

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

BOSTON MUNICIPAL COURT
CENTRAL DIVISION
Docket 1101CR005277

COMMONWEALTH

v.

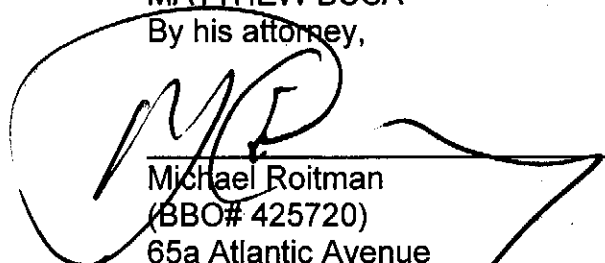
MICHAEL BUSA

**DEFENDANT'S MICHAEL BUSA'S
MOTION TO DISMISS**

The defendant, Michael Busa, moves to dismiss the Criminal Complaint charging him with Possessing/Selling Items Identified by the Reproduction of a "Counterfeit Mark" in violation of *M.G.L. c. 266 §147(b)(1)* on four grounds: (1) the statute is constitutionally overbroad because it renders a substantial amount of otherwise protected speech under the First Amendment illegal; (2) as a matter of law, Mr. Busa did not engage in trademark counterfeiting because his merchandise did not contain a mark identical to any protected trademark; (3) the Commonwealth failed to allege -- and as a matter of law cannot prove -- essential elements of trademark counterfeiting, including likelihood of confusion and/or intentional deception; and (4) *M.G.L. c. 266 §147(b)(1)* is preempted by the federal Copyright Act and Trademark Counterfeiting Act. See generally *Commonwealth v. O'Dell*, 392 Mass. 445,450 (1984); *Commonwealth v. McCarthy*, 385 Mass.160, 163 (1982); *Commonwealth v. DiBennadetto*, 436 Mass. 310 (2002) and M.R.Crim. P. Rule 3(a).

Dated: May 17 2012

MATTHEW BUSA
By his attorney,



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CERTIFICATE OF SERVICE

I hereby certify that I served a true copy of the above motion by hand on May 17, 2012 to ADA Janine D'Amico, Esq., Suffolk County District Attorney's Office, One Bulfinch Place, Boston MA 02114-2997.



Michael Roitman, Esq.

COMMONWEALTH OF MASSACHUSETTS

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**DEFENDANT'S MEMORANDUM OF LAW
IN SUPPORT OF HIS MOTION TO DISMISS**

I. Introduction

The defendant moves to dismiss the Criminal Complaint charging him with Possessing/Selling Items Identified by the Reproduction of a "Counterfeit Mark" in violation of *M.G.L. c. 266 §147(b)(1)* on four grounds: (1) the statute is constitutionally overbroad because it renders a substantial amount of otherwise protected speech under the First Amendment illegal; (2) as a matter of law, Mr. Busa did not engage in trademark counterfeiting because his merchandise did not contain a mark identical to any protected trademark; (3) the Commonwealth failed to allege -- and as a matter of law cannot prove -- essential elements of trademark counterfeiting, including likelihood of confusion and/or intentional deception; and (4) *M.G.L. c. 266 §147(b)(1)* is preempted by the federal Copyright Act and Trademark Counterfeiting Act. See generally *Commonwealth v. O'Dell*, 392 Mass. 445,450 (1984); *Commonwealth v. McCarthy*, 385 Mass.160, 163 (1982); *Commonwealth v. DiBennadetto*, 436 Mass. 310 (2002) and M.R.Crim. P. Rule 3(a).

Both criminal and or civil claims of trademark counterfeiting (or trademark infringement) are designed to protect: (1) the public interest in the "ability of consumers to distinguish among competing producers"; and (2) the private interest of "secur[ing] to the owner of the mark the goodwill of his business," specifically that the mark represents goods of a certain quality. *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189, 198 (U.S. 1985) (citing S. Rep. No. 1333, at 3, 5 (1946)). The Massachusetts criminal statute for counterfeiting a trademark, *M.G.L. c. 266 §147(b)*, fails to protect either of these interests.¹ Indeed, to uphold the statute on its face, as well as under the facts of this case, will chill free expression protected under the First Amendment.

II. Background Context

On June 1, 2011, a week prior to the June 8, 2011 Criminal Complaint at issue in this case, a player for the Vancouver Canucks hockey team, Alex Burrows, bit Patrice Bergeron, of the Boston Bruins, during a fight that erupted between the two players on the ice during the Stanley Cup Finals. The Boston Globe, Boston Herald, local television and sports radio extensively reported on this incident. On June 8, 2011 before Game Two of the Stanley Cup Finals, Mr. Busa applied for and received a Hawkers and Peddler's license from the City of Boston in order to sell t-shirts he made that referred to the June 1, 2011 incident.

¹ A copy of the statute, *M.G.L. c. 266 §147* is attached hereto at tab "A".

III. The Application for the Criminal Complaint

The Application for the Criminal Complaint alleges that Matthew Busa stood in front of the TD Garden to sell ten (10) home-made t-shirts that referred to the hockey fight the week prior.² On the front of one shirt, the text read: "Boston Fights Vancouver Bites." The front of the second t-shirt contained an enlarged version of the Vancouver Canucks team logo overlaid with by a large, red, opaque universal "no" symbol (a circle with a line through it).³

Mr. Busa's t-shirts were confiscated on the "expertise" of Ms. Andrea Powers, an NHL representative, who accompanied Boston Police Detective Gwendolyn Brown that on the evening of June 8, 2011.⁴ After inspecting Mr. Busa's home-made shirts, Ms. Powers opined that they were NHL counterfeit merchandise. Detective Brown thereafter confiscated the ten (10) t-shirts Mr. Busa was selling, a black backpack, and Mr. Busa's Hawkers and Peddler's license.

IV. The Criminal Complaint

The criminal complaint in this case alleges that Mr. Busa offered for sale "counterfeit" merchandise, to wit, unauthorized t-shirts containing the "identical" reproduction of the Canucks' federally registered trademark (U.S. Registration No. 2,196,649, owned by the Canucks Limited Partnership) in violation of *M.G.L. c. 266*

² Copies of the Application for Criminal Complaint and Police Report are attached hereto at tab "B".

³ Copies of photographs of the two t-shirts are attached at tab "C".

⁴ A copy of the Affidavit from Andrea Powers is attached hereto at tab "D".

§147(b)(1).⁵ The complaint does not allege that Mr. Busa intended to deceive potential purchasers into believing that his t-shirts were authorized by the Vancouver Canucks or were otherwise official NHL merchandise, nor does the complaint allege that potential t-shirt purchaser would likely be confused that Mr. Busa's t-shirts were authentic merchandise of the Vancouver Canucks or National Hockey League.⁶

III. M.G.L. c. 266 §147(B)(1) Is Unconstitutionally Overbroad Because It Renders Illegal A Substantial Amount of Speech Protected by the First Amendment

A. Standard of Review

"Statutory interpretation is a question of law for the court to decide."

Commonwealth v. Cintolo, 415 Mass. 358, 359 (1993). Criminal statutes are to be construed strictly so that "[t]he words of a criminal statute ... leave no reasonable doubt as to its meaning or the intention of the legislature." *Commonwealth v. Marrone*, 387 Mass. 702, 706 (1982).

B. The Statute is Constitutionally Overbroad As A Matter of Law

A statute is unconstitutionally overbroad if the law "prohibits a substantial amount of protected speech." *Bulldog Investors Gen. P'ship v. Sec'y of Commonwealth*, 460 Mass. 647, 677 (2011) (quoting *U.S. v. Williams*, 553 U.S. 285, 293 (2008)). In the overbreadth context, "criminal statutes must be scrutinized with particular care" to afford the requisite due process. *Houston v. Hill*, 482 U.S. 451, 459 (1987). See also *Winters v. New York*, 333 U.S. 507, 515 (1948) ("There must be ascertainable standards of guilt.

⁵ A copy of the Criminal Complaint is attached at tab "E" A copy of the federal registration for the logo of the Vancouver Canucks Hockey Club is attached at tab "F".

⁶ Mr. Busa was also charged with Peddling Without a License, *M.G.L. c. 101 §14*; that charge was dismissed.

Men of common intelligence cannot be required to guess at the meaning of the enactment.”) A court can neither apply an overbroad law to the defendant, nor dismiss the claim for lack of standing, even if in fact the defendant’s conduct might be of the type that can be constitutionally regulated. *Commonwealth v. A Juvenile*, 368 Mass. 580, 585 (1975). Aside from *Commonwealth v. Pierre*, 71 Mass. App. Ct. 58 (2008), a case that did not review the language of the statute at issue, no Massachusetts Appellate court has cited *M.G.L. c. 266 §147* or considered its language.

This issue is of first impression in Massachusetts. However, the Pennsylvania Supreme Court has recently interpreted and struck down as constitutional overbroad a Pennsylvania trademark criminal counterfeiting statute nearly identical to *M.G.L. c. 266 §147*. *Commonwealth v. Omar*, 602 Pa. 595 (2009) (striking down Trademark Counterfeiting Act, 18 Pa.C.S. § 4119, as constitutionally overbroad).⁷ In *Omar*, the Court held that because the state law criminalized the “mere use, display or distribution” of the trademark without also requiring intent to deceive, it criminalized otherwise constitutionally protected speech. Specifically, the Pennsylvania Supreme Court explained:

[T]he [Pennsylvania] statute provides ... [that] ... [a]ny person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting. ... It defines “counterfeit mark” broadly to include “[a]ny unauthorized reproduction or copy of intellectual property,” where “intellectual property” is defined by the statute to include “[a]ny trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person’s goods or services.” 18 Pa.C.S. § 4119(i) Therefore, any unauthorized use of a “term” or “word” that is engaged by another person to identify that person’s goods or services is a “counterfeit mark.” Accordingly, the definition of intellectual property criminalizes not only the use of the trademark ...

⁷ A copy of *Commonwealth v. Omar*, 602 Pa. 595 (2009) is attached hereto at tab “G”.

but also the mere word.... [T]he statute, therefore, unconstitutionally prohibits protected speech, including the use of words on a sign praising or protesting any entity with a trademarked name.... Taken to the extreme, even our use of the words "Nike" and "Penn State" in this opinion without the permission of the company or the university would fall under the current definition of a counterfeit mark. Clearly, the statute prohibits a substantial amount of protected speech.

Id. at 607-608.

Massachusetts' trademark counterfeiting statute states, "whoever willfully manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any item or services bearing or identified by a counterfeit mark shall be punished." *M.G.L. c. 266 §147(b)*. This language is identical to that of the Pennsylvania statute except that the Massachusetts law substitute the word "knowingly" for "willfully," the term used in Pennsylvania's statute. Further, under *M.G.L. c. 266 §147*, a counterfeit mark is defined as "any unauthorized reproduction or copy of intellectual property, or intellectual property affixed to any item knowingly sold... without the authority of the owner of the intellectual property." *M.G.L. c. 266 §147(a)*. This language is identical to the Pennsylvania law. Finally, the Massachusetts statute defines "intellectual property" as "any trademark, service mark, trade name, label, term, device, design or word that is (1) adopted or used by a person to identify such person's goods or services, and (2) registered..." *M.G.L. c. 266 §147(a)*. Again this language is identical to the language of the Pennsylvania law, which in *Omar*, was held unconstitutionally overbroad for criminalizing First Amendment protected speech.

Like the Pennsylvania trademark counterfeiting law, *M.G.L. c. 266 §147* criminalizes *any* "use" or "display" of a "counterfeit mark." *M.G.L. c. 266 §147(b)*. It thus sweeps too broadly. A student writing a term paper on fast-food and who copies and uses (without consent) the McDonald's trademark to illustrate her research has

violated the law and could be subject to criminal penalties. Or, as the *Omar* court explained, “the use of the word ‘Nike’ on a sign at a protest rally, such as ‘Nike uses sweatshop labor’ would fall within the reach of the [law] because the activity involves the unauthorized use of a word or term by another to identify goods or services.” *Omar*, 602 Pa. at 604. Indeed, the use of the terms “McDonalds” and “Nike” in this Motion to Dismiss would be an illegal reproduction of someone else’s intellectual property because *M.G.L. c. 266 §147(a)* defines intellectual property as “any trademark... or word that is... adopted or used by a person to identify such person’s goods.” *M.G.L. c. 266 §147(a)*(emphasis added); see also *Omar*, 602 Pa. at 608.

This is not a situation where the statute’s plain language can be narrowly read to avoid an unconstitutional result. *Forsyth County v. Nationalist Movement*, 505 U.S. 123, 132 (U.S. 1992) (rejecting the lower court’s interpretation that the statute at issue creates “narrowly drawn, reasonable and definite standards”). Indeed, the court would have to ignore or remove the clear text of the statute to save it from constitutional overbreadth. Striking words or phrases is statutory remodeling not statutory construction. See *Acme Laundry Co. v. Sec’y of Env’tl. Affairs*, 410 Mass. 760, 779 (1991) (after a lower court “read out” a clause from a statute, the Supreme Judicial Court cautioned that “by nullifying that language, contrary to established precedent relative to statutory construction... the court effectively, and, of course, inappropriately, amends the statute”). Because, on its own terms, *M.G.L. c. 266 §147* requires nothing more than the “use” or “display” of someone’s “intellectual property” to create criminal liability for counterfeiting, the statute plainly renders illegal a “substantial amount of

protected speech.” *Bulldog Investors Gen. P’ship v. Sec’y of Com.*, 460 Mass. 647, 677 (2011). The law is therefore unconstitutionally overbroad and should be struck down.

Laws against trademark counterfeiting prevent consumers from deceptive trade practices (e.g., from unwittingly purchasing knock-off products). Laws against trademark counterfeiting also aim to protect product manufacturers from the erosion of goodwill that stems from unfair competition with low-quality knock-offs. *M.G.L. c. 266 §147* may achieve some of these goals, but it sweeps far too broadly. Some deceptive marks might be caught in the net this law casts; but so is a substantial amount of protected speech. The statute’s plain language is unambiguously overbroad and cannot stand.

If, however, the court is inclined to construe the statutory language more narrowly to avoid constitutional difficulties, as described below, any such narrowing necessary to avoid overbreadth as a matter of law puts the defendant’s conduct outside the scope of the statute.

IV. To Avoid a Finding of Unconstitutionality, This Court Must Imply Certain Elements of the Offense Consistent with the Aims of the Statute

While the doctrine of constitutional avoidance is rarely invoked to contradict the plain language of a statute, courts sometimes rely on the doctrine to interpret statutes more narrowly than their literal language might suggest. Thus, this court could rely on the doctrine of constitutional avoidance to read limitations into the language of *M.G.L. c. 266 §147* that do not appear on its face. *Commonwealth v. Fremont Inv. & Loan*, 459 Mass. 209, 214 (2011) (“Where fairly possible, a statute must be construed ‘so as to avoid not only the conclusion that it is unconstitutional but also grave doubts upon that score.’”); *Blixt v. Blixt*, 437 Mass. 649, 652 (Mass. 2002) (“A court may interpret a

statute to set forth considerations to clarify and specify, and, where necessary, to narrow, the statute's terms in order that it may be held constitutional.”)

Here, to avoid constitutional overbreadth, the court should imply elements into the Massachusetts statute from the federal trademark counterfeiting statute. The Supreme Judicial Court has often been guided in its interpretation of a Massachusetts statute “by construction [of] parallel federal statute by federal courts.” *Howard v. Town of Burlington*, 399 Mass. 585, 589 (1987). See also *Kelley v. Rossi*, 395 Mass. 659, 662 n. 4 (1985). (noting that the Supreme Judicial Court normally looks for assistance from Federal Courts' treatment of cognate provisions of Federal Tort Claims when construing Massachusetts Tort Claims Act); *Miller v. Cotter*, 448 Mass. 671, 679 (2007) (“Unless there is clear reason to do otherwise, appellate courts interpret cognate provisions of state and federal law similarly”). Therefore, it is proper to look for limiting principles in the state law’s federal counterpart, 18 U.S.C. §2320, the Trademark Counterfeit Act (TCA).

The TCA criminalizes the knowing trafficking in goods or services that knowingly use a “a spurious mark.” A “spurious mark” is identical to, or substantially indistinguishable from, a mark registered for those goods and services on the federal register whose use is likely to deceive, confuse, or cause mistake on the part of the consuming public as to the origin of the goods. 18 U.S.C. §§2320(a), (f)(1). To be consistent with the TCA, the following three requirements would need to be read into M.G.L. c. 266 §147: (1) the “counterfeit mark” must be “identical” to or “substantially indistinguishable” from the allegedly counterfeited mark; (2) the Defendant must have used the trademark in question in a manner that is “likely to cause confusion, to cause

mistake, or to deceive”; and (3) the Defendant must have had knowledge that the mark was counterfeit. Under the TCA, failure to prove any one of these three elements is fatal to the prosecution. 18 U.S.C. §2320(f)(1)(A)(ii), (iv) (2011).

These three requirements found in the TCA differentiate counterfeiting from other forms of trademark infringement because counterfeiting poses a risk of deceiving consumers and into buying the defendant’s goods under the false belief that they are getting the trademark owner’s goods. Because the TCA imposes harsher penalties for counterfeiting, it has higher standards than civil liability. Unlike ordinary trademark infringement, which requires only that the defendant’s use be similar enough to create a likelihood of confusion, the TCA requires that the marks be “identical” or “substantially indistinguishable.” United States Attorneys' Manual, Title 9, Criminal Resource Manual §1715 [hereinafter *CRM*].⁸ It does so to “assure that not every case of trademark infringement amounts to trademark counterfeiting.” *Id.* The TCA’s higher threshold thus “prevent[s] a counterfeiter from escaping liability by modifying a protected trademark in trivial ways, while excluding arguable cases of trademark infringement involving trademarks which are merely ‘reminiscent of’ protected trademarks.” *Id.* And the TCA goes even further: not only does it require that the defendant’s mark be identical or substantially indistinguishable, it also requires that the defendant’s use of the mark create a likelihood of confusion, mistake, or deception. This is because, as Congress recognized, “this element is the essence of a trademark infringement,” and counterfeiting is merely a subset of infringement. *Id.* Thus, even though it already

⁸ available at http://www.justice.gov/usao/eousa/foia_reading_room/usam/title9/crm01717.htm

requires more in the way of similarity, the TCA still does not condition liability on the mere use of such a mark. The use must have the effect of causing likely confusion.

The Supreme Judicial Court has stated that “in interpreting a statute, the... starting point is the plain language of the statute, but it also seeks guidance from... law of other jurisdictions.” *Commonwealth v. Welch*, 444 Mass. 80, 85 (2005). Other state counterfeiting statutes have been narrowly construed in the same manner that the Defendant urges upon this court. Fully twenty-six out of the 40 states that have enacted criminal counterfeiting statutes have either mirrored the TCA or have adopted similar limitations.⁹ For example, Colorado’s and Washington’s statutes, both otherwise similar to Massachusetts’, include substantial limitations like those found in the TCA. *Colo. Rev. Stat. § 18-5-110.5* (2012); *Wash. Rev. Code Ann. §§ 9.16.005, 020, 030* (2012). The Attorney General of Oklahoma, in an official opinion written to the legislature, used the TCA to interpret Oklahoma’s statute (the language of which is identical to the Massachusetts statute) and read the elements of “identity” and “knowingly causing confusion or deception” into the statute. *Okl. A.G. Opin. No. 01-20*, The Honorable Gilmer Capps (2001). Where statutes lack such limitations, as the Pennsylvania statute did, in *Omar*, they have been struck down for overbreadth. While the interpretive and

⁹ Cal. Penal Code § 350 (2011); Conn. Gen. Stat. § 53-347A (1999); D.C. Code § 22-902 (2001); Fla. Stat. Ann. § 831.03 (2008); GA. Code Ann. § 10-1-454 (1998); Haw. Rev. Stat. § 708-875 (1999); Idaho Code Ann § 18-3614 (1997); 765 Ill. Comp. Stat. 1040/1-1040/2 (1999); LA. Rev. Stat. Ann. § 14:229 (2011); Mich. Comp. Laws §§ 750.263-.264 (2004); Miss. Code Ann. §§ 97-21-53 (1999); Mont. Code Ann. 30-13-338 (enacted 2009); N.C. Gen. Stat. 80-11.1 (1999); N.D. Cent. Code § 51-07-04; N.H. Rev. Stat. Ann. § 638:6-b (effective 2009); N.J. Stat. Ann. 2C:21-32 (West 1999); N.Y. Penal Law §§ 165.70-.74 (McKinney 1999); Ohio Rev. Code Ann. § 2913.34 (West 1996); OR. Rev. Stat. § 647.135 (1999); R.I. Gen. Laws § 11-17-13 (Supp. 1999); S.C. Code Ann. § 39-15-1190 (Supp. 1997); S.D. Codified Laws §§ 37-6-1 TO -3 (1994); Tenn. Code Ann. § 39-14-152 (1995); Tex. Penal Code Ann. § 32.23 (Supp. 2000); Utah Code Ann. §§ 76-10-1001 *et. seq.* (1999); Wis. Stat. § 132.02 (1989).

statutory pattern of other sister states is not dispositive, it lends strong support to the manner in which this court should interpret the Massachusetts statute. See *EMC Corp. v. Comm'r of Revenue*, 433 Mass. 568, 570 (2001) (“Statutes are to be interpreted in connection with... the history of the times... contemporary customs and conditions and the system of positive law of which they are part.”).

In *O'Brien v. Borowski*, 461 Mass. 415 (2012) the Supreme Judicial Court observed that when a statute is found to be overbroad, the court will narrowly construe it, “especially where we discern a legislative intent that the statute prohibit only constitutionally unprotected speech.” *Id* at 422. In this case, the court's only option for saving this statute from unconstitutional overbreadth is to read into it the TCA's elements of “identity” and “knowingly causing confusion or deception.”

A. Mr. Busa's T-Shirts Contain A Mark That Is Neither Identical To Nor Substantially Indistinguishable From the Canuck's Trademark

Assuming that *M.G.L. c. 266 §147* requires the use of “identical” or “substantially identical” marks to prove a counterfeit claim, the Commonwealth cannot prove Mr. Busa's t-shirts contain such marks. As a matter of law, the design on Mr. Busa's shirt is not identical to the Canuck's registered mark at issue. (Compare tab B and tab F). Mr. Busa superimposed the “universal no” symbol over the Canucks' logo thereby rendering it clearly distinguishable from the registered mark. The t-shirts therefore do not use a counterfeit Canucks' mark; no reasonable consumer could possibly believe the t-shirts are genuine Canucks' goods. Rather, the t-shirts use a significant variation of the mark that conveys the opposite meaning. Mr. Busa's t-shirts say in recognizable symbols “No Canucks.” This significance is further underscored by the lettering on the second t-shirt, which says “Boston Fights Vancouver Bites.”

The prosecution apparently contends that the t-shirt contains a counterfeit mark because the composite design on the t-shirt contains a copy of the Canucks' trademark. But this argument ignores the well-established trademark doctrine of "anti-dissection." See *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) ("Similarity of trademarks is determined on the basis of the total effect of the designation, rather than a comparison of the individual features."); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 18 (1st Cir. 2008) (discussing "the well-established 'anti-dissection rule'"). The anti-dissection principle states that "a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts." J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition*, § 11:27 (4th ed. 1996). See also *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 33 (1st Cir. 2008) (applying anti-dissection principle for the purpose of infringement analysis). Mr. Busa's shirts use a composite design composed of the Canucks' logo and the universal "no" symbol. Evaluating the image as a whole, it is clearly not "identical" to or "substantially indistinguishable" from the registered mark. Mr. Busa's t-shirt incorporates the Canucks mark into its design to say "No Canucks." This is not the use of an "identical" or "substantially identical" mark.

Congress made clear that the requirement for substantially indistinguishable marks in the TCA was "intended to prevent a counterfeiter from escaping liability by modifying a protected trademark in trivial ways." 130 Cong. Rec. H12078, 98th Cong., 2d Sess. (daily ed. Oct. 10, 1984). See also *U.S. v. Guerra*, 293 F.3d 1279, 1288 (11th Cir. 2002) ("The 'identical or substantially indistinguishable' standard is to be construed

more narrowly in a criminal context than in a civil context.”). Mr. Busa did not make a “trivial” modification of the Canucks’ mark. The composite design on the t-shirt obscures the majority of the Canucks’ logo by placing on top of it a large, opaque universal “no” symbol. In contrast to an “identical” use of the Canucks’ logo to indicate that the merchandise are genuine Canucks’ goods, Mr. Busa substantially altered the Canucks’ logo to make it mean the opposite of what it usually does: this is NOT Canucks’ merchandise. Mr. Busa’s use of the Canucks’ logo within a composite design that says “No Canucks” is not use of an identical or substantially indistinguishable mark as a matter of law. See *Jordache Enters., Inc. v. Levi Strauss*, 841 F.Supp. 506, 514–15 (S.D.N.Y.1993) (affirming finding of no infringement by comparing overall meaning of two images that nonetheless use similar components). See also *Universal Money Ctrs., Inc. v. AT & T*, 22 F.3d 1527, 1531 (10th Cir.1994) (repeating the well-worn trademark principle that for infringement to lie the two images must convey the same idea or stimulate the same mental reaction). The Commonwealth therefore cannot prove an essential element of the criminal charge and the complaint must be dismissed.

B. The Commonwealth Failed to Allege, and as A Matter of Law Cannot Prove, That Mr. Busa’s Use of the Canucks’ Mark Is Intentionally Deceptive or Likely To Confuse T-Shirt Purchasers

Nowhere in the Application for the Criminal Complaint does the Commonwealth allege that potential t-shirt purchasers will be confused into believing Mr. Busa’s use of the Canucks’ logo indicates that the Canucks’ made or sponsored the t-shirts.

Nowhere in the Application for the Criminal Complaint does the Commonwealth allege that Mr. Busa used the Canuck’s logo to intentionally deceive potential purchasers into believing that his t-shirts were genuine Canuck/NHL merchandise. Because confusion

and/or deception are essential elements of a trademark counterfeiting cause of action, and must be read into *M.G.L. c. 266 §147* to render it constitutional, the Commonwealth's failure to allege these elements of the offense dooms its case.

Likelihood of confusion and/or deception requires the application of a multi-factor test which includes analysis of: similarity of the goods and marks; strength of the mark; related channels of trade; relationship of the parties' advertising; classes of prospective purchasers; actual confusion; and defendant's intent in using the mark. See *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *Groove Entm't, Inc. v. GrooveBoston, LLC*, 27 Mass. L. Rep. 613 (Mass. Super. Ct. 2011)("The Supreme Judicial Court has adopted a nearly identical test [as Pignon] under Massachusetts common law.").

However, even a cursory analysis reveals no possibility of confusion or deception. The use of the marks and purposes of the goods are dissimilar, Mr. Busa and the Canucks sell their products in different venues (i.e. on the street versus in stores with licensed NHL merchandise), and the classes of prospective purchasers are disparate (i.e. Bruins fans as opposed to Canucks fans). Moreover, Mr. Busa clearly intended to comment on the June 1, 2011 fight during Game One of the Stanley Cup, to support the Bruins and to criticize the Canucks.

Trademark law expressly exempts critical and parodic speech made with the unauthorized use of trademarks. See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28-9 (1st Cir. 1987) ("trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view"). "[W]hen unauthorized use of another's mark is part of a communicative

message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.” See *Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 278 (S.D.N.Y 1992). This is true even when the unauthorized mark appears in products offered for sale, such as Mr. Busa’s t-shirts. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (finding noninfringement despite unauthorized use of Mattel’s trademark for Barbie Dolls in the title and content of hit pop song).

Moreover, even assuming that conclusory allegations of confusion and/or deception appeared in the criminal complaint, viewing the evidence in the light most favorable to the Commonwealth, *Commonwealth v. Latimore*, 378 Mass. 671, 676-678 (1979) and *M.R.Crim.P. Rule 25*, the evidence is insufficient to prove that Mr. Busa’s t-shirt that read “Boston Fights Vancouver Bites” and the t-shirt with the Canucks’ logo with the universal “no” sign on top is either confusing or deceptive as to the origin of the t-shirts. “The relevant question is whether the evidence would permit a jury to find guilt, not whether the evidence requires such a finding.” *Commonwealth v. Brown*, 401 Mass. 745, 747 (1988), See *Commonwealth v. Nelson*, 370 Mass. 192, 200–201 (1976). The evidence here does not permit a finding that Mr. Busa’s t-shirts were either confusing or deceptive.

There could be no reasonable inference that potential purchasers were objectively confused or deceived into believing that t-shirts that said “Boston Fights Vancouver Bites” and symbolically said “No Canucks” were made by, sponsored by or originated with the Vancouver Canucks. The Canucks’ genuine use of their logo would be to promote their team, not to denigrate it. In light of the clear, critical message on Mr. Busa’s t-shirts about the Canucks, even viewing the evidence in the light most favorable

to the Commonwealth, the evidence simply does not permit a reasonable inference that potential purchasers of Mr. Busa's t-shirts were deceived into thinking that he was selling genuine Canuck's merchandise. For this additional reason, the complaint must be dismissed against Mr. Busa.

C. Mr. Busa did not Have the Requisite Knowledge That his Goods Contained Counterfeit Trademarks

The Application for the Criminal Complaint also failed to allege facts that would allow a finding that Mr. Busa intended to sell counterfeited goods. Under the TCA, Mr. Busa must have knowledge that the goods he was selling bore a counterfeit mark. U.S. Attorneys' Manual, Title 9, Criminal Resource Manual (CRM) §1717 ("The second mental state requirement of the statute is that the defendant 'knew' the mark used on or in connection with the goods or services in which he trafficked was counterfeit."). According to the Senate Report for the TCA, "knowledge" means actual knowledge that the goods or services are counterfeit." Michael Coblenz, *Intellectual Property Crimes*, 9 Alb. L.J. Sci. & Tech. 235, 277 (1999) (quoting S. Rep. No. 98-526, at 11-12 (1984)). See also *United States v. Hiltz*, 14 Fed. Appx. 17 (1st Cir. 2001) ("at the minimum willful blindness... satisfies the knowledge requirement under" the TCA)(internal quotation marks omitted). Because the Commonwealth has failed to allege that Mr. Busa intended to counterfeit the Canuck's marks, the Criminal Complaint must be dismissed.

Additionally, in light of the content of his t-shirts, even viewing the evidence in the light most favorable to the Commonwealth, there is insufficient evidence that Mr. Busa intended to counterfeit the Canucks' merchandise. To the contrary, Mr. Busa's t-shirts, by using the universal "no" sign and invoking the biting incident, unambiguously express

Mr. Busa's dislike of the Canucks. It is impossible for Mr. Busa to simultaneously make a statement opposed to the Canucks and intend that the public believe that his t-shirts are sponsored by or affiliated with the Canucks as genuine Canuck merchandise. As a matter of law, in light of the clear message contained on the t-shirts, a jury could not reasonably infer that Mr. Busa intended to pass off his "Boston Fights Vancouver Bites" t-shirts as genuine Canuck's merchandise. Because the element of intent to sell counterfeit goods must be read into the statute to preserve its constitutionality and because there could be no reasonable inference that Mr. Busa actually intended to sell counterfeit goods, the complaint must be dismissed.

V. M.G.L. c. 266 §147(b) Is Preempted by the Copyright Act, 17 U.S.C. §501

If the court was to interpret *M.G.L. c. 266 §147* without the additional elements discussed above that are contained in the TCA (e.g., confusion and/or deception and intent to counterfeit), then *M.G.L. c. 266 §147* would be the equivalent of a copyright statute. It would criminalize the bare copying and distribution of expressive content. This is the role of copyright law. *17 U.S.C. §106(1), (3) and §501*. Copyright law gives to copyright owners the exclusive right to control (among other things) reproduction and distribution of their copyrighted works, and makes unauthorized reproduction and distribution actionable. Notably, copyright law does not require confusion or deceit among consumers. The Commonwealth has not brought a copyright counterfeit claim against Mr. Busa (nor could it sustain one under these facts).

Given that the plain language of *M.G.L. c. 266 §147* functions as the equivalent of copyright law, it is necessarily preempted by the Copyright Act. The Act *expressly*

provides that “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of” subject matter copyrightable under 17 U.S.C. §§ 102 and 103 “are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.” 17 U.S.C. § 301(a) (2012). Therefore, insofar as the Commonwealth’s interpretation and application of *M.G.L. c. 266 §147* against Mr. Busa is really nothing more than an allegation that he has unlawfully reproduced another’s design, it is preempted by federal law. *B.C. Techn’l, Inc. v. Ensil Intern. Corp.*, Slip Copy, 2012 WL 375498, *6 (10th Cir. 2012) (holding Utah theft statute preempted by federal criminal copyright infringement statute).

VI. Conclusion

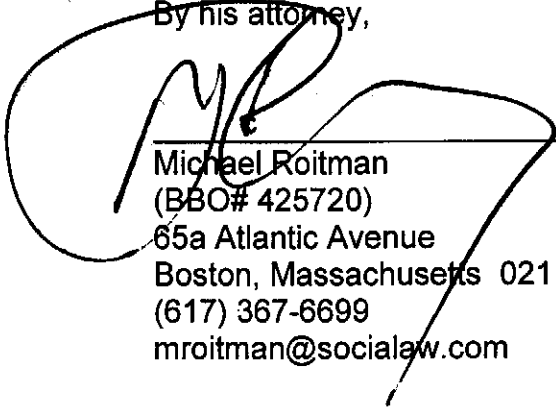
M.G.L. c. 266 §147 is unconstitutionally overbroad. For this reason alone the complaint against Mr. Busa must be dismissed. The statute as written is also preempted by the United States Copyright Act, 17 U.S.C. §501. Additionally, were the court to save the Massachusetts criminal trademark counterfeiting statute by conforming it to other state trademark counterfeiting laws and the TCA, then the Commonwealth has failed to allege facts to support these elements and the complaint must be dismissed. Finally, even viewing the evidence in the light most favorable to the Commonwealth, there could be no reasonable inference that Mr. Busa’s t-shirts contain a counterfeit mark (they are not identical to the Canuck’s mark), that they confuse or deceive the public that the Canuck’s sponsored or licensed the t-shirts, and that Mr. Busa intended to pass off his t-shirts as genuine Canuck merchandise. Each one of these elements must be proven

beyond a reasonable doubt to convict Mr. Busa under a constitutional statute, yet the evidence is insufficient to support an inference that any one of these elements (let alone all three) are satisfied. Mr. Busa made t-shirts to celebrate the Stanley Cup rivalry, to express his personal support for the Bruins and his dislike for the Canucks. The Commonwealth cannot reasonably claim that in so doing Mr. Busa intended to pass off his t-shirts as genuine Vancouver Canuck merchandise or that any actual passing off occurred. "Boston Fights Vancouver Bites" and "No Canucks" in no way signify what a genuine Canucks t-shirt with the Canucks' trademark would signify, which is "this t-shirt is authorized by and celebrates the Vancouver Canucks." The Commonwealth's complaint against Mr. Busa for trademark counterfeiting should be dismissed.¹⁰

Dated: May 14, 2012

MATTHEW BUSA

By his attorney,



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CERTIFICATE OF SERVICE

I hereby certify that I served a true copy of the above motion by mail on May 14, 2012 to ADA Janine D'Amico, Esq., Suffolk County District Attorney's Office, One Bulfinch Place, Boston MA 02114-2997.



Michael Roitman, Esq.

¹⁰ Counsel for Mr. Busa wishes to acknowledge the significant assistance of Adamo Lanza, a second year student at Suffolk University Law School, in the preparation of this memorandum.