

COMMONWEALTH OF MASSACHUSETTS
APPEALS COURT

SUFFOLK, SS.

A.C. No. 2011-P-1533

JENZABAR, INC.,
Plaintiff - Appellant,
v.
LONG BOW GROUP, INC.,
Defendant - Appellee.

ON APPEAL FROM JUDGMENT
OF THE SUPERIOR COURT

BRIEF FOR PLAINTIFF-APPELLANT JENZABAR, INC.

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**RULE 1:21 CORPORATE DISCLOSURE STATEMENT ON POSSIBLE
JUDICIAL CONFLICT OF INTEREST**

Pursuant to Supreme Judicial Court Rule 1:21,
Jenzabar, Inc. hereby states that it has no parent
corporation and that no publicly held company owns 10%
or more of its stock.

Respectfully Submitted,

Dated: Oct. 17, 2011 **JENZABAR, INC.,**

By its attorneys


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ISSUES PRESENTED

1. Whether the Trial Court erred in finding that, as a matter of law, Jenzabar cannot show a likelihood of confusion caused by Long Bow's deceptive uses of the JENZABAR Mark in connection with search engine results.

2. Whether the Trial Court erred by failing to consider the initial interest confusion doctrine.

3. Whether the Trial Court erred in finding that, as a matter of law, Long Bow's conduct was protected by the nominative fair use doctrine.

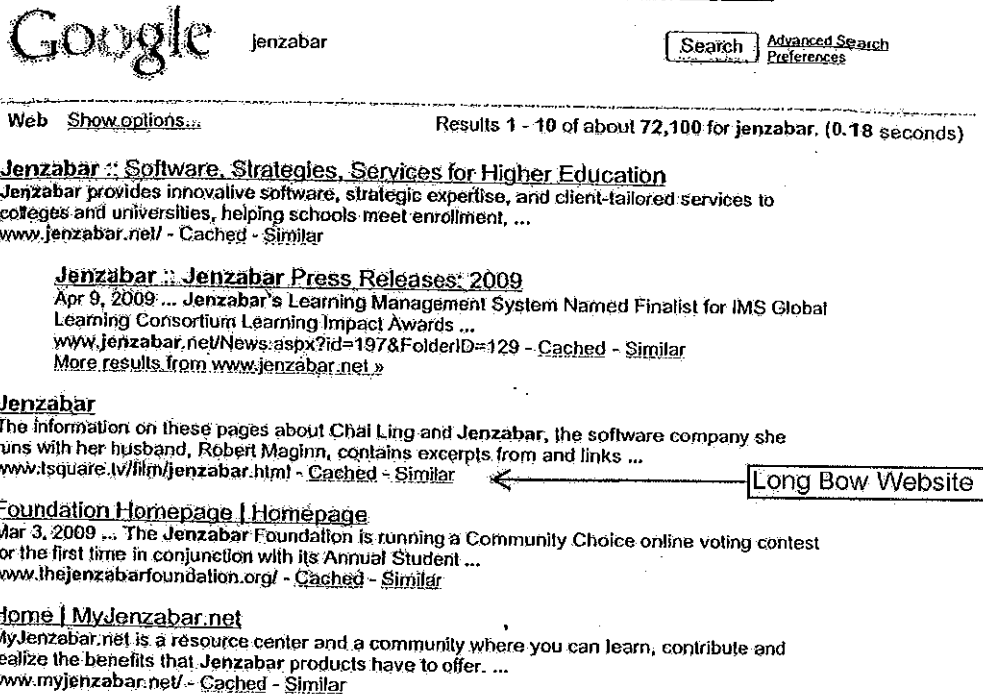
4. Whether the Trial Court erred in dismissing Jenzabar's dilution claim.

5. Whether the Trial Court erred in finding that Jenzabar's Chapter 93A claim could not stand independently without its trademark claims.

STATEMENT OF THE CASE

This case is about whether a company can pretend to be something that it is not in internet search results in order to drive traffic to its website, only revealing its true identity after users have already been duped. The case arises from the unauthorized use by Long Bow Group, Inc. ("Long Bow") of the fanciful trademark JENZABAR in connection with search results on the internet, including in Long Bow's title tag, the description of its website, and metatags and other "optimization" used for its website.

Long Bow deliberately used Jenzabar, Inc.'s ("Jenzabar's") undisputedly strong and distinctive JENZABAR mark to increase web traffic by confusing Internet users who were looking for information about Jenzabar into thinking that the Long Bow site was somehow affiliated with, or approved by, Jenzabar. By way of example, a search on Google for "Jenzabar" in 2009 listed Long Bow's site **second** out of more than 72,000 hits and appeared as follows:



The screenshot shows a Google search interface. The search term "Jenzabar" is entered in the search box. To the right of the search box are links for "Search", "Advanced Search", and "Preferences". Below the search box, it says "Results 1 - 10 of about 72,100 for jenzabar. (0.18 seconds)". The first search result is titled "Jenzabar :: Software, Strategies, Services for Higher Education" and includes a brief description and a link to "www.jenzabar.net/ - Cached - Similar". The second result is titled "Jenzabar :: Jenzabar Press Releases: 2009" and includes a date and a link to "www.jenzabar.net/News.aspx?id=197&FolderID=129 - Cached - Similar". The third result is titled "Jenzabar" and includes a description of the information on the page and a link to "www.tsquare.tv/film/jenzabar.html - Cached - Similar". An arrow points from a box labeled "Long Bow Website" to this link. The fourth result is titled "Foundation Homepage | Homepage" and includes a date and a link to "www.thejenzabarfoundation.org/ - Cached - Similar". The fifth result is titled "Home | MyJenzabar.net" and includes a description and a link to "www.myjenzabar.net/ - Cached - Similar".

Appendix ("App."). at 1044.¹

¹ Long Bow recently changed the text under the "Jenzabar" title, which now reads, "Jenzabar has tried to censor this web page because it carries critical information about the software company that Chai Ling started with her husband." App. at 2710. Long Bow, then, obviously knew how to provide text that makes clear that the subject website is unaffiliated with Jenzabar. They simply chose not to.

With actual Jenzabar-affiliated sites above and below it in search results, Long Bow's website entitled simply "**Jenzabar**," and the misleading words Long Bow chose to describe the information on the website, Long Bow used the JENZABAR mark to create the perfect disguise to allow its website to appear to be related to or endorsed by Jenzabar.

Faced with Long Bow's unauthorized link masquerading among authorized links and causing consumer confusion, including among the parties' overlapping customer base (e.g., colleges and universities), Jenzabar had no choice but to protect its goodwill. As such, on May 14, 2007, Jenzabar, Ling Chai and Robert A. Maginn, Jr. filed a complaint against Long Bow for false designation of origin (15 U.S.C. §§ 1114 and 1125(a)), trademark dilution (15 U.S.C. § 1125(c)), trademark infringement (M.G.L. c. 110B (now c. 110H, §§ 12 and 14)), trademark dilution (M.G.L. c. 110B (now c. 110H, § 13)), unfair and deceptive trade practices (M.G.L. c. 93A, §§ 2 and 11), and common law claims for business defamation, defamation, and trademark infringement.

On August 5, 2008, Judge Nancy Holtz dismissed the business defamation and defamation claims (Counts I and II), but denied Long Bow's motion to dismiss with respect to the trademark claims (Counts III, IV, V, VI, VII) and Chapter 93A claim (Count VIII).

On December 7, 2010, Judge John Cratsley granted Long Bow's motion for summary judgment as to the remaining counts (hereafter, the "Order", attached hereto to the Addendum).

On January 6, 2011, Jenzabar filed its Notice of Appeal. Before this Court now is a question that impacts every company and individual on the internet: Whether it is lawful to confuse and mislead those using search engines by deceptively using a company or individual's very name to falsely imply a connection, and thereby increase the number of visitors to the misappropriator's website. Trademark law, common law, and common sense all answer the same: with a definitive "No."

STATEMENT OF FACTS

Jenzabar and Its Use of the Jenzabar Mark

Founded in 1998, Jenzabar is a Boston-based provider of software and related goods and services to several hundred institutions of higher education worldwide, including the JFK School of Government at Harvard University, Brigham Young University-Idaho, Michigan State University, Louisiana State University, and Colby College. App. at 1009.

Jenzabar's products include web-based enterprise software with student, institutional advancement, human resources, and financial applications; e-learning solutions; and an enterprise information

portal. App. at 1009-10. Jenzabar has also begun to expand into the creation and distribution of educational content (e.g., films). This expansion is the logical extension of Jenzabar's existing services to colleges and universities. App. at 1011-12. Jenzabar has also established the Jenzabar Foundation, which provides millions of dollars of grants to worthy causes. App. at 1010.

"Jenzabar" is a fanciful word that was invented solely for use as Jenzabar's trademark. App. at 1010. Although it is derived from the Chinese symbols for "the class of the best and brightest," it is a phonetic Romanization that has no literal equivalent in either Chinese or English. App. at 1010. The JENZABAR Mark has been used continuously since 1998, and is now widely recognized, particularly in the educational community. App. at 1010. The JENZABAR Mark is registered with the U.S. Patent and Trademark Office ("PTO"), Reg. No. 3108414, as well as in all 27 countries of the European Union, CTM No. 006899546. App. at 1010.

Jenzabar maintains several websites, including JENZABAR.NET, JENZABAR.COM, CHOOSEJENZABAR.NET and MYJENZABAR.NET and has spent millions of dollars since its founding to establish its internet identity and presence. App. at 1011.

Long Bow Misappropriates The JENZABAR Mark To Generate Internet Traffic And Significant Commercial Revenue

Long Bow's stated purpose is "educational media", which includes, according to its tax returns, "documentary films or videos for the use of universities, high schools and public television." App. at 368, 590, 1050-87. More specifically, Long Bow produces and sells educational films and documentary films about Chinese history and culture including "The Gate of Heavenly Peace" concerning the Tiananmen Square Massacre (hereafter, the "Video"). App. at 585, 725.

Long Bow sells the Video and other films to generate revenue, primarily to colleges and universities. App. at 726. Long Bow sells the Video and other films worldwide, through distributors in the United States, Australia, and elsewhere. App. at 582-84. In the United States, Long Bow's distributor sells the Video to colleges and universities for \$295 per copy. App. at 966, 1089. Long Bow's principals also travel and speak at universities to promote sales of their films. App. at 586-87, 724.

These commercial activities generate significant revenue. According to its tax returns, Long Bow's income in 2007 was \$1,241,056. App. at 1067. Richard Gordon, Long Bow's president, testified that its revenue in 2008 was "between \$500,000 and \$1,000,000."

App. at 604. Mr. Gordon sets his own salary; he paid himself \$170,000 in 2008. App. at 604.

Long Bow operates three web sites, including www.tsquare.tv, which it uses to market and sell the Video and other products (the "Website"). App. at 369, 641. The Website includes links to distributors so that visitors can purchase the Video and other products. App. at 966.

Though it sells no Jenzabar products and has absolutely no affiliation with Jenzabar, to generate Internet traffic and sales, Long Bow configured the Website to appear at the top of search engine results for a search of the term "Jenzabar." Jenzabar's expert opined that, to do so, Long Bow engaged in "search engine optimization" techniques using the JENZABAR mark, including through the use of title tags and keyword metatags incorporating multiple iterations of the Jenzabar name. App. at 985-995.² Specifically, Long Bow uses multiple variations of the JENZABAR name and mark in its metatags, including JENZABAR,

² Metatags and title tags are invisible pieces of HTML that are included within the header portion of a web page for the purpose of making it easier for search engines to find the page. App. at 619, 651, 989-90. The World Wide Web Consortium (W3C), the international standards-setting organization for the Web, defines the structure and meaning of HTML. App. at 990. In its standard for HTML 4.01, the W3C states that the purpose of keyword metatags is: to help search engines find and index web pages. App. at 990.

JENZABAR.COM, and JENZABAR.NET, to ensure that its sites are found by search engines and appear at the very top of the results. App. at 384-388, 652, 954-55, 1198-1203.³ As a result, the www.tsquare.tv/film/jenzabar.html page (the "Web Page") on the Website for years has consistently appeared among the very top listings -- on some search engines, the second or third result -- when a user searches for "Jenzabar," "Jenzabar home page," or related terms. App. at 992-93, 1015-16, 1044-48, 1165-66.

This artificially high ranking, however, was just the beginning. During the relevant period, the Long Bow listing among search results for "jenzabar" appeared under a title tag that used the JENZABAR Mark only, and a description of the site that contained no reference to Long Bow, as follows:

³ Tellingly, while Long Bow uses metatags incorporating all variations of the JENZABAR Mark, other page metatags do not include the subjects of, or names identified even more prominently with, those pages. App. at 994, 1015-16. For example, the web page on which Long Bow reprints Li Peng's speech declaring martial law does not contain metatags such as "Li Peng" or "martial law". App. at 1205-16. The pages containing the "June 9 Speech to Martial Law Units" by Deng Xiaoping, the Premier of China, does not include any keyword metatags, not even "Deng" or "Xiaoping". App. at 1171-81.

Jenzabar

The information on these pages about Chai Ling and **Jenzabar**, the software company she runs with her husband, Robert Maginn, contains excerpts from and links ...
tsquare.tv/film/jenzabar.html - Cached - Similar

App. at 1044-48, 1165-66. In short, Long Bow deliberately configured its website's HTML code and metatags so that its listing among search results for "Jenzabar" would appear in this form and at this location. App. at 985-95.⁴

In April 2007, after receiving a cease-and-desist letter from Jenzabar, Long Bow made several modifications to the Website. App. at 374, 380-82. Among those modifications was the addition of a disclaimer on the Website itself, which reads: "These webpages are the sole responsibility of the Long Bow Group, and are in no way affiliated with or sponsored by Jenzabar, Inc." App. at 374, 380-82. Long Bow did not add any such language to its search engine title tag or site description, or even identify itself as the Website's source. Those remained unchanged.

⁴ Jenzabar's expert opined that every search engine uses metatags and title tags to find, index, and rank search results. App. at 992. His opinion was based in part on official statements from Google. App. at 992. Google's official statement, provided by affidavit in response to a court authorized subpoena, states with respect to indexing, "we process information included in key content tags and attributes, such as Title tags". App. at 1019-26. Google explains further that page-based text "can be manipulated by site publishers through meta-tags." App. at 1019-26.

Long Bow's Use of the JENZABAR Mark Caused Confusion

Long Bow's misappropriation worked. As a result of its calculated overuse of the JENZABAR Mark, Long Bow enjoyed substantial hits from those searching for Jenzabar. App. at 993-94. In spite of Long Bow having **no direct connection** to Jenzabar, Long Bow's web host, Aplus.net,⁵ confirmed that "Jenzabar" was one of the **top three** "search strings" that lead internet users to the Website. App. at 1092-99.⁶ Aplus.net records show that during the period from June through August, 2009, individuals associated with over 173 colleges (including at least 28 colleges which are clients of Jenzabar) visited the Website. App. at 993-94, 1014, 1101-07. 1168-69. In fact, Long Bow even used its website and Jenzabar's name as part of an "Appeal" to solicit financial contributions from colleges and universities, further increasing traffic to the Website. App. at 634, 720-21, 1114-52.

⁵ Long Bow's website is hosted by Aplus.net, whose computer servers automatically identify and log the "search strings" -- the terms entered into internet search engines -- that lead internet users to the Website. App. at 641.

⁶ During June, 2009, for instance, out of 2911 search strings generating hits to the Website, "jenzabar" was the third most popular search string. App. at 1092-99.

SUMMARY OF ARGUMENT

Because Long Bow sought summary judgment, it bore the heavy burden of showing that the evidence -- when viewed in the light most favorable to Jenzabar -- is so one-sided that it would not allow a reasonable juror to find for Jenzabar. Ignoring this procedural context, the Trial Court often viewed the evidence in a light favorable to Long Bow, disregarding evidence contradicting Long Bow's arguments and supporting Jenzabar's. The Trial Court committed at least the following errors, each of which independently requires that the Order be reversed:

- the Order disregarded, and failed to discuss, the most important evidence in the case -- Long Bow's use of the JENZABAR Mark as the sole word in its title tag and its use of the JENZABAR Mark in its web page description in a manner that falsely implies an association with Jenzabar in search engine results (see Section I(A), *infra*);
- the Order fails to apply the holdings and reasoning of the leading cases analyzing trademark infringement in the context of the internet, including by failing to apply the initial interest confusion doctrine (see Section I(B), *infra*);
- the Order fails to adhere to the Rule 56 standard for summary judgment and draws inferences against Jenzabar, including when analyzing the elements of confusion for purposes of trademark infringement (see Section I(C), *infra*);
- the Order erroneously concludes that a disclaimer on Long Bow's website obviates any potential confusion (see Section I(D), *infra*);

- the Order misapplies the law regarding the nominative fair use defense (see Section I(E), *infra*);
- the Order contains no substantive analysis of Jenzabar's dilution claim (see Section II, *infra*); and
- the Order holds that Jenzabar's Chapter 93A count fails because it is derivative of its trademark counts -- a holding that is contrary to Massachusetts law and decisions of the Supreme Judicial Court (see Section III, *infra*).

As it has all along, Long Bow will no doubt try to shield its misconduct by claiming it was merely exercising its First Amendment right to criticize, and that this suit is just an attempt to silence Jenzabar's critics. It is not. In criticizing Jenzabar, Long Bow did not have to use the Jenzabar name alone as its title tag, or overload its metatags with the Jenzabar name, or use a misleading description of its website in search results for "jenzabar." But it did. To attract persons who likely would have never otherwise visited Long Bow's website, Long Bow repeatedly misappropriated the JENZABAR Mark, then concealed the actual contents of its website by misleadingly describing it on search results, thereby creating the appearance that the Website was affiliated with Jenzabar. That conduct, creating confusion among internet users, and infringing Jenzabar's trademark rights, has never been protected by the First Amendment. See Section I(F), *infra*.

When the evidence is properly analyzed, there is no basis for summary judgment. The Order must be reversed and this Court should deny Long Bow's motion for summary judgment.

STANDARD OF REVIEW

Review of the Trial Court's grant of summary judgment is *de novo*. See, e.g., *Bank of New York v. Bailey*, 460 Mass. 327, 331 (Mass. 2011). To prevail on summary judgment, Long Bow must show -- with evidence, not just argument -- "that there is no genuine issue as to any material fact." Mass. R. Civ. P. 56(c); *Kourouvacilis v. General Motors Corp.*, 410 Mass. 706, 714 (1991), citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 328 (1986). On a motion for summary judgment, all reasonable inferences must be drawn in favor of the non-moving party (here, Jenzabar), regardless of who bears the ultimate burden of proof. See *Foster Group Health Inc. v. Empire Blue Cross Blue Shield*, 444 Mass. 668, 672 (2005).

ARGUMENT

I. THE TRIAL COURT ERRED IN FINDING THAT, AS A MATTER OF LAW, JENZABAR CANNOT SHOW A LIKELIHOOD OF CONFUSION

To succeed on its trademark infringement claims, Jenzabar must show (1) that it owns a valid mark, (2) that Long Bow has used the JENZABAR Mark or a similar mark in commerce, and (3) that Long Bow's use of the JENZABAR Mark is likely to cause confusion. See

Hasbro Inc. v. Clue Computing, Inc., 66 F. Supp. 2d 117, 121 (D. Mass. 1999) (citations omitted).

Implicitly acknowledging that there is no dispute that Jenzabar owns the JENZABAR Mark or that Long Bow is using the JENZABAR Mark in commerce, the Trial Court's analysis of Jenzabar's trademark infringement claims is limited solely to analyzing whether Jenzabar can show a likelihood of confusion. See Order at 4-9.

To determine whether there is a likelihood of confusion, a fact finder must consider the following eight factors: (1) the similarity of the marks; (2) the similarity of the goods or services; (3) the relationship between the parties' channel of trade; (4) the relationship between the parties advertising; (5) the classes of prospective purchasers; (6) evidence of actual confusion; (7) the defendant's intent in adopting the mark; and (8) the strength of the plaintiff's mark. See *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) (citations omitted). The eight factors are not mechanically toted up, see *id.*, and all doubts are to be resolved in favor of the senior trademark holder. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F. 2d 669, 674 (Fed. Cir. 1984).

The Trial Court's analysis of the *Pignons* factors contains numerous errors, including ignoring critical

evidence, disregarding initial interest confusion, and construing evidence in the light most favorable to Long Bow as the moving party, each of which independently requires that the Order be reversed.

- A. **The Trial Court ignored critical evidence -- Long's Bow use of the JENZABAR Mark as the sole word in its title tag and in its search engine description.**

The most important evidence in determining whether consumers would be confused by Long Bow's link in search engine results is, obviously, the title tag and description in the link itself. Despite the centrality of that evidence, the search results are **not once** mentioned or analyzed anywhere in the Order. Indeed, the Order skips right past it, stating that this dispute is "**over content**" on the Website. Order at 1.² While the Trial Court acknowledges that "Long Bow's site comes up on a list of hits when someone uses a search engine to search for information about Jenzabar" (Order, pp. 2-3), the Trial Court never mentions, let alone discusses, the legal consequences of how and where the title tag and description appear in such a search.

This omission constitutes reversible error. Long Bow's confusing and deceptive title tag and description in search results for "jenzabar," is

² All emphasis has been added unless otherwise noted.

critical to the analysis of Jenzabar's claims. Indeed, when that evidence is factored in, Long Bow plainly fostered actionable confusion among internet users.

B. The Trial Court erred in failing to consider the initial interest confusion doctrine.

The Trial Court should have applied the well-established⁸ doctrine of initial interest confusion to assess Long Bow's use of the JENZABAR mark. "Initial interest confusion occurs when the defendant uses the plaintiff's trademark in a manner calculated to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion." *Interstellar Starship Services, Ltd. V. Epix, Inc.*, 304 F.3d 936, 941 (9th Cir. 2002) (internal quotation and citation omitted).⁹ As

⁸ As Professor McCarthy has said, "[m]ost courts now recognize the initial interest confusion theory as a form of likelihood of confusion which can trigger a finding of infringement." McCarthy on Trademarks & Unfair Competition at §23:6.

⁹ See also *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998) ("Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is fully completed as a result of the confusion."); *Dr. Seuss Enters., L.P. v Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) ("The use of . . . 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."); *Forum Corp. of North Am. v. Forum, Ltd.*, 903 F.2d 434, 442 n. 2 (7th Cir. 1990) ("The fact that confusion as to the source of a product or

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recently stated by the Massachusetts federal court, "There is no question that this type of confusion falls squarely within the scope of trademark violations contemplated by the Lanham Act." *Hearts On Fire Co. v. Blue Nile, Inc.*, 603 F. Supp. 2d 274, 283 (D. Mass. 2009).

Initial interest confusion is particularly important in the internet context. "[U]nder the 'initial interest confusion' theory of trademark liability, 'source confusion' need not occur; rather, in the internet context, the wrongful act is the defendant's use of the plaintiff's mark to 'divert' consumers to a website that 'consumers know' is not [plaintiff's] website." *Storus Corp. v. Aroa Marketing, Inc.*, No. 06 Civ. 2454, 2008 WL 449835, *4 (N.D. Cal. Feb. 15, 2008).¹⁰

It is settled law that initial interest confusion can occur where, as here, a defendant includes a plaintiff's mark in "metatags" found on the

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service is eventually dispelled does not eliminate the trademark infringement which has already occurred.").

¹⁰ See also *Australian Gold, Inc. v. Hatfield*, 436 F.3d 1228, 1239 (10th Cir. 2006) ("Initial interest confusion in the internet context derives from the unauthorized use of trademarks to divert internet traffic, thereby capitalizing on a trademark holder's goodwill."); *Soilworks, LLC v. Midwest Industrial Supply, Inc.*, 575 F. Supp. 2d 1118, 1130 (D. Az. 2008).

defendant's website, thereby causing consumers who enter the plaintiff's mark into a search engine to select defendant's website from a list of search results that includes the defendant's website. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 1058, 1065 (9th Cir. 1999) ("Lanham Act bars [defendant] from including in its metatags any term confusingly similar with [plaintiff's] mark"). "Although there is no source confusion in the sense that consumers know they are patronizing [defendant] rather than [plaintiff], there is nevertheless initial interest confusion in the sense that, **by using [plaintiff's mark] to divert people looking for [plaintiff's product] to its web site, [defendant] improperly benefits from the goodwill that [plaintiff] developed in its mark.**" *Id.* at 1062.

Massachusetts courts have not hesitated to find infringement based on similar conduct. Notably, in the seminal *Brookfield* decision, the Ninth Circuit cited with approval a decision from the District of Massachusetts, *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104 (D. Mass. 1998), where the plaintiff "learned, by chance, that RMD's web sites and the means of attracting internet users to the sites were deceptive and misleading." Defendant had implanted Niton's mark into "keywords"

and "source code" for its website, such that a search of "Niton's home page" resulted in hits instead that gave the web address of RMD's web site. *Id.* at 104. Judge Keeton granted Niton injunctive relief -- even though the parties were "not in direct competition." *Id.* at 103.

In a more recent case from Massachusetts, *Hearts On Fire*, defendants were accused of using the plaintiff's trademark both where the trademark was used (i) just as a metatag and (ii) where it "appeared alongside Defendant's sponsored link." 603 F. Supp. 2d at 277-78. The defendant moved to dismiss certain allegations concerning the former, but **did not even "challenge[]** the allegation that the sponsored link's display of the **exact trademarked phrase** as part of the accompanying advertisement, **if proved, would amount to a trademark violation.**" *Id.* at 280.

Long Bow's conduct created actionable initial internet confusion. The title tag and the description of that website created the appearance that Jenzabar sponsored or approved the Web Page. It was only **after** the consumer visited Long Bow's website that s/he was told that it was not approved by Jenzabar.

Notably, the Trial Court recognized that consumers may be initially confused, but nevertheless held -- without analysis or support -- that "this initial uncertainty does not qualify as confusion and

is an inevitable part of web searching." Order at p. 11. The Trial Court is wrong. The proper analysis is to imagine a consumer who has searched for "Jenzabar" in a search engine, then freeze the moment in time when s/he is about to click on Long Bow's link. If at that moment there is a likelihood that the consumer believes the link is sponsored or authorized by Jenzabar, the unauthorized use of the trademark has gone too far and Jenzabar has a viable claim for infringement for that **pre-click confusion**.

Though not an internet case, *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281 (S.D.N.Y. 2006) provides a particularly apt analogy. There, the cover of pamphlets distributed outside of plaintiff's restaurant by a non-profit group seeking to improve conditions for restaurant workers depicted plaintiff's trademarked logo and the text "SPECIAL FOR YOU." Upon opening the pamphlet, however, the pamphlet asked, "DO YOU REALLY WANT TO EAT HERE?" next to text critical of plaintiff's restaurant. It was undisputed that "**as soon as** the individual opens the leaflet and reads the message inside, the individual will **immediately realize**, based on the critical nature of the message that the leaflet is not in fact associated with plaintiffs." *Id.* at 288. The court nonetheless found that plaintiff was likely to succeed on its trademark infringement claim.

Defendants' use of plaintiffs' marks causes confusion, and therefore falls within the scope of the Lanham Act. **Despite defendants' lack of profit motivation, or the lack of competition between the parties, an individual who is handed one of defendants' pamphlets is, at least initially, confused about the source of the pamphlet.** Under the doctrine of initial interest confusion, **that confusion is sufficient to trigger the protection of the Lanham Act.**

Id. at 290.

The same is true here. Long Bow undoubtedly used the goodwill in the JENZABAR Mark to divert customers to the Web Page. As the Trial Court noted at the summary judgment hearing, the link and metatag description "don't tell the source" (App. at 2297) and as such, a consumer has to actually go to the website and "burrow down underneath that language to find out" the source (App. at 2305). It is not relevant that confusion could be dispelled **after** the key moment that a user clicks on a deceptive search result that has been designed to look authentic or approved by Jenzabar. By then the damage is done. See *Promatek Industries, Inc. v. Equitrac Corp.*, 300 F. 3d 808, 812-813 (7th Cir. 2002) ("**What is important is not the duration of the confusion, it is the misappropriation of Promatek's goodwill. Equitrac cannot unring the bell.**").

The Trial Court's failure to properly apply *Brookfield*, *Hearts on Fire*, and numerous other cases

establishing that using another's trademark to disguise the source of its website thereby diverting internet traffic constitutes infringement in and of itself, resulted in the wrong outcome on summary judgment. It therefore constitutes reversible error.

C. The Trial Court erred in its analysis of the confusion factors.

On top of ignoring the initial interest confusion caused by Long Bow's use of the JENZABAR Mark in its title tag, website description, and metatags, the Trial Court committed several errors in its analysis of the likelihood of confusion factors. Most notably, the Order repeatedly draws inferences **against** Jenzabar (the non-movant) and makes findings in favor of Long Bow (the movant) on disputed issues of fact, turning the well-worn summary judgment standard of requiring all inferences to run in favor of the non-movant on its head. See, e.g., *Pederson v. Time, Inc.*, 404 Mass. 14, 17 (1989).

A determination of likelihood of confusion is a fact-intensive inquiry that should "**rarely**" be decided on summary judgment. See, e.g., *Neles-Jamesbury, Inc. v. Valve Dynamics*, 974 F. Supp. 964, 971 (S.D. Tex. 1997) ("except in rare circumstances, likelihood of confusion should not be determined on a motion for summary judgment"). Appeals courts routinely overturn summary judgment decisions where the trial court erred

in properly considering the confusion factors. See, e.g., *Beacon Mutual Ins. v. OneBeacon Ins. Gr.*, 376 F.3d 8 (1st Cir. 2004); *Fortune Dynamic v. Victoria's Secret*, 618 F.3d 1025, 1044 (9th Cir. 2010); *Board of Regents of the University of Wisconsin System v. Phoenix International Software, Inc.*, -- F.3d --, 2011 WL 3436879, *6 (7th Cir. Aug. 5, 2011).

Here, the Trial Court's analysis of nearly every confusion factor was flawed. When the factors are properly considered, each one either favors Jenzabar, or at worst, involves disputed issues of fact, rendering a motion for summary judgment untenable.

1. The "internet trinity" factors show that confusion is likely.

"[T]he three most important factors in the context of the Internet are the similarity of the marks, the relatedness of the goods, and the use of the Internet as a marketing channel." *Soilworks, LLC*, 575 F. Supp. 2d at 1130-31. "Consequently, where the 'factors of the internet trilogy' weigh against the defendant, a finding of likelihood of confusion is proper unless the defendant shows the remaining [confusion] factors 'weigh strongly against a likelihood of confusion.'" *Storus Corp.*, 2008 WL 449835 at *3. See also *GoTo.Com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (Fed. Cir. 2002) (holding where "marks are similar, [the parties] offer similar

services, and [the parties] both use the web as their marketing channel," confusion is "indeed likely").

a. **Similarity of the Marks**

The mark repeatedly used by Long Bow and Jenzabar's fanciful trademark are identical. It is undisputed that Long Bow uses the exact same mark -- "Jenzabar" -- as the sole word in its title tag and in its website description. It is also undisputed that Long Bow uses multiple variations of the JENZABAR name and mark, including JENZABAR, JENZABAR.COM, and JENZABAR.NET, in its metatags to ensure that a link to the Website appears at the very top of the results for searches of the word "Jenzabar."

Given Long Bow's use of the identical mark, the Trial Court should have found that this factor strongly favored a finding of likelihood of confusion. Incredibly, it did just the opposite, concluding that the "total effect of the two marks does not create a likelihood of confusion." Order at p. 5.¹¹

The Trial Court's conclusion is dead wrong. Long Bow's uses of the identical JENZABAR Mark strongly favors a finding of confusion. Indeed, courts have

¹¹ Such reasoning is flawed and reversible error in and of itself. The question of likelihood of confusion is the ultimate question to be answered **after** each factor is considered. When considering "similarity of the marks," the Trial Court simply must answer whether the parties use the same or similar mark.

held that the use of identical marks alone often creates triable issues of fact. See *Board of Regents of the University of Wisconsin System*, 2011 WL 3436879 at *6 ("While more than the same mark is needed to show confusion, . . . the presence of such identity often creates triable issues of fact regarding the various ways a product is marketed.").

Given that the Trial Court did not properly analyze the similarity of the marks (*i.e.*, the most important confusion factor), the entire analysis is flawed and must be reversed.

b. Similarity of Goods and Services

It is undisputed that both Jenzabar and Long Bow sell education-related products to colleges and universities. More specifically, Jenzabar sells education-related software, and Long Bow produces and sells educational films. The Trial Court acknowledged that a prospective Jenzabar customer "might be distracted by Jenzabar's mark" as used by Long Bow, but nevertheless concluded that "as a matter of law" there is "no similarity of goods and services." Order at p. 6. To do so, the Trial Court relied on the fact that "[u]sers who arrive at Long Bow's Site . . . immediately see a disclaimer." *Id.* This analysis once again erroneously ignores the initial interest confusion already caused by the point in time the disclaimer is seen (discussed *supra*).

Even beyond improperly relying on a disclaimer, the Trial Court's analysis of similarity of goods and services is flawed. The parties' goods need not be identical to be similar enough to create confusion. The goods need only be related enough that consumers might assume a common source for the goods. See *Yale Electronics Corp. v. Robertson*, 26 F. 2d 972, 974 (2d Cir. 1928) (finding infringement of a trademark for locks by a manufacturer of flashlights; "unless the borrower's use is so foreign to the owner's as to insure against any identification of the two, it is unlawful").¹² Notably, numerous courts have found infringement where the goods were non-competing. See, e.g., *Hallmark Cards, Inc. v. Hallmark Dodge, Inc.*, 634 F. Supp. 990 (W.D. Mo. 1986) (greeting cards/automobile dealer); *K2 Corp. v. Philip Morris, Inc.*, 555 F. 2d 815 (3rd Cir. 1977) (skis/filter cigarettes).

Here, the goods are related in that both parties focus on sales to higher education. The evidence indicates that the same purchasers at academic

¹² See *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 522 (S.D.N.Y. 2009) ("Selling different services or targeting a different market does not disprove likelihood of confusion, because the concern is not direct diversion of purchasers but indirect harm through loss of goodwill or tarnishment of reputation.") (quotation omitted).

institutions are responsible for purchasing decisions for both academic software and videos (since administrators, faculty, professors and librarians are often involved in the decision to purchase Jenzabar's products). App. at 1012-13. Moreover, Jenzabar has begun to expand its products to include the creation and distribution of educational content, such as films. App. at 1012. As such, at a minimum, there is a factual dispute as to the degree to which the respective goods and services are related.

c. Similarity of Channels of Trade

It is undisputed that both Jenzabar and Long Bow sell their goods and services through the internet. Despite the obvious overlap in marketing channels, the Trial Court twists the actual standard by finding that there was not a sufficient overlap to support a finding of confusion because "neither Jenzabar nor Long Bow **exclusively** use the web as their marketing channel." Order at p. 6. No court has required marketing channels to completely overlap to support a finding of a likelihood of confusion. Indeed, the confusion factor specifically considers the **similarity** of marketing channels; not the **identity** of marketing channels.

Under the correct analysis, an overlap of marketing channels indisputably exists. Where, as here, the internet is used by both parties, that alone

weighs in favor of finding a likelihood of confusion. See, e.g., *Soilworks, LLC*, 575 F. Supp. 2d at 1131 (finding that marketing channels overlap because both parties "use the Internet to market their products."); *Finance Express LLC v. Nowcom Corp.*, 564 F. Supp. 2d 1160, 1175 (C.D. Cal. 2008) (plaintiff and defendant "are engaged in the simultaneous use of the internet as a marketing channel, 'a factor that courts have consistently recognized as exacerbating the likelihood of confusion.'"). As explained by the Ninth Circuit in *GoTo.com*:

With respect to the Internet, even services that are **not** identical are capable of confusing the public . . . the use of remarkably similar trademarks on different websites creates a likelihood of confusion amongst Web users . . . We now reiterate that ***the Web, as a marketing channel, is particularly susceptible to a likelihood of confusion*** since, as it did in this case, it allows for competing marks to be encountered at the same time, on the same screen.

202 F.3d at 1206-1207. The Order improperly eschews the established standard, and ignores the overlap in marketing channels. The use of the internet by both Jenzabar and Long Bow favors finding a likelihood of confusion.

* * *

In sum, at least two of the internet trinity factors (similarity of the marks and similarity of trade channels) outright support a finding of a likelihood of confusion, and one factor (similarity of

goods or services) at least raises disputed issues of fact that should be considered by a jury. Thus, unless the other factors "**weigh strongly against**" finding a likelihood of confusion, the Trial Court's analysis must be found to be erroneous as a matter of law and the Order must be reversed. As detailed below, just the opposite is true.

2. The other confusion factors confirm that confusion is likely.

a. The Strength of Jenzabar's Mark

As even the Trial Court acknowledged, there is sufficient evidence to show that the JENZABAR mark is strong and distinctive mark. It is undisputed that "Jenzabar" is a fanciful word that was invented by Jenzabar. The inherent strength of the JENZABAR Mark is enhanced by Jenzabar's continuous use of the mark since 1998, trademark registrations in the United States and all 27 countries of the European Community, and widespread recognition in the relevant industry.

While admitting to this evidence, the Trial Court still misconstrued the law, holding that "[Jenzabar] cannot prove as a matter of law that [strength of the mark] is a sufficiently prevailing factor to defeat summary judgment" (*i.e.*, to defeat the conclusion the Trial Court had already reached that there was no likelihood of confusion). Order at 9.

This reasoning was erroneous. A proper analysis would have concluded that strength of the mark was yet another factor favoring a finding of a likelihood of confusion.

b. Overlap in Prospective Purchasers

It is undisputed that both parties sell their goods and services to the same classes of purchasers, namely, colleges and universities. The Trial Court even recognized this fact:

The evidence in the discovery indicates that at times different purchasers within the same academic institutions make the purchasing decisions for both Jenzabar's academic software and Long Bow's documentaries. ***Therefore it is possible that at times that the prospective purchasers overlap.***

Order at p. 7, n.3. Violating the well-worn requirement that the evidence must be construed in the light most favorable to the non-movant (*i.e.*, Jenzabar), however, the Trial Court then held that "as a matter of law the prospective purchasers between Jenzabar and Long Bow do not sufficiently overlap."

Order at p. 7.

A proper analysis would have concluded that overlap in prospective purchasers favors a finding of a likelihood of confusion, or at a minimum, that factual issues exist concerning the overlap in prospective purchasers.

c. Long Bow's Intent in Adopting the JENZABAR Mark.

The Order's analysis of "defendant's intent in adopting the mark" is particularly distorted. Initially, the Order notes that **a plaintiff** is not required to prove intent to show confusion -- that is correct. The Order goes on, however, to find that even if Jenzabar had evidence of an intent to deceive it would be irrelevant "since proof of intent is not required for my evaluation." Order, p. 8. The Trial Court thus determined that it "need inquire no further into Long Bow's intent." *Id.* That is incorrect. See, e.g., *Brookfield Communications*, 174 F.3d at 1059; *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 287 (6th Cir. 1997) ("The presence of intent can constitute **strong** evidence of confusion.").

In fact, this factor either affirmatively weighs in favor of finding a likelihood of confusion, or at least raises triable issues of fact. Jenzabar offered substantial evidence of Long Bow's intent. Specifically, Long Bow has deliberately used the JENZABAR Mark in the title tag, website description, metatags,¹³ and other metadata to make its web pages

¹³ The Trial Court's statement in footnote 1 of its Order that "modern search engines make little if any use of metatags", completely ignores evidence produced by Jenzabar to the contrary, including the affidavits

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appear more prominently to internet users searching for information about Jenzabar and in a manner that creates an impression of affiliation or connection with Jenzabar.

This is persuasive evidence of Long Bow's "intent" -- but the Order never discusses these undisputed facts. For the Order to deem this evidence "irrelevant" and ignore it was clear error. In view of the evidence, this factor favors Jenzabar, or at a minimum, it creates disputed issues of fact.

d. Evidence of Actual Confusion

Evidence concerning a leap in the number of Jenzabar customers and potential customers accessing Long Bow's page at a minimum created a factual dispute as to actual confusion. As a result of its calculated use of the JENZABAR Mark, Long Bow enjoyed a substantial increase in web traffic to the Website. According to the records maintained by Long Bow's web host, Aplus.net, even though Long Bow has no formal connection to Jenzabar, "Jenzabar" is one of the **top**

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of search engine optimization expert Frank Farance (including the experiment he conducted), and statements made on Google's own website that it considers title tags. Moreover, the Trial Court's statement begs the question: if metatags are supposedly irrelevant, why does Long Bow use every variation of the JENZABAR Mark (e.g., Jenzabar, jenzabar.com, Jenzabar.net) in its metatags?

three "search strings" that leads internet users to the Website.¹⁴ From June through August, 2009, individuals associated with over 173 colleges (including at least 28 colleges which are clients of Jenzabar) visited the Jenzabar-related pages on the Website. App. at 993-94, 1014, 1101-07, 1168-69.

Court's have found this type of data to be relevant and persuasive evidence of actual confusion. For example, in *Storus Corp.*, "on 1,374 occasions, consumers who were searching for a website by using Storus' mark were, in fact, 'diverted' to an Aroa website" over 11 month period. *Storus Corp.*, 2008 WL 449835, at *5. As detailed above, the figures regarding "diversion" by Long Bow of internet traffic searching "jenzabar" to Long Bow's website posing as "**Jenzabar**" is even more alarming.

Viewed in the light most favorable to Jenzabar as the non-movant, this evidence tips this factor in favor of finding a likelihood of confusion, or at a minimum raises triable issues of fact as to the degree of actual confusion caused by Long Bow.

¹⁴ Aplus.net's servers automatically identify and log the "search strings" -- the terms entered into Internet search engines -- that lead internet users to the Website. App. at 641. During the month of June, 2009, for instance, out of 2911 search strings generating hits to the Website, "jenzabar" was the third most popular search string. App. at 1092-99.

* * *

Taken separately or together, the Trial Court's findings concerning the confusion factors erroneously ignore issues of material fact, thereby paving the way to a holding that was wholly inconsistent with what a reasonable jury may find. Each and every one of the confusion factors either favors finding a likelihood of confusion or raises genuine disputed issues of fact. As such, the Order should be reversed, and when the evidence is considered *de novo*, Long Bow's Motion for Summary Judgment should be denied. At a bare minimum, the matter should be remanded for a trial because a reasonable juror could be confused by the appearance of Long Bow's listing on Google search results and could believe Long Bow's site was related to or endorsed by Jenzabar. See, e.g., *Fortune Dynamic*, 618 F.3d at 1044 ("This case should go to trial. A jury could reasonably conclude that the majority of the *Sleekcraft* [likelihood of confusion] factors favors Fortune.").

D. Long Bow's use of a disclaimer does not cure initial interest confusion or otherwise preclude finding a likelihood of confusion.

On multiple occasions, the Order improperly relies on the existence of a disclaimer on the Web Page as conclusive evidence that there can be no trademark confusion. The Order cites no law to

support its position,¹⁵ which in fact is fatally flawed, factually and legally.

As a matter of law, a disclaimer is not a blanket defense against trademark infringement. See, e.g., *Planned Parenthood Federation of America, Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, *12 (S.D.N.Y. March 24, 1997), *aff'd*, 152 F. 3d 920 (2d Cir. 1998), *cert. denied* 525 U. S. 834 (1998) (disclaimer not a sufficient remedy to prevent confusion resulting from website name); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000) (rejecting disclaimer as defense to infringement claim); *Australian Gold, Inc.*, 436 F.3d at 1243 (same).

More fundamentally, the Trial Court's reliance on a disclaimer appearing on the Web Page itself simply ignores the fact that Long Bow placed **no** disclaimer in the title tag or search engine listing -- which, in and of themselves, cause sufficient deception and confusion to constitute infringement. See, e.g., *Brookfield*, 174 F.3d at 1066. This renders a later

¹⁵ The court relies on the disclaimer as grounds for its rulings that, *inter alia*, the marks are not similar ("Long Bow does not claim to be sponsored or endorsed by Jenzabar, and this is made clear to web users by a disclaimer at the top of the page."; p. 5), and the goods and services are not similar ("Users who arrive at Long Bow's Site, via a search for a Jenzabar related site, would immediately see a disclaimer at the top of the page."; p. 6).

disclaimer irrelevant.

Precedent from the SJC concurs. In *Planned Parenthood v. Problem Pregnancy*, 398 Mass. 480 (1986), the SJC found infringement where consumers learned they were not actually at Planned Parenthood only **after** defendant lured them to its competing office by masquerading as the plaintiff:

"In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. The public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement." . . . The danger here is the fact that the two organizations, located on the same floor of the same building, operate for diametrically opposing purposes and that PP, Inc. confused the public into believing that its services were endorsed by PPLM.

Id. at 489 (citations omitted).

Just as in *Planned Parenthood*, Long Bow cannot hide from liability based on the use of a disclaimer which is visible only **after** internet users have already been tricked into entering the Long Bow website. The Order's repeated reliance upon a disclaimer on the underlying website as an absolute defense constitutes multiple reversible errors.

E. The Trial Court erred in its application of the nominative fair use defense

Given Long Bow's excessive emphasis and overuse of the JENZABAR Mark, alone or coupled with its confusing description, the Order's finding that Long

Bow had borne its burden of proof to show nominative fair use as a matter of law is improper. The recent decision in *Toyota v. Tabari*, 610 F.3d 1171 (9th Cir. 2010) explains:

In cases where a nominative fair use defense is raised, we ask whether (1) the product was "readily identifiable" without use of the mark; (2) defendant **used more of the mark than necessary**; or (3) defendant **falsely suggested he was sponsored or endorsed** by the trademark holder. *Welles*, 279 F.3d at 801 (quoting *New Kids*, 971 F.2d at 308-09). This test "evaluates the likelihood of confusion in nominative use cases." *Id.* It's designed to address the risk that nominative use of the mark will inspire a mistaken belief on the part of consumers that the speaker is sponsored or endorsed by the trademark holder. The third factor speaks directly to the risk of such confusion, and the others do so indirectly: **Consumers may reasonably infer sponsorship or endorsement if a company uses an unnecessary trademark or "more" of a mark than necessary.**

Id. at 1175-76.

Here, the Trial Court concluded that "[a]s long as **the site as a whole** does not suggest sponsorship or endorsement by the trademark holder, momentary uncertainty by web searchers does not preclude a finding of nominative fair use." Order at p. 10. This analysis completely ignores the excessive use of the JENZABAR Mark in the title tag, misleading website description, and stuffed metatags, thereby ignoring the confusion already caused by Long Bow's use of the JENZABAR Mark before a website disclaimer is ever even seen.

Such analysis is reversibly myopic. See *Tdata Inc. v. Aircraft Technical Publishers*, 411 F. Supp. 2d 901 (S.D. Ohio 2006). In *Tdata*, Tdata used ATP's mark as a metatag **and** in its title tag. The court found that such use could "only serve to bring to Tdata's website potential customers, some of whom might never have gone there but for use of ATP's mark." *Id.* at 907. The Court therefore rejected Tdata's nominative fair use defense, holding that "use of [ATP's] mark **in metatags** constitutes infringing use of the mark to pull consumers to Tdata's website and the products it features, **even if the consumers later realize the confusion.**" *Id.*¹⁶

The same is true here. Long Bow fails the nominative fair use test because (i) Long Bow intentionally overuses Jenzabar's mark -- in the title tag and keywords (*i.e.*, JENZABAR, JENZABAR.COM, JENZABAR.NET), and (ii) as discussed above, Long Bow's site description is both written and titled in such a manner ("Jenzabar") to falsely suggest that it is

¹⁶ The Court's analysis applied to both metatags and title tags. As the court explained, "[t]he parties also argue over the use of 'ATP' as a title tag, which 'is text that is used as the title of a web page in the listings of a crawler-based search engine.' . . . For ease of discussion, the Court shall simply focus on the term metatag, understanding that a title tag can also attract web surfers." *Id.* at 904, n.4 (citation omitted).

related to or endorsed by Jenzabar.¹⁷ As such, Long Bow fails two of the three prongs of the nominative fair use test. The Trial Court's conclusion that it was so protected was therefore clear error.

F. The First Amendment Does Not Insulate Long Bow From Liability Under The Lanham Act

The First Amendment is not a defense against Lanham Act claims that arise from the unauthorized "use" of a trademark "in commerce." *United We Stand America, Inc. v. United We Stand America New York, Inc.*, 128 F. 3d 86, 92-93 (2d. Cir. 1997) (quoting Lanham Act, July 5, 1946, ch. 540, § 32, reprinted in 1946 U.S.C.C.A.N. 412, 421).¹⁸

Lanham Act claims, in turn, are not limited to profit-making activity. See *United We Stand America, Inc.*, 128 F. 3d at 92-93; accord *Planned Parenthood*

¹⁷ If the product or service is considered to be the Video, then Long Bow undoubtedly used the mark more than needed, as the Video does not even mention Jenzabar. If the product or service is considered the Web Page itself, Long Bow still used the mark more than needed, as Long Bow uses the JENZABAR Mark as the **only** word in the title tag.

¹⁸ See *Yankee Publishing, Inc. v. News America Publishing, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992) ("**Free speech rights do not extend to labeling or advertising products in a manner that conflicts with the trademark rights of others.**"); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 286-287 n.1 (D.N.J. 1998) (concluding that defendant's use of plaintiff's organization's service mark in defendant's domain names critical of plaintiff did not implicate rights guaranteed by First Amendment), *aff'd*, 159 F. 3d 1351 (3rd Cir. 1998).

Federation of America, Inc., 1997 WL 133313 at * 4 ("Notwithstanding its jurisdictional 'in commerce' requirement, Section 1114 contains no commercial activity requirement."). The statute has thus been applied to defendants allegedly furnishing a wide variety of non-commercial public and civic benefits.¹⁹ Indeed, the Lanham Act has been applied over First Amendment objections to prevent trademark infringement even in the context of purely political speech. See *United We Stand America, Inc.*, 128 F. 3d at 93 (appropriation of another's mark, even if for political expression, "is not protected by the First Amendment"); accord *Planned Parenthood Federation of America, Inc.*, 1997 WL 133313 at * 4 (finding trademark infringement by anti-abortion advocacy website).²⁰

¹⁹ See, e.g., *Kappa Sigma Fraternity v. Kappa Sigma Gamma Fraternity*, 654 F. Supp. 1095, 1101 (D.N.H. 1987) (membership in collegiate Greek-letter fraternity and solicitation of alumni contributions); *American Diabetes Ass'n, Inc. v. Nat'l Diabetes Ass'n*, 533 F. Supp. 16, 20 (E.D. Pa. 1981) (solicitation of donations), *aff'd*, 681 F.2d 804 (3d Cir.1982); *United States Jaycees v. Philadelphia Jaycees*, 490 F. Supp. 688, 691 (E.D. Pa. 1980) (public service projects), *rev'd on other grounds*, 639 F.2d 134 (3d Cir. 1981).

²⁰ To the extent that Long Bow claims that its website is "noncommercial", Long Bow is mistaken. The evidence establishes that Long Bow is a substantial commercial enterprise, generating annual revenues in excess of one million dollars, including from the sale of the Video and other products. App. at 1050-87. Long Bow uses the JENZABAR Mark to generate traffic to its site, to drive sales of goods with links to

(Footnote Continued on Next Page.)

Ultimately, the First Amendment merely confers "a measure of protection for the unauthorized use of trademarks when that use is a part of the expression of a communicative message." *Yankee Publishing, Inc.*, 809 F. Supp. at 275. That protection ends, however, when the unauthorized user goes past expression about the markholder to using the mark in a way that suggests the markholder somehow approved or sponsored the speech. "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 Group, Inc.*, 439 F. Supp. 2d at 291.

Coca-Cola Co. v. Purdy, 382 F.3d 774 (8th Cir. 2004), is instructive. There, the defendant began registering Internet domain names²¹ which incorporated well-known trademarks, including <mycooca-cola.com>, <mymcdonalds.com>, <mypepsi.org>, and <my-

(Footnote Continued from Previous Page.)

distributors of its videos and films, and to solicit contributions. See *Soilworks, LLC*, 575 F. Supp. 2d at 1129 (use of plaintiff's mark in metatags constitutes "commercial use" for purposes of the Lanham Act because "[defendant] capitalizes on [plaintiff's] trademark to attract clients to its websites").

²¹ Given the increased reliance on search engines to find content, choosing a title tag and link description that so blatantly relies on someone else's trademark rather than your own is the modern and more effective equivalent of the old trick of using another's trademark in a deceptively vague domain name.

washingtonpost.com>. The defendant then linked the domain names to the website <abortionismurder.com>, which contains anti-abortion commentary and graphic images of aborted and dismembered fetuses. *Id.* at 779.

There is little doubt that a consumer looking for a soft drink or a Happy Meal and finding graphic images of aborted fetuses would have no confusion as to whether they were at an authorized website. Nevertheless, the district court found defendant's conduct actionable as an effort to "profit by tarnishing and diluting plaintiffs' trademarks *and by relying on their good names and goodwill to achieve the personal gain of promoting their messages, generating publicity, and raising money for supported causes.*" *Id.* at 783.

In a holding that strongly resonates here, the Eighth Circuit affirmed, rejecting Purdy's argument that his misappropriation was protected by the First Amendment. *Id.* at 787-88. "While Purdy has the right to express his message over the Internet, *he has not shown that the First Amendment protects his appropriation of plaintiffs' marks in order to spread his protest message by confusing Internet users into thinking that they are entering one of the plaintiffs'*

websites." *Id.*²² See also *People for Ethical Treatment of Animals v. 2Doughney [PETA]*, 263 F.3d 359, 366-67 (4th Cir. 2001) (finding <peta.org> confusingly similar to PETA's mark even though the attached "People Eating Tasty Animals" website was a **clear parody**, because "an internet user would not realize that they were not on an official PETA web site **until after they had used PETA's Mark to access the web page**").

In short, pretending to be one thing and then "unveiling" yourself after users click a link is not protected by the First Amendment. Here, Long Bow does exactly that; it uses the JENZABAR Mark in the title tag, site description, and metatags, thereby using the goodwill in the JENZABAR Mark to lure consumers to a website they think is connected to Jenzabar. That has never been protected conduct. See, e.g., *SMJ Group*, 439 F. Supp. 2d at 291 ("Irrespective of the content of defendants' leaflets, defendants are using plaintiffs' marks on the cover of the leaflets to indicate that plaintiffs are the source of the leaflets. **'This is precisely the use that is reserved**

²² The court also rejected Purdy's argument that his site was non-commercial. *Id.* at 786 ("Even after Purdy attached the domain names to his own critical commentary sites, he continued to provide links to sites that **solicit funds for the antiabortion movement and sell merchandise.**").

by the Lanham Act to the owner of the mark. . . . It is not protected by the First Amendment.'"); *OBH, Inc.*, 86 F. Supp. 2d at 197 (rejecting defendant's First Amendment defense where "defendants chose to use plaintiffs' mark as their domain name in order to deceive internet users into believing that they were accessing plaintiffs' web site").

In view of the evidence and case law, Long Bow cannot establish that the First Amendment would insulate it from liability in this action for intentionally and deceptively posing as "**Jenzabar**" on search engine results, to generate controversy and increased sales.

II. THE TRIAL COURT ERRED IN DISMISSING JENZABAR'S DILUTION CLAIM

The Trial Court should not have dismissed Jenzabar's state law dilution claim. The Trial Court brushed off the claim, concluding that "Jenzabar is relying on this [dilution] claim solely because of its difficulty in advancing the necessary evidence to defeat summary judgment on their trademark infringement claim." Order at p. 9. The sole reason given for this conclusion is that "Jenzabar dropped their trademark dilution under federal law claim before the summary judgment hearing on October 7, 2010." *Id.*

The Trial Court's analysis is flawed on many levels. To start, in dropping the federal law dilution claim, Jenzabar did what it was supposed to do -- make a responsible tactical decision, emphasize its most effective claims, and simplify the issues in the case. There is no basis in law or fact for the Trial Court to apply a negative inference concerning Jenzabar's state law dilution claim because it chose not to pursue its federal law dilution claim. See, e.g., *New York Stock Exch., Inc. v. Gahary*, No. 00 Civ. 5764 (RLC), 2003 WL 68038, at *2 (S.D.N.Y. Jan. 8, 2003) (voluntary dismissal on the eve of trial was held to be a "legitimate tactical decision").

Moreover, simply ignored by the Order is that a state law dilution claim under Massachusetts law is substantially different than a dilution claim under federal law. See *Moseley v. Secret Catalogue, Inc.*, 537 U.S. 418, 429-31 (2003) (noting that several state dilution statutes, including the Massachusetts statute, require a lower threshold ("likelihood of dilution") than the Federal statute ("actual dilution")).

Dismissal was improper. Jenzabar can show dilution under Massachusetts law by demonstrating that its mark is distinctive and that defendant's use of a

similar mark has created a likelihood of dilution.²³ See *Monteiro Elec. V. Monteiro Indus.*, No. 082061, 2008 WL 4926496, *3 (Mass. Super. Oct. 17, 2008) ("[T]he legislature of this Commonwealth has determined as a matter of law that the likelihood of dilution of a registered mark is sufficient justification for issuance of an injunction in support of a registered mark, **even in the absence of competition between the parties or confusion as to the source of goods or services.**").

The Trial Court's failure to conduct **any** substantive analysis -- instead summarily dismissing the count as a "fallback" claim -- constitutes reversible error. Just as factual issues exists concerning likelihood of confusion, factual issues also exist concerning likelihood of dilution. See *Pinehurst, Inc. v. Wick*, 256 F. Supp. 2d 424, 431 (M.D.N.C. 2003) (finding dilution where defendant used plaintiff's name and mark in website domain name described as 'free speech forum', thereby "reducing plaintiff's control over its unique association with

²³ Such likelihood of dilution can result from (i) injury to the value of a mark caused by actual or potential confusion, (ii) diminution in the uniqueness and individuality of a mark, or (iii) injury resulting from use of a mark in a manner that tarnishes or appropriates the goodwill and reputation associated with plaintiff's mark. *Black Dog Tavern Co., Inc. v. Hall*, 823 F. Supp. 48, 59 (D. Mass. 1983).

its service marks"); see also *Toyota*, 610 F.3d at 1179, n.7.

III. THE TRIAL COURT ERRED IN FINDING THAT JENZABAR'S CHAPTER 93A CLAIM COULD NOT STAND INDEPENDENTLY WITHOUT ITS TRADEMARK CLAIMS

Flying in the face of the very *raison d'etre* of M.G.L. Chapter 93A (to say nothing of SJC precedent), the Order improperly dismissed the Chapter 93A count on the grounds that it cannot constitute an independent cause of action. See Order at 12 ("Long Bow's conduct does not violate c. 93A because Jenzabar has failed to allege any facts or evidence in the summary judgment record **to support a trademark claim.**"). The Supreme Judicial Court disagrees:

This court has underscored the broad impact of c. 93A as creating "**new substantive rights**" and providing relief which is "in addition to, and not an alternative to, traditional tort . . . remedies." *Linthicum v. Archambault*, 379 Mass. 381, 383, 398 N.E.2d 482 (1979), and cases cited. Consequently, while it is clear that common law actions for fraud and deceit are within the contemplation of an "unfair act" under the statute, **it is equally well established that the definition of the term under c. 93A goes far beyond the scope of these common law actions.** See *Slaney v. Westwood Auto Inc.*, 366 Mass. 688, 703, 322 N.E.2d 768 (1975).

Datacomm Interface v. Computerworld, Inc., 396 Mass. 760, 778 (1986).

Contrary to the Trial Court's finding, there is simply no requirement that Jenzabar must be successful under its trademark claims to sustain a claim under

Chapter 93A. Again, Chapter 93A was conceived to address those deceptive and unfair trade practices²⁴ that may not fall neatly within already existing claims under contract or tort law, including trademarks. See *Doliner v. Brown*, 21 Mass. App. Ct. 692, 697 (1986) ("[i]t is recognized that the language is broad enough to take in some reprehensible acts committed in business contexts that **elude conventional definitions** and categories."); *Keller v. Silverbranch Constr. Corp.*, 376 Mass. 621, 626 (1978) ("The statutory language is **not dependent on traditional tort or contract law concepts** for its definition.").

Jenzabar's claim easily clears the Chapter 93A hurdle. First and foremost, because Jenzabar has stated a cause of action for trademark infringement, see *supra*, its Chapter 93A claim must also survive. See, e.g., *R.J. Toomey Co. v. Toomey*, 683 F. Supp. 873, 879 (D. Mass. 1988) (finding violation of 93A where there is a violation of the Lanham Act).

Even if Long Bow's conduct did not offend Jenzabar's trademark rights, however, it still "could reasonably be found to have caused a person to act

²⁴ The determination as to whether conduct is unfair or deceptive for purposes of 93A liability, in turn, is best discerned "from the circumstances of each case." See *Kattar v. Demoulas*, 433 Mass. 1, 13-14 (2000) (quoting *Commonwealth v. DeCotis*, 366 Mass. 234, 242 (1974)).

differently from the way he [or she] otherwise would have acted," and was therefore "deceptive" in violation of Chapter 93A. *Aspinall v. Philip Morris Co.*, 422 Mass. 381, 394 (2004). Long Bow intentionally manipulated search results to ensure its link appeared among authorized Jenzabar links in search results for "jenzabar" and then used a deceptive and misleading title tag and site description to divert internet traffic. The most obvious effect of Long Bow usurping and trading on Jenzabar's goodwill in that manner was to deceive internet users into acting differently, thus falling squarely within the type of conduct proscribed by Chapter 93A. See *Leardi v. Brown*, 394 Mass. 151, 156 (Mass. 1995) (conduct is actionably deceptive if it possesses "a tendency to deceive"). The Order dismissed this count in error.

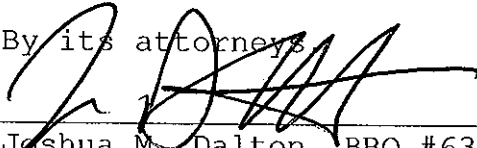
CONCLUSION

For the foregoing reasons, Jenzabar respectfully requests that this Court reverse the Order, deny Long Bow's Motion for Summary Judgment, and grant such further relief as the Court may deem appropriate.

Respectfully Submitted,

Dated: Oct. 17, 2011 **JENZABAR, INC.,**

By its attorneys


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COMMONWEALTH OF MASSACHUSETTS
APPEALS COURT

SUFFOLK, SS.

A.C. No. 2011-P-1533

JENZABAR, INC.,
Plaintiff - Appellant,
v.
LONG BOW GROUP, INC.,
Defendant - Appellee.

ON APPEAL FROM JUDGMENT
OF THE SUPERIOR COURT

ADDENDUM OF DECISIONS BY THE TRIAL COURT PERTINENT TO
AN ISSUE ON APPEAL AND STATUTES, RULES AND REGULATIONS
CITED IN APPEAL BRIEF

<u>TAB</u>	<u>DOCUMENT</u>
1	Memorandum of Decision and Order on Defendant's Motion for Summary Judgment
2	15 U.S.C. § 1114
3	15 U.S.C. § 1125
4	M.G.L. c. 93A, § 2
5	M.G.L. c. 93A, § 11
6	M.G.L. c. 110H, § 12
7	M.G.L. c. 110H, § 13
8	M.G.L. c. 110H, § 14
9	Mass. R. Civ. P. 56

TAB 1

Commonwealth of Massachusetts
County of Suffolk
The Superior Court

CIVIL DOCKET#: SUCV2007-02075-H

RE: Jenzabar, Inc et al v Long Bow Group, Inc

TO: Lawrence R Kulig, Esquire
Eckert Seamans Cherin & Mellott LLC
2 International Place
16th Floor
Boston, MA 02110

NOTICE OF DOCKET ENTRY

You are hereby notified that on 02/05/2010 the following entry was made on the above referenced docket:

Defendant Long Bow Group, Inc's MOTION for Summary Judgment, pursuant to Mass.R.Civ.P. 56, as to Jenzabar, Inc, Ling Chai, Robert A Maginn, Jr w/opposition Dated at Boston, Massachusetts this 7th day of December, 2010.

Michael Joseph Donovan,
Clerk of the Courts

BY: Nancy E. Goldrick
Assistant Clerk

Telephone: 617-788-8147

NOTIFY

12/7

38

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPERIOR COURT DEPARTMENT OF THE TRIAL COURT

JENZABAR, INC., LING CHAI, and ROBERT A MAGINN, JR.,

Plaintiffs,

v.

LONG BOW GROUP, INC.,

Defendant.

CIVIL ACTION NO. 07-2075-H

10/7/10 Argued in open ct file

12/19/10 Allowed See my written decision issued this date

[Handwritten signature]

DEFENDANT LONG BOW GROUP, INC.'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Mass. R. Civ. P. 56 and Superior Court Rule 9A(b)(5), defendant Long Bow

Group, Inc. ("Long Bow") moves for summary judgment in its favor dismissing all claims asserted by plaintiff Jenzabar, Inc. ("Jenzabar").¹ In support of this motion, Long Bow submits the attached supporting memorandum, statement of material facts that Jenzabar cannot dispute, and affidavits and exhibits.

Accordingly, Long Bow respectfully requests that the Court enter summary judgment in its favor on all claims remaining in this case.

Justice
Notice sent
12.07.10
ABZ
MNSK
TCD
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DMTK
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ESCTM
LLC
(md)

¹ This Court previously dismissed all defamation claims asserted by the plaintiffs, including those asserted by plaintiffs Ling Chai and Robert Maginn. As a result, Ling Chai and Robert Maginn no longer are plaintiffs in this case.

NOTIFY

12/7

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

notice sent
12.07.10

SUPERIOR COURT
CIVIL ACTION
SUCV2007-02075

JENZABAR, INC., et al., LING CHAI,
ROBERT MAGINN
Plaintiffs,

ABZ

MNK

TCD

PAZ

v.

DmTK

DCT&LP

LONG BOW GROUP, INC.
Defendant.

LRK

ESC+M.LLC

(mdj)

MEMORANDUM OF DECISION AND ORDER ON DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

INTRODUCTION

This action arises from a dispute between the plaintiffs and defendant over content on the defendant's, Long Bow Group, Inc's ("Long Bow"), web site. The plaintiffs, Jenzabar Inc. ("Jenzabar"), Ling Chai ("Chai"), and Robert Maginn, filed this action claiming business defamation, defamation, false designation of origin under 15 U.S.C. §§1114 and 1125 (a), Federal trademark dilution, common law trademark infringement, trademark infringement under Massachusetts law, trademark dilution under Massachusetts law, and violations of G.L. c. 93A. On August 5, 2008 Long Bow moved to dismiss all of these counts pursuant to Mass. R. Civ. P. 12(b)(6). On August 5, 2008 Long Bow's Motion to Dismiss was allowed as to Counts I and II (business defamation and defamation) and denied as to Counts III, IV, V, VI, VII, VIII (trademark and c. 93A). Although this Court (Holtz, J.) declined to dismiss the remaining six

trademark claims, the judge did note the likelihood that Jenzabar's remaining claims would fail. (Memorandum of Decision and Order on Defendant's Motion to Dismiss, p. 7, August 5, 2008).

Long Bow now moves for Summary Judgment pursuant to Mass. R. Civ. P. 56 on all remaining claims of Jenzabar asserting that there are no genuine issues of material fact and that they are entitled to judgment as a matter of law. For the reasons stated below, Long Bow's Motion for Summary Judgment is ALLOWED.

BACKGROUND

Chai was a student leader during the 1989 protests in Tiananmen Square in China. She subsequently came to the United States and founded Jenzabar, a software company focusing on the needs of educational institutions. Jenzabar and Jenzabar.com are federally registered marks. Jenzabar markets its products on the websites Jenzabar.com and Jenzabar.net, both of which are owned by Jenzabar.

Long Bow is a documentary film production company. In 1995, it produced The Gates of Heavenly Peace (the "Film"), a documentary film about the Tiananmen Square protests. Chai figured prominently in the film, which she claims was critical of her and the protests. Long Bow's web site at <http://www.tsquare.tv/film/jenzabar.html> (the "Site"), provides information about the film and the protests, including articles and background information concerning participants in the protests, including Chai. Long Bow uses the Jenzabar marks as "metatags" within its web site.¹ Long Bow's Site comes up on a list of hits when someone uses a search

¹ A helpful description of meta tags comes from North Am. Med. Corp. v. Axiom Worldwide, Inc., 522 F.3d 1211, 1216 n.2 (11th Cir. 2008): "Meta tags consist of words and phrases that are intended to describe the contents of a website. These descriptions are embedded within the website's computer code. Although websites do not display their meta tags to visitors, Internet search engines utilize meta tags in various ways. First, when a computer user enters particular terms into an Internet search engine, the *engine* may rank a webpage that contains the search terms within its meta tags higher in the list of relevant results. Second, when a particular web page is listed as a relevant search result, the search engine may use the meta tags to provide the searcher a brief description of the webpage." However, "modern search engines make little if any use of meta tags," instead relying on algorithms. Standard

engine to search for information about Jenzabar.² Jenzabar claims that prospective clients are diverted to a portion of Long Bow's website which discusses Jenzabar. Furthermore, Jenzabar claims that Long Bow has intentionally created this diversion which leads prospective clients to false content containing false impressions about Jenzabar, Chai, and Maginn. (Compl. p. 1, May 14, 2007). Jenzabar also claims that Long Bow makes unauthorized use of Jenzabar's protected trademarks to direct traffic to the Site. As a result of Long Bow's diversion, Jenzabar claims that this has caused reputational injury and loss of business opportunities. (Compl. p. 2).

STANDARD OF REVIEW

Summary judgment is appropriate when "there is no genuine issue as to any material facts and that the moving party is entitled to a judgment as a matter of law." Fed R. Civ. P. 56. See also, Black v. Henry Pratt Company, 778 F.2d 1278, 1281 (7th Cir. 1985); Peterson v. Time, Inc., 404 Mass. 14, 16-17 (1989); Mass R. Civ. P. 56(e). The party moving for summary judgment has the burden of proving an absence of disputed facts. Celotex Corporation v. Catrett, 477 U.S. 317, 323 (1986). Once the moving party has sufficiently met their burden, the nonmoving party must then produce evidence that is not based solely on allegations to show that there is a genuine issue of material facts. Howland v. Kilquist, 833 F.2d 639, 642 (7th Cir. 1987). But also, U.S. v. Diebold, Inc., 369 U.S. 654, 655 (1962) (when reviewing evidence, the inferences drawn are required to be read in a light most favorable to the nonmoving party); Kourouvacilis v. Gen. Motors Corp., 410 Mass. 706, 716 (1991).

Despite the advantage of the nonmoving party, the Supreme Court has stated that "the mere existence of a scintilla of evidence in support of plaintiff's position will be insufficient;

Process, Inc. v. Banks, 2008 WL 1805374 *4 (E.D. Wis. Apr. 18, 2008), quoting 4 J. Thomas McCarthy on Trademarks and Unfair Competition § 25:69 (4th ed. 2003).

² As of November 15, 2010, typing "Jenzabar" into Google returns Long Bow's Site as the third "hit." The first two "hits" are Jenzabar.com and Jenzabar.com/aboutus.aspx?id=80. The rest of the hits that come up are all directly endorsed or sponsored by Jenzabar.

there must be evidence upon which the jury could reasonably find for the plaintiff.” Anderson v. Liberty Lobby, Incorporated, 477 U.S. 242, 247 (1986). See also, Polaroid Corp. v. Rollins Environmental Services, 416 Mass. 684, 696 (1993) (“Bare assertions or conclusions regarding an individual’s understandings and assumptions are insufficient to withstand a well-pleaded motion for summary judgment.”).

DISCUSSION

- I. Trademark Claims (Counts III, IV, V, VI, VII)**
- i. (Count III) False Designation of Origin – 15 U.S.C. §§ 1114 and 1125 (a)**
 - ii. (Count IV) Federal Trademark Dilution**
 - iii. (Count V) Common Law Trademark Infringement**
 - iv. (Count VI) Trademark Infringement Under State Law**
 - v. (Count VII) Trademark Dilution Under State Law**

To succeed a plaintiff in a trademark case must show that (1) he owns a mark; (2) the defendant is using the same or similar mark; and (3) the defendant’s use is likely to confuse the public, thereby harming the plaintiff. Star Financial Services, Inc., v. AASTAR Mortg. Corp., 89 F.3d 5, 9 (1st Cir. 1996). Long Bow alleges that Jenzabar fails to establish any factual dispute as to whether Long Bow’s use of “Jenzabar” in its mark has caused a likelihood of confusion for web searchers as to the source or sponsorship of their Site.

Likelihood of confusion is an essential element of trademark infringement, whether it arises under federal or state law. Star Financial Services, Inc at 10. In Star the First Circuit requires evidence of a ‘substantial’ likelihood of a confusion and typically refers to eight factors in making the assessment; (1) similarity of the marks, (2) similarity of the goods, (3) relationship between the parties’ channels of trade, (4) relationship between the parties advertising, (5) the classes of prospective purchasers, (6) evidence of actual confusion, (7) defendant’s intent in adopting its mark, and (8) strength of the plaintiff’s mark. Id.

In the context of the web the three most important factors for determining likelihood of confusion in a trademark infringement case are the similarity of marks; the relatedness of the goods or services; and the simultaneous use of the web as a marketing channel. GoTo.com, Inc., v. The Walt Disney Company, 202 F.3d at 1205 (9th Cir. 2000).

A. Similarity of the Marks

The first controlling factor, the similarity of the marks, is always a critical question in the likelihood of confusion analysis in a trademark infringement case. The greater the similarity between the two marks at issue, the greater the likelihood of confusion. Id. at 1205. Certain factors guide the determination of the similarity of the marks in a trademark infringement case; (1) the marks must be considered in their entirety and as they appear in the marketplace, (2) similarity is adjudged in terms of appearance, sound, and meaning, and (3) similarities are weighed more heavily than differences. Id. at 1201.

On a trademark infringement claim the relevant consumer is the reasonably prudent consumer accustomed to shopping online and the relevant marketplace is the online marketplace. Toyota Motor Sales U.S.A. Inc., v. Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010). Despite the common use of the word "Jenzabar" in each party's mark, the total effect of the two marks does not create a likelihood of confusion. Courts have continuously held that, "the use of identical dominant words does not automatically equate to similarity between marks." See Frosty Treats Inc. v. Sony Computer Ent. Am. Inc., 426 F.3d 1001, 1003 (8th Cir. 2005). It is undisputed that Long Bow uses the mark Jenzabar to describe the content that is found within Long Bow's Site regarding Jenzabar. Long Bow does not claim to be sponsored or endorsed by Jenzabar, and this is made clear to web users who get to Long Bow's Site by a disclaimer at the top of the page. Therefore, the total effect of the Jenzabar mark as used in Long Bow's Site does not as a matter

of law create a likelihood of confusion. Thus, for the reasonable online consumer there is no risk of confusion because of the disclaimer in Long Bow's Site.

B. Similarity of Goods or Services

The second controlling factor is that "[r]elated goods are generally more likely than unrelated goods to confuse the public as to the producers of the goods." Brookfield Communications, Inc., v. West Coast Entertainment Corp., 174 F.3d 1036, 1054 (9th Cir.1999). Here, there is no similarity of goods or services. Jenzabar develops software; Long Bow makes documentary films. A prospective Jenzabar customer might be distracted by Jenzabar's mark appearing on Long Bow's Site, but they would not be confused. Users who arrive at Long Bow's Site, via a search for a Jenzabar related site, would immediately see a disclaimer at the top of the page which states that they are not affiliated with Jenzabar or any of its products. Therefore, this Court finds as a matter of law that there is no similarity of goods or services between Jenzabar and Long Bow.

C. Relationship Between the Parties' Channels of Trade and Relationship Between the Parties' Advertising

Jenzabar alleges that in this case the goods of both parties travel in overlapping channels of trade to reach respective purchasers. However, the evidence in the summary judgment record indicates that Jenzabar sells its products through their Internet and sales teams to educational institutions. (Plaintiffs' Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 16, Feb. 5, 2010). Long Bow sells its films through documentary film distributors, which in turn sell the films to museums, schools and libraries. (Defendant Long Bow Group, Inc's Memorandum in Support of its Motion for Summary Judgment, p. 14, Feb. 5, 2010). Thus both entities sell different products through different channels of trade and neither Jenzabar nor Long Bow exclusively use the web as their marketing channel. Long Bow and Jenzabar are not

direct competitors and it is an undisputed fact that Jenzabar does not sell or advertise through Long Bow's Site. Id. at 14.

Therefore, this Court finds that the summary judgment record contains no indication that a sufficient relationship exists between Jenzabar's and Long Bow's channels of trade and their types of advertising.

D. The Classes of Prospective Purchasers

Jenzabar alleges that the class of prospective purchasers between them and Long Bow overlaps. (Plaintiffs' Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 17, Feb. 5, 2010). Although the summary judgment record suggests that at times there may be some minimal overlap of prospective purchasers³, evidence of this factor alone is not enough for Jenzabar to overcome Long Bow's motion for summary judgment. Based on the summary judgment record I conclude that as a matter of law the prospective purchasers between Jenzabar and Long Bow do not sufficiently overlap.

E. Evidence of Actual Confusion

Another important inquiry at summary judgment in a trademark infringement action is whether the plaintiff has presented material evidence in support of a realistic likelihood of confusion. Hasbro Inc. v. Clue Computing Inc., 66 F. Supp 2d 117(D. Mass. 1999). Jenzabar has not presented any credible evidence at this summary judgment stage to suggest that that Long Bow has created confusion in the reasonably prudent web searcher's mind about the origin of their Site. See Hasbro, Inc., 66 F. Supp. 2d at 125. Further, mere knowledge of the existence of the plaintiff's mark does not mean that the defendant intended to benefit from or infringe upon plaintiff's mark. See Id. "When a domain name consists only of the trademark followed by

³ The evidence in the discovery indicates that at times different purchasers within the same academic institutions make the purchasing decisions for both Jenzabar's academic software and Long Bow's documentaries. Therefore it is possible that at times that the prospective purchasers overlap.

.com or some other suffix like .org or .net, that will typically suggest sponsorship or endorsement by the trademark holder.” In this case the Site at issue does not contain a suffix like .com, .org, .net, but instead just contains the mark Jenzabar in its title

<http://www.tsquare.tv/film/jenzabar.html>.

At this summary judgment stage, Jenzabar has failed to demonstrate with proposed evidence a likelihood that web searchers do or will confuse Long Bow’s Site with being sponsored by or affiliated with Jenzabar.

F. Defendant’s Intent in Adopting its Mark

In a trademark infringement suit the factor of intent is of “minimal importance, as no intent to copy or appropriate is necessary to demonstrate a likelihood of confusion” GoTo.com, Inc., F.3d at 1208. Even if this Court could conclude that Jenzabar has advanced some evidence that Long Bow had an intent to copy or appropriate Jenzabar’s mark (which Jenzabar has not done), it would prove nothing since proof of intent is not required for my evaluation of the key element of a likelihood of confusion. Id. Therefore, I need inquire no further into Long Bow’s intent.

G. Strength of the Plaintiff’s Mark

“The more likely a mark is to be remembered and associated in the public mind with the mark’s owner, the greater protection the mark is accorded by trademark laws.” Kenner Parker Toys Inc., v. Rose Art Indus., Inc., 963 F.2d 350, 353 (Fed.Cir.1992). The strength of the mark must be evaluated in its entirety; it is not enough to just consider individual elements of that mark. California Cooler Inc. v. Loretto Winery, Ltd., 774 F.2d 1451, 1455 (9th Cir.1985).

In this case the plaintiffs claim that Jenzabar is a strong and distinctive mark created solely to identify the company and that it has been in use for more than a decade. (Plaintiffs’

Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 2, February 5, 2010). Although the Jenzabar mark is registered with the U.S. Patent and Trademark Office that alone does not prove the strength of the Jenzabar mark. Furthermore, the plaintiffs assert that the Jenzabar mark is recognizable particularly in the educational community. *Id.* at 3. Since the educational community is but a subset of the overall public, this Court concludes that while the plaintiffs have some evidence of the strength of their mark they cannot prove as a matter of law that it is a sufficiently prevailing factor to defeat summary judgment.

H. Trademark Dilution Under State Law

Jenzabar claims that Long Bow's unauthorized use of the plaintiff's mark would lessen and/or create a likelihood of dilution of the distinctive quality of the Jenzabar mark in violation of Massachusetts General Law 110B. Dilution claims require extensive analysis of their own and "are not intended to serve as mere fallback protection for trademark owners unable to prove trademark infringement." *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 48 (1st Cir. 1998).

This Court finds that Jenzabar is relying on this claim solely because of its difficulty in advancing the necessary evidence to defeat summary judgment on their trademark infringement claim. This conclusion is supported by the fact that Jenzabar dropped their trademark dilution under federal law claim before the summary judgment hearing on October 7, 2010. Therefore, this Court finds that Jenzabar has offered insufficient evidence at this summary judgment stage showing that their Jenzabar mark has been diluted by Long Bow's use of the mark to lead to subject matter on their Site.

Since the plaintiffs and Jenzabar have failed to present any genuine issues of material facts on the critical issues for federal and state trademark infringement, the defendant, Long Bow, is entitled to summary judgment as a matter of law.

II. Nominative Fair Use Defense

Long Bow claims that their use of the mark Jenzabar in meta tags to refer to Jenzabar and to describe and index the contents of their web page about Jenzabar is protected as nominative fair use. Because Long Bow's Motion for Summary Judgment has been successful as described in Section I of this opinion, this discussion of nominative fair use only further confirms the merits of the defendant's motion for summary judgment.

In cases such as this where a nominative fair use defense is raised, courts must determine whether (1) the product was readily identifiable without use of the mark; (2) defendant used more of the mark than necessary and; (3) defendant falsely suggested that it was sponsored or endorsed by the trademark holder. KEMA Inc., v. Koperwhats, 2010 U.S. Dist. LEXIS 90803. This test is "designed to address the risk that nominative use of the mark will inspire a mistaken belief on the part of consumers that the speaker is sponsored or endorsed by the trademark holder." *Id.* (noting eight-factor test for likelihood of confusion, articulated in AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979), does not apply "where a defendant uses the mark to refer to the trademarked good itself"; New Kids on the Block v. New Am. Publ'g., 971 F.2d 302, 307 (9th Cir. 1992); Playboy Enters. v. Welles, 279 F.3d 796, 804 (9th Cir. 2002).

A defendant seeking to assert nominative fair use as a defense need only show that it used the mark to refer to the trademarked good and then the burden shifts to the plaintiff asserting trademark infringement to show a likelihood of confusion. Toyota, 610 F.3d at 1182. As long as the site as a whole does not suggest sponsorship or endorsement by the trademark holder, momentary uncertainty by web searchers does not preclude a finding of nominative fair use. *Id.* at 1179.

In this case, Long Bow uses the Jenzabar mark to refer to the contents of its Site about Jenzabar. Long Bow is unable to discuss Jenzabar in their Site without using the actual name Jenzabar. There has been no evidence in the summary judgment record presented to this Court that Long Bow uses more of the Jenzabar mark than necessary. In fact the mark correctly portrays the content of the web page, the Site, as being about Jenzabar.

As previously discussed, Long Bow does have a disclaimer at the top of the Site that makes it clear to the reasonable web searcher that they are not affiliated with, sponsored by, or endorsed by Jenzabar in any way. This Court finds that Long Bow has not falsely suggested that it is sponsored or endorsed by the trademark holder, which in this case is Jenzabar.

When a domain name making nominative use of a mark does not actively suggest sponsorship or endorsement, it is true that some consumers may arrive at the site uncertain as to what they will find. "But in the age of Fios, cable modems, DSL lines, etc., reasonable and prudent Internet consumers are accustomed to such exploration by trial and error. They expect to find some sites that are not what they first imagined based on a glance at the domain name or search engine summary." *Id.* at 1179. This Court finds that this initial uncertainty does not qualify as confusion and is an inevitable part of web searching.

For purposes of this motion for summary judgment, and strengthening Long Bow's position that none of the plaintiffs' claims can proceed as a matter of law, this Court finds that Long Bow's use of Jenzabar in its metatags is protected under the nominative fair use doctrine because the plaintiffs have failed to show a likelihood of confusion as to sponsorship or endorsement. *Id.* at 1182. Furthermore, the nominative fair use doctrine permits Long Bow to use the mark to refer to Jenzabar and further use it to index and describe the contents of their Site about Jenzabar.

III. G.L. c. 93A Claim (Count VIII)

The theory of Jenzabar's c. 93A claim is essentially (1) that Long Bow manipulated search engine results in order to attract Jenzabar's prospective clients to Long Bow's Site where they would read misleading articles critical of Chai and Jenzabar and (2) that these prospective clients would subsequently not do business with Jenzabar. False and misleading statements can be actionable under c. 93A. But when the alleged existence of such statements is insufficient, and in fact irrelevant, to the overall required legal analysis for trademark claims, such allegations cannot support a cause of action under c. 93A. Dulgarian v. Stone, 420 Mass. 843, 853 (1995) (where allegedly defamatory statements do not support a cause of action for defamation, they also do not support a cause of action under c. 93A). There must be proof of an unfair or deceptive act by Long Bow in the context of the plaintiffs' trademark claims for Jenzabar's c. 93A claim to succeed. See G.L. c. 93A.

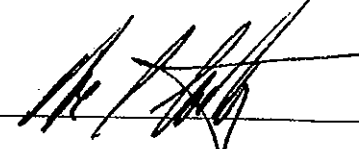
This Court finds that Long Bow's conduct does not violate c. 93A because Jenzabar has failed to allege any facts or evidence in the summary judgment record to support a trademark claim. Furthermore Long Bow enjoys the benefit as a matter of law of the Nominative Fair Use Doctrine. Thus plaintiffs cannot maintain their c. 93A claim.

ORDER

For the foregoing reasons it is hereby **ORDERED** that the Defendant's Motion for Summary Judgment is **ALLOWED**.

December 7, 2010

Date:


Honorable John C. Cratsley
Justice of the Superior Court

NOTE
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(md)

TAB 2

United States Code

- United States Code**
- TITLE 15 — COMMERCE AND TRADE**
- CHAPTER 22 — TRADEMARKS**
- SUBCHAPTER III — GENERAL PROVISIONS**

15 U.S.C. § 1114. Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant —

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section

2510(12) of title 18, the remedies of the owner of the right infringed or person bringing the action under section **1125(a)** of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section **1125(a)** of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D) (i) (I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief or, except as provided in subclause (II), for injunctive relief, to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

(II) A domain name registrar, domain name registry, or other domain name registration authority described in subclause (I) may be subject to injunctive relief only if such registrar, registry, or other registration authority has -

(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court's control and authority regarding the disposition of the registration and use of the domain name;

(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court; or

(cc) willfully failed to comply with any such court order.

(ii) An action referred to under clause (i)(I) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name -

(I) in compliance with a court order under section **1125(d)** of this title; or

(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

(iii) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another

absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages, including costs and attorney's fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

(v) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.

(E) As used in this paragraph -

(i) the term "violator" means a person who violates section 1125(a) of this title; and

(ii) the term "violating matter" means matter that is the subject of a violation under section 1125(a) of this title.

(3) (A) Any person who engages in the conduct described in paragraph (11) of section 110 of title 17 and who complies with the requirements set forth in that paragraph is not liable on account of such conduct for a violation of any right under this chapter. This subparagraph does not preclude liability, nor shall it be construed to restrict the defenses or limitations on rights granted under this chapter, of a person for conduct not described in paragraph (11) of section 110 of title 17, even if that person also engages in conduct described in paragraph (11) of section 110 of such title.

(B) A manufacturer, licensee, or licensor of technology that enables the making of limited portions of audio or video content of a motion picture imperceptible as described in subparagraph (A) is not liable on account of such manufacture or license for a violation of any right under this chapter, if such manufacturer, licensee, or licensor ensures that the technology provides a clear and conspicuous notice at the beginning of each performance that the performance of the motion picture is altered from the performance intended by the director or copyright holder of the motion picture. The limitations on liability in subparagraph (A) and this subparagraph shall not apply to a manufacturer, licensee, or licensor of technology that fails to comply with this paragraph.

(C) The requirement under subparagraph (B) to provide notice shall apply only with respect to technology manufactured after the end of the 180-day period beginning on April 27, 2005.

(D) Any failure by a manufacturer, licensee, or licensor of technology to qualify for the exemption under subparagraphs (A) and (B) shall not be construed to create an inference that any such party that engages in conduct described in paragraph (11) of section 110 of title 17 is liable for trademark infringement by reason of such conduct.

(July 5, 1946, ch. 540, title VI, Sec. 32, 60 Stat. 437; Pub.L. 87-772, Sec. 17, Oct. 9, 1962, 76 Stat. 773; Pub.L. 100-667, title I, Sec. 127, Nov. 16, 1988, 102 Stat. 3943; Pub.L. 102-542, Sec. 3(a), Oct. 27, 1992, 106 Stat. 3567; Pub.L. 105-330, title II, Sec. 201(a)(8), Oct. 30, 1998, 112 Stat. 3070; Pub.L. 106-43, Sec. 4(a), Aug. 5, 1999, 113 Stat. 219; Pub.L. 106-113, div. B, Sec. 1000(a)(9) [title III, Sec. 3004], Nov. 29, 1999, 113 Stat. 1536, 1501A-549; Pub.L. 109-9, title II, Sec. 202(b), Apr. 27, 2005, 119 Stat. 223.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, Sec. 16, 33 Stat. 728; Mar. 19, 1920, ch. 104, Sec. 4, 41 Stat. 534.

AMENDMENTS

2005 - Par. (3). Pub.L. 109-9 added par. (3).

1999 - Par. (1). Pub.L. 106-43, in undesignated par., inserted after "includes" in first sentence "the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and" and, in second sentence, substituted "The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any" for "Any".

Par. (2). Pub.L. 106-113, Sec. 1000(a)(9) [title III, Sec. 3004(1)], in introductory provisions, substituted "under section 1125(a) or (d) of this title" for "under section 1125(a) of this title".

Par. (2)(D), (E). Pub.L. 106-113, Sec. 1000(a)(9) [title III, Sec. 3004(2)], added subpar. (D) and redesignated former subpar. (D) as (E).

1998 - Par. (1). Pub.L. 105-330 substituted "As used in this paragraph" for "As used in this subsection" in last paragraph.

1992 - Par. (1). Pub.L. 102-542 inserted at end "As used in this subsection, the term 'any person' includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity."

1988 - Par. (2). Pub.L. 100-667 amended par. (2) generally. Prior to amendment, par. (2) read as follows: "Notwithstanding any other provision of this chapter, the remedies given to the owner of the right infringed shall be limited as follows: (a) Where an infringer in engaged solely in the business of printing the mark for others and establishes that he was an innocent infringer the owner of the right infringed shall be entitled as against such infringer only to an injunction against future printing; (b) where the infringement complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical the remedies of the owner of the right infringed as against the publisher or distributor of such newspaper, magazine, or other similar periodical shall be confined to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodical: Provided, That these limitations shall apply only to innocent infringers; (c) injunction relief shall not be available to the owner of the right infringed in respect of an issue of a newspaper,

magazine, or other similar periodical containing infringing matter when restraining the dissemination of such infringing matter in any particular issue of such periodical would delay the delivery of such issue after the regular time therefor, and such delay would be due to the method by which publication and distribution of such periodical is customarily conducted in accordance with sound business practice, and not to any method or device adopted for the evasion of this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter."

1962 - Par. (1). Pub.L. 87-772 amended provisions generally, and among other changes, inserted "distribution", and struck out "purchasers as to the source of origin of such goods or services" after "or to deceive" in subsec. (a), inserted provisions regarding the likelihood of such use causing confusion, mistake, or deception, in subsec. (b), and struck out the limitation on recovery under subsec. (b) to acts committed with knowledge that such acts would deceive purchasers.

Par. (2)(b). Pub.L. 87-772 substituted "publisher" for "published".

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub.L. 106-113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, Sec. 3010] of Pub.L. 106-113, set out as a note under section 1117 of this title.

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub.L. 105-330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub.L. 105-330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1992 AMENDMENT

Section 4 of Pub.L. 102-542 provided that: "The amendments made by this Act [enacting section 1122 of this title and amending this section and sections 1125 and 1127 of this title] shall take effect with respect to violations that occur on or after the date of the enactment of this Act [Oct. 27, 1992]."

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub.L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub.L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1115, 1116, 1117, 1122 of this title.

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TAB 3

United States Code

United States Code
TITLE 15 -- COMMERCE AND TRADE
CHAPTER 22 -- TRADEMARKS
SUBCHAPTER III -- GENERAL PROVISIONS

15 U.S.C. § 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation - Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

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

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions - The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with -

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof - In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that -

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies - In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if -

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection -

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action - The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that -

(A) (i) is brought by another person under the common law or a statute of a State; and

(ii) seeks to prevent dilution by blurring or dilution by tarnishment; or

(B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause - Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1) (A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person -

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that -

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section **706** of title 18 or section **220506** of title 36.

(B) (i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to -

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection **(c)** of this section.

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2) (A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if -

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner -

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by -

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which -

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D) (i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this

paragraph, the domain name registrar, domain name registry, or other domain name authority shall -

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

(July 5, 1946, ch. 540, title VIII, Sec. 43, 60 Stat. 441; Pub.L. 100-667, title I, Sec. 132, Nov. 16, 1988, 102 Stat. 3946; Pub.L. 102-542, Sec. 3(c), Oct. 27, 1992, 106 Stat. 3568; Pub.L. 104-98, Sec. 3(a), Jan. 16, 1996, 109 Stat. 985; Pub.L. 106-43, Sec. 3(a)(2), 5, Aug. 5, 1999, 113 Stat. 219, 220; Pub.L. 106-113, div. B, Sec. 1000(a)(9) [title III, Sec. 3002(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-545; Pub.L. 109-312, Sec. 2, Oct. 6, 2006, 120 Stat. 1730.)

REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in subsec. (c)(2)(iv), (6), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502, and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, Sec. 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Act Mar. 19, 1920, ch. 104, Sec. 3, 41 Stat. 534.

AMENDMENTS

2006 - Subsec. (c). Pub.L. 109-312, Sec. 2(1), amended subsec. (c) generally. Prior to amendment subsec. (c) read as follows:

" (c) Remedies for dilution of famous marks

" (1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to -

" (A) the degree of inherent or acquired distinctiveness of the

mark;

" (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

" (C) the duration and extent of advertising and publicity of the mark;

" (D) the geographical extent of the trading area in which the mark is used;

" (E) the channels of trade for the goods or services with which the mark is used;

" (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

" (G) the nature and extent of use of the same or similar marks by third parties; and

" (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

" (2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 1116 of this title unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

" (3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

" (4) The following shall not be actionable under this section:

" (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

" (B) Noncommercial use of a mark.

" (C) All forms of news reporting and news commentary. "

Subsec. (d)(1)(B)(IX). Pub.L. 109-312, Sec. 2(2), substituted reference to subsection (c) of this section for reference to subsec. (c)(1) of this section.

1999 - Subsec. (a)(3). Pub.L. 106-43, Sec. 5, added par. (3).

Subsec. (c)(2). Pub.L. 106-43, Sec. 3(a)(2), inserted "as set forth in section 1116 of this title" after "relief" in first sentence.

Subsec. (d). Pub.L. 106-113 added subsec. (d).

1996 - Subsec. (c). Pub.L. 104-98 added subsec. (c).

1992 - Subsec. (a). Pub.L. 102-542 designated existing provisions as par. (1), redesignated former pars. (1) and (2) as subpars. (A) and (B), respectively, and added par. (2).

1988 - Subsec. (a). Pub.L. 100-667 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: "Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub.L. 106-113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, Sec. 3010] of Pub.L. 106-113, set out as a note under section 1117 of this title.

EFFECTIVE DATE OF 1996 AMENDMENT

Section 5 of Pub.L. 104-98 provided that: "This Act [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] and the amendments made by this Act shall take effect on the date of the enactment of this Act [Jan. 16, 1996]."

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub.L. 102-542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub.L. 102-542, set out as a note under section 1114 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub.L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub.L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

STUDY ON ABUSIVE DOMAIN NAME REGISTRATIONS INVOLVING PERSONAL NAMES

Pub.L. 106-113, div. B, Sec. 1000(a)(9) [title III, Sec. 3006], Nov. 29, 1999, 113 Stat. 1536, 1501A-550, provided that:

" (a) In General - Not later than 180 days after the date of the enactment of this Act [Nov. 29, 1999], the Secretary of Commerce, in

consultation with the Patent and Trademark Office and the Federal Election Commission, shall conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto, including consideration of and recommendations for --

" (1) protecting personal names from registration by another person as a second level domain name for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain;

" (2) protecting individuals from bad faith uses of their personal names as second level domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name;

" (3) protecting consumers from the registration and use of domain names that include personal names in the second level domain in manners which are intended or are likely to confuse or deceive the public as to the affiliation, connection, or association of the domain name registrant, or a site accessible under the domain name, with such other person, or as to the origin, sponsorship, or approval of the goods, services, or commercial activities of the domain name registrant;

" (4) protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential official candidates for Federal, State, or local political office in the United States, and the use of such domain names in a manner that disrupts the electoral process or the public's ability to access accurate and reliable information regarding such individuals;

" (5) existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the considerations described in paragraphs (1) through (4); and

" (6) the guidelines, procedures, and policies of the Internet Corporation for Assigned Names and Numbers and the extent to which they address the considerations described in paragraphs (1) through (4).

" (b) Guidelines and Procedures -- The Secretary of Commerce shall, under its Memorandum of Understanding with the Internet Corporation for Assigned Names and Numbers, collaborate to develop guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto. "

CODE OF FEDERAL REGULATIONS

Importation, see **19 CFR Part 11**.

TAB 4

General Laws of Massachusetts

-  **General Laws of Massachusetts**
-  **PART I ADMINISTRATION OF THE GOVERNMENT**
-  **TITLE XV REGULATION OF TRADE**
-  **CHAPTER 93A. REGULATION OF BUSINESS PRACTICES FOR CONSUMERS PROTECTION**

G.L.c. 93A, § 2. Unfair practices; legislative intent; rules and regulations

Section 2. (a) Unfair methods of competition and unfair or deceptive acts or practices in the conduct of any trade or commerce are hereby declared unlawful.

(b) It is the intent of the legislature that in construing paragraph (a) of this section in actions brought under sections four, nine and eleven, the courts will be guided by the interpretations given by the Federal Trade Commission and the Federal Courts to section 5(a)(1) of the Federal Trade Commission Act (15 U.S.C. § 45(a)(1)), as from time to time amended.

(c) The attorney general may make rules and regulations interpreting the provisions of subsection 2(a) of this chapter. Such rules and regulations shall not be inconsistent with the rules, regulations and decisions of the Federal Trade Commission and the Federal Courts interpreting the provisions of 15 U.S.C. § 45(a)(1) (The Federal Trade Commission Act), as from time to time amended.

TAB 5

General Laws of Massachusetts

General Laws of Massachusetts

PART I ADMINISTRATION OF THE GOVERNMENT

TITLE XV REGULATION OF TRADE

CHAPTER 93A. REGULATION OF BUSINESS PRACTICES FOR CONSUMERS PROTECTION

G.L.c. 93A, § 11. Persons engaged in business; actions for unfair trade practices; class actions; damages; injunction; costs

Section 11. Any person who engages in the conduct of any trade or commerce and who suffers any loss of money or property, real or personal, as a result of the use or employment by another person who engages in any trade or commerce of an unfair method of competition or an unfair or deceptive act or practice declared unlawful by section two or by any rule or regulation issued under paragraph (c) of section two may, as hereinafter provided, bring an action in the superior court, or in the housing court as provided in section three of chapter one hundred and eighty-five C, whether by way of original complaint, counterclaim, cross-claim or third-party action for damages and such equitable relief, including an injunction, as the court deems to be necessary and proper.

Such person, if he has not suffered any loss of money or property, may obtain such an injunction if it can be shown that the aforementioned unfair method of competition, act or practice may have the effect of causing such loss of money or property.

Any persons entitled to bring such action may, if the use or employment of the unfair method of competition or the unfair or deceptive act or practice has caused similar injury to numerous other persons similarly situated and if the court finds in a preliminary hearing that he adequately and fairly represents such other persons, bring the action on behalf of himself and such other similarly injured and situated persons; the court shall require that notice of such action be given to unnamed petitioners in the most effective, practicable manner. Such action shall not be dismissed, settled or compromised without the approval of the court, and notice of any proposed dismissal, settlement or compromise shall be given to all members of the class of petitioners in such a manner as the court directs.

A person may assert a claim under this section in a district court, whether by way of original complaint, counterclaim, cross-claim or third-party action, for money damages only. Said damages may include double or treble damages, attorneys' fees and costs, as hereinafter provided, with provision for tendering by the person against whom the claim is asserted of a written offer of settlement for single damages, also as hereinafter provided. No rights to equitable relief shall be created under this paragraph, nor shall a person asserting such claim be able to assert any claim on behalf of other similarly injured and situated persons as provided in the preceding paragraph. The provisions of sections ninety-five to one hundred and ten, inclusive, of chapter two hundred and thirty-one, where applicable, shall apply to a claim under this section, except that the provisions for remand, removal and transfer shall be controlled by the amount of single damages claimed hereunder.

If the court finds for the petitioner, recovery shall be in the amount of actual damages; or up to three, but not less than two, times such amount if the court finds that the use or employment of the method of competition or the act or practice was a willful or knowing violation of said section two. For the purposes of this chapter, the amount of actual

damages to be multiplied by the court shall be the amount of the judgment on all claims arising out of the same and underlying transaction or occurrence regardless of the existence or nonexistence of insurance coverage available in payment of the claim. In addition, the court shall award such other equitable relief, including an injunction, as it deems to be necessary and proper. The respondent may tender with his answer in any such action a written offer of settlement for single damages. If such tender or settlement is rejected by the petitioner, and if the court finds that the relief tendered was reasonable in relation to the injury actually suffered by the petitioner, then the court shall not award more than single damages.

If the court finds in any action commenced hereunder, that there has been a violation of section two, the petitioner shall, in addition to other relief provided for by this section and irrespective of the amount in controversy, be awarded reasonable attorneys' fees and costs incurred in said action.

In any action brought under this section, in addition to the provisions of paragraph (b) of section two, the court shall also be guided in its interpretation of unfair methods of competition by those provisions of chapter ninety-three known as the Massachusetts Antitrust Act.

No action shall be brought or maintained under this section unless the actions and transactions constituting the alleged unfair method of competition or the unfair or deceptive act or practice occurred primarily and substantially within the commonwealth. For the purposes of this paragraph, the burden of proof shall be upon the person claiming that such transactions and actions did not occur primarily and substantially within the commonwealth.

TAB 6

General Laws of Massachusetts

- General Laws of Massachusetts**
- PART I ADMINISTRATION OF THE GOVERNMENT**
- TITLE XV REGULATION OF TRADE**
- CHAPTER 110H. REGISTRATION AND PROTECTION OF TRADEMARKS**

G.L.c. 110H, § 12. Use or counterfeit of marks without consent of registrant

Section 12. Subject to section 16, a person who shall: -

(i) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this chapter in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in connection with which the use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services; or

(ii) reproduce, counterfeit, copy or colorably imitate the mark and apply the reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale or other distribution in the commonwealth of such goods or services; shall be liable in a civil action by the registrant for the remedies provided in section 14, except that under clause (ii) of this section the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion or mistake or to deceive.

[Added by 2006, 195, Sec. 2 effective October 30, 2006.]

TAB 7

General Laws of Massachusetts

- General Laws of Massachusetts**
- PART I ADMINISTRATION OF THE GOVERNMENT**
- TITLE XV REGULATION OF TRADE**
- CHAPTER 110H. REGISTRATION AND PROTECTION OF TRADEMARKS**

G.L.c. 110H, § 13. Injunctive relief

Section 13. Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this chapter, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.

[Added by 2006, **195**, Sec. 2 effective October 30, 2006.]

TAB 8

General Laws of Massachusetts

General Laws of Massachusetts

PART I ADMINISTRATION OF THE GOVERNMENT

TITLE XV REGULATION OF TRADE

CHAPTER 110H. REGISTRATION AND PROTECTION OF TRADEMARKS

G.L.c. 110H, § 14. Actions for counterfeit or imitation marks; injunctions; damages

Section 14. (a) An owner of a mark registered under this chapter may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and the superior court may grant injunctions to restrain the manufacture, use, display or sale as may be considered by the court as just and reasonable, and may require the defendants to pay to the owner all profits derived from and all damages suffered by reason of the wrongful manufacture, use, display or sale; and the court may also order that the counterfeits or imitations in the possession or under the control of any defendant in the case be delivered to an officer of the court, or to the complainant, to be destroyed. The court, in its discretion, may enter judgment for an amount not to exceed 3 times the profits and damages and reasonable attorneys' fees of the prevailing party in the cases where the court finds the other party committed wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.

(b) The enumeration of any right or remedy herein shall not affect a registrant's right to prosecute under any penal law of the commonwealth.

[Added by 2006, 195, Sec. 2 effective October 30, 2006.]

TAB 9

Rules of Civil Procedure

Rules of Civil Procedure

VII. JUDGMENT

RULE 56. SUMMARY JUDGMENT

(a) For Claimant.

A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) For Defending Party.

A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

(c) Motion and Proceedings Thereon.

The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and responses to requests for admission under Rule 36, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages. Summary judgment, when appropriate, may be rendered against the moving party.

(d) Case Not Fully Adjudicated on Motion.

If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining the pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) Form of Affidavits; Further Testimony; Defense Required.

Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be

supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleading, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If he does not so respond, summary judgment, if appropriate, shall be entered against him.

(f) When Affidavits Are Unavailable.

Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit facts essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

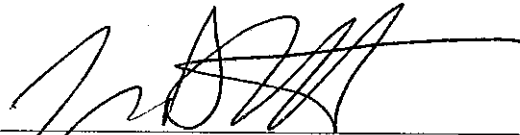
(g) Affidavits Made in Bad Faith.

Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

Amended March 7, 2002, effective May 1, 2002.

RULE 16(k) CERTIFICATION

The undersigned hereby certifies that this brief complies with the rules of court that pertain to the filing of briefs, including but not limited to Mass. R. App. P. 16(a)(6) (pertinent findings or memorandum of decision); Mass. R. App. P. 16(e) (references in briefs to the record); Mass. R. App. P. 16(f) (reproduction of statutes, rules and regulations), Mass. R. App. P. 16(h) (length of briefs); Mass. R. App. P. 18 (appendix to the briefs); and Mass. R. App. P. 20 (forms of briefs, appendices, and other papers).



Joshua M. Dalton

