

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPERIOR COURT DEPARTMENT  
OF THE TRIAL COURT

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

Plaintiffs, )

CIVIL ACTION NO. 07-2075-H

v. )

LONG BOW GROUP, INC., )

Defendant. )

**LONG BOW’S OPPOSITION TO  
JENZABAR’S MOTION FOR LEAVE TO AMEND COMPLAINT**

**TABLE OF CONTENTS**

TABLE OF AUTHORITIES..... iii

INTRODUCTION..... i

I. JENZABAR’S AMENDED COMPLAINT IS NOT BASED ON FACTUAL  
ISSUES THAT WERE TRIED WITH CONSENT..... 1

II. THE MOTION TO AMEND SHOULD BE DENIED BECAUSE OF JENZABAR’S  
UNDUE DELAY AND BECAUSE OF PREJUDICE TO LONG BOW..... 4

III. THE MOTION TO AMEND SHOULD BE DENIED FOR FUTILITY BECAUSE THE  
PROPOSED AMENDED COMPLAINT IS STILL SUBJECT TO SUMMARY  
JUDGMENT. .... 7

A. The Cases Providing Special Standards for Expressive Uses Apply with  
Espesial Force to Title Tags..... 7

B. Jenzabar’s Proposed New Claims Run Afoul of the First Amendment Right to  
Describe Truthfully the Content of Long Bow’s Web Pages Containing Non-  
Commercial Speech About Jenzabar..... 10

C. Jenzabar’s Proposed New Claims Are Equally Subject to Dismissal Because the Doctrine of Initial Interest Confusion Cannot Be Applied Here as a Matter of Law.. . . . 13

D. The Proposed Claims Are Still Susceptible to the Fair Use Defense. . . . . 14

E. The Proposed Claims Are More Untimely Than the Original Claims.. . . . 15

F. Jenzabar’s New Allegations Do Not Help It Survive Summary Judgment Under the “Likelihood of Confusion” Factors... . . . . 17

G. The Proposed Amended Complaint Does Not Avoid Summary Judgment on Chapter 93A.. . . . 19

CONCLUSION. . . . . 20

## TABLE OF AUTHORITIES

### CASES

<i>Astra Pharmaceutical Products v. Beckman Instruments</i> , 718 F.2d 1201 (1st Cir. 1983). . . . .	14, 18
<i>Bihari v. Gross</i> , 119 F. Supp. 2d 309 (S.D.N.Y. 2000). . . . .	15
<i>Brookfield Communications v. West Coast Entertainment</i> , 174 F.3d 1036 (9th Cir. 1999). . . . .	9
<i>Castellucci v. U. S. Fidelity &amp; Guaranty Co.</i> , 372 Mass. 288 (1977). . . . .	4, 6
<i>Christoff v. Nestle, Inc.</i> , 47 Cal. 4th 468, 213 P.3d 132 (2009). . . . .	16
<i>ETW Corp. v. Jireh Pubs.</i> , 332 F.3d 915 (6th Cir. 2003). . . . .	8
<i>Glassman v. Computervision Corp.</i> , 90 F.3d 617 (1st Cir. 1996). . . . .	5
<i>Hasbro, Inc. v. Clue Computing</i> , 232 F.3d 1 (1st Cir. 2000). . . . .	14
<i>Hustler Magazine v. Falwell</i> , 485 U.S. 46 (1988). . . . .	20
<i>Interactive Products Corp. v. a2z Mobile Office Solutions</i> , 326 F.3d 687 (6th Cir. 2003). . . . .	10
<i>J.K. Harris &amp; Co. v. Kassel</i> , 253 F. Supp. 2d 1120 (N.D. Cal. 2003). . . . .	15
<i>King v. Globe Newspaper Co.</i> , 400 Mass. 705 (1987). . . . .	6
<i>LL Bean v. Drake Publishers</i> , 811 F.2d 26 (1st Cir. 1987). . . . .	7
<i>Lamparello v. Falwell</i> , 420 F.3d 309 (4th Cir. 2005). . . . .	13

<i>Massachusetts Eye &amp; Ear Infirmary v. QLT Phototherapeutics</i> , 412 F.3d 215 (1st Cir. 2005).	5
<i>Mathis v. Massachusetts Electric Co.</i> , 409 Mass. 256 (Mass. 1991).	4
<i>Mattel v. Walking Mt. Products</i> , 353 F.3d 792 (9th Cir. 2003).	8
<i>Murphy v. ISKCON of New Eng.</i> , 409 Mass. 842 (1991).	4
<i>Nelson v. Sorrentino</i> , 2007 WL 4711518 (Mass. Super. Dec. 20, 2007).	5
<i>Ng Bros. Construction v. Cranney</i> , 436 Mass. 638 (2002).	17
<i>Niton Corp v. Radiation Monitoring Devices</i> , 27 F. Supp. 2d 102 (D. Mass. 1998).	9, 14
<i>PACCAR Inc. v. TeleScan Technologies</i> , 319 F.3d 243 (6th Cir. 2003).	9
<i>Playboy Enterprises v. Welles</i> , 279 F.3d 796 (9th Cir. 2002).	15
<i>Procter &amp; Gamble Co. v. Amway Corp.</i> , 242 F.3d 539 (5th Cir. 2001).	7
<i>Quaker State Oil Refining Corp. v. Garrity Oil Co.</i> , 884 F.2d 1510 (1st Cir. 1989).	6
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989).	7
<i>Sullivan v. Iantosca</i> , 409 Mass. 796 (1991).	4
<i>Terrio v. McDonough</i> , 16 Mass. App. Ct. 163 (1983).	4
<i>Torres-Rios v. LPS Laboratories</i> , 152 F.3d 11 (1st Cir. 1998).	5

*Westchester Media v. PRL USA Holdings*,  
214 F.3d 658 (5th Cir. 2000) ..... 8

**CONSTITUTION, STATUTES AND RULES**

United States Constitution

First Amendment..... 1, 7, 8, 13, 20

Lanham Act,

15 U.S.C. §§ 1051 *et seq.*..... 15

Massachusetts General Laws

Chapter 93A..... 19, 20

Massachusetts Rules of Civil Procedure

Rule 15(a)..... 3

Rule 15(b). .... 1, 3

Rule 30(d)(3)(A). .... 4

**MISCELLANEOUS**

Goldman, *Deregulating Relevancy in Internet Trademark Law*,

54 Emory L.J. 507 (2005). .... 18

On November 3, 2009, 2-1/2 years after the complaint was filed, six months after Jenzabar replaced its counsel, four months after Long Bow Group first moved for summary judgment, two months after an extended discovery deadline, and a month after Long Bow's renewed motion for summary judgment, Jenzabar sought leave under Rule 15(b) to amend its complaint, supposedly to conform the complaint to the evidence tried with Long Bow's consent.

As filed in May 2007, the complaint contained 36 numbered factual allegations, mainly directed at a single web page, <http://www.tsquare.tv/film/jenzabar.html>, which the complaint called "the Site." The complaint asserted defamation claims, alleging that "the Site" contained false statements about Jenzabar and the two individual plaintiffs, and also asserted trademark claims on the ground that "the Site" appeared as one of the top "hits" that an Internet user sees when using the term "Jenzabar" as a search term on Google and "other popular online search engines." According to the original complaint, Long Bow infringed and diluted Jenzabar's mark by unfairly using its name in the meta tags for that page, thus bringing more attention to that page where the public would see statements about plaintiffs, and confusing consumers about whether either the page, or Long Bow's film itself, was endorsed by one or more of the plaintiffs. The defamation claims were dismissed in August 2008. In May 2009, Jenzabar hired new counsel to pursue trademark discovery. Long Bow sought summary judgment on July 20, 2009, but discovery was extended until September 15, and the Court set a summary judgment briefing schedule.

Long Bow's October 12 summary judgment made nine main arguments:

- (1) The keyword meta tags (the only type of meta tags that Long Bow uses) on the Jenzabar-related pages ("JRP") truthfully describe the content of those pages.
- (2) The First Amendment precludes application of trademark law to non-commercial speech about Jenzabar in the Jenzabar-related pages and the non-commercial speech about the content of those pages contained in the pages themselves.
- (3) Even if the trademark laws apply at all, special standards apply to trademark claims based on the titles or content of artistic and other expressive speech.

(4) The factors that govern the analysis of likely confusion favor defendant.

(5) Even if the doctrine of initial interest confusion were valid, it would not apply here.

(6) Plaintiff's claims are untimely.

(7) Fair use allows the use of meta tags for web pages about the trademark holder.

(8) Even if the trademark claims were otherwise valid, there is no evidence that the use of the mark in the meta tags caused "the Site" (described in the motion for summary judgment as the main Jenzabar-related page, or "MJP") to appear high in the search rankings.

(9) Calling attention to criticism of plaintiff is not actionable under trademark law.

The 85 numbered factual allegations in Jenzabar's proposed amended complaint address some of these arguments by drastically revising Jenzabar's trademark theories. First, in response to argument 8 (causation), which noted Google's September 2009 statement that keyword meta tag do not affect its search rankings, and have not for many years, Jenzabar now seeks to sue Long Bow for making "Jenzabar" the **title** of its main page about Jenzabar. Second, to meet arguments 2, 5 and 9, Jenzabar alleges that the purpose of Long Bow's alleged infringement is to bring its films to the attention of potential customers in colleges and universities, who are also Jenzabar's customer base; the proposed amended complaint still directs its allegations at "the Site" but now defines that term as referring to Long Bow's entire web site, including pages about the Film and how to get it. Third, instead of complaining only about the high search ranking of the MJP, the proposed amended complaint also objects to the content of the search listing, which it says could confuse Internet users, and refers vaguely to "other deceptive techniques."

The motion to amend should be denied for several reasons. First, there has been no evidence adduced at trial to which the complaint can conform, and Long Bow never consented to have new issues tried. Second, the motion for leave to amend comes unconscionably late, and allowance of the amendment at this late date would prejudice Long Bow by forcing a reopening of discovery in a

case that has been far too expensive to date, given the frivolous nature of Jenzabar's trademark claims. Third, because the trademark claims in the amended complaint remain legally baseless, and hence are subject to the motion for summary judgment that has already been filed, the motion for leave to amend should also be denied for futility.

**I. JENZABAR'S AMENDED COMPLAINT IS NOT BASED ON FACTUAL ISSUES THAT WERE TRIED WITH CONSENT.**

Jenzabar seeks leave to amend under Rule 15(b), which allows amendment to conform to issues that were tried by express or implied consent of the parties. However, this case has not yet gone to trial, and none of the new issues pleaded in the complaint was litigated with Long Bow's consent. Rather than pointing to a trial transcript, Jenzabar attaches a 327-page transcript of the deposition of plaintiff Maginn, during which Maginn was constantly making speeches that were not responsive to the questions from Long Bow's counsel, and asserts — falsely, and citing only one statement — that the many new allegations are based on statements by Maginn at his deposition. This is not a motion to amend based on trial of issues with consent that could properly have been made under Rule 15(b); this is a motion for leave to amend a complaint to add new allegations during the pretrial period, that should have been made under Rule 15(a).

But Rule 15(a) does not apply either. Jenzabar claims that the new allegations are based on “evidence that has come to light during recent discovery.” Motion to Amend 2. No **evidence** supports this characterization. Maginn's extraneous speeches do not support most of the new allegations. Some new allegations reflect facts about which Jenzabar inquired during the depositions of Long Bow's officials and staff, which they answered by **contradicting** the allegations in the amended complaint. For example, Jenzabar alleges “on information and belief” that Long Bow has edited the Wikipedia article about Ling Chai, ¶¶ 75-76. Even assuming that these allegations had any bearing on valid trademark claims, the only admissible evidence is Chang's



denial of involvement. Chang Dep. 127-128. And, to the extent that the allegations reflect deposition testimony, they are facts that could have been seen on Long Bow's web site at the outset of the case, and even nearly ten years ago when the MJP was first created. Rather than being based on newly discovered evidence, the motion reveals that, confronted with a motion for summary judgment, Jenzabar wants to change its lawsuit in the hope of keeping up the financial pressure on a small adversary that has expressed uncomfortable truths about Jenzabar and its founder.

Nor can the motion be justified on the theory of Long Bow's "consent." Long Bow did not consent to Maginn's deposition filibusters; relevance is not a valid objection during a deposition; and Rule 30(d)(3)(A) provides that such objections are not waived by failure to object.

## **II. THE MOTION TO AMEND SHOULD BE DENIED BECAUSE OF JENZABAR'S UNDUE DELAY AND BECAUSE OF PREJUDICE TO LONG BOW.**

"[T]he right to amend a complaint is not automatic." *Terrio v. McDonough*, 16 Mass. App. Ct. 163, 167 (1983). A motion to amend may be denied for "undue delay, bad faith or dilatory motive on the part of the movant, . . . undue prejudice to the opposing party by virtue of allowance of the amendment, [or] futility of the amendment." *Castellucci v. U. S. Fidelity & Guaranty Co.*, 372 Mass. 288, 290, (1977); *see also* *Murphy v. ISKCON of New Eng.*, 409 Mass. 842, 864 (1991) (amendment may properly be denied for "undue delay or undue prejudice"). Unexcused delay in seeking to amend is alone a valid basis for denying a motion to amend. *Mathis v. Massachusetts Electric Co.*, 409 Mass. 256, 264 (Mass. 1991). Although prejudice is less likely to be found if discovery is "far from complete," *Sullivan v. Iantosca*, 409 Mass. 796, 800 (1991), courts frown on motions to amend made after the close of discovery, and particularly when made in response to a motion for summary judgment. *Torres-Rios v. LPS Laboratories*, 152 F.3d 11, 16 (1st Cir. 1998) ("Allowing addition of a new theory of liability after the defendant's February motion for summary judgment and after discovery had closed in April unquestionably would prejudice defendant").

When “the motion to amend is filed after the opposing party has timely moved for summary judgment, a plaintiff is required to show substantial and convincing evidence to justify a belated attempt to amend a complaint.” *Massachusetts Eye & Ear Infirmary v. QLT Phototherapeutics*, 412 F.3d 215, 231 (1st Cir. 2005); *Glassman v. Computervision Corp.*, 90 F.3d 617, 623 (1st Cir. 1996) (disapproving motion to amend that tries “to alter the shape of the case in order to defeat summary judgment”); *Nelson v. Sorrentino*, 2007 WL 4711518, \*2 (Mass. Super. Dec. 20, 2007).

Although Jenzabar seeks leniency because it replaced its counsel in May 2009, the motion for leave to amend was not filed then; Jenzabar waited six more months, until after discovery closed. As late as the September 14, 2009 discovery hearing, Jenzabar described its legal theory as being about the meta tags on four pages on Long Bow’s tsquare.tv web site, without the slightest mention of title tags or the other newly-pleaded theories. Tr. at 15-16. Only after Long Bow moved for summary judgment did Jenzabar move to amend, and hence tell Long Bow the real issues on which Long Bow should have been taking discovery and preparing for trial.

Moreover, Jenzabar is a big company with very substantial assets that is using its resources to punish a small company for its temerity in having made a film that portrays the actions of Jenzabar’s founder in the events leading up to the Tiananmen Square massacre in a light that is contrary to the public image that she wants to cultivate. Having survived extensive proceedings that pushed its resources to the limit, Long Bow has moved for summary judgment, which is a favored remedy to lawsuits that seek to suppress free speech, because the “costs of litigation may induce an unnecessary and undesirable self-censorship.” *King v. Globe Newspaper Co.*, 400 Mass. 705, 708 (1987). Jenzabar should not be allowed to postpone the day of summary judgment just because its new counsel have come up with some new legal theories that they would like to explore further, especially because, as we explain below, the new theories of the complaint are equally susceptible to

dismissal on summary judgment.

Finally, a motion to amend is filed too late when the plaintiff either knew or should have known the new facts and theories that it is alleging. *Quaker State Oil Refining Corp. v. Garrity Oil Co.*, 884 F.2d 1510, 1518 (1st Cir. 1989); *Castelucci*, 372 Mass. at 292. To the limited extent that the new allegations in the amended complaint have any basis in fact, Jenzabar either knew or should have known those facts since the outset of this case if not before. The MJP has had the same title tag since it was first created. The tsquare.tv web site has identified and linked to Long Bow's distributors since the site began. The search listing's content (which consists of the title of the page, the first two dozen words on the page, and the URL of the page) has been the same at least since the lawsuit began. There is no reason why Jenzabar could not have pleaded in May 2007 exactly the same complaint that it now seeks to file, or why Jenzabar's new counsel could not have sought leave to amend the complaint before the depositions began.

In retrospect, reading extraneous speeches in the Maginn and Chai depositions and questions asked of Long Bow's witnesses, it is apparent that Jenzabar knew or suspected the allegations that are now pleaded in its proposed amended complaint. Had Jenzabar sought leave to amend several months ago, Long Bow could have focused its trial preparation and its discovery on those new issues. For example, had Jenzabar alleged at the outset of this case that the tsquare.tv web site was diverting traffic from Jenzabar's web site, Long Bow could have pursued discovery to test whether Jenzabar was losing traffic. Had Jenzabar alleged a claim about title tags, Long Bow could have pursued discovery (and secured expert testimony) to determine what impact title tags have on search ranking. Had Jenzabar alleged that it is "considering" the possibility of making films for its customers, Long Bow could have taken discovery of Jenzabar's business planning to determine whether the claim of consideration is genuine. Long Bow should not be forced to reopen discovery

just because Jenzabar has finally recognized that its original theories are so wanting. The Court should deny the motion for leave to amend and rule on the pending motion for summary judgment.

### **III. THE MOTION TO AMEND SHOULD BE DENIED FOR FUTILITY BECAUSE THE PROPOSED AMENDED COMPLAINT IS STILL SUBJECT TO SUMMARY JUDGMENT.**

The motion to amend should also be denied because it does not bar summary judgment for Long Bow. Most of the arguments advanced in favor of summary judgment apply equally, if not more forcefully, to the proposed amended complaint.

#### **A. The Cases Providing Special Standards for Expressive Uses Apply with Especial Force to Title Tags.**

Long Bow's opening brief cited *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 552-553 (5th Cir. 2001), and a line of cases starting with the Second Circuit decision in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), in which courts have accommodated the First Amendment by formulating special standards for assessing trademark claims against those who use trademarks for expressive purposes. SJ Mem. 8-10. As the First Circuit recognized in *LL Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987), if First Amendment protections are not accommodated, the trademark laws themselves would be unconstitutional. SJ Mem. 6-7.

Jenzabar never replies directly to these arguments — it never even mentions *Amway*, *Rogers* or *LL Bean*. Nor does Jenzabar present **evidence** to meet the *Amway* test by showing that Long Bow had an economic motive for criticizing Jenzabar, or to meet the *Rogers v. Grimaldi* test by showing that the name “Jenzabar” lacks expressive relevance to the subject of the web pages whose meta tags include Jenzabar. Jenzabar does argue that the First Amendment is not always a defense to a trademark claim, and that the trademark laws can be used against non-profit or political defendants who use misuse trademarks to seek donations or sell trademarked paraphernalia. Jenzabar Opposition to Summary Judgment (“SJ Opp.”) 9-10. But those arguments do not evade

Long Bow's cases that require special standards in the free speech context. After all, the household goods seller in *Amway*, the sex magazine publisher in *LL Bean*, and the filmmakers in *Rogers*, not to speak of the maker of the felt painting of Tiger Woods in *ETW Corp. v. Jireh Pub.*, 332 F.3d 915 (6th Cir. 2003), the publisher of *Polo* magazine in *Westchester Media v. PRL USA Holdings*, 214 F.3d 658 (5th Cir. 2000), and the photographer in *Mattel v. Walking Mt. Prods.*, 353 F.3d 792, 807 (9th Cir. 2003), were all making works for sale to the general public.

Indeed, although Long Bow cited the *Rogers v. Grimaldi* line of cases only by analogy in arguing for summary judgment on Jenzabar's trademark claims against use of its name in the meta tags for four pages on the tsquare.net web site, these cases apply directly to the use of the name Jenzabar in the **title** tag for the MJP. Just as the Second Circuit held that a trademark may be used in the title of a movie so long as the mark is relevant to the subject matter of the movie, so too may Long Bow properly use "Jenzabar" as the title of a page devoted to discussing Jenzabar. The public understands that the title of a work does not identify its author. When David McCullough wrote his magisterial biography of John Adams, he could use the title *John Adams* without running any risk of being sued on the theory that his readers might be confused about whether John Adams was the author of the book. The same is true for the title of a web page.

In this one respect, the expert affidavit that Jenzabar submitted in opposition to summary judgment supports Long Bow. In footnote 6 to his affidavit (page 7), Farance explains that the purpose of keyword and title meta tags is to "index" the web sites on which they are placed, "similar to the card cataloguing process that a librarian uses: a librarian takes the description of the book (title, subject, author, etc.) and puts it in a card catalogue for subsequent search and discovery by a user." The Court of Appeals for the Sixth Circuit noted that analogy in addressing use of keyword meta tags for a site where defendant had a legitimate basis for referring to the plaintiff's name.

*PACCAR Inc. v. TeleScan Technologies*, 319 F.3d 243, 248 n.2 (6th Cir. 2003). Because Jenzabar is discussed on the MJP, and indeed on each of the JRP, the analogy between keyword meta tags and the subject cards in a card catalogue supports Long Bow's choice to put Jenzabar's name in its keyword meta tags. And, insofar as the title tag is analogous to the title card in the card catalogue, Long Bow's use of "Jenzabar" as the MJP's title is also a non-confusing use of Jenzabar's mark.

Farance's card catalogue analogy, indeed, explains well the decisions of courts that have held that use of a trademark in the keyword meta tags for a competitor's web site is potentially confusing and hence infringing, *e.g.*, *Niton Corp v. Radiation Monitoring Devices*, 27 F. Supp 2d 102 (D. Mass. 1998), as well as the decisions cited in Long Bow's opening brief holding that a trademark may be used in the meta tags of a web page that discusses the trademark holder, even if that page is part of a larger web site that promotes a competitor. SJ Mem. at 20; *see also Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036, 1065 (9th Cir. 1999) (competitor's trademark could be used to denote comparative advertising). The courts enjoining the use of keyword meta tags generally expressed disdain for the sneakiness that was inherent in the use of a competitor's mark in invisible HTML code for a web page that nowhere used the competitor's mark in visible text. That reasoning does not apply to the title tag which, unlike keyword meta tags, is **openly** displayed in the user's browser, in the title bar of the web page.

Perhaps that is why Jenzabar could cite several cases holding the use of a trademark in keyword meta tags unlawful, SJ Opp. 19-22, but not even one case holding that the use of a trademark in a title tag is trademark infringement or dilution. The most analogous cases to title tags, indeed, are the cases holding that a trademark may be included in the "path" portion of a URL without infringing the mark. *E.g.*, *Interactive Products Corp. v. a2z Mobile Office Solutions*, 326 F.3d 687, 698 (6th Cir. 2003) ("Because post-domain paths do not typically signify source, it is

unlikely that the presence of another's trademark in a post-domain path of a URL would ever violate trademark law"). Yet the proposed amended complaint, ¶¶ 62, 65, alleges that the post-domain path of the MJP is itself confusing. Like a post-domain path, the title tag of a web site denotes the title of a web page, and not its source. Consequently, the proposed amendment to include a new claim against Long Bow's use of Jenzabar's name in the title tag of the MJP should be denied.

**B. Jenzabar's Proposed New Claims Run Afoul of the First Amendment Right to Describe Truthfully the Content of Long Bow's Web Pages Containing Non-Commercial Speech About Jenzabar.**

Long Bow argued that its pages about Jenzabar contain exclusively non-commercial speech, and that, because it uses Jenzabar's name in the meta tags only of web pages that contain such speech about Jenzabar, the First Amendment protects its right to describe truthfully the contents of those pages. SJ Mem. 4-8. Jenzabar does not dispute the proposition that the First Amendment protects the right to engage in truthful non-commercial speech, but its proposed amended complaint alleges, ¶¶ 39, 49, 65, and its summary judgment brief argues, SJ Opp. 3-4, that Long Bow is not engaged in non-commercial speech because Long Bow makes films and sells them through distributors, and because there are pages on the site that tell users how to contact the distributors to buy Long Bow's films. One of Jenzabar's new theories is that Long Bow is using its mark as a ruse to draw users to the Jenzabar-related pages on its web site, from which the users may move to the sales pages on the site, and that the use of the Jenzabar mark in the meta tags and title tags has resulted in a substantial increase in traffic to Long Bow's site. Because the arguments are both legally futile and unsupported by any evidence, Jenzabar's motion to amend should be denied, and summary judgment granted.

First, as Long Bow argued in its SJ Mem, 6-8, a speaker's right to engage in non-commercial speech is not lost because compensation is received. If Jenzabar were correct in arguing that Long

Bow's speech can be deemed commercial just because Long Bow is in the business of making and selling documentary films, then the New York Times was engaged in commercial speech when it published an advertisement about the civil rights struggle in Birmingham, Alabama, and *New York Times v. Sullivan* was wrongly decided. Nor is non-commercial speech rendered commercial just because the speaker hopes that potential customers will think better of the speaker and hence consider buying its products. The question whether Long Bow's speech at issue in this case is commercial or non-commercial rests on the well-established test defining non-commercial speech that applies equally to businesses — is it speech that proposes a commercial transaction? SJ Mem. 6-8. The Jenzabar-related pages do not propose any commercial transaction; Jenzabar's SJ Opp. never responds to this argument. Consequently, its proposed amended complaint is legally futile.

This new theory also fails to prevent summary judgment for failure of proof, because Jenzabar has produced no evidence to support its conspiracy theories. To support its claims, Jenzabar would, for example, need evidence showing that Long Bow's purpose in discussing Jenzabar was to have an excuse to draw visitors to its web site where they might see information about buying Long Bow's films, and evidence showing that searchers using the term "Jenzabar" were actually continuing to the pages identifying the distributors. Jenzabar has no such evidence. Jenzabar seeks to create an implication of such a purpose through allegations that significant numbers of Internet users are coming to the site as a result of the meta tags and title tag about which it complains, but Jenzabar has provided no evidence to support that contention. Jenzabar shows only that, in one three-month period, a few hundred Internet users reached the JRP as a result of seeing them listed in Google search results. Farance Aff. ¶ 28. Jenzabar provides **no** evidence that any of those users then clicked through to one of the sales pages. Nor is there any admissible evidence that the supposed trademark violations had any impact either on the search rankings or on



the decision to click on the MJP in the search results. Moreover, the number of Internet users who reached the Jenzabar-related page as the result of a search using the term “Jenzabar” constitutes a minuscule fraction — fewer than one-tenth of one percent — of all the hits to the web site. Wilson Aff. ¶¶ 6, 8; Farance Aff. ¶ 28; Exhibit 42, pages 869, 874. Even if every one of those visitors was drawn by an act of trademark infringement (and there is no proof of that), it is simply not credible that selling films could have been the purpose of such infringement.

Jenzabar’s theory about Long Bow’s motive — deliberately placing commentary about a big company on a minor web site in the hope of drawing traffic that might learn about and buy its films — also assumes that Jenzabar was an important company back at the turn of the century when the MJP was created and the meta tags (and title tag) were chosen. Even if the motive of attracting attention by criticizing a big company were deemed to make the critical speech commercial, Jenzabar has adduced no evidence that it was anything other than just another start-up at that time. No evidence supports Jenzabar’s theories about Long Bow’s motives, and the motion to amend should be denied because the amended complaint is futile on First Amendment grounds.

In addition to adding allegations about the title tags, Jenzabar has also added allegations about the content of the search result listing that shows the MJP. These allegations are futile because everything that appears in the search result listing is true, and hence is protected speech — the word Jenzabar in the first line of the search listing accurately describes the main subject of that web page, which plaintiff has admitted is “about Jenzabar,” Undisputed Facts ¶¶ 10-11, and the next two lines of the search listing truthfully characterize the page as containing information about Chai Ling and Jenzabar, and as having excerpts and links. The allegations are also wanting because Jenzabar assumes that it was Long Bow that chose the heading and wording in the search result, but has submitted no **evidence** to show that Long Bow made up the search listing. Even Jenzabar’s

hired expert does not support this claim. In fact, it is the search engine itself that selects the text to be displayed in a search result, although in this case it appears to have copied verbatim the first 25 words on the web page (which constitute an accurate topic sentence for the rest of the page). Moreover, although the amended complaint (and the opposition to summary judgment) complain that the word “Jenzabar” appears in bold print, again Jenzabar presents no evidence that Long Bow chose the bold lettering, and in fact the undisputed evidence shows that Google searches consistently display the search term itself in bold print. For example, if someone uses the search string “information on these pages about Chai Ling” on Google, any of those words in the search listings would appear in bold print. *See* Exhibit 62, attached. This particular allegation simply reflects Jenzabar’s ignorance about how Google operates; it does not show trademark infringement.

**C. Jenzabar’s Proposed New Claims Are Equally Subject to Dismissal Because the Doctrine of Initial Interest Confusion Cannot Be Applied Here as a Matter of Law.**

In support of summary judgment, Long Bow argued that Jenzabar’s claims appeared to rest on a claim of initial interest confusion; that the doctrine of initial interest confusion is unconstitutional as applied to non-commercial speech; and that, in any event, the undisputed facts bar the application of that doctrine to this case. SJ Mem 16-21. Jenzabar’s opposition brief does not contend that there is any evidence supporting a likelihood of confusion about whether Long Bow’s Jenzabar-related pages are themselves sponsored by Jenzabar; indeed, Jenzabar apparently concedes that an Internet user who reaches the MJP will not be confused about source. SJ Opp. 21. Moreover, as in cases such as *Lamparello v. Falwell*, 420 F.3d 309, 317 (4th Cir. 2005), the Court can determine the non-confusing nature of a gripe site simply by looking at the page. Consequently, Jenzabar’s trademark claims depend entirely on its initial interest confusion argument.

But nothing in the proposed amended complaint cures the fundamental flaw in Jenzabar’s

initial interest confusion claim, even if this Court chooses to adopt that doctrine. Jenzabar has no answer to the First Circuit's ruling which, while declining to adopt initial interest as valid trademark doctrine, squarely ruled, in agreement with every other appellate court that has addressed initial interest confusion, that initial interest confusion applies **only** if plaintiff and defendant compete for sales of similar goods to the same customers. SJ Mem. 17. Jenzabar has no evidence that such competition exists here; even its proposed amended complaint does not plead such competition.

Instead, Jenzabar (SJ Opp. 20) cites a decision by Judge Keeton, *Niton Corp. v. Radiation Monitoring Devices*, 27 F. Supp. 2d 102 (D. Mass. 1998), finding infringement based on use of meta tags. Jenzabar cites language stating that the companies are "not in direct competition," but the opinion actually reveals that both companies made "x-ray fluorescence instruments" that detected lead in paint, sometimes using the same technology, and that each was "aiming to sell to the same potential entities." *Id.* at 103. Apart from the fact that Judge Keeton did not articulate the doctrine of initial interest confusion as the basis for his decision, the First Circuit's decision in *Hasbro, Inc. v. Clue Computing*, 232 F.3d 1, 2 (1st Cir. 2000) came two years later and controls on the limits of initial interest confusion **if** that is a valid doctrine. *See also Astra Pharm. Prods. v. Beckman Instruments*, 718 F.2d 1201, 1207 (1st Cir. 1983) ("temporary confusion" is not sufficient to support a trademark claim). And each of the other decisions cited by Jenzabar in its arguments about initial interest confusion involved directly competing companies. Because the undisputed evidence in this case is that Long Bow has "no business interest that overlaps with us," Maginn Dep. 62, Jenzabar cannot invoke the doctrine of initial interest confusion here, and the proposed amended complaint is futile for this reason as well.

**D. The Proposed Claims Are Still Susceptible to the Fair Use Defense.**

Long Bow argued in its summary judgment motion that Long Bow's inclusion of Jenzabar's

name in the keyword meta tags was protected as nominative fair use, a doctrine that courts in several different circuits have adopted and applied to meta tags; in 2006, Congress expressly incorporated this defense into the Lanham Act. SJ Mem. 23-25, 31. The defense is equally applicable to Jenzabar's claims based on title tags. Jenzabar argues that the nominative fair use defense cannot be invoked here because Long Bow "is not using Jenzabar's mark to describe the products it is offering; Long Bow's films do not refer to Jenzabar at all." SJ Opp. 23. This argument is a nonsequitur. Long Bow has not used the Jenzabar mark in the keyword meta tags or title tag for any of the pages of the tsquare.tv web site that are about the film "The Gate of Heavenly Peace." The mark is only used to describe pages that are about Jenzabar. That is precisely the reason why, for example, nominative fair use protected Terry Welles's use of "Playboy" in the meta tags for web pages that recounted her career as a Playmate of the Year, protected Craig Gross' use of Bihari's name in the meta tags for his gripe site about Bihari Interiors, and protected Steven Kassel's use of JK Harris' name in the meta tags for the one page of his business site where he attacked JK Harris, a competitor. *Playboy Enters. v. Welles*, 279 F.3d 796, 803-804 (9th Cir. 2002); *J.K. Harris & Co. v. Kassel*, 253 F.Supp. 2d 1120, 1125-1128 (N.D. Cal. 2003); *Bihari v. Gross*, 119 F. Supp. 2d 309, 321-324 (S.D.N.Y. 2000). Nominative fair use makes Jenzabar's proposed new claims futile.

**E. The Proposed Claims Are More Untimely Than the Original Claims.**

Long Bow argued in support of summary judgment that Jenzabar's claims were untimely because Long Bow used the Jenzabar name in the meta tags since at least 2001, when the tsquare.tv web site was created, and even earlier when the MJP was part of a different web site, and because Google has not taken keyword meta tags into account in computing search rankings "for many years." SJ Mem. 23. As the Third Chang Affidavit shows, the title tag of that page has similarly

always been “Jenzabar,” and so the added allegations in the amended complaint are futile because they are equally subject to dismissal under the statute of limitations. Because Jenzabar’s claim based on the title tags was not served until November 2009, 2-1/2 years later than the original complaint, they are even more severely untimely.

Jenzabar responds to the limitations argument by misciting the Chang affidavit as stating that “Jenzabar only became aware of the existence of Long Bow’s web site in August 2006.” SJ Opp. 22 n.11. Chang’s Affidavit says no such thing — she said that **she** first learned of the MJP’s search ranking when a Jenzabar representative called her in August 2006. First Chang Aff. ¶ 26. There is no evidence that Jenzabar was unaware of the web site from the very first date that it appeared in the Google search results. Indeed, if Jenzabar’s theory of this case (that keyword meta tags and title tags are what put the MJP in the first ten Google search results) were correct, then that page must have been one of the top Google search results since the outset inasmuch as both tags have been in the MJP since it was first created. Regardless of when Jenzabar actually learned of the MJP, it plainly should have known of a page that would have been near the top of the Google search results and hence Jenzabar cannot take advantage of the discovery rule to defeat the statute of limitations. In any event, Jenzabar’s failure to put in any evidence of its own showing the date when it learned about the page speaks volumes about the truth on this point. Moreover, *Christoff v. Nestle, Inc.*, 47 Cal.4th 468, 482-483, 213 P.3d 132, 141 (2009), squarely rejects the application of the discovery rule to limit enforcement of the single publication rule.

Jenzabar also argues, SJ Opp. 22 n.11, that changes in the text of the MJP constitute “republication” that restarts the running of the statute of limitations, citing *Christoff v. Nestle, Inc.*, *supra*. *Christoff* does not so hold. The issue there was whether the inclusion of the same allegedly infringing likeness in a series of different forms — transit ads, coupons in newspapers, magazine

advertisements, and Internet advertisements — constituted a “single integrated publication” with the original appearance of the likeness in a product label. Far from holding that each of the later uses re-started the running of the limitations period, it remanded the case for determination of that issue. Moreover, as the affidavit of Jenzabar’s own expert witness explains, the tags for a web page appear in the “header” section of a web page, while the text of the page appears in the body. Farance Aff. ¶¶ 12-15 and n.2. It is undisputed that the header portion containing keyword meta tags and the title tag was never changed; the alterations were only to the body. Hence there were not different publications of the allegedly tortious matter, and the amended complaint fails as untimely for the same reason as the original complaint.

**F. Jenzabar’s New Allegations Do Not Help It Survive Summary Judgment Under the “Likelihood of Confusion” Factors.**

Long Bow’s summary judgment motion argued that it prevails on the “likelihood of confusion” factors as they apply in a case where the mark has been used to denote a subject for parody or criticism. SJ Mem. 13-16. The proposed amended complaint has new allegations intended to address some of the factors, but Jenzabar has no evidence to support those contentions; hence the motion for leave to amend is futile in this respect as well.

For example, Jenzabar tries to argue that the parties have similar goods and overlapping classes of purchasers because it is considering expanding its product line beyond software to developing content for academic customers, and because sometimes professors “are responsible for purchasing decisions for . . . academic software.” SJ Opp. 16, 17, citing Maginn Affidavit. But as shown in Long Bow’s Response to Jenzabar’s Additional Facts and Reply to Jenzabar’s Response to the Undisputed Facts (“Long Bow Facts Response”), ¶¶ 4, 25, 46, nothing in Maginn’s affidavit shows that Jenzabar is even **considering** making films. Moreover, Jenzabar conceded in its Rule 30(b)(6) deposition that Long Bow has “no business interest that overlaps with [Jenzabar].” Maginn

Dep. 67 (Exh. 12) may not contradict by affidavit its sworn concessions in discovery. *Ng Bros. Constr. v. Cranney*, 436 Mass. 638, 648 (2002) (“A party cannot create a material issue of fact to defeat summary judgment simply by submitting affidavits that contradict previously sworn statements.”). Similarly, Maginn’s Affidavit does not show on personal knowledge either that any professor who buys films was ever involved in deciding whether to buy Jenzabar software, or even that professors ever do anything but give input to actual IT decision-makers. Long Bow Facts Response ¶ 47. And in any event, Jenzabar does not deny that its customers are sophisticated buyers who take a great deal of care in their decisions, a factor that weighs heavily against likelihood of confusion. *Astra Pharm. Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206 (1st Cir. 1983). Finally, Jenzabar’s complaint that Long Bow’s appeal for support against this trademark litigation is directed, in part, to the academic community, SJ Opp. 14, is a red herring — the appeal does not violate Jenzabar’s trademark rights.

The proposed amended complaint is also larded with allegations that Internet users at colleges and universities who are looking for Jenzabar’s own web site are being “diverted” to Long Bow’s web site by the appearance of the MJP near the top of the search results, ¶¶ 55, 64, 65, but no **evidence** shows this. Thus, Jenzabar cannot invoke these allegations to oppose summary judgment on the theory that searchers experience initial interest confusion when they see and click on the search result for the MJP; Jenzabar equates this result with “actual confusion.” SJ Opp. 18. Jenzabar’s only evidence is that a certain number of individuals using computers at colleges and universities visited the JRP, and that a certain number of persons using search engines reached the JRP when they used a search engine to look for web pages that were somehow relevant to the term “Jenzabar.” Jenzabar has presented no evidence showing what those searchers were looking for, and as Professor Goldman has persuasively explained, search engine users can have any of a variety

of different reasons for using a trademarked name as a search term. Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L. J. 507, 521-526 (2005). Instead of using a consumer survey or direct evidence to support its contention that those who use “Jenzabar” as a search term were looking for Jenzabar’s official site and only its official site, Jenzabar relies on its own speculation. But speculation does not defeat summary judgment.

Moreover, Jenzabar admits that colleges and universities engage in “due diligence” about their contractors. Undisputed Facts ¶¶ 27, 41. Due diligence means looking for criticism as well as praise to allow balanced evaluation — when such searchers find criticisms on the MJP, they find exactly what they are seeking. In addition, because the MJP appears in search results **after** two listings for Jenzabar’s own site, those who click on the MJP search result have either visited the sites listed in the first two listings but decided they wanted more information, or decided as a preliminary matter that the MJP might be more promising for their purposes. Jenzabar has submitted no evidence about whether computers that visited the MJP also visited one of Jenzabar’s own sites, although such information could certainly be derived from Jenzabar’s own server logs. Wholly apart from whether initial interest confusion is a viable doctrine on the facts of this case, *supra* 13-14, Jenzabar’s evidence does not support any claim of actual confusion.

**G. The Proposed New Allegations Do Not Avoid Summary Judgment on Chapter 93A.**

The proposed amended complaint is littered with vague references to “a variety of search engine optimization techniques and deceptive practices,” ¶¶ 2, 7, 46, 52, 53, 55; contrary to its original complaint, where the chapter 93A claim piggybacked on trademark claims, Jenzabar now argues that chapter 93A reaches a variety of deceptive practices, and pleads for the right to go to trial on vague claims of still unspecified deceptive practices. SJ Opp. 27-31. However, the only allegedly deceptive practice on which Jenzabar presents **evidence** is its trademark claims, and Long



Bow's papers have conclusively shown that, on the undisputed facts, Jenzabar's claims fail under trademark law and contravene the First Amendment. To the extent that the "deceptive practices" in the proposed amended complaint allege falsehoods that harm Jenzabar's reputation, the claims fail because Jenzabar has neither pleaded nor proved the constitutionally required elements of a defamation claim. *See Hustler Magazine v. Falwell*, 485 U.S. 46 (1988). The proposed amendments are futile with respect to chapter 93A, and hence do not block summary judgment. Leave should not be granted to amend that claim.

### CONCLUSION

The motion for leave to amend should be denied.

Respectfully submitted,

LONG BOW GROUP, INC.  
By its attorneys,

Paul Alan Levy (pro hac vice)<sup>1</sup>  
plevy@citizen.org  
Michael Kirkpatrick (pro hac vice)  
mkirkpatrick@citizen.org  
Public Citizen Litigation Group  
1600 20th Street, N.W.  
Washington, DC 20009  
(202) 588-1000

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

Dated: December 4, 2009

---

<sup>1</sup>Counsel gratefully acknowledge the assistance of Harvard Law School Cyberlaw Clinic student Rachel Funk in the preparation of this memorandum.