

In his motion for summary judgment, plaintiff Christopher Lamparello argued that his use of the domain name www.fallwell.com for a web site criticizing defendant Jerry Falwell is protected speech under the First Amendment. He showed that the trademark laws were not violated both because the web site is non-commercial, and because a trademark may properly be used in a domain name for a web site about the trademark holder so long as the web site itself is not confusing about the source of the web site. He also argued that he did not register the name with a “bad faith intent to profit” and that Falwell’s trademark claims were untimely.

In his memorandum in support of his motion for summary judgment (“Fal. Mem.”), Falwell concedes that commercial use is required for claims under section 43 of the Lanham Act, but contends that it is not required for infringement claims under section 32 of the Act and that, in any event, Lamparello’s use is commercial. Falwell also argues that even if the web site is not confusing, the multi-factor likelihood of confusion test together with the doctrine of initial interest confusion warrants a finding that the domain name is infringing. He also asserts that the nine-factor test under the cybersquatting law supports the conclusion that Lamparello had a bad faith intent to profit, and that consequently the Court should award \$1 million dollars in statutory damages as well as attorney fees. As explained below, none of Falwell’s arguments supports judgment in his favor. In fact, consideration of the issues that he raises shows the propriety of summary judgment for Lamparello.

RESPONSE TO STATEMENT OF UNDISPUTED FACTS

Falwell’s Statement of Undisputed Facts is set forth in a table that provides no numbering for the “facts,” and it is often difficult to understand precisely which facts are said to be undisputed, and which statements in the memorandum of law are attested by the Falwell and Peterson affidavits. Attached to this brief is a revision of the table that numbers the statements from 1 to 26. Falwell’s

facts are accepted except as indicated here:

3. It is unclear what about “Opposition to sodomy” is said to be undisputed. It is undisputed that Falwell disapproves of sodomy and that many other people disapprove of it.

4. It is unclear what about “Choice of contested domain name fallwell.com” is said to be undisputed. It is undisputed that Lamparello chose that domain name for his web site, and that he identified reasons for his choice in his written discovery responses and in his affidavit.

10. It is unclear what about “Plaintiff’s metatags” is said to be undisputed. It is undisputed that the meta tags set forth on page 10 of Falwell’s brief have appeared on the home page of Lamparello’s web site since it was created. Lamp. Aff., attached CD (filename for home page is “Jerry Falwell’s anti-gay preaching and writing causes death”). However, Falwell’s counterclaim does not allege any violation based on the meta tags, and a new claim cannot be added to a case merely by inclusion in a summary judgment brief.

11. It is disputed that “Falwell” is “uncommon.” The stipulations reveal that, with nearly 1000 people named Falwell living in the United States, it is more common than Fallwell, Lamparello or Midlen, and less common than Levy or Hilton. Stip. 2, 28-32.

13. It is undisputed that plaintiff uses the domain name fallwell.com on the Internet. The implication that Internet use is a “service” for the purpose of analyzing the *Pizzeria Uno* factors is a statement of law and is incorrect. The Patent and Trademark Office has ruled that “Advertising one’s own products or services on the internet is not a service.” Examination Guide No. 2-99, *Marks Composed, in Whole or in Part, of Domain Names* (September 29, 1999) (Part II(B)).

16. The statement that “plaintiff in the past has sold goods on his web site” is false. The undisputed evidence is to the contrary. Lamparello’s Answer to Falwell Interrogatory No. 18

(although Falwell filed a printed version of the answers that were emailed to his counsel, the signed copy is attached). Falwell is apparently referring to Answers to Interrogatory No. 4, 5, and 17, which state that, beginning in 1999 and ending in 2001, fallwell.com recommended to its readers a book on the interpretation of Bible verses, and linked to a different web site where the book could sometimes be bought. *See also* Lamparello Affidavit ¶ 13.

21. It is undisputed that, on two occasions, Falwell's counsel Mr. Midlen sent emails to Lamparello using the accurate name and address that Lamparello listed when he registered the domain name, expressing the opinion that Lamparello had violated the trademark laws, and demanding that he relinquish the domain name or face litigation. Admissions Nos. 1, 4 and 8.

23. The undisputed evidence contradicts Assertion No. 23. As stated in Responses to Admissions Requests Nos. 6, 7, and 12, and shown in Falwell Exhibit 13, Lamparello listed "Lamparello International" as the "Registrant" and listed "Lamparello, Christopher" as the "Administrative Contact"; Lamparello provided accurate address, telephone and email information as well, and Falwell had no difficulty using the information provided to contact Lamparello with his demand that the domain name be relinquished and to file his UDRP complaint.

24. It is undisputed that the registration agreement signed by Lamparello incorporates a lengthy dispute resolution policy that includes the quoted representation. The question whether the domain name "interfere[s] with or infringe[s] on" anybody's rights is the issue in this case.

26. Although its relevance is dubious, the parties have stipulated that Lamparello had no formal religious training apart from what he received as a student at a Catholic high school. Stip.

34.

SUMMARY OF ARGUMENT

Falwell’s opening brief seeks to take advantage of what he deems a key difference between sections 32 and 43 of the Lanham Act, 15 U.S.C. §§ 1114, 1125 –

[W]hile the prohibitions of the Lanham Act § 43(a) are limited to “commercial” activities, the prohibition of § 32(1)(a) on infringements of registered marks has no such “commercial activity” requirement.

Fal Mem. at 16 (quoting decision of UDRP panel).

Falwell acknowledges that section 32 can only be invoked for infringement of registered trademarks, and that, therefore, infringement of his “Jerry Falwell” and “Falwell” marks can be remedied only under section 43. Fal. Mem. 10, 13. Even though he admits that his only registered trademark is “Listen America with Jerry Falwell,” he urges that his surname “Falwell” is the most important part of the registered mark and hence section 32 is violated.

Part A below shows both that Falwell cannot show infringement of his one registered mark by the use of a name that is similar to his surname alone, and that section 32 does require commercial use. Part B addresses Falwell’s contention that commercial use has been shown here. Part C rebuts the contention that the Fourth Circuit’s *Pizzeria Uno* factors show a likelihood of confusion, and shows that neither actual confusion nor initial interest confusion apply here. Part D shows that the “damage” requirement for section 43 cannot be met, and Part E rebuts Falwell’s claim that “bad faith intent to profit” factors under the ACPA show a violation of that statute. Finally, Part F addresses Falwell’s claims for statutory damages and attorney fees in the event liability is established.

ARGUMENT

A. Falwell Does Not Have a Tenable Infringement Claim under Section 32 of the Lanham Act Because Fallwell.com Cannot Be Confused With “Listen America with Jerry Falwell,” and Because “Use in Commerce” Is Required.

Falwell's first argument is that, unlike section 43, section 32 does not require a showing of commercial use; he contends that his one registered trademark, "Listen America with Jerry Falwell," is infringed by the domain name fallwell.com. However, the infringement argument is faulty, and in any event Falwell is wrong that section 32 does not require commercial use.

The fundamental flaw in Falwell's attempt to rely on section 32 is that this section can be invoked only to protect **registered** trademarks, *Superformance Intern. v. Hartford Casualty Ins. Co.*, 332 F.3d 215, 221-222 (4th Cir. 2003), and the Lanham Act specifically forbids the registration of any trademark that consists of "primarily merely a surname." Section 2(e)(4), 15 U.S.C. § 1052(e)(4). That is why, in ruling that domain names cannot normally be registered as trademarks, the Patent and Trademark Office has stated, "If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act §2(e)(4)." Examination Guide No. 2-99, *Marks Composed, in Whole or in Part, of Domain Names* (September 29, 1999).

Most of Falwell's argument for confusing similarity is based, not on the level of public recognition for "Listen America with Jerry Falwell," but on public recognition of Falwell's surname and full name alone. Fal. Mem. 11-12. But the bare names are not the registered marks, and the degree of recognition of the names is relevant only to his unfair competition claim under section 43. Indeed, given the fact that the similarity that is relevant to a domain name claim is based on concerns about "name-guessing," the fact that nobody looking for the registered mark "Listen America With Jerry Falwell" would type "fallwell" into his browser is fatal to the section 32 claim.

Falwell also cites the Federal Circuit's decision in *Hewlett Packard Co. v. Packard Technologies*, 281 F3d 1261 (2002), in which the question was whether Packard Press improperly

encroached on the trademark Hewlett-Packard by seeking to register “Packard Technologies” while disclaiming any rights in the term “Technologies.” The court ruled that Packard was a prominent part of the two-word trademark “Hewlett-Packard” and that “Packard” was the dominant part of “Packard Technologies” because “Technologies” was not claimed as a mark. Accordingly, the sought-after registration was likely to be confused with HP’s mark when considered in conjunction with the other factors of the likelihood of confusion test. Similarly, in *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1529-1530 (4th Cir. 1984), the court stated, “Where the proposed mark consists of but two words, one of which is disclaimed, the word not disclaimed is generally regarded as the dominant or critical term . . .” That is a far cry from this case, however, where Falwell’s only registered mark is the five-word “Listen America with Jerry Falwell.” Indeed, if Falwell were correct that Falwell’s surname were the dominant part of the “Listen” mark, there would be no need for Falwell to seek to register “Jerry Falwell” as a trademark, as he is currently trying to do. Cpt. ¶ 25; Levy Aff. ¶ 2 and Exhibit A. In sum, there is insufficient similarity between fallwell.com and “Listen America With Jerry Falwell” to present a section 32 infringement claim here.¹

Moreover, Falwell is wrong to assume that section 32 is violated so long as Lamparello’s actions meet the “in commerce” requirement of the Act, Fal. Mem. at 10, 15-16, which, he insists, should not be considered to be in contradistinction to “noncommercial,” but simply as signifying “interstate or foreign commerce.” *Id.* 15. This argument does not focus on the relevant language of the statute. To be sure, section 32(1) of the statute, as first enacted in 1946, provided for a cause

¹Falwell’s brief also argues, at 12, that the Court should consider “the source identification portion of a mark where such a portion exists.” Br. at 12. However, as shown in Lamparello’s opening memorandum, at 18-19, a trademark is protected only as a source identification. Hence, if the entire mark is not a source identification, it is not protected against infringement.

of action against “any person who shall, in commerce, infringe a registered trademark in a manner there detailed.” *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283 (1952). Thus, when, as in *Steele*, courts first addressed the meaning of “in commerce,” they looked only to this language and at the definition of “commerce” in section 45, and decided that the Lanham Act reached to the full extent of Congress’ power under the Commerce Clause. But such cases, which were litigated between two commercial actors, had no occasion to decide whether the Act applied to non-commercial activities.

However, the 1962 amendments to the Lanham Act, 76 Stat. 773, changed the structure of the claim for trademark infringement, requiring that the defendant have made a “use in commerce” of the plaintiff’s trademark. 15 USC § 1114(1)(a). In 1988, Congress defined the phrase “use in commerce” with the express purpose, discussed in our opening brief at 9-10, of **limiting** its scope to use in the ordinary course of trade. Falwell ignores the statutory definition of “use in commerce” and addresses only the “in commerce” language.

For the same reasons, Falwell is wrong to rely on an excerpt from the UDRP ruling in his favor stating that section 32 is exempt from the commercial use requirement that admittedly applies to section 43.² The UDRP panel cited *United We Stand America v. United We Stand New York*, 128 F.3d 86 (2^d Cir. 1997), a case where a national party sued to stop local adherents of Ross Perot from raising money, operating an office, and conducting other activities under a name suggesting they were a state affiliate of the national party. That court discussed the well-established law holding that the “commerce” to which the Lanham Act applies includes foreign commerce and intra-state commerce having an effect on interstate commerce – reaching to the extent of the Commerce Power

²Falwell properly acknowledges that the decision of the UDRP panel receives no deference in this Court. Mem. 12.

– and then just assumed that “‘use in commerce’ denotes Congress’ authority under the Commerce Clause rather than an intent to limit the Act’s application to profit-making activity.” *Id.* at 92-93. This assumption ignored the fact that, just as “commerce” is defined by the Lanham Act, so too is “use in commerce” defined by the Act. The meaning of “use in commerce” is discussed in Lamparello’s summary judgment memorandum, and will not be further discussed here.

The *United We Stand* court failed to come to grips with the historical development of the statutory language, not to speak of the First Amendment considerations that impel construction of the Lanham Act to avoid applying the doctrine of “likelihood of confusion” to purely non-commercial speech. Accordingly, Falwell cannot evade the commercial use requirement by relying on section 32 in addition to section 43.

B. There Is No Evidence of Commercial Use on Lamparello’s Web Site.

Falwell argues the evidence shows that Lamparello’s web site at one time sold a book, and, for that reason, his site’s immunity from coverage by the trademark law based on non-commercial use has been irrevocably compromised. However, Falwell has misstated the evidence.

The undisputed evidence is that Lamparello’s web site has **never** sold any good or services. Lamparello’s Answer to Interrogatory No. 18.³ Although from 1999 to 2001 Lamparello’s web site did recommend a book about certain Bible verses, Lamparello has no relationship to author Daniel Helminiak or to his publisher, Lamp. Aff. ¶ 13, and Lamparello has **never** received any revenue of any kind for the content placed on his web site. *Id.* As explained in Lamparello’s opening brief, the mere existence of links to other sites that may be commercial is not a sufficient

³ Falwell submitted a printed version of the answers that were emailed to his counsel. However, the signed copy is attached. Unlike Falwell’s affidavits and discovery answers, which are sworn on information and belief, there is no such qualifier in Lamparello’s certifications.

basis for finding commercial use, at 15-16, and *PETA v. Doughney* is inapposite, at 16-17; that argument is not repeated here.

Nor does this case present any similarity to the other cases on which Falwell relies. Mem. at 14. In *Planned Parenthood v. Bucci*, 1997 WL 133313 (S.D.N.Y. 1997), *aff'd mem.*, 152 F.3d 920 (2d Cir. 998), the defendant's home page opened up with the legend "Welcome to the Planned Parenthood Home Page," and then showed the cover of the book that Bucci was promoting; Bucci acknowledged that the reason he put the book on his home page was to help the author plug it. *Id.* at *1, *4. Similarly, in *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J. 1998), the defendant's home page linked directly to his own group's Outreach Judaism web site, which marketed Judaica, and the defendant acknowledged that his purpose was to divert potential converts to that competing commercial web site. *Id.* at 290-291. Here, Lamparello's only purpose is to engage in purely non-commercial expression, and he mentioned the book because he concluded that it did a better job than he did of explaining why the Bible should not be interpreted as a blanket condemnation of homosexuals. That Lamparello made a favorable reference to a commercially available book, for a non-commercial purpose, deep inside the web site, does not show that "[Falwell]'s trademark has been used for commercial gain," *CPC Int'l v. Skippy Inc.*, 214 F.3d 456, 461 (4th Cir. 2000), and it does not transform the otherwise non-commercial use of the domain name into a commercial one.

Moreover, even if the reference to the Helminiak book were deemed a violation of the Lanham Act, the violation ended in 2001, well before the beginning of the two-year limitation period for claims under sections 32 and 43. No damages can be awarded for violations that occurred outside the limitations period, and there is no basis for any injunction absent some evidence that the

the violation will likely recur.⁴

C. The Undisputed Evidence Shows That There is No Likelihood of Confusion.

Lamparello's opening brief, at 19-24, argued that the use of a trademark in the domain name for a web site that is about the trademark holder is non-confusing and is fair use, as a matter of law, so long as the web site itself is plainly not confusing about whether the trademark holder is the sponsor or source of the web site. Falwell's motion for summary judgment ignores that analysis. Instead, he argues that likelihood of confusion is shown by the inclusion of words related to Falwell in the meta tags of Lamparello's web site, Fal. Mem. at 9-10, 17, 19, 24, and by an analysis of the multiple factors that courts across the country consider when deciding whether one trademark poses a likelihood of confusion with another. *Id.* at 21-23. Neither argument supports Falwell.

1. Meta Tags.

With respect to the meta tags, neither the counterclaim nor the answer contains any allegation based on meta tags, and it is well-established that pleadings cannot be amended, or summary judgment against a party avoided, through allegations put forward for the first time in a summary judgment brief. *Griffin v. Potter*, 356 F.3d 824, 830 (7th Cir. 2004); *In re Merrill Lynch Research Reports*, 289 F. Supp.2d 429, 436 (S.D.N.Y. 2003) ("plaintiffs may not amend their pleadings by way of their briefs [to add allegations to resist motion to dismiss]"). Indeed, when Lamparello asked

⁴Even if an injunction were appropriate, the cardinal principle under the Lanham Act is that the least intrusive remedy should be selected, even in the commercial context, but especially where otherwise protected speech is involved. *CPC v. Skippy*, 214 F.3d 456, 461 (4th Cir. 2000); *Anheuser-Busch v. Balducci Publications*, 28 F.3d 769, 778 (8th Cir. 1994); *Better Business Bureau v. Medical Directors*, 681 F.2d 397, 404-405 (5th Cir. 1982). Under this principle, if there were to be any injunction at all, it would only prohibit Lamparello from placing further links to commercial sites on his fallwell.com web site.

Falwell to specify the facts on which he based his claim of likelihood of confusion, Falwell said nothing about the meta tags on Lamparello's web site. Levy Affidavit Exhibit D, Answer to Interrogatory No. 1. Although Falwell's memorandum asserts that the meta tags "were unknown to Counterclaimant Falwell at the time of submission of his case to the [UDRP] Panel," Mem. 17, the same meta tags were on the home page of Lamparello's web site at the time of the initial disclosures, *see* Lamparello Affidavit ¶ 12 and attached CD, and indeed for years before that. Falwell should not be permitted to add this new claim on the eve of summary judgment.⁵

2. Factors Bearing on Likelihood of Confusion.

"The ultimate question is 'whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or indeed simply confused, as to the source of the goods in question.'" *Perini Corp. v. Perini Constr.*, 915 F.2d 121, 127 (4th Cir. 1990). *Pizzeria Uno* directs courts to consider (1) the strength or distinctiveness of the plaintiff's mark, (2) the similarity of the two parties' marks, (3) the similarity of the goods and services the marks identify, (4) the similarity of the facilities the two parties use in their businesses, (5) the similarity of advertising used by the two parties, (6) the defendant's intent, and (7) actual confusion. *Petro Stopping Centers, L.P. v. James River Petroleum*, 130 F.3d 88, 91 (4th Cir. 1997), *citing Pizzeria Uno*. *Perini* introduced yet another factor, the sophistication of the buyers. 915 F.2d at 127-128. The undisputed evidence on these factors supports judgment in favor of Lamparello, as a matter of law.

The strength of Falwell's mark. The stipulated fact that Falwell's surname is distinctive

⁵In any event, the trademark laws do not forbid the use of meta tags to attract attention to a critical web site or a web site that bears a fair relationship to the trademark holder. *Playboy Enterprises v. Welles*, 79 F.3d 796 (9th Cir. 2002); *J.K. Harris & Company v. Kassel*, 253 F. Supp. 2d. 1120 (N.D. Cal. 2003); *Bihari v. Gross*, 119 F. Supp.2d 309, 317 (S.D.N.Y. 2000).

says little about the relative strength of the mark, because Jerry Falwell shares that surname, and the similar Fallwell surname, with nearly 1500 other people. Stip. ¶ 2, 32. Many of these other people (and one corporation) use their names in connection with commercial activities, Stip ¶¶ 4-6; Falwell Admissions Nos. 6-9; Levy Affidavit Exhibit C, and hence have common-law trademarks in their names. And although Jerry Falwell is far more notorious than the other similarly named persons, the search engine results attached to the summary judgment motions of both sides reveal that the notoriety stems more from the firestorm of criticism that he attracts than from his self-promotion,. Surely, the fact that the surname has become so well identified with Jerry Falwell because of the extent of public criticism should not be a reason to forbid critics from using his surname to identify a web site that criticizes him.

Moreover, Falwell has not claimed that his mark in his surname is famous (because other Falwells and Fallwells made commercial use of the name before he did, Stip. 4; Fal. Adm. 6-9), and he has disclaimed any dilution theories. Falwell Answer to Interrogatory No. 4. Even in the limited “industry” of using religious proselytizing to make money, at least one person with the surname Fallwell solicits donations on the Internet. In sum, the distinctiveness of Falwell’s last name does not make his mark particularly strong under the first factor.

Similarity of marks. Lamparello’s domain name fallwell.com is similar to defendants’ common law Falwell mark, but for the reasons discussed above at pages 5 to 6, it is not similar to the registered mark “Listen America With Jerry Falwell.” In any event, this factor is not very helpful to Falwell, because Lamparello is using “fallwell.com” for a web site that is **about** Falwell, which is fair use. The reason why “similarity of marks” is often a factor that weighs in favor of likelihood of confusion is that rival manufacturers have a wide range of names they can pick for

their own products, and when they pick a name that is highly similar to the trademark owner's name, they are causing likely confusion. But when the mark is used for purposes of identifying the subject of criticism, similarity is not so helpful to the mark holder because there is an alternate explanation for the use of the name – to identify the product being criticized. Indeed, similarity of marks will always be present when the defendant is engaged in fair use. “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.” *CPC v. Skippy*, 214 F.3d 456, 462 (4th Cir. 2000) A factor that will always be present when fair use is claimed should not weigh in favor of a finding of likely confusion, lest the very presence of fair use be sufficient to show likely confusion. *See also Anheuser-Busch v. L&L Wings*, 962 F.2d 316, 321 (4th Cir. 1992) (similarity does not favor markholder when parody is at issue).

Relatedness of Goods and Services. Falwell argues that the parties operate in the same “relevant market, i.e., the Internet.” However, in the examination guide that explains why attempts to register domain names as trademarks must generally be rejected, the Patent and Trademark Office refused to countenance such an analysis, because “Advertising one’s own products or services is not a service. [citation omitted]. Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity.” Examination Guide No. 2-99, *Marks Composed, in Whole or in Part, of Domain Names* (September 29, 1999). This factor also does not support Falwell because it has been stipulated that the Lamparello’s web site does not sell goods or services. Stip. 1. Although the web site did recommend a book several years ago, it was never sold on the site and the references were removed voluntarily long before suit was brought.

Similarity of facilities used in business and similarity of advertising. These factors similarly favor Lamparello because Lamparello does not use the web site for business and he does not advertise the web site.

Lamparello's intent. Falwell's only discussion of this factor is the cryptic comment that "Lamparello's intent is admitted." Fal. Mem. at 22. But *Pizzeria Uno* makes clear that the only intent that is relevant is "intent to confuse the buying public." 747 F.2d at 1535. *Accord Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234, 241 (4th Cir. 1997); *Anheuser-Busch v. L&L Wings*, 962 F.2d 316, 321 (4th Cir. 1992). No such intent is present here. To be sure, when the seller of a rival product deliberately chooses a domain name for a web site for its own products using a name known to be the trademark of another person, as in *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036, 1059 (9th Cir. 1999), an inference of bad intent is appropriate. But when the trademarked name is used for the domain name of a web site that is about the trademarked product, quite the opposite intent should be inferred. Otherwise, any fair use would support a finding of bad intent. In this case, the undisputed evidence is that Lamparello's purpose in choosing his domain name was to denominate accurately the topic of his web site. Lamp. Aff. ¶ 3.

Further supporting Lamparello on the "intent" factor are the facts that his web site includes a strong disclaimer and a hyperlink to Falwell's own web site, at both the top and bottom of the home page. The disclaimers negate any inference that Lamparello was trying to confuse Internet viewers or to keep them from finding Falwell's own site. Indeed, the Second Circuit has held that the First Amendment requires courts to consider the use of disclaimers when they can dispel any confusion that may exist. *Consumers' Union v. General Signal Corp.*, 724 F.2d 1044, 1053 (2^d Cir. 1983). Especially when, as here, the trademark claim is relatively weak, a prominent disclaimer may

provide all the protection against confusion that the mark holder deserves. *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 673 (5th Cir. 2000) (reversing because district court refused to consider disclaimers); *Soltex Polymer Corp. v. Fortex Indus.*, 832 F.2d 1325, 1329-1330 (2^d Cir. 1987). Indeed, the Sixth Circuit has expressly relied on the use of a disclaimer and a hyperlink on a consumer site as defeating a trademark infringement claim. *Taubman v. WebFeats*, 319 F.3d 770, 776-777 (2003), as have some district courts. See Lamparello's opening brief, at 21.

Actual Confusion. Falwell (at 22) contends that this factor supports him because "actual confusion has been shown," but in fact this factor weighs very heavily in Lamparello's favor, for several reasons. Falwell's evidence on actual confusion consists of a survey of Falwell's written mail showing that between 3% and 5.5 % of his correspondents spell his name "Fallwell," Fal. Mem. at 18, and the contention that over the period of the last two and one half years, Falwell has received "2 or 3 e-mails and at least 5 telephonic communications" from people who complained about Lamparello's web site and/or expressed concern that Falwell's web site had been hacked. *Id.* at 17.

However, the fact that a survey of mail shows that up to 5.5% of his supporters use a misspelling that might lead them to find fallwell.com does not help Falwell. Rather, as the Fourth Circuit has stated, survey evidence showing less than 10% confusion favors the defendant. *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455 (4th Cir. 1996). Moreover, it is questionable whether the seven or eight calls and emails are evidence of actual confusion. These individuals apparently recognized that the web site was not sponsored by Falwell, and they contacted Falwell's own webmaster precisely because they were **not** confused about the source of the material they found at fallwell.com. At best, these seven or eight individuals might be examples of initial interest confusion (an issue discussed *infra*), although without knowing how they happened upon

fallwell.com, even that is not certain, and surely it has not been proved. Because Falwell neither saved the email communications nor logged the telephone calls, but instead asks the Court to accept the testimonial recollection of his webmaster sworn months or years later, even this paltry evidence should be taken with a grain of salt.⁶

Moreover, the small number of cases of actual confusion is very supportive of Lamparello's position, because, as the Fourth Circuit said in *Petro Stopping Centers*, 130 F.3d at 95, "the company's failure to uncover more than a few instances of actual confusion creates a presumption against likelihood of confusion in the future." Likewise, numerous other circuits have said that when two uses have existed side by side for several years and there are only a few instances of confusion, that fact actually weighs **against** a finding of likely confusion. *Kendall-Jackson Winery v. E&J Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir. 1998). *Accord A&H Sportswear v. Victoria's Secret Stores*, 237 F.3d 198, 227 (3^d Cir. 2000); *Elvis Presley Enterprises v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

Here, it is undisputed that, every day, plaintiff Lamparello received approximately 200 hits on his web site, Stip. ¶11; over the period of thirty months, that means that more than 180,000 hits on his site. During the same time, Falwell's web traffic was many times larger. *Id.* Moreover, Lamparello's web site had coexisted with Falwell's web site for more than five years at the time this brief is written (since February 1999). The eight instances of purported actual confusion is so minute by comparison that it weighs very heavily against a finding of likelihood of confusion.

⁶Because Falwell began threatening Lamparello with trademark litigation in October 2001, the entire period of 2½ years during which the emails were discarded and the phone calls were not logged occurred when Falwell knew that litigation was a possibility and that the evidence was potentially relevant.

Other undisputed facts further support Lamparello on the issue of actual confusion. The parties have stipulated that Lamparello's web site had "no measurable impact" on the quantity of traffic to Falwell's web site. Suppl. Stip. And, Falwell has waived any claim of actual damages based on lost sales or donations on his web site, and refused in discovery to produce evidence of sales from which any trends might have been determined. Fal. Interrog. Nos. 5-6; Fa. Doc. Nos. 9-12. These facts further negate any implication that whatever initial interest confusion might have been suffered by persons reaching fallwell.com when they were looking for Falwell's own site ripened into actual confusion that actually diverted them from Falwell's site.

Sophistication of the Buying Public. Although there is no evidence directly on this point, Falwell's views about homosexuality are notorious, and it is difficult to believe that any of his supporters or target audience would believe that he was the sponsor of a web site that defends gay and lesbian people and criticizes Falwell for his positions. Moreover, courts recognize the increasing sophistication of Internet users and their ability to find what they want when a first web visit does not meet their expectations. *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002) ("consumers are aware that domain names for different Web sites are often quite similar . . . and that very small differences matter"); *Strick Corp. v. Strickland*, 162 F.Supp.2d 372, 377 (E.D.Pa. 2001). See generally expert report of Milton Mueller and 19 to 20 , *infra*.

The Relevance of Initial Interest Confusion. Falwell also argues that, even if there is no likelihood of confusion, Lamparello is guilty of causing initial interest confusion. In the Internet context, initial interest confusion is said to occur when a consumer looking for a trademark holder is drawn by use of the mark in a domain name, meta tags, or keyword advertising, to a web site that is **not**, once viewed, confusing about source. Nonetheless, the consumer may decide that he is

interested in the goods or services marketed there, and thus stay and look further **despite** the lack of confusion. *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036, 1062 (9th Cir. 1999). The hypothetical user decides not to continue to look for the trademark holder, not because of any illusions about who sponsors the website he or she is viewing, but because the website provides other attractive inducements. For example, the consumer may perceive that the current website offers good comparative information, or cheaper prices for functionally equivalent goods, or higher quality goods. However, for three critical reasons, this doctrine cannot help Falwell here.

First, the doctrine of initial interest confusion has its most important application when two commercial competitors are selling similar goods to the same set of consumers. The doctrine has less force when customers are likely to exercise care in making their final purchasing decisions. *Checkpoint Systems v. Check Point Software Tech.*, 269 F.3d 270, 296 (3^d Cir. 2001). Because Lamparello is not selling rival goods but is simply expressing his views about Falwell, and because people who support Falwell are likely to be fully cognizant of Falwell's hostility toward homosexuality and hence quite able to distinguish between Lamparello's views and Falwell's, initial interest confusion does not support a finding in favor of Falwell.⁷

Second, post-*Brookfield* developments in both law and technology call into question the applicability of initial interest confusion to a web site that accurately uses a domain name to denote the subject of the site. The early domain name cases spoke with assurance of the supposed lack of sophistication of Internet viewers and the absence of a reliable index of web sites. *E.g., Panavison*

⁷Such recognition was manifest in each of the three emails attached to Falwell's Answers to Interrogatories. Second Levy Affidavit ¶ 4 and Exhibit I.

v. Toeppen, 141 F.3d 1316, 1327 (9th Cir. 1998); *Jews for Jesus v. Brodsky*, 993 F.Supp. 282, 303 (D.N.J. 1998). The courts assumed that a customer who got to the wrong website would just give up “due to anger, frustration or the assumption that plaintiff’s home page does not exist.” *Id.* at 307. On this theory, when a customer was confused into visiting another person’s website by a misleading domain name, even though confusion was dispelled as soon as the customer reached the rival site, the customer would find it too hard to find the site that he was really seeking. In this context, the doctrine of initial interest confusion protected the consumer against unduly high search costs that would have been incurred as a consequence of the temporarily confusing use of the mark.

This analysis has become outdated through both changes in the sophistication of Internet viewers and developments in search technology. Although it authored *Brookfield*, the Ninth Circuit has repudiated the view that Internet viewers are naive or unsophisticated *Entrepreneur Media v. Smith*, 279 F3d 1135, 1147 (9th Cir. 2002). And in *Interstellar Starship Serv. v. Epix*, 304 F3d 936, 942 (9th Cir. 2002), that court retreated from the suggestion that initial interest confusion was an independent violation that could be found without reference to other factors: “[t]o evaluate the likelihood of confusion, including initial interest confusion, the so-called *Sleekcraft* factors provide non-exhaustive guidance.” The court denied relief by “balancing all of the *Sleekcraft* factors within the unique context of each case.” *Id.* And numerous courts, not to speak of the expert report of Milton Mueller, submitted with Lamparello’s opening brief, have recognized that search engines now **do** provide an excellent index for the World Wide Web, or at least large portions of it, and have acknowledged the diminution of the consequences of landing at the “wrong” web site as a result of initial interest confusion. *E.g.*, *Strick Corp. v. Strickland*, 162 F.Supp.2d 372 (E.D.Pa. 2001); *Bihari v. Gross*, 119 F.Supp.2d 309, 320 n.15 (S.D.N.Y. 2000). As *Strick* stated:

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

162 F.Supp.2d at 377 (quotation marks and citations omitted).⁸

Here, of course, Lamparello's hyperlink to Falwell's own web site means that viewers who suffer from initial interest confusion need not even press the "back" button or go to a search engine; they need only click on the hyperlink to go straight to Falwell's site.

Third, an injunction against noncommercial use of the trademark pursuant to the doctrine of initial interest confusion, or an award of damages based on profits lost because the critic was effective in persuading consumers not to buy the trademark holder's product, would be inconsistent with the First Amendment. Even if a compelling government interest were served by forbidding a mere "likelihood of confusion," and there were thus a constitutionally permissible basis for issuing an injunction against noncommercial speech, the constitutional basis for the injunction is even more problematic if the confusion caused by the trademark is merely ephemeral. If, for example, the confusion caused by use of the trademark in a domain name is dispelled as soon as the consumer begins to read the home page and recognizes that the site is critical of the trademark owner and does not sell the trademark owner's or a competitor's products, there is no "compelling government interest" served by enjoining the domain name. *Cf. Northland Ins. Co. v. Blaylock*, 115 FSupp2d 1108, 1119-1121 (D.Minn. 2000) (declining as a matter of trademark law to apply initial interest

⁸David Bernstein, a prominent trademark enforcement lawyer, stated that "99 times out of 100, consumers are able to find the site they are looking for." Loomis, *Domain Name Disputes Decline as Internet Matures*, <http://www.law.com/jsp/article.jsp?id=1044059430652>.

confusion absent proof of commercial motive).

In sum, the *Pizzeria Uno* factors weigh heavily in favor of a finding of no likelihood of confusion, and summary judgment should be granted in Lamparello's favor for this additional reason.

D. Falwell Has Not Shown Damage As Required for Liability Under Section 43 of the Lanham Act.

Falwell cannot establish a violation of section 43 of the Lanham Act, which provides that the cause of action can be pursued only by "any person who believes that he or she is or is likely to be damaged by such act." Despite the language "who believes," Falwell acknowledges, Fal. Mem. at 23, that standing to sue under section 43(a) requires evidence that the plaintiff was damaged, or is likely to have been damaged, by the violation. *Servicetrends v. Siemens Medical Sys*, 870 F. Supp. 1042, 1067-1068 (N.D. Ga. 1994). "The likelihood of injury and causation will not be presumed, but must be demonstrated." *Havana Club Holding v. Galleon S.A.*, 203 F.3d 116 (2^d Cir. 2000); *Frisch's Restaurants v. Elby's Big Boy*, 670 F.2d 642, 649 (6th Cir. 1982). *See also Perini Corp. v. Perini Constr.*, 915 F.2d at 128 (basis for predicting damage must be explained). Such proof is absent here.

Falwell's purported evidence on the issue of damage is two-fold. He shows that between three and five-and-a-half percent of the people who send him mail misspell his name "Fallwell," Fal. Mem. 18, and then argues that those who find Lamparello's site instead of his own and are misled into accepting Lamparello's idea that homosexuality is acceptable will go to Hell. *Id.* at 23-24. He also speculates that some people might not reach his own web site, and that he might therefore lose sales or donations. *Id.* 24.

Falwell's claim to standing based on the spiritual consequences that others will suffer if they

agree with Lamparello's views is dubious at best, as is his unstated premise that the Establishment Clause allows the Court to consider this form of "damage." In any event, both arguments fail because of admissions that Falwell has previously made in this case. First, he has conceded that Lamparello's web site had no measurable impact on the quantity of traffic reaching the Falwell web site. Suppl. Stip. Second, Falwell agreed in discovery not to claim actual damages, based on lost sales and donations, and consequently refused to produce evidence of the level of sales or revenues since 1998, when he first created his web site. Levy Aff., Exhibit D, Answer to Interrogatory No. 6, Responses to Document Request Nos. 3, 9, 10, 11, 12. Third, when asked to describe each "injury . . . suffered as a result of Lamparello's use of the marks at issue," Falwell complained only of the harm from criticism, with no mention of the harms now asserted in his memorandum. Levy Aff., Exhibit D, Answer to Interrogatory No. 5. Fourth, the relatively small number of hits that Lamparello's web site received, Stip. 11, makes any speculation about lost revenue extremely dubious. In this context, such speculation simply does not show any probability that Falwell will suffer damage, and for this reason, as well as the lack of commercial conduct and no likelihood of confusion, summary judgment should be granted dismissing Falwell's section 43 claim.⁹

E. Lamparello Did Not Register Falwell.Com With a Bad Faith Intent to Profit.

"The ACPA was enacted in 1999 in response to concerns over the proliferation of

⁹Indeed, in June 2003, Falwell was actually making a prominent display on his home page of his trademark complaints about his Internet critics, Levy Second Aff. Exhibit H, presumably because he felt that the activity would inflame his supporters and hence spur them to greater devotion and support. In an analogous situation, the Sixth Circuit refused to assume that an alleged copyright infringement harmed the plaintiff financially, but took the more practical view that the "infringement" was being used quite profitably by the plaintiff. *See NRA v. Handgun Control Fed'n*, 15 F.3d 559, 562 (6th Cir. 1994).

cybersquatting – the Internet version of a land grab. . . . Cybersquatting is the practice of registering well-known brand names as Internet domain names in order to force the rightful owners of the marks to pay for the right to engage in electronic commerce under their own brand name.” *Virtual Works v. Volkswagen of America*, 238 F.3d 264, 267 (4th Cir. 2001). *Accord Mayflower Transit v. Prince* 2004 WL 859281 (D.N.J. 2004). *See also Rohr-Gurnee Motors v. Patterson*, 2004 WL 422525 (N.D.Ill.), at *5 (awarding attorney fees against plaintiff). *Virtual Works* specifically warned against the chilling effects of expansive interpretations of this statute. 238 F.3d at 269.

The purpose of the “bad faith intent to profit” prong of the cybersquatting statute undercuts Falwell’s claim of bad faith intent to profit. Both the House and Senate Committees explained this purpose in almost identical language, which was repeated in the Conference Report reconciling the House and Senate Bills:

The bill is carefully and narrowly tailored, however, to extend only to cases where the plaintiff can demonstrate that the defendant registered, trafficked in, or used the offending domain name with bad-faith intent to profit from the goodwill of a mark belonging to someone else. Thus, the bill does not extend to . . . someone who is aware of the trademark status of the name but registers a domain name containing the mark for any reason other than with bad faith intent to profit from the goodwill associated with that mark.

. . . The [nine enumerated] factors are designed to balance the property interests of trademark owners with the legitimate interests of Internet users and others who seek to make lawful uses of others’ marks, including for purposes such as comparative advertising, comment, criticism, parody, news reporting, fair use, etc.

House Report 106-412, at 10; Senate Report No. 106-140, at 12-13; House Conf. Report 106-464, at 109.

As the House Committee explained, at 10, “the first four [factors] suggest circumstances that may tend to indicate an absence of bad faith intent to profit,” while the remainder point in the opposite direction. Unlike the *Pizzeria Uno* factors, which can be considered in every case, a mark holder cannot simply run through the four “pro-registrant” factors and argue that the absence of

some of them outweighs others, as Falwell tries to do; each of the first four factors addresses separate situations, some of which are mutually exclusive, such as “noncommercial use” under factor IV and use for a bona fide offering of the registrant’s own goods under factor III.

In his opening brief, Lamparello showed that factor IV pointed strongly in his favor, and that the negative factors were absent. Falwell attempts to invoke three of the negative factors, but his arguments take excerpts from each factor completely out of context. First, by his assertion that Lamparello “intended to confuse, mislead and divert internet users into accessing his site,” Fal. Mem. at 25, Falwell apparently invokes factor V, 15 U.S.C. § 1125(d)(1)(B)(i)(V):

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

However, not only is there no evidence of an intent to divert consumers from Falwell’s own site, but the disclaimer and hyperlink to Falwell’s own site negates any such contention. Moreover, other necessary elements of this factor are missing – there is no intent to act for commercial gain, and the intent to criticize the mark holder is not the sort of tarnishment or disparagement that is actionable under the trademark laws. 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:148 (4th ed. 1999). Nor, as shown above, is there any likelihood of confusion about who sponsors the web site. This factor cannot help Falwell.

Falwell also cites Lamparello’s use of the fictitious name “Lamparello International” to identify the registrant as allegedly showing a bad faith intent to profit, Fal. Mem. 25-26, in an apparent attempt to invoke factor VII, 15 U.S.C. § 1125(d)(1)(B)(i)(VII):

provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate

contact information, or the person's prior conduct indicating a pattern of such conduct;

As the House Committee made clear, this factor was aimed at persons who give false **contact** information to make it harder to serve process and thus to attempt to frustrate the legal enforcement of mark holders' rights. House Report 106-412, at 12-13. But as Falwell's Exhibit 13 shows, Lamparello provided his name, snail mail and email addresses, and telephone number; nor did Falwell have any difficulty contacting Lamparello or serving him with process.

Finally, Falwell cites Lamparello's acknowledgment that his surname is distinctive as showing a bad faith intent to profit, but factor IX supports the conclusion of bad faith only to "**the extent to which** the mark incorporated in the person's domain name registration is or is not distinctive and famous." 15 U.S.C. § 1125(d)(1)(B)(i)(IX) (emphasis added). There would be no coverage by the ACPA at all if the name were not distinctive, because it would enjoy no trademark protection. But there is no evidence on the "extent" of distinctiveness, except that many search engine hits are devoted to praise or criticism of Jerry Falwell, and that many other people make commercial use of the names Falwell and Fallwell and hence all enjoy common law trademarks in those names. In short, this factor is at best neutral for Falwell, and for these reasons, as well as those set forth in Lamparello's opening brief, at 25-26, Falwell has no ACPA claim.

F. Neither Statutory Damages Nor Attorney Fees Should Be Awarded Against Lamparello.

With the barest of citations of authority, Falwell requests an award of \$1,000,000 in statutory damages as well as an unspecified amount of attorney fees. Even if the Court finds Lamparello liable, neither form of monetary relief is appropriate here.

First, Falwell seeks statutory damages only under section 35(c) of the Lanham Act, 15 U.S.C.

§ 1117(c), which authorizes awards of statutory damages in lieu of actual damages when the defendant has used a “counterfeit mark as defined in section 1116(d).” Section 1116(d)(1)(B)(i), in turn, defines a “counterfeit mark” as “a counterfeit of a mark that is registered.” Although the Lanham Act never defines the term “counterfeit,” the legislative history of the Anti-counterfeiting Consumer Protection Act of 1996, which added the provision of statutory damages for counterfeit goods, makes clear that the purpose of the remedy was to provide a civil counterpart for criminal counterfeiting actions. House Report No. 104-556, 104th Cong., 2d Sess., *reprinted in* 1996 U.S.C.C.A.N. 1074, 1075 *et seq.* The criminal counterfeiting statute, in turn, defines a counterfeit mark as one that is “identical with, or substantially indistinguishable from” the registered mark. 18 U.S.C. § 2320(d). Similarly, the original Trademark Counterfeiting Act of 1984 made clear that not every trademark infringement was intended to be considered a counterfeit, but only the commercial trafficking in goods and services through the placement of a designation that is identical to or indistinguishable from the registered mark. *See* Senate Report No. 98-526, 98th Cong. 2d Sess., *reprinted in* 1984 U.S.C.C.A.N. 3627, 3628-3631. *See also* 15 U.S.C. §§ 1114(1) (a) (listing “counterfeit” as one or four ways in which a trademark can be infringed), 1116(d)(1)(B)(ii) (provision for civil action against counterfeit of Olympic mark also defined counterfeit mark as one that is “identical with, or substantially indistinguishable from” the protected mark), 1117(c) (authorizing statutory damages only when counterfeit mark is used “in connection with the sale, offering for sale, or distribution of goods and services”).

However, the only registered mark at issue in this case is “Listen America With Jerry Falwell,” and fallwell.com is neither identical to, nor indistinguishable from, that mark. Moreover, even if the Court determines that Lamparello’s praise for a published book made his site

impermissibly commercial, that violation ended more than two years before Falwell sued, outside the limitations period under *Teaching Co. v. Unapix Entertainment*, 87 F. Supp.2d 567, 585 (E.D. Va. 2000), and *Unlimited Screw Products v. Malm*, 781 F. Supp. 1121, 1125-1126 (E.D. Va. 1991). The Fourth Circuit, in an unpublished ruling, has affirmed dismissal based on this limitations period. *CACI Int'l v. Pentagen Technol*, 1995 WL 679952, at *3. Accordingly, statutory damages are unavailable.

If any statutory damages are to be awarded, the amount should be small. Although Falwell has waived any claim for statutory damages under the ACPA by not seeking them in his motion, review of domain name cases in which courts have awarded statutory damages shows that “courts reserve the high-end of the \$1,000 to \$100,000 range for the most egregious offenders.” *International Bancorp. v. Société des Bains de Mer*, 192 F.Supp.2d 467, 490 (E.D.Va. 2002), *aff’d other grounds*, 329 F.3d 359 (4th Cir. 2003). Higher levels of damages are awarded against serial cybersquatters who make substantial profits from their activities. *E.g.*, *E&J Gallo Winery v. Spider Webs*, 286 F.3d 270, 277-278 (5th Cir. 2002); *Shields v. Zuccarini*, 254 F.3d 476, 479 (3d Cir. 2001). A lower statutory award is justified when conduct is not “malicious” or “fraudulent,” and when there is no “finding of actual economic harm.” *Société des Bains de Mer*, 192 F.Supp.2d at 491 (E.D.Va. 2002) (awarding statutory damages of \$1,000 to \$5,000 per infringing domain name against gambling web site operators, despite the “purely commercial” nature of the infringement); *Mattel v. Adventure Apparel*, 2001 WL 1035140, at *5 (S.D.N.Y. 2001) (awarding minimum statutory damages “since little if any actual harm has been done”). Indeed, Falwell gives no basis for his demand for \$1,000,000 in damages. He simply quotes the words “broad judicial discretion” used in a New York case, but does not even try to analyze this case by reference to that court’s detailed

consideration of the factors it deemed relevant. Fal. Mem. at 27, citing *Sara Lee Corp. v. Bags of NY*, 36 F. Supp.2d 161 (S.D.N.Y. 1999). By making such an outlandish and baseless request, Falwell invites this Court to exercise its discretion in the other direction, by denying any award of damages. *Shell Oil Co. v. Commercial Petroleum*, 928 F.2d 104, 108 (4th Cir. 1991).

Finally, no attorney fees should be awarded in this case because fees can be awarded only in exceptional cases. In his memorandum, at 26, Falwell acknowledges the high standard for fee awards in trademark cases set forth in *PETA v. Doughney*, 263 F.3d 359 (4th Cir. 2001), but he makes no serious attempt to meet that standard:

“a case is ‘exceptional’ if the defendant’s conduct was malicious, fraudulent, willful or deliberate in nature. In other words, a prevailing plaintiff must show that the defendant acted in bad faith. [T]he term ‘exceptional’ should be interpreted by courts to require a showing of a high degree of culpability on the part of the infringer, for example, bad faith or fraud. . . . [A] bad faith finding under the ACPA does not compel a finding of malicious, fraudulent, willful or deliberate behavior.

263 F.3d at 370 (quotations and citations omitted).

Falwell’s only basis for seeking fees is that Lamparello finished only two years of college, is not a trained priest, and yet has the audacity to contradict a well-established religious figure on matters of doctrine. Fal. Mem. at 26. These facts do not provide any basis for awarding fees under the *PETA* standard. Nor does Falwell acknowledge that, according to one of the cases he cites, not to speak of every other circuit to consider the issue directly, his failure to show any actual damages is “an important factor in determining whether a case is exceptional.” *Texas Pig Stands v. Hard Rock Café*, 951 F.2d 684, 697 n.23 (5th Cir. 1992); *Tamko Roofing Prods. v. Ideal Roofing Co.*, 282 F.3d 23, 33 (1st Cir. 2002); *Bishop v. Equinox Int’l Corp.*, 154 F.3d 1220, 1224 (10th Cir. 1998); *Ferrero USA v. Ozak Trading*, 952 F.2d 44, 49 (3^d Cir. 1991); *Hindu Incense v. Meadows*, 692 F.2d 1048, 1052 (6th Cir. 1982). Cf. *Shell Oil Co. v. Commercial Petroleum*, 928 F.2d 104, 108 n.6 (4th Cir.

1991) (denying fees under state law because no actual damages).

Here, even if the Court decides that Lamparello's registration and use of fallwell.com for his gripe site was improper, many other courts have come to contrary conclusions in cases of domain names in the form www.trademark.com. Indeed, the Fifth, Sixth and Seventh Circuits, and district courts in Alabama, California, Illinois, Maryland, Minnesota, and New Jersey have authorized the use of such domain names for web sites, either because the sites were noncommercial or created without extortionate intent, or because the web sites were facially non-confusing, or for each of these reasons independently. The extent of contrary rulings surely bars any conclusion that Lamparello's failure to predict that this Court would disagree constituted an "exceptional" case warranting an award of attorney fees.

CONCLUSION

Falwell's motion for summary judgment should be denied, and Lamparello's cross-motion should be granted.

Respectfully submitted,

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