

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
FORT WORTH DIVISION

CLARK BAKER and THE OFFICE OF)	
MEDICAL AND SCIENTIFIC JUSTICE, INC.)	
)	
Plaintiffs,)	
)	
v.)	Civil Action No. 4:13-00552-C
)	
JEFFERY TODD DESHONG,)	
)	
Defendant.)	

MEMORANDUM IN SUPPORT OF MOTION TO DISMISS

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CONSTITUTION, LEGISLATIVE MATERIALS, AND RULES

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1. This is a lawsuit by a professional “HIV denialist”: someone who makes a living by providing a pseudo-scientific cover for the proposition that HIV does not lead to AIDS and that AIDS medications do no good but cause serious problems. The lawsuit seeks to suppress criticism by a non-commercial blogger. The denialist sues for defamation and related torts, while his company purports to bring trademark claims under the federal Lanham Act and its state-law analog. In a motion accompanying this one, defendant brings a special motion to strike the state-law defamation and trademark claims; this motion seeks dismissal pursuant to Rule 12(b)(6) because the complaint does not plead a tenable trademark claim and, indeed, considering the blog over which plaintiffs have sued, it is apparent that no trademark claim could be pleaded.

2. The complaint never alleges that defendant used the trademark in connection with the sale or advertising of goods and services, nor could it have, because it is apparent that the blog consists entirely of non-commercial criticism that is beyond the constitutionally permissible purview of the trademark laws. The complaint repeatedly uses the catchphrase “likelihood of confusion,” but never pleads that defendant’s use of the mark is likely to cause confusion about the source or sponsorship of the blog; instead, plaintiffs allege that defendant is using their mark to call attention to allegedly defamatory statements about plaintiffs. But that is not a proper basis for a trademark claim. Defendant has used the mark truthfully to identify the content of his blog, and the accurate use of a trademark to denote the subject matter of online content is protected both by the trademark laws and by the First Amendment.

FACTS

3. Plaintiff Clark Baker is an “HIV denialist”—disputing mainstream science, he argues that evidence of HIV’s link to AIDS is too equivocal to warrant social or legal reliance, and that the various medical treatments aimed at ameliorating the effects of HIV and AIDS are a sham and a

fraud. Complaint ¶¶ 7, 9, 12. After leaving his previous career in law-enforcement, Baker reinvented himself as a private investigator, and specializing in cases in which defendants have been accused of spreading HIV by having unprotected sex while concealing their HIV-positive status. He founded plaintiff Office of Medical and Scientific Justice, Inc., (“OMSJ”) to help propagate his views. *Id.* OMSJ, in turn, created an “HIV Innocence Project” but, after complaints of trademark infringement from an existing organization called The Innocence Project, <http://www.innocenceproject.org/>, it changed the name of the project to HIV Innocence Group, <http://hivinnocencegrouptruth.com/2011/07/12/the-purpose-of-this-site/>, and secured a federal trademark registration for that name. Complaint ¶ 11. Plaintiffs’ web sites tout their many “successes” in helping defendants avoid conviction on charges of deliberately exposing sex partners to HIV. *E.g.*, <http://www.omsj.org/innocence-group>.

4. Defendant Todd deShong operates a blog about Baker’s HIV activities using the domain names hivinnocenceprojecttruth.com and hivinnocencegrouptruth.com (the two blogs are largely mirror images of each other, DeShong Affidavit ¶ 2; this brief uses the singular word “blog” to identify both). The blog gives deShong’s views about plaintiffs, and dissects several examples of “successes” claimed by the HIV Innocence Group. DeShong Affidavit Exhibit A. Because the blog recounts the “truth” about plaintiffs as he sees it, the domain names truthfully denote the subject of the blog. *Id.* The blogs are entirely non-commercial. They carry no advertising, solicit no subscriptions, and provide no link for donations. *Id.* ¶ 3.

5. Before creating the blog at issue here, DeShong had a blog called “Dissidents4Dumbees” in which he discussed Baker and other individuals. DeShong Affidavit ¶ 6. Baker responded with a campaign of harassment that included a threatening telephone call to DeShong’s mother, with

whom deShong lived at that time, and complaints to DeShong's employer. *Id.* When he created the blog at issue in this case, DeShong was also afraid of Baker because he had heard about Baker's having lost his job as a police officer over an incident of alleged brutality toward a jaywalker. *Id.* Chastened by what he knew about Baker, DeShong registered the domain names at issue anonymously with Domains by Proxy and kept his name off the blog. *Id.* However, after Baker challenged the anonymity of the registration, DeShong removed the blog from public view by setting up a password requirement for access to the blogs. The password requirement was removed recently, after DeShong obtained pro bono counsel to defend himself against Baker's claims. *Id.* ¶ 7.

6. Baker's various web sites have harsh words for his adversaries. For example, his web sites accuse Nobel laureate Robert Gallo of being a fraud, <http://exlibhollywood.blogspot.com/2008/07/gallos-egg.html>. His attacks on defendant include these lines:

... Fauci's goons dispatch people like Jeffrey to disrupt, embarrass, and intimidate those witnesses. And because of their psychological disposition, crazies are assumed not to possess the mental capacity to commit crimes – which makes it difficult to hold them accountable in criminal or civil courts.

As a 45-year-old single man who has no meaningful or spiritual life, assets, profession, or prospects, Jeffrey lives alone with his mother in her small Texas rental. Like the unloved target of a child molester, Jeffrey was easily seduced and exploited by Moore and other goons who reward Jeffrey with the love and respect he cannot find in normal healthy relationships.

<http://exlibhollywood.blogspot.com/2009/06/rants-from-villiage-idiot.html>

7. Despite the strong language with which he attacks his critics, Baker, as this lawsuit shows, is sensitive to criticism. First, OMSJ brought a proceeding under the Uniform Domain Name Dispute-Resolution Policy ("UDRP"), contending that DeShong's domain names infringed its trademark in "HIV Innocence Group." DeShong Affidavit ¶ 9. Even though UDRP proceedings are

notoriously favorable to trademark holders, *e.g.*, <http://aix1.uottawa.ca/~geist/fairupdate.pdf>, the UDRP panelist found no trademark infringement. To the contrary, the panelist entered the UDRP equivalent of a finding that the UDRP complaint had been brought in bad faith, ruling that OMSJ sought to seize the names even though it knew that they were being used lawfully to post criticisms of the trademark holder online. <http://domains.adrforum.com/domains/decisions/1486064.htm>. Unfazed by this rejection, Baker and OMSJ have now sued DeShong for defamation and related torts, and for trademark infringement under both federal and state law.¹

ARGUMENT

8. An action should be dismissed under Rule 12(b)(6) for failure to state a claim when the well-pleaded allegations, taken to be true, do not disclose any viable claim. Only well-pleaded allegations can be considered on a motion to dismiss; conclusory allegations are ignored. *Kaiser Aluminum & Chem. Sales v. Avondale Shipyards*, 677 F.2d 1045, 1050 (5th Cir.1982).

[F]acts taken as true must . . . state a claim that is plausible on its face. A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. A complaint is insufficient if it offers only labels and conclusions, or a formulaic recitation of the elements of a cause of action.”

Highland Capital Mgmt. v. Bank of America, 698 F.3d 202, 205 (5th Cir. 2012)
(internal quotation marks and citations omitted).

9. Defendant’s blog can also be considered on a motion to dismiss, even though it has not been attached to the complaint, because the complaint not only refers to it but depends on it. *Lone Star Fund V (U.S.) v. Barclays Bank*, 594 F.3d 383, 387 (5th Cir. 2010); *Kane Enters. v. MacGregor (USA)*, 322 F.3d 371, 374 (5th Cir. 2003); *Branch v. Tunnell*, 14 F.3d 449, 453-454 (9th Cir. 1994).

¹ Although the complaint suggests that both plaintiffs have brought trademark claims, only OMSJ has registered the mark and thus only it has standing to sue for trademark infringement.

I. THE TRADEMARK CLAIMS INFRINGE DeSHONG'S FREE SPEECH RIGHT TO DESCRIBE THE SUBJECT OF HIS CRITICISM.

10. Ordinarily, courts consider statutory issues first to avoid constitutional issues. However, trademark statutes are customarily construed in light of First Amendment concerns, particularly insofar as they distinguish between commercial and noncommercial speech. Accordingly, we begin our analysis with the First Amendment.

11. DeShong's speech about Baker and OMSJ is indisputably protected by the First Amendment. Baker's trademark claims seek government action by a court, which is subject to First Amendment scrutiny. *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 418 (1971). Unlike copyright cases, where fair use is co-extensive with the First Amendment, *e.g.*, *Harper & Row v. Nation Enters.*, 471 U.S. 539, 560 (1985), in trademark cases, First Amendment considerations routinely receive separate discussion, although they also inform statutory interpretation. Where a defendant is engaged in noncommercial speech, mere application of trademark law may violate the First Amendment. *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 32-33 (1st Cir. 1987). Even when trademarks have been used in a commercial context, courts still construe the trademark laws narrowly to avoid impingement on First Amendment rights. *E.g.*, *Cliffs Notes v. Bantam Doubleday*, 886 F.2d 490, 494 (2d Cir. 1989). First Amendment interests are weighed as a factor in deciding whether a trademark violation should be found, *e.g.*, *Anheuser-Busch v. Balducci Pubs.* 28 F.3d 769, 776 (8th Cir. 1994), and injunctions must be narrowly crafted to comply with the rule against prior restraints on speech. *Id.* at 778; *U-Haul Int'l v. Jartran*, 793 F.2d 1034, 1042 (9th Cir. 1986); *Better Business Bureau v. Medical Directors*, 681 F.2d 397, 404-405 (5th Cir. 1982).

12. In many cases, courts have struggled to decide whether a particular use of trademarks

constituted commercial or noncommercial speech. *Porous Media Corp. v. Pall Corp.*, 173 F.3d 1109, 1119-1121 (8th Cir. 1999); *Semco v. Amcast*, 52 F.3d 108, 111-114 (6th Cir. 1995); *U.S. Healthcare v. Blue Cross of Greater Philadelphia*, 898 F.2d 914, 927-939 (3d Cir. 1990). The question whether speech is commercial is significant not only because, as discussed below, Congress has limited the application of the Lanham Act to commercial speech, but also because commercial speech receives less protection under the First Amendment than does noncommercial speech. Indeed, recognition that the First Amendment would bar claims for misleading statements in noncommercial speech underlay Congress' establishment of the "commercial" requirement in section 43 of the Lanham Act. *Semco*, 52 F.3d at 111-112.

13. Thus, when, as in *Porous Media*, *Semco*, and *U.S. Healthcare*, a company criticizes a competitor during an advertising campaign, courts determine first whether the statements are noncommercial, and thus entitled to full First Amendment protection, or commercial, and thus entitled only to have their First Amendment interests weighed as part of a fair use or fair commentary defense. *Id.* Similarly, when sellers of T-shirts or other commercial products spoof trademarks or use trademarks to denounce political positions, courts decide whether the alleged infringers or diluters are predominantly engaging in commentary, or are using trademarks mainly to sell their own products. *E.g.*, *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968-970 (10th Cir. 1996); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402-403 (8th Cir. 1987). However, when an action is brought against plainly noncommercial uses of trademarks for political commentary, courts have not hesitated to afford full First Amendment protection against the trademark holder's claim, either by holding that First Amendment principles bar application of the statute, or by holding

that a state law is unconstitutional on its face or as applied in the particular case.²

14. DeShong's website is just the sort of commentary that courts assiduously protect. DeShong's criticisms of OMSJ's project would be pointless if he could not identify that project. Furthermore, it is not just the blog generally, but DeShong's use of OMSJ's trademark in his domain name, that constitutes protected speech. Even outside the domain name context, courts have held that the use of trademarks constitutes speech protected by the First Amendment, even when used **only** to designate source. *E.g.*, *Bad Frog Brewery v. New York Liquor Auth.*, 134 F.3d 87, 94-97 (2d Cir. 1998); *Sambo's Rest's v. Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981).

15. Using trademarks in domain names is analogous to using trademarks in book titles, to which the courts give First Amendment protection because they are part of the authors' expression, and call attention to the fact that the works in question contain content on those topics. *E.g.*, *Twin Peaks Prod. v. Public'ns Int'l*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). *Accord Mattel v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003).

16. OMSJ does not allege that DeShong's web site and domain name do anything other than utilize the name of its project, to call attention to DeShong's non-commercial discussion of the project. DeShong's use of the mark is, therefore, protected by the First Amendment, and the trademark claims in the complaint should be dismissed under Rule 12(b)(6) for that reason alone.

² *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp.2d 1161, 1167 (C.D. Cal. 1998); *ACLU of Georgia v. Miller*, 977 F. Supp. 1228, 1233 (N.D. Ga. 1997); *Lighthawk v. Robertson*, 812 F. Supp. 1095, 1097-1101 (W.D. Wash. 1993); *Stop the Olympic Prison v. United States Olympic Comm.*, 489 F. Supp. 1112, 1124-1125 (S.D.N.Y. 1980).

II. THE COMPLAINT SHOULD BE DISMISSED BECAUSE IT DOES NOT ALLEGE COMMERCIAL USE, AND BECAUSE THE BLOG IS PLAINLY NON-COMMERCIAL.

A. The Trademark Laws Apply Only to Commercial Uses of Trademarks.

17. Trademark law creates a commercial tort. The limitation of trademark law to commercial uses appears in the statutory language and caselaw, and its existence follows both from the limitations that the First Amendment places on the exercise of government authority restricting free speech, *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003), and because the Commerce Clause empowers Congress to regulate only matters with a nexus to economic activity. *United States v. Lopez*, 514 U.S. 549 (1995).

18. The First Amendment does not authorize regulating noncommercial speech simply because it is misleading. 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. The concept of regulating speech that has the potential to be misleading, even though it is not strictly speaking false, has developed over the thirty years since the Supreme Court first extended First Amendment protection to commercial speech. *Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2002); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001). Unlike noncommercial speech, commercial speech 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 Prods. Corp.*, 463 U.S. 60 (1983). *Accord Bates v. State Bar of Arizona*, 433 U.S. 350,

383 (1977) (“[T]he leeway for untruthful or misleading expression that has been allowed in other contexts has little force in the commercial arena . . .”); *Smith v. United States*, 431 U.S. 291, 318 (1977) (“Although . . . misleading statements in a political oration cannot be censored, . . . misleading representations in a securities prospectus may surely be regulated.”); *Young v American Mini Theatres*, 427 U.S. 50, 68 & n.31 (1976) (“[R]egulatory commissions may prohibit businessmen from making statements which, though literally true, are potentially deceptive[.]”); *Mattel v. MCA Records*, 296 F.3d 894, 905 (9th Cir. 2002) (“[C]onsumer protection rationale [for trademark relief] averting what is essentially a fraud on the consuming public is wholly consistent with the theory of the First Amendment, which does not protect commercial fraud[.]”).

19. Thus, in *TMI v Maxwell*, 368 F.3d 433 (5th Cir. 2004), a company that built houses under the name Trendmaker Homes sued a dissatisfied consumer who had established a web site using the domain names trendmakerhome.com and trendmakerhome.info, where he recounted his bad experience in buying a new home from the trademark holder. The district court awarded damages on an anti-dilution theory, but the Fifth Circuit reversed, holding that dilution claims could only be made against commercial uses of a mark. Significantly, the court noted that the same limitation would apply to claims against false and misleading descriptions under section 43(a)(1), one of the two Lanham Act provisions at issue here. 368 F.3d at 436 n.2. Indeed, in *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 552-553 (5th Cir. 2001), the Fifth Circuit drew a distinction based on whether speakers had an economic motive for the speech, holding that the Lanham Act could apply if the purpose of the speech was to sell more products, but not if the primary purpose of the speech was to express criticism of the trademark holder.

20. Similarly, in *CPC Int'l v. Skippy Inc.*, 214 F.3d 456 (4th Cir. 2000), the Fourth Circuit

implicitly recognized that trademark law is limited to commercial uses to be consistent with the First Amendment. The issue there was whether a trademark injunction forbade criticism of the maker of Skippy peanut butter at the domain name skippy.com. The court began by noting that the purposes of the trademark laws all related to giving consumers accurate information about commercial products, *id.* at 461, and that the trademark laws do not prevent critics from commenting on commercial products. *Id.* at 462. The court further held that criticism of the trademark holder was not commercial speech simply because it might impair the holder's commercial interests. Although the court's analysis was rooted in the First Amendment, the case surely shows that the trademark laws cannot be applied to forbid such noncommercial speech.³

21. Several other courts have rejected trademark infringement claims based on the use of a trademark in the domain name of a commentary web site because the web site was non-commercial. *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045, 1052-1055 (10th Cir. 2008); *Bosley Medical v. Kremer*, 403 F.3d 672, 677-670 (9th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003).

22. The limitation of trademark law to commercial situations follows from the distinctions that First Amendment law draws between commercial and noncommercial speech. The fundamental precept of trademark law is that it prevents uses of trademarks that are misleading, in that they are "likely" to be "confusing" to consumers. *Moseley v. V Secret Catalogue*, 537 U.S. 418, 429-430 (2003). To constitute infringement, use of the trademark need not be deliberately confusing, and it

³See also *White v. Samsung Electronics America*, 971 F.2d 1395, 1401 (9th Cir. 1992) (rules against exploitation of personality permissible under First Amendment because of commercial speech context); *E&J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1297 (9th Cir. 1992) (trademark injunction permissible because it limits commercial speech).

need not actually constitute a “false” statement of origin. Because these standards do not meet the First Amendment’s requirements for prohibiting **noncommercial** speech, the First Amendment provides an important reason to construe the trademark laws to apply only to **commercial** goods and speech.

23. Limiting the trademark laws to the commercial context also finds support in caselaw applying the Commerce Clause. The courts’ discussion of “commerce” consistently equates that term with “commercial” or “economic” activity. *E.g.*, *United States v. Kebodeaux*, 687 F.3d 232, 252 & n.54 (5th Cir. 2012); *United States v. Buculei*, 262 F.3d 322, 328-329 (4th Cir. 2001). Thus, the Commerce Clause allows Congress to regulate activities because they have a substantial effect on commerce, but only when the regulated activity “has been some sort of economic endeavor.” *United States v. Morrison*, 529 U.S. 598, 611 (2000). Moreover, the activity substantially **affected** must be an “economic enterprise or transaction.” *Hoffman v. Hunt*, 126 F.3d 575, 585-588 (4th Cir. 1997); *see Gibbs v. Babbitt*, 214 F.3d 483, 491-492 (4th Cir. 2000).

24. Accordingly, each of the statutory provisions at issue here is limited to commercial speech. OMSJ brings infringement claims under Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114, 1125(a). Section 32 of the Lanham Act, which bars infringement of registered marks, 15 U.S.C. § 1114, applies to anyone who “**use[s] in commerce** any reproduction, counterfeit, copy, or colorable imitation of a registered mark **in connection with the sale, offering for sale, distribution, or advertising of any goods or services.**” 15 U.S.C. § 1114(1)(a) (emphasis added). Similarly, section 43(a)(1)(A), which allows infringement claims against unregistered marks, applies when anyone “on or in connection with **any goods or services**, or any container for goods, **uses in commerce** any [mark], which (A) is likely to cause confusion, or to cause mistake, or to deceive as

to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval **of his or her goods, services, or commercial activities.**” 15 U.S.C. § 1125(a)(1)(A) (emphasis added).

25. In repeatedly limiting the Lanham Act to commercial communications, Congress evinced its awareness of the constitutional problems that it sought to avoid. Thus, for example, the House Judiciary Committee explained that the 1989 Lanham Act amendments would not affect noncommercial speech:

[T]he proposed change in Section 43(a) should not be read in any way to limit political speech, consumer or editorial comment, parodies, satires, or other constitutionally protected material. . . . The section is narrowly drafted to encompass only clearly false and misleading commercial speech.

135 Cong. Rec. H1207, H1217 (April 13, 1989).

Similarly, in adopting the 1996 amendments, Senator Hatch explained that the purpose of the statute’s noncommercial use exception was to protect ““parody, satire, editorial and other forms of expression that are not part of a commercial transaction.”” *Dr. Seuss Enters. v. Penguin Books USA*, 924 F.Supp. 1559, 1574 (S.D. Cal. 1996) (quoting legislative history), *aff’d*, 109 F.3d 1394 (9th Cir. 1997).

26. Plaintiffs’ state-law infringement claim rests on section 16.102 of the Texas **Business and Commerce** Code, which bars “use[] anywhere in this state . . . of a mark registered under this chapter⁴ in connection with **selling, distributing, offering for sale, or advertising goods or services.**” (emphasis added). As with the federal law under which OMSJ has sued, the wording of

⁴Although OMSJ alleges a federal trademark registration, Complaint ¶ 11, it never alleges that he has registered a trademark under Chapter 16 of the Texas Business and Commerce Code, which provides an additional reason why the state-law claim should be dismissed.

the state statute on which OMSJ relies allows claims only about commercial uses of trademarks.

B. The Complaint Does Not Allege Commercial Use in Connection With Defendant's Goods or Services, and in Fact DeShong's Blog Is Non-commercial.

27. The complaint should be dismissed because, although it alleges that DeShong has used the trademark improperly in the domain names of his blogs, it nowhere alleges use in connection with goods or services; it certainly does not allege that the mark is used in connection with advertising or sale of good and services, or that it is used in any commercial sort of way. In fact, the complaint repeatedly acknowledges that the purpose of the blog is to criticize the plaintiffs in this case, rather than to promote some commercial product.

28. Moreover, the complaint should be dismissed with prejudice, rather than with leave to replead, because it is apparent by looking at the blogs in question that they contain only non-commercial criticism of the trademark owner and its principal, plaintiff Baker. There are no advertisements, nothing for sale, not even solicitation of financial support for DeShong or any cause that he supports. Consequently, a trademark claim could not be properly pleaded based on this web site, and the complaint should be dismissed.

III. THE COMPLAINT SHOULD BE DISMISSED BECAUSE OMSJ HAS NOT PLEADED LIKELIHOOD OF CONFUSION ABOUT THE SOURCE OF PLAINTIFFS' WEB SITE, NOR COULD SUCH LIKELY CONFUSION BE PLEADED.

29. The third reason why the trademark claims should be dismissed is that although several paragraphs recite the phrase "likelihood of confusion," the complaint never alleges that viewers of DeShong's blogs are likely to experience confusion about whether OMSJ is the source or sponsor of the blog, and **that** is the only form of confusion that is actionable as trademark infringement.

A. Trademark Infringement Claims Require the Plaintiff to Plead and Prove That Consumers are Likely to Be Confused About the Source, Sponsorship or Affiliation of the Goods or Services.

30. The provisions of the Lanham Act and of the Texas Business and Commerce Code on which OMSJ has sued do not allow claims based on any sort of confusion. Rather, they require confusion about **source**. This limitation is explicit in the language of Lanham Act section 43(a)⁵ and Business and Commerce Code section 16.102,⁶ and although the limitation does not appear in the language of Lanham Act section 32, the case law clearly imposes that requirement.

31. Thus, in *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 536-37 (5th Cir. 1998), the Fifth Circuit insisted that “liability for trademark . . . infringement hinges upon whether a likelihood of confusion exists in the minds of potential consumers as to the source, affiliation, or sponsorship of the defendant’s product or service due to the use of the allegedly infringing marks.” *See also id.* at 542 (“The touchstone of infringement is whether the use creates a likelihood of confusion as to the “source, affiliation, or sponsorship.”). Similarly, in *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 663-64 (5th Cir. 2000) (citations omitted), the same court said ,

To prevail on its trademark infringement claim, PRL must show that Westchester’s use of the “Polo” mark creates a likelihood of confusion in the minds of potential consumers as to the “source, affiliation, or sponsorship” of Westchester’s magazine. . . . Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion.

32. The Sixth Circuit summarized the law as follows: “the imitated feature must be regarded

⁵ Use must be “likely to cause confusion, or to cause mistake, or to deceive **as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval** of his or her goods, services, or commercial activities.” (emphasis added).

⁶ Use must be “likely to deceive or cause confusion or mistake **as to the source or origin** of the goods or services.” (emphasis added).

by prospective purchasers as identifying the source of the product. . . . It is only when the feature in fact identifies source and the imitation is likely to deceive prospective purchasers who care about source that the imitator is subject to liability.” *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581, 590 (6th Cir. 1955). Other courts agree: “All of [the] legitimate trademark purposes derive ultimately from the mark’s representation of a single fact: the product’s source. It is the source denoting function which trademark laws protect, and nothing more.” *Anti-Monopoly v. Gen. Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979); *Smith v. Chanel*, 402 F.2d 562, 566-569 (9th Cir. 1968) (explaining how confining trademark law to this function best serves consumers’ and companies’ interests).

33. Some cases hold that domain names in the form of trademark.com can be the basis for an infringement claim, but that is true only when the domain name has been hijacked by a commercial competitor of the trademark holder to offer goods and services that compete with the trademark holder. *E.g., Brookfield Communications v. West Coast Video*, 174 F.3d 1036 (9th Cir. 1999). As applied to domain names, the concern about confusion is that a member of the public, wanting to find a particular website but not knowing its Internet address, may simply “name-guess” – type a trademarked name into his browser and be led to the wrong location. If the user thus reaches the website of a competitor of the trademark holder, the trademark holder may lose business because the user does not realize, until it is too late, that he is doing business not with the trademark holder but with somebody else. However, those cases have no application here, because DeShong is not OMSJ’s competitor, and is not using OMSJ’s trademark for a website about DeShong’s own products; his website is about OMSJ and its principal.

34. After all, domain names may designate the subject of websites, not just their source. For

example, “apples.com” could be the domain name of a website about apples, not the website of Apple computer company. Domain names can play the same role as book titles in denominating the subject of underlying web sites. Just as the title of a book may use a trademark truthfully to describe the content of the book, so may DeShong use plaintiff’s trademark as a domain name truthfully to describe the contents of his web sites. As Justice Holmes said in *Prestonettes v. Coty*, 264 U.S. 359, 368 (1924), “When the mark is used in a way that does not deceive the public, we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo.”

35. Consequently, numerous federal courts have held that trademarks may be used as domain names for web sites that are about markholders or about trademarked goods or services, even when the sites are operated by persons other than the markholders, because the names do not occasion confusion about source. *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Resch.*, 527 F.3d 1045 (10th Cir. 2008); *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770 (6th Cir. 2003); *Mayflower Transit v. Prince*, 314 F. Supp.2d 362 (D.N.J. 2004); *Ficker v. Tuohy*, 305 F. Supp.2d 569, 572 (D. Md. 2004); *Northland Ins. Cos. v. Blaylock*, 115 F. Supp.2d 1108 (D. Minn. 2000); *Cello Holdings v. Lawrence-Dahl Cos.*, 89 F. Supp.2d 464 (S.D.N.Y. 2000).

B. The Complaint Does Not Plead Likelihood of Confusion About Source, Nor Could It Plead Such Confusion Given the Nature of the Blog in Question.

36. The complaint should be dismissed because, although it uses the word “confusion” and the phrase “likelihood of confusion” in several different paragraphs, ¶¶ 15, 16, 18(c), 19, it never alleges likelihood of confusion about sponsorship, source or affiliation. Similarly, the complaint’s vague references to DeShong’s “infringement” of OMSJ’s mark, ¶¶ 5, 15, 17 should be ignored as

“labels and conclusions” under *Highland Capital Management*, 698 F.3d at 205.

37. Indeed, to the extent that the complaint specifies the confusion that the blog is allegedly causing, paragraph 15 alleges that Internet users will experience confusion about whether OMSJ is a good or bad company because they may believe the derogatory statements that DeShong makes about Baker and OMSJ: “using OMSJ’s trade name as a vehicle to disparage Plaintiffs’ business reputations”; “made it possible to put his defamatory message in front of prospective OMSJ clients”; “and therefore the defamatory and misinformation they contain appear”; “[w]hen users arrive at [DeShong’s] site . . . they are often confused by the infringer’s URL, web site and the information contained therein.” But, as the Court of Appeals for the First Circuit has explained, the harms that come from exposure to information about the trademark holder is not trademark injury. *Universal Communication Sys. v. Lycos*, 478 F.3d 413, 424 (1st Cir. 2007). “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.” *Id.* (Citation omitted).

38. Indeed, the **only** place in the entire complaint that comes close to being specific about which parts of DeShong’s blog are allegedly defamatory are paragraphs 16(a) to 16(h), although even these, as noted in the anti-SLAPP motion, fail to specify the allegedly defamatory words and hence are insufficient under Texas law. But paragraph 16 is part of the **trademark** allegations in the complaint, which shows how much the trademark claim is merely a defamation claim propounded under guise of a different legal theory that it cannot support.

39. Nor could any valid claim of likelihood of confusion be pleaded in this case. First, as discussed in Part II A, above, domain names that accurately depict the subject of the web site do not

create an actionable likelihood of confusion about source. Second, the underlying basis for suing over trademarks in domain names—worry about the impact of “name-guessing”—does not apply here. After all, DeShong’s domain names are not simply the trademark with “.com” added at the end; they include the word “truth,” which is not part of OMSJ’s trademark. There is no likelihood that anybody looking for plaintiffs’ web site, knowing OMSJ’s trademarked name, would type “hivinnocencegrouptruth” into his web browser.

40. In that regard, the facts here resemble those in *Ty v. Prettyman*, 306 F.3d 509 (7th Cir. 2002). In that case, the Seventh Circuit overturned an injunction issued against an unauthorized reseller of Beanie babies who used the name “bargainbeanies.com” for her marketing website. Because Prettyman was entitled under trademark law to tell the consuming public that she sold Beanie babies through her website, Judge Posner held that trademark law could not be used to deprive Prettyman of the right to truthfully identify the content of her website by placing the trademark “Beanie” in her domain name. *Id.* at 512.

41. Finally, OMSJ attempts to salvage its trademark claim by alleging that, because DeShong’s web sites show up among the results when Internet users use “hiv innocence” as a search string using search engines such as Google, this appearance causes “initial interest confusion.” Complaint ¶¶ 15, 16(h). However, the Fifth Circuit has never held that initial interest confusion is alone a basis for imposing liability for trademark infringement; at most, it can affect the assessment of the “actual confusion” factor in assessing a likelihood of confusion. *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 203-04 (5th Cir. 1998); *see also FPX, LLC v. Google, Inc.*, 276 F.R.D. 543,

549-50 (E.D. Tex. 2011).⁷ Nor, indeed, is OMSJ entitled to invoke trademark law to punish the author of a critical web site for the fact that a search engine reveals the critical web site when Internet users enter the trademark as a search term.⁸ The very reason why search engine users use search engines is to find a **range** of web sites relevant to the search term; it is certainly not solely for the purpose of finding the trademark holder's official web site. 4 McCarthy on Trademarks § 23:6, at 23–55 n.13 (2011). *See also Jenzabar v. Long Bow Group*, 82 Mass. App. Ct. 648, 977 N.E.2d 75 (Mass. App. Ct. 2012) (“Internet users . . . understand that a Google search returns a list of pages of varying relevance from a wide range of sources.”).

42. Moreover, the complaint does not allege initial interest confusion **about source**, which is fatal to OMSJ's reliance on this doctrine. And the complaint itself belies any claim that an Internet user encountering DeShong's blog among the search engine results would experience the slightest confusion about whether clicking on that search result would bring the user to OMSJ's web site: subparagraph 16(h) alleges that a search for the term “HIV Innocence Group” produces, among other search results, a listing linked to DeShong's web site that reads, “Why the HIV Innocence Group is sick and evil bullshit.” No reasonable Internet user would expect that clicking such a critical search result would bring the user to the official web site of the HIV Innocence Group.

43. As DeShong recounts in his affidavit accompanying his special motion to strike, for a

⁷Indeed, “initial interest confusion” has encountered increasing skepticism in the courts, because it is, in the end, an incoherent doctrine. Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L. J. 507, 559-575 (2005) (doctrine 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).

⁸The search result described in the complaint is attached to the DeShong Declaration as Exhibit H.

period of time after OMSJ first initiated its trademark claims against him through the UDRP, he placed his web sites about Baker and OMSJ under password protection until he was sure that he could obtain legal counsel to protect his rights. DeShong Affidavit ¶ 7. The search result alleged in the complaint was obtained while the web sites were closed to the general public (including, necessarily, to search engine spiders, the mechanisms by which search engines crawl the web to check for new content). Now that DeShong has counsel, he has reopened the web sites to public viewing, and as Exhibit I to the DeShong Affidavit shows, the Google search engine currently returns this search result for his HIV Innocence Group Truth blog:

HIV Innocence Group Truth | Truthfully Deconstructing The HIV ...
hivinnocencegrouptruth.com/
Jan 15, 2012 - Truthfully Deconstructing The HIV Innocence Group

This search result truthfully informs search engine users that the site is one that analyzes plaintiff; it in no way suggests that the link goes to the OMSJ's own web site. No likelihood of confusion about source could be alleged here.⁹

C. The Complaint Also Does Not Plead Facts That Meet the Heightened Standard for Trademark Claims About Expressive Works.

44. In *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), the Second Circuit accommodated the First Amendment interests of authors and artists by adopting a rule governing infringement claims against artistic or literary products made for sale, such as mass publications, movies and musical recordings. Under this approach, the Lanham Act cannot be applied unless the trademark in the title “has no artistic relevance to the underlying work whatsoever or, if it has some

⁹The complaint erroneously assumes that search engine result listings are designed by the web sites themselves, when, in fact, it is the search engine that creates the search results listings using a proprietary algorithm. DeShong Affidavit ¶ 13.

artistic relevance, unless the title **explicitly** misleads as to the source or the content of the work.” *Id.* (emphasis added). If that condition is met, then the plaintiff must allege (and ultimately prove) that the author of the work used the trademark with intent to create confusion about source. The Fifth Circuit has embraced the *Rogers v. Grimaldi* standard and extended it to the titles of expressive works generally. *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 664 (5th Cir. 2000). Other courts have followed it as well. *E.S.S. Entm’t 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).

45. OMSJ’s trademark claims have not been pleaded to this standard. The domain names for hivinnocenceprojecttruth.com and hivinnocencegrouptruth.com are plainly relevant to the content of those blogs, and neither name explicitly misleads about the source or content of the work. Nor has plaintiff pleaded intent to deceive about source. Consequently, the trademark claims should be dismissed for this reason as well as those set forth in Parts I and II.

IV. THE COMPLAINT SHOULD BE DISMISSED BECAUSE DeSHONG HAS MADE FAIR USE OF THE PHRASE “HIV INNOCENCE” TO DESCRIBE THE GROUP THAT HIS BLOGS CRITICIZE.

46. Cases involving critical websites fall under the rubric of “nominative fair use,” where the speaker uses the trademark to speak about the trademark holder or its goods and services. *Brookfield*, 174 F.3d at 1065-66; *New Kids on the Block v. New America Pub.*, 971 F.2d 302, 306-309 (9th Cir. 1992). As Judge Kozinski said in *New Kids*,

one might refer to “the two-time world champions” or “the professional basketball team from Chicago,” but it’s far simpler (and more likely to be understood) to refer to the Chicago Bulls. In such cases, use of the trademark does not imply sponsorship or endorsement of the product because the mark is used only to describe the thing, rather than to identify its source. . . . 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.

971 F.2d at 306.

The Fifth Circuit endorsed the doctrine of nominative fair use in *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 536 (5th Cir.1998), and has applied the doctrine several times since then. *E.g.*, *Board of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008). If fair use is established under the Lanham Act, the defense also precludes the state law claims. *Rin Tin Tin, Inc. v. First Look Studios*, 671 F. Supp.2d 893, 902 (S.D. Tex. 2009)

47. And although fair use is an affirmative defense, such defenses can form a basis for dismissal under Rule 12(b)(6) if the applicability of the defense is revealed on the face of the complaint or by documents properly considered on such a motion because the complaint depends on them. *Jones v. Bock*, 549 U.S. 199, 215 (2007); *Kansa Reinsurance Co. v. Cong. Mortg. Corp. of Tex.*, 20 F.3d 1362, 1366 (5th Cir.1994); *Clark v. Amoco Prod. Co.*, 794 F.2d 967, 970 (5th Cir.1986). In such cases, the complaint is said to have a “built-in defense.” *Garrett v. Commonwealth Mortg. Corp. of America*, 938 F.2d 591, 594 (5th Cir. 1991). “It is clearly proper in deciding a 12(b)(6) motion to take judicial notice of matters of public record.” *Norris v. Hearst Trust*, 500 F.3d 454, 461 n.9 (5th Cir. 2007). DeShong’s blogs are matters of public record and have been put before the Court as attachments to DeShong’s affidavit.

48. The complaint itself comes close to showing that the trademark claims are precluded by the defense of nominative fair use. OMSJ has pleaded that the blogs are directed to criticizing Baker and OMSJ, thus showing that domain names using the phrase “HIV Innocence” are a completely accurate depiction of a central topic of the blogs. Coupled with the blogs themselves, which can be

accessed online but which are reprinted and attached to the DeShong affidavit, it is apparent that the domain names simply identify blogs that are about the trademark holder. Nobody could read either blog and believe that OMSJ sponsors or approves them. Indeed, the most recent post on <http://hivinnocencegrouptruth.com/> is a description of plaintiff's unsuccessful legal attack on the blogs. The nominative use defense provides an additional ground for dismissal of the trademark claims.

V. THE DEFAMATION AND DISPARAGEMENT CLAIMS SHOULD ALSO BE DISMISSED.

49. Counts II and III of the complaint should also be dismissed for failure to state a claim on which relief can be granted, for some but not all of the reasons set forth in defendant's special motion to strike under the Texas anti-SLAPP statute. Under that law, once defendant has shown that plaintiff has sued over speech that is within the scope of the statute, it is plaintiff's burden to make an evidentiary showing sufficient to show a prima facie case; under Rule 12(b)(6), by contrast, only the complaint and matters referenced in the complaint or on which the complaint depends, can be considered in deciding whether a viable claim has been alleged.

50. Because the complaint alleges the dates on which allegedly defamatory or disparaging statements were made, the Court can apply the statute of limitations under Rule 12(b)(6) to eliminate most of Counts II and III for that reason alone, and the failure to alleged the defamatory words with sufficient specificity to permit the Court to ascertain whether plaintiffs are suing over objectively verifiable statements that are of and concerning each plaintiff, or only suing over generalities and opinions, warrants dismissal of the remaining parts of the claim. *See, e.g., Perkins v. Welch*, 57 S.W.2d 914, 915 (Tex.Civ.App. - San Antonio 1933) (requiring specific pleading of defamatory

statements); *Granada Biosciences v. Barrett*, 958 S.W.2d 215, 222 (Tex. App. - Amarillo 1997, pet. denied) (disparaging words must be specifically pleaded). Indeed, to the extent that of-and-concerning issues are presented, as also argued in the anti-SLAPP motion, dismissal for lack of standing may also be appropriate under Rule 12(b)(1).

CONCLUSION

51. The motion to dismiss should be granted.

Respectfully submitted,

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