

1 THOMAS E. SHARDLOW, State Bar #072616
2 PATRICIA G. VICK, State Bar #113951
3 THE LAW OFFICES OF SHARDLOW & VICK
4 790 East Colorado Boulevard, 9th Floor
5 Pasadena, California 91101
6 (626) 584-1600; FAX (626) 584-3952

7
8 Attorneys for Plaintiff and Counterdefendant
9 THE NETWORK NETWORK
10

11 **UNITED STATES DISTRICT COURT**
12 **CENTRAL DISTRICT OF CALIFORNIA**
13

14 The Network Network,) Case No. CV98-1349-NM (ANx)
15)
16) Plaintiff,)
17)
18) vs.)
19)
20) CBS, Inc. and Does 1 to 10,)
21)
22) Defendants.)
23) Date: August 16, 1999
24) Time: 10:00 a.m.
25) Place: Courtroom 11
26) 312 North Spring Street
27)
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1 I. INTRODUCTION.

2 This case arises out of an attempt by CBS, Inc. to deprive The Network Network ("NET-
3 WORK") of a web site domain name which it has lawfully been using for almost five years, by threat and
4 financial intimidation. CBS's tactics have unfortunately become so common that they have been given a
5 name on the Internet: "poaching" or "reverse domain name hijacking." See, e.g., *Showdown at the*
6 *Domain Name Corral: Squatters, Poachers and other Parasites*, 58 U. Pitt. L. Rev. 991 (1997),
7 www.pitt.edu/~lawrev/58-4/articles/domain.htm ("'[P]oaching' via 'reverse domain name hijacking' .
8 . . . occurs when a trademark holder seeks to obtain a domain name from another person who also holds a
9 colorable claim to the same name. . . . [P]oacher cases offer the greatest chance for abuse and
10 overextension by those with registered trademarks.").

11 This case does not arise from the unauthorized use by NETWORK of The Nashville Net-
12 work's ("NASHVILLE") registered "TNN" service mark. NASHVILLE registered its mark "For: Television
13 Program Production Services and Distribution of Television Programming to Cable Television Systems."
14 NETWORK is not even arguably using the TNN mark for anything related to television program
15 production or distribution services. NETWORK is not using the NASHVILLE'S mark; it is using its own
16 mark in connection with its computer network consulting services, the same mark which it has used
17 since 1986, the same mark which it began extensive use and promotion of in 1989, the same mark
18 which it registered as a domain name in 1994 and used without objection for four years, and the same
19 mark which it has used continuously to this day.

20 NASHVILLE's dilution claims fail as a matter of law because NETWORK began extensive use
21 of its mark no later than 1989.¹ NASHVILLE does not even contend that it possessed a famous mark in
22 1989, and any such contention would be frivolous. Aware that it cannot establish that it possessed a
23 famous mark in 1989, NASHVILLE asks this Court to rewrite the statute to instead allow it to test whether

24
25 ¹ This is the latest possible date of first use. NETWORK contends that it first began using
26 the TNN mark in 1986. However, since NASHVILLE makes no contention that it possessed a
27 famous mark in 1989, it is irrelevant whether NETWORK first began using its mark in 1986 or in
28 1989.

1 its mark was famous in 1994.² The law clearly requires fame to be tested in 1989.

2 NASHVILLE's infringement claims fail as a matter of law because NASHVILLE's and
3 NETWORK's services are neither competitive nor related. NASHVILLE does not contend that they are.
4 Ninth Circuit law requires goods and services to be "competitive" or at least "related"³ as an absolute
5 precondition to the existence of a trademark infringement claim. Despite the absolute requirement that
6 for confusion to exist goods and services must at least be related, NASHVILLE asks this Court to simply
7 ignore the relatedness or proximity factor. See NASHVILLE's opening brief, page 24, note 28.

8 Finally, NASHVILLE provides no justification, excuse, or even explanation for its four-year
9 delay between the time that the NETWORK registered its domain name and the date of NASHVILLE's
10 objection thereto. Not only is no explanation provided, NASHVILLE's motion appears to be carefully
11 constructed so as to conceal that delay from the Court,⁴ strongly suggesting that NASHVILLE understands
12 very well the extremely negative impact that its unjustified delay has upon its Summary Judgment
13 Motion.

14 NETWORK will not burden the record by repeating the material contained in its own
15 summary judgment motion, scheduled to be heard simultaneously with NASHVILLE's motion. NETWORK
16 incorporates the Points and Authorities, Declarations, and other materials filed in connection therewith
17 into this Response. This brief assumes the reader's familiarity with those materials, and they are hereby
18 incorporated by reference.

19
20 ² NASHVILLE makes no showing at all with respect to the alleged fame of its mark in 1994.
21 Rather, it asks this Court to conclude that since its mark is (allegedly) famous in 1999, the Court
22 should infer that its mark was famous in 1994. That request is clearly improper, especially in a
summary judgment context.

23 ³ Related goods or services are those products or services which, while not competing, would
24 reasonably be thought by the buying public to come from the same source if sold under the same
mark. *AMF Incorporated v. Sleekcraft Boats*, 599 F.2d 341, 348 n.10 (9th Cir. 1979).

25 ⁴ Despite the extensive documentary and other records provided by NASHVILLE, nothing in
26 NASHVILLE's papers mentions the fact that NASHVILLE's discovery of the registration of
27 tnn.com occurred no later than April 1995.

1 II. NASHVILLE'S MARK IS REQUIRED TO HAVE BEEN FAMOUS IN 1989.

2 NETWORK began extensive use of its TNN mark no later than 1989. DCH⁵ ¶ 7, and Exh.
3 1,2,4 & 5. NASHVILLE does not contend that it possessed a famous ``TNN" mark in 1989 and any such
4 claim would be extraordinarily frivolous. Rather, NASHVILLE contends that the Court should look to
5 whether NASHVILLE had a famous mark when NETWORK registered its domain name in January 1994.
6 That contention is contrary to the plain language of the statute, the interpretation of the leading
7 authority on trademarks, the legislative history of the dilution statute, the court cases which have
8 interpreted the statutory language, and the previous interpretation of NASHVILLE's own legal counsel.

9 The Federal anti-dilution statute, 15 U.S.C. § 1125(c), provides in relevant part that

10 ``The owner of a famous mark shall be entitled . . . to an injunction against another
11 person's commercial use in commerce of a mark or trade name if such use
12 begins after the mark has become famous and causes dilution . . ." Emphasis
13 added.

14 ``[S]uch use" is clearly a reference to ``commercial use in commerce." Hence, the statute
15 unambiguously provides that what is relevant is whether NETWORK began its use of the mark in
16 commerce after the mark became famous.⁶

18 ⁵ Following the convention established in NETWORK's Summary Judgment Motion, DCH,
19 DGH, and DTS stand, respectively for the declarations of Clive Hermann, Guy Hermann and
20 Thomas E. Shardlow, filed in connection with NETWORK's motion. The only additional
21 declaration filed herewith is an second declaration of Thomas E. Shardlow, referred to herein as
22 ``2DTS."

23 ⁶ The extent to which NASHVILLE must torture the statutory language demonstrates the
24 weakness of NASHVILLE's argument. NASHVILLE suggests that the Court should move the
25 ``causes dilution" language from the end of the sentence in which it is contained and place it instead
26 immediately after ``commercial use in commerce." See NASHVILLE's Opening Brief, page 17,
27 lines 9 and 10. If the language were moved around in that way, the statute **would** read ``against
28 another person's commercial use in commerce **which causes dilution** of a mark or trade name is
such use begins after the mark has become famous . . ." The argument is then made, based upon
the revised language, that ``such use" refers to ``commercial use in commerce which causes
dilution."

1 In the leading treatise on trademark law, 4 McCarthy on Trademarks § 24:96 (West,
2 1999), Professor McCarthy describes the requirement as to the timing of acquisition of fame as follows:

3 "Section 43(c) states that the accused use must have begun after the time that the
4 plaintiff's mark has become famous. This reflects the fair and equitable
5 principle that one should not be liable for dilution by the use of a mark
6 which was legal when first used. That is, if at the time of first use, Zeta's
7 mark did not dilute Alpha's mark because Alpha's mark was not famous, then
8 Alpha will not at some future time have a federal dilution claim against Zeta's
9 mark. Thus, the junior user must be proven to have first used its mark *after*
10 the time that plaintiff's mark achieved fame. This requires evidence and
11 proof of the timing of two events: when the plaintiff's mark achieved that
12 elevated status called 'fame' and when the defendant made its first use of its
13 mark." Emphasis added.

14 This is so clearly the meaning of the statutory language to Professor McCarthy that he does
15 not even entertain any conflicting interpretation.

16 Professor McCarthy's reading of the statute is unequivocally supported by the 1987
17 Trademark Review Commission Report,⁷ 77 Trademark Rep. 375, 462 (1987) which described the tim-
18 ing requirement as follows: "If the later user adopts its mark before the registrant's mark becomes
19 famous, the court should not enjoin the latter user's use on dilution grounds." Further, the Trademark
20 Review Commission stated that "this rule would correspond to the present rule on secondary meaning
21 marks" which require that the senior user must prove that the secondary meaning in the mark was
22 established prior to the junior user's first use. McCarthy, *supra*.

23 Courts have uniformly interpreted the statute in the same way. For example:

24 a. "In a federal dilution action, a plaintiff bears the burden of proving . . . (ii) that the

25
26 ⁷ "[T]he precursor to the 1996 Act." *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st
27 Cir. 1998).

1 defendant adopted its mark after the plaintiff's mark became famous . . ." *Ringling Brothers-Barnum &*
2 *Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 955 F. Supp. 605, 613 (E.D. Va.
3 1997). Emphasis added.

4 b. "The elements of a dilution claim are that . . . defendant's use began after the
5 plaintiff's mark became famous." *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161, 1166 (C.D. Cal. 1998).
6 Emphasis added.

7 c. "To obtain protection under this statute, Plaintiff must demonstrate that . . .
8 Defendant's use of their allegedly diluting mark began after Plaintiff's mark achieved such fame . . ."
9 *Star Markets, Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030, 1032 (D.C. Ha. 1996).

10 NASHVILLE makes the meritless contention that *Teletech Customer Care Management v.*
11 *Tele-Tech Company, Inc.*, 977 F. Supp. 1407 (C.D. Ca. 1997) is to the contrary. *Teletech* involved a
12 situation in which two companies had for many years been using similar, but not identical, trademarks.
13 The plaintiff used "Teletech" as its mark. The defendant used "Tele-Tech." When the defendant chose a
14 domain name to register, it chose "teletech" (without a hyphen) rather than the "tele-tech" mark which
15 it had used for many years.⁸ Judge Pfaelzer looked to whether "teletech" (without a hyphen) was a
16 famous mark when Tele-tech registered that as its domain name because that was the very first time that
17 Tele-tech had ever used the teletech (without a hyphen) mark.⁹ Accordingly, the *Teletech* case represents
18 nothing more than a straightforward application of the rule that a court must look to the existence of
19 fame at the time of the accused's first use of the mark.¹⁰

20
21 ⁸ Tele-tech claimed that it chose the plaintiff's trademark rather than its own because it
22 mistakenly assumed that domain names could not have hyphens in them. *Id.* at 1413. Far from
23 ruling that Tele-tech violated the law by using its own established trademark as its domain name,
24 the court made it clear that "Tele-tech is not precluded from using its own name, "Tele-Tech, with
its distinctive hyphenation, as its domain name." *Id.* at 1410. NETWORK has done no more than
what Judge Pfaelzer indicated was entirely appropriate.

25 ⁹ The Court pointed out that Tele-tech was completely free to use the www.tele-tech.com
domain name, and that hyphens were permissible characters in domain names. *Id.* at 1409-1410.

26 ¹⁰ It is impossible to imagine that Judge Pfaelzer intended her decision to be taken for a
27 pronouncement that the anti-dilution statute means something other than what everyone else be-

1 Finally, NASHVILLE's own attorney, in a 1998 opposition to an application for the
2 trademark registration of ``TNN Transplant News Network" (subsequently withdrawn), objected to the
3 registration on the grounds that ``Any use, if any (sic.), by Applicant would have begun after Opposer's
4 TNN mark had become a famous mark" thus acknowledging that the relevant legal consideration is when
5 the junior user first began using the mark. 2DTS, ¶ 2, Exhibit A.
6

7 III. NASHVILLE DID NOT POSSESS A FAMOUS MARK IN 1994.

8 As shown above, whether NASHVILLE had a famous mark in 1994 is clearly irrelevant.
9 However, NASHVILLE has not even demonstrated that it had a famous mark in 1994. As discussed in
10 more detail in NETWORK's motion for summary judgment, in order to be famous a mark ``must rise to
11 the level of `Buick' or `Kodak.'" *Michael Caruso & Co., Inc. v. Estefan Enterprises, Inc.*, 994 F. Supp.
12 1454, 1463 (S.D. Fla. 1998). NASHVILLE has not come close to proving that its use of TNN has acquired
13 that level of fame in 1994. Its contention to the contrary is built upon clear misapplications of the eight
14 factors set forth in the statute.¹¹

15 A. The Degree of Inherent or Acquired Distinctiveness of the Mark.

16 The strength of a trademark or tradename is largely determined by its position on a
17 continuum stretching from arbitrary marks to descriptive marks. *Accuride International, Inc v. Accuride*
18 *Corporation*, 871 F.2d 1531, 1536 (9th Cir. 1989). Under controlling Ninth Circuit law a trademark
19 which is comprised of the initials of the trademark holder's name is a descriptive mark. *Everest &*
20 *Jennins, Inc. v. E & J. Manufacturing Company*, 263 F.2d 254, 259 (9th Cir. 1958); *CD Solutions, Inc. v.*
21

22 (..continued)

23 lieved it to mean, without her having once explicitly addressed the issue.

24 ¹¹ The statute provides that ``a court may consider factors such as, but not limited to" 15
25 USC § 1125(c). The eight factors are therefore neither exclusive nor sufficient. The party
26 contending that a mark is famous must prove that the mark is ``truly prominent and renowned,"
27 ``especially famous and distinctive" and ``rises to the level of `Buick' or `Kodak.'" Without regard
28 to the factors which the statute says a Court may consider, NASHVILLE has not come close to
proving that its mark meets the general test of famousness.

1 *Tooker*, 15 F. Supp. 2d 986 (D.C. Or. 1998). As such, it is the weakest type of mark which is allowed any
2 trademark protection at all.

3 The fact that the mark is incontestible does not favor a finding of fame. Incontest-
4 ability merely precludes NETWORK from arguing that NASHVILLE's descriptive mark is invalid because it
5 is not distinctive (i.e., because it has not acquired a secondary meaning). *Park 'N Fly, Inc. v. Dollar Park*
6 *& Fly, Inc.* 469 U.S. 189, 205 (1985). Incontestability does not increase the "degree of inherent or
7 acquired distinctiveness." If it did, then every mark which has been registered for five years would be
8 considered to be highly distinctive, a patently ridiculous result.

9 NASHVILLE has presented no evidence as to the acquired distinctiveness of the
10 mark in 1994. Even NASHVILLE's asserted expert has limited his testimony to the situation in 1999. Any
11 assertion that by 1994 the mark had acquired any distinctiveness, much less a high degree of
12 distinctiveness, would be pure speculation.¹²

13 NASHVILLE's evidence of distinctiveness even in 1999 is quite weak. NASHVILLE's
14 cable programming appeals to a limited audience. According to NASHVILLE's own evidence, its average
15 viewership ranks it twelfth among cable television networks, behind such "powerhouses" as the Cartoon
16 Network, Lifetime and the Discovery Channel. Declaration of Ken Kagen ¶ 9. Note also that Mr. Kagen
17 conveniently defines cable television network to include networks which are exclusively on cable,
18 thereby excluding from the analysis ABC, NBC, CBS, FOX, WARNER, and their local affiliates. Those
19 networks are also carried on cable, relegating NASHVILLE's average viewership to something closer to
20 twentieth than twelfth.

21 It is also of more than passing interest that as late as February 1998, NASHVILLE's press
22 releases still referred to itself as "TNN: The Nashville Network." 2DTS ¶ 2, Ex. B. Four years after
23 NASHVILLE claims to have had a famous mark, NASHVILLE felt that the reader might not know who
24

25 ¹² Of course, NASHVILLE's intentional delay in making any objection to NETWORK's
26 registration of tnn.com has made it very difficult for NASHVILLE to come forward with any
27 evidence of the degree of acquired distinctiveness of its TNN mark in 1994. However, NASH-
28 VILLE is entirely responsible for this self-imposed injury.

1 NASHVILLE was talking about if NASHVILLE identified itself simply as TNN.

2 Assuming that the Declaration of Henry Ostberg, NASHVILLE's alleged expert, is ad-
3 missible, it proves only that even in 1999 TNN's recognition was limited. Mr. Ostberg restricted his
4 survey not only to individuals who subscribed to cable television (Ostberg Declaration, Ex. 1, page 7) but
5 also restricted it to people who had NASHVILLE as part of their cable television lineup. DTS, Exhibit 9.
6 The survey was thus skewed towards people likely to recognize NASHVILLE's mark.

7 Even then, after twice being asked to identify cable networks which primarily show
8 country music and country dancing programs, only 35% identified TNN, with another 2% identifying
9 "The Nashville Network." When then asked whether they had heard of a cable television network called
10 "TNN," 87% claimed that they had, but when asked "What types of programs are primarily shown on
11 TNN, less than 36% responded with anything having to do with "country/country and western music"
12 or "country/country and wester programming/shows." The remainder claimed that TNN showed
13 primarily programs related to auto repair, auto mechanics news, old TV shows, sitcoms, reruns, talk
14 shows, interviews, racing, fishing, outdoors, dancing etc. See Osterberg Declaration, Exhibit A, page 20.
15 In short, the survey first excluded anyone who did not have both cable television and The Nashville
16 Network in their homes. Even then, and even after TNN was specifically mentioned, the vast majority of
17 the respondent could not associate it with NASHVILLE.

18 Finally, as discussed in more detail in the Evidentiary Objection filed concurrently
19 herewith, the survey has nothing at all to do with the possible fame of NASHVILLE. The cases have
20 universally held that fame can only be measured by determining how well a mark is recognized divorced
21 from the goods or services with respect to which it is associated. By specifically asking about cable
22 television programming rather than a more general question,¹³ Mr. Osterberg gathered evidence which
23 the Courts have held is irrelevant.

24 B. The Duration and Extent of Use of the Mark in Connection with the Goods or
25

26 ¹³ For example, the survey respondents could have been asked whether they had ever heard of
27 TNN, and then asked what they associated TNN with.
28

1 Services with Which the Mark Is Used, and the Duration and Extent of Advertising and Publicity.

2 NASHVILLE did not advertise under the TNN mark until 1988. Until sometime in
3 1988, NASHVILLE always referred to itself as "The Nashville Network" in its advertising. "TNN" was
4 nowhere to be found. DTS ¶ 6 and Exh. 3. By January 1994, NASHVILLE had been advertising¹⁴ the
5 TNN mark for less than six years. This is an extremely short period of time for a mark to become famous,
6 and no case has held that a mark has become famous in anything approximating that time period.

7 The extent of the use of the mark was limited as well in 1994. Until recently, the
8 mark was always advertised in conjunction with the words "The Nashville Network" and therefore self-
9 limited in extent to the country music area. Declaration of Steven Yanovsky, Exhibit A. There is no
10 evidence that NASHVILLE was thought of by the typical consumer as TNN in 1994, rather than the much
11 more prominently used "Nashville Network," or that the letters "TNN" were uniquely identified with
12 NASHVILLE.¹⁵

13 Thus, even in 1994, neither the duration nor the extent of NASHVILLE's use or
14 advertisement of its TNN mark supports a finding that it was famous.

15 C. The Geographical Extent of the Trading Area in Which the Mark is Used.

16 The fact that NASHVILLE uses the TNN mark throughout the United States means
17 that it meets the minimum threshold for possibly being famous. It is difficult to imagine that a mark
18 could attain the exalted status of "fame" without being used throughout the country. The reverse is
19 certainly not true. There are hundreds of thousands of marks used throughout the United States, but
20

21 ¹⁴ NETWORK does not dispute that before 1988, TNN was used in isolated instances as an
22 abbreviation for The Nashville Network. However, TNN is not found in any of NASHVILLE's
23 advertisements prior to 1988. Clearly the extent of the use of the TNN mark prior to 1988 was
24 extremely slight. Isolated uses of an abbreviation for The Nashville Network certainly does not
support an inference that the abbreviation had therefore become famous.

25 ¹⁵ "A mark that evokes an association with a specific source only when used in connection
26 with the particular goods or services that it identifies is ordinarily not sufficiently distinctive to be
27 protected against dilution." *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 46-47 (1st Cir.
28 1998).

1 only a handful are "truly prominent and renowned." *I.P. Lund, Id.* at 46. Accordingly, this factor neither
2 suggests that NASHVILLE's mark is famous, nor that it is not famous.

3 D. The Channels of Trade for the Goods or Services with Which the Mark Is Used.

4 A mark which is used in conjunction with a wide number of unrelated goods or
5 services and in a wide number of unrelated markets is more likely to be famous than a mark which is
6 associated with a single product or market.

7 It is undisputed that NASHVILLE uses its TNN mark only in conjunction with cable
8 television programming related to country music and country living. NASHVILLE reaches a great deal to
9 argue that the sale of memorabilia with the TNN logo on it means that its markets extend beyond country
10 music cable programming. The "shirts, jackets, key chains and other memorabilia" from which
11 NASHVILLE obtains an undisclosed portion of its revenue are items associated with country music or
12 country living or NASHVILLE's country music television network. See Declaration of Steven Yanovsky Ex.

13 B. More important, TNN simply puts its logo on this memorabilia, a logo which has meaning only
14 because it has some association with NASHVILLE's country music cable network. There are no "TNN"
15 brand clothes, no "TNN" brand key chains, no "TNN" brand watches. Indeed, there is no TNN brand
16 anything (at least associated with NASHVILLE) other than relating to NASHVILLE's country music cable
17 network.¹⁶

18 Accordingly, since NASHVILLE does not sell any goods or services outside the
19 country music or country living field, and since it is not involved in any markets outside country music
20 or country living, its mark is not likely to have acquired fame outside of those contexts.

21 E. The Degree of Recognition of the Mark in the Trading Areas and Channels of Trade
22 Used by the Mark's Owner and the Person Against Whom the Injunction Is Sought.

23 NASHVILLE has not presented a scintilla of evidence of the degree of recognition of
24

25 ¹⁶ Consider for example, the mark "Lakers." The Lakers sell all type of memorabilia with the
26 Lakers logo on it, yet no one could seriously suggest that the Lakers are associated with anything
27 other than basketball.

1 its mark in 1994 in its own trading areas or channels of trade. Indeed, although requested in discovery
2 and promised, NASHVILLE has failed and refused to produce any of the name recognition, mark
3 recognition or advertising effectiveness surveys taken by NASHVILLE in the normal course of business.
4 2DTS ¶ 3.

5
6 Nor has NASHVILLE produced any evidence of the recognition of the TNN mark in
7 NETWORK's trading areas and channels of trade (either as a mark belonging to NETWORK or as a mark
8 belonging to NASHVILLE). Lacking such evidence, NASHVILLE requests the Court to make the amazing
9 leap of faith that since NASHVILLE is known by a large number of cable television viewers, and since
10 allegedly there must be some country music lovers who also are interested in computer network
11 consulting, therefore NASHVILLE's TNN mark must have wide recognition within the computer network
12 consulting trade. Not only is NASHVILLE's second premise completely unsupported, but NASHVILLE's
13 conclusion does not logically flow from its premises.

14 NASHVILLE has absolutely no evidence of the extent to which TNN would be
15 recognized as a mark associated with NASHVILLE among the computer networking industry. Likewise,
16 NASHVILLE has absolutely no evidence of the extent to which TNN was recognized in 1994 among cable
17 television customers. Since NASHVILLE has the burden of proof with respect to the alleged famous status
18 of its trademark, its absence of any evidence supporting this factor supports NETWORK.

19 F. The Nature and Extent of the Use of the Same or Similar Marks by Third Parties.

20 According to the 1987 Trademark Review Commission Report, 77 Trademark Rep.
21 375, 461 (1987), "Third party uses of the same or similar marks are relevant in determining the fame
22 and distinctiveness of the mark, since the mark must be in substantially exclusive use." As shown in
23 NETWORK'S summary judgment motion, there are scores of other companies using marks the same as or
24 similar to "TNN." Given this evidence, it is not surprising that NASHVILLE's summary judgment motion
25 entirely ignores this factor.

26 NASHVILLE contends instead that finding a of fame is supported because there has
27 been some limited attempts to keep others from using the TNN mark. But that is not what the statute says
28

1 that the Court should consider. In any event, only one of the documented attempts at enforcement pre-
2 ceded January 1994 (and that only by seven months) so it is difficult to see how even these limited
3 attempts can have any relevance at all to the existence of fame in January 1994. The lack of attempts to
4 enforce its so-called famous mark before June 1, 1993 suggests that it was not famous.¹⁷ Similarly, no
5 objection was made to NETWORK's registration or use of tnn.com between January 1994 and December
6 1997. In 1995, a written objection was made to the use of the tnnNet.com mark in connection with
7 music entertainment, but no action was filed against TnnNet.com until 1998.¹⁸ No action has been
8 brought against any other user of the TNN mark, although there are scores of them. These facts do not
9 suggest any diligence in protecting what NASHVILLE now claims is a famous mark, and certainly do not
10 suggest that NASHVILLE's mark was famous in 1994, or that NASHVILLE even believed in 1994 that it
11 was.

12 G. Registration on the Principal Register.

13 "[T]his factor permits a court to find that a mark is not 'famous' because, among
14 other reasons, it was not federally registered. The logic would be that if the owner of an allegedly
15 'famous' mark did not even bother to take the commercially ordinary and minimal step of federally
16 registering the mark, this is an admission against interest that the mark is not 'famous.'" 4 McCarthy on
17 Trademarks § 24:92 (West, 1999). Registration, however, does not suggest that a mark is famous. There
18 are millions of marks registered on the principal register, only a handful of which are famous. The best
19 that NASHVILLE can hope for, therefore, is that this factor is neutral.

20 In fact, this factor strongly suggests that NASHVILLE did not have a famous mark in
21

22 ¹⁷ Note that the June 1, 1993 objection related to another cable television station, strongly
23 suggesting that possible trademark infringement rather than dilution was NASHVILLE's concern.

24 ¹⁸ NASHVILLE's contention that there was a Court finding that its mark was famous, and its
25 contention that the defendant was required to pay damages for past "misuse" of TNN, is completely
26 false. There was no Court finding at all, merely an agreement by the defendant in a consent decree
27 (undoubtedly obtained so that NASHVILLE could attempt to mischaracterize it as a finding of the
28 Court in this litigation). The consent decree not only contains no provision for payment of any
damages but expressly waives a claim for same. See Declaration of Kevin Wilson, Exhibit F.

1 1989 or 1994, since it did not even bother to register its mark until 1987.

2 IV. DILUTION.

3 If NASHVILLE had possessed a famous mark in 1989, and if it objected to the registration
4 of "tnn.com" by NETWORK immediately after learning of it, a finding of dilution would almost certainly
5 follow as a matter of course. However, NASHVILLE has shown by its own actions and statements that it
6 did not consider the registration of tnn.com and the establishment by NETWORK of a website thereon to
7 dilute its trademark.

8 NASHVILLE learned that NETWORK had established a website at tnn.com no later than
9 April 1995. DTS Ex. 5. No objection was made thereto. In December 1996, the Systems Manager of
10 NASHVILLE's Information Technology department sent an e-mail to Clive Hermann informing Clive
11 Hermann that "I understand that our company wanted to represent a lot of our attractions under the
12 country.com umbrella rather than have a separate site just for TNN." DCH Ex. 10. In April 1997, NASH-
13 VILLE did in fact establish its website at www.country.com. DTS Ex. 11.

14 The lack of any objection from NASHVILLE to NETWORK's use of its tnn.com site between
15 April 1995 and December 1997, and the fact that NASHVILLE's employee told Clive Hermann that
16 NASHVILLE was not interested in having a separate tnn.com site, seriously calls into question any claim
17 by NASHVILLE that NETWORK's registration of tnn.com dilutes its trademark.

18
19 V. CALIFORNIA ANTI-DILUTION LAW DOES NOT DIFFER FROM FEDERAL LAW.

20 NASHVILLE claims that California law differs from the Federal anti-dilution statute in that
21 (it claims): i) fame is not required, and ii) it is irrelevant when fame was acquired. NASHVILLE is wrong
22 on both counts.

23 California anti-dilution law applies only to "strong, well-recognized marks . . . as
24 exemplified by such famous names as 'Tiffany,' 'Polaroid,' 'Rolls Royce' and 'Kodak' " (*Accuride, supra, at*
25 1539, emphasis added). If this is not a requirement that the mark be famous, then what would be?

26 NASHVILLE claims that when fame is acquired is irrelevant under California law.
27
28

1 NASHVILLE cites no authority for that proposition, nor suggests any reason why that should be the rule.
2 NASHVILLE simply relies upon the fact that California Business & Professions Code § 14330 does not
3 specify that the mark must have acquired fame before the accused's first use of the mark. Of course,
4 § 14330 does not discuss fame at all. That is because California anti-dilution law is not embodied in
5 § 14330.

6 Far from being embodied in precise statutory language, as pointed out by the Ninth Circuit
7 in *Carter-Wallace, Inc. v. Proctor & Gamble, Inc.*, 434 F.2d 794, 803 (9th Cir. 1970), California's ``law
8 regarding the dilution doctrine is not altogether clear and cannot be readily summarized except to say
9 that it is an offshoot of the equitable considerations inherent in the concept of unfair competition."
10 NASHVILLE presents no reasons why California would or should ignore ``the fair and equitable principle
11 that one should not be liable for dilution by the use of a mark which was legal when first used."
12 4 McCarthy, *supra* at 24:96.

13
14 VI. TRADEMARK INFRINGEMENT - GOODS OR SERVICES MUST AT LEAST BE RELATED.

15 ``Related goods are those `products which would be reasonably thought by the buying
16 public to come from the same source if sold under the same mark.' " *AMF Incorporated v. Sleekcraft*
17 *Boats*, 599 F.2d 341, 348 Note 10 (9th Cir. 1979). *Sleekcraft*, the leading case on trademark
18 infringement in the Ninth Circuit, unambiguously held that ``If the goods are totally unrelated, there can
19 be no infringement because confusion is unlikely." *Sleekcraft* at 348 (emphasis added).

20 The *Sleekcraft* language is so clear that goods or services must at least be related in order
21 for there to be an infringement that it appears to be ``beating a dead horse" to pursue the matter further.
22 However, since this is a critical point, and one which NASHVILLE entirely ignores, the horse will
23 unfortunately be beaten.

24 The Courts have repeatedly followed the language in *Sleekcraft* to require that goods or
25 services at least be related in order to support a trademark infringement. Fourteen years after *Sleekcraft*,
26 the Ninth Circuit confirmed that ``The eight factor test applies when the products are related"
27
28

1 *Official Airline Guides v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993). In *Lockheed Martin Corporation v.*
2 *Network Solutions, Inc.*, 985 F. Supp. 949, 963 (C.D. Cal. 1997) (emphasis added), the Court held that in
3 order for use of a mark to constitute infringement "such use must be in connection with goods or ser-
4 vices that are competitive with, or at least related to, the goods or services for which the trademark has
5 been registered or used in commerce." More recently a District Court held that "The Sleekcraft factors
6 apply to related goods. . . . The Court finds that the goods here are not related. . . . Therefore, Bally's claim
7 for trademark infringement fails as a matter of law." *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161,
8 1163-1164 (C.D. Cal. 1998) (emphasis added).

9 NASHVILLE concedes that the goods in question are not related, and any contention to the
10 contrary would clearly be frivolous. See NASHVILLE's opening brief, page 24, note 28. Therefore, the
11 infringement claim "fails as a matter of law."¹⁹

12
13 VII. EVEN IF THE SLEEKCRAFT FACTORS WERE RELEVANT NASHVILLE HAS MISAPPLIED
14 THEM.

15 NASHVILLE concedes that of the eight *Sleekcraft* factors, at least three ("relatedness or
16 proximity of products or services, the junior user's intent in selecting the mark, and the likelihood of
17 expansion in product lines") do not support a finding of likelihood of confusion. See NASHVILLE's
18 opening brief, page 24, note 28. NASHVILLE is wrong in claiming that four of the additional factors
19

20
21 ¹⁹ Even if NASHVILLE could credibly argue that the parties services are "related," they are
22 certainly not competitive. Where goods are related, but not competitive, NASHVILLE would not
23 be barred as a matter of law from pursuing its claim. However, even with respect to goods which
24 were related but "did not compete to any extent whatever . . . the likelihood of confusion would be
25 remote." *Brookfield Communications, Inc. v. West Coast Entertainment*, 174 F.3d 1036, 1056 (9th
26 Cir. 1999). The lack of any competition whatever creates "at the least . . . the **heavy burden**" on
27 the complaining party to establish likelihood of confusion despite the inherent unlikelihood that
28 confusion could exist with respect to non-competitive goods and services. *Id.* (emphasis added).
NASHVILLE's suggestion, therefore, that the lack of proximity of the parties' goods or services
should simply be overlooked by the Court is remarkable.

1 support a finding of infringement:²⁰

2 A. Strength of the Mark.

3 NASHVILLE supports its claim that its mark is strong by contending that it is "suggestive"
4 under trademark law. Actually, the Ninth Circuit has made it clear that a trademark which is comprised
5 of the initials of the trademark holder's name is a descriptive mark. *Everest & Jennings, Inc. v. E & J*
6 *Manufacturing Company*, 263 F.2d 254, 259 (9th Cir. 1958); *CD Solutions, Inc. v. Tooker, supra* at 989.

7 The strength of a trademark or tradename is largely determined by its position on a con-
8 tinuum stretching from arbitrary marks to descriptive marks. *Accuride International, Inc v. Accuride*
9 *Corporation*, 871 F.2d 1531, 1536 (9th Cir. 1989). Accordingly, the TNN mark is the weakest type of
10 mark entitled to any trademark protection at all. That hardly supports NASHVILLE's claim of
11 infringement.

12 B. Marketing Channels Used.

13 While both NASHVILLE and NETWORK use the Internet, in part, to market their goods and
14 services, the Internet is a minor marketing tool for both of them, and the only point in common between
15 them in marketing or advertising. Compare *Richards v. Cable News Network, Inc.*, 15 F. Supp. 2d 683,
16 692 (E.D. Pa. 1998) ("A close comparison of the parties marketing and advertising illustrates that the
17 two parties share only one medium in common, the Internet.") Furthermore, saying that both use the
18 Internet as a marketing tool is like claiming that two companies use the telephone or the mail as a
19 marketing tool. That may be true, but if the telephone, mail or Internet is deemed a "marketing channel"
20 without regard to the actual persons to whom the goods or services are being marketed, then the
21 "marketing channel" factor is completely meaningless. It is hard to imagine any two companies which
22 do not both use the telephone or mail to market their products, and very soon it will be difficult to find
23

24 ²⁰ Since the parties marks are for all practical purposes identical, this factor favors NASH-
25 VILLE. However, for the reasons set forth in NETWORK's Summary Judgment Motion (including
26 the fact that at all relevant times NASHVILLE has always used its mark in conjunction with "The
27 Nashville Network" and NETWORK has always used its mark in conjunction with "The Network
28 Network") this factor favors NASHVILLE less than it normally might.

1 any business which does not market its goods or services in some manner on the Internet.

2 NASHVILLE miscites *Brookfield* for the proposition that the mere simultaneous use of the
3 Internet means that the "marketing channels used" factor supports a finding of infringement. To the
4 contrary, the *Brookfield* Court based its conclusion on the fact that "Not only do they compete for the
5 patronage of an overlapping audience on the Web, both 'MovieBuff' and 'Moviebuff.com' are utilized in
6 conjunction with Web-based products." Neither NASHVILLE' nor NETWORK services are Web-based,
7 and they do not complete for the patronage of an overlapping audience.²¹

8 C. Actual Confusion.

9 Despite the fact that NASHVILLE's website is being accessed over a million times
10 every month, and NETWORK's website is being accessed about 37,750 times per month, there are vir-
11 tually no instances in which any individual has gone to the NETWORK's website and confused it for
12 NASHVILLE's website and extremely few instances in which anyone has gone to NETWORK's website
13 hoping to find NASHVILLE's website.²² The instances which NASHVILLE claims demonstrate confusion
14 demonstrate no such thing. With respect to the five Exhibits to Randall Boese's declaration:

15 1. Exhibit K is from an individual who clearly understood that he had not
16 accessed the Nashville Network's website.²³

17
18 ²¹ NASHVILLE suggests that since some people who are interested in country music may
19 coincidentally be interested in computer network consulting services, the markets overlap. Again,
20 if this is sufficient for the marketing channels to be similar, then the factor has no meaning at all. It
21 is difficult to imagine circumstances in which one party's customers might not **coincidentally** be
22 interested in completely unrelated services provided by the other party.

23 ²² The Court must ignore NASHVILLE' suggestion that it "infer" that there are many other
24 unproven instances of confusion, especially in the context of NASHVILLE's summary judgment
25 motion.

26 ²³ The same is true of Exhibit A to the Declaration of Pam Posey, Exhibit A to the Declaration
27 of Alfredo Fraunfelder, and Exhibit A to the Declaration of Eddie Ridgway. *See Washington*
28 *Speakers Bureau, Inc. v. Leading Authorities, Inc.*, 33 F. Supp. 2d 488, 501 (E.D. Va 1999).
(Indeed, it is not completely clear whether the e-mails described expressed actual confusion or
whether the messages were meant to alert WSB that the washingtonspeakers names were being
used by another organization.)

1 2. Exhibit I is a fax from someone who shows no indication of ever having
2 been to either NETWORK's or NASHVILLE's website.

3 3. Exhibit H is from someone who was not able to determine whose website
4 was accessed, and so asked; and

5 4. Exhibits F and G are e-mails from individuals who show no indication of
6 ever having been to either NETWORK's or NASHVILLE's website.

7 Indeed, the only individual who accessed NETWORK's site who claims to have been
8 confused is Gary Peterson, who concedes that all he did was look at the TNN logo and concluded from
9 that that he had reached a site owned and operated by The Nashville Network. Clearly Mr. Peterson
10 made no effort whatever to read anything on the website other than the logo. Mr. Peterson's extreme
11 lack of care hardly demonstrates that the average prudent consumer is likely in any way to be confused.

12 In *Sleekcraft*, the Court observed that evidence of alleged actual confusion was
13 often discounted because it was unclear or insubstantial. *Sleekcraft, supra* at 352. In *Accuride Inter-*
14 *national, Inc v. Accuride Corporation*, 871 F.2d 1531, 1537 (9th Cir. 1989), the Court dismissed as
15 anecdotal and too weak to support a finding of actual confusion evidence which was much, much
16 stronger than that presented by NASHVILLE:

17 ``AII presented the following evidence of actual confusion: (1) AII has been
18 contacted on several occasions regarding `its' recent buyout (the buyout, of
19 course, was of the Firestone Steel Products Division, the predecessor of
20 Accuride Corporation); (2) on at least one occasion, merchandise and
21 invoices intended for Accuride Corporation were delivered to AII; (3) AII
22 field representatives have received phone calls intended for Accuride
23 Corporation; (4) one person interviewing at AII thought it made truck
24 wheels; (5) some individuals thought AII and Accuride Corporation were the
25 same company. The district court concluded that the evidence presented on
26 the actual confusion issue was anecdotal and too weak to support a finding
27
28

1 of actual confusion. This conclusion is not clearly erroneous."

2 The *Accuride* Court also favorably cited the case of *Scott Paper Co. v. Scott's Liquid Gold,*
3 *Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978), for the proposition that "evidence of nineteen misdirected
4 letters over four years is insufficient to establish actual confusion." *Id.* Finally, the Court pointed out that
5 "the evidence presented does not demonstrate the type of confusion that could affect the markets of
6 either party." Even the anecdotal and weak evidence submitted by NASHVILLE shows only a single
7 instance in which an individual looking for NASHVILLE's website failed to locate it.²⁴ The evidence
8 clearly does not demonstrate the type of confusion which could affect the markets of either party.

9 In the recent *Brookfield* case, the Ninth Circuit acknowledges that the mere fact that a
10 person might inadvertently access the wrong website was not evidence of actual confusion within the
11 meaning of the trademark laws:²⁵

12 "If . . . Brookfield and West Coast did not compete to any extent whatsoever, the
13 likelihood of confusion would probably be remote. A Web surfer who
14 accessed 'moviebuff.com' and reached a web site advertising the services of
15 Schlumberger, LTD. (a large oil drilling company) would be unlikely to think
16 that Brookfield had entered the oil drilling business or was sponsoring the oil
17 driller. . . ."

18 In *Interstellar Starship Services v. Epix, Inc.*, 983 F. Supp. 1331, 1336 (D.Or. 1997), the
19 Court dismissed as irrelevant to an infringement claim the possibility that an Internet user might mis-
20 takenly access the wrong website.

21 "While an Internet user seeking to purchase a product of Epix, Inc. may go initially
22

23 ²⁴ Mr. Frauenfelder claims not to have been able to find NASHVILLE's web site in May 1997.
24 That is not particularly surprising since the site only opened on April 14, 1997, and appears not to
25 have been indexed yet in the "search engine" consulted by Mr. Frauenfelder.

26 ²⁵ This is in contrast to "initial interest confusion" discussed below in which parties' goods
27 were "similar enough to . . . that a sizeable number of consumers who were originally looking for
28 Brookfield's product will simply decide to utilize West Coast's offerings instead."

1 to the Interstellar Starship website, an actual or prospective customer of
2 Epix, Inc. could not be confused in its purchasing decision by the name `EPIX'
3 or the words `epix.com' because such a person cannot purchase a circuit
4 board or computer program from `epix.com' and cannot obtain an image of
5 a cast member of the Clinton Street Cabaret from Epix, Inc."

6 As in *Interstellar*, a person going to NETWORK's website cannot obtain any information
7 about country music or country living, or any goods or services in any way related thereto. Likewise, a
8 person going to NASHVILLE's website cannot obtain computer network consulting services. Therefore,
9 an actual or prospective customer could not be confused in its purchasing decisions.

10 *See also CD Solutions, Inc. v. Tooker, supra* at 989. ("While an Internet user seeking to
11 purchase a product of defendants may go initially to the plaintiff's website, it is unlikely that an actual or
12 prospective customer of defendants would be confused in its purchasing decision by the name CDS or
13 the words `cds.com.'").

14 D. Degree of Care Likely To Be Exercised.

15 Surprisingly, NASHVILLE claims that its services should be considered "free
16 information" and uses that to contend that it is unlikely that consumers will exercise a high degree of
17 care in differentiation between NASHVILLE and NETWORK. NASHVILLE is not in the business of
18 providing "free information" but of selling advertising and cable programming (which is sold to cable
19 systems, not to individual subscribers). Both of these products are marketed to sophisticated purchasers.

20 In any event, whether a high degree of care might be exercised is not relevant here.
21 No one can obtain "free information" about cable programming, country music or country living at
22 tnn.com, so no one going to NETWORK's site will obtain such information believing that it came from
23 NASHVILLE or a company associated with NASHVILLE. No matter how you look at this factor, it does not
24 support NASHVILLE's position.

25
26 VIII. INITIAL INTEREST CONFUSION.
27
28

1 NASHVILLE inaccurately claims that "unauthorized use of another's trademark"²⁶ that
2 causes Internet users to mistakenly access a web site . . . gives rise to a claim for trademark infringement
3 under the Latham Act."²⁷ NASHVILLE bases that contention on a trademark doctrine known as "initial
4 interest confusion." NASHVILLE, however, ignores two important requirements for "initial interest
5 confusion," the existence of competition and a specific intent to trade off the competitor's goodwill. In
6 *Brookfield, supra* at 1062, the Court described "initial interest confusion" as follows:

7 "Web surfers looking for Brookfield's 'MovieBuff' products who are taken by a
8 search engine to 'westcoastvideo.com' will find a database similar enough to
9 'MovieBuff' such that a sizeable number of consumers who were originally
10 looking for Brookfield's product will simply decide to utilize West Coast's
11 offerings instead."

12 Web surfers looking for NASHVILLE will not find products or services similar enough at
13 NETWORK's website that anyone (much less a "sizeable number") looking for NASHVILLE will or even
14 could simply decide to utilize NETWORK's services "instead."²⁸ The *Brookfield* Court three times
15 referred to the initial interest confusion doctrine as applying to "competitors." *Id.* at 1064 and 1066.
16 One of these references was in the Court's official holding. *Id.* at 1066. NASHVILLE and NETWORK are
17 clearly not competitors.²⁹

18 Further, the *Brookfield* Court held that an intent to trade off the goodwill of the competitor
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20 ²⁶ Of course, this begs the question of when one has made use of "another's trademark."
21 NETWORK is not using NASHVILLE's trademark any more than NASHVILLE is using NET-
22 WORK's trademark. Each is using its own trademark in connection with its unrelated goods and
services.

23 ²⁷ This contention is contrary to the holdings of the *Brookfield*, *Interstellar*, and *CD's, Inc.*
24 cases discussed immediately above.

25 ²⁸ "Instead" means as a replacement for or in lieu of.

26 ²⁹ Nor are their products related, the minimum requirement for any finding of trademark
27 infringement. See discussion *infra*.

1 is an essential element of "initial interest confusion." Merely taking advantage of a situation in which
2 confusion was likely to exist is insufficient; the accused party must have taken some affirmative act
3 intended to create the confusion. *Id.* at 1065. The use of the trademark must be "in a manner
4 calculated . . . to capture initial consumer attention." *Supra* at 1062. The intent must be "to divert
5 people" looking for the competitor's website. *Id.* The intent must be to "capitalize" on the similarity in
6 marks to "lure" customers onto its web page. *Id.* at 1063. The intent must be to "misappropriat[e]" the
7 competitor's acquired goodwill. *Id.* at 1064. The intent must be to "purposefully divert" individuals
8 from the competitor's website. *Id.* at 1065.

9 Not only is there not a scintilla of evidence that the NETWORK is purposefully diverting
10 NASHVILLE's customers to its website, NASHVILLE cannot even suggest a reason why NETWORK would
11 want to do so. Certainly if NETWORK wanted to divert customers, it would divert them from a site
12 related to computer networks, not a website related to country music.³⁰

13
14 IX. STATE AND FEDERAL UNFAIR COMPETITION CLAIMS.

15 NASHVILLE concedes that its California and Federal unfair competition claims are based
16 upon a likelihood of confusion. As such, they fail for the same reasons that NASHVILLE's trademark
17 infringement claim fails.

18 X. LACHES AND ACQUIESCENCE.

19 As set forth in more detail in NETWORK's summary judgment motion, NASHVILLE knew
20 no later than April 1995 that NETWORK had registered a website at tnn.com. No objection was made by
21 NASHVILLE. Not until December 1997, after NASHVILLE was acquired by CBS, Inc., did CBS, Inc. send a
22

23 ³⁰ Apparently unwilling to risk its own credibility with a frivolous argument as to why
24 NETWORK would have any interest in diverting people from a country music website, NASH-
25 VILLE presents the uninformed, inadmissible and quite frankly ludicrous speculation of "Pam
26 Posey" that NETWORK wanted to increase the number of "hits" on the website showing on its
27 counter. Ms. Posey's speculation begs the question of why NETWORK would want to increase the
28 number of hits showing on its "counter" and why, if it wanted to do so illegitimately, it didn't
simply change the counter manually.

1 letter demanding that NETWORK abandon its website and turn over the tnn.com domain to CBS.

2 NASHVILLE's Points and Authorities and Declarations note that at some point NASHVILLE
3 learned that NETWORK had registered tnn.com as its domain name. See NASHVILLE's OPENING BRIEF,
4 page 1, lines 14 to 17; Declaration of Martin Clayton, ¶ 3. But, NASHVILLE studiously avoids mentioning
5 that this occurred no later than April 1995, and fails to attach to its motion a copy of NASHVILLE's
6 internal memorandum demonstrating such. See DTS, Ex. 5. NASHVILLE cannot sweep this issue under
7 the rug that easily.

8 Laches is a defense to a Federal trademark action, *Brookfield, supra* at 1061, as well as a
9 California trademark or unfair competition action. *Tustin Community Hospital, Inc. v. Santa Ana*
10 *Community Hospital Association*, 89 Cal. App. 3d 889, 153 Cal. Rptr. 76 (4th Dist. 1979).

11 In *Brookfield, Id.*, the Court dealt with a two-year delay between the time the plaintiff
12 learned of the registration of the website, and the time it brought action. The Court strongly suggested
13 that but for the fact that the defendant registered the domain name but did not actually construct a
14 website thereon, the delay would have barred the trademark infringement action:

15 ``Here, although Brookfield waited over two years before notifying West Coast that
16 its intended use of `moviebuff.com' would infringe on Brookfield's
17 trademark, West Coast did not do anything with its domain address during
18 that time, and Brookfield filed suit the very day that West Coast publicly
19 announced its intention to launch a web site at `moviebuff.com'.
20 Accordingly, we conclude that Brookfield's delay was not such that it should
21 be estopped from pursuing an otherwise meritorious claim." Emphasis
22 added.

23 NETWORK established its website at tnn.com soon after its January 1994 registration of
24 the tnn.com website, and has maintained the web site continuously thereafter. DGH ¶ 6. Therefore,
25 when NASHVILLE learned that NETWORK had registered tnn.com, NETWORK had an active website at
26 that location. NETWORK has established in great detail in its summary judgment motion the extreme
27

1 prejudice it would suffer from NASHVILLE's unexplained and unjustified delay if the tnn.com website
2 were taken away from NETWORK.

3 NETWORK has a particularly compelling laches and acquiescence defense with respect to
4 NASHVILLE's dilution claims. "Unlike cases of traditional trademark infringement, in dilution cases
5 there is no strong policy of consumer confusion to weigh against dismissal or narrowing of relief due to
6 the equities created by delay or acquiescence." Furthermore, NASHVILLE claims that the registration of
7 tnn.com is "per se dilution" of its (allegedly) famous trademark. Since NASHVILLE knew of the
8 registration of the trademark in April 1995, it also knew of the alleged "per se dilution" of its famous
9 mark in April 1995. However, it did not even bother to send out a letter of objection, much less take any
10 affirmative steps to protect its alleged famous mark.

11 12 CONCLUSION

13 If the Court makes the following three legal conclusions, each of which is clearly supported
14 herein and in NETWORK's Motion for Summary Judgment, NETWORK is entitled to judgment as a matter
15 of law:

16 A. In a dilution action, fame is tested when the alleged infringer first used the
17 mark;

18 B. California dilution law does not differ with respect to the requirement of
19 fame or when fame should be tested; and

20 C. In an infringement action, goods or services must at least be "related" for
21 any possible infringement to occur.
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If the Court does not make these conclusions, the undisputed facts still clearly indicate that judgment must be entered in favor of NETWORK. NASHVILLE has not even come close to proving a case of either infringement or dilution.

Respectfully submitted,

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

DATED: July 19, 1999

By: _____
Thomas E. Shardlow

1 PROOF OF SERVICE BY MESSENGER

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 July 19, 1999 I served:

9 Plaintiff's Response to Defendant's Motion for Summary Judgment

10 or, in the Alternative, Summary Adjudication of Issues

11
12 on the interested parties in this action by delivering a true copy thereof to Best Plus Messenger Service
13 with instructions to deliver on the date set forth above said document as follows:

14
15 Kelli L. Sager, Esq.
16 Randall Boese, Esq.
17 Davis Wright Tremaine LLP
18 1000 Wilshire Boulevard, Suite 600
19 Los Angeles, California 90017-2463

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

23 Executed on July 19, 1999.

24
25 _____
26 Carol Jarvis