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

Of Counsel:
RONALD D. COLEMAN (*Admitted Pro Hac Vice*)
RColeman@goetzfitz.com
GOETZ FITZPATRICK LLP
One Penn Plaza—Suite 4400
New York, New York 10119
Telephone: (212) 695-8100

Attorneys for Defendant
AMERICAS NEWS INTEL PUBLISHING, LLC

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

INTEL CORPORATION,

Plaintiff,

v.

AMERICAS NEWS INTEL PUBLISHING, LLC,

Defendant.

CASE NO. CV 09-05085 CRB

DEFENDANT'S REPLY IN SUPPORT OF MOTION TO DISMISS INTEL CORPORATION'S FIRST AMENDED COMPLAINT

Date: July 2, 2010
Time: 10:00 a.m.
Courtroom: 8, 19th Floor
Judge: Hon. Charles R. Breyer

Defendant America's News Intel Publishing, LLC ("ANIP") hereby submits its memorandum of points and authorities in further support of its motion to dismiss the amended complaint pursuant to Fed. R. Civ. P. 12(b)(6).

Dated: June 18, 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

SUMMARY OF ARGUMENT

Plaintiff Intel Corporation ("Intel") argues, in its opposition to Americas News Intel Publishing, LLC ("ANIP")'s motion to dismiss Intel's First Amended Complaint, that the reed-thin amendments of the First Amended Complaint pass muster under Federal Rule of Civil Procedure (12)(b)(6). While Plaintiff Intel may have changed the wording, the First Amended Complaint still presents a patently implausible claim: that the mark LATIN INTEL for consulting on the Latin Americas and a newsletter for the same infringes the INTEL trademarks associated with computer hardware and related services. Intel's opposition is entirely casuistic and addresses none of the fundamental flaws in reasoning or defensibility (or lack thereof) of the legal result sought by way of Intel's initial complaint. That complaint was dismissed in that the result sought by Intel through its pleading was one that the law does not, and should not, provide. The Court should similarly end this matter—once and for all—by dismissing the First Amended Complaint and the present action with prejudice.

LEGAL ARGUMENT

A. MOTIONS TO DISMISS UNDER RULE 12(b)(6) ARE NOT DISFAVORED AND ARE PROPERLY GRANTED TO DISMISS PATENTLY MERITLESS CLAIMS SUCH AS THOSE IN THE FIRST AMENDED COMPLAINT.

Intel's argument that the Court should be disinclined to dismiss this action based on broad statements in the cases about the low standard of notice pleading does not succeed at remedying the fact that the First Amended Complaint does not, as set forth in ANIP's moving papers, even meet that purported standard.

Most of the points raised in the Intel opposition do not require further reply and have been sufficiently addressed in ANIP's initial moving papers seeking dismissal of the First Amended Complaint. Among those few arguments by Intel that warrant additional commentary in that they actually address the merits of the present motion is the contention that "the applicable law here does not prevent anyone from use of a word, but it does preclude use of a trademark that is likely to dilute or confuse, regardless of a defendant's intent in selecting a mark." In fact, this formulation is

no more than a distraction, because (a) the First Amended Complaint still fails to set out a plausible case that there could be a likelihood of confusion or dilution here, and (b) ANIP never suggested that its "intent" in any way affects the legal issues of likelihood of confusion or of dilution.

That is because ANIP never used the INTEL trademark. ANIP used the English word "intel." This is not sophistry. It is the fundamental problem with each and every one of Intel's claims.

Intel states, "[d]efendant also argues that 'government officials, journalists and pundits' freely use the term 'intel' to refer to military intelligence. Again, this assertion is not relevant to whether Intel has properly pled its claim." Intel could not be more wrong. This so-called "irrelevance" is wishful thinking by Intel as this use, which Intel does not and cannot dispute, has **everything to do with whether Intel has properly pled its claim**. This is not because there is a question of whether Intel knows how to prepare a lawsuit, but because within the ambit of a "properly pled claim" lies not only artfulness in draftsmanship but **the existence of a cognizable legal claim**. This, Intel does not have.

Intel relegates its response to the substantive legal claims to a footnote, using examples of trademarks that are common dictionary terms. This mischaracterizes ANIP's argument and utterly fails to wrestle with the four-square applicability of cases such as *Mattel, Inc. v. MCA Records, Inc*., 296 F.3d 894 (9th Cir. 2002) and *Miller Brewing Co. v. G. Heileman Brewing Co., Inc*., 561 F.2d 75 (7th Cir. 1977), *cert den*., 444 U.S. 1102 (1980) as to when a non-competitive or **even competitive** use is made of a word from the language that coincides with a trademark used in an entirely different context. Intel relies on Professor McCarthy, but ignores this passage from ANIP's moving brief, and worthy of being repeated here because it so fundamentally addresses the only real issue in this case:

> This policy of allowing parallel "generic" use of a trademark in a different context acknowledges the dynamic nature of modern language: the meaning of a word or symbol is not necessarily fixed for all time as it is first used, or as it is defined in the dictionary, but may grow and develop new meaning and nuances according to its use. Although a word may have developed a new, generic meaning in a non-commercial, non-trade context, as long as it still functions in the commercial context to identify the good will of its source, it has meaning as a trademark and that meaning will be judicially protected against confusingly similar commercial use. . . .

> **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.**

4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:3 (4th ed.2004) (emphasis added). Nothing in Intel's opposition brief, including its insufficient legal responses to ANIP's legal arguments respecting the specific legal issues and its "implausible" attempts to enunciate legally cognizable confusion or dilution, addresses this entirely dispositive and fundamental legal issue.

CONCLUSION

Accordingly, this Court should grant defendant's Motion to Dismiss Intel's First Amended Complaint.

Respectfully submitted,

Dated: June 18, 2010

CARR & FERRELL *LLP*

By: /s/ Colby B. Springer
COLBY B. SPRINGER
Attorneys for Defendant
AMERICAS NEWS INTEL PUBLISHING

RONALD D. COLEMAN
GOETZ FITZPATRICK LLP
Of Counsel for Defendant
AMERICAS NEWS INTEL PUBLISHING