

1 COLBY B. SPRINGER (SBN 214868)
cspringer@carrferrell.com
2 CARR & FERRELL LLP
2200 Geng Road
3 Palo Alto, California 94303
Telephone: (650) 812-3400
4 Facsimile: (650) 812-3444

5 RONALD D. COLEMAN (*Admitted Pro Hac Vice*)
RColeman@goetzfitz.com
6 GOETZ FITZPATRICK LLP
One Penn Plaza—Suite 4400
7 New York, New York 10119
Telephone: (212) 695-8100
8
9 Attorneys for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC

10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION
13

14 INTEL CORPORATION,
15 Plaintiff,
16 v.
17 AMERICAS NEWS INTEL PUBLISHING,
18 LLC,
19 Defendant.

CASE NO. CV 09-05085 CRB

**DEFENDANT’S NOTICE OF
MOTION AND MOTION TO
DISMISS THE FIRST AMENDED
COMPLAINT; MEMORANDUM
OF POINTS AND AUTHORITIES**

Date: June 25, 2010
Time: 10:00 a.m.

20
21 Defendant hereby gives notice of its Motion to Dismiss Plaintiff’s Complaint, set for
22 hearing on June 25, 2010 at 10:00 a.m., or as soon thereafter as counsel may be heard.

23 Defendant hereby moves the Court to dismiss plaintiff’s First Amended Complaint its
24 entirety for failure to state a claim pursuant to Federal Rule of Civil Procedure 12(b)(6), for the
25 reasons more fully set forth in defendants’ accompanying memorandum of points and authorities.
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Dated: May 17, 2010

CARR & FERRELL *LLP*

By: /s/ Colby B. Springer
COLBY B. SPRINGER

Attorneys for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC

RONALD D. COLEMAN
GOETZ FITZPATRICK LLP

Of Counsel for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC

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14 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2004)
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 17 56 *INTA Bulletin*, no. 14 p.1 (Aug. 1, 2001)7
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SUMMARY OF THE ARGUMENT

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2 In accordance with this Court’s Standing Order, Defendant ANIP summarizes its argument
3 in that the Lanham Act imposes liability upon any person who (1) uses an infringing mark in
4 interstate commerce, (2) in connection with the sale or advertising of goods or services, and (3)
5 such use is likely to cause confusion or mislead consumers. 15 U.S.C. § 1114(1)(a). The crux of a
6 Lanham Act claim is that a defendant must use a plaintiff’s trademark so as to capitalize on its
7 goodwill. *See Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 880 (9th Cir. 1999) (“commercial
8 use under the Federal Trademark Dilution Act requires the defendant to be using the trademark as a
9 trademark, capitalizing on its trademark status”).

10 While the defendant has incorporated the word ‘intel’ into the compound phrases
11 AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL, and LATIN INTEL TRADE
12 CENTER, the word “intel” is being used in its plain English meaning (intelligence) along with
13 other words in those phrases as one. “[When a] mark is a composite term . . . its validity is not
14 judged by an examination of its parts. Rather, the validity of a trademark is to be determined by
15 viewing the trademark as a whole. *See Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379
16 (7th Cir.), *cert. denied*, 429 U.S. 830, 97 S.Ct. 91, 50 L.Ed.2d 94 (1976). “Words which could not
17 individually become a trademark may become one when taken together.” *Id. See also California*
18 *Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985).

19 Plaintiff Intel Corp. cannot, therefore, proffer a plausible suggestion that Defendant ANIP is
20 using the English word ‘intel’ as a trademark and capitalizing upon any fame or goodwill of the
21 INTEL mark. Intel Corp. must do more than recite the mere elements of the claim; Intel Corp. must
22 “provide the grounds of [its] entitlement to relief” and allege conduct that is conceivable and
23 “plausible.” *Bell Atlantic v. Twombly*, 127 S. Ct. 1955, 1959 (2007) (citations omitted). Intel
24 Corp.’s claim, therefore, must ultimately fail.
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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **INTRODUCTION AND FACTUAL OVERVIEW**

3 Like the prior Complaint that this Court dismissed almost in its entirety, the Amended
4 Complaint (“AM. COMPL.”) filed by Intel Corporation (“Intel Corp.”) is “more of the same” and
5 sets forth the “usual” menu of trademark-based claims. Notwithstanding the fact that this Court
6 offered Intel Corp. the opportunity to amend that dismissed Complaint, the plaintiff has done
7 nothing in terms of offering a coherent argument in response to the fundamental question: Why
8 should the law prevent the defendant from using an English word—“intel,” meaning intelligence or
9 information reporting—which is unrelated to the plaintiff or any trademark Intel Corp. may own, to
10 describe its own utterly unrelated services.

11 As did its predecessor, the Amended Complaint centers on the allegation that the defendant,
12 America News Intel Publishing (“ANIP”), infringed Intel Corp.’s INTEL trademarks through the
13 use of the marks AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL, and LATIN INTEL
14 TRADE CENTER in association with “consulting services and newsletter subscriptions on
15 business, economics, travel and politics in Mexico.” AM. COMPL. ¶ 9. Intel Corp. is, of course, the
16 well-known computer chip maker whose INTEL trademark is known for technology. AM. COMPL.
17 ¶¶ 8; 11-13. Intel Corp. claims that its Latin American business is significant and that ANIP’s own
18 newsletters, if still extant, would likely cover Intel Corp.’s Latin American adventures. AM.
19 COMPL. ¶¶ 15, 16. Intel Corp. also alleges that it offers “newsletter and circulars [that] provide
20 analysis regarding how businesses may optimize business processes and reduce costs” and that the
21 audience for these newsletters includes people in the U.S. “who are interested in” such
22 developments “both domestic and abroad.” AM. COMPL. ¶ 14. Despite its best efforts, however,
23 Intel Corp. does not—and cannot—allege that it uses its trademarks, intends to use those marks, or
24 is likely to use said marks in connection with consulting services and newsletter subscriptions that
25 are specifically focused on developments in Latin American and Mexico.

26 In contrast to its original pleading, in the Amended Complaint Intel acknowledges ANIP’s
27 fundamental argument that the word “intel” used in defendant’s marks has **nothing** to do with
28 INTEL chips, Intel Corp. or its business, and **is a word in the English language for**

1 “**intelligence**,” usually used in the sense of reconnaissance and analysis regarding areas of special
2 interest. AM. COMPL. ¶ 2. Intel Corp. grotesquely distorts ANIP’s argument, however, in claiming
3 that ANIP “contends that its trademark use of INTEL is overwhelmingly understood by the relevant
4 public to denote ‘intelligence.’” *Id.* This is not ANIP’s argument—ANIP does not use the block-
5 letter trademark INTEL as a trademark—despite the otherwise confusing allegation that INTEL and
6 AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL, and LATIN INTEL TRADE
7 CENTER are all “INTEL-formative marks,” whatever that formulation actually means. AM.
8 COMPL. ¶ 1. In fact, ANIP does not use “INTEL-formative” anything; ANIP uses the unrelated
9 English word “intel” as part of a multi-word combination which, in that context, is understood in a
10 way that does not **at all** impinge on Intel Corp.’s goodwill.

11 Intel Corp.’s subsequent arguments invoking unsourced survey evidence with respect to its
12 trademark is thus demonstrated to be irrelevant. For Intel Corp. to suggest that “Intel’s fame is
13 such that a recent consumer survey found that over 86% of respondents who associate the term
14 “intel” with any word, definition, or mark associate the term with Intel Corporation” ignores the
15 question of how many consumers in the relevant market here would associate the term “intel” with
16 Intel Corp. in the context of the trademarks AMERICAS NEWS INTEL PUBLISHING, LATIN
17 INTEL, and LATIN INTEL TRADE CENTER. Intel’s suspect survey evidence also ignores the
18 question of whether Intel has the right to prevent the use of a word from the English-language—
19 “intel”—on the basis of such an alleged “association.” The answer is, quite simply, Intel Corp.
20 does not. No reasonable person is likely confuse the use of “intel,” as used by ANIP, with Intel
21 Corp.’s block-letter INTEL trademark. Dilution is unlikely because of the multi-word context in
22 which the word is used and there is no cybersquatting issue because ANIP’s domain names were
23 neither registered in bad faith, nor identical, nor confusingly similar to or dilutive of the INTEL
24 trademark—all legal matters already determined by the Court on the prior motion.

25 Having already taken judicial notice of the universe of dictionary and other reference and
26 popular media definitions for the word “intel” on ANIP’s previous motion to dismiss, it is patently
27 obvious that the Amended Complaint adds nothing of substance to the Complaint that preceded it
28 and as such, the present Amended Complaint is entitled to the same treatment—dismissal—albeit

1 without further leave to amend.

2 As referenced in briefing ANIP’s first motion to dismiss, Merriam-Webster’s online
 3 dictionary reports a single, solitary definition for the word “intel”: “Function: *abbreviation*
 4 [Definition:] intelligence.” The various other exhibits from the aforementioned briefing evidenced
 5 use of the term “intel” for “intelligence” as completely accepted in journalistic usage. Intel Corp.
 6 would, however, have a word, which happens to be the same word as its trademark, operate as a
 7 prohibition against anyone else from using that word in an unrelated, unconfusing way. Intel Corp.
 8 not only wants to own the trademark INTEL, but the English language use of the word “intel” as
 9 well. No one else may utilize that word as any part of a trademark—ever. The law does not allow
 10 such a grant of proprietary rights.

11 LEGAL ARGUMENT

12 A. **PLAINTIFF’S ALLEGATIONS SOUNDING IN TRADEMARK INFRINGEMENT** 13 **FAIL TO STATE CLAIMS FOR WHICH RELIEF CAN BE GRANTED.**

14 1. Legal standard for dismissal under Fed. R. Civ. P. 12(b)(6)

15 A motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) tests the “legal
 16 sufficiency” of the claims alleged in the complaint. *In re Graphics Processing Units Antitrust*
 17 *Litig.*, 527 F. Supp. 2d 1011, 1018 (N.D. Cal. 2007). A motion to dismiss is properly granted under
 18 Fed. R. Civ. P. 12(b)(6) where the pleadings fail to state a claim upon which relief can be granted.
 19 While the Amended Complaint is construed in the light most favorable to the non-moving party and
 20 all material allegations in the Amended Complaint are taken to be true, the court is not required to
 21 accept legal conclusions cast in the form of factual allegations if those conclusions cannot
 22 reasonably be drawn from the facts alleged. *Sanders v. Kennedy*, 794 F.2d 478, 481 (9th Cir.
 23 1986); *Clegg v. Cult Awareness Network*, 18 F.3d 752, 754-55 (9th Cir. 1994). Mere “conclusory
 24 allegations of law and unwarranted inferences are insufficient to defeat a motion to dismiss for
 25 failure to state a claim. *Epstein v. Washington Energy Co.*, 83 F.3d 1136, 1140 (9th Cir.1996)
 26 (citations omitted).” A plaintiff must do more than recite the elements of the claim and must
 27 “provide the grounds of [its] entitlement to relief.” *Bell Atlantic v. Twombly*, 127 S. Ct. 1955, 1959
 28 (2007) (citations omitted). In addition, the pleading must not merely allege conduct that is

1 conceivable, but it must also be “plausible.” *Id.* at 1974.

2 2. The Court has taken judicial notice of dictionary definitions of the word “intel.”

3 Relying on Fed. R. Evid. 201(b)(2), which permits the Court to take judicial notice of facts
4 that are “not subject to reasonable dispute in that it is . . . (2) capable of accurate and ready
5 determination by resort to sources whose accuracy cannot be reasonably questioned,” the Court, on
6 the previous motion, apparently took judicial notice of the dictionary definition of “intel.” Having
7 established the legal basis for the Court to consider such definitions, consideration of the extensive
8 body of references set forth in the prior motion as to use of the word “intel” in the manner used by
9 defendants, and completely unrelated to plaintiff’s trademarks or its business, easily demonstrates
10 the meritless nature of the Complaint.

11 3. Defendant’s of the word “intel” in its plain English
12 sense is not use of the INTEL trademark.

13 Intel Corp. has merely repleaded its number of claims sounding in trademark infringement
14 and based on different legal theories premised on an alleged wrongful use of INTEL trademark.
15 Not only are ANIP’s actions **still** not plausibly likely to cause confusion or dilution, Intel Corp. has
16 again failed to allege that ANIP used the INTEL **trademark** when it used the **unrelated** English
17 word “intel”—and even when it used that word as a trademark for its own (unrelated) services.

18 As set forth in ANIP’s original papers, the Lanham Act imposes liability upon any person
19 who (1) uses an infringing mark in interstate commerce, (2) in connection with the sale or
20 advertising of goods or services, and (3) such use is likely to cause confusion or mislead
21 consumers. 15 U.S.C. § 1114(1)(a). The crux of this legal wrong is that the defendant must have
22 used plaintiff’s trademark **so as to capitalize on its goodwill**. *See Avery Dennison Corp. v.*
23 *Sumpton*, 189 F.3d 868, 880 (9th Cir. 1999) (“commercial use under the Federal Trademark
24 Dilution Act requires the defendant to be using the trademark as a trademark, capitalizing on its
25 trademark status.”); *Academy of Motion Picture Arts and Sciences v. Network Solutions*, 989 F.
26 Supp. 1276, 1279-81 (C.D. Cal. 1997) (federal trademark infringement, cybersquatting and dilution
27 claims and state law unfair competition claims require that defendant “used” another’s mark
28 without permission in connection with its own goods and services); *Toho Co. v. Sears, Roebuck &*

1 *Co.*, 645 F.2d 788, 793 (9th Cir. 1981) (dilution doctrine codified in Business and Professions Code
 2 protects trademark holder from harm due to defendant’s “use” of its mark); *Sunset House*
 3 *Distributing Corp. v. Coffee Dan’s Inc.*, 240 Cal. App. 2d 748, 753 (1966) (state law trademark
 4 infringement and unfair competition claims require defendant’s “use of a confusingly similar
 5 tradename” to tradename used by plaintiff). Trademark rights only enable their owner to prohibit
 6 the use of that trademark “so far as to protect the owner’s good will against the sale of another’s
 7 product as his.” *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924).

8 Intel Corp.’s insistence that ANIP is indeed making “trademark use” of the INTEL mark is a
 9 red herring. It is true that, as incorporated into the compound phrases AMERICAS NEWS INTEL
 10 PUBLISHING, LATIN INTEL, and LATIN INTEL TRADE CENTER, the word “intel” is part of
 11 a trademark, but is being used along with the other words in those phrases as one. But as was
 12 demonstrated before and again below, defendant never used the INTEL trademark owned by Intel
 13 Corp. at all.

14 4. Any use by defendants of plaintiff’s mark is an example of a
 15 non-actionable generic meaning in different contexts.

16 The cases have not hesitated to give short shrift to plaintiffs, such as Intel Corp., seeking
 17 control over language and culture merely based on their stake in a particular combination of letters
 18 in the Latin alphabet. Such attempts are rejected even when the association—notwithstanding the
 19 genesis of the junior mark—is in fact obvious, yet consumer associations are not:

20 The First Amendment may offer little protection for a competitor who labels its
 21 commercial good with a confusingly similar mark, but “[t]rademark rights do not
 22 entitle the owner to quash an unauthorized use of the mark by another who is
 23 communicating ideas or expressing points of view.” *L.L. Bean, Inc. v. Drake*
 24 *Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir.1987). Were we to ignore the expressive
 25 value that some marks assume, trademark rights would grow to encroach upon the
 26 zone protected by the First Amendment. *See Yankee Publ’g, Inc. v. News Am. Publ’g,*
 27 *Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y.1992) (“[W]hen unauthorized use of another’s
 mark is part of a communicative message and not a source identifier, the First
 Amendment is implicated in opposition to the trademark right.”). Simply put, the
 trademark owner does not have the right to control public discourse whenever the
 public imbues his mark with a meaning beyond its source-identifying function. *See*
Anti-Monopoly, Inc. v. Gen. Mills Fun Group, 611 F.2d 296, 301 (9th Cir.1979) (“It
 is the source-denoting function which trademark laws protect, and nothing more.”).

28 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-901 (9th Cir. 2002) (no trademark

1 infringement in BARBIE trademark for dolls arising from performance of “Barbie Girl” song).

2 Perhaps no case better conveys this principal than the famous “LITE BEER” decision by the
3 Seventh Circuit Court of Appeals:

4 [E]ven if Miller had given its light beer a characteristic not found in other light
5 beers, it could not acquire the exclusive right to use the common descriptive word
6 “light” as a trademark for that beer. Other brewers whose beers have qualities that
7 make them “light” as that word has commonly been used remain free to call their
8 beer “light.” Otherwise a manufacturer could remove a common descriptive word
9 from the public domain by investing his goods with an additional quality, thus
10 gaining the exclusive right to call his wine “rose,” his whiskey “blended,” or his
11 bread “white.”

12 The word “light,” including its phonetic equivalent “lite,” being a generic or
13 common descriptive term as applied to beer, could not be exclusively appropriated
14 by Miller as a trademark, despite whatever promotional effort (Miller) may have
15 expended to exploit it. Because probability of success cannot be established, other
16 issues argued by the parties need not be decided, and the preliminary injunction must
17 be reversed.

18 *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 81 (7th Cir. 1977), *cert den.*,
19 444 U.S. 1102 (1980) (footnote and internal quotes and citations omitted). Here, Intel Corp. has
20 not acknowledged the relationship between its INTEL trademark and the obvious allusion to
21 “intelligence.” While Intel Corp. may refuse to acknowledge this relationship, the law
22 nevertheless remains in favor of ANIP: Preventing non-competitors from making use of a word as
23 part of marks bearing no relation to those of Intel Corp. or that suggest any possibility of confusion
24 is simply not permitted under the law. The meaning of a familiar, basic word in the English
25 vocabulary can depend on associations the word brings to consumers as a result of advertising.

26 As submitted as part of ANIP’s original motion, Professor McCarthy’s definitive treatise,
27 addresses this phenomenon under the rubric of “generic meanings in different contexts”:

28 Sometimes a word used as a trademark comes to have an entirely new “generic”
meaning or usage apart from its function as a trademark. This occurrence has been
described as “the parallel development of new dictionary meanings in the everyday
give and take of human discourse.” In one such case, a federal court refused to
enjoin public interest groups from referring to the “Strategic Defense Initiative” as
the “Star Wars Program” in television media, over the objection of the owner of the
STAR WARS motion picture trademark. The court reasoned that:

[T]he use of star wars in political propaganda, newspapers or
noncommercial, non-trade references will not undermine plaintiff’s
exclusive property right to use in connection with goods and services. ...
**Now the phrase star wars has acquired a double meaning ... The new
meaning of the phrase in the political context or scientific context**

1 **does not affect the distinct, and still strong secondary meaning of**
 2 **STAR WARS in trade and entertainment.**

3 This policy of allowing parallel “generic” use of a trademark in a different context
 4 acknowledges the dynamic nature of modern language: the meaning of a word or
 5 symbol is not necessarily fixed for all time as it is first used, or as it is defined in the
 6 dictionary, but may grow and develop new meaning and nuances according to its
 7 use. Although a word may have developed a new, generic meaning in a non-
 8 commercial, non-trade context, as long as it still functions in the commercial context
 9 to identify the good will of its source, it has meaning as a trademark and that
 10 meaning will be judicially protected against confusingly similar commercial use. . . .
 11 The trademark owner does not have the right to control public discourse whenever
 12 the public imbues his mark with a meaning beyond its source-identifying function.

13 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:3 (4th ed.2004)
 14 (“McCarthy”) (emphasis added, internal citations omitted), citing *Lucasfilm, Ltd. v. High Frontier*,
 15 622 F. Supp. 931, 969 (D.D.C. 1985); *Viacom International Inc. v. Komm*, 46 U.S.P.Q.2d 1233,
 16 1998 WL 177472 (T.T.A.B. 1998) (MY-T-MOUSE software not an infringement of MIGHTY
 17 MOUSE cartoon character though merchandised for use on toys, which could include computer
 18 toys and games); 56 *INTA Bulletin*, no. 14 p.1 (Aug. 1, 2001) (Hormel Foods “spam” litigation);
 19 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003)
 20 (“Some trademarks enter our public discourse and become an integral part of our vocabulary.”);
 21 *Illinois High School Ass'n v. GTE Vantage, Inc.*, 99 F.3d 244 (7th Cir. 1996) (“[A] court could not,
 22 without violating the free speech clause of the First Amendment, have enjoined (or used other legal
 23 remedies to prevent or deter) the media from calling the NCAA tournament ‘March Madness’ . . .
 24 [W]e think that for the sake of protecting effective communication [the issue] should be resolved
 25 against trademark protection, thus assimilating dual use of multiple use terms to generic terms.”).

26 In each of these cases the junior use was clearly an allusion to the trademark in question, yet
 27 was found non-infringing as a generic meaning in a different context. Trademark rights do not
 28 follow a change in meaning. ANIP’s position is far stronger, for it claims no change or
 “genericization” (or “genericide”) of the INTEL trademark. Rather, the generic word used by the
 defendant—“intel”—bears no conceptual, commercial, or semantic relationship to the trademark
 INTEL besides a common root in the word “intelligence” and, unfortunately for INTEL, identical
 spelling and pronunciation. The government officials, journalists and pundits quoted using the
 English term “intel” for “intelligence information” were obviously not referring to, much less

1 using, the INTEL trademark, and their listeners obviously could not be under any impression that
 2 they were. Thus neither can the same use of the same term in the same way by ANIP plausibly be
 3 alleged to constitute trademark infringement.

4 5. Plaintiff has failed adequately to plead facts amounting
 5 to a plausible claim of likelihood of confusion.

6 In determining whether confusion between related goods is likely, the Ninth Circuit
 7 considers eight factors: (1) strength of the mark; (2) relatedness of the goods and services; (3)
 8 similarity of the marks; (4) evidence of actual confusion; (5) marketing channel used; (6) type of
 9 goods and the degree of care likely to be exercised by the purchaser; (7) the defendant's intent in
 10 selecting the mark; and (8) likelihood of expansion of the product lines. *AMF, Inc. v. Sleekcraft*
 11 *Boats*, 599 F.3d 341, 349 (9th Cir.1979). The Amended Complaint fails, here, on multiple scores.

12 First, notwithstanding there is no plausible relation between the goods and services of
 13 plaintiff and defendant. Second, the uses of the word “intel” by defendant, even if those uses are
 14 construed by the Court as legally cognizable uses of the INTEL mark, and even if they are not
 15 deemed fair uses, they are not confusingly similar to the INTEL trademarks because they are not
 16 similar to the INTEL trademark; rather, they are embedded in longer, multi-word phrases of which
 17 “intel” is only a component of the phrase. Third, there is no allegation of actual confusion. Fourth,
 18 the types of goods and the marketing channels for these goods are entirely disparate—there is no
 19 **plausible** allegation here that a prospective customer interested in any service provided by plaintiff
 20 would choose or even consider defendant’s offerings instead. Fifth, there is not even a plausible
 21 allegation that plaintiff is going into the business of publishing area-related, much less specifically
 22 Latin America-related, policy analysis and “intel” in any form—general promotional literature
 23 about its own business sector hardly qualifying as “competitive.” Most of these facts are self-
 24 evident; defendant analyzes some of the relevant legal principles below.

25 a. *Defendant’s of the word “intel” as part of various longer phrases*
 26 *is not likely to be confused with the INTEL trademark.*

27 The “anti-dissection” rule provides that “[t]he commercial impression of a trademark is
 28 derived from it as a whole, not from its elements separated and considered in detail.” *Estate of*

1 *P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46, 40 S.Ct. 414, 64 L.Ed. 705 (1920);

2 McCarthy § 23:41. The Ninth Circuit has phrased the test this way:

3 [When a] mark is a composite term . . . its validity is not judged by an examination
4 of its parts. Rather, the validity of a trademark is to be determined by viewing the
5 trademark as a whole. *See Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366,
6 379 (7th Cir.), *cert. denied*, 429 U.S. 830, 97 S.Ct. 91, 50 L.Ed.2d 94 (1976).
7 “Words which could not individually become a trademark may become one when
8 taken together.” *Id.* “A composite geographical mark should not be dissected into its
9 parts . . . It is the likely reaction of customers to the total mark that is at issue.” 1 J.
10 McCarthy, *supra*, § 14:6, at 496 . . .

11 *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985).

12 Plaintiff’s trademark claim is based on the use by defendant of the word “intel” in the
13 phrases AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL and LATIN INTEL TRADE
14 CENTER. None of these phrases, however, is confusingly similar either to the INTEL mark itself,
15 nor to any of the multi-word marks alleged by plaintiff but which cannot plausibly be as likely to
16 be confused with defendant’s marks.

17 b. *Defendant’s of the word “intel” is not likely to be confused with the INTEL*
18 *trademark because each is used with completely different goods and services.*

19 “Even where there is precise identity of a complainant’s and an alleged infringer’s mark,
20 there may be no consumer confusion—and thus no trademark infringement—if the alleged infringer
21 is in a different geographic area or in a wholly different industry.” *Brookfield Communications,*
22 *Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054-56 (9th Cir. 1999) (“If, on the other
23 hand, Brookfield and West Coast did not compete to any extent whatsoever, the likelihood of
24 confusion would probably be remote”). Here geography is irrelevant, but surely the disconnection
25 between the parties’ different businesses is more than sufficient to deem the Complaint’s claim of a
26 likelihood of confusion implausible.

27 In *Viacom*, for example, the TTAB was easily able to distinguish between the rights of
28 Viacom in the MIGHTY MOUSE trademarks and the software at issue in that opposition
proceeding based on a record indicating that despite the virtual identity of the trademarks in
question as a matter of law—MIGHTY MOUSE and MY-T-MOUSE—consumers simply would
not confuse the animated rodent superhero with software to enhance the performance of a computer

1 mouse, even where (unlike here) it was obvious that former was meant as an allusion to the latter.
2 Where, as here, the Amended Complaint itself makes it clear that there is no coherent connection
3 between the goods and services offered by the plaintiff and those of the defendant, it is entirely
4 proper for a court to dismiss trademark claims for failure to plead a plausible case of likelihood of
5 confusion at the pleadings stage:

6 A likelihood of confusion exists when a consumer viewing a service mark is likely
7 to purchase the services under a mistaken belief that the services are, or associated
8 with, the services of another provider. *Rodeo Collection, Ltd. v. West Seventh*, 812
9 F.2d 1215, 1217 (9th Cir.1987). The confusion must “be probable, not simply a
possibility.” *Id.* If goods or services are totally unrelated, there is no infringement
because confusion is unlikely. *AMF v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th
Cir.1979).

10 *Murray v. Cable Nat. Broadcasting Co.*, 86 F.3d 858, 861 (9th Cir. 1996) (rejecting suggestion that
11 12(b)(6) relief unavailable in Lanham Act cases on likelihood of confusion grounds). Similarly, no
12 plausible likelihood of confusion has been pleaded. And while *Viacom* was procedurally
13 distinguishable from this case, the TTAB's argument for rejecting a claim of likelihood of
14 confusion is completely applicable here: all the Court needs to know perform the same analysis is
15 indeed contained in the Complaint.

16 ANIP publishes—or, until plaintiff destroyed its business by its legal threats, did publish—a
17 newsletter and blog offering “intel,” or intelligence information, about world affairs, and in
18 particular about Mexico and Latin America. Intel Corp. sells computer chips and related goods and
19 services. Intel Corp.’s allegation that it in competes with defendant at all because it publishes
20 newsletters is preposterous, and falls far short of the plausibility standard of Rule 12(b)(6).¹ This
21 would, after all, apply to virtually all modern commerce, communication, and human intercourse in
22 almost the whole world. Indeed, as an initial matter, the TTAB was not at all impressed, as this
23 Court should not be, with broad claims by a trademark owner that its mark is all about “the
24 Internet,” and that “the Internet” is all about absolutely anything:

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27 ¹ Intel’s throwaway invocation of its “design center in Guadalajara” (¶ 14) suggests both its
28 desperation and cynicism on this point. It also ignores the fact that, as the Amended Complaint
itself states, the target audience of defendant’s publications was not in Mexico at all, but
“individuals in the U.S.” (¶ 14).

1 The mere fact that computer accessories and computer toys and games involve the
 2 use of computers or software, and that applicants' goods are also computer software,
 3 does not, in and of itself, demonstrate that the computer software on which
 4 applicants use their mark is within the natural scope of expansion of the use of
 5 opposer's mark. As we have said in the context of determining whether products are
 6 related, "Given the ubiquitous use of computers in all aspects of business in the
 7 United States today, this Board and its reviewing Court have rejected the view that a
 relationship exists between goods and services simply because each involves the use
 of computers." *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d
 1460, 1463 (TTAB 1992). See also *Octocom Systems, Inc. v. Houston Computers
 Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Information
 Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988). . . .

8 *Id.* Plaintiff's "wide variety of computer, communications and Internet-related products and
 9 services" allegation proves too much, and helps the Court focus on the paucity of allegations that
 10 could amount to a substantive basis to find that likelihood of confusion had been pleaded here.

11 Indeed, and again in *Viacom*, after brushing away the "Internet and computers" distractions,
 12 the TTAB relied, in finding that there was no likelihood of confusion, on a far more fundamental
 13 fact. In short, the two trademarks existed in completely different conceptual "spaces"—just as the
 14 INTEL trademark associated with computer chips are plainly not be likely, and cannot plausibly be
 15 alleged as likely, to be confused with regional or strategic "intel" delivered via a newsletter or blog:

16 Moreover, the marks have different connotations, in that applicants' mark is actually
 17 used in connection with the computer peripheral known as a "mouse," and this
 18 meaning is further emphasized by the informational language in the mark, THE
 19 SOFTWARE THAT MAKES YOUR MOUSE A MOUSE THAT TYPES. Thus, it
 is the connotation of the computer accessory, rather than of the cartoon animal
 associated with opposer's mark, that consumers will perceive.

20 *Viacom*, 46 U.S.P.Q.2d 1233, 1998 WL 177472. Computer mouses are not cartoon mice, just as
 21 INTEL chips and their "related goods and services" could never, in the mind of a consumer,
 22 plausibly be alleged to connote publishing about overseas affairs.

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 24 6. The fame of defendant's mark does not enhance the plausibility
 25 of its allegations of a likelihood of confusion because
defendant's use of the word "intel" is not a "competing mark."

26 Finally, there is the matter of fame, which, while not the same as "strength" in trademark
 27 terms, is an issue in a trademark case such as this one. Indeed "a mark's fame creates an incentive
 28 for competitors "to tread closely on the heels of a very successful trademark," and "A strong mark .

1 . . . casts a long shadow which competitors must avoid.” *Kenner Parker Toys Inc. v. Rose Art*
2 *Industries, Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992). For this reason, “the Lanham Act’s tolerance
3 for similarity between competing marks varies inversely with the fame of the prior mark. As a
4 mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.” *Id.* But these
5 considerations are relevant only to competing goods and services, which it cannot plausibly alleged
6 are implicated by this Complaint. In *Viacom*, the TTAB set out an important lesson for those who
7 are unduly impressed with the fame of a trademark and who assert, or believe, that the owner of a
8 famous trademark is entitled, per se, to own or control every manifestation of some version of it
9 that might occur in common parlance:

10 We acknowledge that applicants’ mark MY-T-MOUSE and design might bring to
11 mind the cartoon MIGHTY MOUSE. However, this does not necessarily mean that
12 consumers will be confused into believing that the two marks indicate the same
13 source of origin. See *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212
14 USPQ 641, 642 (CCPA 1982) (the fact that one mark may bring another to mind
15 does not in itself establish likelihood of confusion as to source). See also, *Original*
16 *Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717 (TTAB 1987) As the Court
17 stated in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*,
18 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983):

19 likely * * * to cause confusion means more than the likelihood that the public
20 will recall a famous mark on seeing the same mark used by another. It must
21 also be established that there is a reasonable basis for the public to attribute
22 the particular product or service of another to the source of the goods or
23 services associated with the famous mark. To hold otherwise would result in
24 recognizing a right in gross, which is contrary to principles of trademark law
25 and to concept embodied in 15 USC Section 1052(d).

26 Thus, even in the case of a famous mark (and, as we have stated, on this record
27 MIGHTY MOUSE does not rise to the level of a famous mark), the mere fact that
28 the junior user’s mark may remind the public of the famous mark does not mean that
the use of the junior mark is likely to cause confusion. For the reasons given above,
we find that consumers will distinguish between the parties’ marks, and are not likely
to believe that applicants’ identified software, sold under the MY-T-MOUSE and
design mark, emanates from or is sponsored by the same source as the MIGHTY
MOUSE cartoon character.

Here, too, it cannot plausibly be alleged that consumers encountering newsletters, blogs or
consulting services utilizing the marks AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL
and LATIN INTEL TRADE CENTER would possibly think they emanate from or are sponsored by
computer-chip maker Intel Corp.

1 7. Plaintiff has failed to state a claim that defendant’s use of
2 the word “intel” is likely to dilute its INTEL mark.

3 To prevail on its dilution by blurring claim, Intel Corp. has the burden of proving by a
4 preponderance of evidence: (a) that it is the owner of a trademark that is famous; (b) that the
5 famous mark is distinctive, either inherently or through acquired distinctiveness; (c) that defendant
6 is making or has made use in commerce of an identical or nearly identical trademark; (d) that
7 defendant's use of the INTEL mark began after it became famous; and (e) that defendant’s use of
8 the word “intel” as part of its AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL and
9 LATIN INTEL TRADE CENTER marks is likely to cause dilution by blurring of the INTEL
10 trademark. 15 U.S.C. § 1125(c); *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 634 (9th Cir. 2007).

11 As set forth above, plaintiff cannot establish all these elements. The first two elements as
12 well as the fourth are not at issue, but it is clear that defendant is not making and has not made use
13 in commerce of an identical or nearly identical trademark to INTEL by its own use of the English
14 word “intel” in the marks AMERICAS NEWS INTEL PUBLISHING, LATIN INTEL and LATIN
15 INTEL TRADE CENTER. These are simply not identical, or nearly identical, trademark uses.

16 The Amended Complaint similarly fails as to the likelihood of causing dilution by blurring.
17 “Dilution by blurring” is association arising from the similarity between a mark or trade name and a
18 famous mark that impairs the distinctiveness of the famous mark. 15 U.S.C. § 1125(c)(2)(B). But
19 while the INTEL mark remains distinctive in its own right, the word “intel” has its own meaning, is
20 in widespread—indeed, nearly universal—use that has no connection to Intel Corp. or its business,
21 and is either properly considered a separate word or “mark” from the plaintiff’s INTEL mark or, by
22 virtue of its use as a word, a clear indication that the distinctiveness that plaintiff claims for its
23 mark is long gone, and that defendant’s actions have nothing at all to do with that.

24 8. Plaintiff has failed to state a claim that defendant’s use of the
25 word “intel” in its domain names constitutes cybersquatting.

26 To establish liability under the Anticybersquatting Consumer Protection Act (“ACPA”), a
27 plaintiff must prove that the defendant: “(i) has a bad faith intent to profit from [a] mark ...; and (ii)
28 registers, traffics in, or uses a domain name that . . . (II) in the case of a famous mark that is famous

1 at the time of registration of the domain name, is identical or confusingly similar to or dilutive of
2 that mark.” 15 U.S.C. § 1125(d)(1)(A). A “trademark owner asserting a claim under the ACPA
3 must establish [that] . . . the defendant's domain name is identical or confusingly similar to, or in
4 the case of famous marks, dilutive of, the owner's mark . . . with a bad faith intent to profit.” *Bosley*
5 *Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 681 (9th Cir. 2005) (internal quotes and citations
6 omitted). “In determining whether there is a likelihood of confusion under the ACPA, courts
7 compare the plaintiff's mark with the name of the website. . . . if the name of the website at issue
8 itself makes clear that it is not affiliated with the plaintiff's mark, there can be no likelihood of
9 confusion.” *Ringcentral, Inc. v. Quimby*, 2010 WL 1459736 at *10 (N.D.Cal. 2010). For all the
10 reasons set forth above, the Amended Complaint fails plausibly to allege either identity, confusing
11 similarity, or a likelihood of dilution.

12 As to bad faith, this Court has defined the limits of this concept clearly:

13 H.R. Conf. Rep. No. 106-464 (1999) (“[T]he bill does not extend to innocent domain
14 name registrations by those who are unaware of another's use of the name, or even to
15 someone who is aware of the trademark status of the name but registers a domain
16 name containing the mark for any reason other than with bad faith intent to profit
17 from the goodwill associated with that mark,” quoted in *Harrods*, 110 F.Supp.2d at
426 (emphasis added)); S.Rep. No. 106-140 (“Under the bill . . . the abusive conduct
that is made actionable is appropriately limited just to bad-faith registrations and
uses of others' marks by persons who seek to profit unfairly from the goodwill
associated therewith,” quoted in *Harrods*, 110 F.Supp.2d at 426 (emphasis added)).

18 *Solid Host, NL v. Namecheap, Inc.*, 652 F. Supp. 2d 1092, 1109 (C.D. Cal. 2009). Considering the
19 Court's ruling on ANIP's prior motion, suggesting, to put it lightly, the existence of a very sound
20 good faith basis that ANIP had the right to register its domain names, and all the other foregoing
21 arguments bearing on ANIP's actions, the ACPA's definition of bad faith cannot be met by the
22 allegations in the Amended Complaint.

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CONCLUSION

Accordingly, for all of the foregoing reasons, this Court should grant defendants' Motion to Dismiss the Amended Complaint with prejudice.

Dated: May 17, 2010

Respectfully submitted,
CARR & FERRELL *LLP*

By: /s/ Colby B. Springer
COLBY B. SPRINGER

Attorneys for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC

RONALD D. COLEMAN
GOETZ FITZPATRICK LLP

Of Counsel for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC