

NOTIFY

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COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPERIOR COURT DEPARTMENT OF THE TRIAL COURT

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

Plaintiffs,

v.

LONG BOW GROUP, INC.,

Defendant.

CIVIL ACTION NO. 07-2075-H

10/7/10 Argued in open ct file

12/29/10 Allowed See my written decision issued this date

DEFENDANT LONG BOW GROUP, INC.'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Mass. R. Civ. P. 56 and Superior Court Rule 9A(b)(5), defendant Long Bow Group, Inc. ("Long Bow") moves for summary judgment in its favor dismissing all claims asserted by plaintiff Jenzabar, Inc. ("Jenzabar").¹ In support of this motion, Long Bow submits the attached supporting memorandum, statement of material facts that Jenzabar cannot dispute, and affidavits and exhibits.

Accordingly, Long Bow respectfully requests that the Court enter summary judgment in its favor on all claims remaining in this case.

Justice

Notice sent 12.07.10 ABZ msk TCD PAC DMTK OLTG LJP LRK ESCM LLC (mdj)

¹ This Court previously dismissed all defamation claims asserted by the plaintiffs, including those asserted by plaintiffs Ling Chai and Robert Maginn. As a result, Ling Chai and Robert Maginn no longer are plaintiffs in this case.

NOTIFY

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*notice sent
12.07.10*

**SUPERIOR COURT
CIVIL ACTION
SUCV2007-02075**

**JENZABAR, INC., et al., LING CHAI,
ROBERT MAGINN
Plaintiffs,**

ABZ

MNK

TCD

PIAL

v.

DmTK

DC+Glyp

**LONG BOW GROUP, INC.
Defendant.**

LRK

ESC+m.LLc

(mdj)

**MEMORANDUM OF DECISION AND ORDER ON DEFENDANT'S MOTION FOR
SUMMARY JUDGMENT**

INTRODUCTION

This action arises from a dispute between the plaintiffs and defendant over content on the defendant's, Long Bow Group, Inc's ("Long Bow"), web site. The plaintiffs, Jenzabar Inc. ("Jenzabar"), Ling Chai ("Chai"), and Robert Maginn, filed this action claiming business defamation, defamation, false designation of origin under 15 U.S.C. §§1114 and 1125 (a), Federal trademark dilution, common law trademark infringement, trademark infringement under Massachusetts law, trademark dilution under Massachusetts law, and violations of G.L. c. 93A. On August 5, 2008 Long Bow moved to dismiss all of these counts pursuant to Mass. R. Civ. P. 12(b)(6). On August 5, 2008 Long Bow's Motion to Dismiss was allowed as to Counts I and II (business defamation and defamation) and denied as to Counts III, IV, V, VI, VII, VIII (trademark and c. 93A). Although this Court (Holtz, J.) declined to dismiss the remaining six

trademark claims, the judge did note the likelihood that Jenzabar's remaining claims would fail. (Memorandum of Decision and Order on Defendant's Motion to Dismiss, p. 7, August 5, 2008).

Long Bow now moves for Summary Judgment pursuant to Mass. R. Civ. P. 56 on all remaining claims of Jenzabar asserting that there are no genuine issues of material fact and that they are entitled to judgment as a matter of law. For the reasons stated below, Long Bow's Motion for Summary Judgment is ALLOWED.

BACKGROUND

Chai was a student leader during the 1989 protests in Tiananmen Square in China. She subsequently came to the United States and founded Jenzabar, a software company focusing on the needs of educational institutions. Jenzabar and Jenzabar.com are federally registered marks. Jenzabar markets its products on the websites Jenzabar.com and Jenzabar.net, both of which are owned by Jenzabar.

Long Bow is a documentary film production company. In 1995, it produced The Gates of Heavenly Peace (the "Film"), a documentary film about the Tiananmen Square protests. Chai figured prominently in the film, which she claims was critical of her and the protests. Long Bow's web site at <http://www.tsquare.tv/film/jenzabar.html> (the "Site"), provides information about the film and the protests, including articles and background information concerning participants in the protests, including Chai. Long Bow uses the Jenzabar marks as "metatags" within its web site.¹ Long Bow's Site comes up on a list of hits when someone uses a search

¹ A helpful description of meta tags comes from *North Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1216 n.2 (11th Cir. 2008): "Meta tags consist of words and phrases that are intended to describe the contents of a website. These descriptions are embedded within the website's computer code. Although websites do not display their meta tags to visitors, Internet search engines utilize meta tags in various ways. First, when a computer user enters particular terms into an Internet search engine, the *engine* may rank a webpage that contains the search terms within its meta tags higher in the list of relevant results. Second, when a particular web page is listed as a relevant search result, the search engine may use the meta tags to provide the searcher a brief description of the webpage." However, "modern search engines make little if any use of meta tags," instead relying on algorithms. Standard

engine to search for information about Jenzabar.² Jenzabar claims that prospective clients are diverted to a portion of Long Bow's website which discusses Jenzabar. Furthermore, Jenzabar claims that Long Bow has intentionally created this diversion which leads prospective clients to false content containing false impressions about Jenzabar, Chai, and Maginn. (Compl. p. 1, May 14, 2007). Jenzabar also claims that Long Bow makes unauthorized use of Jenzabar's protected trademarks to direct traffic to the Site. As a result of Long Bow's diversion, Jenzabar claims that this has caused reputational injury and loss of business opportunities. (Compl. p. 2).

STANDARD OF REVIEW

Summary judgment is appropriate when "there is no genuine issue as to any material facts and that the moving party is entitled to a judgment as a matter of law." Fed R. Civ. P. 56. See also, Black v. Henry Pratt Company, 778 F.2d 1278, 1281 (7th Cir. 1985); Peterson v. Time, Inc., 404 Mass. 14, 16-17 (1989); Mass R. Civ. P. 56(e). The party moving for summary judgment has the burden of proving an absence of disputed facts. Celotex Corporation v. Catrett, 477 U.S. 317, 323 (1986). Once the moving party has sufficiently met their burden, the nonmoving party must then produce evidence that is not based solely on allegations to show that there is a genuine issue of material facts. Howland v. Kilquist, 833 F.2d 639, 642 (7th Cir. 1987). But also, U.S. v. Diebold, Inc., 369 U.S. 654, 655 (1962) (when reviewing evidence, the inferences drawn are required to be read in a light most favorable to the nonmoving party); Kourouvacilis v. Gen. Motors Corp, 410 Mass. 706, 716 (1991).

Despite the advantage of the nonmoving party, the Supreme Court has stated that "the mere existence of a scintilla of evidence in support of plaintiff's position will be insufficient;

Process, Inc. v. Banks, 2008 WL 1805374 *4 (E.D. Wis. Apr. 18, 2008), quoting 4 J. Thomas McCarthy on Trademarks and Unfair Competition § 25:69 (4th ed. 2003).

² As of November 15, 2010, typing "Jenzabar" into Google returns Long Bow's Site as the third "hit." The first two "hits" are Jenzabar.com and Jenzabar.com/aboutus.aspx?id=80. The rest of the hits that come up are all directly endorsed or sponsored by Jenzabar.

there must be evidence upon which the jury could reasonably find for the plaintiff.” Anderson v. Liberty Lobby, Incorporated, 477 U.S. 242, 247 (1986). See also, Polaroid Corp. v. Rollins Environmental Services, 416 Mass. 684, 696 (1993) (“Bare assertions or conclusions regarding an individual’s understandings and assumptions are insufficient to withstand a well-pleaded motion for summary judgment.”).

DISCUSSION

I. Trademark Claims (Counts III, IV, V, VI, VII)

- i. (Count III) False Designation of Origin – 15 U.S.C. §§ 1114 and 1125 (a)**
- ii. (Count IV) Federal Trademark Dilution**
- iii. (Count V) Common Law Trademark Infringement**
- iv. (Count VI) Trademark Infringement Under State Law**
- v. (Count VII) Trademark Dilution Under State Law**

To succeed a plaintiff in a trademark case must show that (1) he owns a mark; (2) the defendant is using the same or similar mark; and (3) the defendant’s use is likely to confuse the public, thereby harming the plaintiff. Star Financial Services, Inc., v. AASTAR Mortg. Corp., 89 F.3d 5, 9 (1st Cir. 1996). Long Bow alleges that Jenzabar fails to establish any factual dispute as to whether Long Bow’s use of “Jenzabar” in its mark has caused a likelihood of confusion for web searchers as to the source or sponsorship of their Site.

Likelihood of confusion is an essential element of trademark infringement, whether it arises under federal or state law. Star Financial Services, Inc at 10. In Star the First Circuit requires evidence of a ‘substantial’ likelihood of a confusion and typically refers to eight factors in making the assessment; (1) similarity of the marks, (2) similarity of the goods, (3) relationship between the parties’ channels of trade, (4) relationship between the parties advertising, (5) the classes of prospective purchasers, (6) evidence of actual confusion, (7) defendant’s intent in adopting its mark, and (8) strength of the plaintiff’s mark. Id.

In the context of the web the three most important factors for determining likelihood of confusion in a trademark infringement case are the similarity of marks; the relatedness of the goods or services; and the simultaneous use of the web as a marketing channel. GoTo.com, Inc., v. The Walt Disney Company, 202 F.3d at 1205 (9th Cir. 2000).

A. Similarity of the Marks

The first controlling factor, the similarity of the marks, is always a critical question in the likelihood of confusion analysis in a trademark infringement case. The greater the similarity between the two marks at issue, the greater the likelihood of confusion. Id. at 1205. Certain factors guide the determination of the similarity of the marks in a trademark infringement case; (1) the marks must be considered in their entirety and as they appear in the marketplace, (2) similarity is adjudged in terms of appearance, sound, and meaning, and (3) similarities are weighed more heavily than differences. Id. at 1201.

On a trademark infringement claim the relevant consumer is the reasonably prudent consumer accustomed to shopping online and the relevant marketplace is the online marketplace. Toyota Motor Sales U.S.A. Inc., v. Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010). Despite the common use of the word “Jenzabar” in each party’s mark, the total effect of the two marks does not create a likelihood of confusion. Courts have continuously held that, “the use of identical dominant words does not automatically equate to similarity between marks.” See Frosty Treats Inc. v. Sony Computer Ent. Am. Inc., 426 F.3d 1001, 1003 (8th Cir. 2005). It is undisputed that Long Bow uses the mark Jenzabar to describe the content that is found within Long Bow’s Site regarding Jenzabar. Long Bow does not claim to be sponsored or endorsed by Jenzabar, and this is made clear to web users who get to Long Bow’s Site by a disclaimer at the top of the page. Therefore, the total effect of the Jenzabar mark as used in Long Bow’s Site does not as a matter

of law create a likelihood of confusion. Thus, for the reasonable online consumer there is no risk of confusion because of the disclaimer in Long Bow's Site.

B. Similarity of Goods or Services

The second controlling factor is that "[r]elated goods are generally more likely than unrelated goods to confuse the public as to the producers of the goods." Brookfield Communications, Inc., v. West Coast Entertainment Corp., 174 F.3d 1036, 1054 (9th Cir.1999). Here, there is no similarity of goods or services. Jenzabar develops software; Long Bow makes documentary films. A prospective Jenzabar customer might be distracted by Jenzabar's mark appearing on Long Bow's Site, but they would not be confused. Users who arrive at Long Bow's Site, via a search for a Jenzabar related site, would immediately see a disclaimer at the top of the page which states that they are not affiliated with Jenzabar or any of its products. Therefore, this Court finds as a matter of law that there is no similarity of goods or services between Jenzabar and Long Bow.

C. Relationship Between the Parties' Channels of Trade and Relationship Between the Parties' Advertising

Jenzabar alleges that in this case the goods of both parties travel in overlapping channels of trade to reach respective purchasers. However, the evidence in the summary judgment record indicates that Jenzabar sells its products through their Internet and sales teams to educational institutions. (Plaintiffs' Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 16, Feb. 5, 2010). Long Bow sells its films through documentary film distributors, which in turn sell the films to museums, schools and libraries. (Defendant Long Bow Group, Inc.'s Memorandum in Support of its Motion for Summary Judgment, p. 14, Feb. 5, 2010). Thus both entities sell different products through different channels of trade and neither Jenzabar nor Long Bow exclusively use the web as their marketing channel. Long Bow and Jenzabar are not

direct competitors and it is an undisputed fact that Jenzabar does not sell or advertise through Long Bow's Site. Id. at 14.

Therefore, this Court finds that the summary judgment record contains no indication that a sufficient relationship exists between Jenzabar's and Long Bow's channels of trade and their types of advertising.

D. The Classes of Prospective Purchasers

Jenzabar alleges that the class of prospective purchasers between them and Long Bow overlaps. (Plaintiffs' Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 17, Feb. 5, 2010). Although the summary judgment record suggests that at times there may be some minimal overlap of prospective purchasers³, evidence of this factor alone is not enough for Jenzabar to overcome Long Bow's motion for summary judgment. Based on the summary judgment record I conclude that as a matter of law the prospective purchasers between Jenzabar and Long Bow do not sufficiently overlap.

E. Evidence of Actual Confusion

Another important inquiry at summary judgment in a trademark infringement action is whether the plaintiff has presented material evidence in support of a realistic likelihood of confusion. Hasbro Inc. v. Clue Computing Inc., 66 F. Supp 2d 117(D. Mass. 1999). Jenzabar has not presented any credible evidence at this summary judgment stage to suggest that that Long Bow has created confusion in the reasonably prudent web searcher's mind about the origin of their Site. See Hasbro, Inc., 66 F. Supp. 2d at 125. Further, mere knowledge of the existence of the plaintiff's mark does not mean that the defendant intended to benefit from or infringe upon plaintiff's mark. See Id. "When a domain name consists only of the trademark followed by

³ The evidence in the discovery indicates that at times different purchasers within the same academic institutions make the purchasing decisions for both Jenzabar's academic software and Long Bow's documentaries. Therefore it is possible that at times that the prospective purchasers overlap.

.com or some other suffix like .org or .net, that will typically suggest sponsorship or endorsement by the trademark holder.” In this case the Site at issue does not contain a suffix like .com, .org, .net, but instead just contains the mark Jenzabar in its title

<http://www.tsquare.tv/film/jenzabar.html>.

At this summary judgment stage, Jenzabar has failed to demonstrate with proposed evidence a likelihood that web searchers do or will confuse Long Bow’s Site with being sponsored by or affiliated with Jenzabar.

F. Defendant’s Intent in Adopting its Mark

In a trademark infringement suit the factor of intent is of “minimal importance, as no intent to copy or appropriate is necessary to demonstrate a likelihood of confusion” GoTo.com, Inc., F.3d at 1208. Even if this Court could conclude that Jenzabar has advanced some evidence that Long Bow had an intent to copy or appropriate Jenzabar’s mark (which Jenzabar has not done), it would prove nothing since proof of intent is not required for my evaluation of the key element of a likelihood of confusion. Id. Therefore, I need inquire no further into Long Bow’s intent.

G. Strength of the Plaintiff’s Mark

“The more likely a mark is to be remembered and associated in the public mind with the mark’s owner, the greater protection the mark is accorded by trademark laws.” Kenner Parker Toys Inc., v. Rose Art Indus., Inc., 963 F.2d 350, 353 (Fed.Cir.1992). The strength of the mark must be evaluated in its entirety; it is not enough to just consider individual elements of that mark. California Cooler Inc. v. Loretto Winery. Ltd., 774 F.2d 1451, 1455 (9th Cir.1985).

In this case the plaintiffs claim that Jenzabar is a strong and distinctive mark created solely to identify the company and that it has been in use for more than a decade. (Plaintiffs’

Memorandum in Opposition to Defendant's Motion for Summary Judgment, p. 2, February 5, 2010). Although the Jenzabar mark is registered with the U.S. Patent and Trademark Office that alone does not prove the strength of the Jenzabar mark. Furthermore, the plaintiffs assert that the Jenzabar mark is recognizable particularly in the educational community. *Id.* at 3. Since the educational community is but a subset of the overall public, this Court concludes that while the plaintiffs have some evidence of the strength of their mark they cannot prove as a matter of law that it is a sufficiently prevailing factor to defeat summary judgment.

H. Trademark Dilution Under State Law

Jenzabar claims that Long Bow's unauthorized use of the plaintiff's mark would lessen and/or create a likelihood of dilution of the distinctive quality of the Jenzabar mark in violation of Massachusetts General Law 110B. Dilution claims require extensive analysis of their own and "are not intended to serve as mere fallback protection for trademark owners unable to prove trademark infringement." *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 48 (1st Cir. 1998).

This Court finds that Jenzabar is relying on this claim solely because of its difficulty in advancing the necessary evidence to defeat summary judgment on their trademark infringement claim. This conclusion is supported by the fact that Jenzabar dropped their trademark dilution under federal law claim before the summary judgment hearing on October 7, 2010. Therefore, this Court finds that Jenzabar has offered insufficient evidence at this summary judgment stage showing that their Jenzabar mark has been diluted by Long Bow's use of the mark to lead to subject matter on their Site.

Since the plaintiffs and Jenzabar have failed to present any genuine issues of material facts on the critical issues for federal and state trademark infringement, the defendant, Long Bow, is entitled to summary judgment as a matter of law.

II. Nominative Fair Use Defense

Long Bow claims that their use of the mark Jenzabar in meta tags to refer to Jenzabar and to describe and index the contents of their web page about Jenzabar is protected as nominative fair use. Because Long Bow's Motion for Summary Judgment has been successful as described in Section I of this opinion, this discussion of nominative fair use only further confirms the merits of the defendant's motion for summary judgment.

In cases such as this where a nominative fair use defense is raised, courts must determine whether (1) the product was readily identifiable without use of the mark; (2) defendant used more of the mark than necessary and; (3) defendant falsely suggested that it was sponsored or endorsed by the trademark holder. KEMA Inc., v. Koperwhats, 2010 U.S. Dist. LEXIS 90803. This test is "designed to address the risk that nominative use of the mark will inspire a mistaken belief on the part of consumers that the speaker is sponsored or endorsed by the trademark holder." *Id.* (noting eight-factor test for likelihood of confusion, articulated in AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979), does not apply "where a defendant uses the mark to refer to the trademarked good itself"; New Kids on the Block v. New Am. Publ'g., 971 F.2d 302, 307 (9th Cir. 1992); Playboy Enters. v. Welles, 279 F.3d 796, 804 (9th Cir. 2002).

A defendant seeking to assert nominative fair use as a defense need only show that it used the mark to refer to the trademarked good and then the burden shifts to the plaintiff asserting trademark infringement to show a likelihood of confusion. Toyota, 610 F.3d at 1182. As long as the site as a whole does not suggest sponsorship or endorsement by the trademark holder, momentary uncertainty by web searchers does not preclude a finding of nominative fair use. *Id.* at 1179.

In this case, Long Bow uses the Jenzabar mark to refer to the contents of its Site about Jenzabar. Long Bow is unable to discuss Jenzabar in their Site without using the actual name Jenzabar. There has been no evidence in the summary judgment record presented to this Court that Long Bow uses more of the Jenzabar mark than necessary. In fact the mark correctly portrays the content of the web page, the Site, as being about Jenzabar.

As previously discussed, Long Bow does have a disclaimer at the top of the Site that makes it clear to the reasonable web searcher that they are not affiliated with, sponsored by, or endorsed by Jenzabar in any way. This Court finds that Long Bow has not falsely suggested that it is sponsored or endorsed by the trademark holder, which in this case is Jenzabar.

When a domain name making nominative use of a mark does not actively suggest sponsorship or endorsement, it is true that some consumers may arrive at the site uncertain as to what they will find. “But in the age of Fios, cable modems, DSL lines, etc., reasonable and prudent Internet consumers are accustomed to such exploration by trial and error. They expect to find some sites that are not what they first imagined based on a glance at the domain name or search engine summary.” *Id.* at 1179. This Court finds that this initial uncertainty does not qualify as confusion and is an inevitable part of web searching.

For purposes of this motion for summary judgment, and strengthening Long Bow’s position that none of the plaintiffs’ claims can proceed as a matter of law, this Court finds that Long Bow’s use of Jenzabar in its metatags is protected under the nominative fair use doctrine because the plaintiffs have failed to show a likelihood of confusion as to sponsorship or endorsement. *Id.* at 1182. Furthermore, the nominative fair use doctrine permits Long Bow to use the mark to refer to Jenzabar and further use it to index and describe the contents of their Site about Jenzabar.

III. G.L. c. 93A Claim (Count VIII)

The theory of Jenzabar's c. 93A claim is essentially (1) that Long Bow manipulated search engine results in order to attract Jenzabar's prospective clients to Long Bow's Site where they would read misleading articles critical of Chai and Jenzabar and (2) that these prospective clients would subsequently not do business with Jenzabar. False and misleading statements can be actionable under c. 93A. But when the alleged existence of such statements is insufficient, and in fact irrelevant, to the overall required legal analysis for trademark claims, such allegations cannot support a cause of action under c. 93A. Dulgarian v. Stone, 420 Mass. 843, 853 (1995) (where allegedly defamatory statements do not support a cause of action for defamation, they also do not support a cause of action under c. 93A). There must be proof of an unfair or deceptive act by Long Bow in the context of the plaintiffs' trademark claims for Jenzabar's c. 93A claim to succeed. See G.L. c. 93A.

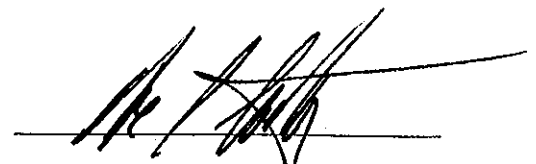
This Court finds that Long Bow's conduct does not violate c. 93A because Jenzabar has failed to allege any facts or evidence in the summary judgment record to support a trademark claim. Furthermore Long Bow enjoys the benefit as a matter of law of the Nominative Fair Use Doctrine. Thus plaintiffs cannot maintain their c. 93A claim.

ORDER

For the foregoing reasons it is hereby **ORDERED** that the Defendant's Motion for Summary Judgment is **ALLOWED**.

Date:

December 7, 2010



Honorable John C. Cratsley
Justice of the Superior Court

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