

COMMONWEALTH OF MASSACHUSETTS
COURT OF APPEALS

SUFFOLK, SS

A.C. No. 2011-P-1533

JENZABAR, INC.,

Plaintiff-Appellant/Cross-Appellee,

v.

LONG BOW GROUP, INC.,

Defendant-Appellee/Cross-Appellant.

ON APPEAL FROM A JUDGMENT
OF THE SUPERIOR COURT

**BRIEF FOR DEFENDANT-APPELLEE/CROSS-APPELLANT
LONG BOW GROUP, INC.**

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January 18, 2012

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

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

Respectfully submitted,

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Dated: January 18, 2012

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GLOSSARY OF FREQUENTLY-USED ABBREVIATIONS

App. Br.	Jenzabar's Appellate Brief
HTML	HyperText Markup Language
JA	Joint Appendix
IIC	initial interest confusion
MJP	main Jenzabar-related page, http://tsquare.tv/film/jenzabar.html

INTRODUCTION

In this case a software company, unhappy about how one of its founders was portrayed in a documentary made in the mid-1990's, brought meritless trademark claims to try to bludgeon the documentarists into revising statements about the company and the founder on a film-related web site. The trademark suit blamed the use of HTML tags, which used the company's name accurately to identify a page on the web site as being about the company, for the prominent appearance of that page among the results of a Google search using the company's name. It further alleged that potential customers would thereby find the criticisms and take them into account in deciding whether to do business with the company. The superior court properly recognized that truthful use of plaintiff's name to denote a web page about plaintiff did not violate the trademark laws, and that plaintiff had no evidence that even a single Internet user experienced confusion, or was likely to suffer confusion, about whether the web page was affiliated with it. Because the suit's purpose was to suppress the truth, not avoid confusion, the court granted summary judgment. This Court should affirm the judgment, but remand to permit the trial court to decide whether to award attorney fees.

ISSUES PRESENTED

1. Under the First Amendment do trademark laws forbid artists to use a company's name truthfully to identify web pages that offer non-commercial speech critical of the

company, where there is no evidence that any Internet users were confused, or likely would be confused, about whether the critical pages were from the trademark owner?

2. Was a trademark suit filed in 2007 over placement of a trademarked name into HTML tags in 1999 timely?

3. Was this suit so meritless and so evidently brought to suppress criticism that the trial court should be given the opportunity, on remand, to decide whether to award attorney fees under the Lanham Act?

STATEMENT

A. Facts.

In 1995, defendant Long Bow Group made a documentary, *The Gate of Heavenly Peace*, about the Tiananmen Square protests and the resulting massacre. The documentary included an 1989 interview with plaintiff Ling Chai, then a student leader at Tiananmen, in which she expressed hope that the Chinese government would use military force against the protesting students, because "[o]nly when the Square is awash with blood will the people of China open their eyes" to the true nature of the Communist regime. http://tsquare.tv/film/transcript_may27.php.

In 1996, in conjunction with a PBS showing of the film, Long Bow created a web site about the film and its subject. JA 372, 684. The site traced later developments about the massacre and about some of the film's leading characters, including Chai. After Long Bow learned in the late 1990's that Chai and her husband, plaintiff Robert Maginn, had founded plaintiff Jenzabar, Inc., to create

software for educational institutions, it added a page about Jenzabar to its site about the film. JA 616, 956.

From the beginning, this page on Long Bow's site was simply entitled "Jenzabar"; its web address, title tag and keyword meta tags included that word. JA 373, 650, 1420. Because in its early years the company was also known as jenzabar.com and jenzabar.net, the keyword meta tags included those terms as well. JA 652. Originally, the purpose of such tags was to help search engines index web pages, functioning vis-a-vis search engines much as title, subject and author cards in a card catalog would help a library index the books in its collection. JA 312, 991; *PACCAR Inc. v. TeleScan Technologies*, 319 F.3d 243, 248 n.2 (6th Cir. 2003). The standard use of keyword meta tags is illustrated by Jenzabar's own web site, whose tags include the names of many prominent universities with which Jenzabar does business or **hopes** to do business, JA 326, 523-524, and by the sites of CNN and Forbes Magazine, whose 1999 and 2003 news stories about Jenzabar feature its name in their keyword meta tags. JA 911, 927. In 2001, when the entire web site about Long Bow's film was moved to the newly purchased domain name tsquare.tv, the precursor page about Jenzabar, with its pre-existing title and keyword meta tags, was moved to the new site. JA 373.

In the late 1990's, when Altavista was a leading search engine, keyword meta tags played a significant role in helping search engines determine which web pages should be returned. JA 651-652. Later, other search engines such

as Google rose to prominence, and keyword meta tags became less significant, because the new search engine operators understood that such tags could too easily be manipulated. Google became the leading search engine provider by using a secret algorithm that considered a multitude of factors, without any reference to keyword meta tags, but including the keywords actually appearing in the text of a page. Experts in search engines repeatedly commented on the irrelevance of keyword meta tags. JA 1270, 1272, 1278. In 2009, a leader of Google's Search Quality team noted that Google's search algorithm gave no consideration to such meta tags, and had not done so for many years. JA 1333.

Also during the first decade of the new century, Jenzabar gained more traction in its sector, aided by a major investment by plaintiff Maginn, and bought out some of its competitors. JA 903-904. It became a large company, with three hundred employees and customers and offices throughout the nation. JA 322. As it grew, Jenzabar was the subject of unflattering articles in the Boston Globe. Long Bow excerpted those articles on its own web site and linked to them from its page about Jenzabar. JA 390.

In 2006 and 2007, Jenzabar complained to Long Bow both that a link to Long Bow's main Jenzabar-related page (henceforth called the "MJP") appeared on the first page of the search results when a user entered the search term "Jenzabar" into the Google search engine, and that unflattering information from the Boston Globe was later shown to be false. JA 394, 656. Jenzabar demanded removal

of the references; Long Bow refused. JA 394-401.¹

B. Proceedings Below.

Jenzabar, Chai and Maginn sued Long Bow on May 14, 2007, but did not contend that the film's portrayal of Chai defamed her. Instead, all three plaintiffs claimed they were defamed by the republication of material from the Boston Globe's web site, reporting financial controversies involving Jenzabar. JA 7-8.

Jenzabar alone brought trademark claims, alleging that Long Bow infringed and diluted its trademarks by using Jenzabar's various names in keyword meta tags of pages about Jenzabar. The complaint made no reference to any title tags. The keyword meta tags, Jenzabar alleged, unfairly increased the impact of Long Bow's defamatory criticism on its reputation and hence its business, JA 1, 7-8, because meta tags were supposedly responsible for the MJP's ranking in the first few Google search results. JA 7. Thus, Jenzabar complained, its potential customers would find allegedly false criticism when doing their due diligence before adopting Jenzabar's costly enterprise

¹By the time of the complaint, "jenzabar" appeared in keyword meta tags and title tags for two other pages (www.tsquare.tv/film/jenzabar_letters_2007.html and www.tsquare.tv/film/american_dream.html) and in keyword meta tags alone for another page: www.tsquare.tv/film/harvard.html. JA 245. **Each** page reports information about Jenzabar, *id.*, and **none** appears in even the first 100 search results on Google. JA 248. Jenzabar never explained below how the use of its mark in the HTML tags of any of these other pages could have led to actionable customer confusion, and it does not so argue on appeal. Nor has it rebutted the damning impact of this low search ranking on Jenzabar's theory that it was the use of its mark in the tags that caused the high search placement of the MJP.

software, so costly that loss of one customer would allegedly result in huge damages. JA 488.

On October 20, 2008, the defamation claims were dismissed because the statements about Jenzabar were nonactionable opinion. But opposing Long Bow's motion to dismiss the trademark claims, Jenzabar argued that it would be "premature" to reject trademark claims at the pleading stage. Because Jenzabar's complaint used labels, conclusions, and allegations that the Court felt rule-bound to accept, the Court declined to dismiss the trademark claims but noted the likelihood that Jenzabar's claims would fail. After several months of inactivity, in the spring of 2009, Jenzabar replaced its original counsel and extensive discovery began.

In discovery, Jenzabar interrogated Long Bow's principals about their political views, family histories, personal travel, Long Bow's making of documentary films, the accuracy of statements on the web site, and what Long Bow does when inaccuracies on the web site are called to its attention. These issues had nothing whatsoever to do with the case, and in the end Long Bow had to get a protective order against such inquiries. JA 2363. Jenzabar's inquiries included whether Long Bow founder Carma Hinton, a history professor who grew up in China, or others in her family, had belonged to the Red Guard or tried to join it, JA 740, or whether any of her teachers, or children with whom she grew up, had parents in the Communist leadership or had become Communist leaders. JA

739. See generally JA 2454-2477. Jenzabar's representatives persistently complained that Hinton would not meet personally with Chai to discuss Chai's belief that Hinton is responsible for what Chai regards as Long Bow's lies about her, JA 540, 593-594, 608-610, a subject related to Jenzabar's propaganda war against Long Bow but with no bearing on its trademark claims. It is no coincidence that the nastiest questions were directed to Hinton, because Chai made clear during her deposition that she holds Hinton personally responsible for the statements about Chai in the film and on the web site that she considers lies, because Hinton knows the most about China and about Chai's role at Tiananmen Square. JA 539-540.

Similarly, Jenzabar used its depositions to inquire at length about statements on the site that it deemed inaccurate, and about Long Bow's dealings with the press. *E.g.*, JA 695-701, 727-728, 732-736. Jenzabar thus abused its access to the discovery power to seek information that is irrelevant to a trademark claim, but useful in propagandizing about Long Bow.

The depositions were re-set under instructions that barred repetition of the political inquiries, while also barring lawyers from raising relevance objections; only objections on clear issues of privilege were to be made. Transcript of July 30 Hearing, 7-8, 15, 21-22, 29-30. Jenzabar nevertheless again asked irrelevant, politically oriented questions. JA 958-959, 967-971.

As the litigation wore on, Long Bow had to

contemplate the possibility that the expense of defending the suit might put it out of business, JA 610-611, until, after paying \$200,000 in legal fees, JA 2362, Long Bow was lucky to find a pro bono lawyer. JA 2481, 2484.

Long Bow moved for summary judgment, making ten different arguments, **each of which would have been sufficient to warrant judgment as a matter of law:**

1. The meta tags were factually irrelevant, because the search algorithm of Google, the overwhelmingly dominant search provider, has ignored keyword meta tags for many years.

2. The speech about Jenzabar on the pages bearing the tags was non-commercial criticism of Jenzabar; hence the use of the meta tags was protected for two separate reasons:

(a) The First Amendment protects truthful non-commercial speech, and the meta tags are truthful -- they denote the pages as being about Jenzabar; and

(b) The trademark laws simply do not apply to non-commercial speech.

3. Jenzabar's claim rests on a theory -- initial interest confusion (i.e, people may click on the link leading to MJP believing that the page is from Jenzabar; but they will know that it is not as soon as they reach the page) -- that is not valid here, if it is ever valid.

4. Construing trademark laws narrowly in light of the First Amendment, when a trademark is used in the title of an expressive work, the trademark holder must show that the mark is not relevant to the content of the work.

5. There was no proof of likelihood of confusion, applying standard likelihood of confusion factors.

6. The use of Jenzabar's name is nominative fair use.

7. Even back when they had causal impact, meta tags were a legally permissible and indeed entirely proper way to call attention to the

content of web pages, just as the title of a book or the subject card in a library card catalogue may do.

8. The claims, filed eight years after the meta tags were first used, were untimely.

Long Bow offered two more reasons for summary judgment against the dilution claims:

9. Dilution claims may only be brought to protect "famous" marks, and a 2006 amendment to the Lanham Act provided that marks are famous only if widely known to "the general consuming public of the United States," but Jenzabar claimed only that its name was widely known in the higher education community.

10. Using a trademark to denote expression about the trademark holder is not dilution -- it reinforces association of the mark with its owner, and hence is not blurring; and use of a trademark to identify the subject of criticism is not tarnishment.

Jenzabar responded to the summary judgment motion by trying to amend its complaint. But even had the amendments been allowed, they would have done Jenzabar no good. Jenzabar tried to avoid the non-commercial speech aspects of the argument by alleging that Long Bow's web site was trying to promote sales of its documentary, and that Long Bow had cynically created a web page about Jenzabar to take advantage of Jenzabar's strong trademark to obtain attention for its web site. JA 253, 255-256, 262, 2178, 2185. These arguments failed, however, because the mere fact that a work contains advertising does not make it commercial speech -- the Boston Globe carries ads and is sold to customers, but that does not make its articles about the Celtics commercial speech. The argument made no sense factually, either, because on the undisputed

facts, when the MJP was created (and when both the meta tags and the title tag were put on the MJP), Jenzabar was just another start-up. JA 616.²

Jenzabar tried to address Google's non-use of keyword meta tags by adding claims about the title tag of the MJP, the one page that appears high in Google's search results, and complaining that the search result itself did not clearly indicate that Long Bow was the author of the MJP, JA 257-258, 273-274, 2187-2190; it also produced an expert who averred that the title tag and meta tags **combined** contributed to the MJP's high Google search rank. JA 985. But these arguments did not affect the outcome both because the expert never opined that keyword meta tags alone had such impact, and because allegations about title tag's impact failed to overcome the many other hurdles to a successful trademark claim. Finally, Jenzabar tried to avoid the flaws in its trademark dilution claim by dropping the Lanham Act dilution claim and alleging state-law dilution instead. But that change did not help because even if state-law famousness has a broader scope than federal-law famousness, the many other grounds for rejecting dilution claims remained, such as that dilution

² Internet users from educational institutions conducting searches using the term "jenzabar" made less than .004% of all hits on Long Bow's site, and **none of them** then reached either of the pages on Long Bow's site that told visitors how to find the companies that distribute Long Bow's films. JA 1417-1418, 1421. The data refute Jenzabar's assertion that use of the mark caused "a substantial increase in web traffic." App. Br. 32. The relative number of hits is so tiny that even the characterization "increase" is unsupported.

law cannot apply to non-commercial speech, that there was still no evidence of dilution, and that fair use is a defense to dilution as it is to infringement.

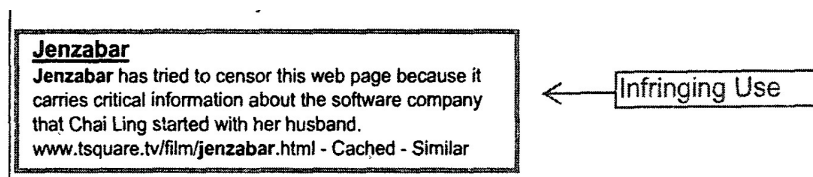
Equally telling was what Jenzabar never showed in opposition to summary judgment. It never showed that any consumer could possibly be confused about whether the actual web page linked from the one search result about which it complained was associated with Jenzabar -- indeed, it admitted that Long Bow's web pages about it were plainly critical. JA 314, 457-458. It never showed that Long Bow had placed its trademarks in HTML tags for pages that were **not** about Jenzabar -- indeed, it admitted that the mark was **only** used in tags of pages about Jenzabar, JA 314 (that is, the tags told the truth about pages that bore them). Jenzabar never showed that, in the ten years that Long Bow had been using the tags, even a single Internet user had experienced confusion about whether the search results themselves were from Jenzabar; nor did it show that even a single customer or potential customer was misled by the search result into reaching Long Bow's criticisms of Jenzabar when that customer was searching only for Jenzabar's own web site. Indeed, Jenzabar's discussion about the "due diligence" in which customers engage before buying Jenzabar's very expensive product, tends to suggest that such customers would have been hoping to find criticism as well as promotional material so that they could better assess whether to buy Jenzabar's products. After three years of litigation,

Jenzabar could offer only its CEO's uninformed hypotheses and speculation about possible confusion of Internet users generally or of its actual or potential customers.

The court below granted summary judgment dismissing Jenzabar's trademark claims on several independent grounds, enumerated 1, 3, 5, 6, and 10 on pages 8 to 9 above; it therefore did not need to reach the other grounds for summary judgment. The Court dismissed Jenzabar's claim under G.L. c. 93A because it had offered nothing besides a repetition of its trademark claims as a basis for finding such a violation. Nor did the Court have to address whether the motion for leave to amend should be granted, because even as amended plaintiff's suit would have been subject to summary judgment.

C. Proceedings After Summary Judgment.

Having won the case, Long Bow for the first time added a description meta tag to its main page about Jenzabar. Because Google sometimes uses such tags in composing part of the search results, the search result linking to the MJP appeared as follows (JA 2710):



In theory, this new listing should have met Jenzabar's purported concern that the original search listing could confuse potential customers using Jenzabar's name as a search term. But Jenzabar argued below, and apparently still contends on appeal, that this is an "infringing" use

of its marks. JA 2710. Nothing could show more clearly that this case is about suppressing public access to truthful criticism, not protecting against deception of consumers.

Long Bow moved for an award of attorney fees under the Lanham Act, arguing that the Lanham Act claims were so plainly meritless, and the lawsuit so obviously a misuse of the trademark law to try to suppress criticism, among other factors, that the case was "exceptional" and hence an appropriate case for an award of attorney fees against the losing plaintiff. Jenzabar opposed, arguing that the judge had been wrong to grant summary judgment, and that in any event no fees should be awarded absent an express finding that it sued in bad faith. The trial court decided not to award fees until this Court had addressed the merits of the case, noting that yet another fee proceeding would be required if summary judgment were affirmed (for fees on appeal). JA 2715-2716.

Jenzabar appeals the summary judgment dismissing its trademark and c.93A claims, but not the dismissal of its defamation claims, whose lack of merit is now final. Long Bow cross-appeals the denial of its attorney fees.

SUMMARY OF ARGUMENT

Jenzabar survived a motion to dismiss its trademark claims through conclusory allegations of a likelihood of confusion, but after discovery ended, its response to the motion for summary judgment was still based on conclusory allegations, suspicions or hypotheses about possible

consumer confusion and possible commercial motivations on Long Bow's part. There are no genuine issues about the material facts; it is the legal conclusions that are at issue, and in that respect Jenzabar's claims are frivolous. Justice Oliver Wendell Holmes said nearly 90 years ago that trademark law does not prevent the use of a word "to tell the truth. It is not taboo." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924). In Justice Holmes' terms, Long Bow's meta tags (and title tag) simply "tell the truth" about the contents of web pages about Jenzabar.

The court below properly granted summary judgment on several independent grounds, and it could have granted judgment on other grounds that Long Bow presented below and argues here as alternative grounds for affirmance:

- Either the First Amendment, or the trademark laws as construed to avoid needless conflict with the First Amendment, condemn Jenzabar's claims to failure (pp. 16-24).
- Jenzabar has not shown any likelihood that the search result that appears on the first page of Google search results for viewers using the search term "Jenzabar" will confuse users into believing that Jenzabar is the sponsor of that result, and in any event the "initial interest confusion" theory on which Jenzabar depends to make such confusion unlawful has no application on the undisputed facts of this case, even if the theory is **ever** valid (pp. 24-39).
- As in every other case where a trademark claim has been brought over use of a company's name in the HTML tags for a web page that relates to that company, the nominative fair use doctrine negates Jenzabar's claims (pp. 39-40).
- Jenzabar's afterthought causes of action based on dilution and c. 93A do not meet statutory or constitutional requirements (pp. 41-45).

-- Jenzabar cannot excuse having waited 8 or 10 years to bring its claims (page 45-46).

The meritlessness of Jenzabar's Lanham Act claims is enough to make the lawsuit "exceptional" and hence subject to a possible award of attorney fees. The groundlessness is so extreme as to imply that Jenzabar sued for improper ulterior motives, motives confirmed by its conduct of the litigation. After affirming the judgment, the Court should remand so the superior court can exercise discretion to award fees (pp. 46-49).

I. THE FIRST AMENDMENT PROTECTS LONG BOW'S TRUTHFUL, NON-COMMERCIAL SPEECH ABOUT JENZABAR.

By seeking an injunction and damages, Jenzabar invoked government power to limit expression by Long Bow and impose monetary remedies because of Long Bow's expression. But court orders are state action, and hence subject to First Amendment limitations. *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 418 (1971); *New York Times v. Sullivan*, 376 U.S. 254, 265-266 (1964). When a defendant is sued for using marks in noncommercial speech, the very application of the trademark laws may violate the First Amendment. *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 32-33 (1st Cir. 1987). Even when trademarks are used in a commercial context, courts construe the trademark laws narrowly to avoid impinging on First Amendment rights. *E.g.*, *Cliffs Notes v. Bantam Doubleday*, 886 F.2d 490, 494 (2d Cir. 1989). Consequently, legal analysis in this case necessarily begins with discussion of the First Amendment.

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

However, the First Amendment does not authorize regulating noncommercial speech simply because it is misleading or hurtful. For example, a political flyer or a newspaper article about a public figure could not be enjoined, or made the basis for an award of damages, simply because some readers would likely find it confusing. *O'Connor v. Superior Court*, 223 Cal. Rptr 357, 361 (Cal. App. 1986). The concept of regulating speech that is or has the potential to be misleading, even though it is not strictly speaking false, is a concept limited to commercial speech, which can be regulated even if it is "not provably false, or even wholly false, but only deceptive or misleading." *Friedman v. Rogers*, 440 U.S. 1, 9 (1979). Thus, although "[a] company has the full panoply of protections available to its direct comments on public issues, . . . there is no reason for providing similar constitutional protection when such statements are

made in the context of commercial transactions." *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60 (1983).

Recognizing these constraints, both the Lanham Act and the caselaw limit the application of trademark law to noncommercial speech. Under the Federal Trademark Dilution Act, "any noncommercial use of the mark . . . shall not be actionable under this section." 15 U.S.C. § 1125(c)(3)(C). See *Universal Communication Sys. v. Lycos*, 478 F.3d 413, 424 (1st Cir. 2007). An infringement claim may be brought only against use of the mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services." 15 U.S.C. § 1114(1)(a). Courts repeatedly hold that this language limits the trademark laws to "commercial" uses and hence avoids conflict with First Amendment protection of noncommercial speech. *Bosley Medical v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003); *CPC Int'l v. Skippy*, 214 F.3d 456, 461 (4th Cir. 2000). When state trademark laws do not expressly exempt noncommercial speech, they should be read in pari materia with federal statutes that do protect such speech; otherwise, they would be unconstitutional as applied to noncommercial parodic or critical uses of protected marks. *L.L. Bean*, 811 F.2d at 33.

Jenzabar responds to this point indirectly, arguing that the Lanham Act is "not limited to profit-making activity." App. Br. 39-40, citing several cases. That is true -- a non-profit or even a political group can violate

the Lanham Act by using some other group's name to solicit donations for itself or sell goods and services.³ Every one of the cases Jenzabar cites on this point involves such use of a rival's trademark. Long Bow does sell films, but that fact neither makes the film's expression commercial speech, nor authorizes application of commercial speech standards to limit expression on pages of its site that just provide information about Jenzabar, or expression in HTML tags that denote the pages.

Commercial speech is speech that proposes a commercial transaction. *United States v. United Foods*, 533 U.S. 405, 409 (2001); *Bolger*, 463 U.S. at 66; *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 455-456 (1978). The fact that noncommercial statements are made in a medium which is itself sold does not mean that the content may be regulated under the standards that apply to commercial speech. "It is well settled that a speaker's rights are not lost simply because compensation is received." *Riley v. Nat'l Fed'n of Blind*, 487 U.S. 781, 801 (1988). After all, it was a paid advertisement that was held to be protected, noncommercial speech in *New York Times v. Sullivan*, 376 U.S. at 265-266.

³Jenzabar also cites *Coca-Cola Co. v. Purdy*, 382 F.3d 774 (8th Cir. 2004), where defendant registered domain names using names of famous companies, not to discuss them, but to post graphic anti-abortion photographs, App. Br. 41-43. Jenzabar ignores both that *Purdy* was decided **only** under the ACPA, 29 U.S.C. § 1125(d), and not as an infringement case, and that the "intent to profit" found in that case included solicitation of donations for the anti-abortion cause and an effort to shake down plaintiffs to give him editorial page space. *Id.* at 786.

Jenzabar's proposed amended complaint alleged that Long Bow used its trademarks in the meta and title tags to attract buyers for films, but in opposition to summary judgment, Jenzabar never cited any **evidence**. Indeed, although its expert reviewed Long Bow's server logs to determine how many potential customers had reached Long Bow's web site after using the search term "jenzabar," that expert said nothing about how many users then looked at either of the two pages on the web site that provide information about how to obtain Long Bow's film. Long Bow's expert ascertained that **none** of those Internet users did so. JA 1417-1418, 1421.

Jenzabar's self-important hypothesis that Long Bow deliberately discussed Jenzabar for the very purpose of drawing Internet users to a web site where they might find out how to buy Long Bow's films fails given the absence of any evidence that, when the page was first created in 1999 and the tags were placed on it, Jenzabar was any more than just another Internet startup. JA 903-904, 906. The contention that Long Bow deliberately uses its Jenzabar-related pages to draw traffic to a film-selling web site is also belied by the fact that only a tiny, tiny fraction of all visitors or hits to its web site come as a result of searches using the term "jenzabar." JA 645-646, 1417-1418. Moreover, even were it true that Long Bow deliberately discussed Jenzabar to attract interest, that would not make its speech about Jenzabar commercial. The Boston Globe may hope that coverage of the Celtics and the

Patriots will gain it readers, but that does not make its articles on that subject commercial speech. For all these reasons, Long Bow's speech at issue is noncommercial.

Its speech about Jenzabar is also truthful. The web pages themselves are conclusively non-defamatory, with the dismissal of Jenzabar's defamation claims having become final. And even assuming Jenzabar's argument that the meta tags and title tag cause Internet users to find the web page about it, the speech in the tags themselves is truthful -- it tells search engine users who conduct Google searches, that here, among the more than sixty or seventy thousand pages listed in the Google search results, is another place where they can find information about Jenzabar. Because that is a truthful statement, and a noncommercial statement, the First Amendment forbids a court order suppressing it or imposing damages because of its alleged effects.⁴

⁴ Jenzabar faults the court below for noting that keyword meta tags do not affect search ranking and not mentioning possible impact of title tags on ranking, but Jenzabar never showed that the mark's use in keyword meta tags was alone a reason why the MJP showed up in the first page of Google search results. It has been well-established for many years that Google ignores keyword meta tags. JA 1277-1279, 1329-1333; *Ascentive LLP v. Opinion Corp.*, 2011 WL 6181452 (E.D.N.Y. Dec. 13, 2011), at *12, citing *McCarthy on Trademarks* § 25:69 (4th ed. 2003). Jenzabar's proof rests entirely on affidavits of a purported expert, provided only after discovery closed, that Long Bow showed were artfully drafted to seem to say more than they did, and to overstate his sources. JA 1759-1766, 1847-1850. The expert opined only that keyword meta tags **together with the title tag** boosted the MJP's search ranking, JA 1755, and his final affidavit admitted he could not even say how much effect keyword meta tags had. JA 1850. Because Jenzabar initially limited its claims to the meta tags, JA 757, and asserted the title tag claim

Jenzabar denies that it seeks to suppress speech, App. Br. 12, but that is exactly what it is doing -- trying to suppress the true statement that the MJP is a page where information about Jenzabar can be found. Even more important, Jenzabar seeks to suppress public access to the criticism of Jenzabar. In essence, Jenzabar, argues that people can say anything they like about Jenzabar on an Internet consisting of billions and billions of web pages, so long as the location of that criticism is not available to prospective customers on the first page of Google search results. As amicus Digital Media Law Project argues, that is just as much an effort to suppress criticism as an injunction against the web page itself would be, and the First Amendment does not allow it.

II. CONSTRUING THE STATUTE IN LIGHT OF THE FIRST AMENDMENT, JENZABAR'S INFRINGEMENT CLAIMS CANNOT STAND.

Even when the Lanham Act is deemed applicable to speech because, for example, the speech is directed at criticizing a direct competitor or the speech helps advertise a work that is sold commercially, federal courts of appeals have developed various approaches to accommodate First Amendment concerns. For example, in *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 552-553 (5th Cir. 2001), the court drew a distinction based on whether speakers had an economic motive for the speech,

only after discovery closed, the court below could properly have declined to consider this new claim of causative impact. Jenzabar has not raised the discretionary failure to explicitly allow the amended complaint as an issue on appeal.

holding that the Lanham Act could apply if the purpose of the speech itself was to sell more products, but not if the primary purpose of the speech was to express criticism of the trademark holder. And *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), accommodated the First Amendment interests of authors and artists through a rule governing infringement claims against artistic or literary products made for sale, such as mass publications, movies and musical recordings. Under this approach, now adopted by many circuits, the Lanham Act cannot apply unless the trademark in the title "has no artistic relevance to the underlying work whatsoever or, if it has some artistic relevance, unless the title **explicitly** misleads as to the source or the content of the work." *Id.* (emphasis added); *E.S.S. Entertainment 2000 v. Rock Star Videos*, 547 F.3d 1095 (9th Cir. 2008); *Mattel v. Walking Mt. Prods.*, 353 F.3d 792, 807 (9th Cir. 2003); *ETW Corp. v. Jireh Pub.*, 332 F.3d 915, 920 (6th Cir. 2003); *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 664 (5th Cir. 2000).

Under *Amway* or *Rogers*, the undisputed facts require affirmance of Long Bow's summary judgment. Taking first the *Amway* standard, Chai and her company are a legitimate subject for public discussion, and the Jenzabar-related pages on the tsquare web site simply discuss the software company that she founded and reproduce information about that company without selling any goods or services. Moreover, the trademark use in question -- the tags -- fairly denotes the subject matter of the web pages, just

as, following the analogy used by Jenzabar's expert, JA 991 n.6, the subject and title cards in a library's card catalog could properly use a trademark to identify the book in question to library searchers. And Long Bow has no intent to mislead search engine users about the subject of the web pages. Indeed, as soon as Long Bow learned about Jenzabar's concerns, it added a prominent disclaimer of affiliation. JA 315.

Similarly, applying the *Rogers* standard, because the web pages are about Jenzabar, there is no way that Long Bow could discuss Jenzabar without using Jenzabar's name. The undisputed facts thus show no explicit deception, and, indeed, painstaking care **not** to deceive. Summary judgment should be affirmed on this standard as well.

III. JENZABAR'S TRADEMARK CLAIMS REST ON A LEGALLY UNTENABLE CLAIM OF INITIAL INTEREST CONFUSION.

Jenzabar does not contend -- and it has no evidence whatsoever -- that a reasonable potential customer could visit the Jenzabar-related pages and conclude that Jenzabar is affiliated with that page. In the court below, it readily conceded that its greatest worry is that a potential customer might find the page while doing a due diligence investigation, read its content, and decide that the criticisms make doing business undesirable. JA 853-856. On appeal, Jenzabar admits that the confusion on which it depends is the mental state of an Internet viewer looking at the Google search result and deciding to click on that link, regardless of the fact that confusion is

dispelled immediately on clicking through to the underlying page. App. Br. 21. Jenzabar's appeal thus rests squarely on the theory of initial interest confusion ("IIC"); if the Court rejects that argument, as it should, Jenzabar's appeal must be rejected with it.

Courts are increasingly skeptical about whether IIC is **ever** a tenable basis for finding infringement, so long as it is clear to customers by the point of sale that the parties are unrelated. *Suntree Technologies v. Ecosense Int'l.*, 2011 WL 2893623 (M.D. Fla. July 20, 2011). IIC is "predicated on multiple mistaken and empirically unsupportable assumptions about searcher behavior," and is a hopeless hodgepodge of theories that are not applied consistently by the courts. Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L. J. 507, 559-575 (2005). But even if IIC is **ever** valid, it cannot succeed on the undisputed record in this case.

In the Internet context, some courts say that IIC occurs when a consumer looking for a trademark holder is drawn by use of the mark in HTML code or similar means to a site that is **not**, once viewed, confusing about source. Nonetheless, the consumer may decide that he is interested in the goods or services marketed there, and thus stay and look further **despite** the lack of confusion. *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036, 1062 (9th Cir. 1999). The hypothetical user decides not to keep looking for the trademark holder, not because of any illusions about who sponsors the web site, but because

the web site provides other attractive inducements. For example, the consumer may perceive that the current web site offers cheaper prices for functionally equivalent goods, or higher quality goods. However, this analysis does not support Jenzabar here, for several reasons.

First, IIC applies only when two commercial competitors sell similar goods to the same set of consumers, *Nissan Motor v. Nissan Computer*, 378 F.3d 1002, 1019 (9th Cir. 2004); *Checkpoint Sys. v. Check Point Software Tech.*, 269 F.3d 270, 296-297 (3d Cir. 2001), and has less force when customers are likely to exercise care in making their purchasing decisions. *Id.* Both the First and Fourth Circuits, while expressing considerable skepticism about whether the doctrine of IIC is ever valid, avoided deciding that question "[w]hen an alleged infringer does not compete with the markholder for sales." *Hasbro, Inc. v. Clue Computing*, 232 F.3d 1, 2 (1st Cir. 2000); *Lamparello v. Falwell*, 420 F.3d 309, 317 (4th Cir. 2005). See also *Hearts on Fire Co. v. Blue Nile*, 603 F. Supp. 2d 274, 287 (D. Mass. 2009) ("[I]nitial interest confusion can support a claim under the Lanham Act -- but only where the plaintiff has plausibly alleged that consumers were confused, and not simply diverted."). Long Bow does not sell rival goods but simply sets forth historical facts and opinions about Jenzabar. Long Bow does not sell "complex enterprise software." JA 243. Jenzabar has not made or sold documentaries, about China

or otherwise. JA 249, 538. The companies simply do not compete.⁵ Moreover, it is undisputed that potential customers for Jenzabar's products exercise great care before making purchases. JA 323. In these circumstances, the possibility of IIC is virtually non-existent.

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

This analysis became outdated through both changes in the sophistication of Internet viewers and developments

⁵Jenzabar's appellate brief (at 27) asserts that Jenzabar "has begun to expand its products to include the creation and distribution of educational content, such as films." Not only does the cited evidence, an affidavit submitted by Maginn after discovery closed, not use the word "films," but during discovery Jenzabar repeatedly conceded the facts cited in the text; Maginn admitted in Jenzabar's 30(b)(6) deposition that Long Bow has "no business interest that overlaps with us." JA 439.

in search technology. Although it issued *Brookfield*, the Ninth Circuit has repudiated the view that Internet viewers are naive or unsophisticated. *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002). And *Interstellar Starship Serv. v. Epix*, 304 F.3d 936, 942 (9th Cir. 2002), retreated from the notion that IIC was an independent violation that could be found without reference to other factors. Many courts now recognize that search engines now provide an excellent index for the World Wide Web, or at least large portions of it, and acknowledge the trivial consequences of landing at the "wrong" website as a result of initial interest confusion. *E.g.*, *Strick Corp. v. Strickland*, 162 F. Supp.2d 372 (E.D. Pa. 2001); *Bihari v. Gross*, 119 F. Supp.2d 309, 320 n.15 (S.D.N.Y. 2000). As *Strick* stated:

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

162 F.Supp.2d at 377 (quotation marks and citations omitted).⁶

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

Recent decisions consistently follow this analysis in declining to find initial interest confusion based on search engine results, because

in the age of FIOS, cable modems, DSL and T1 lines, reasonable, prudent and experienced internet consumers are accustomed to such exploration by trial and error. They skip from site to site, ready to hit the back button whenever they're not satisfied with a site's contents. They fully expect to find some sites that aren't what they imagine based on a glance at the domain name or search engine summary. Outside the special case of ... domains that actively claim affiliation with the trademark holder, consumers don't form any firm expectations about the sponsorship of a website until they've seen the landing page -- if then.

Network Automation v. Advanced Systems Concepts, 638 F.3d 1137, 1152-1153 (9th Cir. 2011), quoting *Toyota Motor Sales v. Tabari*, 610 F.3d 1171, 1179 (9th Cir.2010).

Because these decisions are from the Ninth Circuit, whose *Brookfield Entertainment* decision spawned both the doctrine of IIC and its widespread application to meta tags, these cases are especially telling.⁷ Similarly, the Second Circuit has cut back IIC in the Internet context by demanding a showing of intentional diversion, evidence that is lacking from this record:

Because consumers diverted on the Internet can more readily get back on track than those in actual space, thus minimizing the harm to the owner of the searched-for site from consumers becoming trapped in a competing site, Internet initial interest confusion requires a showing of intentional deception.

⁷*Accord, Fancaster Corp. v. Comcast Corp.*, 2011 WL 6426292, *25-*26 (D.N.J. Dec. 22, 2011) ("the confusion one encounters on an Internet search engine is a twenty-first century version of that experienced when searching the phone book"); *Ascentive, LLC v. Opinion Corp.*, 2011 WL 6181452 (E.D.N.Y. Dec. 13, 2011).

Savin Group v. Savin Corp., 391 F.3d 439, 462 n.13 (2d Cir. 2005).

This context easily distinguishes this case from *Planned Parenthood v. Problem Pregnancy*, 398 Mass. 480 (1986), where customers testified that they came to an office building looking for plaintiff and used defendant's services before figuring out they were in the wrong office. *Id.* at 489-490. The decision does not endorse IIC (and says nothing about disclaimers, although Jenzabar discusses the case in that part of its brief (at 36)).⁸

Moreover, each of Jenzabar's meta tag cases invoking the doctrine of IIC, as well as the cases cited by its supporting amicus Patent Law Association, involved a **commercial competitor** of the trademark holder who used meta tags to **falsely** portray its own web page as being about the trademark holder. By contrast, every one of the meta tag cases in which IIC was invoked to forbid an Internet critic from calling Internet users' attention to the existence of a critical page was decided in favor of the critic. *Faegre & Benson v. Purdy*, 367 F. Supp.2d 1238, 1247 (D. Minn. 2005); *J.K. Harris & Company v. Kassel*, 253 F.Supp.2d 1120 (N.D. Cal. 2003); *Bihari v. Gross*, 119 F. Supp.2d at 320; *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp.2d 1161, 1165 (C.D. Cal. 1998). Indeed,

⁸Problem Pregnancy's services also directly competed with plaintiff; thus, if IIC were a valid doctrine, its application here would not affect Long Bow's entitlement to summary judgment. The finding of deliberate intent to confuse, *id.* at 488, further distances *Planned Parenthood* from this case.

Brookfield recognized that its holding about the misuse of meta tags would be different if the mark were used in aid of comparative advertising about the trademark holder. 174 F.3d at 1065-1066.⁹

This Court should consider the social costs of applying IIC when it is a critic that has used HTML tags to bring its comments about the trademark holder to the attention of search engine users. Not all Internet users conduct searches using a trademark to find the official web site of the trademark holder. Jenzabar's own evidence shows that its prospective customers use the Internet to conduct "due diligence" -- that is, to find the bad as well as the good -- because customers in the "nonprofit world of higher education . . . care about who they are doing business with." JA 324. The information on the MJP could be exactly what such potential Jenzabar customers are looking for. And each page of search results in the record reflects the existence of more than 60,000 or even

⁹ An injunction against noncommercial use of the trademark pursuant to the doctrine of initial interest confusion, or an award of damages based on profits lost because the critic was too persuasive, would raise serious First Amendment concerns. Even if a compelling government interest were served by forbidding mere "likelihood of confusion," and there were thus a constitutionally permissible basis for issuing an injunction against noncommercial speech, the constitutional basis for the injunction is even more problematic if the confusion caused by the trademark is merely ephemeral. If, for example, the confusion caused by use of the trademark in a meta tag is dispelled as soon as the viewer begins to read the web page and recognizes that the site comments on the markholder, rather than promoting the markholder's viewpoint, no "compelling government interest" would be served by enjoining use of the meta tag.

70,000 web pages relevant to the search term "jenzabar." Not only will no rational user assume that every one of these pages is from Jenzabar; but the first result on every result list is Jenzabar's own official web site, and several other pages that Jenzabar sponsors are also on that first page of results. If IIC keeps a single critical site off this first page of search results, trademark law will deprive the public of access to information that it wants, not to speak of suppressing Long Bow's noncommercial speech. The Fourth Circuit said,

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

Lamparello, 420 F.3d at 317-18 (quoting *CPC Int'l v. Skippy*, 214 F.3d 456, 462 (4th Cir. 2000), quoting *L.L. Bean*, 811 F.2d at 33.¹⁰

IV. JENZABAR'S CLAIMS ALSO FAIL UNDER A TRADITIONAL CONFUSION ANALYSIS.

Jenzabar reprints the search result for the MJP, App. Br. 2, 9, and repeatedly asserts that Internet users are likely to believe that it links to one of Jenzabar's own pages. *Id.* 2, 3, 12, 15, 19, 20, 21, 32, 35, 36, 37, 38,

¹⁰Jenzabar cites *PETA v. Doughney*, 263 F.3d 359 (4th Cir. 2001), App. Br. 43, without acknowledging that the registration of *peta.org* was done to shake PETA down for money, and that the Fourth Circuit later distinguished *PETA* in *Lamparello*, *supra*, holding that the non-confusing noncommercial criticism on the web site itself precluded a trademark infringement or dilution claim.

43. But it cites no evidence for this conclusion. There is no evidence about how actual Internet users (other than its own CEO) perceive the search listing. Indeed, Jenzabar's expert witness had nothing to say on the subject; at best he opined only about how the search listing got to that position in the search rankings.

Instead, Jenzabar tries to apply the traditional multi-factor likelihood of confusion analysis to the MJP search result that Jenzabar posits as the basis for initial confusion. But the superior court also properly granted summary judgment based on those factors. Jenzabar faults the judge below for not treating the "Internet trinity" factors as being alone the most important, citing decisions from the Ninth Circuit, App. Br. 23, even though the Ninth Circuit itself has since disavowed the concept. *Network Automation*, 638 F.3d at 1148. In any event, neither the trinity nor the other factors favor Jenzabar. We discuss them in the same order as Jenzabar does.¹¹

A. Similarity of Marks. Jenzabar contends that Long Bow's use of Jenzabar's name to talk about Jenzabar solidly positions this factor in Jenzabar's favor. What

¹¹Contrary to Jenzabar's brief, at 22, federal courts often allow summary judgment where the undisputed facts show that the likelihood of confusion factors -- which are legal conclusions -- largely or overwhelmingly favor one side. Many First Circuit cases cited elsewhere in this brief, including *Winship Green*, *Astra Pharmaceutical*, *Hasbro* and *Pignons*, upheld summary judgment because the factors did not show likelihood of confusion. See also *Peckham v. Boston Herald*, 48 Mass. App. Ct. 282, 288 (1999) (summary judgment favored lest protracted litigation chill free speech).

Jenzabar ignores is that, when a trademark claim is brought against a parody that uses the mark to comment on the trademark holder, similarity between the parties' two marks does not support finding a likelihood of confusion, because similarity "is the essence of a parody." *Louis Vuitton v. Haute Diggity Dog*, 507 F.3d 252, 262 (4th Cir. 2007). quoting *PETA v. Doughney*, 263 F.3d at 366. Similarly, when the purpose of using a mark is to denote a page discussing the trademark holder, only the mark itself will serve that legitimate purpose, and so the identity between Long Bow's use of the mark and the mark itself does not support Jenzabar here. Otherwise, the similarity factor would always favor a finding of confusion in cases where the mark is used to comment on the trademark holder, which makes no sense.

B. Similarity of goods. Long Bow's goods -- documentaries about China -- have no similarity whatsoever to Jenzabar's "complex enterprise software solutions." JA 310, 322. As noted *supra* at 27, after Jenzabar admitted in discovery that there is no overlap between the parties' business interests, it responded to the motion for summary judgment with a conclusory affidavit claiming that it was considering expanding into distributing educational content. The trial judge properly refused to allow this ruse to defeat summary judgment.

C. Overlap of channels of trade and advertising. The parties' channels of trade and their advertising do not overlap. Long Bow's films are available through

distributors that sell the films to museums, libraries, and schools. JA 310. Jenzabar has produced no evidence that it sells computer software through any channel for distribution of documentary films. To the contrary, Jenzabar clearly is a profit-seeking enterprise that sells its products through traditional commercial channels, including through a sales force. JA 322. Jenzabar does not sell or advertise through Long Bow's web site. *Id.* Jenzabar also admitted that its sales efforts are concluded through meetings with university committees. JA 1013. Jenzabar argues that because both parties have web sites, this factor should be deemed to favor Jenzabar. (App. Br. 27-28). However, in an age in which almost every company uses the Internet for marketing, if that fact is enough to make the "similarity of advertising" favor a finding of likely confusion, then this factor will always favor the plaintiff, and it will no longer help distinguish cases of no confusion from cases of likely confusion. The court should not accept this argument.

D. Strength of Jenzabar's Mark. Jenzabar's reliance on the strength of its mark ignores the cases holding that, like the similarity factor, this factor favors defendants who use the mark to comment on the plaintiff, for two reasons. First, the very strength of the mark helps consumers understand that a parody or other commentary is offered by a critic, not by the trademark owner. *Hormel Foods Corp. v. Jim Henson Productions*, 73 F.3d 497, 503 (2d Cir. 1996). Second, the more well-known

the plaintiff is, the stronger the public interest in the freedom of others to criticize the plaintiff, which simply cannot be done without using the mark.

E. Prospective Purchasers. Contrary to Jenzabar, App. Br. 30, there is no dispute about relevant facts -- Jenzabar sells its products to universities, but committees of technical specialists, administrators and faculty leaders convene to make these purchasing decisions; some of Long Bow's purchasers are university professors who want to show the film to their students. JA 337; App. Br. 27. Jenzabar ignores the relevant law on this factor: A corporation or non-profit institution cannot be treated as an undifferentiated whole; it is the particular purchasers within the entity that matter. *Astra Pharm. Prod. v. Beckman Instruments*, 718 F.2d 1201, 1206-1207 (1st Cir. 1983). Moreover, because Jenzabar software is an expensive product aimed at professional buyers who take great care in their purchase decisions, JA 323-324, confusion is very unlikely. *Merchant & Evans v. Roosevelt Bldg Prods.*, 963 F.2d 628, 636-637 (3d Cir. 1992); *Pignons S.A. v. Polaroid Corp.*, 657 F.2d 482, 489 (1st Cir. 1981).

F. Long Bow's Intent. Contrary to Jenzabar's apparent assumption, App. Br. 31, this factor does not turn on whether Long Bow showed an intent to copy the Jenzabar mark; otherwise, all commentary would show the sort of intent that supports likelihood of confusion. Rather, what matters is an intent to confuse. *A & H*

Sportswear v. Victoria's Secret Stores, 237 F.3d 198, 225-226 (3d Cir. 2000). See also *Sensient Technologies Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 767 (8th Cir. 2010). "There is a considerable difference between an intent to copy and an intent to deceive." *Starbucks Corp. v. Wolfe's Borough Coffee*, 588 F.3d 97, 115 (2d Cir. 2009), quoting *McCarthy on Trademarks* § 23.113. There is no evidence of such intent. And Long Bow's response to Jenzabar's expression of concern about confusion by posting a disclaimer helps show Long Bow's lack of intent to confuse. *Smith v. Wal-Mart Stores*, 537 F. Supp.2d 1302, 1338 (N.D. Ga. 2008). Indeed, the First Amendment requires consideration of the use of disclaimers when they can dispel confusion. *Consumers' Union v. General Signal Corp.*, 724 F.2d 1044, 1053 (2d Cir. 1983).

G. No Evidence of Actual Confusion. No evidence exists of actual confusion of any kind, much less confusion about affiliation or about product origin, sponsorship, or approval. JA 326-328. The absence of such evidence, even for web pages and tags that have been used for ten years, is very strong evidence of no likelihood of confusion. *Aktiebolaget Electrolux v. Armatron Int'l*, 999 F.2d 1, 4 (1st Cir. 1993); *A&H Sportswear*, 237 F.3d at 227; *Kendall-Jackson Winery v. E&J Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir. 1998); *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

Jenzabar puts forward a fragment of its expert witness's affidavit showing the number of Internet users

who came to the Long Bow web site as a result of using Jenzabar as a search term. But the Fifth Circuit has refused to accept such expert testimony as showing actual confusion, because the expert was unable to say whether these hits actually or initially confused any customers. *Southwest Recreational Indus. v. FieldTurf, Inc.*, 2002 WL 32783971, at *7 (2002). Moreover, Jenzabar's assumption that any Internet users from educational institutions who viewed Long Bow's web site as the result of using the search term "Jenzabar" must have suffered confusion about source is contradicted by Jenzabar's ready admission that its prospective customers engage in due diligence, which includes looking for neutral and even critical web sites, so that they can assess whether Jenzabar is the right software provider. Consequently, there is no evidence of actual confusion. Given the ten years that Long Bow's web page used the tags, such absence is compelling evidence that there is no likelihood of confusion.

* * *

In sum, the confusion factors do not show that the MJP's search result "carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care" into believing it leads to Jenzabar's own web site. *Winship Green*, 103 F.3d at 201. Jenzabar lacks evidence of a "'substantial' likelihood of confusion" -- a mere possibility is not enough. *Id.* at 200. Summary judgment was therefore proper.

V. LONG BOW'S USE OF THE MARKS IS PROTECTED AS NOMINATIVE FAIR USE.

Nominative fair use permits Long Bow to use the Marks to refer to Jenzabar and to index and describe the contents of a web page about Jenzabar. *See, e.g., Century 21 Real Estate Corp. v. LendingTree*, 425 F.3d 211, 228-31 (3d Cir. 2005). This doctrine rests on the premise that:

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

New Kids on the Block v. New Am. Publ'g, 971 F.2d 302, 306-307 (9th Cir. 1992).

Several courts have specifically upheld the use of trademarks in the meta tags of a web site where the defendant had a legitimate reason to use the mark to identify the subject matter of the site. *Playboy Enters. v. Welles*, 279 F.3d 796, 803-04 (9th Cir. 2002); *J.K. Harris*, 253 F Supp.2d 1120; *Bihari*, 119 F. Supp.2d at 321-24. *See also Lycos*, 478 F.3d at 424-25 (rejecting trademark claim by company criticized on Internet message board because "trademark law should not prevent Lycos from using the 'UCSY' mark to indicate that a particular company is the subject of a particular message board.")

Jenzabar faults the trial judge's application of the nominative fair use doctrine asserting that Long Bow "used more of the mark than necessary," but each of the uses that it treats as excessive is a perfectly legitimate use

of the mark -- the title tag "Jenzabar" fairly summarizes the content of the page, and the three variations in the keyword meta tags simply reflect three names by which plaintiff was originally known, JA 652, and indeed still uses. App. Br. 5. Plaintiff also faults Long Bow for the way the web site was described in the Google search result, but there is no evidence that Long Bow, as opposed to Google, chose that description; indeed, the Court can take notice that the description is just the first several words on the MJP. JA 380. Nor is the description in the search result misleading -- the web page does, in fact, provide information about Chai and Jenzabar, and contain excerpts and links. Most important, there is nothing about this description that implies that Jenzabar is the source of the page -- it is not misleading about source.¹²

¹² Jenzabar argues that Long Bow should have put its own name in the page description or title in the search listing, App. Br. 8, 9, but **that** would have been misleading, because the page is not about Long Bow, it is about Jenzabar. Jenzabar falsely suggests (as usual, without citing evidence) that the appearance of the term "Jenzabar" in bold type is attributable to Long Bow; in fact, as Long Bow showed below, the bold type is an artifact of the search term being "jenzabar". JA 332-333, 1284-1285, 2218, 2297. Indeed, although Jenzabar repeatedly complains about what Long Bow supposedly placed in the search result description, it is Google's algorithm that defines that "snippet," pulling out a group of text from the page that includes the search term (or from the description tag, if there is one and its contents are most relevant to search term). *Results page full overview*, <http://support.google.com/websearch/bin/answer.py?hl=en&answer=35891>. Jenzabar never produced evidence showing that Long Bow created the result listing (and again, its expert said nothing about it). Jenzabar's argument that the inclusion of its mark in the Internet address for the MJP could have confused consumers was rejected in *Interactive Products Corp. v. a2z Mobile Office Solutions*, 326 F.3d 687, 698 (6th Cir. 2003).

VI. JENZABAR LACKS A TENABLE DILUTION THEORY.

In addition to the fact that a dilution claim cannot, consistent with the First Amendment, be applied to a web page that comments on the trademark holder without causing actionable confusion, *L.L. Bean, supra*, dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). "The basic idea of blurring is that the defendant's use of the plaintiff's mark causes the public no longer to think only of the plaintiff's product upon seeing the famous mark, but rather to associate both the plaintiff and the defendant with the mark." *Hasbro, Inc. v. Clue Computing*, 66 F. Supp. 2d 117, 134 (D. Mass. 1999), *aff'd*, 232 F.3d 1 (1st Cir. 2000). A classic example of dilution by blurring is the use of a famous mark (like Coca-Cola) to signify goods that are dissimilar to those with which the famous mark is associated (like shoes): "Coca-Cola Shoe Co." Association between the mark and shoes in consumers' minds might impair the Coca-Cola mark's distinctiveness and diminish its ability to serve as a singular identifier of source. But nominative use of a trademark to criticize the trademark owner does not lead to blurring; quite to the contrary, it reinforces the association between the mark and the markholder. *See Hormel Foods*, 73 F.3d at 506, citing *Jordache Enterprises v. Hogg Wyld*, 828 F.2d 1482, 1489-1490 (10th Cir. 1987).

No evidence exists that Long Bow's use of the marks as tags on a web page about Jenzabar could impair their ability to identify the products of Jenzabar. Jenzabar has no evidence -- expert testimony, consumer surveys, or otherwise -- to support a claim of dilution by blurring. Nor is such a claim even theoretically possible given the undisputed nature of Long Bow's use of the marks as meta tags on a webpage about Jenzabar. People viewing the MJP will continue to associate the marks exclusively with "complex enterprise software solutions"; they will not perceive the marks as identifying documentary films about China. Jenzabar has no prospect of proving that the meta tags are likely to cause dilution by blurring.

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

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

which are of shoddy quality or which conjure associations that clash with the associations generated by the owner's lawful use of the mark.

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

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

As with blurring, no evidence exists that Long Bow's use of the marks as meta tags is likely to cause dilution by tarnishment. Long Bow simply has not "linked [the marks] to products" at all, much less to products "which are of shoddy quality or which conjure associations that clash with the associations" generated by Jenzabar's own efforts. *L.L. Bean*, 811 F.2d at 31. Jenzabar's feeble interrogatory response on this point demonstrates the misguided nature of its tarnishment claim (JA 857):

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

Again, Jenzabar is harping on the content of MJP and its worry that readers of news articles about Jenzabar that MJP cites will form a negative impression of Jenzabar. This concern simply is not a trademark claim. *L.L. Bean*, 811 F.2d at 31. As the First Circuit has explained, the

injury Jenzabar asserts is not a trademark injury:

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

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

VII. JENZABAR HAS NO TENABLE CHAPTER 93A CLAIM.

The superior court properly granted summary judgment dismissing Jenzabar's chapter 93A claim because the claim was wholly derivative of its trademark claims. To be sure, a chapter 93A claim need not be a trademark claim, but in the court below Jenzabar made only trademark arguments as a basis for chapter 93A relief, and its appellate brief manifests the same shortcoming. Moreover, as the First Circuit held, a state law trademark claim that does not meet federal Lanham Act standards for infringement or dilution, limited as they are to protect free expression, would fail First Amendment scrutiny. *L.L. Bean*, 811 F.2d at 33. With no prospect of showing that Long Bow's use of the marks is unlawful, much less a product of bad faith, Jenzabar cannot prevail on its chapter 93A claim.

Moreover, proof of "loss of money or property" is an explicit statutory requirement for a claim under c. 93A § 11. See *Lumbermans Mut. Cas. Co. v. Offices Unlimited*, 419 Mass. 462, 468 (1995) (affirming summary judgment based on failure to prove loss); *Fruzzo v. Landenberger*, 61 Mass. App. Ct. 814, 823 (2004). Jenzabar has no evidence of "loss of money or property" resulting from

Long Bow's use of the marks as meta tags. JA 329-331. It could not identify a single customer that saw Long Bow's site because of the search results and consequently did not do business with Jenzabar. JA 490-494.

VIII. THE TRADEMARK CLAIMS WERE BROUGHT TOO LATE.

The statute of limitations for trademark claims is four years. *Kusek v. Family Circle*, 894 F. Supp. 522, 530 (D. Mass. 1995). Even if keyword meta tags made a difference in search ranking when they were first placed on the MJP, Jenzabar did not file its keyword meta tag claim until eight years after they were first placed on the MJP, and it did not propose its amended complaint adding title tag claims until **ten** years after the tag was put on the page. The single publication rule, *Keeton v. Hustler Magazine*, 828 F.2d 64, 65 (1st Cir. 1987), applies to Internet communications. *Abate v. Maine Antique Digest*, 2004 WL 293903, at *1-2 (Mass. Super., Jan. 26, 2004); *Christoff v. Nestle USA*, 213 P.3d 132 (Cal. 2009), *Nationwide Bi-Weekly Admin. v. Belo Corp.*, 512 F.3d 137, 144 (5th Cir. 2007). Consequently, summary judgment can be affirmed on this alternate ground.¹³

Jenzabar publicly admitted to the Boston Globe why it waited so long to sue (JA 1160):

¹³Below, Jenzabar tried to escape the limitations issue by misciting evidence as showing that it did not discover high Google placement of the MJP until 2006. JA 2221. In any event, as Long Bow showed below, *id.*, the discovery rule doesn't apply to widely available materials. *Flynn v. AP*, 401 Mass. 776, 781 (1988).

Long Bow has gratuitously maligned Ling Chai for decades, and now that she has the resources to fight back, they don't like it.

When Long Bow began its use of the marks, Jenzabar was just an Internet startup that did not have the resources to pour hundreds of thousands of dollars of legal fees into this case. But that is no excuse for waiting until it had grown into a company with hundred of employees that could afford to spend millions of dollars on charity, App. Br. 5, as well as on oppressing Long Bow with the legal expenses of a frivolous trademark lawsuit.

IX. THE CASE SHOULD BE REMANDED TO ALLOW THE SUPERIOR COURT TO ADDRESS IN THE FIRST INSTANCE WHETHER THIS CASE IS "EXCEPTIONAL" AND HENCE SUBJECT TO AN AWARD OF ATTORNEY FEES UNDER THE LANHAM ACT.

In response to the motion for summary judgment on the issue of dilution, which was based in part on the fact that Jenzabar could not meet the definition of "famous" that Congress had adopted the year before suit was filed, Jenzabar dropped that part of its Lanham Act claim, and the court below properly granted summary judgment against the remaining Lanham Act claims. But because Jenzabar had already filed its appeal from the decision on the merits, that court declined to decide whether fees should be awarded, both because it felt that the appellate court should first address whether Jenzabar had sufficient grounds for suing (Jenzabar's main ground for opposing fees was that the summary judgment was erroneous), and because a second fee proceeding would be inevitable on the issue of fees for time spent on appeal. JA 2715-2716.

Long Bow cross-appeals the denial of fees. *Yankee Candle Co. v. Bridgewater Candle Co.*, 140 F. Supp. 2d 111, 121 (D. Mass. 2001), *aff'd other grds.*, 259 F.3d 25 (1st Cir. 2001), laid out a multi-factor test from which the determination of "exceptional" proceeds:

By using the phrase "equitable considerations" in the Senate Report to describe what is "exceptional," "Congress intended to invoke the tradition of equity, a hallmark of which is the ability to assess the totality of the circumstances in each case.".... As the Third Circuit has stated, "whether a case qualifies as exceptional ultimately turns on consideration of the equities in full."... The court may examine the plaintiff's "litigating conduct,"...; whether plaintiff's behavior included "economic coercion,"...; plaintiff's use of "groundless argument[s]," ...; failure to cite controlling law,..., and the generally "oppressive" nature of the case,.... A showing of bad faith would satisfy this standard, but is not necessary.....

Id. at 121 (citations omitted).

See also *Empire Today v. National Floors Direct*, 788 F.Supp.2d 7, 31 (D.Mass. 2011).

These factors were surely met in this case. This action was a classic SLAPP suit -- a suit brought not in any realistic expectation of victory, but in the hope that the very expense of litigation might wear down the defendant and force it to negotiate its way out by promising to retract criticism. The groundlessness of the suit has been addressed throughout this brief. The fact that there are seven different reasons why the Lanham Act suit was groundless -- the six independent grounds for affirming discussed above, plus the dropping of the Lanham Act dilution claim in response to the summary judgment

motion -- is more than enough reason all by itself to deem the case "exceptional" given that this is a lawsuit over an expressive use of the mark. *Mattel, Inc. v. Walking Mt. Prods.*, 353 F.3d at 816.

Plaintiffs' own papers as well as their public statements during the litigation make clear that the suit was aimed at responding to what they deemed false criticisms, and at preventing their prospective customers from learning about those criticisms and hence, perhaps, deciding not to do business with Jenzabar. See also JA 485-486, 544. This is an improper purpose for a trademark case. *Lycos*, 478 F.3d at 423. The pervasive misuse of discovery to interrogate Long Bow's witnesses about their family backgrounds and alleged ties to Communists in China, about the truthfulness of their documentary and of various statements on the web site even though those issues were either never in the case, or had been dismissed from the case, or about their willingness to meet face to face with Chai, *supra* at 7-8, made the litigation oppressive. So too, the fact that Jenzabar deliberately used its massive financial resources to pick on a small non-profit firm, coming close to driving it out of business before it found pro bono counsel, *supra* at 8-9, then tried to deprive Long Bow of pro bono help through a spurious motion to disqualify, JA 31-67, further cements the case's exceptional status.

Long Bow does not suggest that this Court should decide whether fees should be awarded under the Lanham

Act's exceptional standard. Fee determinations are properly made in the first instance by the trial court, subject to review on an abuse of discretion standard. But the Court should vacate the denial of the motion for an award of attorney fees and remand with instructions to address the issue of fees, and the amount of fees.

CONCLUSION

The summary judgment should be affirmed. The denial of Long Bow's motion for an award of attorney fees should be vacated, and the superior court instructed to take up that motion and decide it on the merits.

Respectfully submitted,

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