

COMMONWEALTH OF MASSACHUSETTS

# Appeals Court

No. 2011-P-1533

SUFFOLK COUNTY

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JENZABAR, INC.,  
PLAINTIFF - APPELLANT,

v.

LONG BOW GROUP, INC.,  
DEFENDANT - APPELLEE.

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ON APPEAL FROM JUDGMENT OF THE SUPERIOR COURT

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**AMICUS CURIAE BRIEF OF  
BOSTON PATENT LAW ASSOCIATION**

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**CORPORATE DISCLOSURE STATEMENT**

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

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## INTEREST OF AMICUS CURIAE

Founded in 1924, the Boston Patent Law Association ("BPLA") is one of the oldest intellectual property law organizations in the country. The BPLA sponsors educational programs and forums for its approximately 900 members concerning patent, trademark, and other intellectual property rights. BPLA members—attorneys and other intellectual property professionals—serve a broad range of clients that rely on intellectual property, such as individual inventors, companies large and small, investors, merchants, and research universities, to name a few. These clients operate in an equally broad range of industries, including life sciences, software, "high tech," consumer products, and traditional manufacturing.

The BPLA is concerned that as new technologies transport the marketplace from the "brick and mortar" world to the Internet and mobile platforms, traditional trademark law may require additional interpretation. That interpretation could cause inconsistency in the application of the law, thus weakening trademark rights and leading to a lack of confidence in intellectual property rights generally.

As such, the BPLA seeks to help clarify the law and provide guidance for when trademarks are at issue in Internet and other "new economy" cases.<sup>1</sup>

#### SUMMARY OF THE ARGUMENT

The BPLA is concerned that because the Superior Court viewed this matter as a case about one party's attempt to "censor" content on another's website, it did not appreciate the affect its decision will have on the law governing how trademarks may be used online. The BPLA views this case as one about maintaining the usability of the Internet. The law does not, and should not, allow a third party to use the goodwill earned by another to divert consumers, either directly or indirectly, to its website. This is and should be the case regardless of whether that party competes with the trademark holder or has a purely political or non-profit motive. The Superior Court's ruling, however, threatens orderly use of the Internet by allowing or encouraging parties to hijack trademarks to trick Internet users into visiting their sites. (pp. 5-10)

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<sup>1</sup> No party, its counsel, or any third party authored, funded, or otherwise contributed any part of this brief.



The analogy often employed to describe the result of search engine optimization (i.e., the use of keywords, Google AdWords, and metatags) is that such optimization recreates in the online realm the brick and mortar experience of walking down an aisle in a store and seeing several different brands of competing products next to each other on a shelf. If one party used packaging that caused consumers to mistake the product for a competitor's product—at least until the consumer picked up the product and examined it more closely—there would be no doubt that such activity would be infringing. If it were otherwise, a consumer might have to take several products off the shelf and examine them at the supermarket before finding the desired brand. Courts have confirmed that activity causing such confusion, often referred to as "initial interest confusion," is infringing, not only as to competing goods but also as to non-competing goods and non-commercial goods that use the goodwill of another to attract consumers' attention. This result is equally true online. If parties are allowed to litter search results with links and advertisements that purport to be affiliated with a well-known brand in a confusingly similar fashion, the usability of the

Internet would be significantly impaired and the value of the intellectual property associated with that goodwill would be significantly reduced. (pp. 11-22)

The Lanham Act prohibits consumer confusion even when such confusion is used to draw attention to a political message. Allowing a party, even a party with no commercial motive, to use a trademark to trigger confusing links and advertisements would seriously curtail the usability of the Internet and chip away at the value of that trademark. It is immaterial that consumers would not be confused once they landed on the webpages that confusing links resolved to if they were tricked into clicking on the links in the first place. (pp. 22-27)

The mechanism for a nominative fair use of a trademark already provides some basis for trademarks to be used without running afoul of the law. There is no reason not to apply these standards to search engine optimization ploys that trigger confusing website descriptions and title tags in online search results. To this end, a party should be able to use no more of a trademark than is necessary to refer to the trademark's holder and should not be able to use a mark in a way that implies affiliation with or any

connection to that mark holder. Permitting trickery to draw in viewers has no apparent value, and can only cause harm to a brand and frustration to Internet users. (pp. 27-31)

## ARGUMENT

### I. IMPROPER SEARCH ENGINE OPTIMIZATION CAN CONSTITUTE TRADEMARK INFRINGEMENT

A review of the relevant cases from the past decade teaches that courts have broken cases of online trademark infringement into a myriad of pieces. While this case involves manipulation of search engine results rather than purchased keywords, we can look to these cases for some guidance. Unlike links triggered by the purchase of AdWords, however, which are visually separated in the results and labeled as sponsored links, the present case involves manipulation of the system so that the link to the target website blends directly into the mix of the organic search results.

Some courts have focused on whether the Google AdWords program is *per se* trademark infringement. Other courts have addressed whether the use of a trademark as a keyword, AdWord, or metatag is a "use" for the purposes of trademark infringement. The

Second Circuit recently issued a well-regarded opinion holding that the sale of a trademark as an AdWord was at least a "use" for the purposes of the Lanham Act. *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 131 (2d Cir. 2009); accord, *Network Automation, Inc. v. Advanced Systems Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011) (agreeing with the Second Circuit's decision in *Rescuecom*); *Fair Isaac Corp. v. Experian Information Solutions Inc.*, 645 F. Supp. 2d 734, 761 (D. Minn. 2009) (citing the Second Circuit's approach favorably). The BPLA agrees with the vast majority of courts that the use of a trademark as an AdWord, keyword, or metatag is "use" and can be – but is not *per se* – actionable. The more reasoned approach is to focus on the effect of such use by proceeding with a likelihood of confusion analysis.

Two early cases clearly illustrate the BPLA's point. In 1999, the Ninth Circuit found that there was a likelihood of success as to a claim alleging likelihood of confusion after a defendant purchased metatags that caused its site to appear prominently in search results for the plaintiff's trademark. See *Brookfield Communications, Inc. v. West Coast Corp.*, 174 F.3d 1036 (9th Cir. 1999). The court stated that

"[i]n the Internet context, . . . entering a web site takes little effort—usually one click from a linked site or a search engine's list; thus, Web surfers are more likely to be confused as to the ownership of a web site than traditional patrons of a brick-and-mortar store would be of a store's ownership." *Id.* at 1057. Five years later, the Ninth Circuit narrowed this holding by limiting this type of infringement to instances in which the advertisements triggered by the purchase of a trademark as a keyword were unlabeled, and thus potentially confusing. *Playboy Enterprises, Inc. v. Netscape*, 354 F.3d 1020, 1026 (9th Cir. 2004). The BPLA views this narrow holding as the correct approach. Had the banner ads that were triggered by the keyword purchases in that case been labeled in a manner that obviated a likelihood of confusion, the Ninth Circuit may have allowed them. The BPLA sees nothing intrinsically wrong with the use of a trademark in search engine optimization, so long as such use does not trick the end user into clicking on a link expecting different content. Thus, the inquiry turns on the specific facts of each case—facts that the Superior Court refused even to consider.

During the past decade, many courts have agreed with the BPLA's point of view. In 2005, the Eastern District of Virginia found that a plaintiff had not shown sufficient evidence of a likelihood of confusion in the use of Sponsored Links that did not reference the marks purchased as AdWords in the text of the links displayed in the search results. See *Government Employees Insurance Co. v. Google, Inc.*, 2005 WL 1903128, \*7 (E.D. Va. 2005). One year later, the Northern District of Illinois granted relief not because plaintiff's trademarks had been purchased as AdWords, but rather because the plaintiff "established through affidavits and attached materials that defendants are using terms trademarked by [plaintiff] as search terms in Google's AdWords program in a manner likely to cause confusion." *International Profit Assocs. v. Paisola*, 461 F. Supp. 2d 672, 676-77 (N.D. Ill. 2006) (emphasis added). The District of Utah similarly reasoned that "the mere purchase of a trademark as a keyword cannot alone result in consumer confusion. Accordingly, the relevant inquiry here regarding consumer confusion is not just what keyword was purchased, but what was the language of the advertisement generated by that keyword." 1-800

*Contacts, Inc. v. Lens.com, Inc.*, 755 F. Supp.2d 1151, 1174 (D. Utah 2010). A District Court in Minnesota confronting the issue held that "the question of likelihood of confusion turns on the particular circumstances surrounding the manner in which the allegedly infringing website is presented to the consumer." *Fair Isaac*, 645 F. Supp. 2d at 761.

The constant in the above cases is that all of these courts recognize that there is a potential for confusion when a party uses another's trademark for search engine optimization, through the use of a trademark as a keyword, AdWord, metatag, or otherwise. The BPLA cautions the Court against the sort of overly broad holding issued by the Eastern District of Pennsylvania in 2005, when the court found that no reasonable trier of fact could find a likelihood of confusion because the search results were in the separately displayed section for advertisements. See *J.G. Wentworth, S.S.C. Ltd. Partnership v. Settlement Funding LLC*, 2007 WL 30115, \*8 (E.D. Pa. 2007). Such an unnecessarily blunt approach is particularly dangerous in the likelihood of confusion context, because "[c]ourts have recognized that 'the likelihood of confusion' is a fact-specific inquiry best left for

decision after discovery." *Morningware, Inc. v. Hearthware Home Prods., Inc.*, 673 F. Supp. 2d 630, 636 (N.D. Ill. 2009) citing *Vulcan Golf, LLC v. Google Inc.*, 552 F. Supp.2d 752, 769 (N.D. Ill. 2008). Applying the Eastern District of Pennsylvania's standard in the brick and mortar setting would mean allowing products to be labeled in a confusing manner simply because they are on different shelves.

Even more concerning, however, is the situation presented in this case. By having a link positioned to appear as part of the viewer's search results as Long Bow's was, the products in the above analogy would be next to each other on the same shelf in the same packaging and could only be distinguished after removing each box from the shelf and inspecting it. The Superior Court's ruling in this case can be read almost as a free pass for such labeling and threatens the ability of future trademark holders to protect themselves and consumers from such a situation. To be sure, there are cases where the manner in which advertisements and links are displayed in search results creates a likelihood of confusion. At the very least, this fact-specific inquiry should be conducted by a trier of fact.



II. A LINK THAT DISPLAYS ANOTHER'S TRADEMARK AS  
A TITLE TAG WITH AMBIGUOUS DESCRIPTIVE  
LANGUAGE CAUSES INITIAL INTEREST CONFUSION  
REGARDLESS OF A SITE'S CONTENT

Likelihood of confusion, which is the *sine qua non* of trademark infringement, will almost always result when search engine optimization is used to prominently display a link to one party's website in response to a search based on another party's trademark, especially when ambiguous title tags or poorly labeled text describes the search result link or the displayed advertisement. See *Binder v. Disability Group, Inc.*, 772 F. Supp. 2d 1172 (C.D. Cal. 2011) (finding a likelihood of confusion after the defendant purchased the plaintiff's trademark as an AdWord causing its website to appear in the Sponsored Links portion of the Google Search results for plaintiff's trademark); *CJ Products LLC v. Snuggly Plushez LLC*, 2011 WL 3667750 (E.D.N.Y. 2011) (granting a motion to enjoin the defendant from using Plaintiff's trademarks in Google's AdWords program); *Morningware*, 673 F. Supp. 2d at 633 (finding that plaintiff had alleged sufficient facts to establish the potential for confusion after defendant bought plaintiff's trademark as an AdWord but did not sell

plaintiff's products); *Hysiton Inc. v. MTS Systems Corp.*, 2008 WL 3161969 (D. Minn. 2008) (denying summary judgment for defendant because there was an issue as to likelihood of confusion after defendant purchased plaintiff's trademark as an AdWord).

The important rights protected by these cases are threatened by the Superior Court's refusal to consider the impact of the search engine results in this case, and, in particular, its holding that, as a matter of law, there could be no likelihood of confusion. As new technologies develop, it is imperative that courts allow triers of fact to determine how the relevant consumers interact with those technologies. Only then will relevant consumers have a hand in determining what does and does not confuse them.

**A. EVEN IF CONSUMERS WOULD NOT BE CONFUSED AFTER CLICKING ON A LINK, THE DOCTRINE OF INITIAL INTEREST CONFUSION STILL BARS CONFUSING SEARCH RESULTS**

As trademark law has evolved, particularly in the internet context, initial interest confusion has been invoked in a widening range of scenarios. See e.g., *Hearts on Fire Co. v. Blue Nile, Inc.*, 603 F. Supp. 2d 274, 284 (D. Mass. 2009) citing *Brookfield*, 174 F.3d at 1062. "Initial interest confusion targets one

specific type of pre-sale confusion: It involves confusion at the very earliest stage-not with respect to the source of specific goods or services under consideration, but during the process of searching and canvassing for a particular product." *Hearts*, 603 F. Supp. 2d at 284. Improperly using the goodwill built by one party to divert that party's customers and potential customers away from it triggers initial interest confusion. See *Brookfield*, 174 F.3d 1036; *Dr. Seuss Enterprises, L.P. v. Penguin Books, USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254 (2d Cir. 1987); *Hearts*, 603 F. Supp. 2d 274; *Storus Corp. v. Aroa Marketing, Inc.*, 2008 WL 449835, \*4-7 (N.D. Cal. 2008). The duration of the confusion is unimportant. See *Promatek Industries, Inc. v. Equitrac Corp.*, 300 F.3d 808, 812-13 (7th Cir. 2002).

In *Hearts*, the defendant purchased the plaintiff's trademark to cause sponsored links to the defendant's jewelry site to appear after a search for plaintiff's trademarks. See 603 F. Supp. 2d 274. The defendant was not an authorized reseller of the plaintiff's diamonds or jewelry, and did not sell any of plaintiff's products. *Id.* The court denied a

motion to dismiss the trademark infringement claim, noting that misuse of search engine optimization can result in trademark infringement:

To be sure, the sponsored links appearing on a search-results page will not always be a menu of readily distinguished alternatives. With the intense competition for internet users' attention and mouse-clicks, online merchants may well be tempted to blur these distinctions, hoping to create and capitalize on initial interest confusion. Such conduct undoubtedly begins to sound in trademark infringement.

*Id.* at 286. After applying the eight factors that the First Circuit has identified as being what a court should look to when determining whether a trademark use is likely to confuse an appreciable number of consumers, the court stated that "the likelihood of confusion will ultimately turn on what the consumer saw on the screen and reasonably believed, given the context." *Id.* at 289. The court held that plaintiff had sufficiently alleged infringement even though the sponsored links did not contain the trademark because nothing in the links indicated that they were not affiliated with plaintiff. *Id.* at 288.

Likewise, in *Storus*, the court granted summary judgment for a plaintiff as to its claim of trademark

infringement after the defendant purchased plaintiff's trademark as an AdWord even though the defendant's URL was plainly visible in the resulting link and advertisement before a consumer clicked on it. 2008 WL 449835 at \*4-7. The link shown in response to a search for the plaintiff's trademark displayed a title tag comprised entirely of the trademark. *Id.*

In *Promatek*, the Seventh Circuit found that the defendant's use of the plaintiff's trademark as a metatag would trick consumers looking for the plaintiff's website and divert them to the defendant's. 300 F.3d at 812. Although consumers might immediately recognize that they were not at the plaintiff's website after having clicked on the links in question, the court still found actionable infringement, stating "[t]hat consumers who are misled to [defendant's] website are only briefly confused is of little or no consequence." *Id.* at 813.

In this case, Long Bow appears to have done exactly what the court in *Hearts* feared; blurring the lines between search engine optimization that results in the presentation of non-confusing links and search engine optimization that results in deceptive links that trick consumers. There is no opportunity for the

viewer to know that the content of the Long Bow site is something other than Jenzabar goods or services. Even parody, which can take the form of social commentary, gives the user an immediate chance to recognize the difference in source. The link that appeared among the highest-ranked results and directed users to Long Bow's website featured Jenzabar's trademark as the title tag and included no language that would lead a consumer to believe that the linked to site was not affiliated with Jenzabar. As the Northern District of California did in *Storus*, this court should recognize that conduct of this nature alone could be enough to create a likelihood of confusion. Allowing parties like Long Bow to optimize its position in searches for another party's trademark and then adopt questionable links and accompanying text that appear in response to an online search for a plaintiff's trademark could transform search results into a guessing game that would make the internet frustrating and time-consuming to use.

Moreover, if extrapolated to an extreme, permitting wholesale use of trademarks to draw in unsuspecting viewers could eventually cost a markholder equal footing in its use of the internet

for business as potential consumers associate the trademark with unpredictable or useless search results. The defendant in *Storus* used a title tag comprised entirely of the plaintiff's trademark. In *Storus*, the court found an actionable likelihood of confusion despite the fact that the defendant's URL was clearly visible below the title tag. In this case, the four official Jenzabar links that surround Long Bow's link each display a completely different URL, which increases the chances that a consumer would believe that Long Bow's link is an official Jenzabar link. As noted in *Hearts*, the use of another's trademark for search engine optimization such as in metatags or as a keyword for online search results, if used in a non-confusing manner, presents a consumer with a menu of choices much like a grocery store aisle that groups competing brands together on the shelf. If, however, the use of a trademark as a keyword triggers confusing advertisements and links, the menu or grocery store aisle analogy collapses. A menu is useless if it consists of the same or confusingly similar items repeated again and again. Likewise, consumers would not shop at a grocery store that contained aisles of identical boxes with entirely

different contents. Adding to consumer search costs runs directly counter to the goal of trademark law and diminishes the value of trademarks in general.

The frustration of the internet user can be imagined in a parallel situation involving email. While spam email takes many forms, "spoofing" is when the name of the "sender" is replaced with a different party. Fortunately, filters and other technologies allow for the substantial reduction of spoofed emails. Such technology is not readily available to filter spoofed links from search results. If spoofing were freely permitted and even encouraged, email inboxes would be overwhelmed with messages from "close friends," but real and fake would be indistinguishable. Spoofing Google search results would have a more significant impact since the user has requested the results based on the searched term. Turning back to the email parallel, that would be like expecting to receive an email from a close friend, but then simultaneously receiving dozens of emails that appear to be from that friend but are not.



**B. USING A TRADEMARK TO TRIGGER CONFUSING  
LINKS AND ADVERTISEMENTS IS  
INFRINGEMENT EVEN ABSENT DIRECT  
COMPETITION OR A COMMERCIAL MOTIVE**

Competition between the parties is not a prerequisite for relief. See *Mobil Oil*, 818 F.2d at 257-58; *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 103 (D. Mass. 1998). "Confusion, or the likelihood of confusion, not competition, is the real test of trademark infringement." *Mobil*, 818 F.2d at 257-58; accord, *Dr. Seuss*, 109 F.3d at 1404. It is also not necessary that the defendant have a profit motive. See *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 289 (S.D.N.Y. 2006).

In *Dr. Seuss*, the Ninth Circuit considered a book about the O. J. Simpson trial that made significant use of plaintiff's trademarks to mimic the style of the plaintiff's *Cat in the Hat* book. See 109 F.3d 1394. The court found that "the use of the Cat's stove-pipe hat or the confusingly similar title to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may still be an infringement." *Id.* at 1405.

In *Mobil Oil*, the defendant operated as the Pegasus Petroleum Corp. in the oil trading business. 818 F.2d 254. The court found that, although the plaintiff did not use the trademark at issue in the oil trading business, infringement could still be found in the absence of direct competition. *Id.* at 258. The court affirmed the district court's finding of infringement largely because parties involved in the oil trading business would agree to speak to the defendant only because they initially thought that the defendant was affiliated with the plaintiff even though such confusion would be quickly resolved after any contact with the defendant. *Id.*

In *SMJ*, a non-profit organization working to improve the situation of New York City's restaurant workers stood outside the plaintiff's restaurant and handed out flyers containing a political message that prominently featured the plaintiff's trademark. 439 F.Supp. at 285-86. The Southern District of New York stated "[d]efendants seek to educate the public, an admirable service, but an individual being educated should not be misled about the source of that education, just as an individual purchasing a can of peas should not be misled about the source of those

peas." *Id.* at 287 (citation omitted). Discussing previous cases that defendant used to argue that initial interest confusion must include the diversion of a plaintiff's consumers for financial gain, the court stated that those cases "simply reflect the unsurprising fact that the typical trademark infringement case involves commercial competitors. The Lanham Act, however, does not only apply to typical cases." *Id.* at 289. The court found that although there was no competition between the parties and the defendant had no commercial agenda, the fact that a person handed one of defendant's flyers would be initially confused as to its origin was "sufficient to trigger the protection of the Lanham Act." *Id.* at 290.

In *Dr. Seuss* and *Mobil Oil*, the courts recognized that initial interest confusion may still be found even when the parties' goods are non-competitive. In this case, even if the court believes that Jenzabar's educational software is not related to Long Bow's educational films, it should recognize that initial interest confusion will still affect consumers searching the internet. In *SMJ*, the Southern District of New York recognized that even use of a plaintiff's

trademark to grab a consumer's attention in order to deliver a political message is actionable under the Lanham Act. In this case, although Long Bow claims it is delivering a political message, it is making a much more commercial use of Jenzabar's trademark than the defendants in *SMJ*. There, the defendant had no commercial motivation. Here, a brief review of the Long Bow website to which Jenzabar's consumers are diverted shows that Long Bow's website features links to purchase its educational films, which are its core products. Even if Long Bow's website was purely non-commercial, which it is not, the court could still find initial interest confusion in this case. While the BPLA is not taking a position on whether confusion is likely here, it does view Long Bow's actions as a possible basis for such a finding and worthy of being sent to a trier of fact.

**III. NOMINATIVE FAIR USE SHOWS WHAT TYPE OF USE IS ALLOWED, AND IT DOES NOT SHIELD LONG BOW'S USE OF JENZABAR**

The doctrine of nominative fair use allows a party to make a use of a trademark when (1) the product or service in question cannot be easily identified without use of the trademark; (2) only so much of the mark is used as is reasonably necessary to

identify the product or service; and (3) the party using the trademark does nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). "When [a trademark] is used in a way that does not deceive the public we see no such sanctity in the word as to prevent it being used to tell the truth." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924); see also *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968). The question of whether a party using another's trademark adequately distinguishes itself from the trademark owner is one of fact, and each case must be decided on its own facts. *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969) (citation omitted).

In *New Kids*, a newspaper ran a poll that asked its readers to vote on their favorite member of the popular boy band, New Kids on the Block. See 971 F.2d 302. The Ninth Circuit found that nominative fair use allowed such use of the mark, largely because the newspaper used only as much of the mark as needed to reference the boy band, there was no other readily available way to reference the band, and the newspaper

did nothing that suggested that the band sponsored or endorsed the poll. *Id.* at 308.

In *Prestonettes*, the defendant purchased the plaintiff's goods and sold them in smaller quantities by repackaging them. See 264 U.S. 359. The smaller packages were labeled with "Prestonettes, Inc., not connected with Coty, states that the contents are Coty's [giving the name of the article] independently rebottled in New York." *Id.* at 366. All of the lettering was the same size and font. *Id.* The Supreme Court noted that had COTY been larger than the other wording, or had it been in a distinctive font, the casual consumer might have assumed that Coty had sponsored or endorsed the product so such use would have infringed on the Coty's mark. *Id.* at 368-69. The Court determined that the phrase, used on the outside of the product, was sufficient to avoid deceiving the public. *Id.* at 368.

When an auto repair shop advertised that it serviced Volkswagens, without using stylized script or the Volkswagen logo but instead the word "Volkswagen" in conjunction with the word "independent," the court found that, in the context of an auto repair shop, no consumers would be misled into believing that the

plaintiff had sponsored or endorsed the shop. *Volkswagenwerk*, 411 F.2d 350.

Finally, in *Smith*, the Ninth Circuit allowed a maker of generic perfumes to refer to Chanel #5 to describe one of its own fragrances that was designed to mimic the Chanel scent. 402 F.2d at 569. The advertisement at issue read "[w]e dare you to try to detect any difference between Chanel #5 (25.00) and Ta'Ron's 2nd Chance. \$7.00." *Id.* at 563. Because the "appellants' advertisements make it clear that the product they offer is their own," the court found no likelihood of confusion. *Id.* at 569.

In all of these cases, the most important factor is the third element necessary for nominative fair use to protect a defendant, namely, that the defendant did nothing to imply a connection with the trademark holder. In fact, these defendants went out of their way to dispel any possible confusion. If the appellant in *Prestonettes* had featured COTY, even by presenting it in a larger font than the surrounding text in a clear disclaimer, the Supreme Court seemingly would have barred the practice. Here, Long Bow used search engine optimization to make its link appear among the very first search results for

JENZABAR. Further, the link displayed in those search results featured a heading comprised entirely of JENZABAR with no clarification or disclaimer of any kind. Moreover, the language beneath this heading did nothing to dispel a belief that Jenzabar sponsored or endorsed the linked-to site. Presented with such a display, consumers could assume that the site was connected to Jenzabar. Just as the owner of the auto repair shop in *Volkswagenwerk* was allowed to use the plaintiffs mark to advertise his services only because the owner always included the work "independent" next to the mark and never used the plaintiff's distinctive lettering or logos, Long Bow should be allowed to use JENZABAR to advertise its documentary, but not when it uses only JENZABAR and ambiguous language in its search results link that does not disclaim an affiliation with the company. The defendant in *Volkswagenwerk* would have been prevented from using VOLKSWAGEN on its own. Likewise, in *Smith*, the court allowed the appellant to use CHANEL #5 only because it did so in a manner that was not likely to confuse consumers. In this case, Long Bow's use of JENZABAR includes no disclaimers or words that might mitigate consumer confusion. For this reason, nominative fair



use does not insulate Long Bow from an infringement claim. The doctrine of nominative fair use is well established and readily available to Long Bow and any other party wishing to advertise in a non-confusing manner, but it does not protect a party that uses another's goodwill to trick consumers into granting their attention, however briefly. At a minimum, the internet user deserves the opportunity to distinguish an official site from a cloaked diversion.

**IV. THE FIRST AMENDMENT PROVIDES NO DEFENSE IN THIS CASE**

Although this issue is not on appeal, the BPLA expects that Long Bow may argue that its actions should be shielded by the First Amendment by pointing to cases involving cybersquatting and free speech. See *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005). As a preliminary matter, cybersquatting involves the registration of a domain name that is confusingly similar to a trademark and so is only indirectly related to the use of a trademark in search engine optimization to trigger search results containing confusingly similar links. See *Id.* at 311; *Coca-Cola v. Purdy*, 382 F.3d 774, 778 (8th Cir. 2004).

In *Lamparello*, the court found that there was no likelihood of confusion as to source when a plaintiff registered a domain name that was a misspelling of the plaintiff's name because the website to which the domain resolved was clearly not affiliated with the plaintiff and the defendant made no commercial use of the site. 420 F.3d at 314-315. In *Purdy*, however, the Eighth Circuit affirmed an injunction preventing the defendant from registering domain names that incorporated the plaintiff's trademarks and directing those domain names to *abortionismurder.com*, which contained a political message. 382 F.3d at 779.

The BPLA believes that this Court should not follow *Lamparello* for two important reasons. *Lamparello* involved a case of alleged cybersquatting wherein the only way a consumer would be confused is if a domain name was misspelled. There would be no intervening page of search results having the potential to trick consumers. The BPLA believes that domain names are less relevant now than they may have been in the early days of the internet because users only infrequently type in exact domain names as though they were dialing a phone number and instead use search engines for the lion's share of browsing on the

internet. Because of the case's focus on domain names, it makes sweeping requirements that "court[s] must look not only to the allegedly infringing domain name, but also at the underlying content of the website." *Id.* at 318. Such an approach would leave infringers free to cause any amount of confusion in search results so long as they address that confusion on the linked website. This bright line requirement should therefore be rejected.

Second, the BPLA feels that *Lamparello's* suggestion that there must be some "financial gain" shown to apply the initial interest confusion doctrine is misguided. As the *SMJ* court explained:

The Lanham Act seeks to protect the public from "confusion of any kind," and the effect on the public is no different whether one party is profiting from its use of the other's mark or whether the parties are in competition with each other. If the public is confused, the harm the Act seeks to prevent has occurred.

*SMJ*, 439 F. Supp. 2d at 290. The *Lamparello* court found that there was no commercial use of the subject mark. Had the defendant there sold expensive educational films for his own profit at the site in question, the Fourth Circuit likely would have decided

the case differently. Here, Long Bow sells its films, which are its core products, on the website that its confusing link resolved to. Even if there had been no commercial use here, however, trademarks cannot be left defenseless in search results. The First Amendment should not allow a bad actor to trick consumers simply by claiming that it is spreading a political message.

More fundamentally, the BPLA feels that there is already an appropriate balance between protecting trademarks and free speech. If a trademark is used simply to identify the subject of the speaker's criticism or comment, there is no trademark violation. The problem lies where a party uses a trademark in such a way as to blur the line between the speaker identification and the message. "The First Amendment protects an individual's right to speak out against a markholder, but it does not permit an individual to suggest that the markholder is the one speaking." *SMJ* at 291. As the Eighth Circuit said in *Purdy*, "While [the defendant] has the right to express his message over the Internet, he has not shown that the First Amendment protects his appropriation of plaintiff's marks in order to spread his protest message by

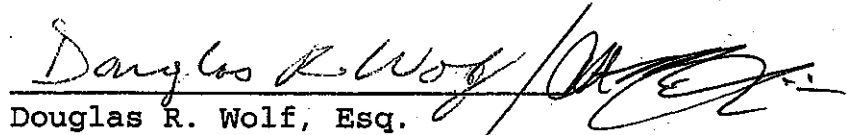
confusing internet users into thinking that they are entering one of plaintiff's websites." 382 F.3d at 787-88 (citing 4 McCarthy § 25.76). Confusion "pre-click" is still confusion, and should not be condoned or protected in a blanket fashion.

#### CONCLUSION

Even if Long Bow's website is characterized as completely political and non-commercial, the doctrine of initial interest confusion may still prohibit it from using Jenzabar's trademarks in its search engine optimization to trigger a link or advertisement that prominently features JENZABAR and does not contain any language indicating that the link is not affiliated with or sponsored by Jenzabar. This is true even in the absence of competition or a profit motive on the part of the defendant because the harm that trademark law seeks to prevent is harm to the consumer. Allowing parties to use trademarks to confuse and divert consumers on the internet would drastically decrease the ease with which the average consumer could navigate through search results. Because a likelihood of confusion analysis is highly fact-specific and our interactions with new media are

rapidly developing, such analyses should rarely be dispensed with on summary judgment.

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PURSUANT TO MASS. R. A. P. 16(k)**

I, Christina M. Licursi, hereby certify that this brief complies with the rules of court that pertain to the filing of briefs, including but not limited to: Mass. R. A. P. 16(a)(6) (pertinent findings or memorandum of decision); Mass. R. A. P. 16(f) (reproduction of statutes, rules, and regulations); Mass. R. A. P. 16(h) (lengths of briefs); Mass. R. A. P. 18 (appendix to the briefs); and Mass. R. A. P. 20 (form of briefs, appendices, and other papers).

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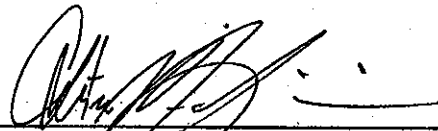
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