first century. Whereas people generally visit stores to purchase goods, people use the Internet (and, thus, search engines that help them locate content on the Internet) for innumerable purposes beyond shopping, including research, expression of ideas, dating, newsgathering, and aimless meandering through depths of information and opinion.

Because searchers, unlike shoppers, do not browse the Internet with a common purpose or set of purposes, search engines have evolved to provide efficient access to *all* of the types of websites that relate to a search query. This includes websites not owned, operated, or controlled by the query's namesake. In the same way, searchers have developed habits that allow them to sift through and navigate the diverse content of the Internet without difficulty or confusion. Both search engines and searchers have rendered Jenzabar's concerns about consumer confusion obsolete.

A. Modern search engine implementations prevent parties from altering search results by use of "optimizing" metatags.

Effectively guiding searchers with different aims and preferences to individual pages of the many billions¹³ of websites indexed by search engines necessarily involves a much more sophisticated and complicated process than merely assessing which websites include certain text or metatags.¹⁴ To surmount the technical difficulties associated with this complex task, search engines routinely tweak the algorithms that determine their results. See Goldman, *Deregulating Relevancy, supra*, at 536 ("[S]earch engines constantly change their relevancy algorithms."). These constant revisions to promote search accuracy and efficiency make it difficult for parties to artificially alter search rankings. In fact, through this revision process, and because of

¹³ In July 2008, Google announced that it had indexed over one-trillion unique URL's. Jesse Alpert & Nissan Hajaj, *We Knew the Web Was Big...*, The Official Google Blog (Jul. 25, 2008, 10:12 AM), <http://googleblog.blogspot.com/2008/07/we-knew-web-was-big.html>.

¹⁴ Google itself has noted that "over 200 signals that can affect how your site is crawled, indexed and ranked." *FAQ: Crawling, Indexing & Ranking*, Google Webmaster Central (Jan. 16, 2012, 2:00 PM), <https://sites.google.com/site/webmasterhelpforum/en/faq--crawling--indexing---ranking>.

attempts to game its search results, Google has publicly announced that it disregards the keywords metatag – a particular type of metatag central to Jenzabar’s claims – in determining the prominence of websites in its search results.¹⁵

As such, the prediction that allowing parties to optimize their search rankings in searches for other parties’ trademarks would lead to inaccurate search results and a frustrating and inefficient Internet is a chimera. See William Romanos, *Internet Accuracy Wars: How Trademarks Used in Deceptive Metatagging Should Be Dealt with To Increase Economic Efficiency*, 7 U. Balt. Intell. Prop. L.J. 79, 80 (1998) (“If deception is used in the metatags, search engines will adapt to this deception.”); see also Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 Cardozo L. Rev. 105, 174 (2005) (“Many search engines discount repeated uses of the same terms.”). To remain relevant, search

¹⁵ See, e.g., Matt Cutts, *Google Does Not Use the Keywords Metatag in Web Ranking*, Webmaster Central Blog: Official News on Crawling and Indexing Sites for the Google Index (Sep. 21, 2009, 10:00 AM), <http://googlewebmastercentral.blogspot.com/2009/09/google-does-not-use-keywords-meta-tag.html> (“Because the keywords meta tag was so often abused, many years ago Google began disregarding the keywords meta tag.”).

engines do and must stay a step ahead of those who try to game the system so that those who, like Long Bow, accurately label their content can reach their audiences. See James Grimmelman, *The Structure of Search Engine Law*, 93 Iowa L. Rev. 1, 44 (2007) (“Strong market incentives compel search engines to combat SEO because by doing so, engines can give users better results. The consequence is a technical arms race between engines and manipulators.”).

B. Jenzabar’s claims do not accurately reflect the search habits of readers.

The specter of searcher confusion raised by Jenzabar is also inconsistent with how people actually search the Internet. Courts have recognized that “[a]ny internet user is familiar with the confusion one confronts with such a welter of search results, but that confusion is the uncertainty about where to go next, not necessarily the confusion that is relevant for purposes of trademark law.” *Fancaster, Inc. v. Comcast Corp.*, No. 08-2922, 2011 WL 6426292 at *26 (D.N.J. Dec. 22, 2011) (internal quotations omitted) (quoting *Simon Property Grp. L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1044 (S.D. Ind. 2000)). Moreover, Internet searchers are increasingly

sophisticated and resistant to trickery. See *Network Automation*, 638 F.3d at 1152 (acknowledging heightened consumer care "as the novelty of the Internet evaporates and online commerce becomes more commonplace."). Though *Jenzabar* frames its case as one about "users hav[ing]. . . been duped" by Long Bow's use of the word "Jenzabar" on its website, it is quite clear that Internet searchers are savvy with respect to the nature of search engine results: "the confusion one encounters on an Internet search engine is a twenty-first century version of that experienced when searching the phone book." *Fancaster*, 2011 WL 6426292 at *26.

These observations militate against the applicability of the initial interest confusion doctrine to the context of Internet search. The idea that trademark infringement occurs when a searcher is unsure whether a particular search result is sponsored by a trademark holder simply does not accord with the realities of modern search. "[I]n the age of FIOS, cable modems, DSL and T1 lines, reasonable, prudent and experienced internet consumers are accustomed to such exploration by trial and error. . . . They skip from site to site, ready to hit the back button

whenever they're not satisfied with a site's contents." *Toyota Motor Sales v. Tabari*, 610 F.3d 1171, 1179 (9th Cir. 2010); see also *Fancaster*, 2011 WL 6426292 at *26 (holding "the search engine results offered by Fancaster are not probative of initial interest confusion" because searchers are not confused, for the purposes of trademark law, by an amalgam of search results).

In addition to the fact that searchers are accustomed to the potpourri of results generated by many search queries, and that broad application of the initial interest confusion doctrine threatens critical speech, Long Bow's use of the Jenzabar trademark should be protected because searchers commonly use trademarks as part of their search queries to find results tangentially related to those trademarks. See, e.g., Goldman, *Deregulating Relevancy*, *supra*, at 509; see also Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, *supra*, at 106. If the Internet is to remain a bastion of robust and democratic speech, it is essential that searchers be able to use search engines in this manner. Consider a Google search for "Bain Capital." Though some searchers might use that term in an effort to

locate the company's corporate web page, others might be looking for information about Mitt Romney,¹⁶ editorials about his history at Bain,¹⁷ or websites discussing Romney's response to such editorials.¹⁸ Other searchers might be searching by analogy: "Bain Capital" might strike them as the best query to find information about private equity investing, venture capital, or firms similar to Bain.¹⁹ These websites would be significantly more difficult – or nearly impossible – to find if they could not optimize their search engine placement by using trademarks in their metadata.

Jenzabar's trademark theories ignore the realities of the Internet environment and would harm the ability

¹⁶ See Robert Gavin & Sacha Pfeiffer, *The Making of Mitt Romney*, Bos. Globe, Jun. 26, 2007, http://www.boston.com/news/politics/2008/specials/romney/articles/part3_main/?page=8.

¹⁷ See William D. Cohan, *When Romney Ran Bain Capital, His Word Was Not His Bond*, Wash. Post, Jan. 14, 2012, http://www.washingtonpost.com/opinions/when-romney-ran-bain-capital-his-word-was-not-his-bond/2012/01/12/gIQACvQxwP_story.html.

¹⁸ See also Maeve Reston, et al., *Romney Rebuts Opponents' Attacks*, L.A. Times, Jan. 13, 2012, <http://articles.latimes.com/2012/jan/13/nation/la-na-campaign-20120113>.

¹⁹ *Private Equity*, Wikipedia, http://en.wikipedia.org/wiki/Private_equity (last updated Jan. 17, 2012 8:36 AM EST); *Venture Capital*, Wikipedia, http://en.wikipedia.org/wiki/Venture_capital (last updated Dec. 17, 2011 7:03 PM EST).

of the Internet to function as a vital information resource. See *Lamparello*, 420 F.3d at 317-18 (rejecting initial interest confusion because it risks silencing critical speech). To allow trademark law to disrupt and discourage critical, communicative uses of company brand names on the Internet violates the constitutional rights of both those that publish information and those who read that information.


CONCLUSION

For the foregoing reasons, DMLP respectfully submits that this Court should recognize the vital speech interests at the heart of this case and affirm the lower court's ruling dismissing Jenzabar's trademark claims in a manner that avoids needless entanglement of traditional trademark infringement analysis with long-standing protections for speech.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I, Christopher T. Bavitz, hereby certify pursuant to Mass. R. App. P. 16(k) that the instant brief complies with the rules of court pertaining to the filing of briefs, including, but not limited to, Mass. R. App. P. 16(a)(6), (b), (e), (f), and (h), 18, and 20.

Dated: January 18, 2012

 C.T. Bavitz

ADDENDUM

United States Constitution Amendment I

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.

Constitution of the Commonwealth of Massachusetts Article XVI

The liberty of the press is essential to the security of freedom in a state: it ought not, therefore, to be restrained in this commonwealth. The right of free speech shall not be abridged.

CERTIFICATE OF SERVICE

I, Christopher T. Bavitz, hereby certify that on January 18, 2012, I caused two true and correct copies of the above document to be served on counsel of record for each of the parties by mailing the document by first-class mail, postage pre-paid, to the following:

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