

For opinion see [159 F.3d 1351](#)

United States Court of Appeals,
Third Circuit.

JEWS FOR JESUS, Appellee,

v.

Steven C. BRODSKY, Appellant.

No. 98-6031.

May 29, 1998.

On Expedited Appeal from an Interlocutory Order Pursuant to [28 U.S.C. 1292\(a\)\(1\)](#),
United States District Court, District of New Jersey 98-CV-274 (Hon. Alfred J.
Lechner, U.S.D.J.)

Reply Brief of Appellant Steven C. Brodsky

Of Counsel: [Murray J. Laulicht](#), [Michael J. Dunne](#), On the Brief: [Ronald D. Coleman](#).

Pitney, Hardin, Kipp & Szuch, P.O. Box 1945, Morristown, New Jersey 07962, Attorneys for Appellant Steven C. Brodsky.

***i TABLE OF CONTENTS**

TABLE OF AUTHORITIES ... ii

PRELIMINARY STATEMENT ... 1

LEGAL ARGUMENT ... 5

I. AN INJUNCTION FORBIDDING THE USE OF A COMBINATION OF WORDS DESCRIBING A TOPIC OF PUBLIC AND RELIGIOUS INTEREST AS THE NAME OF AN INTERNET WEBSITE VIOLATES THE FIRST AMENDMENT ... 5

II. THE DISTRICT COURT IMPROPERLY CURTAILED APPELLANT'S FIRST AMENDMENT RIGHTS WHILE UNDULY EXTENDING THE SCOPE OF APPELLEE'S CLAIMED TRADEMARKS IN RULING THAT AN UNREGISTERED COMBINATION OF WORDS DESCRIBING A TOPIC OF PUBLIC AND RELIGIOUS INTEREST, USING UNSTYLIZED ELEMENTS OF A STYLIZED REGISTERED MARK, MAY NOT BE USED BY APPELLANT AS THE NAME OF HIS INTERNET WEBSITE ... 13

III. APPELLANT'S USE OF AN UNREGISTERED WORD COMBINATION TO PROMOTE HIS RELIGIOUS POINTS OF VIEW ON THE INTERNET, AND TO PROVIDE ACCESS TO A NON-PROFIT, NON-COMMERCIAL WEBSITE SHARING HIS VIEWS, IS NOT COMMERCIAL SPEECH UNDER THE ANTI-DILUTION ACT ... 17

IV. THE PHRASE "JEWS FOR JESUS" IS GENERIC AS APPLIED TO JEWS WHO ARE FOR JESUS ... 19

V. THE DISTRICT COURT ABUSED ITS DISCRETION BY ISSUING A PRELIMINARY INJUNCTION DESPITE APPELLEE'S FAILURE TO MEET ITS HEAVY BURDEN OF PROVING A REASONABLE LIKELIHOOD OF CONFUSION SUFFICIENT TO OVERCOME APPELLANT'S RIGHTS UNDER THE FIRST AMENDMENT ... 21

CONCLUSION ... 24

***ii** TABLE OF AUTHORITIES

CASES

A.J. Canfield Co. v. Honickman, 808 F.2d 291 (3rd Cir. 1986) ... 20

American Civil Liberties Union v. Miller, 977 F. Supp. 1228 (N.D. Ga. 1997) ... 17

American Home Products v. Barr Laboratories, 834 F.2d 368 (3rd Cir. 1987) ... 12, 24

Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316 (4th Cir.), cert. denied, 506 U.S. 872 (1992) ... 14

Armstrong Cork Co. v. World Carpets, Inc., 76 F.R.D. 613 (N. D. Ga. 1977) ... 20

Board of Airport Commissioners of the City of Los Angeles v. Jews for Jesus, Inc., 482 U.S. 569 (1987) ... 8

Cardtoons, L.C. v. Major League Baseball Players Assoc., 95 F.3d 959 (10th Cir. 1996) ... 6, 7, 8, 12

Chicago Reader, Inc. v. Metro College Publishing, 222 U.S.P.Q. 782 (7th Cir. 1980) ... 4

Cincinnati v. Discovery Network, Inc., 507 U.S. 410 (1993) ... 17

Cohen v. California, 403 U.S. 15 (1971) ... 8

Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 924 F. Supp. 1559 (S.D. Cal.), aff'd, 109 F.3d 1394 (9th Cir.), cert. dismissed, 118 S. Ct. 27 (1997) ... 18

Girl Scouts v. Personality Posters Mfg. Co., Inc., 304 F. Supp. 1228 (S.D.N.Y. 1969) ... 13, 22, 23

In re Electrolyte Laboratories, Inc., 929 F.2d 645 (Fed. Cir. 1990) ... 14

In re K-T Zoe Furniture, 16 F.3d 390 (Fed. Cir. 1990) ... 4

Jews for Jesus, Inc., v. Massachusetts Bay Transp. Auth., 984 F.2d 1319 (1st Cir. 1993) ... 8

*iii *Leejay v. Bed Bath & Beyond*, 942 F. Supp. 702 (D. Mass. 1996) ... 20

Lucasfilm Ltd. v. High Frontier, 622 F. Supp. 931 (D.D.C. 1985) ... 19

Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir.), cert. denied, 488 U.S. 933 (1998) ... 6, 7

Natural Footwear, Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383 (3d Cir. 1984) ... 13, 15, 17, 20

New York Times v. Sullivan, 376 U.S. 254 (1964) ... 11, 17

Park N Fly Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985) ... 16

Planned Parenthood Fed'n of America, Inc. v. Bucci, 42 U.S.P.Q. 2d 1430 (S.D.N.Y.), aff'd unpublished table decision, No. 97-7492 (2d Cir. 1998) ... 5

Revlon Consumer Products Corp. v. Jennifer Leather Broadway Inc., 858 F. Supp. 1268 (S.D.N.Y.), aff'd, 57 F.3d 1062 (2d Cir. 1995) ... 12

Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) ... 7, 8, 9, 10 11

Rosen v. Port of Portland, 641 F.2d 1243 (9th Cir. 1981) ... 8, 15

San Francisco Arts & Athletics, Inc. v. United States Olympic Committee, 483 U.S. 522 (1987) ... 12

Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902 (9th Cir. 1995) ... 21

United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86 (2d Cir. 1997) ... 18, 19

Weiss Assoc., Inc. v. HRL Assoc., Inc., 902 F.2d 1546 (Fed. Cir. 1990) ... 22

STATUTES

15 U.S.C. § 1111 ... 14

15 U.S.C. § 1125 ... 19

*1 PRELIMINARY STATEMENT

Appellee's brief is of a piece with the shell game it has played with its own self-described stylized trademark - JEWS F*R JESUS - since even before this litigation began. Appellant Steven Brodsky's Appeal Brief ("Brief") set forth eight issues for consideration on this appeal, each addressing a critical finding made by the District Court. Appellee conflates these eight issues into only two, thereby evading careful legal analysis and instead painting an impressionistic "rough justice" picture. Its subject is Steven Brodsky's too-effective criticism of ap-

pellee's message. The Constitution, and the law of trademark, are left barely discernible and facts that do not suit appellee's vision are either distorted or painted out of its Opposition Brief ("Opp. Br."). Therefore, before replying to the legal arguments that appellee did bother to address, it is necessary to correct some of the most egregious misstatements in that brief.

Mr. Brodsky's Alleged Statements Appellee sets forth various purported quotes from Steven Brodsky, supposedly as proof of Mr. Brodsky's intent to deceive. Opp. Brief at 11-12. As set forth below, momentary confusion or association do not ineluctably lead to actionable deception; nor does the First Amendment automatically cease to exist where confusion is asserted. Yet even then, most of the "statements" set forth in the Opposition Brief are innocuous, such as "See how I'm fighting back" and "(Jews for Jesus] rubs me the wrong way." Opp. Brief. at 11. Other supposed Brodsky statements cited by appellee, however, are doubtless pure *2 expressions of his intent - intent, that is, to exercise his constitutional right to freedom of conscience and expression. Thus: "I thought I could offer an educational counterpoint against their lies"; "I figure if I can save one person from switching over to those guys [Christianity], I'd be very happy"; "[I want] confused Jews looking for answers to know that there is someone to help people if they're confused." Opp. Brief. at 12.

That appellee puts forth these "statements" as proof speaks volumes about what this case is really about. It is not about trademarks. Rather, the gravamen of Mr. Brodsky's supposed offense is "providing these Internet users with information that is antiJews for Jesus and antithetical to the Jews for Jesus message and mission." Opp. Brief at 13 (emphasis added).

The Stylized Mark The "Federal mark" referred to in the letter sent by appellee's lawyer to Mr. Brodsky before this suit was instituted is the stylized mark JEWS F*R JESUS, complete with the critical Star of David, as registered and as indicated on the organizational stationery. A054. Appellee never advised Mr. Brodsky of any "plain type" mark. [FN1] His written response to the effect that he was not using the stylized mark, only the plain words, was evaded. A055. The District Court held that appellee's only registered mark is the stylized mark, JEWS F*R *3 JESUS. A355, A396.

FN1. Though appellee now says the JEWS F*R JESUS mark is not a stylized mark, it twice described its registered mark as "stylized" (without qualification) in its own Complaint, A011 (¶ 15), and in its current motion in this Court. Furthermore, its associate executive director called JEWS F*R JESUS a "stylized service mark" in two sworn affidavits. A063, A107.

Internet Traffic to the Subject Site Appellee suggests various reasons for the heavy Internet traffic to Steven Brodsky's original jewsforjesus.org website, in order to discount the most likely one, which is that people wanted to read what Mr. Brodsky had to say if they could find his site. Appellee notes that there was

a lot of publicity about the website. Appellee also acknowledges the plain truth that if Mr. Brodsky cannot use an accurate description of the topic of his site, he will have less traffic - precisely the First Amendment harm he is suffering. Opp. Brief at 19. But most interesting is the suggestion that "as demonstrated by the affidavits plaintiff filed in support of the injunction motion ... a significant percentage of the site's hits were undoubtedly confused Internet users looking for the actual Jews for Jesus website ..." Opp. Brief at 19.

What is a "significant percentage"? Mr. Brodsky reported an average of 110 hits per day over 54 days, amounting to approximately 5,940 hits. A466-67. (The actual number of total hits is much higher, probably double or more, but as a result of appellee's actions the number of hits before January 30, 1998 was rendered unavailable to Mr. Brodsky. A467.) Appellee submitted three affidavits (Kalstein, Chellathurai and Sanchez) in support of its injunction application. [FN2] It claims these affidavits, contrary *4 to their plain meaning and regardless of their obvious bias, demonstrate confusion. Taking appellee at its word, however, the evidence indicates a "confused" user ratio of three out 5,940, or .000505%. This is not, despite appellee's claim, "significant."

FN2. The Sanchez affidavit was not part of the original TRO application. A059. Appellee did not serve the Sanchez affidavit until 2:30 p.m. the day before the District Court hearing, well after Mr. Brodsky's opposing papers had been filed. A273, A505. It was nonetheless considered by the District Court. A402.

The False Waiver Appellee implies that Mr. Brodsky is propounding novel legal arguments on appeal. This is plainly false. Appellee insists that two compelling cases cited by Mr. Brodsky for the proposition that a stylized mark is not afforded protection beyond its stylized form were not cited, or only belatedly cited, by Mr. Brodsky. Opp. Brief at 26. In fact, these cases, *In re K-T Zoe Furniture*, 16 F.3d 390 (Fed. Cir. 1990), and *Chicago Reader, Inc. v. Metro College Publishing*, 222 U.S.P.Q. 782 (7th Cir. 1980), were cited in the opposition brief filed below by Mr. Brodsky on February 9, 1998 and served on appellee that day. See *Laulicht Aff.* at ¶¶ 4,5. Appellee's error was corrected on the record, a correction that was unrebutted. A505. In addition, a substantial proportion of oral argument opposing the injunction was devoted to that argument. A281-83; A290-92.

Common Law vs. Registered Mark Appellee claims Mr. Brodsky's Brief "ignores" this distinction. Opp. Brief. at 33. In fact, Mr. Brodsky's Brief shows why appellee has no valid common law mark at pages 29, 33-35, and 45-46.

*5 LEGAL ARGUMENT

I. AN INJUNCTION FORBIDDING THE USE OF A COMBINATION OF WORDS DESCRIBING A TOPIC OF PUBLIC AND RELIGIOUS INTEREST AS THE NAME OF AN INTERNET WEBSITE VIOLATES THE FIRST AMENDMENT.

Steven Brodsky has argued that the District Court's analysis was erroneously based on the flawed, largely inapposite unpublished decision in *Planned Parenthood Fed'n of America, Inc. v. Bucci*, 42 U.S.P.Q.2d 1430 (S.D.N.Y.), *aff'd unpublished table decision*, No. 97-7492 (2d Cir. 1998). Mr. Brodsky's Brief sets out at pages 1920 the serious legal and logical problems with *Planned Parenthood*; these points are not addressed by appellee.

The suggestion that Mr. Brodsky "has never offered any meaningful analysis supporting th[e] statement" that there are critical fact distinctions between the cases, Opp. Brief at 22, is fatuous. Mr. Brodsky's Brief explains that *Planned Parenthood* involved a registered word mark, unlike here, and discusses the distinction between his unequivocal anti-Jews for Jesus message and disclaimer, and the "WELCOME TO THE PLANNED PARENTHOOD WEB PAGE!" message in *Planned Parenthood*. See 42 U.S.P.Q.2d at 1432, 1438. This "welcome" message, quoted twice by the court in *Planned Parenthood*, was central to its conclusion that, "It is highly likely that an Internet user will still believe that she has found plaintiff's web site at this point," i.e., after beginning to read the contents of defendant's website. 42 U.S.P.Q.2d at 1438. Appellee's brief follows the court below and ignores these two essential differences between the cases. Similarly, none of the *6 Internet domain name cases cited in the footnote on page 21 of appellee's brief involves a website making a religious, political or social statement about the plaintiff. All involve commercial speech.

Appellee says "there is no colorable argument that Brodsky or his message has [sic] been silenced." One of appellee's main arguments to this effect is that Mr. Brodsky has other websites where he can express his opinion. This approach to the First Amendment has, however, been strongly criticized. Appellee relies largely on *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir.), cert. denied, 488 U.S. 933 (1998). In *Mutual of Omaha*, the defendant Novak used slight variations in the Mutual of Omaha word mark and logo as the basis for a series of products, sold by him, bearing the words "Mutant of Omaha" and "Nuclear Holocaust Insurance." *Id.* at 398. Unlike here, the object of Novak's social statement was not the plaintiff, and his use of its marks could not be described as fair use or even necessary to express his views about an unrelated topic, nuclear war. Here, in contrast, the subject matter of Steven Brodsky's speech is the idea of Jews for Jesus; hence the domain name, "jewsforjesus."

More significantly, the *Mutual of Omaha* court found that Novak's use of the plaintiff's marks was commercial. [FN3] In fact, the *7 court contrasted this commercial use of a mark with the protected use of a trademark by social critics such as Steven Brodsky:

FN3. This determination is itself questionable. "Although [products are] sold in the marketplace, they are not transformed into commercial speech merely because they are sold for a profit." *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959 (10th Cir. 1996), citing *Virginia State*

The injunction at issue does not quash most uses to which Novak might wish to put his design, nor does it require that the design be altered. Novak is prohibited from using the design only in the specific commercial ways mentioned in the injunction. His right to use the design in other ways - such as in antinuclear pamphlets and the like - is not restricted in any manner whatsoever.

Id. at 403, n. 8. (emphasis added). Thus, even under the authority relied upon by appellee, the non-commercial website in this case would not constitute a trademark infringement. And, under this case cited by appellee - as well as many other cases cited by Mr. Brodsky - appellee's glib overstatement that "trademark law generally prevails over the First Amendment or any other rights," Opp. Brief. at 43, is belied.

Yet, even as so limited, the holding of *Mutual of Omaha* has been rejected. In [Cardtoons, L.C. v. Major League Baseball Players Assoc.](#), 95 F.3d 959 (10th Cir. 1996), the producer of a series of baseball cards was found not to need the permission of the Major League Players Association to sell cards with the ballplayers' pictures on them. The Tenth Circuit rejected a superficial comparison of intellectual property rights to rights in tangible property:

[I]n the context of intellectual property, [the] "no adequate avenues" test does not sufficiently accommodate the public's interest in free expression. See [Rogers v. Grimaldi](#), 875 F.2d 994, 999 (2d Cir. 1989); [Mutual of Omaha Ins. Co.](#), 836 F.2d at 405-06 (Heaney, J., dissenting). Intellectual property, unlike real estate, includes the words, images, and sounds that we use to communicate, and "we cannot indulge in the facile *8 assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process." [Cohen \[v. California\]](#), 403 U.S. 15] at 26 [(1971)]

Id. at 971. See also, [Rogers v. Grimaldi](#), 875 F.2d 994, 999-1000 (2d Cir. 1989) (rejecting "no alternative avenues" test).

Nonetheless, appellee insists that all is well as long as Mr. Brodsky can post his message at other websites using other domain names. Opp. Brief at 43. Steven Brodsky can say what he wants, says appellee, as long as no one hears him. But while this approach might suit appellee in this case, it does not suit the Constitution or even, in other contexts, appellee itself. For example, in [Jews for Jesus, Inc., v. Massachusetts Bay Transp. Auth.](#), 984 F. 2d 1319 (1st Cir. 1993), [Board of Airport Commissioners of the City of Los Angeles v. Jews for Jesus, Inc.](#), 482 U.S. 569 (1987), and [Rosen v. Port of Portland](#), 641 F.2d 1243 (9th Cir. 1981), appellee fought on First Amendment grounds for the right to express its message effectively. In each case the courts upheld its right to do so, viewing "time, place and manner" restrictions dimly. Yet such restrictions on speech are still less ominous than restrictions on "the words and images that may be used by a speaker." [Cardtoons](#), 95 F.3d at 971; accord, [Rogers](#), 875 F.2d at 999 ("a restriction on the location of speech is different from a restriction on the words the

speaker may use," citing *Cohen*).

Faced with *Rogers*, appellee denies that "jewsforjesus" is an appropriate title for a website about Jews for Jesus. In essence *9 it then admits that if Mr. Brodsky did not use such a succinct and accurate description of his site's content, consisting of unregistered generic words, no one would have gone to his website in the first place. Opp. Brief at 39. This, of course, is the lesson of *Rogers*, and it supports Mr. Brodsky's argument that he should be able to use the most appropriate title available for his website. As the Second Circuit explained:

[T]itles with at least minimal artistic relevance to the work may include explicit statements about the *content* of the work that are seriously misleading ... We therefore need not interpret the Act to require authors to select titles that unambiguously describe what the work is about nor to preclude them from using titles that are suggestive of some topics the work is not about. Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act.

875 F.2d at 1000 (emphasis added, except underscore). Appellee meets this by arguing that "jewsforjesus" has "no artistic relevance" to a website debunking the very idea of ... Jews for Jesus! Opp. Brief at 41. Appellee's conception of "no artistic relevance" is far wide of the mark set by the Second Circuit, which upheld the use of "Ginger and Fred" as the title of a movie that had virtually nothing to do with Ginger Rogers or Fred Astaire. [FN4]

FN4. Appellee also cites a number of cases holding that a domain name is a source identifier. Opp. Brief at 40. These cases are not controlling here, and, as indicated in the *amicus curiae* brief, their conclusions, taken broadly as appellee does, are simply incompatible with the objective fact that domain names are used for many purposes other than designation of source. Appellee's response is that the expressive domain names described in the *amicus* brief are distinguishable from Mr. Brodsky's, because "Brodsky's use of plaintiff's mark is actionable because he has used them in a trademark sense." Opp. Brief at 52. This statement only begs the question this Court is being asked to decide. Similarly, the statement that Mr. Brodsky's alleged intent makes his domain name a source identifier, Opp. Brief at 53, is a non sequitur.

*10 Even if appellee's metaphysical argument that "the true subject matter of Brodsky's sites is not 'Jews for Jesus,'" (Opp. Brief. at 41) were accepted, and "jewsforjesus" were found to be momentarily misleading to some religiously unsophisticated and functionally illiterate Internet users (see Mr. Brodsky's Brief at 35-36), *Rogers* teaches that the decision below still runs afoul of the Constitution. In *Rogers* there was evidence of actual confusion - a full 14% of survey respondents mistakenly believed the actress Ginger Rogers had been involved in producing "Ginger and Fred." This percentage dwarfs the three (dubious) claims of actual confusion out of the almost 6,000 known encounters here. Yet the Second Circuit ruled that even a 14% rate of actual confusion as to sponsorship was not suf-

ficient to overcome the First Amendment, where free expression was threatened:

The survey evidence ... indicates at most that some members of the public would draw the incorrect inference that Rogers had some involvement with the film. But that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.

875 F.2d at 1001. Confusion not only as to sponsorship but even as to content will not automatically displace the Constitution:

[T]here is no doubt a risk that some people looking at the title "Ginger and Fred" might think the film was about Rogers and Astaire in a direct, biographical sense. For those gaining that *11 impression, the title is misleading

[A] mixture of meanings, with the possibly misleading meaning not the result of explicit misstatement, precludes a Lanham Act claim for false description of content in this case. To the extent that there is a risk that the title will mislead some consumers as to what the work is about, that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.

Id. (emphasis added). *Rogers* is consistent with a line of free speech cases beginning with *New York Times v. Sullivan*, 376 U.S. 254 (1964), which hold:

[E]rroneous statement is inevitable in free debate, and ... it must be protected if the freedoms of expression are to have the breathing space that they need to survive ...

* * *

Even a false statement may be deemed to make a valuable contribution to debate, since it brings about the clearer perception and livelier impression of truth, produced by its collision with error.

376 U.S. at 271-72, 279 n. 19 (citations omitted). These cases demonstrate that the right to free expression may take precedence over the need to avoid consumer confusion, even where a label or title may be misleading. How much more so does that principle apply here, where (i) Mr. Brodsky's speech is non-commercial, (ii) it concerns a topic (religion) of special First Amendment concern, (iii) the title of his website is not misleading, (iv) the evidence of "confusion" is statistically infinitesimal and (v) such "confusion" was, at worst, evanescent and harmless? The court below refused to balance the slight risk of innocuous confusion against the profound cost of stifling speech, writing the Constitution out of the law. This was error.

*12 Finally, appellee quotes *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 541 (1987), implying that Mr. Brodsky seeks to "appropriate to himself the harvest of those who have sown." This is an "unjust enrichment" argument. See *Cardtoons*, 95 F.3d at 976. But such an analysis is inapposite here. Mr. Brodsky never profited from this enterprise, and he never palmed himself off as a Jew for Jesus; far from it.

Not every party that uses words or images associated with another is "hitching

its wagon to a star," especially when it adds its own "creative component." *Cardtoons*, 95 F.3d at 976; cf., *American Home Products v. Barr Laboratories*, 834 F.2d 368, 371 (3rd Cir. 1987) ("association" is not "identification"; only latter probative of confusion as to source); *Revlon Consumer Products Corp. v. Jennifer Leather Broadway Inc.*, 858 F. Supp. 1268, 1276 (S.D.N.Y.), *aff'd*, 57 F.3d 1062 (2d Cir. 1995) (use of mark as shorthand method of communicating a quality is not misappropriation of mark's goodwill or reputation). Here too, Mr. Brodsky has added his own creative or expressive component, and joined an entirely new message, to the words "Jews for Jesus."

This is a marketing technique appellee itself uses. It "borrows" celebrity likenesses, such as that of radio announcer Howard Stern (A229), and the trademarks of others, [FN5] such as "Star Wars" (A237) and "The Simpsons" (A238), to promote its message. The general public is expected to distinguish an endorsement or a claim of origination from mere association or "attention-grabbing." *13 As in *Girl Scouts v. Personality Posters Mfg. Co., Inc.*, 304 F. Supp. 1228 (S.D.N.Y. 1969), consumers "rationally analyze" appellee's promotional materials. Recipients use their brains to discern that these pamphlets are not what they first seem to be. Similarly, one look at Steven Brodsky's website makes it clear that his message is distinct from, indeed explicitly opposed to, that of appellee.

FN5. *Laulicht Aff.* at ¶¶ 9, 10.

II. THE DISTRICT COURT IMPROPERLY CURTAILED APPELLANT'S FIRST AMENDMENT RIGHTS WHILE UNDULY EXTENDING THE SCOPE OF APPELLEE'S CLAIMED TRADEMARKS IN RULING THAT AN UNREGISTERED COMBINATION OF WORDS DESCRIBING A TOPIC OF PUBLIC AND RELIGIOUS INTEREST, USING UNSTYLIZED ELEMENTS OF A STYLIZED REGISTERED MARK, MAY NOT BE USED BY APPELLANT AS THE NAME OF HIS INTERNET WEBSITE.

Appellee defends the District Court's unprecedented extension of trademark law to protect an unstylized version of a stylized registered mark by claiming that (1) its JEWS F*R JESUS mark is not stylized (the first time it has ever made such a claim); (2) the stylized portion of the mark JEWS F*R JESUS is immaterial to the rights claimed; (3) this Court's opinion in *Natural Footwear, Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383 (3d Cir. 1984) is wrong. Each of these is addressed below *seriatim*.

The preposterous claim that JEWS FR JESUS is not a stylized mark is new to this litigation. Even if there were anything to this claim, it has been waived both by the appellee's own unqualified use of the term in its own papers, A011, A063, A107, and its failure to appeal or in any way object to the District Court's finding that the mark is stylized, A355. Even appellee's motion to *14 supplement the record on this appeal plainly states that its mark is stylized. Therefore the discussion in the Opposition Brief about the protectability of a word "registered in typed format" is irrelevant and seriously lacking in candor.

Appellee claims alternatively that the Star of David portion is not a material part of the stylized JEWS F*R JESUS mark - that it is "inconsequential." Opp. Brief. at 30. [FN6] Besides defying both sense and the "as shown" disclaimer in the registration, appellee's position is contradicted by its own behavior. Why did appellee not register the words "Jews for Jesus" without any stylized element at all? Discovery has shown that there is no registration for a "plain type" "Jews for Jesus" mark, and that the decision not to apply for one was apparently made upon the advice of counsel. Obviously such an application would have been rejected as generic. That rejection would have hindered appellee's *sub rosa* strategy of bootstrapping its legitimate rights in the stylized JEWS FR JESUS mark into a monopoly on the unstylized generic words it could never register. [FN7]

FN6. The citations to McCarthy by appellee are inapposite, since JEWS FR JESUS is not a composite mark, consisting of separable word and design components, but has been held to be a stylized mark. Appellee's approach ignores the broader rule that the mark itself must be considered, not in isolation, but as used in the marketplace. See, e.g., *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 319 (4th Cir.), cert. denied, 506 U.S. 872 (1992) (test for confusion was not parody of logo but all the elements presented on T-shirt; jury finding of no confusion upheld). See also *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645 (Fed. Cir. 1990) (stylized marks analyzed; no likelihood of confusion). Here, in the context of Mr. Brodsky's website, no confusion is possible.

FN7. This bootstrapping strategy also explains appellee's failure to comply with 15 U.S.C. § 1111, mandating use of the (R) symbol or other indicator of trademark registration. This notice would either require appellee to limit its claim to its actual registered mark, JEWS F*R JESUS, or illegally claim a registration in the unregistered plain block letters. Appellee's Opposition Brief ignores this point as well.

*15 Appellee's "inconsequential" position is further undermined by the trademark record, considering appellee's registration of the following additional stylized mark, No. 1,537,366 (Laulicht Aff. at ¶ 3):

F??R

If, as appellee urges, the Star of David in JEWS F*R JESUS is "inconsequential," is it also inconsequential in the F*R mark? Does appellee then claim rights in the word "FOR"? Such a trademark strategy, if allowed, would certainly keep Steven Brodsky, and appellee's other religious rivals, very quiet. It allow appellee to avert the pain of criticism that motivated this lawsuit. But "a function of free speech under our system is to invite dispute. It may indeed serve its high purpose best when it induces a condition of unrest, creates dissatisfaction with conditions as they are, or even stirs people to anger." *Rosen v. Port of Portland*, 641 F.2d at 1248, quoting *Terminiello v. Chicago*, 337 U.S. 1, 4-5 (1949).

Finally, appellee seeks to avoid the implications of this Circuit's rule in *Natural Footwear*. It cites Professor McCarthy's belief that this Court is simply wrong when it says the rights granted by a trademark registration are essentially limited to the terms and uses of that registration. Opp. Brief. at 33. But *Natural Footwear* is consistent with the Supreme Court's holding that the *16 holder of an incontestable mark cannot expand its rights "beyond the good or service for which it was originally designated." *Park 'N' Fly Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 204 (1985). [FN8]

FN8. Mr. Brodsky recognizes that this argument does not necessarily affect the alleged common law rights to the words "Jews for Jesus" asserted by appellee. But, as argued in his original Brief at 45-46, a holding of infringement of a registered mark, and especially an incontestable one, is a very different thing, and requires much less evidence, than a finding of infringement of a common law mark. "Jews for Jesus" is a generic term. Moreover, the District Court found "Jews for Jesus" to be a descriptive common-law mark. Even as a descriptive mark, "Jews for Jesus" is entitled to protection only upon a showing of secondary meaning, which was lacking in the injunction application.

Appellee wrongly focuses on whether the PTO registration classification is controlling. Opp. Brief. at 33. Mr. Brodsky's Brief does analyze the District Court's flawed classification ruling. But what matters here is the listing, provided by the registrant to the Patent and Trademark Office, of actual uses in commerce, the *sine qua non* of trademark protection. Appellee ignores this.

Appellee admits that its § 1065 "incontestability" affidavit, setting out the specific continuous uses of the mark over the previous five years, was not before the District Court. Opp. Brief. at 5. But even though appellee has moved to supplement the record on appeal, it has omitted the § 1065 affidavit it refers to in its own brief. On inspection the reasons for this omission are clear. The only use indicated in the affidavit is for religious pamphlets. And the only version of the mark on the affidavit exemplar is not *17 in "plain type" or "block letters," but JEWS F*R JESUS, with a large, prominent Star of David. Laulicht Aff. at ¶ 2, Exh. A.

Appellee sees its stylized trademark registration as a literal carte blanche with which to cashier its enemies, a bootstrap to rights of unlimited scope. But *Natural Footwear* teaches that trademark registration grants only a carefully circumscribed monopoly on expression. Nothing in appellee's Opposition Brief suggests that the law should be otherwise.

III. APPELLANT'S USE OF AN UNREGISTERED WORD COMBINATION TO PROMOTE HIS RELIGIOUS POINTS OF VIEW ON THE INTERNET, AND TO PROVIDE ACCESS TO A NON-PROFIT, NON-COMMERCIAL WEBSITE SHARING HIS VIEWS, IS NOT COMMERCIAL SPEECH UNDER THE ANTIDILUTION ACT.

Appellee, faced with clear Supreme Court authority establishing that neither Steven Brodsky's nor Outreach Judaism's websites are commercial, and that appellee has no cause of action under the Anti-Dilution Act, is forced to resort to the "no bright lines" argument. Opp. Brief. at 48. It ignores the standard of *Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422-23 (1993) (speech is commercial if "proposal of a commercial transaction" is its sole purpose), and lists all sorts of things that Steven Brodsky is alleged to have done. But none of these acts is, separately or together, the proposal of a commercial transaction; merely a religious one. This is not commerce, but a "communicat[ion] of information, express[ion] of opinion, recitat[ion] of grievances" deserving of constitutional protection. *New York Times v. Sullivan*, 376 U.S. at 267. See **18 American Civil Liberties Union v. Miller*, 977 F. Supp. 1228, 1233 (N.D. Ga. 1997) (statute prohibiting use of trade names or logos in noncommercial commentary in Internet transmission violates First Amendment). The fact that Mr. Brodsky also refers Internet users to Outreach Judaism, an effective advocate of views with which Mr. Brodsky agrees, cannot change this.

Appellee attempts to distinguish *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 924 F. Supp 1559 (S.D. Cal.), *aff'd*, 109 F.3d 1394 (9th Cir.), *cert. dismissed*, 118 S. Ct. 27 (1997), because the trademark use there was a parody. Appellee does not explain what difference that should make in this Court's analysis. And appellee's citation here, Opp. Brief. at 49, of *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86 (2d Cir. 1997) is inapposite. There a breakaway affiliate of a political group sought, by use of its former parent's name, misleadingly to identify itself with the well-known larger group. *Id.* at 88. The defendant's use of the United We Stand America trademark in this way was correctly found to threaten "significant consumer confusion," *id.* at 89, with "catastrophic" effects, *id.* at 90. Because of the depth of the *United We Stand* deception, its facts resemble not this case but *Planned Parenthood*. *United We Stand* also has nothing to do with the Anti-Dilution Act. While the Second Circuit held that "commerce" as used in the Lanham Act was meant to extend congressional jurisdiction over trademarks to its full constitutional extent (which has never been challenged by Mr. Brodsky), it never ruled on the meaning of "commercial use" under **19 15 U.S.C. § 1125*, the Anti-Dilution Act. That statute was not even asserted in *United We Stand*. [FN9]

FN9. Appellant does commend to the Court's attention the analysis in *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985). Unlike the hypothetical establishment of a university considered in *United We Stand*, the expression of an opinion with nothing more, as in *Lucasfilm* and as here, is not the provision of a "service." See *Lucasfilm*, 622 F. Supp. at 934.

Ultimately appellee must fall back on *Planned Parenthood's* novel, unprecedented "tests" for commercial use. One equates intellectual "competition" with "commerce." Another says that a trademark use is commercial if it "showcases" or "plugs" something. A third finds commercial use where the defendant intends to

show that the party asserting the mark is "wrong." Opp. Brief. at 46-47. These formulations, however, are descriptions of debate, not commercial use of a trademark under § 1125. This Court's approval of any of them as a basis for a finding of "commercial use" would not only eviscerate the Internet as shown by the *amicus*, but. devastate the First Amendment. [FN10]

FN10. Here too appellee recycles its lament that Mr. Brodsky is citing authorities on its appeal that it did not use in the brief below. Mr. Brodsky's injunction brief was prepared on less than a week's notice and with a 40-page limit, for a hearing styled as an order to show cause for a temporary restraining order. In contrast, appellee had weeks to prepare its papers and, despite the supposedly "emergent" nature of the relief sought, was allowed the privilege of a reply brief. Thus appellee's complaints on this score come with ill grace and, more importantly, are of no legal import. There can be no suggestion that this issue and the others presented here on appeal were argued by Mr. Brodsky below, and appellee offers none.

IV. THE PHRASE "JEWS FOR JESUS" IS GENERIC AS APPLIED TO JEWS WHO ARE FOR JESUS.

Regarding Mr. Brodsky's argument that the words "Jews for *20 Jesus" are generic, appellee tries several distracting tacks, ignoring the analysis presented by Mr. Brodsky, as it must. It claims that genericness is not a defense to an incontestable mark. Opp. Brief at 23. But Mr. Brodsky has never used appellee's registered JEWS F*R JESUS mark; nor has he ever claimed that this registered stylized mark is generic. It is the unstylized, unregistered words, "Jews for Jesus," the ones comprising the domain name at issue, that Mr. Brodsky maintains are generic. Appellee has no more right to exclusive use of "Jews for Jesus" than the holder of a stylized trademark depicting the words CHOCOLATE FUDGE covered with gooey drips, or even just one letter so stylized, would have to those generic words without the device. See *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3rd Cir. 1986); see also *Leejay v. Bed Bath & Beyond*, 942 F. Supp. 702 (D. Mass. 1996) (generic phrase not protected by stylized registered mark); *Armstrong Cork Co. v. World Carpets, Inc.*, 76 F.R.D. 613, 615 (N. D. Ga. 1977) (stylized mark not a grant of monopoly in words).

Appellee also ignores the authority establishing that generic use by a trademark proponent amounts to estoppel of the trademark claim. It portrays its own generic uses as "ambiguous" (the same word it used to describe *Natural Footwear*), and "isolated examples." Opp. Brief. at 24. But appellee cites no authority for the proposition that its own generic use, even if "merely" sporadic, does not work an estoppel. In fact, the examples in Mr. Brodsky's Brief were just samples; there are more. Here is another one, taken from one of appellee's own publications:

*21 Howard Stern A Jew for Jesus?

* * *

What would it take for Howard Stern (or anyone else) to be a Jew for Jesus?

1. An admission that sin separates you from God
2. The acknowledgment that Y'Shua (Jesus) died to pay God's judgment on your sin
- ...
3. Accept His atonement personally ...
4. You have to be Jewish in the first place to be a Jew for Jesus (of course you *don't* have to be Jewish to be for Jesus!).

A229 (emphasis added, except underscore). There is no suggestion in this excerpt that, to be "a Jew for Jesus," Mr. Stern need formally affiliate with appellee's group or license its purported trademark. Rather, a (profound) spiritual change is contemplated. Once accomplished, Howard Stern - under appellee's own formulation - becomes "a Jew for Jesus." Without a Star of David.

V. THE DISTRICT COURT ABUSED ITS DISCRETION BY ISSUING A PRELIMINARY INJUNCTION DESPITE APPELLEE'S FAILURE TO MEET ITS HEAVY BURDEN OF PROVING A REASONABLE LIKELIHOOD OF CONFUSION SUFFICIENT TO OVERCOME APPELLANT'S RIGHTS UNDER *THE FIRST AMENDMENT*.

In defending the District Court's likelihood of confusion analysis, appellee comes again to its prized exhibits: the three "confusion affidavits" of Chellathurai, Kalstein and Sanchez. There is little left to debate regarding whether these affidavits demonstrate confusion, or, more likely, the absence of confusion. [FN11] This Court will simply have to read them. A076, A080, A257.

FN11. Appellee brandishes the District Court's finding that "Defendant has offered nothing to contest the reliability or accuracy of these affidavits," Opp. Brief. at 36, presumably to evade the damning holding of *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995) cited below by Mr. Brodsky. Laulicht Aff. at ¶ 6.

*22 Appellee suggests that the District Court found "initial interest confusion" here. Opp. Brief. at 37. But this doctrine is mentioned nowhere in the opinion below. Developed in a sales context, it has been applied only where "a potential purchaser is initially confused [such that] the [senior seller] may be precluded from further consideration." *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546 (Fed. Cir. 1990) (emphasis added). Thus it does not apply here. In fact, in *Girl Scouts* the Southern District of New York rejected transient confusion as proof of trademark harm in a social-commentary context:

Even if we hypothesize that some viewers might at first believe that the subject of the poster is actually a pregnant Girl Scout, it is highly doubtful that any such impression would be more than momentary or that any viewer would conclude that the Girl Scouts had printed or distributed the poster. [FN12]

FN12. The *Girl Scouts* court also noted that the presence of an explicit disclaimer militated against a finding of confusion. *Id.* at 1231.

304 F. Supp. at 1231. As the *Girl Scouts* court recognized, ephemeral moments of

confusion that do not threaten to divert sales are not evidence of actionable harm under the Lanham Act. Real harm must be shown to overcome the constitutional protection of free speech:

No evidence is found anywhere in the record before the court that the poster has to date damaged the plaintiff in any way. No facts are presented to show that contributions to the organization have fallen off, that members have resigned, that recruits have failed to join, that sales ... have decreased, or that voluntary workers have dissociated themselves or declined to support the honorable work of the organization.

***23** *Id.* at 1235. Similarly, there is no evidence in this case of any actionable or even discernible harm that appellee has suffered as a result of Mr. Brodsky's website. Even the court below admitted that the publicity surrounding this dispute was, far from harmful, undoubtedly a boon for appellee. A436-37. And all three supposedly confused affiants found their way to appellee's website, undeterred by Steven Brodsky and more zealous than ever in their devotion to appellee. In fact, their reports to appellee negate the suggestion of confusion; again from *Girl Scouts*:

[I]ndignation is not confusion. To the contrary, the indignation of those who [reported the offending use] would appear to make it clear that they feel that the Girl Scouts are being unfairly put upon, not that the Girl Scouts are the manufacturers or distributors of the object of indignation.

Id. at 1231. This passage perfectly describes the three "confusion" affidavits here: indignant, yes, but certain that appellee was not the source of Mr. Brodsky's website. They were not confused.

When actual confusion fails, appellee falls back on intent. Despite the nonconfusing content, despite the explicit disclaimer, Steven Brodsky is said to have intended confusion and therefore, by definition, to have violated the Lanham Act. The evidence proffered for this conclusion is Mr. Brodsky's statement that the "intent behind [his] bogus 'Jews for Jesus' site ... is to intercept potential converts before they have a chance to see the obscene garbage on the real J4J site." A049. This statement is amenable to more than one interpretation, of course. ***24** For example, what does "intercept" mean in the context of this case? Appellee admits that "Brodsky, like any other web site operator, cannot compel an Internet user to visit his site." *Opp. Brief.* at 39. Obviously, neither can he compel anyone not to visit appellee's website. Appellee sounds a drumbeat of "intent." But what does appellee itself say was Mr. Brodsky's intent? "Providing ... Internet users with information." *Opp. Brief.* at 13 (emphasis added).

This Court has stated unequivocally that under the Lanham Act, "evidence of defendant's intent does not relieve plaintiff of its burden of proving likelihood of confusion." *American Home Products, 834 F.2d at 371.* Appellee has never met its burden. Its "proof" of intent amounts to proof that Mr. Brodsky intended to provide information appellee did not want not provided.

CONCLUSION

The court below ruled that the law of unfair competition proscribes Steven Brodsky's dissemination of information. The cases and the plain language of the statutes themselves demonstrate the District Court erred. But even if the District Court were right about the Lanham Act and the Anti-Dilution Act, it cannot be right that the First Amendment does not protect Steven Brodsky's right to attempt intellectual "interception," otherwise known as persuasion.

Steven Brodsky's effective expression of dissent threatened in appellee's own words - to "provid[e] these Internet users with information" that is "antithetical to [appellee's] message and mission." To suppress that message, appellee launched an assault *25 styled as an unfair competition claim. It claims Mr. Brodsky harmed it under the laws of commerce.

But appellee has never described any commercial harm it has suffered. Before Steven Brodsky's website was posted, appellee had a website to promote Christianity to Jews. After the website was posted, appellee had a website to promote Christianity to Jews. Appellee's website was as accessible as ever and there is no evidence that the number of visitors to appellee's website fell. But, there was Steven Brodsky's stinging critique, the fact that it could be found, the possibility that it just might persuade.

Neither the censorship of religious ideas, nor the protection of one creed, are appropriate uses of the law of intellectual property. The Lanham Act is a valuable tool of commerce, not a weapon of religious engagement. The state's role is to guarantee the freedoms of religion and speech, not to be the agency of an ecclesiastical ban. For the foregoing reasons, appellant Steven C. Brodsky respectfully requests that this Court reverse and vacate the order of the District Court.

JEWS FOR JESUS, Appellee, v. Steven C. BRODSKY, Appellant.

1998 WL 34137272

END OF DOCUMENT