

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPERIOR COURT DEPARTMENT
OF THE TRIAL COURT

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

Plaintiffs,)

v.)

LONG BOW GROUP, INC.,)

Defendant.)

CIVIL ACTION NO. 07-2075-H

**DEFENDANT LONG BOW GROUP’S SURREPLY MEMORANDUM
IN OPPOSITION TO MOTION TO AMEND COMPLAINT**

In opposing Jenzabar’s motion to amend its complaint to add a host of new trademark claims, based on several dozen new factual allegations that were supposedly based on “new evidence,” Long Bow explained that the new factual allegations were **not** based on new evidence, and that Long Bow had not received notice of the new legal theories before discovery expired so that it could explore them through discovery, not to speak of pursuing expert testimony with respect to the new theories. Long Bow also argued that the proposed amendments were defective for many of the same reasons why the original complaint was defective and hence subject to summary judgment.

Rather than explaining how each of the new allegations in the proposed amended complaint is supported by evidence, Jenzabar simply points to excerpts from two depositions that supposedly contain all of the evidence to which the proposed amendments conform. The **only** example using the term “title tag” involved questions posed to Nora Chang at her deposition on September 10, 2009, mere days from the September 15 expiration of discovery, when it was too late for Long Bow to initiate discovery from Jenzabar on the subject. Reply Br. 3 n.2. The other examples consist of

a disparate handful of excerpts from the Maginn deposition in June 2009. Generally giving answers that were unresponsive to the questions that were posed to him, Maginn complained that (1) the main Jenzabar-related page on the tsquare.tv web site (the “MJP”) came up second in the list of Google search results, (2) was listed as “Jenzabar,” and (3) that word appeared in bold print. But he never testified about anything that Long Bow had supposedly done, other than using the word Jenzabar in its keyword meta tags for that page, either to cause the high search ranking or to cause anything else to appear in the search listing.

Maginn’s testimony did not include any admissible evidence about Long Bow’s alleged infringement, nor about how consumers view the search listings and hence whether there was a likelihood of confusion. Consequently, his testimony is not evidence to which the proposed amendments to the complaint could conform. At best, the excerpts show in retrospect his own hypotheses and some theories that plaintiff was considering, but which it never alleged until after summary judgment was sought.

Moreover, Jenzabar points to **nothing** in the supposed evidence to which its proposed amendments would conform that support each of the several dozen other new allegations in its proposed amended complaint, such as that Long Bow supposedly discussed Jenzabar in its web site for the purpose of marketing its film to colleges and universities, that Long Bow’s entire web site is infected with infringing objectives, or that Long Bow engaged in unspecified “other deceptive techniques.” Because Jenzabar is not conforming to new evidence, and because Long Bow could not fairly be expected to prepare for trial without having discovery to ascertain what evidence Jenzabar plans to adduce to prove these allegations, none of these new allegations should be

allowed.¹

Although Long Bow put forth several reasons why Jenzabar's proposed new allegations are equally susceptible or even more susceptible to its motion for summary judgment, hence making the proposed amendments legally futile, Jenzabar has chosen to respond to only one such flaw in its argument — the lack of any precedential support for the proposition that the use of the name of a company that is criticized on a web page as the title tag for that web page constitutes trademark infringement. Jenzabar essentially admits that it has no precedent to cite. Instead, it cites vague dicta in two rulings from the United States District Court for the Southern District of Ohio that referred in passing to possible trademark claims based on the use of a trademark in the title tags for a web page by a competitor about the competitor's own products. But not only did neither case even say that such a use of title tags constitutes trademark infringement, no less adopt such a holding,² but

¹ For example, Jenzabar's supplemental discovery response, identifying Frank Farance as its expert witness, indicated that, depending on what additional discovery Jenzabar obtained from Google and from Long Bow's ISP, he might testify about "the impression of such search results upon the person searching for a particular term." Opposition to Motion to Strike Farance Affidavit, Exhibit B, page 5. However, even Jenzabar's belated affidavit from Farance, filed in response to the motion for summary judgment and after the close of discovery, does not contain any such testimony. If Jenzabar has in mind to present any evidence on this point, Long Bow needs to know what that evidence is so that it can pursue discovery and possibly retain its own expert witnesses to address it; the need to pursue such discovery is prejudice caused by the belated disclosures. If, on the other hand, Jenzabar does not intend to present any evidence on this point other than what Maginn said at his deposition, then Jenzabar should say so clearly, and Long Bow's summary judgment motion should be considered in light of Jenzabar's admission that it has no specific evidence to carry its burden of proof on these theories.

²In *Tdata v. Aircraft Tech. Pub'rs*, 411 F.Supp.2d 901 (S.D. Ohio 2006), the plaintiff alleged trademark claims based on a competitor's use of both meta tags and title tags, but the trial court discussed only the meta tag claims. In *Amco Ins. Co. v. Lauren-Spencer*, 500 F. Supp.2d 721 (S.D. Ohio, 2007), the issue before the Court was whether an insurance company was obligated by the defendant's advertising insurance coverage to provide a defense against certain copyright claims, and the court discussed both meta tags and title tags as examples of claims that qualify for coverage under an advertising injury clause. The court did not decide whether the claims were valid under the Lanham Act.

both that court and the United States Court of Appeals for the Sixth Circuit have repeatedly rejected trademark claims based on use of a trademark in the **domain name** for a web site about the trademark holder. *Lucas Nurseries v. Grosse*, 359 F.3d 806 (6th Cir. 2004); *Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir.2003); *Savannah College of Art & Design v. Houeix*, 369 F. Supp.2d 929 (S.D. Ohio 2004). They reached these holdings even though in many contexts a domain name indicates source. The title of a work, by contrast, is generally not taken as indicating source, which is why every court of appeals to address the question has held that a title using a trademark does not violate the trademark laws if the title bears any relevance to the contents of a work. Opening Mem. at 7-8, citing cases. Here, even Jenzabar now admits that the MJP is about Jenzabar. It follows that trademark claims based on the title tag must fail, and the proposed amendment to add that claim is legally futile.

CONCLUSION

The motion for leave to amend should be denied.

Respectfully submitted,
LONG BOW GROUP, INC.

By its attorneys,

Paul Alan Levy (pro hac vice)
plevy@citizen.org
Michael Kirkpatrick (pro hac vice)
mkirkpatrick@citizen.org
Public Citizen Litigation Group
1600 20th Street, N.W.
Washington, DC 20009
(202) 588-1000

T. Christopher Donnelly, BBO #129930
tcd@dcglaw.com
Adam B. Ziegler, BBO #654244
abz@dcglaw.com
Donnelly, Conroy & Gelhaar, LLP
One Beacon Street, 33rd Floor
Boston, Massachusetts 02108
(617) 720-2880

Dated: January 8, 2010