

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 14-10747

OFFICE OF MEDICAL AND SCIENTIFIC JUSTICE, INC.,
Plaintiff-Appellant,

v.

JEFFERY TODD DeSHONG,
Defendant-Appellee.

On Appeal from a Final Judgment of the United States
District Court for the Northern District of Texas, Fort Worth Division
No.4:13-CV-00552-C, Hon. Sam R. Cummings

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FOR THE FIFTH CIRCUIT

OFFICE OF MEDICAL AND SCIENTIFIC)	
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)	
Plaintiff-Appellant,)	
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)	No. 14-10747
v.)	
)	
JEFFERY TODD DeSHONG,)	
)	
Defendant-Appellee.)	

CERTIFICATE OF INTERESTED PERSONS

The undersigned counsel of record certifies that the following listed persons and entities as described in the fourth sentence of Rule 28.2.1 have an interest in the outcome of this case. These representations are made in order that the judges of this court may evaluate possible disqualification or recusal:

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Defendant-Appellee Jeffery Todd DeShong

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STATEMENT ABOUT ORAL ARGUMENT

Because this appeal is so insubstantial that treatment under Rule 38 may be warranted, it would ordinarily not merit oral argument. However, appellee does not object to appellant's request for oral argument in light of the misrepresentations of the record in appellant's opening brief (see, for example, the issues discussed at page 37-38 n. 7 and pages 49-50 in the following brief). If similar misrepresentations appear in the reply brief, appellee would not have the opportunity to respond. Oral argument may provide a needed opportunity to correct the record.

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The district court dismissed a lawsuit by plaintiffs Clark Baker and an organization he founded, appellant “Office of Scientific and Medical Justice” (“OMSJ”), seeking to suppress a blog that criticizes plaintiffs for their advocacy of HIV denialism—the theory that HIV does not lead to AIDS and that AIDS medications do no good but cause serious problems. Parading under the rubric “HIV Innocence Group,” plaintiffs oppose the prosecution of individuals who have spread HIV through sexual relations with partners from whom the individuals have deliberately concealed their HIV positive status, urging defendants to embrace its conspiracy theories and argue them to juries. Appellee Jeffery Todd DeShong is a blogger who, using the web addresses “HIVInnocenceProjectTruth.com” and “HIVInnocenceGroupTruth.com,” expresses vigorous criticisms of plaintiffs’ efforts and explains in some detail the flaws in their “science.”

OMSJ and Baker sued DeShong for defamation, but also tried to dress up their defamation claims by asserting that the use of their “HIV Innocence” name in the domain names for DeShong’s blog infringed their trademark in that phrase. However, the complaint failed to allege two of the necessary elements of a trademark claim. First, the complaint never alleged that DeShong’s use of the mark was likely to cause confusion about the source or sponsorship of his critical website; instead, it complained that Internet users visiting DeShong’s website

were likely to be confused about whether DeShong's criticisms were valid. Second, precedent in the Fifth Circuit and elsewhere bars trademark claims over non-commercial criticism sites. Appellant argued below that the fact that DeShong's criticism could injure its business reputation was enough to make DeShong's site commercial, but such arguments do not support a trademark infringement claim; it is a defamation claim relabeled to try to make a federal case out of it. The trademark claim was rejected by an arbitrator who ruled that the trademark owner was engaged in reverse domain name hijacking, and by the trial court which dismissed for failure to state a claim. Because the trial court correctly applied the law in dismissing appellant's preposterous arguments, and because there were a variety of other grounds on which the trademark count in the complaint could have been dismissed, the judgment should be affirmed.

QUESTIONS PRESENTED

1. Did the district court properly dismiss the trademark infringement count of a complaint that did not allege either that defendant's domain names were likely to cause confusion about the source or sponsorship of the website or that the domain names were used in connection with the sale or advertising of goods and services?
2. Do the First Amendment and the trademark laws allow the critic of a

trademark owner to include the trademark as part of the domain names for a non-commercial website that criticizes the trademark holder?

3. Was defendant's use of appellant's trademark protected fair use?

4. Did appellant meet the special pleading requirements that this Court has adopted when a trademark is used as the label for an expressive work?

STATEMENT

A. Facts

This appeal arises from a dismissal under Rule 12(b)(6) of the Federal Rules of Civil Procedure on the ground that the trademark count of the First Amended Complaint fails to state a claim on which relief can be granted. The most remarkable aspect of the statement of facts in appellant's opening brief is that it **never** mentions or cites the original complaint, or the first amended complaint, as a source of the facts on which this appeal turns. The statement of facts in this brief, however, rests largely on the complaints themselves (the amended complaint is in Appellee's Record Excerpt), as well as on defendant-appellee's blog and other matters that are referenced in the complaint and hence can be considered on a motion to dismiss without converting it into a motion for summary judgment. *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). Defendant cited these other matters and authenticated them by affidavit.

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. ROA.874-877, ¶¶ 7, 9, 12. After leaving his previous career in law-enforcement, Baker reinvented himself as a private investigator, specializing in cases where defendants are accused of spreading HIV by having unprotected sex while concealing their HIV-positive status. He founded plaintiff-appellant OMSJ to help propagate his views. *Id.* OMSJ, in turn, created an “HIV Innocence Project” but, after complaints of trademark infringement from an existing group called The Innocence Project, <http://www.innocenceproject.org/>, it changed that name to HIV Innocence Group, <http://hivinnocencegrouptruth.com/2011/07/12/the-purpose-of-this-site/>, and secured a federal trademark registration for that name. ROA.876 ¶ 11. Plaintiffs’ websites 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>.

Defendant-appellee Jeffery 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, ROA.119 ¶ 2; this brief uses the singular “blog” to identify both). The blog gives DeShong’s views about plaintiffs and dissects several examples of “successes” claimed by the HIV Innocence Group. ROA.129-160. Because the blog discusses plaintiffs’ work, 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.

The domain name is neither identical to appellant’s trademark nor one that would be mistakenly typed into an Internet browser by a careless Internet user trying to find appellant’s own website by “name-guessing”—the need to enter the entire additional word “truth” ensures that. Moreover, from the first look at the blog, an Internet viewer would see immediately that it was not OMSJ’s own website, but rather a blog devoted to criticizing appellant. The banner at the top of the page reads,

**HIV Innocence Group Truth
Truthfully Deconstructing The HIV Innocence Group**

and each of the articles on the blog directly criticizes OMSJ and its principal, plaintiff Baker. Although appellant tries to make an issue of the appearance of

search engine results, citing its own affidavit below, Br. 10, citing ROA.1307-1308, the search engine results that were authenticated for the record below show that OMSJ's own website is the **first** search engine result for the search string "hiv innocence," and that DeShong's site shows up next, either with the title "Why the HIV Innocence Project is sick and evil bullshit," ROA.205, or with the milder "HIV Innocence Group Truth – Truthfully Deconstructing the HIV Innocence Group." ROA.207. In either case, no rational Internet user viewing search engine results is likely to be confused about whether clicking the search result for DeShong's site will take him to a site sponsored by or affiliated with the owner of the "HIV Innocence Group" mark.

Baker's various websites have harsh words for his adversaries. For example, his websites 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-village-idiot.html>

Despite the strong language with which he attacks his critics, Baker, as this lawsuit shows, is sensitive to criticism directed at Baker. 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.” ROA.892 ¶ 23. Even though UDRP proceedings are notoriously favorable to trademark holders, *e.g.*, Geist, *Fundamentally Fair.com: An Update on Bias Allegations and the ICANN UDRP* (2002) <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 used lawfully to post criticisms of the trademark holder. <http://domains.adrforum.com/domains/decisions/1486064.htm>. Unfazed by this rejection, Baker and OMSJ sued DeShong for defamation and related torts, and for trademark infringement under both federal and state law.

B. Proceedings Below

On July 9, 2013, Baker and OMSJ filed a complaint against DeShong in the United States District Court for the Northern District of Texas, Fort Worth Division, alleging claims for defamation, business disparagement, trademark infringement under the Lanham Act and the Texas Business and Commerce Code, and injunctive relief. The complaint was larded with allegations about the plaintiffs' pseudo-scientific theories, about the evil conspiracy perpetrated by large pharmaceutical companies and the medical establishment that have supposedly foisted the myth of HIV on the public, and about DeShong's perfidious support for the scientific establishment.

But the allegations in support of the trademark claims were strikingly sparse. The infringement claim was based on the fact that the federally registered "HIV Innocence Group" forms a significant part of the domain name "hivinnocencegrouptruth.com" and about half of the domain name "hivinnocenceprojecttruth.com." But the complaint never alleged that the domain name was used in connection with the sale or advertising of goods and services, but only that DeShong is trying to destroy plaintiffs' business. Moreover, although the phrases "likelihood of confusion" and "actual confusion" are strewn about in the complaint (ten and four times, respectively), along with many

conclusory references to the word “infringement” (ten repetitions), the word “confusion” (thrice) and the phrase “actual confusion” (four times), the complaint **never once** alleges a likelihood of confusion about the source, sponsorship or affiliation of DeShong’s website. Instead, the complaint alleged that members of the public might be confused by DeShong’s derogatory statements into believing that Baker and OMSJ were knaves or fools. ROA.16-17 ¶ 16.¹

DeShong moved to strike the state-law claims under the Texas anti-SLAPP statute and submitted affidavits and exhibits in support of that motion. He also moved to dismiss the federal trademark claims under Rule 12(b)(6), relying only on the face of the complaint and the limited materials that had been referenced in the complaint and thus were properly before the trial court on a Rule 12 motion, including his blog, OMSJ’s own website, and the UDRP decision. The brief in support of the motion identified several irremediable flaws in the complaint’s Lanham Act claims:

- a. **First**, the complaint did not allege that DeShong had made use of the two domain names in connection with the sale or advertising of goods and services; indeed, inspection of the blog reveals that the names were

¹ Although, as drafted, the complaint appeared to bring trademark claims for both plaintiffs, only OMSJ has registered the mark and thus only it had standing to sue for trademark infringement. Only OMSJ appealed the judgment of dismissal.

used only for a website that set forth information about the plaintiffs, along with expressions of DeShong's adverse opinions about plaintiffs. In this respect, the complaint as pleaded ran afoul of cases previously decided by the Fifth Circuit and elsewhere holding that Internet commentary sites are not vulnerable to challenge under the trademark laws so long as they are strictly noncommercial. ROA.56-61, *citing TMI v. Maxwell*, 368 F.3d 433 (5th Cir. 2004) *et al.*

b. **Second**, although the word "confusion" and the phrase "likelihood of confusion" were sprinkled around the complaint in several different paragraphs, ¶¶ 15, 16, 18(c), 19, the complaint never alleged that the domain names and accompanying websites posed any danger of creating confusion about the **source** of DeShong's blog—that is, they did not create any risk that viewers of the blog would think that plaintiffs were the authors or sponsors of DeShong's website. Indeed, inspection of the blog clearly shows that it is so adverse to plaintiffs that no Internet user in his right mind could think that plaintiffs were sponsoring it. ROA.64-66.

c. **Third**, a raft of appellate cases from other circuits hold that domain names for commentary sites may incorporate the trademarked name of the subject of the commentary so long as the website itself is non-

confusing. ROA.64.

d. **Fourth**, given the expressive nature of DeShong's website, the complaint's infringement allegations did not meet the special irrelevance test originated by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (1989), and specifically endorsed by this Court in *Westchester Media v. PRL USA Holdings*, 214 F.3d 658, 664 (5th Cir. 2000), and by other courts of appeals. ROA.68-69.

e. **Fifth**, DeShong's truthful use of the trademarked name to identify the blog as being about the holder of the trademarked name meant that the domain name is fair use. This ground for dismissal is an affirmative defense, but affirmative defenses are properly a basis for dismissal because plaintiffs' allegations, coupled with the blog itself that was properly considered on a motion to dismiss, *Lone Star Fund*, 594 F.3d at 387, sufficiently established the defense that the complaint had a "built-in defense." *Garrett v. Commonwealth Mortg. Corp. of America*, 938 F.2d 591, 594 (5th Cir. 1991). ROA.69-71.

f. **Sixth**, another affirmative defense disclosed on the face of the complaint was that DeShong's truthful use of the trademarked name to identify the blog as being about the holder of the trademarked name meant

that the domain name was protected by the First Amendment against government action (such as the order of a court) that could either penalize the use or enjoin further use. ROA.53-55.

In response to the motion to dismiss, the plaintiffs sought leave to file an amended complaint; the trial court granted leave and denied the motion to dismiss on the ground that DeShong's memorandum in support of dismissal had not directly addressed the allegations of the complaint as amended. DeShong renewed his motion to dismiss, showing that the amendments had neither addressed the failure to allege likelihood of confusion about source, affiliation or sponsorship, nor the failure to allege that the use of a trademarked phrase in DeShong's domain names was in connection with the advertising of goods or services, or that the speech fostered by the challenged domain names was commercial. The new allegations included that DeShong had some unknown relationship with famed scientist Robert Gallo, that DeShong's blog had the potential to harm plaintiffs' business, and that there were commercial links on some of the pages linked from DeShong's blogs.²

²The amended complaint withdrew the state-law infringement claim and substituted a state-law dilution claim. Because OMSJ has limited its appeal to the dismissal of the Lanham Act claim, this brief does not address the flaws in the dilution claim.

DeShong argued that the new allegations did not render DeShong's speech commercial, or make his blog and domain names subject to the Lanham Act. While the motion to dismiss was pending, plaintiffs issued discovery requests that included efforts to force DeShong to disclose his personal finances and to disclose any communications DeShong might have had with a variety of the established figures of AIDS research, including Dr. Gallo, who are the bêtes noires of Baker's conspiracy theories. ROA.941-942. DeShong sought a protective order, quoting statements from Baker that his reason for suing DeShong was to create a vehicle to obtain judicial process to make Dr. Gallo answer his questions in a deposition. ROA.921-922. The trial court granted a protective order, ROA.950, and ultimately dismissed the complaint. ROA.1958-1970.

The court declined to reach the First Amendment issues because the Lanham Act itself disposed of the claims. ROA.1960. It began its analysis of the statutory issue by recognizing that not any confusion makes out a Lanham Act infringement claim: the plaintiff must allege "likelihood of confusion in the minds of potential clients as to the course, affiliation or sponsorship of DeShong's website." ROA.1961. The court organized its discussion of that issue around an analysis of the familiar multi-factor test enunciated in *Elvis Presley Enters. v Capece*, 141 F.3d 188, 194 (5th Cir. 1998); ROA.1961-1962; in the course of its

discussion, the court accepted the various independent grounds that DeShong had offered for dismissing the trademark counts.

Thus, in discussing the similarity between the domain name and the marks, he acknowledged that the domain name included Baker's mark, but noted that the addition of the word "truth" showed that the website is not sponsored by OMSJ, and "even more important" the website itself does not look like OMSJ's own site. Moreover, the website was not the advertising for a business, but was created as a forum for criticizing OMSJ. ROA.1962. Nor did appellee and appellant offer similar services: OMSJ offers a service of investigating HIV-related crimes, while DeShong was trying "to criticize Baker, not steal his clients." *Id.* Indeed, the website does not advertise a business at all. In this regard, the district judge cited the case that first recognized the defense of nominative fair use. *Id.*, citing *New Kids on the Block v. News America Pub.*, 971 F.2d 302 (9th Cir. 1992).

The judge next ruled that DeShong's alleged intent to destroy OMSJ's business was not the sort of "bad intent" that supports a finding of likelihood of confusion; rather, the "intent" that supports a claim of infringement must be "an attempt to piggyback off the goodwill of . . . The Innocence Group mark." ROA.1963. Then the court addressed and rejected appellant's contention that actual confusion had been pleaded. To the contrary, OMSJ would have had to

plead that a potential client is “confused as to the **source** of the website, which is the only kind of confusion with which the Lanham Act is concerned.” ROA.1963-1964 (emphasis in original). The complaint, however, pleads only that Internet users “are often confused by . . . the information contained [in DeShong’s site],” ROA.1963, quoting ROA.886 ¶ 18, and that is not sufficient to support a claim for infringement.

Finally, the trial judge rejected OMSJ’s contention that it had pleaded initial interest confusion, because, in the context of a claim about a domain name, a claim of initial interest confusion can be pleaded only in the context of the website for which the domain name has been used. ROA.1964, *citing Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005). Indeed, the court said, initial interest confusion can be found only “in cases involving a factor absent here—one business’s use of another’s mark for its own financial gain.” ROA.1965. “When an alleged infringer does not compete with the markholder for sales, ‘some initial interest confusion will not likely facilitate free riding on the goodwill of another mark.’” *Id.*, *citing Checkpoint Sys. v. Checkpoint Software Techs.*, 269 F.3d 270, 296-297 (3d Cir. 2001). Moreover, “[a]pplying the initial interest confusion theory to gripe sites like DeShong’s would enable the markholder to insulate himself from criticism—or at least to minimize access to it. Such use of the Lanham Act is

condemnable . . .” ROA.1966. The court thus dismissed the Lanham Act claim, *id.*; it declined to exercise jurisdiction over the state-law claims. ROA.1969.

OMSJ has now appealed from the judgment of dismissal, confining its arguments to the dismissal of the Lanham Act claim.

SUMMARY OF ARGUMENT

Although the names of policy-oriented groups, like the names of churches and political parties, can be trademarked, the First Amendment gives its greatest protection to speech about non-commercial ideas, and courts are properly very cautious about applying expansive trademark doctrines to limit speech at the core of the First Amendment. Trademark law implicates principles of commercial speech that allow liability to be imposed for merely confusing or misleading advertisements, and authorizing injunctive relief as a significant remedy, but courts give a wide berth to speech about political and religious subjects, requiring a compelling government interest before liability can be imposed, disfavoring injunctive relief through the rule against prior restraints, and requiring a false statement about facts, including an intentional falsehood or at least reckless disregard of probable falsehood, before liability can be imposed. When the speech at issue is noncommercial criticism, trademark law does not apply at all.

Where, as here, the complaint alleges neither that defendant’s use of the

mark created a likelihood of confusion about source or sponsorship of the website, nor that the mark was used in connection with the sale or advertising of goods and services, that should be enough to warrant affirmance of the dismissal without addressing other questions such as the First Amendment or various Lanham Act doctrines. Indeed, dismissal was proper under this Court's decision in *TMI v. Maxwell*, 368 F.3d 433, which held that a non-commercial criticism site was beyond the reach of the trademark laws simply because it was non-commercial. Or, dismissal can be affirmed in reliance on several decisions in other circuits holding, as a matter of law, that a trademark may be used in the domain name for a website about the trademark holder because such use does not create a likelihood of confusion about source. The law is so clear that a look at the domain name and the website is enough—there is no need to engage in thorough consideration of what has been pleaded or of the likelihood of confusion factors.

And if the Court does choose to address the likelihood-of-confusion factors, the trial court can be affirmed on that ground as well. Or, given the fact that the domain name has been used as the web address of an expressive work, dismissal was also appropriate in light of the special pleading standard that the Court has adopted for such cases, following the Court of Appeals for the Second Circuit. On any of these grounds, or based on the First Amendment's protection for truthful

speech, the Court should affirm the judgment below.

ARGUMENT

An action is properly dismissed under Rule 12(b)(6) 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).

Moreover, as noted above on page 3, defendant’s blog and OMSJ’s own website were also properly considered on a motion to dismiss, even though they were not attached to the complaint, because the complaint not only refers to them but depends on them.

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

Ordinarily, courts consider statutory issues first to avoid constitutional

issues. Trademark statutes are customarily construed in light of First Amendment concerns, particularly insofar as they distinguish between commercial and noncommercial speech. To show that principles of constitutional avoidance are properly invoked here, we begin our analysis with the First Amendment.

DeShong's speech is indisputably protected by the First Amendment. OMSJ'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 Enterprises*, 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; *Better Business Bureau v. Medical Directors*, 681 F.2d 397, 404-405 (5th Cir. 1982); *U-Haul Int'l v. Jartran*, 793 F.2d 1034, 1042 (9th Cir. 1986).

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). This question 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. *Semco v. Amcast*, 52 F.3d at 111-112.

Thus, when, as in *Semco*, *Porous Media*, and *U.S. Healthcare*, one company makes statements about a competitor during an advertising campaign, courts apply multi-factor tests to determine whether 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.³

DeShong's website is just the sort of social commentary that courts assiduously protect. DeShong's criticisms would be pointless if he had to omit OMSJ's "HIV Innocence Group" name. Furthermore, it is not just the websites generally, but DeShong's use of OMSJ's trademark in his domain name, that constitutes protected speech. Courts have repeatedly held that the use of

^{3/} *L.L. Bean v. Drake Publishers*, 811 F.2d at 33.

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 Restaurants v. Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981).

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. Publ'ns Int'l*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). In *Grimaldi*, 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 artistic relevance, unless the title **explicitly** misleads as to the source or the content of the work." *Id.* at 999 (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).

OMSJ's trademark claims were not 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, dismissal of the trademark claims should be affirmed for this reason alone.

II. DeSHONG WAS ENTITLED TO DISMISSAL FOR LACK OF COMMERCIAL USE OF APPELLANT'S TRADEMARK.

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

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 from the limitations of the Commerce

Clause, which empowers Congress to regulate only matters with a nexus to economic activity. *United States v. Lopez*, 514 U.S. 549 (1995).

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[.]”).

Thus, 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 markholder was not commercial speech simply because it might

impair the markholder's commercial interests. Although the court's analysis was rooted in the First Amendment, the case surely stands for the proposition that the trademark laws cannot be applied to forbid such noncommercial speech.⁴

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 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.

Limiting the trademark laws to the commercial context also finds support in caselaw applying the Commerce Clause. The courts' discussion of "commerce"

⁴See 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).

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), *rev’d on other grounds*, 133 S. Ct. 2496 (2013); *U.S. 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.” *U.S. v. Morrison*, 529 U.S. 598, 611 (2000). Moreover, the activity substantially **affected** must itself be an “economic enterprise or transaction.” *Hoffman v. Hunt*, 126 F.3d 575, 585-588 (4th Cir. 1997); *Gibbs v. Babbitt*, 214 F.3d 483, 491-492 (4th Cir. 2000).

Accordingly, the statutory provisions at issue in this case are limited to commercial speech. “The act’s purpose, as defined in Section 45, is exclusively to protect the interests of a purely commercial class against unscrupulous commercial conduct.” *Made in the USA Found. v. Phillips*, 365 F.3d 278, 280 (4th Cir. 2004); *Colligan v. Activities Club of New York*, 442 F.2d 686, 692 (2d Cir. 1971). OMSJ brought 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). 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).

Moreover, giving the statute its plain meaning has the additional benefit of avoiding the constitutional issues that would arise were the “likelihood of confusion” standard, that allows speech to be enjoined and punished without any finding of actual or intentional falsehood, applied to purely noncommercial speech. One cannot review the corpus of trademark decisions in this Circuit (and elsewhere), and their articulation of the likelihood of confusion factors, without being struck by the pervasiveness of the assumption that trademark is a **commercial** tort that applies to unfair conduct by **commercial** competitors.

Moreover, 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) (emphasis added).

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 Enterprises 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).

Both this Court, and several other circuits, have limited the application of the Lanham Act to lawsuits over commercial uses of domain names. Thus, in *TMI v Maxwell*, 368 F.3d 433, a company that built houses under the name Trendmaker Homes sued a dissatisfied consumer who had established a website 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 this Court 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), this Court 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.

Several other courts have joined this Court in rejecting trademark infringement claims based on the use of a trademark in domain names of commentary websites because the sites were 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).

OMSJ argues that, instead of following its own precedent in *TMI* and *Procter & Gamble* on the scope of the Lanham Act, the Court should hold that the statutory language “use in commerce” takes the Lanham Act to the limits of Congress’ Commerce Clause authority and hence warrants infringement findings against defendants who do not gain any economic benefit from their use of the

plaintiff's trademark, citing the Second Circuit's decision in *United We Stand America v. United We Stand America New York*, 128 F.3d 86, 92 (1997), as well as a few district court rulings. This argument ignores the economic nexus requirement of contemporary Commerce Clause jurisprudence, and in any event DeShong does not rely on the statute's "use in commerce" language. Instead, he invokes the requirement that the use of the mark be in connection with sale or advertising of goods and services, following such cases as *Bosley*, *Utah Lighthouse* and *Taubman* that have relief on that language as well for their commerciality requirements. Moreover, in *United We Stand* and all of the district court rulings cited by OMSJ, save one, the defendants were using the mark to solicit donations to their cause, as many of the parentheticals on pages 14-15 of OMSJ's own brief make clear.⁵ Here, DeShong gets no financial benefit from the

⁵ In *Committee for Idaho's High Desert v. Yost*, 881 F. Supp. 1457 (D. Idaho 1995), *aff'd in part on other grounds*, 92 F.3d 814 (9th Cir. 1996), cited by OMSJ at 16, the opinion reflects that the plaintiff used the trade name for fundraising purposes as well as selling goods to its members and the general public. 881 F. Supp. at 1465. Moreover, the trial court's discussion of whether the sale of products was **required** for the application of the Lanham Act was limited to whether such sale was needed for the mark to be protected by the Lanham Act; the court never suggested that a defendant could be held liable for infringement if it did no more than use the name to identify the trademark holder as a subject of criticism. In *Brach's Van Houten Holding v. Save Brach's Coalition*, 856 F. Supp. 472 (N.D. Ill. 1994), the defendant was using plaintiff's trademarked logo on leaflets and press releases **and** in "soliciting donations." *Id.* at 475. The Court's holding of infringement was confined to the logo, not the use of the word "Brach's." *Id.* at 476, 477.

use of the mark in his domain names.

B. DeShong's Website Is Noncommercial.

In light of this governing law, dismissal of this case should be affirmed for two reasons. The complaint never alleges that DeShong's website used OMSJ's mark in connection with the sale or advertising of DeShong's goods or services. The failure to plead this element of an infringement claim is fatal all by itself.

Moreover, looking beyond the face of the complaint to the blog itself, which was referenced in the complaint and as argued above can be considered on a motion to dismiss, also reveals its noncommercial character. The website is dedicated to the communication of opinions and information about OMSJ and its principal, Baker. The website contains no advertisements (which is how many websites produce revenues for their operators).

On appeal, OMSJ advances arguments about why DeShong's website should be seen as being sufficiently "commercial" to come within the purview of the trademark laws. None of these arguments are sound.

First, OMSJ argues that DeShong's blog is not a "gripe site" as that term has been defined by the cases because he is not dissatisfied customer, Br. 7, 17-19, but that is a distinction without a difference, because it is not only former customers who are entitled to engage in non-commercial speech about trademark holders. In

the *Utah Lighthouse* and *Lamparello* cases, the websites were created by opponents' of the markholders' policies, and in *Taubman*, the original website over which the trademark litigation began was a **fan** site about shopping mall, posted by a resident of a nearby neighborhood.

Second, OMSJ argues, relying on an exhibit to an affidavit from Baker, that, even though there were no advertisements on DeShong's website, some of the websites to which he linked themselves contained links to commercial websites. Br. 13, citing ROA.1402-1405. Apart from the fact that affidavits cannot be considered on a motion to dismiss, and that the exhibit is an unauthenticated listing of supposed links, *Bosley* squarely held that this sort of linking argument does not bring a criticism website within the purview of the trademark laws:

Kremer's website contains no commercial links, but rather contains links to a discussion group, which in turn contains advertising. This roundabout path to the advertising of others is too attenuated to render Kremer's site commercial. At no time did Kremer's BosleyMedical.com site offer for sale any product or service or contain paid advertisements from any other commercial entity.

403 F.3d at 678.

Finally, OMSJ argues that its allegations about DeShong's adverse impact on its business, and about DeShong's **intent** to hurt its business, is enough to make his criticisms commercial speech. Br. 9-12. But that argument runs

squarely up against this Court's decision in *TMI*, considering that the defendant created his website to warn consumers about the perils of buying houses from TMI. Moreover, several courts have squarely rejected the contention that adverse impact on a business makes speech commercial, *e.g.*, *CPC Holdings*, 214 F.3d at 461-463; *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1015-1017 (9th Cir. 2004), and this rule is implicit in *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 418 (1971), where the Supreme Court struck down an injunction against criticizing a business as a prior restraint, at a time when the First Amendment had not yet been held applicable to commercial speech.

Consequently, the non-commercial nature of DeShong's website is alone sufficient reason to affirm the judgment dismissing OMSJ's trademark claim.

III. THE INFRINGEMENT CLAIM WAS PROPERLY DISMISSED FOR LACK OF LIKELY CONFUSION ABOUT WHETHER OMSJ SPONSORS DeSHONG'S WEBSITE, AND BECAUSE DeSHONG MADE FAIR USE OF THE MARK.

Dismissal was also proper because trademark law is not a general law against confusing speech—it limits only speech that creates confusion about the **source** of goods or services—and domain names may designate the subject of websites, not just their source. Consequently, numerous federal courts have held that trademarks may be used as domain names for websites that are **about**

markholders or about trademarked goods or services, even sites that are operated by persons other than the markholders, because the names do not occasion confusion about source. And the complaint did not allege likely confusion about source.

A. The Only Confusion That Matters is About Source, Sponsorship or Affiliation.

This Court’s decisions repeatedly confirm that infringement liability depends on “likelihood of confusion as to source, affiliation, or sponsorship.” *National Business Forms & Printing v. Ford Motor Co.*, 671 F.3d 526, 532 (5th Cir. 2012); *Board of Supervisors for LSU Agricultural and Mechanical College v. Smack Apparel Co.*, 550 F.3d 465, 478 (5th Cir. 2008). “Trademark law is plainly not designed to protect licensees as such, but instead to protect the public—i.e., consumers—from confusion about a product’s source.” *ICEE Distributors v. J&J Snack Foods Corp.*, 445 F.3d 841, 846 (5th Cir. 2006). *See also Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 157 (1989) (“[Unfair competition law’s] general concern is with protecting consumers from confusion as to source[.]”).

Other circuits hold the same. “The limited purpose of trademark protections set forth in the Lanham . . . Act is to avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying

a product they mistakenly believe is sponsored by the trademark owner. Trademark law aims to protect trademark owners from a false perception that they are associated with or endorse a product.” *Mattel v. Walking Mt. Prods.*, 353 F.3d 792, 806 (9th Cir. 2003). “The trademark laws exist not to ‘protect’ trademarks, but . . . to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.” *James Burrough Ltd. v. Sign of Beefeater*, 540 F.2d 266, 276 (7th Cir. 1976); “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. General Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979). *See also West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581, 590 (6th Cir. 1955) (“[I]t 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[.]”).

OMSJ squarely disputes this proposition, arguing based on a single district court decision from within the Fourth Circuit that infringement claims can proceed even if the likely confusion does not relate to the source or sponsorship of a defendant’s web site. OMSJ Br. 9 (caption of section D(1) “Need not . . . Create Confusion as to Origin or Sponsorship”), 10 (“does not depend on . . . mistake as to

ownership of the site”), citing *PETA v. Doughney*, 113 F.Supp.2d 915 (E.D. Va. 2000). This argument proceeds without acknowledging contrary Fifth Circuit cases (cited above), or admitting that the Fourth Circuit has squarely held the contrary, “[T]he use of a competitor’s mark that does not cause confusion as to source is permissible.” *Lamparello v. Falwell*, 420 F.2d at 314, quoting *Dorr-Oliver v. Fluid-Quip*, 94 F.3d 376, 380 (7th Cir.1996).

B. The First Amended Complaint Never Alleges Confusion About Source, Sponsorship or Affiliation.

When a plaintiff makes sufficient plausible and non-conclusory allegations that the defendant’s use of a protected mark is likely to cause confusion among reasonable consumers about the source of the defendant’s goods or services, the plaintiff can survive a motion to dismiss and impose the significant costs of trademark litigation, at least including discovery, expert reports, and the like, pending a motion for summary judgment. In this case, however, there was no reason to put DeShong to that expense because although the word “confusion” and “likelihood of confusion” are liberally sprinkled throughout the complaint, OMSJ **never** alleged that DeShong’s use of the mark was likely to cause confusion about source, sponsorship or affiliation. Moreover, the only confusion pleaded in the complaint is that consumers will read what DeShong has to say about OMSJ and

Baker and thus be misled into believing facts that hurt plaintiffs' reputation. *E.g.*, ROA.885-886 ¶¶ 18-19, 891 ¶ 22. But complaints about the impact of allegedly false statements about the trademark holder on its reputation are redressed through the law of defamation, not through trademark law. *Universal Commc'n Sys. v. Lycos*, 478 F.3d 413, 424 (1st Cir. 2007).

C. Trademarks May Be Used in Domain Names for Nonconfusing Websites About the Markholder.

As applied to domain names, the historic concern about source confusion is that a member of the public, wanting to find a particular website but not knowing its Internet address, would simply “name-guess”—type a trademarked name into his browser, followed by the top-level domain “com,” hoping that is the correct web address, and be led to the wrong location. *Panavision Int'l v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998). 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.⁶

⁶ Although OMSJ's appellate brief makes no argument about how name-guessing would lead Internet users to DeShong's blog instead of OMSJ's web site, OMSJ's appellate brief argues that “DeShong's site actually appears before any other site of the same name,” Br. 10, citing ROA.1307-1308. However, these pages of the record contain an affidavit from Baker asserting facts about search engine results that are not alleged in the complaint; such material cannot be considered on a motion to

Particularly during the early years of the Internet, courts decided several cases where competitors disputed which of them was entitled to use particular trademarks to denominate their products, and therefore the websites about those products. *E.g., Brookfield Communc'ns v. West Coast Video*, 174 F.3d 1036 (9th Cir. 1999). 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.

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. *Id.* at 1065-66; *New Kids on the Block v. New America Pub.*, 971 F.d 302, 306-309 (9th Cir. 1992). This Court has endorsed this fair use defense. *Bd. of Supervisors for LSU Agric. & Mech. College*, 550 F.3d at 488-489. For example, the courts consistently hold that fair use, construed consistently with the First Amendment, allows publishers or authors of books or other expressive works about famous persons to use such persons' names in the titles of the books,

dismiss. Moreover, the affidavit does not attach any search results, but asserts that the order of web sites appear in search engine results attributed to a declaration supposedly submitted by one of DeShong's lawyers, and "attached documents." In fact, the search engine results that **do** appear in the record were attached to an affidavit from DeShong, and those results show that OMSJ's own web site shows up **first**, before any result related to DeShong's site. ROA.205, 207.

movies and songs. *Twin Peaks Prod. v. Publications Int'l*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Mattel v. MCA Records*, 296 F.3d 894, 902 (9th Cir. 2002).

Domain names can play the same role as book titles in denominating the subject of underlying websites. For many years, “apples.com” was the domain name of a website about apples, not the website of Apple computer company. Just as the title of a book may use a trademark truthfully to describe the content of the book, so may DeShong use a trademark as a domain name truthfully to describe the contents of his website. 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.”

If the Web’s sole function were to serve as a commercial marketplace, and the only reason Internet users might be searching for websites were to find the vendors of goods, then a rule that only the owner of a trademark could use that mark as the domain name to denominate its website might be sensible. But the Web is not exclusively a marketplace—even at the turn of the century, there were millions of eleemosynary websites that provided information rather than peddling products. Kelly, *The Web Runs on Love Not Greed*, Wall Street Journal, January

3, 2002. And a report by the Markle Foundation revealed that the predominant public perception of the Internet is of a library, or source of information, rather than as a shopping mall, or a place to obtain goods and services from their vendors. *Toward a Framework for Internet Accountability* (2001), http://www.markle.org/downloadable_assets/accountabilitych1.pdf, at 20-25 (last visited October 14, 2014).

Thus, there is no reason to assume that persons looking for websites bearing the title “HIV Innocence Group” are necessarily looking for OMSJ—they may just as well be looking for information that will help them evaluate OMSJ, or for information about how to take action if they disapprove of it. The rules governing uses of domain names must accommodate all of these disparate reasons for seeking OMSJ-related information, and concomitantly all of the ways in which website operators may want to speak about OMSJ, either positively or negatively.

Although *TMI*, in addressing the use of trademarks used in the domain name for a criticism site, addressed only the issue of non-commercial use, other courts have held that it is permissible to use a domain name incorporating a trademark for a facially nonconfusing website about the trademark holder. The leading case involved a consumer who established a website at shopsatwillowbend.com about a neighboring shopping mall. The court found no violation of the trademark laws.

Taubman v. WebFeats, 319 F.3d 770 (6th Cir. 2003). Similarly, in *Lamparello v. Falwell* and *Utah Lighthouse Ministry*, the Fourth and Tenth Circuits rejected trademark claims about domain names for criticism sites resting squarely on the lack of likely confusion. At the district court level, when a dissatisfied customer created northlandinsurance.com to publicize his grievances about the small amount that Northland Insurance had paid on a claim, the court found a legitimate use of the domain name for the expression of opinions about the company. *Northland Ins. Co. v. Blaylock*, 115 F.Supp.2d 1108 (D. Minn 2000). See also *Bosley Medical v. Kremer*, 2004 WL 964163 (S.D. Cal.), the website was erected by a dissatisfied customer of a “hair restoration company” at www.bosleymedical.com and www.bosleymedicalviolations.com. The district court granted summary judgment, finding no likelihood that Internet visitors would be confused about the sponsorship of the website. *Id.* at *10, *aff’d on other grounds*, 403 F.3d 672, 677-670 (9th Cir. 2005). Other cases upholding domain names about criticism sites are *Ficker v. Tuohy*, 305 F. Supp.2d 569, 572 (D.Md. 2004) (domain name robinficker.com for website attacking candidate in Republican Congressional primary); *Crown Pontiac v. Ballock*, 287 F. Supp.2d 1256 (N.D. Ala. 2003) (domain name crownpontiacnissan.com for website about car dealer).

DeShong's website falls squarely within these holdings. OMSJ is the subject of his site, and the site's content makes plain that it is a criticism site, not OMSJ's own site. Moreover, there is an additional fact about this case that undercuts any possible claim that DeShong's domain names are likely to create confusion about source, and that is the fact that the word "truth" is appended at the end of the domain name, after the trademark but before the top-level domain, the dot.com. Even assuming that name-guessing remains a serious concern for trademark owners, no consumer is likely to type OMSJ's trademark, **plus** the word "truth," into a browser in the hope of finding OMSJ's own website.

Some early district court decisions disallowed trademarked domain names for criticism websites. *E.g., Planned Parenthood v. Bucci*, 1997 WL 133313 (S.D.N.Y.), *aff'd mem.*, 152 F.3d 920 (2d Cir. 1998) (mem.); *Jews for Jesus v. Brodsky*, 993 F. Supp 282 (D.N.J. 1998), *aff'd mem.*, 159 F.3d 1351 (3rd Cir.). In those cases, however, the websites at issue were intentionally confusing, and the entire domain name consisted of the trademark, without additional expression. Moreover, the cases were decided at a time when search engines were in their infancy and, therefore, courts worried that individuals looking for a particular site would give up after they found defendants' sites instead.⁷ More recent cases take

⁷In each case, the website operators were also peddling books or trinkets.

a more sanguine view because “there is a difference between inadvertently landing on a website and being confused,” *The Network Network v. CBS*, 54 USPQ2d 1150, 1155, , 2000 WL 362016 (C.D. Cal. 2000), and Internet users “are inured to the false starts and excursions awaiting them in this evolving medium.” *Chatam v. Bodum*, 157 F. Supp.2d 549, 558-559 (E.D. Pa. 2001). *See also Network Automation v. Advanced Systems Concepts*, 638 F.3d 1137, 1152-1153 (9th Cir. 2011). If they do not find what they are seeking with their first guess about how to find it, they will try another approach, such as by using a search engine. *Strick Corp. v. Strickland*, 162 F. Supp.2d 372 (E.D. Pa. 2001). As search engines have improved over ensuing years, the cost to consumers of landing on the wrong site based on a bad guess about a domain name is so low as to be de minimis, and certainly is not sufficiently great to warrant imposing a burden on a critic’s right to use the trademark to identify his website as being about the trademark holder. Consequently, the Court should follow the overwhelming weight of recent authority, including rulings from other circuits, rather than these outdated trial court decisions, on the issue whether domain names that include a trademark are likely to cause confusion about source and are beyond the protection of the fair use defense.

D. The Likelihood of Confusion Factors Show No Likelihood of Confusion.

In the court below, DeShong did not argue for dismissal based on the likelihood of confusion factors because the complaint never alleged likelihood of confusion about source and because the impossibility of actionable confusion is so clear. This Court has noted that the factors need not be considered in every case, *Falcon Rice Mill v. Community Rice Mill*, 725 F.2d 336, 345 n.9 (5th Cir. 1984), and rote discussion of factors is no substitute for sound consideration of whether, in the particular context where the marks were used, there is a likelihood of confusion about source: this Court has stressed that “[c]ontext is especially critical.” *Scott Fetzer Co. v. House of Vacuums*, 381 F.3d 477, 485 (5th Cir. 2004). “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). Moreover, recent trademark scholarship shows a tendency for judges to “stampede” the likelihood of confusion factors after deciding based on only one or two of the factors, Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581, 1614-1621 (2006). In any event, the district court’s analysis of the likelihood-of-

confusion factors was correct, and, as shown below, OMSJ's attack on the trial judge's analysis is not only deeply flawed but rests on misrepresentations about the record

This Circuit's multi-factor test, enunciated in *Elvis Presley*, 141 F.3d at 194, shows that the domain name and website pose no likelihood of confusion. *Elvis Presley* 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 to cause confusion about source, and (7) actual confusion. The complaint did not allege facts that would support a claim for likelihood of confusion about source based on these factors; indeed the complaint, and the web sites themselves, establish the lack of likely confusion.

The strength of OMSJ's mark. The complaint alleged that OMSJ's mark was well-known in the community of HIV denialists, indeed that the mark was "famous" in that community. Even assuming that OMSJ has a strong mark, that factor does not support a finding of likely confusion in this case. The very strength of the mark helps consumers understand that a parody or other commentary is offered by a critic, not by the trademark owner. *Hormel Foods*

Corp. v. Jim Henson Productions, 73 F.3d 497, 503 (2d Cir. 1996). Moreover, the more well-known the plaintiff is, the stronger the public interest in the freedom of others to criticize the plaintiff, which simply cannot be done without using the mark.

Similarity of marks. DeShong's domain names hivinnocencegrouptruth.com and hivinnocenceprojecttruth.com both contain all or part of OMSJ's registered mark, but the former address also contains the word "truth", and the latter contains only the "hivinnocence" portion of the mark. As Judge Cummings noted below, this difference is crucial because an Internet user would not assume that a domain name containing the word "truth" in addition to the mark is a site operated by OMSJ itself. ROA.1962. And given the Court's command that the **context** be considered in analyzing the likelihood-of-confusion factors, *Scott Fetzer*, 381 F.3d at 485, it is crucial that domain names cause confusion, if at all, through erroneous name-guessing. It is highly unlikely that an Internet user searching for OMSJ's site would go beyond typing "hivinnocencegroup" in her browser before typing ".com"; it is hard to imagine why such a user would also type in "truth." The similarity of mark factor, therefore, supports lack of likely confusion.

But even if the domain name were identical to the trademark, that would not

favor OMSJ because DeShong uses his domain name for a website that is **about** the trademark holder, 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. Therefore, if a rival picks a name for its own product that is highly similar to the markholder’s name, it is taking advantage of the chance of confusion. But when the mark is used for purposes of identifying the subject of criticism, similarity is not so helpful to the markholder because there is an alternate explanation for the use of the name—to identify the target of criticism. Indeed, similarity of marks will always be present when defendants are 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 at 462. 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 Anheuser-Busch v. L&L Wings*, 962 F.2d 316, 321 (4th Cir. 1992) (similarity does not favor markholder when parody is at issue).

Similarity of Goods and Services. This factor does not support OMSJ

because DeShong does not sell goods or services; OMSJ implicitly admits that this factor is against it insofar as it argues instead that the trial court was wrong to consider this factor at all. Br. 19-22. But appellant never explains why consideration of this factor is irrelevant to the issue of likelihood of confusion. Instead, it relies on a Fifth Circuit case addressing the commercial activities exception to the Texas Citizen Participation Act. Br. 21-22, citing *NCDR, LLC v. Mauze & Bagby*, 745 F.3d 742 (5th Cir. 2014). That decision has nothing to do with trademark law and has no bearing on the likelihood of confusion.

Similarity of Facilities Used in Business and Similarity of Advertising.

These factors similarly favor DeShong because he does not use the website for business and he does not advertise the website.

DeShong's intent. *Elvis Presley* makes clear that the only intent that is relevant is "intent to confuse the public," and that an "intent to parody . . . is not an intent to confuse." 141 F.3d at 203. An intent to comment is similarly not an intent to confuse. No intent to confuse about source is even alleged here. To be sure, when the seller of a rival product deliberately chooses a domain name for a website for its own products using a name known to be another person's trademark, 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 website that is about the trademarked service, quite the opposite intent should be inferred. Otherwise, any fair use would support a finding of bad intent. In this case, DeShong chose a domain name that accurately identified his web site as being about OMSJ's HIV Innocence Group activities.

Actual Confusion. Although the complaint contains the phrase "actual confusion," OMSJ never alleged that there was actual confusion about source, and confusion about source is the **only** confusion that matters.

OMSJ's brief identifies one incident that supposedly shows actual confusion, Br. 23-24, but in fact it shows nothing of the kind. Apparently, lawyers for an accused defendant told the defendant that they would withdraw if the defendant (Gutierrez) insisted that they advance OMSJ's theories; OMSJ claims that "evidence presented by OMSJ points to Gutierrez attorney finding DeShong's web site, taking it at face value, and looking no further." *Id.* Even if this were a fair representation of the record, and even if the court below should have considered "evidence" that was not alleged in the complaint on a motion to dismiss, the facts would have no bearing on the existence of actual confusion about the source or sponsorship of DeShong's web site. Instead, this is another example of OMSJ treating the persuasiveness of DeShong's **substance**, and the

impact of that substance on OMSJ's reputation, as a trademark claim.

But the problem goes deeper because the record does not say what OMSJ's brief says it does. ROA.1345-1351 is an affidavit from a military defense lawyer recounting his consideration and eventual rejection of the possibility of using OMSJ and Clark Baker as experts in Gutierrez' defense. We have placed the affidavit in Appellee's Record Excerpt so that the Court may easily compare it to the characterization in OMSJ's brief. Not only does the affidavit say nothing about DeShong or his web site (an attachment to the affidavit, at ROA.1352-1355, is from a **different** blog), but it does not suggest that the lawyer visited some web site, took it at face value, and looked no further. To the contrary, the lawyer averred that he communicated with Baker personally several times, that he received and read emails from Baker, and that he then did his own research that led him to conclude that Baker was "ethically questionable" and that Baker was touting wild conspiracy theories that are rejected by every real scientist, would not likely persuade military jurors, and might even lead to a harsher sentence by suggesting to the tribunal that Gutierrez took his HIV status lightly and would infect more sexual partners.

In any event, there is no evidence of actual confusion about source, and no allegation of actual confusion about source. The absence of such allegations is

alone fatal to plaintiff on the issue of likely confusion, because this Court has held that “absence of, or minimal, actual confusion over an extended period of concurrent sales weighs against a likelihood of confusion.” *Elvis Presley*, 141 F.3d at 204. Many other circuits agree that when two uses exist side by side for several years and there are only a few instances of confusion, that fact weighs **against** a finding of likely confusion. *See also A&H Sportswear v. Victoria’s Secret Stores*, 237 F.3d 198, 227 (3d Cir. 2000); *Kendall-Jackson Winery v. E&J Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir. 1998); *Petro Stopping Ctrs. v. James River Petroleum*, 130 F.3d 88, 91 (4th Cir. 1997).

The complaint alleges that DeShong first posted his blogs in July 2011. ROA.855. The absence of any actual confusion about source in the intervening years strongly suggests that no confusion is likely.

The Relevance of Initial Interest Confusion. Finally, OMSJ invokes “initial interest confusion” as a basis for its infringement claim. In the Internet context, some courts say that initial interest confusion occurs 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 website 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.

This Court has never recognized this doctrine in the Internet context, however, and it should not do so here. Although the concept was trendy in the early years of this century, trademark law scholars have pointed out that initial interest confusion is “predicated on multiple mistaken and empirically unsupportable assumptions about searcher behavior,” and is a hopeless hodgepodge of theories that are not applied consistently by the courts. Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L. J. 507, 559-575 (2005). Several circuits gone out of their way to avoid adopting the concept, often expressing serious skepticism of it. *Sensient Technologies Corp. v. Sensory Effects Flavor Co.*, 613 F.3d 754, 766 (8th Cir. 2010); *Lamparello v. Falwell*, 420 F.3d 309, 317 (4th Cir. 2005); *Hasbro, Inc. v. Clue Computing*, 232 F.3d 1, 2 (1st Cir. 2000). In any event, for three critical reasons, initial interest confusion cannot

help OMSJ here.

First, initial interest confusion has its most important application when two commercial competitors are selling similar goods to the same set of consumers, *Nissan Motor v. Nissan Computer*, 378 F.3d 1002, 1019 (9th Cir. 2004); *Checkpoint Sys. v. Check Point Software Tech.*, 269 F.3d 270, 296-297 (3d Cir. 2001). Here, DeShong is not selling rival goods but is simply expressing his views about OMSJ. In these circumstances, the possibility of initial interest confusion is virtually non-existent.

Second, developments in both law and technology call into question the applicability of initial interest confusion to websites that accurately use domain names to denote websites' subjects. 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 websites. *E.g.*, *Panavison v. Toeppen*, 141 F.3d at 1327; *Jews for Jesus*, 993 F. Supp at 303 (D.N.J. 1998). Courts assumed that a customer who got to the wrong website would just give up "due to anger, frustration or the assumption that plaintiff's homepage does not exist." *Id.* at 307. 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 F.3d 1135, 1147 (9th Cir. 2002). Next, in *Interstellar Starship Serv. v. Epix*, 304 F.3d 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. And numerous courts 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” website as a result of initial interest confusion. *E.g.*, *Strick Corp. v. Strickland*, 162 F. Supp.2d 372 (E.D. Pa. 2001); *Bihari v. Gross*, 119 F. Supp.2d 309, 320 n.15 (S.D.N.Y. 2000). As *Strick* stated:

[A]ny initial confusion that arises from Defendant’s use of his strick.com domain site, specifically, that consumers will realize that they are at the wrong site and will go to an Internet search engine to

find the right one, is not enough to be legally significant. . . . It is clear that Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded, or unnerved, when, after taking a stab at what they think is the most likely domain name for particular web site [they] guess wrong and bring up another's webpage.

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

Given the fact that it was the Ninth Circuit that spawned the application of initial interest confusion in the Internet context, its recent treatment of the doctrine is especially telling:

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

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

Similarly, the Second Circuit has cut back initial interest confusion in the Internet context by demanding a showing of intentional diversion, which is not alleged in the complaint:

Because consumers diverted on the Internet can more readily get back

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

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

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 too persuasive, would be inconsistent with the First Amendment. Even if a compelling government interest were served by forbidding mere “likelihood of confusion,” and there were thus a constitutionally permissible basis for issuing an injunction against noncommercial speech, the constitutional basis for the injunction is even more problematic if the confusion caused by the trademark is merely ephemeral. If, for example, the confusion caused by use of the trademark in a domain name is dispelled as soon as the viewer begins to read the homepage and recognizes that the site is critical of the markholder and does not promote the markholder’s viewpoint, there is no “compelling government interest” served by enjoining the domain name. *See Lamparello*, 420 F.2d at 317 (as a matter of trademark law, initial interest confusion cannot be a basis for liability absent “one business’s use of another’s mark for its own financial gain.”) *Cf. Northland Ins. Co. v. Blaylock*, 115 F.

Supp.2d 1108, 1119-1121 (D. Minn. 2000) (declining as a matter of trademark law to apply initial interest confusion absent proof of commercial motive).

In sum, the *Elvis Presley* factors weigh heavily in favor of a finding that there is no likelihood of confusion, and judgment should be affirmed for this additional reason.

CONCLUSION

The judgment of the district court should be affirmed.

Respectfully submitted,

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October 15, 2014

CERTIFICATE OF COMPLIANCE

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