

APPEAL NO. 04-55962

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**IN THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT**

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BOSLEY MEDICAL INSTITUTE, INC.,

Plaintiff and Appellant,

v.

MICHAEL STEVEN KREMER,

Defendant and Appellee.

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On Appeal from a Judgment  
OF THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA  
Case No. 01-CV-1752-WQH  
THE HONORABLE WILLIAM Q. HAYES, JUDGE

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**STATEMENT OF CONSENT PURSUANT TO  
FED. R. APP. P. 29(a)**

Both plaintiff-appellant Bosley Medical Institute, Inc., and defendant-appellee Michael Steven Kremer have consented to the filing of this Brief *Amici Curiae* of Intellectual Property Law Faculty In Support of Affirmance.

## I. INTRODUCTION

The parties listed at Appendix A submit this brief as *amici curiae* supporting affirmance of the District Court's order, which found no basis for applying the Lanham Act to "cybergripping" sites that were "purely noncommercial". *Bosley Med. Inst., Inc. v. Kremer*, No. Civ.01-1752WQHJMA, 2004 WL 964163, at \*5, \*9 (S.D. Cal. Apr. 30, 2004). According to the District Court, the Lanham Act could not apply because "[n]o genuine issues of material fact" existed with respect to the issue of "commercial use": Bosley Medical Institute, Inc. ("Bosley") had no evidence that Michael Kremer's ("Kremer") use of Bosley's marks in the "bosleymedical.com" and "bosleymedicalviolations.com" websites was related to any business purpose. *Id.* at \*9.

The Lanham Act was expressly designed for and has been exclusively applied to commercial contexts. On appeal, Bosley makes several arguments that, if adopted, would abandon this bedrock principle and result in a fundamental misapplication of trademark law.

In particular, Bosley urges this Court to impermissibly circumvent the core concept of commerciality when it argues:



- (a) links from a non-commercial site to an unaffiliated commercial site satisfy the commercial use requirement (Bosley Br. at 28);
- (b) an adverse impact on a trademark owner constitutes commercial use (*Id.* at 29-30); and
- (c) the Lanham Act’s likelihood of confusion requirement is met “as a matter of law” simply by a showing of initial confusion upon accessing a website (*Id.* at 40).

Bosley’s misunderstanding of the dividing line between unauthorized commercial uses of trademarks, which may be actionable, and unauthorized non-commercial uses, which are not, is perhaps most evident in Bosley’s efforts to force this case into the section of the Lanham Act tailored to address cybersquatting, the Anticybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C. § 1125(d).<sup>1</sup> Bosley argues that:

- (d) ACPA does not require use of a mark in connection with the sale of goods or services or some other commercial context (Bosley Br. at 18);

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<sup>1</sup> ACPA was enacted “to protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with the *intent to profit* from the goodwill associated with such marks—a practice commonly referred to as ‘cybersquatting.’” *Sporty’s Farm v. Sportsman’s Mkt.*, 202 F.3d 489, 495 (2d Cir. 2000) (quoting S. Rep. No. 106-140, at 4 (1999)) (emphasis added).

(e) the non-commercial purpose of a website using a domain name is irrelevant to ACPA (*Id.* at 20); and

(f) settlement negotiations constitute a bad faith intent to profit under ACPA (*Id.* at 22-23).

These arguments seriously distort the purpose of the Lanham Act, which is to guard against the misuse of trademarks in ways that are likely to lead to mistaken purchasing decisions. Moreover, Bosley's overbroad approach to commercial use is wholly inconsistent with the First Amendment values that operate to limit the scope of trademark law.

## **II. STATEMENT OF INTEREST**

The amici listed on Appendix A are 15 faculty members who research, teach and write scholarly articles and books about intellectual property and technology at law schools nationwide.<sup>2</sup> None received any compensation for participating in this brief. Amici's sole interest in this case is in the evolution of sound and balanced legal rules for trademark law.

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<sup>2</sup> Amici wish to acknowledge the invaluable assistance of Harvard Law School and Berkman Center Clinical Program in Cyberlaw students Agnes Li, Eric Priest, Parish Sanjanwala, and Thiruvendran Vignarajah in the preparation of this brief.

Amici believe that this brief will assist the Court in its consideration of the legal standards advanced in this case.

### **III. ARGUMENT**

#### **A. The Focus of the Lanham Act Is Quintessentially Commercial.**

The principal evil trademark law was designed to combat is the unfair practice of confusing the public as to the source of goods or services. *See 1 McCarthy on Trademarks and Unfair Competition* § 2:7 (4th ed. 2004) (“[T]rademark law is a species of the generic law of unfair competition.”). Because trademarks developed to help consumers identify the goods of a particular producer in *trade*, they are only protected in commercial contexts. *See, e.g., Indus. Rayon Corp. v. Dutchess Underwear Corp.*, 92 F.2d 33, 35 (2d Cir. 1937) (“The owner of the mark acquires the right to prevent the goods to which the mark is applied from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. There are no rights in a trade-mark beyond these.”).

Congress codified these common law principles in the Lanham Act<sup>3</sup> (“the Act”). *See Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (“The broader law of unfair competition . . . was largely codified in the Trademark Act of 1946 (Lanham Act)”). Whether a claim is brought under the infringement,<sup>4</sup> dilution,<sup>5</sup> or cybersquatting<sup>6</sup> provisions of the Act, the statutory language, legislative history, and historical application of the Act all reveal that the core requirement of commerciality runs throughout the Act’s provisions.

### **1. Trademark Infringement Requires Commercial Use.**

Commercial use always has been the starting point for trademark law:

The Lanham Act seeks to prevent consumer confusion that enables a seller to pass off his goods as the goods of another. . . . [T]he relevant confusion is that which affects the purchasing and selling of the goods or services in question. . . . Trademark infringement protects against mistaken purchasing decisions and not against confusion generally.

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<sup>3</sup> 15 U.S.C §§ 1051-1129 (2004).

<sup>4</sup> 15 U.S.C § 1114 (2004).

<sup>5</sup> 15 U.S.C. § 1125(c) (2004).

<sup>6</sup> 15 U.S.C. § 1125(d)(1) (2004).

*Lang v. Retirement Living Publ'g Co., Inc.* 949 F.2d 576, 582-83 (2d Cir. 1991) (internal citations and quotation marks omitted). Under the Lanham Act's infringement provision, confusion with the plaintiff's mark **must** arise in a commercial context to be actionable. See *Newton v. Thomason*, 22 F.3d 1455, 1463 (9th Cir. 1994) (in a Lanham Act claim, "[t]o raise an inference of a likelihood of confusion, [a plaintiff] must show that, in selecting his name, [defendant] 'intended to **profit** by confusing **consumers**'") (emphasis added) (citing *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 791 n.2 (9th Cir. 1981) ("in order to raise the inference of a likelihood of confusion, a plaintiff must show that the defendant intended to profit by confusing consumers.")); *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 450 (S.D.N.Y. 1982) ("[T]he trademark laws are intended to protect those members of the public who are or may become customers of either from **purchasing the products** of one of them under the mistaken assumption that they are buying a product produced or sponsored by the other."); RESTATEMENT THIRD, UNFAIR COMPETITION, § 20, *cmt b* ("not every instance of potential confusion . . . constitute[s] infringement.")

This requirement flows from the plain language of the Act, which imposes infringement liability on an unauthorized use in commerce of:

(a) . . . any reproduction, counterfeit, copy, or colorable imitation of a registered mark *in connection with the sale, offering for sale, distribution, or advertising of any goods or services* on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . .

15 U.S.C § 1114 (2004) (emphasis added).<sup>7</sup> Accordingly, unless the unauthorized trademark use is in connection with one of those specified commercial activities, it is outside the purview of the statute. Any other result ignores Congress' purpose, which was to provide a remedy against the potential misappropriation of a mark by competitors:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.

S. Rep. No. 1333, at 3 (1946).

The central flaw underlying Bosley's arguments is that trademark law does not prevent all unauthorized uses of a mark. Instead, trademark infringement prevents only unauthorized uses in connection with some form

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<sup>7</sup> The labeling provision in 15 U.S.C. § 1114(b) repeats the same language. *See also* 15 U.S.C. § 1125(a) (prohibiting, *inter alia*, false or misleading descriptions of fact "in connection with any goods or services . . . in commerce.").

of a proposed (or consummated) commercial transaction in which the trademark is being used to confuse potential consumers. “[A trademark] does not confer a right to prohibit the use of the word or words. . . . A trade-mark only gives the right to prohibit the use of it so far as to protect the owner’s good will *against the sale of another’s product as his.*”

*Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.) (emphasis added); *see also United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918) (“[A trademark’s] function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another’s product as his. . . . The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly.”).

## **2. Trademark Dilution Requires Commercial Use.**

In 1996, Congress significantly expanded the scope of federal trademark law when it amended the Lanham Act to add the Federal Trademark Dilution Act (“FTDA”). Although confusion is not an element

of trademark dilution,<sup>8</sup> the FTDA still requires that the allegedly diluting use be commercial:

The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's *commercial use in commerce* of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark . . . .

15 U.S.C. § 1125(c) (2004) (emphasis added).<sup>9</sup> To underscore this point, the FTDA expressly exempts “noncommercial use” of a mark from liability. 15 U.S.C. § 1125(c)(4)(B).

Congress limited liability under the FTDA to commercial uses to avoid giving trademark owners a monopoly in their marks that could conflict with the constitutional right to free speech. “The proposal adequately addresses legitimate First Amendment concerns . . . . The [FTDA] will not prohibit or threaten ‘noncommercial’ expression, as that term has been

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<sup>8</sup> See H.R. Rep. No. 104-374, at 2 (1995) (“The purpose [of the FTDA] is to protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion.”).

<sup>9</sup> The use of the somewhat awkward phrase “commercial use in commerce” underscores that “commercial use” is an additional predicate to liability that exists separately from “use in commerce.” See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (discussing “ungainly” but comprehensible statutory language).



defined by the courts.” H.R. Rep. No. 104-374, at 4 (1995). The Ninth Circuit has defined “commercial speech” for dilution purposes as speech that “does no more than propose a commercial transaction.” *Mattel*, 296 F.3d at 906 (quoting *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quotation marks omitted). Accordingly, in *Nissan Motor Co. v. Nissan Computer Corp.*, this Court found that the defendant’s use of “[n]egative commentary about [plaintiff] does more than propose a commercial transaction and is, therefore, non-commercial.” 378 F.3d 1002, 1017 (9th Cir. 2004).<sup>10</sup>

**B. Efforts To Expand The Definition Of Commercial Use Should Be Resisted.**

**1. Links That Do Not Commercially Benefit A Defendant Cannot Trigger Liability.**

Bosley urges an extremely broad view of commerciality by arguing that a website is commercial if “it contains links to other sites that also

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<sup>10</sup> *Mattel* noted that “commercial” has several possible meanings. For purposes of “commercial use in commerce,” it means that a mark is used to sell goods in the marketplace. *Mattel*, 296 F.3d at 903. This is essentially the same as the “in connection with” requirement for infringement. For purposes of the noncommercial use exception to dilution, “commercial” has the narrower meaning taken from First Amendment cases. *Mattel*, 296 F.3d at 905-06.

contained commercial links.” (Bosley Br. at 33.) Citing *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1019 (9th Cir. 2004), Bosley asserts that Kremer’s link from bosleymedical.com to bosleymedicalviolations.com, and then another, separate link from bosleymedicalviolations.com to an archive of a discussion group related to baldness, constitutes “commercial use.” (See Bosley Br. at 33.)

*Nissan*, however, involved fundamentally different facts. In *Nissan*, the defendant sold advertising space and “received a payment each time a user clicked through to an advertiser’s website.” 378 F.3d at 1007. Consequently, “once nissan.com offered links to auto-related websites,” it stood to benefit financially “because it received money from every click” on those links. *Id.* at 1019.<sup>11</sup>

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<sup>11</sup> The *Nissan* court had no reason to mention indirect, uncompensated, and unaffiliated linking because that was not the case before it. Similarly, Bosley’s reliance on *United We Stand Am., Inc. v. United We Stand Am. N.Y., Inc.*, 128 F.3d 86 (2d Cir. 1997), is entirely misplaced. (Bosley Br. at 29-30.) *United We Stand* holds that a corporation that was “incorporated ‘to solicit, collect and otherwise raise money’” for political causes was providing “services” under its infringing mark and using that mark “in commerce.” 128 F.3d at 90, 92-93. The Second Circuit repeatedly distinguished its holding from the precise issue before this Court: One who uses a mark in connection with commentary on the mark’s owner cannot be liable for infringement. See *id.* at 92-93.

By contrast, Kremer's bosleymedical.com website contains no links at all to sites with any commercial content, but only links to Bosley's official home page, a district attorney's investigation of and other disciplinary proceedings involving Bosley, the Public Citizen website, and Kremer's other site (bosleymedicalviolations.com). The bosleymedicalviolations.com site then contains a link to the hair-loss discussion group, which happens to contain other sponsored links. (See Bosley Br. at 33 (citing Bosley Excerpts of Record ("BEOR") 141; 138)). Kremer is not selling any products or services whatsoever, much less ones that compete with Bosley; he receives no financial support from any banner advertising; and he does not receive any compensation when users click on the link to the newsgroup or any other links on his sites.<sup>12</sup> For these reasons, the District Court found there were no disputed issues of fact and correctly held that Kremer's link to a discussion group simply provided "critical content," not commercial use. *Bosley*, 2004 WL 964163, \*8 (citing *Taubman Co. v. Webfeats* 319 F.3d

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<sup>12</sup> Though the alt.baldspot discussion group archive happens to have sponsors, Kremer "is not engaged in his own business enterprises through his websites." *Bosley*, 2004 WL 964163 at \*8. Neither Kremer's site nor his link has been sponsored by anybody.

770, 775 (6th Cir. 2003) (a website is non-commercial if it contains no advertising, no links to commercial sites and no expressly commercial content)).<sup>13</sup>

This Court should reject Bosley’s unprecedented view of commercial use and adopt that of the Fifth Circuit in *TMI Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004): A site is “noncommercial” when there is no evidence that the website “was ‘in the ordinary course of trade,’ or that it had any business purpose at all,” *id.* at 438, as evidenced by a complete lack of any charges imposed or payments made in connection with its operation.

Conceding that the advocacy group Public Citizen charges Kremer no money for its representation, Bosley nonetheless contends that a link to the group, which provides legal services to defendants like Kremer free of charge, constitutes use of Bosley’s mark in connection with the sale of goods

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<sup>13</sup> Bosley relies heavily on a footnote in *Taubman* stating that direct links to a commercial website would render the linking site commercial. (Bosley Br. at 31.) *Taubman*, however, never discussed unaffiliated, unsolicited links to discussion-group or news sites, and neither it nor *Nissan* supports the obvious consequences of such an approach: A non-commercial website that linked to a news story on the *New York Times* website would be deemed to be commercial because the *Times* runs ads of its own. That is an impermissibly overbroad approach.

and services. (Bosley Br. at 34-35.) As an initial matter, this argument fails for the reason that, as Bosley acknowledges (Bosley Br. at 35), it presented no evidence of any *quid pro quo* between Public Citizen and Kremer in which Kremer traded advertising for representation.

The Public Citizen argument also suffers from a more fundamental flaw. There is no principled distinction to be drawn between a narrative, factual statement by Kremer on his website that Public Citizen represents him—which plainly would not render his site commercial—and the presence of a Public Citizen banner and html code that creates a link to Public Citizen’s website. Anyone visiting Kremer’s site could, a moment after reading that narrative statement, use a search engine to find the Public Citizen site and thus be exposed to Public Citizen’s independent solicitations for contributions. Code does not trigger the Lanham Act; rather, the question is whether Kremer used Bosley’s mark to sell or advertise goods or services. Accordingly, had Public Citizen paid Kremer to advertise on Kremer’s site even *without* an html link, Kremer could have been found to

have engaged in commerce.<sup>14</sup> It is the complete absence of any evidence of such a commercial relationship in this case that matters, not the link.

Finally, it is worth emphasizing that how Public Citizen arranges its own financial affairs is irrelevant to whether Kremer is being compensated or whether *Kremer's* website is commercial. Bosley's suggestions to the contrary have chilling implications for pro bono advocacy groups. *Cf. NAACP v. Button*, 371 U.S. 415, 420-22, 429-31 (1963) (discussing NAACP's financial arrangements for financing lawsuits and holding that its pro bono representation of clients was political speech and association protected by the First Amendment).

## **2. Adverse Effects Cannot Constitute Commercial Use.**

Bosley argues for an “effect on commerce” test, under which the non-commercial use of a mark would be transformed into a commercial use because of its potential impact on commerce. (Bosley Br. at 29-30.) This Court already has rejected that approach.

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<sup>14</sup> Whether Kremer used *Bosley's* mark in connection with goods or services would still be a separate issue in such a case.

In *Nissan Motor Co.*, faced with an argument that “disparaging remarks or links to websites with disparaging remarks at nissan.com is commercial because the comments have an effect on [Nissan Motor’s] own commerce,” this Court emphasized that it had “never adopted an ‘effect on commerce’ test to determine whether speech is commercial and decline[d] to do so [now].” 378 F.3d at 1017 (citing *CPC Int’l, Inc. v. Skippy Inc.*, 214 F.3d 456, 461-63 (4th Cir. 2000)).

The First Circuit also has rejected the effects test, explaining that if a trademark owner could “enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.” *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987); *see also Ford Motor Co. v. 2600 Enters.*, 177 F. Supp. 2d 611 (E.D. Mich. 2001) (rejecting the commercial harm theory because it is over-expansive). As the *Nissan* panel noted, it is critical that trademarks not be “transformed from rights against unfair competition to rights to control language.” *Nissan*, 378 F.3d at 1017 (quoting *Skippy*, 214 F.3d at 462 (quoting Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1710-11 (1999)) (internal

quotation marks omitted)). Indeed, this Court held years ago that “[m]uch useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.” *New Kids on the Block v. New Am. Publ’g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992).

Despite this Court’s clear refusal to adopt an “effects” test, Bosley relies on *People for the Ethical Treatment of Animals (PETA) v. Doughney*, 263 F.3d 359 (4th Cir. 2001), to argue that “the infringer [does not need to use] . . . the mark for his own commercial benefit in order to fall within the proscriptions of the Lanham Act. . . . [He] ‘need[s] only have prevented users from obtaining or using [plaintiff’s] goods or services.’” (Bosley Br. at 30-31 (quoting *PETA*, 263 F.3d at 365)). The outdated and substantially flawed *PETA* rationale should be rejected for two reasons. First, as the *Nissan* court recognized, it is incorrect to presume, as *PETA* does, that potential harm to a commercial entity renders the offending conduct commercial. Such an overbroad view would make any negative product review “commercial.”



Second, *PETA* relied heavily on another presumption that is simply outmoded today. *PETA* assumed, without evidence, that Internet users would readily give up trying to find a business' website if their first guess about the domain name was wrong. This concern, expressed primarily at a time when courts (and consumers) were significantly less experienced with and sophisticated about the Internet, today lacks whatever empirical foundation it might once have had. See Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L.J. [] (forthcoming 2005) (currently available at <http://law.marquette.edu/goldman/deregulatingrelevancy.pdf>).

This Court recognized in *Nissan* that a consumer who clicked on nissan.com expecting to find Nissan automobiles but instead found information on computers ““would realize in one hot second that she was in the wrong place and either guess again or resort to a search engine to locate”” the site she was seeking. 378 F.3d at 1019 (quoting *Interstellar Starship Servs. v. Epix, Inc.*, 304 F.3d 936, 946 (9th Cir. 2002); see also *Chatam Int’l Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 559 & n.17 (E.D. Pa. 2001) (““Thousands of Internet users every day take a stab at what they think is the most likely domain name for a particular website.’ . . . Internet surfers

are inured to the false starts and excursions awaiting them in this evolving medium.”) (quoting *Network Network v. CBS Inc.*, No. CV 98-1349 NM(ANX), 2000 WL 362016, at \*5 (C.D. Cal. Jan. 18, 2000)). That is especially true here, because both of Kremer’s challenged sites display, near the top of the first page of each, a direct link to the trademark owner’s official site as well as “a prominent disclaimer.” 2004 WL 964163, \*6; Kremer Excerpts of Record at 79, 126. These features, like the direct link and disclaimer cited by the court in *Taubman*, 319 F.3d at 777, remove any risk of consumers giving up on finding Bosley’s site in “anger, frustration, or the belief that [Bosley’s] home page does not exist.” *PETA*, 263 F.3d at 370. By contrast to Bosley’s unsupported inference of harm, confining the Act to commercial contexts avoids the need for speculation about commercial “effects.”

### **3. Initial Interest Confusion Must Be Linked to a Commercial Context.**

Perhaps most inconsistent with fundamental trademark principles is Bosley’s argument that the likelihood of initial interest confusion, even if it occurs in a non-commercial context, is sufficient for Lanham Act liability. (Bosley Br. at 39-40.) Because the Act prohibits only confusion in a

commercial context, other forms of confusion, whether fleeting or long-lasting, cannot constitute a trademark violation if divorced from a proposed commercial transaction. Even assuming that initial interest confusion has any bearing at all on the outcome of this case, the doctrine is concerned solely with the overall *likelihood* of confusion, and should not be used, as Bosley would have it, to circumvent the separate and independent requirement of commerciality.<sup>15</sup>

This point was made in *Nissan*, when the Court held that “[t]o evaluate the likelihood of confusion, including initial interest confusion, the so-called Sleekcraft factors provide non-exhaustive guidance.” 378 F.3d 1002 at 1018 (citation and internal quotation marks omitted). For that reason, Bosley’s argument that “the Lanham Act’s likelihood of confusion requirement is met in connection with a domain name when there is

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<sup>15</sup> This brief does not address whether the initial interest confusion doctrine ought to have any application here, or in any other case, where consumers were “not hijacked or misdirected elsewhere.” See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1036 (9th Cir. 2004) (Berzon, C.J., concurring) (inviting reexamination of the doctrine, as applied in *Brookfield Communications, Inc. v. West Coast Entertainment, Corp.*, 174 F.3d 1036 (9th Cir. 1999)). In this regard, however, it should be reemphasized that Kremer’s websites provide links directly to Bosley’s official home page.

likelihood of initial interest confusion” tells only half the story. (Bosley Br. at 39.) The confusion must be in the context of some proposed commercial transaction of goods or services that appears on the accused website.

*Nissan* does not stand alone. In *Interstellar Starship*, initial interest confusion involving websites that did not sell any product or service was again distinguished from those situations (more closely linked to the origins of the doctrine<sup>16</sup>) involving competing products or other commercial contexts:

Overall, ***the ISS website had little to do with commerce***. The website contained no contact information for ISS or Tchou, and it was otherwise unable to interface with users. Indeed, Epix adduced no evidence that ISS or Tchou ever sold any product or service through its website. ***Under these circumstances, we discern no likelihood of consumer initial interest confusion.***

304 F.3d at 946 (emphasis added). Other courts agree. See *Chatam Int’l Inc.*, 157 F. Supp. 2d at 558 (“Where companies are non-competitors, initial interest confusion does not have the same consequence, because there is no substituted product to buy from the junior user, and the senior user does not bear the prospect of harm. Initial interest confusion can be viewed as a

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<sup>16</sup> See *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331 (2d Cir. 1975).

variation on the practice of the ‘bait and switch.’”) (internal citations and quotation marks omitted); *see also Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1120 (D. Minn. 2000) (finding initial interest confusion inapplicable where protest site provided no “financial[]” or “commercial[]” benefit to defendant; he was seeking to attract attention to criticize, not to compete, and therefore “while defendant may arguably be trying to ‘bait’ Internet users, there is no discernable ‘switch’”).

In short, if initial interest confusion has any role at all in this context, it is as a probative factor in a likelihood of confusion analysis, but only in a case where related or competing goods are involved. *Checkpoint Systems, Inc. v. Check Point Software Tech’s, Inc.*, 269 F.3d 270, 294 (3d Cir. 2001). It does not stand alone as the basis for infringement liability, nor does it provide any reason to abandon basic concepts of commerciality. *See* Michael Grynberg, *The Road Not Taken: Initial Interest Confusion, Consumer Search Costs, and the Challenge of the Internet*, 28 Seattle U. L. Rev. 97, 103, n.35 (2004).

**C. ACPA Does Not Alter The Lanham Act’s Commercial Character.**

The linchpin of this appeal is Bosley’s desire to have ACPA apply absent a classically commercial context. (Bosley Br. at 18.) Bosley argues that the commerciality requirement under ACPA can be satisfied even though the defendant is not using the mark commercially: “The infringer need not be using the mark for his own commercial benefit in order to fall within the proscriptions of the Lanham Act.” (Bosley Br. at 29.) Such a rule would eviscerate the traditional commercial use requirement that prevents trademark owners from enjoying unfettered monopolies in their marks and trampling First Amendment rights.

**1. ACPA Requires Intent To Profit Financially.**

The plain text of the statute, the legislative history and court decisions applying ACPA illustrate why Bosley’s efforts should be rejected. ACPA states:

A person shall be liable in a civil action by the owner of a mark . . . if, without regard to the goods or services of the parties, that person

(i) has a bad faith intent to *profit* from that mark . . . ; and

(ii) registers, traffics in, or uses a domain name [that is confusingly similar to another’s mark or dilutes another’s famous mark].

15 U.S.C. § 1125(d)(1)(A) (2004) (emphasis added). ACPA’s use of the words “bad faith intent to *profit*” serves the same function, in the specific context of cybersquatting, as the other commerciality requirements in the Act. It makes clear that the law targets *commercial trafficking* in domain names.<sup>17</sup>

ACPA is limited in its scope because Congress sought to prohibit very specific kinds of conduct, namely, the registration of others’ distinctive marks as domain names (1) with the intention of selling them to the trademark owners at a profit (typically engaging in wide-scale domain name arbitrage); (2) “to warehouse those marks with the hope of selling them to the highest bidder, whether it be the trademark owner or someone else”; (3) “to prey on consumer confusion by misusing the domain name to divert customers from the mark owner’s site to the cybersquatter’s own site, many of which are pornography sites that derive advertising revenue based on the number of visits, or ‘hits,’ the site receives”; or (4) to “defraud consumers, including to engage in counterfeiting activities.” S. Rep. No. 106-140, at 5-6 (1999). Under any of these scenarios, a cybersquatter stands to profit

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<sup>17</sup> See *supra* note 1 (quoting legislative history).

financially from registering another's mark as a domain name, therefore satisfying the commercial use requirement of ACPA.

## **2. The Non-Commercial Purpose Of A Website Is Crucial To ACPA Analysis.**

Bosley's argument that the purpose of a website should not be considered when looking at the issue of bad faith for ACPA purposes is incorrect. (Bosley Br. at 20.) ACPA expressly lists, as a factor disproving bad faith intent to profit, the "bona fide noncommercial or fair use of the mark in a site accessible under the domain name."<sup>18</sup> 15 U.S.C.

§ 1125(d)(1)(B)(i)(IV). Just as the FTDA exempts noncommercial use of a mark, Congress included this factor to underscore its intention that ACPA not reach non-commercial uses of a mark, and to preserve the public's constitutional right to use a mark for criticism and other forms of free expression: "[N]oncommercial uses of a mark, such as for comment,

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<sup>18</sup> Other factors could apply if the registrant were using the domain name commercially, but in a way that demonstrated good faith, e.g., a domain name containing "apple" used to sell fruit instead of computers. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(III). Noncommercial use without an intent to profit is dispositive in this case even though ACPA lists other factors for courts to consider where applicable: Obviously, noncommercial use and good faith commercial use are mutually exclusive, yet a court is not required to weigh inapplicable factors against a registrant.



criticism, parody, news reporting, etc . . . are beyond the scope of the [ACPA's] prohibitions . . . ." S. Rep. No. 106-140, at 9 (1999). Ignoring the non-commercial nature of Kremer's use would ride roughshod over Congress' express direction as to when the ACPA is inapplicable.

Adhering to the statutory text and legislative intent, in *TMI, Inc. v. Maxwell*, 368 F.3d 433, 438 (5th Cir. 2004), the Fifth Circuit found that ACPA could not be applied to a gripe site with a domain name (trendmakerhome.info) substantially similar to the trademark holder's mark and domain (trendmakerhomes.com) where the plaintiff failed to show that the defendant had "engaged in the business of selling domain names," that the defendant's use was "in the ordinary course of business," or that it "had any business purpose at all." 368 F.3d at 438. The court found no commercial use existed, even though the site included an electronic bulletin board on which readers could provide information about the plaintiff's competitors. *Id.* Central to the court's decision was that the defendant "never accepted payment for a listing on the [bulletin board], and he charged no money for viewing it . . . [and there was no evidence that he] had any intent to ever charge money for using the site," *id.*, and "the site's purpose as a method to inform potential customers about a negative experience with the

company is key.” *Id.* at 439. Like the disgruntled customer in *TMI*, Kremer simply did not engage in the kind of trafficking ACPA was designed to address. *See Lucas Nursery & Landscaping v. Grosse*, 359 F.3d 806, 810-11 (6th Cir. 2004) (finding no bad faith on the part of a dissatisfied consumer who registered business’ name as domain name “in the spirit of informing fellow consumers about the practices of a . . . company she believed had performed inferior work,” as distinguished from “[t]he paradigmatic harm that the ACPA was enacted to eradicate—the practice of cybersquatters registering several hundred domain names in an effort to sell them to the legitimate owners”). Accordingly, Bosley’s effort to excise the requirement of commerciality from ACPA should be rejected.

The outer limits of an arguably proper application of ACPA are suggested by *Coca-Cola Co. v. Purdy*, 382 F.3d 774 (8th Cir. 2004). There, the defendant registered multiple domain names that were substantially the same as certain famous trademarks and linked them to anti-abortion websites which directly solicited monetary contributions and sold anti-abortion merchandise; although the opinion is unclear, Purdy may not have had any financial connection to those sites. *Id.* at 779-80. The court found, however, among other indicia of bad faith, that, far from being a dissatisfied customer

like Kremer, Purdy had registered multiple names and that his offer to stop using some of the names in exchange for space on the editorial page of the *Washington Post* satisfied the “intent to profit” requirement, because profit includes “an attempt to procure an advantageous gain or return.” *Id.* at 786 (citation and quotation marks omitted). In that regard, the court expressly noted that the “*monetary value*” of such access to space in a major newspaper “could be significant.”<sup>19</sup> *Id.* (emphasis added).

Although an offer to transfer a domain name in return for something of monetary value plainly can violate ACPA in the same way as an attempt to sell it for cash, non-monetary “gain” is utterly unrelated to the concept of “profit.” Kremer, like any critic, surely obtains satisfaction from informing others about Bosley’s legal and disciplinary problems and Kremer’s own negative experiences with Bosley, but he receives no pecuniary benefit; any

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<sup>19</sup> The court also expressly distinguished *TMI* and *Lucas Nursery* on the grounds that neither of those cases involved an offer to transfer domain names “in exchange for valuable consideration.” *Purdy*, 382 F.3d at 787.

interpretation to the contrary would read “intent to profit” out of the statute.<sup>20</sup>

### 3. Settling A Dispute Is Not Commercial.

Accepting as true that Kremer stated to Bosley that he would use the Internet to criticize Bosley’s business, the District Court nonetheless concluded those statements contained “no mention of Kremer’s websites and no offer to sell the domain names” and thus were insufficient evidence of intent to profit. *Bosley*, 2004 WL 964163 at \*9. Kremer’s “letter,” which discusses Kremer’s substantive complaints and how he planned to publicize them, not the domain names he planned to use, BEOR at 87, 117, appears insufficient to allow a reasonable trier of fact to conclude that Kremer attempted to hold either domain name hostage for profit.

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<sup>20</sup> *Purdy* quoted legislative history stating that noncommercial or fair use of a mark in a website’s content “does not necessarily” indicate a lack of a bad faith intent to profit. *See Purdy*, 382 F.3d at 778. But that legislative history addresses cases in which a cybersquatter posts criticism not because he believes it but because he wants to make a domain name sale more attractive and thus a bad faith *intent to profit* is still present. *See* S. Rep. No. 106-140, at 8-9 (1999); H.R. Rep. No. 106-412, at 11 (1999). The expression of true consumer dissatisfaction is not evidence of an intent to profit.

Even had Kremer made an offer to sell the contested domain names to the trademark holder as part of an effort to settle an ongoing dispute, this, without more, would not automatically satisfy ACPA's bad faith requirement: "While offers to sell a contested domain name may in certain circumstances be probative evidence of bad faith, *see Panavision Int'l L.P. v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998), here, the offer to sell came from [the defendant's] attorney in the context of settlement negotiations after the commencement of litigation." *Interstellar Starship Servs. v. Epix, Inc.*, 304 F.3d 936, 947 (9th Cir. 2002) (citations omitted). There are important practical and policy reasons to distinguish such overtures from the extortionate land-grab perpetrated by paradigmatic cybersquatters. *See id.*; *see also Toeppen*, 141 F.3d at 1325; *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 880 (9th Cir. 1999); *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003). This Circuit should not endorse the troubling circularity raised by equating a trademark defendant's effort to settle an ongoing dispute with a cybersquatter's extortionate behavior.

**D. The First Amendment Precludes Broader Application Of The Lanham Act.**

Bosley's efforts to induce this Court to apply the Act to gripe sites that deliver no financial benefit to the registrant raise serious constitutional concerns. This Court should eschew such an interpretation of the Act, especially when that interpretation finds no support in the plain language, purpose or principles of the Act. *See Ashwander v. Tenn. Valley Auth.*, 297 U.S. 288, 348 (1936) (Brandeis, J., concurring) ("When the validity of an act of the Congress is drawn in question, and even if a serious doubt of constitutionality is raised, it is a cardinal principle that this Court will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided.") (internal quotation marks and citations omitted).

Although a full recitation of the constitutional conflicts that would result from Bosley's approach is beyond the scope of this brief, two points are worth noting. First, an individual's right to criticize a commercial entity has long been protected under the First Amendment. *See, e.g., Bakery and Pastry Drivers, Local 802 v. Wohl*, 315 U.S. 769 (1942). For that reason, a website that proposes no commercial transaction deserves the full protection of the First Amendment, especially when the domain name at issue assists a

dissatisfied customer in reaching other potential customers. *Nissan*, 378 F.3d at 1017.<sup>21</sup>

Second, courts have acknowledged that “domain names may be sufficiently expressive to constitute protected speech.” *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 588 (2d Cir. 2000). In cases like this, where a website’s content erases any possible confusion, a domain name substantially identical to the mark may be essential to the expressive message insofar as it ensures that the protester’s complaints reach the intended audience. In that sense, it is analogous to a particular piece of ground from which protestors wish to broadcast their message to best target the appropriate audience. “It is well established that the location of a demonstration may be ‘an essential part of the message sought to be

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<sup>21</sup> For First Amendment purposes, courts could distinguish between a dissatisfied customer’s use of a mark to criticize the trademark holder and use “to attract an unwitting and possibly unwilling audience” for non-commercial speech unrelated to the trademark holder. *Cf. Coca-Cola v. Purdy*, 382 F.3d 774, 787 (8th Cir. 2004). Yet even unrelated non-commercial content may merit full First Amendment protection: use of the domain name supportstarwars.com in a political context, like the use of that trademark in offline political discourse, should not be suppressed. *See, e.g., Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934 n.2 (D.D.C. 1985) (rejecting liability for use of “Star Wars” in political debate).

conveyed,’ as well as ‘essential to communicating with the intended audience.’” *Coalition to Protest Democratic Nat. Convention v. City of Boston*, 327 F. Supp. 2d 61, 72 (D. Mass. 2004) (quoting *Nationalist Movement v. City of Boston*, 12 F. Supp. 2d 182, 192 (D. Mass. 1998)). The Supreme Court articulated long ago the basic principle on which this reasoning rests: “[O]ne is not to have the exercise of his liberty of expression in appropriate places abridged on the plea that it may be exercised in some other place.” *Schneider v. New Jersey*, 308 U.S. 147, 163 (1939). Cybergripping is an inexpensive and effective way to convey complaints about a business to the very audience the protester seeks to reach. *Cf. Martin v. City of Struthers*, 319 U.S. 141, 144 (1943) (“[D]oor to door distribution of circulars is essential to the poorly financed causes of little people.”). Courts should be careful not to circumscribe those communications.



#### IV. CONCLUSION

For the foregoing reasons, *amici curiae* intellectual property law faculty respectfully request that this Court uphold the District Court's grant of summary judgment in favor of appellee Kremer.

Dated: November 2, 2004

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE PURSUANT TO  
FED. R. APP. P. 21(a)(7)(C)**

I certify, pursuant to Fed. R. App. P. 32(a)(7)(C) and Ninth Circuit Rule 32-1, that the attached Brief *Amici Curiae* of Intellectual Property Law Faculty Supporting Affirmance is proportionally spaced, has a typeface of 14 points, and contains 6,906 words (based on Microsoft Word 2002, the word processing system used to prepare the brief), exclusive of the tables, certificates, Appendix, and cover.

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**APPENDIX A**

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## CERTIFICATE OF SERVICE

I, Phillip R. Malone, hereby certify that I am a member of the bar of this Court. On November 2, 2004, I caused the attached Brief *Amici Curiae* of Intellectual Property Law Faculty Supporting Affirmance to be filed by causing it to be delivered to the United States Postal Service for Express Mail overnight delivery, and to be served by First Class U.S. Mail, pursuant to Fed. R. App. P. 25(c), to counsel for plaintiff-appellant Bosley Medical Institute, Inc., at the following addresses:

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