

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

JONATHAN ELLER and MORMON
MATCH LLC,

Plaintiffs,

v.

INTELLECTUAL RESERVE, INC.,
a Utah Corporation, holding intellectual
property for The Church of Jesus Christ
of the Latter-day Saints,

Defendant.

CIVIL ACTION NO.: 14-CV-00914

**BRIEF OF AMICUS CURIAE ELECTRONIC FRONTIER FOUNDATION
IN SUPPORT OF JONATHAN ELLER**

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STATEMENT OF INTEREST

The Electronic Frontier Foundation (“EFF”) is a nonprofit civil liberties organization that has worked for more than 20 years to protect consumer interests, innovation, and free expression in the digital world. EFF and its more than 20,000 dues-paying members have a strong interest in helping the courts and policy-makers in striking the appropriate balance between intellectual property rights and the public interest.

Counsel for proposed amicus curiae Electronic Frontier Foundation affirms that no party, or counsel for any party, authored any part of this brief in whole or in part, and that no payment for the preparation or submission of this brief was made by anyone other than amicus curiae.

INTRODUCTION

Amicus Electronic Frontier Foundation submits this brief because we believe there is more at stake in this litigation than the simple question of whether an online dating site should have to change its name. Intellectual Reserve, Inc. (“IRI”) has brought numerous claims against Jonathan Eller, a small startup entrepreneur that in all likelihood cannot afford to fight. And that is unfortunate, because Eller’s use of the term “Mormon” is indisputably fair.

Cases such as this one, where the affirmative defense of fair use is so clear from the outset, can and should be dismissed at the earliest possible stage of litigation. As this Court is aware, discovery can be expensive and time-consuming in trademark cases. In addition to the usual attorneys fees and costs, litigants must often hire experts to conduct and/or debunk large surveys identifying consumer confusion. These expenses quickly add up to eye-popping amounts. *See, e.g., Mattel, Inc. v. Walking Mountain Prods.*, No. CV99-8543RSWL, 2004 WL 1454100, at *4 (C.D. Cal. June 21, 2004) (awarding defendant \$1,584,089 in legal fees and \$241,797 in costs). Such expenses can be enough to stifle a business in its infancy, no matter how meritorious the company’s legal position. Some start-up entrepreneurs will choose to play it safe by changing the content of their services, or not creating certain services at all, because they cannot afford to litigate their

rights. And even if an entrepreneur is willing to take a risk, his partners and funders might be more risk-averse.

Moreover, these effects are not confined to the commercial realm. Artists and activists regularly use trademarks in the course of their work. While these uses are normally protected by a variety of doctrines, including fair use, that has not stopped trademark owners from using trademark threats to attempt to silence their critics. *See, e.g., Chamber of Commerce v. Servin*, No. 1:09-cv-02014-RWR (D.D.C. filed Oct. 26, 2009) (trademark claim against Yes Men for using logo in parody of Chamber’s position on climate change); *Dardenne v. Moveon.org*, No. 3:14-cv-00150-SDD-SCR (M.D. La. filed Mar. 14, 2014) (trademark claim against Moveon.org for parody of Louisiana motto).

Thus, where a case can be resolved without such expense, it should be. By granting Eller’s motion now, this Court will help ensure not only that Eller’s business can survive, but also that other similarly situated persons, from entrepreneurs to authors, filmmakers, cartoonists, songwriters, and other creators will not feel pressured or succumb to meritless infringement claims.

ARGUMENT

A. Eller’s Use of the Term “Mormon” Is a Textbook Fair Use

“The fair-use defense allows a party to use a term in good faith to describe its goods or services . . . when the term is used in its descriptive sense rather than

in its trademark sense.” *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 270-71 (5th Cir. 1999). A term is descriptive if it “denote[s] ‘a characteristic or quality of an article or service.’” *Test Masters Educational Services, Inc. v. Singh*, 428 F.3d 559, 566 (5th Cir. 2005) (quoting *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983)).

IRI admits that the term “Mormon” can be used to refer to members of The Church of Jesus Christ of Latter-day Saints, i.e., that it is a descriptive term. IRI’s Amended Answer, Dkt. No. 33, at ¶116; *see also* IRI’s Opp. to Motion to Dismiss, Dkt. No. 45, at 5 (“The word ‘Mormon’ is often used to denote members of the Church”). Given that IRI does not and cannot own the right to use “Mormon” in its descriptive sense, *see KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004)¹, IRI’s concession dooms its claims. There is no reason that a service devoted to connecting those church members with each other cannot use the term usually used to “denote” those members, any more than it would be prevented from using the term “match.”

First, trademark rights do not cabin all uses of a terms that happens to be a mark, but only those that are used by the public to identify a source. “The key issue . . . is whether use of the term is meant to identify the source of the good or service,

¹ In *KP Permanent Make-Up, Inc.*, the Supreme Court held that rights in descriptive marks do not extend to rights in the original, descriptive meaning. *Id.* at 122.

or whether such use is meant solely to describe the product.” *Rin Tin Tin, Inc. v. First Look Studios, Inc.*, 671 F.Supp.2d 893, 899 (S.D. Tex. 2009). “This right to describe is the reason that descriptive terms qualify for registration as trademarks only after taking on secondary meaning as distinctive of the applicant’s goods, with the registrant getting an exclusive right not in the original, descriptive sense, but only in the secondary one associated with the markholder’s goods.” *KP Permanent Make-Up, Inc.*, 543 U.S. at 122 (internal citations and quotations omitted); *see also Car-Freshner Corp. v. S. C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995) (noting importance of “protect[ing] the right of society at large to use words or images in their primary descriptive sense”).

Eller is not using the term “Mormon” to describe the source of his services, but rather the nature of his services. *See Western Pub. Co., Inc. v. Rose Art Industries, Inc.*, 733 F. Supp. 698, 700-01 (S.D.N.Y. 1990), order aff’d on other grounds, 910 F.2d 57 (2d Cir. 1990) (descriptive use was not a trademark use even where defendant put a “TM” after use of the composite MAGNETIC GOLDEN SLATE containing the descriptive term GOLDEN). Eller is not attempting to trademark the term “Mormon Match”, nor has he expressed any intent to use “Mormon” in any sense other than to describe his service. Furthermore, Eller clearly disclaims any affiliation with The Mormon Church on his website.

Second, potential confusion as to whether the Mormon Church sanctions the website “Mormon Match” because it happens to hold some limited rights in some versions of “Mormon” is irrelevant. As recognized by the Supreme Court, the Lanham Act provides “no indication that the statute was meant to deprive commercial speakers of the ordinary utility of descriptive words. If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well known descriptive phrase.” *KP Permanent Make-Up, Inc.*, 543 U.S. at 122 (internal quotation marks and citation omitted). Indeed, it has long been established that “[t]he use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product.” *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 529 (1924).

Third, Eller’s use of “Mormon” is undoubtedly done fairly and with good faith. *See Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1187 (5th Cir. 1980) (use of the descriptive mark “larvicide” fair where allegedly infringing product “kills specifically larvae and nothing else”). Simply put, Eller uses the term “Mormon” because it is the most precise way to describe his service: a dating website run by Mormons to facilitate relationships between Mormons. Indeed, as mentioned, IRI admits as much when it admits the potential for the descriptive use of “Mormon.” *See IRI’s Amended Answer*, Dkt. No. 33, at ¶ 116.

IRI cannot restrict Eller from using the word “Mormon” to describe his Mormon matching service as “Mormon Match,” any more than Burger King® could prevent In-n-Out Burger® from including the term “burger” in its name.

B. Early Dismissal on Fair Use Grounds Supports the Balance Between Trademark and Free Speech

1. Early Dismissals Help Limit the Harm of Frivolous Lawsuits

In a world where trademarks are part of common discourse, “trademarks [must] not be transformed from rights against unfair competition to rights to control language.” *CPC Int’l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (internal quotation marks and citation omitted); *see also Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004). Because of this potential threat, Congress and reviewing courts have made quite clear that “the Lanham Act is intended to protect the ability of consumers to distinguish among competing producers, not to prevent all unauthorized uses.” *Utah Lighthouse Ministry v. Foundation for Apologetic Info. & Research*, 527 F.3d 1045, 1052 (10th Cir. 2008) (internal quotation marks and citation omitted).²

² The ability of the public to use trademark terms without liability has also been recognized as important for fostering the public discourse. *See Alex Kozinski, Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960, 973 (1993) (“[Trademarks] often provide some of our most vivid metaphors, as well as the most compelling imagery in political campaigns [A]llowing the trademark holder to restrict their use implicates our collective interest in free and open communication.”); *see also Robert C. Denicola, Trademarks as Speech: Constitutional Implications of the*

Nonetheless, as trademark scholars have noted, it is a common and unfortunately effective speech-chilling tactic to bring trademark infringement actions against those engaging in the fair use of marks. *See, e.g.*, Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus That the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 Va. J.L. & Tech. 3, 14 (2005) (“Many non-competitive users of trademarks in artistic, cultural, and political speech have finally prevailed in court only after incurring massive costs. Such costs, including attorney’s fees, the costs of expert witnesses, lost time, and uncertainty can deter both lawful and unlawful conduct—indeed, the ‘specter of such expenses’ is part of traditional deterrence analysis.”). Given the threat of high legal bills to defend against baseless claims, it is unsurprising that such tactics are used. One recent study from the American Intellectual Property Law Association estimated that median trademark litigation cost is \$300,000 when less than \$1 million is at issue, \$800,000 when \$1-\$25 million is at issue and \$1,500,000 when over \$25 million is at issue. Divine, D. & Goldstein, R., *AIPLA Report on the Economic Survey*, at 35 (2013).

Emerging Rationales for the Protection of Trade Symbols, 1982 Wis. L. Rev. 158, 195-96 (“Famous trademarks . . . become an important, perhaps at times indispensable, part of the public vocabulary. Rules restricting the use of well-known trademarks may therefore restrict the communication of ideas.”).

By dismissing this case now, this Court will not only limit the harm of IRI's improper counterclaims, but also help deter future trademark "bullies" from abusing the legal process solely to deter lawful conduct.

Moreover, discovery here would serve no purpose other than to needlessly increase the costs on the parties. Indeed, IRI cannot point to any discovery it needs in order for this case to be resolved. IRI admits that the term "Mormon" has a descriptive meaning in that it refers to members of the Mormon Church. IRI's Amended Answer, Dkt. No. 33, at ¶ 116. Eller makes clear that he is only using the term in its descriptive sense and has disclaimed all rights to the term "Mormon" as a mark. Complaint, Dkt. No. 1, at ¶¶ 114-119 & ¶¶ 43-44 (disclaiming rights in "Mormon Match"). There can be no doubt that using the term "Mormon" to describe Mormons is a fair and good faith use of the term. Discovery would not change any of these facts.

2. If Necessary, This Court Can Convert the Extant Motion to One for Summary Judgment and Rule in Eller's Favor

"[W]hen all relevant facts are presented, the court may properly dismiss a case before discovery...on the basis of an affirmative defense." *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687, 690 (7th Cir. 2012). This Court should not hesitate to dismiss IRI's claims on the pleadings. However, should the Court determine Eller's motion is more properly considered under Federal Rule of Civil Procedure 56, this Court need not wait until the end of expensive discovery to rule.

Discovery would only prove what we all know to be true: IRI does not own the word “Mormon”, and cannot prevent Eller from using it in its descriptive sense to describe his product. The court has the information it needs, whether it treats this motion as one under Rule 12(b)(6), 12(c), or 56, to rule in Eller’s favor.

CONCLUSION

For these reasons, IRI’s trademark claims relating to the use of the descriptive term “Mormon” should be dismissed.

May 30th, 2014

Respectfully Submitted,

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