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THE NETWORK NETWORK  
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8 **UNITED STATES DISTRICT COURT**  
9 **CENTRAL DISTRICT OF CALIFORNIA**  
10

11 The Network Network, ) Case No. CV98-1349-NM (ANx)  
12 )  
13 Plaintiff, )  
14 vs. )  
15 CBS, Inc. and Does 1 to 10, )  
16 Defendants. )  
17 ) Date: August 16, 1999  
18 ) Time: 10:00 a.m.  
19 ) Place: Courtroom 11  
20 ) 312 North Spring Street  
21 )  
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29 Please take notice that on August 2, 1999 at 10:00 a.m. plaintiff and counterdefendant will  
30 move the Court for Summary Judgment or, in the alternative, for "Partial Summary Judgment" (i.e., for an  
31 order specifying the facts which appear without substantial controversy) including but not limited to an  
32 order determining with respect to each of the causes of action set forth in the counterclaim that such cause  
33 of action is not supported by the evidence, and dismissal of all claims for damages.  
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MEMORANDUM OF POINTS AND AUTHORITIES

I. PROCEDURAL BACKGROUND.

Plaintiff filed this action on February 5, 1998, seeking a declaration that the plaintiff's use of its common-law TNN mark did not infringe upon any rights of the defendant. The defendant answered and counterclaimed, asserting that the plaintiff's use of its TNN mark constitutes trademark infringement under the Lanham Act (15 U.S.C. §§ 1051-1125), unfair competition under the Lanham Act, a violation of the Federal anti-dilution act, unfair competition under California law, and a violation of California's anti-dilution statute.

II. UNDISPUTED FACTS.

The plaintiff, The Network Network (hereinafter ``NETWORK"), was formed as a sole proprietorship of Clive Hermann in 1986, and was incorporated in California on November 30, 1988. From 1986 to today, the sole business of NETWORK has been to provide consulting and training to IT managers and professionals<sup>1</sup> concerning the establishment and maintenance of computer networks. The plaintiff's clients are large corporations or governmental entities, including such entities as AT&T, Southwest Bell, Lucent, Nynex, LAX Airport Police, Telecom New Zealand, and the Hong Kong Hospital Authority. Plaintiff's consulting and training contracts range from \$10,000 to \$100,000 or more; and it does business for only a few clients in any year. For example, plaintiff did work for 19 clients in 1998. Declaration of Clive G. Hermann (hereinafter ``DCH") ¶¶ 2, 6, 9 and 11 and Exhibits 3, 6 & 7.<sup>2</sup>

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<sup>1</sup> ``IT" stands for ``Information Technology" and is the name by which professionals in industry and government who are responsible for the maintenance of computer networks of their employers are known. An ``IT manager" is a manager of her or his employer's IT department. An ``IT professional" is a professional employee in her or his employer's IT department, without regard to whether that person is a manager. DCH ¶ 9.

<sup>2</sup> All of the facts set forth in a particular paragraph are supported by the declaration paragraphs, exhibits and other references set forth at the end of the paragraph.

1           The Nashville Network<sup>3</sup> (hereinafter "NASHVILLE") is a niche "country music and  
2 country lifestyle cable television network." (Answer, ¶ 4). NASHVILLE first went on the air on March 7,  
3 1983. (Counterclaim, ¶ 6). NASHVILLE was acquired by the defendant<sup>4</sup> Network Enterprises, Inc.  
4 ("NEI") on October 1, 1997 (*Id.*). In response to an interrogatory request, NEI identified the goods and  
5 services which have been available from it and its predecessors in interest as i) the sale of programming  
6 to cable and satellite television providers; ii) the licensing of its TNN mark for use on network and  
7 program-related merchandise; iii) provision of production services to the television production  
8 community; and iv) the sale of a local fiber optic video transmission service called "Metronet," which  
9 allows others to use NEI's fiber optic video transmission satellite. Declaration of Thomas E. Shardlow  
10 (hereinafter "DTS") ¶ 3, Exhibit 1 (Inter. 12).

11           From the beginning, NETWORK has identified itself as "TNN." For example, on October  
12 14, 1986, Clive Hermann notified an associate in South Africa of the formation of NETWORK to do  
13 business in South Africa, and referred to it as "TNN." From that time to this date, NETWORK has utilized  
14 "TNN" as its common-law trademark. In September 1987, Clive Hermann began using NETWORK for  
15 all of his new consulting business. On November 9, 1987, Clive Hermann made a detailed Proposal to  
16 AT&T for work to be done in this country which referred to NETWORK as TNN. By no later than  
17 September 1989, NETWORK had developed a logo consisting of the letters TNN, with the letters slanted  
18 to the right and the top of the "T"<sup>5</sup> extending over all three letters, and used it as a backdrop during a  
19 course which Clive Hermann taught to AT&T's IT professionals. The logo has been consistently used at  
20 NETWORK's training lectures, on its written training manuals, and on NETWORK's website. No one at  
21 NETWORK was aware that NASHVILLE used "TNN" to identify itself at the time NETWORK was formed,  
22

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23       <sup>3</sup> The Nashville Network is a trade name, not the name of a corporation or other entity.

24       <sup>4</sup> The Answer was filed by "Defendant Network Enterprises, Inc. (NEI or defendant) erroneously  
25 sued herein as CBS, Inc." Answer, Introduction.

26       <sup>5</sup> To the best of the plaintiff's knowledge, NASHVILLE has never slanted the letters "TNN"  
27 nor extended the "T" across all three letters.  
28

1 at the time NETWORK was incorporated, at the time NETWORK developed and began using its "TNN"  
2 logo, or at any time prior to 1995. DCH, ¶¶ 3 to 5, 7 to 8, 10, Exhibits 1, 2, 4 and 5, Declaration of Guy  
3 R. Hermann (hereinafter "DGH") ¶ 3.

4 From 1983 on,<sup>6</sup> NASHVILLE has referred to itself from time to time as TNN. However,  
5 NASHVILLE's logo, at least through 1986, was comprised of the words "The Nashville Network" under-  
6 neath the end of a guitar. "TNN" was not used in any way in advertisements. In 1988, NASHVILLE  
7 started using a logo comprised of the letters "TNN" next to the end of a guitar. On January 20, 1987,  
8 NASHVILLE's then-owner obtained a federal trademark registration for the letters "TNN" "For:  
9 Television Program Production Services and Distribution of Television Programming to Cable Television  
10 Systems." On October 10, 1989, NASHVILLE's then-owner obtained a federal trademark registration of a  
11 logo consisting of the end of a guitar next to the letters "TNN," also for cable television programming.  
12 This registration claimed a first-use date of February 12, 1988. It appears clear, therefore, that  
13 NASHVILLE first used the letters "TNN" as part of its logo and in advertisements no earlier than February  
14 12, 1988.<sup>7</sup> DTS, ¶ 6, Exhibits 3 and 4; Exhibit A to the Counterclaim.

15 On January 7, 1994, NETWORK registered TNN.COM as the "domain name" for its  
16 website. A domain name is utilized both as a website address and for e-mail addresses. Immediately  
17 upon the registration of its domain name, NETWORK assigned e-mail addresses to its employees (e.g.  
18 "guy@tnn.com" for Guy Hermann), and began to publicize those addresses to clients and potential  
19 clients. Within several months of registration of its domain name, NETWORK opened a website at  
20 www.tnn.com,<sup>8</sup> which was also extensively publicized to its clients and potential clients. Although many  
21

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22 <sup>6</sup> At least, NEI has not produced any evidence of The Nashville Network use of TNN in any  
23 way prior to 1983.

24 <sup>7</sup> Plaintiff concedes, for purpose of this motion, that The Nashville Network's first use of its  
25 TNN mark in connection with its cable television network preceded The Network Network's first  
26 use of its TNN mark. The fact that The Nashville Network's first use of TNN as part of its logo  
(and therefore, the first use in its advertising) until at best February 12, 1988 is relevant to the  
defendant's contention that its TNN mark was famous when the plaintiff first began using its mark.

27 <sup>8</sup> E-mail addresses and website addresses are not case sensitive, and by convention are  
28

1 changes have been made to the website, there have been no material changes in the character of the  
2 website since it originally was created. It has always been devoted to providing information concerning  
3 NETWORK's computer network consulting business to IT professionals, and as a contact point between  
4 NETWORK and IT professionals. A printout of the pages on the website, at least two levels deep, is  
5 attached to Clive Hermann's declaration as Exhibit 8. No one at NETWORK was aware at the time that  
6 the TNN.COM domain was registered, or that at the time the website was created that NASHVILLE used  
7 ``TNN" to identify itself. DGH ¶ 3 to 7; DCH Exhibit 8.

8  
9 Sometime prior to April 19, 1995, the NASHVILLE decided to acquire names for future  
10 sites on the Internet, and determined that ``names or initials such as TNN, CMT, OMG, GET, WSM are  
11 already in use by other companies." The defendant's predecessor knew prior to April 19, 1995 that  
12 NETWORK had registered the domain name ``TNN.COM" before January 14, 1994, and had the street  
13 address, e-mail address, and telephone number of NETWORK. DTS Exhibit 5.

14 NASHVILLE did not object in any way to NETWORK's registration of the TNN.COM domain  
15 name, or the maintenance of a website at www.tnn.com. On October 2, 1995, counsel for NASHVILLE  
16 made written objection to a different company to the registration by that company of the TNNet.COM  
17 domain, but no similar letter was sent to NETWORK.<sup>9</sup> DTS, Exhibit 6. NASHVILLE, in its letter to  
18 TNNet.COM, claimed rights to the TNN mark only ``for various goods and services in the musical  
19 entertainment field." NASHVILLE objected to the registration of TNNet.COM because it was being used  
20 ``in association with musical entertainment." The fact that NASHVILLE did not object to the registration  
21 of TNN.COM before December 1997 can only be explained by the fact that NETWORK has absolutely  
22 nothing to do with musical entertainment, broadcasting services, country music, or any similar product.

23 On December 12, 1996, Warren Bone, the System's Project Manager of NASHVILLE's IT  
24 Department wrote Clive Hermann and told him that NASHVILLE was working to create its own site at  
25 (..continued)  
normally shown in lower case.

26 <sup>9</sup> In addition, no action was taken against TNNet until 1998. DTS, Exhibit 12. Note the  
27 1998 case number on the consent decree.  
28



1 ``www.country.com." Mr. Bone did not object to NETWORK's registration or use of its TNN.COM  
2 domain, and in fact indicated that NASHVILLE wanted to ``represent a lot of our attractions under the  
3 country.com umbrella, rather than have a separate site just for TNN." Mr. Bone emphasized that he was  
4 not writing the e-mail as a representative of NASHVILLE, but only as a fellow user of the Internet, but  
5 Clive Hermann had no reason then or now to believe that Mr. Bone was not telling the truth about  
6 NASHVILLE's intentions towards www.country.com, and lack of interest in establishing a website at  
7 www.tnn.com. DCH ¶ 13 to 14, Exhibit 11.

8 In fact, NASHVILLE did develop a website at www.country.com, which was an umbrella for  
9 a number of different country-related products provided by the website's sponsor. A copy of the ``home"  
10 page of the website, as well as the ``www.country.com/tnn" subdivision, is attached to the declaration of  
11 Clive Hermann as Exhibit 9.

12 On October 1, 1997, CBS, Inc. acquired NASHVILLE through NEI, its wholly owned  
13 subsidiary. On December 16, 1997, over eleven years after NETWORK began using TNN as its mark,  
14 over eight years after it began using TNN as its logo, and four years after it began using TNN.COM for its  
15 e-mail and website on the Internet, an attorney for CBS, Inc. sent a letter to NETWORK demanding that  
16 NETWORK cease using TNN in any way, and give its website to CBS. After several letters back and forth  
17 between counsel, plaintiff filed this declaratory relief lawsuit concerning its use of its TNN mark. DCH ¶  
18 15, Exhibit 11; DTS ¶ 7, Exhibit 7.

### 20 III. STANDARD FOR SUMMARY JUDGMENT.

21 Summary judgment is appropriate when there is no genuine issue of material fact and the  
22 moving party is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*,  
23 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

24 The moving party has the burden of demonstrating the lack of a genuine issue of material  
25 fact. However, as to issues which the non-moving party has the burden of proof at trial, the moving  
26 party may satisfy its burden by demonstrating the absence of evidence supporting the non-moving  
27 party.

1 party's claim. *Id.* at 323. Inasmuch as the plaintiff seeks only a declaration that its use of its TNN mark  
2 does not violate any of the rights of the defendant, and asks for no affirmative relief, the defendant has  
3 the burden of proof at trial on all issues.  
4

#### 5 IV. EFFECT OF REGISTRATION OF DEFENDANT'S MARK.

6 As noted above, in 1987 the defendant's predecessor registered TNN "For: Television  
7 Program Production Services and Distribution of Television Programming to Cable Television Systems."  
8 "Trademark law permits multiple parties to use the same mark for different classes of goods and services  
9 . . . ." *Panavision International v. Toeppen*, 945 F. Supp. 1296, 1302 (C.D. Ca 1996). "Unlike a patent or  
10 copyright, a trademark does not confer on its owner any rights . . . Only uses that infringe or dilute an  
11 owner's trademark or service mark are prohibited." *CD Solutions, Inc. v. Tooker*, 15 F. Supp. 2d 986, 988  
12 (D.C. Or. 1998). Registration under the Lanham Act does not create a right to a trademark. Trademarks  
13 may be acquired only by use in accordance with common-law principles. *Tillamook County Creamery*  
14 *Association v. Tillamook Cheese and Dairy Association*, 345 F.2d 158, 160 (9th Cir. 1965).

15 15 U.S.C. § 1115 provides that registration is conclusive evidence of the validity of the  
16 mark and of the exclusive right to use the mark. However 15 U.S.C. § 1115 also provides that "Such  
17 conclusive evidence shall relate to the exclusive right to use the mark in connection with the goods or  
18 services specified in the affidavit filed under the provisions of section 15 . . . ."<sup>10</sup> Moreover, "Such  
19 conclusive evidence of the right to use the registered mark shall be subject to proof of infringement . . . ."

20 In the Ninth Circuit "incontestability [is] a defensive provision only. It helps protect the registrant's  
21 mark from cancellation but is of no offensive use." *Prudential Insurance Company v. Gibraltar Financial*  
22 *Corporation*, 694 F.2d 1150, 1153 (9th Cir. 1982). Plaintiff does not contest the validity of defendant's  
23 mark or defendant's exclusive right to use the mark for cable television broadcasting. Defendant's  
24 registration of its mark is, accordingly, entirely irrelevant.

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26 <sup>10</sup> The statute goes on to state that the goods or services can be limited, but not expanded, by  
27 any renewal application.  
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V. FEDERAL TRADEMARK INFRINGEMENT.

In an action for trademark infringement, the key question is "whether the public is likely to be deceived or confused by the similarity of the marks." *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988). "Establishing seniority, however, is only half the battle. [NASHVILLE] must also show that the public is likely to be somehow confused about the source or sponsorship of [NETWORK's] tnn.com web site -- and somehow to associate that site with [NASHVILLE]." *Brookfield Communications, Inc. v. West Coast Entertainment*, \_\_\_ F.3d. \_\_\_, 1999; U.S. App. Lexis 7779, p. 40 (9th Cir. 1999).

The leading case on trademark infringement in the Ninth Circuit is *AMF Incorporated v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). Under *Sleekcraft*, a determination of "confusion" is a two-part process. First, a determination must be made as to whether the product in question is in competition with, related or unrelated to the complaining party's product:

"When the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are sufficiently similar that confusion can be expected. When the goods are related, but not competitive, several other factors are added to the calculus. If the goods are totally unrelated, there can be no infringement because confusion is unlikely." *Sleekcraft* at 348.

*Sleekcraft* went on to establish an eight-factor test for related goods. See *Sleekcraft* at 348 ("In determining whether confusion between related goods is likely, the following factors are relevant . . ." (Emphasis added). The *Sleekcraft* factors are not relevant if goods are unrelated. "The Sleekcraft factors apply to related goods." *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161, 1163 (C.D. Cal. 1998). In order for use of a mark to constitute infringement "such use must be in connection with goods or services that are competitive with, or at least related to, the goods or services for which the trademark has been registered or used in commerce." *Lockheed Martin Corporation v. Network Solutions, Inc.*, 985 F. Supp. 949, 963 (C.D. Cal. 1997) (emphasis added).

1           Related goods or services are those products or services which would reasonably be  
2 thought by the buying public to come from the same source if sold under the same mark. *Sleekcraft*,  
3 *supra at n. 10*. Examples of goods or services which the Courts have found to be unrelated are web page  
4 design and operation of a health club (*Bally, supra*). Goods and services which have been found to be  
5 related are i) shirts and pants, ii) beer and whiskey, and iii) locks and flashlights. *See Bally, supra*, and  
6 cases cited therein.

7           It is difficult to imagine services less related than computer network consulting services  
8 and country music cable programming. Accordingly, under *Sleekcraft*, the Court's task with respect to  
9 trademark infringement should be at an end. Unrelated goods or services cannot infringe. Nevertheless,  
10 since many of the *Sleekcraft* factors are relevant to defendant's dilution claim, they will be discussed in  
11 turn.

12           1.       Similarity of the Marks.

13           Under *Brookfield*, the Ninth Circuit considers that plaintiff has used two trademarks,  
14 ``TNN" and ``TNN.COM" (or tnn.com). *Supra at p. 46*. However, *Brookfield* held that marks such as  
15 TNN and TNN.COM (or tnn.com) are ``essentially identical" to each other. ``In terms of appearance,  
16 there are differences in capitalization and the addition of ``.com' . . . but these differences are  
17 inconsequential in light of the fact that Web addresses are not caps-sensitive and that the .com top-level  
18 domain signifies the sites's commercial nature." *Id.* Consequently, the marks used by the plaintiff, TNN,  
19 TNN.COM (or tnn.com), are ``essentially identical" to the TNN mark used by NASHVILLE. However,  
20 ``[e]ven where there is precise identity of a complainant's and an alleged infringer's mark, there may be  
21 no consumer confusion - - if the alleged infringer is . . . in a wholly different industry." *Brookfield supra*  
22 at p.44.

23           Any confusion which might otherwise exist due to the similarity of the marks is signi-  
24 ficantly lessened due to the fact the plaintiff uses TNN as a mark in association with its name, ``The  
25 Network Network." DCH ¶ 16. Once NASHVILLE began including ``TNN" in its advertising, its use of  
26 TNN was accompanied by ``The Nashville Network." DTS Exhibit 8.

1                   2.       Proximity of Services.

2                   The Ninth Circuit recently discussed the importance of this factor in connection with the  
3 concurrent use of identical marks:

4                   `If . . . Brookfield and West Coast did not compete to any extent whatsoever, the  
5 likelihood of confusion would probably be remote. A Web surfer who  
6 accessed `moviebuff.com' and reached a web site advertising the services of  
7 Schlumberger, LTD. (a large oil drilling company) would be unlikely to think  
8 that Brookfield had entered the oil drilling business or was sponsoring the oil  
9 driller. . . . At the least, Brookfield would bear the heavy burden of  
10 demonstrating (through other relevant factors) that consumers were likely to  
11 be confused as to source or affiliation in such a circumstance." *Brookfield*,  
12 *supra* at p.50 (emphasis added).

13                   A review of the website at www.tnn.com, and a comparison of it with the website at  
14 www.country.com, demonstrate that no reasonable consumer could believe that at www.tnn.com she or  
15 he had accessed a site which was operated by NASHVILLE or related in any way to country music or  
16 country living. The services provided by the plaintiff and the defendant are as unrelated as are a movie  
17 database and oil drilling. Accordingly, `at the least" the defendant bears a `heavy burden" in de-  
18 monstrating through the other factors that confusion is nonetheless likely.

19                   The defendant has essentially conceded that there is no possibility of confusion between its  
20 services and plaintiff's services under the standard Sleekcraft factors.<sup>11</sup> In its answers to Interrogatories,  
21 the defendant conceded that `NEI is not, and could not possibly be, aware of any person who has pur-  
22 chased computer network training or consulting from The Network Network under the belief that the  
23 training or consulting services were being obtained from NEI." In response to a question about the  
24 possibility of future confusion, NEI responded that any answer would require speculation. Finally, in its  
25

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26                   <sup>11</sup> The defendant appears to base its infringement case entirely on the concept of `initial  
27 interest confusion," a concept discussed *infra*.  
28

1 response to a Request to Produce, NEI stated that ``The only `confusion' relevant to the subject matter of  
2 this litigation is `confusion' over what entity operates particular Internet websites."

3 3. Strength of the Mark.

4 The strength of a trademark or tradename is largely determined by its position on a con-  
5 tinuum stretching from arbitrary marks to descriptive marks. *Accuride International, Inc v. Accuride*  
6 *Corporation*, 871 F.2d 1531, 1536 (9th Cir. 1989). A trademark which is comprised of the initials of  
7 the trademark holder's name is a descriptive mark in the Ninth Circuit. *Everest & Jennins, Inc. v. E & J.*  
8 *Manufacturing Company*, 263 F.2d 254, 259 (9th Cir. 1958); *CD Solutions, Inc., supra at 989.*  
9 Accordingly, the TNN mark is the weakest type of mark entitled to any trademark protection.

10 NASHVILLE's mark is further weakened by the substantial number of other companies  
11 which use TNN marks or marks which contain TNN, including many which use the letters TNN as their  
12 logos.<sup>12</sup> In addition to the plaintiff and defendant, there are literally hundreds of companies using TNN,  
13 many of which are on the web, including:

- 14 TNN (a Florida Company).
- 15 The National Network (which uses ``TNN" as a logo).
- 16 Television News Network (which uses a large ``TNN" with a much smaller ``television"  
below as a logo).
- 17 TNN Transplant News Network (which uses ``TNN" with a trademark symbol as part  
of its logo).
- 18 Tribulation News Network Online (which uses TNN Online as a logo).
- 19 Tax News Network (which uses TNN as its mark).
- 20 TNN Radio (which uses TNN as a logo).
- 21 TNN Networks (which uses a large TNN, with a smaller ``network" below, as a logo).
- 22 TNN Technology, Inc. (which uses TNN as a logo).
- 23 TNN Tableware.
- 24 TNN Auto Stereo.
- 25 TNN International Import Export Co.
- 26 TNN Super Discount Store.
- 27 TNN Auto Body.
- 28 TNN Sports Wholesalers.
- TNN Manufacturing Company.
- TNN Equity.
- TNNet Business Services.
- TNN Productions.
- TNN Technology.

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<sup>12</sup> Note that many of the examples in the body are of broadcast networks. TNN can stand for the very well-known Turner News Network.

1 TNN Video.  
2 TNN Services.

3 There are at least thirty different websites which use TNN as the domain name or as part of  
4 the domain name,<sup>13</sup> including:

5 TNN.COM  
6 TNN.NET  
7 TNN.BG  
8 TNN.DK  
9 TNN.SE  
10 TNN.PL  
11 TNNMFG.COM  
12 TNNTECHNOLOGY.COM  
13 TNNNS.NET  
14 TNN-TELEMARKETING.NL

15 There are also approximately fifty different Internet newsgroups which begin with ``tnn."  
16 DCH ¶ 17, Exhibits 12 to 16.

17 ``A strong trademark is one that is rarely used by parties other than the owner of the  
18 trademark, while a weak trademark is one that is often used by other parties." *Universal Money Centers,*  
19 *Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1533 (10th Cir. 1994). Sometimes extensive advertising  
20 can strengthen a weak mark. However, ``[NASHVILLE'S] advertising and sales are insufficient to convert  
21 [``TNN"] into a strong mark/name because of the parties' concurrent use of that term as a trademark."  
22 *Accuride, supra*, at 1536. To be a strong mark, the mark must be ``strongly and uniquely associated"  
23 with the claimant's business. *Id.* (Emphasis added). Further weakening the mark is the fact that  
24 NASHVILLE'S length of use of its mark is limited. At best, its mark has been used in some manner for  
25 only eighteen years, and has been advertised for only ten years.

26 A descriptive mark is not entitled to any protection under trademark law unless it has  
27 acquired a ``secondary meaning." *Carter-Wallace, Inc. v. Proctor & Gamble, Inc.*, 434 F.2d 794, 802

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28 <sup>13</sup> A few of these cites, but no more than five, may be associated with the defendant. That still  
leaves at least twenty-five sites not associated with the plaintiff which use tnn as part of their  
domain name.

1 (9th Cir. 1970). The principal inquiry is "does it denote a single thing coming from a single source." *Id.*  
2 There is no evidence that the defendant's TNN mark has acquired a secondary meaning.

3 On May 24, 1999, seven days before the discovery cut-off date, plaintiff's counsel received  
4 in the mail a so-called "final report"<sup>14</sup> of an alleged expert regarding name recognition of TNN in  
5 connection with cable television.<sup>15</sup> The expert's survey was limited not only to individuals who  
6 subscribed to cable television, but also limited to people who had NASHVILLE as part of their cable  
7 television lineup. DTS, Exhibit 9.

8 The survey asked two questions of potential relevance. The first question of import (which  
9 was repeated two times) was whether the individual could identify any cable networks which primarily  
10 show country music and country dancing programs. Combining the answers to the two times the  
11 question was asked, 2% of the respondents identified "The Nashville Network" and 35% of the  
12 respondents answered "TNN." Although 89% stated that they believed that they had heard of a cable  
13 television network called TNN, when asked "What type of programs are primarily shown on TNN," less  
14 than 36% responded with anything having to do with country music, country living or country  
15 programming. The fact that so many people who thought they had heard of TNN could not associate it  
16 with country music, country living or country programming can probably be explained by the large  
17 number of television stations which have call letters which begin with "T" including the very similar  
18 "TNT" (and the Turner News Network). DTS ¶ 8, Exhibit 10.

19 These figures demonstrate a low awareness of NASHVILLE and its TNN mark. Even among  
20 individual who have TNN on their televisions at home, only 35% or 36% of those surveyed associated  
21 TNN with country music, country living or country programming.

22 More important, the survey tells us nothing about secondary meaning. A mark has a  
23 secondary meaning only if it has come to denote to the consumer "a single thing coming from a single  
24

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25 <sup>14</sup> There was no interim or preliminary report. The final report was the only report ever re-  
26 ceived.

27 <sup>15</sup> Plaintiff intends to object to any attempt by the defendant to introduce the expert's report.  
28



1 source." When asked if they had heard of a record company called "Apple" (the record company  
2 founded by the Beatles), a large percentage of the population would probably answer yes. That,  
3 however, tells us nothing about whether consumers consider any product with an Apple mark on it to  
4 have come from the Apple record company. Again, most people have heard of the Cadillac ranch.  
5 However, even if 100% of consumers were familiar with a ranch called Cadillac, that tells us nothing as  
6 to whether consumers would assume that any product with "Cadillac" on it came from the company  
7 which ran the Cadillac ranch (and common sense tells us they they would not).

8 Finally, the defendant is incorrect to characterize viewers of its programs as its  
9 "customers." The defendant does not sell cable television programs to the public, but to cable system  
10 operators. Unlike a pay TV cable service (HBO, Cinemax, etc.), cable television viewers do not even  
11 indirectly purchase the defendant's cable television programming.

12 4. Evidence of Actual Confusion.

13 Defendant admits that "NEI is not, and could not possibly be, aware of any person who has  
14 purchased computer network training or consulting from NETWORK under the belief that the training  
15 or consulting services were being obtained from NEI."

16 In February 1999 alone, 1,132,232<sup>16</sup> people visited its country.com home page, and of  
17 those, 183,399 accessed the NASHVILLE section of country.com. The plaintiff's website, www.tnn.com, is  
18 being accessed approximately 37,750 times per month. DCH, ¶ 21. Since January 1994, the plaintiff  
19 has received eight e-mails, faxes or letters which refer or relate in any way to NASHVILLE, and the  
20 defendant has received only three e-mails, faxes or letters which refer or relate in any to NETWORK. If  
21 relied upon by the defendant, plaintiff will demonstrate that the most of these eleven pieces of  
22 correspondence do not reflect even a hint of actual confusion.

23 In *Accuride* the Ninth Circuit described multiple instances of alleged actual confusion,  
24 much more substantial than is even arguably present in this case. *Supra at 1537*. The Court upheld a

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25  
26 <sup>16</sup> Although these figures were provided by the defendant, website counters are not entirely  
27 reliable, and so these figures should not be considered exact. See DTS Exhibit 11.  
28

1 finding that the evidence was "anecdotal and too weak to support a finding of actual confusion." The  
2 Ninth Circuit relied upon and quoted a third circuit case which held that "evidence of nineteen  
3 misdirected letters over four years is insufficient to establish actual confusion." *Accuride* at 1537. Even  
4 assuming therefore that the ten e-mails and one fax described above all constitute "misdirected letters,"  
5 that is clearly insufficient to demonstrate actual confusion. Furthermore, unlike the evidence of actual  
6 confusion in *Accuride*, the claimed evidence of actual confusion in this case involved viewers of  
7 NASHVILLE, not the businesses which purchase the defendant's cable television programming.

8 In addition, "[i]n assessing the likelihood of confusion to the public, the standard used by  
9 the courts is the typical buyer exercising ordinary caution." *Sleekcraft* at 353. There is no evidence of  
10 whether the people who sent the ten e-mails and one fax were "typical buyers" or whether they were  
11 "exercising ordinary caution." Given the fact that the defendant's website is being accessed over a  
12 million times every month, and plaintiff's website is being accessed about 37,750 times per month, the  
13 number of alleged instances of actual confusion is extremely low. DCH ¶¶ 21 to 22.

14 5. Marketing Channels.

15 Plaintiff markets its goods exclusively to IT managers and IT professionals. Such marketing  
16 is done (directly or through distributors) by direct mailings using lists which are confined to IT managers  
17 and IT professionals, through distribution of its course books containing its website address to IT  
18 managers and IT professionals, and through advertisements in trade magazines, trade newspapers or  
19 newspaper supplements which are directed at IT professionals. Plaintiff maintains a website which is  
20 directed specifically at IT professionals. DCH ¶ 18.

21 On the other hand, the defendant admits that "All of NASHVILLE's advertising is directed  
22 at the public in general." DTS Exhibit 1 (Inter. 15). NASHVILLE admits its customers are i) cable and  
23 satellite television providers, ii) licensees who use the defendant's TNN mark to sell "network and  
24 program related merchandise, iii) the television production community, and iv) users of local fiber optic  
25 video transmission satellites. DTS Exhibit 1 (Inter. 12). Obviously, plaintiff's and defendant's marketing  
26 channels are as different as can be.

1                   6.       Types of Goods and Purchaser Care.

2                   Both parties sell expensive services to sophisticated purchasers. The plaintiff markets  
3 expensive consulting contracts in the tens if not hundreds of thousands of dollars. The services are con-  
4 tracted for by sophisticated employees in charge of information technology systems for large companies  
5 and governmental agencies.

6                   The care and sophistication exercised by the defendant's consumers or viewers is, in any  
7 event, irrelevant here. The care and sophistication of potential purchasers would appear to be relevant  
8 only where there is some possibility of confusion among ordinary consumers exercising prudent care.  
9 That is not the case here.

10                   7.       Intent.

11                   The uncontradicted evidence is that the plaintiff had no knowledge of the existence of  
12 NASHVILLE or its use of a TNN mark prior to sometime in 1995, when Guy Hermann (Clive Hermann's  
13 son) came across NASHVILLE (not carried by the Hermanns' cable provider prior to 1995) while  
14 ``channel surfing." This was after the formation of TNN, after its incorporation, after the development of  
15 its TNN logo, and after the establishment of its website. DGH ¶ 7.

16                   NASHVILLE registered the TNN mark only for Cable Television Broadcasting. From early  
17 1994 until early 1998, plaintiff openly utilized www.tnn.com as its website without any objection from  
18 NASHVILLE. NASHVILLE had actual knowledge of the website for approximately three years before any  
19 objection was lodged. Plaintiff clearly had no actual or constructive knowledge that NASHVILLE claimed  
20 that its TNN mark was famous or extended to computer network services until immediately before this  
21 action was commenced.

22                   8.       Likelihood of Expansion.

23                   The defendant concedes that ``NEI presently has no plans to provide consulting or training  
24 to the general public regarding the establishment or maintenance of computer networks." In any event,  
25 the likelihood of expansion factor supports the claimant only if there is a ``strong possibility" of  
26 expansion (*Sleekcraft, supra*, at 354) and the expansion would be ``within the senior user's natural zone  
27  
28

1 of expansion." *Brookfield, supra* at p. 20. *See also* p. 33. Expansion by NASHVILLE into computer  
2 network consulting and training is not planned, and such expansion would not be a natural outgrowth  
3 of cable television programming.

#### 4 VI. INITIAL INTEREST CONFUSION.

5 Recently, in *Brookfield*, the Ninth Circuit recognized a type of confusion, which it referred  
6 to as "initial interest confusion" which the Ninth Circuit determined was not readily amenable to  
7 analysis under the *Sleekcraft* eight-factor test. *Brookfield, supra*, at p. 71 to 72. The Court described this  
8 type of confusion as follows:

9 "[s]ince West Coast's initial web page prominently displays its own name, it is  
10 difficult to say that a consumer is likely to be confused about whose site he  
11 has reached or to think that Brookfield somehow sponsors West Coast's web  
12 site. Nevertheless, West Coast's use of 'moviebuff.com' in metatags will still  
13 result in what is known as initial interest confusion. Web surfers looking for  
14 Brookfield's 'MovieBuff' products who are taken by a search engine to  
15 'westcoastvideo.com' will find a database similar enough to 'MovieBuff' such  
16 that a sizeable number of consumers who were originally looking for  
17 Brookfield's product will simply decide to utilize West Coast's offerings  
18 instead. Although there is no source confusion in the sense that consumers  
19 know they are patronizing West Coast rather than Brookfield, there is  
20 nevertheless initial interest confusion in the sense that, by using  
21 'moviebuff.com' or 'MovieBuff' to divert people looking for 'MovieBuff' to its  
22 web site, West Coast improperly benefits from the goodwill that Brookfield  
23 developed in its mark. Recently in *Dr. Seuss*,<sup>17</sup> we explicitly recognized that  
24 the use of another's trademark in a manner calculated to capture initial  
25

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26 <sup>17</sup> *Dr. Seuss Enters v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997), petition for  
27 cert. dismissed by, 118 S. Ct. 27 (1997).

1 consumer attention, even though no actual sale is finally completed as a  
2 result of the confusion, may be still an infringement.' " *Id.* (Emphasis  
3 added).

4 There are two essential criteria for "initial interest confusion." First, the goods or services  
5 of the parties must be "similar enough" so that that a sizeable number of consumers will consider one  
6 party's goods or services a reasonable substitute for the other's goods or services. The Court emphasized  
7 this point in its formal holding: "[U]sing a competitor's trademark in the metatags of such web site is  
8 likely to cause what we have described as initial interest confusion." *Id.* at 86. Clearly nothing on the  
9 plaintiff's website is "similar enough" to what people are looking for when they try to find NASHVILLE  
10 "such that a sizeable number of consumers who were originally looking for [NASHVILLE's] product will  
11 simply decide to utilize [NETWORK's] offerings instead."

12 A second requirement for "initial interest confusion" is that the confusion must be  
13 "calculated" to capture initial interest.<sup>18</sup> Nothing which the plaintiff has done with its website is  
14 calculated to capture the interest of people looking for NASHVILLE. Not only was the plaintiff unaware  
15 of the existence of NASHVILLE when it established www.tnn.com, but it defies all common sense to think  
16 that the plaintiff would have any interest in luring people who are interested in country music to a  
17 website targeted at IT professionals. Plaintiff does not have any third party advertising on its site, and  
18 could not possibly benefit from luring people interested in country music cable programming to its site. In  
19 the five years that the website has been in existence, the plaintiff has not received any business or interest  
20 from anyone who accessed the website looking for anything related to country music or country living.  
21 DCH ¶¶ 19 to 20.

22  
23 VII. LANHAM ACT UNFAIR COMPETITION.  
24

25 <sup>18</sup> Every example which the Ninth Circuit set forth in its discussion, and every case upon  
26 which it relied involved instances where the alleged infringer had intentionally sought to lure the  
27 customers of the trademark owner with misleading information.  
28



1 preventing all others from using the mark, regardless of whether the marks are in related fields or are  
2 those of competitors." *Star, supra at* 1033 (emphasis added).

3 The legislative history of the statute provides that "the use of DuPont shoes, Buick aspirin,  
4 and Kodak pianos would be actionable under this bill." 141 Cong. Rec. S19306, S19310 (daily ed. Dec.  
5 29, 1995). In order to be considered distinctive and famous "a mark must clearly be more than just  
6 distinctive in a trademark sense, and must rise to the level of 'Buick' or 'Kodak.'" *Michael Caruso & Co.,*  
7 *Inc. v. Estefan Enterprises, Inc.*, 994 F. Supp. 1454, 1463 (S.D. Fla. 1998).

8 2. Plaintiff's First "Commercial Use in Commerce".

9 In order to establish dilution, not only must the defendant's TNN mark be famous, but the  
10 plaintiff's "commercial use in commerce" of its TNN mark must have begun after the defendant's mark  
11 became famous. "In a federal dilution action, a plaintiff bears the burden of proving . . . (ii) that the  
12 defendant adopted its mark after the plaintiff's mark became famous . . ." *Ringling Brothers-Barnum &*  
13 *Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 955 F. Supp. 605, 613 (E.D. Va.  
14 1997).

15 "Use in commerce" is defined in the Lanham Act as "the bona fide use of a mark in the  
16 ordinary course of trade, and not made merely to reserve a right in a mark." "[A] mark shall be deemed  
17 in use in commerce . . . (2) on services when it is used or displayed in the sale or advertising of services  
18 and the services are rendered in commerce . . ." 15 U.S.C. 1127.<sup>19</sup>

19 It is beyond dispute that the plaintiff made commercial use in commerce of its TNN mark  
20 in November 1987, and certainly no later than September 19, 1989, when a training session was  
21 delivered by Clive Hermann to approximately 1,000 AT&T employees, with a large TNN logo prominently  
22 displayed immediately behind Mr. Hermann for the entire training session.

23 3. Application to the Current Case.

24  
25 <sup>19</sup> Aside from the issue of fame, it is not at all clear that NASHVILLE is the senior user of the  
26 mark. The defendant has not produced any instances of use in the advertisement or sale of goods or  
27 services prior to 1988.  
28

1           The above principles are easily applied in this case, since the defendant has not produced a  
2 scintilla of evidence that its mark has acquired the fame and distinctiveness of a "Buick" or a "Kodak" in  
3 1999, much less in 1989. Indeed, all the available evidence is to the contrary.

4           It is clear that until at least 1988 the defendant's corporate logo, as used in its press releases  
5 and advertising, was the words "The Nashville Network" next to or underneath the end of a guitar. In  
6 1989, the defendant registered its new logo, "TNN," next to the end of a guitar, with a claimed first-use  
7 date of February 12, 1988.

8           [F]ifteen years . . . has been generally held an insufficient amount of time for a mark to  
9 become famous. *Michael Caruso, supra*, at 1463. See also *Genovese Drug Stores, Inc. v. TGC Stores, Inc.*,  
10 939 F. Supp. 340, 350 (D.N.J. 1996) (slogan which "has only been used by plaintiff for nine years" not  
11 famous). Further, a claim of dilution is "seriously undermined by third party use of the same or similar  
12 marks." *Trustees of Columbia University v. Columbia/HCA Healthcare Corp.*, 964 F. Supp. 733, 750  
13 (S.D.N.Y. 1997). Accord, *Michael Caruso* at 1163; *Sports Authority v. Abercrombie & Fitch*, 965 F. Supp.  
14 925, 941 (E. D. Mich. 1997). Finally, the fact that NASHVILLE made no objection to the plaintiff's  
15 registration of the TNN.COM domain, the establishment of the www.tnn.com website, or the prominent  
16 use of plaintiff's TNN logo on the website when NASHVILLE learned of the same is strong evidence that  
17 NASHVILLE (at least until CBS acquired it) never believed that it possessed a famous trademark. Indeed,  
18 it is clear that this litigation is not the result of anything other than CBS's acquisition of NASHVILLE in  
19 October 1, 1997, and CBS's decision to attempt to enforce rights that its predecessor never claimed to  
20 have.<sup>20</sup>

21           NETWORK does not have the burden of proving that NASHVILLE's "TNN" mark is not  
22 famous, or that it was not famous in 1989. NASHVILLE must prove that its mark is famous, and that it  
23 was famous in 1989. It cannot even come close to doing so.

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24  
25 <sup>20</sup> Note also that although The Nashville Network objected to the use of TNNet in connection  
26 with music entertainment in 1995, it was only in 1998, after CBS acquired The Nashville Network,  
27 that suit was brought against TNNet.  
28



1  
2  
3 X. CALIFORNIA ANTI-DILUTION.

4 California Business and Professions Code § 14330 provides that the likelihood of injury to  
5 business reputation or of dilution of the distinctive quality of a mark shall be grounds for injunctive  
6 relief notwithstanding the absence of competition between the parties or of confusion as to the source of  
7 goods. Section 14330 applies only to "strong, well-recognized marks . . . as exemplified by such famous  
8 names as 'Tiffany,' 'Polaroid,' 'Rolls Royce' and 'Kodak' " (*Accuride, supra, at 1539*), although § 14330  
9 itself says nothing about the necessity of the mark's being famous. Since the statute says nothing about  
10 the necessity for the mark to be famous, it is not surprising that it also says nothing about the necessity for  
11 it to have been famous when the alleged dilutor began using its mark. However, plaintiff's counsel's  
12 review of the cases interpreting § 14330 has found no case in which a cause of action under § 14330  
13 was established where the alleged infringing use began before the mark became a "strong, well-  
14 recognized mark."

15 The Ninth Circuit has repeatedly warned against a broad interpretation of the California  
16 anti-dilution law "lest it swallow up all competition in the claim of protection against trade name  
17 infringement." *See, e.g., Toho Company, Ltd*, 645 F.2d 788, 793 (9th Cir. 1981); *Carter-Wallace, supra*  
18 *at 803, n.3*. Since adoption of the Federal Anti-Dilution statute, the Ninth Circuit has considered the  
19 Federal and California anti-dilution statutes to be substantially identical. *See, e.g., Panavision*  
20 *International v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998) ("Panavision's state law dilution claim is  
21 subject to the same analysis as its federal claim"); *Teletech Customer Care Management v. Tele-Tech*  
22 *Company, Inc.*, 977 F. Supp. 1407, 1412-1414 (C.D. Ca. 1997) (Federal and California anti-dilution  
23 applied without distinction); *Panavision International v. Toeppen*, 945 F. Supp. at 1302-1304 (same).

24 The underlying rationale of Cal. Bus. & Prof. § 14330 and similar anti-dilution statutes is to  
25 prevent "the gradual diminution or whittling away of the value of a trademark . . . ." *Sykes Laboratory,*  
26 *Inc. v. Calvin*, 610 F. Supp. 849, 856 (C.D. Ca. 1985). If the mark in question became famous after the  
27 alleged dilutor's use began, then by definition the alleged dilutor's use of the same mark did not result in  
28

1 ``the gradual diminution or whittling away of the value of a trademark." In other words, the  
2 requirement that the mark must have become famous before the alleged dilutor's use began is an  
3 essential component of the concept of ``dilution." Finally, § 14330 is an equitable statute, providing only  
4 equitable relief. Under circumstances where two trademark holders have lawfully used the same mark  
5 on different classes of goods concurrently, it would be inequitable to allow one of the two to oust the  
6 other from use of the mark through later events.

7 In short, ``[NASHVILLE's] state law dilution claim is subject to the same analysis as its  
8 federal claim." *Panavision*, 141 F.3d at 1324.

#### 9 10 XI. LACHES.

11 Laches is a defense to a Federal trademark action, *Brookfield, supra*, at p. 66, as well as a  
12 California trademark or unfair competition action. *Tustin Community Hospital, Inc. v. Santa Ana*  
13 *Community Hospital Association*, 89 Cal. App. 3d 889, 153 Cal. Rptr. 76 (4th Dist. 1979). A six-factor  
14 test is utilized to determine whether laches will bar relief:

15 1. Strength and Value of Trademark Rights Asserted.

16 As discussed previously, under Ninth Circuit law the TNN mark is descriptive, and  
17 therefore entitled to the least protection afforded any mark by trademark law. The mark is further  
18 weakened by the substantial number of other users of the TNN mark.

19 2. Counter-Plaintiff's Diligence in Enforcing the Mark.

20 NASHVILLE's pursuit of the plaintiff following its failure for four years to object to the  
21 registration of TNN.COM, the establishment of a website there and the use of the TNN logo is  
22 inexcusable. Almost three years elapsed from the date that NASHVILLE had actual knowledge of these  
23 uses, and the date on which any objection of any nature to the plaintiff's use was made.

24 The defendant has produced only two instances of any attempt to enforce the TNN mark  
25 prior to April 1997, the eve of the acquisition of NASHVILLE by CBS. In 1993, NASHVILLE sent a letter  
26 to Arts & Entertainment, Inc. objecting to A&E's trademark application for registration of ``THN" for  
27  
28

1 ``various cable television program services." There is no evidence of any follow-up or enforcement effort  
2 with respect to this matter. The second was the letter of objection sent to TNNet in 1995. NASHVILLE  
3 did nothing to enforce its alleged rights with respect to TNNet until 1998, after CBS acquired  
4 NASHVILLE. There is no evidence that the Nashville Network has ever attempted to enforce its alleged  
5 famous mark against the scores of other users of the mark outlined above, or that before December 1997  
6 it ever attempted to enforce TNN as a famous mark. Indeed, the 1993 and 1995 objections were  
7 expressly limited to marks which TNN argued were confusingly similar because of the related goods and  
8 services.

9 Not only did NASHVILLE take no steps for four years to object to the establishment and use  
10 of www.tnn.com, but a high-ranking employee (Systems Manager of the Information Technology  
11 Department) of NASHVILLE informed NETWORK that NASHVILLE had no interest in TNN.COM because  
12 ``our company wanted to represent a lot of our attractions under the country.com umbrella, rather than  
13 have a separate site just for TNN."<sup>21</sup> DTS, ¶ 11, Exhibit 12.

14 3. Harm to Senior User if Relief is Denied.

15 NASHVILLE is not suffering any harm to its trademark rights, at least none which it has not  
16 suffered since January 1994 when plaintiff established its website. The plaintiff is a family-owned  
17 business, and the prospect of significant expansion of the business is limited. The plaintiff is one of  
18 many, many users of the TNN mark. The counter-plaintiff claims that, notwithstanding the plaintiff's use  
19 of its TNN mark since at least 1989, and use of the www.tnn.com website since 1994, it has been  
20 successful in establishing its mark as a famous mark.

21 NASHVILLE has an extremely successful website at country.com, which it advertises  
22 prominently. DTS Exhibits 11 & 13. In addition, it has registered thenashvillenetwork.com, which it  
23 could utilize as a website. DGH, Exhibit 2. Unfortunately, CBS is not satisfied with that. The Internet is  
24 viewed by large corporations as the new Wild Wild West, and there is a veritable land rush on for  
25

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26 <sup>21</sup> A review of www.country.com demonstrates that that, in fact, is the strategy that The  
27 Nashville Network and its owners have pursued to this day.  
28

1 ``Internet Real Estate" (i.e., website names). This suit is motivated solely by CBS's desire to wrest control  
2 of www.tnn.com from the plaintiff. Obviously, to the extent that CBS is not successful in doing so, it will  
3 have failed in its goal. However, it is plaintiff's website ``real estate" that CBS will have lost; it will not  
4 have suffered any harm to its mark.

5 4. Good Faith Ignorance by the Junior User.

6 As discussed above, until 1995, none of plaintiff's employees had any knowledge of the  
7 existence of NASHVILLE or of its use of a TNN mark. More importantly, until December 1997, none of  
8 plaintiffs had any knowledge, and could not have had any knowledge that NASHVILLE's new owner now  
9 claimed that its trademark rights extended from its country music cable station to computer consulting  
10 services.

11 5. Competition between the Senior and Junior Users.

12 Not only are the plaintiff and the defendant not competitors, their services are completely  
13 unrelated.

14 6. Extent of Harm Suffered by Junior User because of the Senior User's Delay.

15 The plaintiff will suffer overwhelming harm if it is forced to give up its www.tnn.com  
16 website to the defendant, which is clearly the defendant's only goal in this litigation. Since the defendant  
17 learned that NETWORK maintained a website at www.tnn.com, that website has become the primary  
18 means of contact between the plaintiff and its clients and potential clients. The plaintiff's main source of  
19 ``advertising" is the distribution of training manuals to IT professionals with its website address.<sup>22</sup> The  
20 horrendous effect that loss of its website will have on the plaintiff is outlined in great detail in Clive  
21 Hermann's declaration, and the Court is referred to that for a more detailed discussion. DCH ¶¶ 23 to  
22 40.

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23  
24 <sup>22</sup> Until 1998, the plaintiff seminar work was done either for un-related third-party distributors  
25 who organized, advertised and put on the seminars, or for large corporations (such as AT&T) who  
26 organized, advertised and put on the seminars. In neither case did the plaintiff have access to the  
27 names, street addresses, e-mail addresses or phone numbers of the seminar attendees. Plaintiff,  
28 therefore, has no way of notifying these people of its loss of its website.

1 No better proof of the sincerity of the plaintiff's position can be found than the very fact  
2 that the plaintiff, a family business, has felt itself compelled to defend itself against the vastly superior  
3 financial resources of CBS. No doubt CBS is usually successful in intimidating most smaller businesses  
4 into giving up their websites in these circumstances. Plaintiff, however, knows that changing websites  
5 will have a devastating impact on its business.  
6

7 XII. CONCLUSION.

8 For the reasons set forth herein, the plaintiff submits that there are no triable issues of  
9 material fact, and that the plaintiff is entitled to judgment in its favor as a matter of law. In the event that  
10 full Summary Judgment is not granted, the Court is requested to dismiss those of the defendant's causes  
11 of action not supported by the undisputed facts. Finally, if full Summary Judgment is not granted, the  
12 Court is requested to strike all of the defendant's requests for monetary damages. The defendant/counter  
13 plaintiff has no evidence of intentional infringement and no good-faith argument to support any award  
14 of monetary damages against the plaintiff. Furthermore, in response to discovery, the defendant has not  
15 produced a scintilla of evidence of any monetary damages to itself. If the request for monetary damages  
16 remains, the Court will be saddled with a lengthy jury trial over issues which properly should be tried  
17 only to the Court.  
18

19 Respectfully submitted,

20 THE LAW OFFICES OF SHARDLOW & VICK  
21 ATTORNEYS FOR PLAINTIFF AND  
22 COUNTERDEFENDANT

23 DATED: June 14, 1999

24 By: \_\_\_\_\_  
25 Thomas E. Shardlow  
26  
27  
28

1 PROOF OF SERVICE BY MAIL

2  
3  
4 I, Carol Jarvis, am a resident of the County of Los Angeles, State of California; I am over the  
5 age of 18 years and not a party to the within action. My business address is: The Law Offices of  
6 Shardlow & Vick, 790 East Colorado Boulevard, 9th Floor, Pasadena, California 91101.

7  
8 On June 14, 1999 I served:

9  
10 Plaintiff's Notice of Motion and Motion for Summary Judgment or Partial  
11 Summary Judgment; Memorandum of Points and Authorities

12  
13 on the interested parties in this action by placing a true copy thereof, enclosed in a sealed envelope with  
14 postage prepaid, in the United States Mail at Pasadena, California, addressed as follows:

15  
16  
17 Kelli L. Sager, Esq.  
18 Randall Boese, Esq.  
19 Davis Wright Tremaine LLP  
20 1000 Wilshire Boulevard, Suite 600  
21 Los Angeles, California 90017-2463

22 I declare under penalty of perjury under the laws of the United States of America that the  
23 foregoing is true and correct, and that I am employed in the office of a member of the bar of this Court  
24 at whose direction the service was made.

25 Executed on June 14, 1999.

26  
27  
28 \_\_\_\_\_  
Carol Jarvis

1 14969:cj

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