

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.

April 22, 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.)

Brief of Appellant Steven C. Brodsky

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*1 STATEMENT OF SUBJECT MATTER AND APPELLATE JURISDICTION

The District Court's jurisdiction in this action for trademark infringement and related claims is based on 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338. Pursuant to 28 U.S.C.A. § 1292(a)(1), this Court has jurisdiction over this appeal from a preliminary injunction entered on March 19, 1998. Defendant Steven Brodsky filed his timely Notice of Appeal on April 1, 1998.

STATEMENT OF ISSUES FOR CONSIDERATION ON THIS APPEAL

1. Does 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 violate the First Amendment?

2. Did the District Court improperly curtail 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 may not be used by appellant as the name of his Internet website?

3. Is appellant's use of an unregistered word combination to promote his religious point of view on the Internet, and to provide access to a non-profit, non-commercial website sharing his views, commercial speech under the Anti-Dilution Act?

4. Did appellant infringe appellee's stylized registered trademark("JEWS F??R JE-SUS") by using non-stylized, unregistered elements of the stylized mark ("jewsforjesus")?

*2 5. Is the phrase "Jews for Jesus" generic as applied to Jews who are for Jesus?

6. Did the District Court abuse 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?

7. Did the District Court abuse its discretion by issuing a preliminary injunc-

tion despite appellee's failure to prove a reasonable likelihood of success on the merits of its claims concerning the scope and status of its registered and alleged common law trademarks?

8. Did appellee sustain its burden of proving irreparable harm?

STATEMENT OF THE CASE

In mid-December 1997, appellant Steven Brodsky posted an Internet website that he used to express his opposition to the appellee organization, a non-profit Christian missionary group that targets Jews for conversion to Christianity based on the proposition that one can simultaneously be a Jew and a Christian. Mr. Brodsky, a Jew, named his website www.jewsforjesus.org. [FN1] A138, A008. The subject matter of his website was Jews who are "for Jesus." The content of his website was unequivocal in its *3 opposition to appellee and to the concept that Jews can be for Jesus. It offered users the opportunity to "hyperlink," or transfer, to a website operated by an anti-missionary organization called Outreach Judaism. A361. In late December 1997, a truthful disclaimer of affiliation with either plaintiff or Outreach Judaism was added to the display, which in total reads as follows:

FN1. Mr. Brodsky also registered the domain name jews-for-jesus.com, but deleted this registration shortly thereafter. The District Court held that this domain name is no longer in dispute. A351.

Jews for Jesus?

Are you interested in learning about Jews and Jesus?

Want to know why one cannot believe in Jesus and be a Jew?

The answers you seek already exist within your faith.

Come home to the truth and beauty of Judaism.

Don't be fooled.

Click *here* to learn more about how the Jews for Jesus cult is founded upon deceit and distortion of fact.

PLEASE NOTE

This website is an independent project which reflects the personal opinion of its owner, and is in no way affiliated with the Jewish organization Outreach Judaism, or the Christian organization Jews for Jesus.

Send all correspondence to stevebro@worldnet.att.net

A361.

Mr. Brodsky had no commercial purpose whatsoever in operating his website. No so-

licitation of funds, no advertisement or other message bearing in any way on commerce, appeared on the site. *Id.* The websites of both plaintiff and Outreach Judaism are also noncommercial. Neither charges a fee for access nor carries commercial advertisements. Both websites, operated by non-profit religious organizations, offer literature promoting their *4 respective causes and points of view, in some cases for payment of a fee. A117; A129. In the cases of both the Outreach Judaism and Jews for Jesus websites, the sale of religious materials is incidental to the expressive religious messages of the respective websites. *Id.*

The words "Jews for Jesus" do not comprise a registered trademark. Plaintiff holds a registered trademark in the stylized mark, JEWS F??R JESUS, which stylized mark explicitly disclaims the words "Jews" and "Jesus" and expressly claims rights in the mark only "as shown" (i.e., incorporating a Star of David) on the registration. A036. There is no evidence that appellee ever attempted to register the words "Jews for Jesus" or that it ever claimed monopoly rights in them before this dispute arose. [FN2]

FN2. There is no evidence of plaintiff ever using the (R) symbol, the designation provided for by [15 U.S.C.A. § 1111](#), or other claim of reservation of rights in the words "Jews for Jesus" or its stylized registered mark, JEWS F??R JESUS.

On December 23, 1997, James Erikson, counsel for appellee sent a letter to Mr. Brodsky claiming that he was infringing on trademark rights owned by Jews for Jesus ("the Erikson letter"). Significantly, the Erikson letter, on stationery topped with the JEWS F??R JESUS trademark registered by appellee, was straightforward in its description of the sole trademark appellee claimed Mr. Brodsky was infringing. It stated that Mr. Brodsky's domain name "violates the rights of Jews for Jesus, holder of the trademark, 'Jews F??r Jesus'" (emphasis added). Erikson did not *5 claim appellee held a trademark in the words "Jews for Jesus" used without a Star of David. A054.

Mr. Brodsky responded that same day, explaining that he did not believe he was infringing the registered trademark of Jews for Jesus, and noting that there were "numerous and substantial differences between [Jews for Jesus'] alleged trademark and the domain name" ("the Brodsky letter"). A055. On January 16, 1998 outside counsel for Jews for Jesus sent a letter instructing Mr. Brodsky to cease and desist from the use of his domain name ("the January 16 letter"). The January 16 letter, while long, did not respond to the contentions of the Brodsky letter or in any way address the distinction raised by Mr. Brodsky between the rights claimed by appellee and its registered trademark though it did, strangely, claim that Mr. Brodsky was infringing appellee's "federally-registered marks" (i.e., plural). A093A-95 (emphasis added). Based on these letters, Mr. Brodsky continued to believe that the claims by Jews for Jesus were legally unfounded and intended solely to harass a vocal opponent. A139.

On January 21, 1998, appellee filed suit against Mr. Brodsky, claiming infringement of its registered mark as well as common-law infringement, trademark dilution and other related claims. Appellee sought a temporary restraining order ("TRO") and a preliminary injunction against Mr. Brodsky's activities. A006. Pursuant to the District Court's suggestion at a February 13, 1998 hearing, appellee agreed to withdraw its TRO request and treat the *6 hearing as one solely for a preliminary injunction. A276-77.

The application for restraints was supported by a number of affidavits. Three of the affidavits, those of Vijay Chellathurai (as amended), Michael Kalstein and Donald Sanchez, purported to show actual confusion. A135, A079, A257. Executed during the period between appellee's contacts with Mr. Brodsky and the filing of the litigation, these affidavits described how each of the affiants, who apparently are Christians (none attested to being Jews), sought plaintiff's website on the Internet by manually inputting the Internet domain name jewsforjesus.org, and found Mr. Brodsky's website. A136, A081, A258. However, rather than showing confusion, the affiants demonstrated their ability quickly to discern the difference between Mr. Brodsky's vigorously and explicitly anti-Jews for Jesus website and appellee's website. A136, A081, A259. In fact, the gravamen of these affidavits, and of much of appellee's submissions, was not trademark confusion but offense at the content of Mr. Brodsky's message. A136, A081, A259.

Additional affidavits of counsel were also submitted, as well as two affidavits of Susan Perlman, appellee's Associate Executive Director. A105, A210. But, appellee submitted no evidence of unsolicited reports of confusion, nor of any Internet user (solicited or otherwise) actually being confused by the contents of Mr. Brodsky's website. Nor did it submit any evidence to support its claim that Internet domain names are source identifiers.

Appellee claimed its registered mark was incontestable, but it *7 never alleged the existence of, nor entered into the record below, the affidavit required to be filed with the Patent and Trademark Office pursuant to [15 U.S.C.A. § 1065](#). A012. Even after Mr. Brodsky requested that the Court order plaintiff to complete the record and submit a copy of its [15 U.S.C.A. § 1065](#) affidavit, the court below inexplicably refused to do so. A310, A314. Thus, there was no record on which the District Court could determine the uses of the mark that were statutorily entitled to the privilege of incontestable status, or if any conditions or limitations attached to this status.

Mr. Brodsky's opposition included his own certification and an affidavit of counsel. A138, A146. Mr. Brodsky has said that he intended to "intercept" potential converts, A304, but nothing in the record suggests that he tried to, or could, block plaintiff's website, or that plaintiff's website is, or could be, in any way less accessible than it has ever been.

Nonetheless, in an opinion dated March 5, 1998, the District Court ruled that Mr.

Brodsky had willfully infringed plaintiff's registered mark, A404, which the court held "appears to be" incontestable, A374. The court below rejected all of Mr. Brodsky's defenses, even though it recognized that appellee's mark was descriptive. A383. In its opinion, the court below dismissed Mr. Brodsky's First Amendment defense in footnote 1, stating simply, "The dispute does not implicate rights granted by the First Amendment of the United States Constitution." A350. On March 19, 1998, the preliminary injunction order issued by the District Court *8 was entered on the docket. A455.

On April 1, 1998, Mr. Brodsky made an emergent motion for a stay of the District Court's order, A462, and on that same day filed a Notice of Appeal, A460. In support of his stay motion, Mr. Brodsky filed an affidavit demonstrating that "traffic" to his Internet site, now located at www.jewscantbeforjesus.org, had dwindled to a small fraction of its previous volume, effectively silencing his message by relegating it to oblivion. A465. On April 6, 1998, the District Court summarily denied the motion to stay, declaring at a hearing that "there is no First Amendment aspect to this case" and offering no elucidation of its First Amendment ruling whatsoever. A506. This Court denied Mr. Brodsky's motion for a stay on April 14, 1998 but granted his application for an expedited briefing schedule. A510.

STANDARD OF REVIEW

A. Preliminary Injunctions A Court of Appeals reviews an order granting a preliminary injunction for abuse of discretion. [Acierno v. New Castle County](#), 40 F.3d 645, 652 (3d Cir. 1994). Any determination that was made as a prerequisite to issuing an injunction is reviewed according to the standard applicable to that determination. [American Tel. and Tel. Co. v. Winback & Conserve Program, Inc.](#), 42 F.3d 1421, 1427 (3d Cir. 1994), cert. denied, 514 U.S. 1103 (1995). A district court's conclusions of law and its applications of the law to the facts are reviewed in a plenary fashion; its findings of fact are reviewed under a *9 clearly erroneous standard. *Id.*

B. First Amendment In cases raising an issue implicating the First Amendment, an appellate court has an obligation to make an independent examination of the whole record to ensure that the judgment does not constitute a forbidden intrusion on the field of free expression. [Bose Corp. v. Consumers Union](#), 466 U.S. 485, 499 (1984); [Ferris v. Cuevas](#), 118 F.3d 122, 125 n.3 (2d Cir. 1997) (no deference to trial court).

C. Likelihood of Confusion The Court of Appeals reviews a district court's factual findings regarding likelihood of confusion under the clearly erroneous standard. [Sterling Drug, Inc. v. Bayer AG](#), 14 F.3d 733, 741 (2d Cir. 1994). The review is not as limited, however, when the district court's conclusions are "inextricably bound up" in its view of the law. [Anheuser-Busch, Inc. v. Balducci Publications](#), 28 F.3d 769, 773 (8th Cir. 1994), cert. denied, 513 U.S. 1112 (1995). An appellate court that cannot separate the trial court's factual finding of confu-

sion from its legal conclusions may conduct a *de novo* review of the record. *Id.*

D. Genericness A District Court's ruling on genericness of a trademark is reviewed in plenary fashion on the basis of whether the court correctly applied the law to the facts. See [Berner Int'l Corp. v. Mars Sales Co.](#), 987 F.2d 975 (3d Cir. 1993).

***10 SUMMARY OF ARGUMENT**

The District Court erred in ruling that the unregistered mark "Jews for Jesus" was infringed by Mr. Brodsky's incorporation of those words in the domain name of his Internet web site (www.jewsforjesus.org), a forum in which he expresses his opposition to appellee. The District Court ruled that there are no First Amendment issues implicated by this use, and this was error. The injunction issued below has resulted in the virtual cessation of Internet "traffic" to Mr. Brodsky's website and the silencing of his message, resulting in significant First Amendment harm.

The ruling of the District Court was based on unwarranted and unprecedented extensions of trademark law without any consideration of countervailing First Amendment interests. The court below ignored the substantial body of authority holding that a stylized registered mark is not infringed by use, in non-stylized form, of descriptive words incorporated into that mark. At the same time, the District Court erroneously failed to acknowledge and defer to the precedent forbidding the novel extension of trademark law at the expense of free speech interests.

The District Court also erroneously found that Mr. Brodsky's speech was commercial, and subject to the Federal anti-dilution statute. This holding was based purportedly on the fact that Mr. Brodsky's website allows access to another website to which he is sympathetic, and the latter website, operated by an anti-missionary organization, sells religious materials. In so ruling, the court *11 below ignored clear Supreme Court precedent holding that protected speech, especially speech relating to areas of special First Amendment concern, is not rendered commercial by incidental "commercial" activity that is not the main purpose of such speech. In any event, Mr. Brodsky's website itself has absolutely no commercial aspects. The court below thus erred in holding the anti-dilution law applicable to Mr. Brodsky's activities.

The court below ignored the authority requiring that the enforcement of rights in a registered trademark be strictly limited to the terms of the registration itself. It thus erroneously extended the registration beyond its stylized form, even granting rights in elements disclaimed by the appellee, at the expense of an innocent party who expressly relied on the terms of the registration.

In addition, the District Court erred by rejecting Mr. Brodsky's defense that the unstylized words "Jews for Jesus" are generic and entitled to no protection. The court below incorrectly based its finding of non-genericness on length of use, which is never a factor in a genericness determination, as well as the supposed

existence of alternatives. It also ignored clear and un rebutted evidence of generic use of these words by appellee itself, amounting to estoppel of appellee's trademark claim.

The District Court erroneously issued an injunction against Mr. Brodsky despite appellee's failure to show likelihood of confusion. The District Court wrongly based its decision in part on the idea that Mr. Brodsky "would have" used an infringing *12 stylized form of the registered mark if he "could have," a formulation offensive to our legal system. The court below also gave undue weight to affidavits of persons affiliated with appellee that indicated quick and ready comprehension that Mr. Brodsky's website was not that of appellee, rather than confusion. Furthermore, the District Court wrongly made a finding regarding Mr. Brodsky's intent based almost entirely on inadmissible hearsay.

The issuance of a preliminary injunction by the court below was also erroneous because appellee fell far short of its burden of demonstrating a likelihood of success on its trademark claims. The court below wrongly ruled that appellee's mark was incontestable, without proof of the filing with the Patent and Trademark Office ("PTO") of the affidavit required by statute to establish statutory incontestability. The District Court also erroneously disregarded the PTO's determination that the goods set forth in appellee's registration do not encompass any alleged use of the registered mark by Mr. Brodsky.

Finally, appellee failed to meet of its burden of demonstrating irreparable harm. Appellee's affidavits demonstrate that its website is as accessible as ever, and that Mr. Brodsky's activities have had no effect on appellee other than those protected by the First Amendment.

***13 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.*

This appeal is not about some obscure precinct of trademark law or even an emerging "cyberlaw" dispute. Something much more important than that is at stake - the right of a person to publicize his views on a topic of social and religious concern in a non-confusing, appropriately labeled manner, when those views are offensive to a religious group that would use the trademark laws to muzzle free speech. Such debate and expression are at the heart of the interests the First Amendment protects. "Cyberspace" is not exempt from the reach of the Constitution.

Yet the District Court refused even to address whether Steven Brodsky's First Amendment rights are implicated by appellee's trademark claims. [FN3] Instead, the Court concluded summarily (and erroneously) that "[T]he dispute does not implicate rights granted by the First Amendment ...," A350, and repeated that conclusion, without analysis, at the hearing denying plaintiff's stay *14 application, A506.

[FN4] Unfortunately, therefore, the District Court did not provide the parties or this Court with any basis on which to analyze its "ruling" on the First Amendment. The abridgment of Mr. Brodsky's right to free speech is demonstrated by the affidavit filed in support of his stay motions, which shows the virtual cessation of traffic to his newly-renamed website. A456. A reversal of the District Court's order is appropriate to avoid the nearly total muffling of Mr. Brodsky's religious, non-commercial message, and to put the brakes on an extension of trademark law far beyond Congressional intent.

FN3. At the hearing on February 13, 1998, the District Court signaled its unwillingness even to consider the possibility that Mr. Brodsky's constitutional rights were implicated by this action:

THE COURT: You're not suggesting for a one second that there is a First Amendment issue in this litigation?

MR. LAULICHT: We are suggesting that. We started to brief it. We did, I believe, cite some cases in our brief.

THE COURT: That's quibbling....

A296.

FN4. At that hearing, and in its opinion, the District Court also stated - contrary to fact - that both of the parties represented that there was no First Amendment issue here. A350, A505. *But see*, e.g., A296.

The District Court's muting of Mr. Brodsky's speech constitutes the sort of irreparable First Amendment harm cited by the United States Supreme Court when it wrote, "[W]e cannot indulge the facile 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, 26 (1971). As applied in [Rogers v. Grimaldi](#), 875 F.2d 994 (2d Cir. 1989), the First Amendment's mandate that free speech not be abridged applies not only to what is said but whether or not it will be heard.

Some commercial interests may conceivably be implicated if this Court reverses the District Court's order. But these interests are paltry in comparison to the free speech rights protected by the Constitution of the United States. Constitutional ***15** rights are superior to commercial interests protected by statute, and the balance between the two must favor the constitutionally protected rights. Mr. Brodsky's First Amendment rights are being trampled by a District Court ruling that extends the reach of the trademark statutes beyond that contemplated by Congress and permitted by the First Amendment. Here, where there is no competent evidence of actual confusion but only of vigorous debate, the application of the trademark laws to this dispute is particularly inappropriate.

Despite the powerful First Amendment considerations implicated by this case, however, the District Court's First Amendment analysis consisted of a simple, slammed door: "No issue." On the motion for a stay, the Court, rather than expand-

ing on its reasoning, again insisted: "No issue." The District Court erroneously failed to weigh the, at worst, momentary possibility of confusion against the critical First Amendment issues at stake in Mr. Brodsky's use of a descriptive and appropriate title for his pro-Judaism, anti-missionary website.

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 MAY NOT BE USED BY APPELLANT AS THE NAME OF HIS INTERNET WEBSITE.

In granting appellee a mandatory injunction, the District Court has taken the as-
sertion of trademark rights into a heretofore *16 uncharted area, relying almost
entirely on the plainly distinguishable opinion in *Planned Parenthood Fed'n of Am.
v. Bucci*, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997), *aff'd unpublished table decision* __
F.3d __ (2d Cir. 1998). The court below pushed the law of trademark far beyond
precedented boundaries, shunting the First Amendment aside.

The essence of Mr. Brodsky's trademark defense, described more fully in Point IV,
infra, is this: Where a trademark registration consists of a descriptive term in
distinctive type style, that registration is not infringed by the same descriptive
words presented in a different lettering style. In support of this proposition,
Mr. Brodsky's brief below cited *In re K-T Zoe Furniture*, 16 F.3d 390, 394 (Fed.
Cir. 1994), which held that trademark protection limited to the particular design
form of a mark "does not confer a monopoly" on an unstylized form, and *Chicago
Reader, Inc. v. Metro College Publ'g Co.*, 222 U.S.P.Q. 782, 783 (7th Cir. 1980),
holding that the rights to a descriptive mark are limited to the stylized version
set forth in the registration. Here the District Court found the term "Jews for
Jesus" descriptive, as was the case in *K-T Zoe Furniture* and *Chicago Reader*. Yet,
it ignored these cases while harshly ridiculing the legal rule for which they
stand. A297, A281.

That rule, however, was the basis of a decision by the very same District Court
judge who wrote the *Planned Parenthood* opinion on which the court below relied, in
a case - in *17 contradistinction to *Planned Parenthood* - that involved trademark
facts very similar to those here:

[T]he PTO registered plaintiff's stylized trademark "Grand Cru Vineyards" .. The
trademark itself states that "[n]o claim is made to the exclusive right to use
'grand cru,' apart from the mark as shown." ...

* * *

Plaintiff does not argue that defendant has copied the stylized mark that [it]
has registered on the supplemental register. Indeed, a picture of a bottle of wine
purportedly distributed by defendant, submitted by plaintiff as an exhibit,
clearly shows that defendant uses only the words "grand cru," and not the stylized
version of the word that plaintiff uses as its trademark.... Because Grand Cru
Vineyards' federally registered trademark disclaims an exclusive right to use

"grand cru," apart from the mark as shown, defendant's mere use of the term "grand cru" does not infringe plaintiff's federally registered mark.

Grand Cru Vineyards, Inc. v. Grand Cru, Inc., 1990 WL 16152, *1 (S.D.N.Y. 1990) (Wood, J.) (emphasis added).

Even as the court below took trademark law where it had never gone before, however, it curtly dismissed Mr. Brodsky's First Amendment concerns, stating "The issue is not before me and I consider it to be quibbling, trying to move the target from where the opinion is." A506. The courts, however, have put the target exactly where Mr. Brodsky has urged it belongs. They have held that the "so-called First Amendment" (*id.*) counsels against staking out new territory in the trademark domain, as the District Court has done. This fundamental principle has been applied in particular to titles, such as the title of Mr. Brodsky's website, that fairly and accurately describe the content of what they are ***18** labeling.

The leading authority for this proposition is *Rogers v. Grimaldi, supra*, 875 F.2d at 998, a case ignored by the court below. In *Rogers*, the Second Circuit ruled that the Lanham Act must be construed narrowly when applied to titles because of First Amendment concerns. The Court there agreed with plaintiff Ginger Rogers that consumers might be confused by the title of a movie called, without her permission, "Ginger and Fred." Nonetheless, the Court ruled that the First Amendment protected expression that the Lanham Act might limit, and found for the defendant, writing:

Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods. But most consumers are well aware that they cannot judge a book solely by its title any more than by its cover. We therefore need not interpret the Act to require that authors select titles that unambiguously describe what the work is about nor to preclude them from using titles that are only suggestive of some topics that the work is not about. Where a title has at least some artistic relevance to the work and is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act.

Id. at 1000 (emphasis added; citations omitted). *Accord, No Fear, Inc. v. Imagine Films*, 930 F. Supp. 1381 (C.D. Cal. 1995); see also, *Twin Peaks Prods., Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993) ("the District Court failed to recognize the special concerns implicated by Lanham Act claims against titles of works of artistic expression"); *Silverman v. CBS, Inc.*, 870 F.2d 40, 49 (2d Cir.), cert. denied, 492 U.S. 907 (1989) ("in ***19** determining the outer limits of trademark protection ... the balance of [the] risks [of confusion and suppression of expression] is relevant and in some cases may tip the scales against trademark protection"). Here the District Court erroneously failed to give the First Amendment any weight at all. [FN5]

FN5. The District Court, on appellant's stay motion below, refused to reveal any of its First Amendment reasoning. A506. But the District Court did rely in its opinion on the holding of Judge Wood in *Planned Parenthood*, which set

forth two purported grounds on which to distinguish *Rogers*. First, *Planned Parenthood* held that Internet domain names are not communicative statements but rather source identifiers. This conclusion was not based on a specific finding of fact or on case law, legislation or regulation. Judge Wood also held that *Rogers* applied only to titles of artistic works, a limitation neither found in *Rogers* nor consonant with the First Amendment. There is neither a reason nor authority to suggest that titles lose "expressive" or even "artistic" protection when they are used to label nonartistic works, especially those entitled to special First Amendment protection such as the religious issues projected here by Mr. Brodsky.

Moreover, in *Planned Parenthood*, unlike the case here, there was clear and purposeful website confusion based on content: in *Planned Parenthood*, defendant's page began, "WELCOME TO THE [PLANNED PARENTHOOD HOME PAGE!](#)" 42 U.S.P.Q.2d at 1432.

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.

The court below further erred in concluding that Mr. Brodsky's website constitutes commercial speech as defined by the Anti-Dilution Act, 15 U.S.C. § 1125. [FN6] The purported basis for this *20 finding is that Mr. Brodsky's site offers a "link" to the Outreach Judaism site. The District Court held that the Outreach Judaism site was itself commercial because it sells "certain merchandise" associated with its anti-missionary work. A415. The court below held that by "linking" to this website, Mr. Brodsky's activities were also commercial because they were "designed to harm" plaintiff. A416. The District Court did not explain how, by providing free and voluntary access to supposedly commercial speech, Mr. Brodsky's own speech itself was rendered commercial. In fact, it does not - and in any case, the Outreach Judaism web page is clearly non-commercial speech, entitled to the highest form of First Amendment protection.

FN6. Non-commercial speech is exempted from the dilution law by 15 U.S.C. § 1125(c)(4), which reads:

The following shall not be actionable under this section:

- (A) Fair use of a famous mark by another person in comparative advertising or promotion to identify the competing goods or services of the owner of the famous mark.
- (B) Noncommercial use of a mark.
- (C) All forms of news reporting and news commentary.

In finding Mr. Brodsky's website "commercial," the District Court relied solely on *Planned Parenthood*. That court, however, cited no authority whatsoever in support of its commercial speech analysis. Its so-called "intent to harm" test has no legal or logical relationship to a finding of commercial speech. In contrast, un-

der *Lockheed Martin Corp. v. Network Solutions, Inc.*, 1997 WL 721899 (C.D. Cal. 1997), and *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. 1997), the use of trademarks in titles for *21 purposes of public comment is protected First Amendment activity not subject to the anti-dilution laws.

The District Court's ruling completely misapprehends the definition of commercial speech. The Supreme Court has taught that the appropriate test of whether speech is commercial is whether or not "proposal of a commercial transaction" is the sole purpose of the expression. *Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422-23 (1993). Here, it cannot reasonably be argued that the sole, main or even subsidiary purpose of Mr. Brodsky's speech is proposal of a commercial transaction. Mr. Brodsky provides voluntary access to the website of an unaffiliated non-profit group that sells tapes to promote its religious message. The activities of speech outlets like Outreach Judaism are not commercial speech. See *Riley v. National Federation of the Blind*, 487 U.S. 781 (1988), where the Supreme Court not only ruled that charitable fundraising is not commercial speech, but also stated:

[W]here ... the component [commercial and noncommercial] parts of a single speech are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase.... Therefore, we apply our test for fully protected expression.

Id. at 796. See also *Cincinnati v. Discovery Network*, *supra*; *Schaumburg v. Citizens for a Better Environment*, 444 U.S. 620 (1980) (charitable solicitation is protected speech); *Gordon & Breach Science Publishers S.A., v. American Inst. of Physics*, 859 F. Supp. 1521, 1540 (S.D.N.Y. 1994) (summarizing cases). Mr. Brodsky is not involved in fundraising. But even if he were, his *22 speech would still be non-commercial under these decisions.

IV. APPELLANT DID NOT INFRINGE APPELLEE'S STYLIZED REGISTERED TRADEMARK ("JEWS F??R JESUS") BY USING NON-STYLIZED, UNREGISTERED ELEMENTS OF THE *STYLIZED MARK* ("JEWSFORJESUS").

This controversy could have been resolved on the basis of black-letter trademark law. As discussed in Point II, *supra*, Mr. Brodsky did not infringe the registered mark owned by Jews for Jesus because that mark incorporates a Star of David as part and parcel of what is registered; it is a stylized mark. The registration itself disclaims use of the words "Jews" and "Jesus" and claims rights only in the mark "as shown," i.e., incorporating the Star of David, to wit: JEWS F??R JESUS. A036. There is no allegation here that Mr. Brodsky has used this stylized mark, the only registered trademark at issue. The District Court, however, characterized this point as "hypertechnical" and "intellectually fraudulent." A297, A281. In so doing the court below disregarded unambiguous precedent, and committed plain error.

Though eluding the court below, the *Planned Parenthood* court recognized the legal difference between a registered stylized mark and non-registered words in *Grand*

Cru, supra. This legal divide has been recognized for decades by judges and commentators alike. See, e.g., *In re K-T Zoe Furniture, supra*, 16 F.3d at 394 (trademark protection limited to particular design form of mark "does not confer a monopoly" on unstylized form); *23 *Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993) (registration of stylized logo of magazine title; no infringement by use of non-stylized word form for competing magazine); *Chicago Reader, supra*, 222 U.S.P.Q. at 783 (rights to descriptive mark limited to stylized version in registration); *Time Inc. v. Petersen Publ. Co.*, 976 F. Supp. 263, 264 (S.D.N.Y. 1997) (registered stylized trademark for magazine title not infringed by words used as title of competing magazine presented in different style; plaintiff was "asserting broader trademark rights than it owns"); *FS Services, Inc. v. Custom Farm Services*, 471 F.2d 671, 673-74 (7th Cir. 1972) (stylized mark protected only to extent of distinctive style; trademark registration does not include non-stylized depiction); *Security Works!, Inc. v. Security World Int'l, Inc.*, 33 U.S.P.Q.2d 1734, 1739 (S.D. Fla. 1994) (similarities between stylized registered mark and non-stylized words, even if key words, not sufficient to confer registered trademark rights in unadorned words); *Oxford Indus., Inc. v. JBJ Fabrics, Inc.*, 6 U.S.P.Q.2d 1756, 1760-61 (S.D.N.Y. 1988) (stylized registered mark incorporating words and logo not infringed by use of same words in block lettering); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:30 at 11-51 (1996, 1997) ("McCarthy").

The District Court nonetheless ruled that plaintiff infringed the narrow, stylized mark JEWS F??R JESUS with his Internet web address. The District Court found that there was *24 only a "minor difference" between the registered mark and the term used by Mr. Brodsky. A378. Yet this "minor" difference is, according to the very terms of the registration, the essence of the actual stylized mark registered, while the other elements (the descriptive words used by Brodsky) are disclaimed by the registration. A036. The approach of the court below is the exact opposite of how courts should treat registration disclaimers. Thus it was held, in a dispute over the words "Travel Planner," that the registrant of a stylized version of those words "may not take advantage of the special protection afforded to registered trademarks [where] its registration expressly 'disclaim[ed] the words "Travel Planner" apart from the mark as shown.'" *Official Airline Guides v. Goss*, 856 F.2d 85, 87 (9th Cir. 1988).

Here the District Court erroneously rendered appellee's disclaimer a nullity. It extended registration protection and all its privileges to a non-stylized version of a stylized mark in the face of appellee's failure to register the words "Jews for Jesus," a fact that the District Court completely and indefensibly ignored. The opinion below obviates the need to register a pure word mark and to test the registrability of a generic or descriptive term. By registering stylized versions of their self-descriptions, users of generic or descriptive marks can, under the District Court's approach, accomplish by judicial fiat what they could not do under the trademark statutes.

There is no legal basis, however, for this usurpation of the *25 role of Congress. The legislatively-granted privileges of registration are a harsh disincentive to would-be infringers. They give registrants the devastating weapons of litigation presumptions and, perhaps, attorneys' fees and costs. Plainly such privileges should be restricted to the strict terms of registrations approved by the PTO, and not extended by judges. Thus, as this Court has held, the impact of registration must be limited to the "specific terms of the registration so as to allow parties ... to rely as fully as possible on the registry." *Natural Footwear, Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1396 (3d Cir.), cert. denied, 474 U.S. 920 (1985).

Even in the commercial area, this Court has expressed concern about extending the monopoly rights in expression granted to trademark owners, warning in *Natural Footwear*, "[W]e believe that the grant of a form of monopoly should not be liberally construed." 760 F.2d at 1396. Thus, this Court avoids unfairly subjecting innocent "infringers" of unregistered descriptive marks to the severe sanctions of the registration scheme.

If *Natural Footwear* forbids such a holding in a commercial context, how much more so should the impact of registration, with all its heightened privileges and penalties for trespass, be circumscribed here, where not commerce but free religious expression is at issue? Here the registrant has, by expanding its state-protected franchise beyond its intended scope, used it to quash vigorous and effective debate on an issue of special *26 First Amendment concern and to punish a vigorous opponent. And appellee has been allowed by the District Court to do all this, buttressed by the enhanced legislative grant of incontestability, without even including in the record the affidavit that is, under 15 U.S.C.A. § 1065, the *sine qua non* of both the existence and scope of incontestability.

The decision below is contrary to this Court's controlling holding in *Natural Footwear*, as well as considerations of public policy and plain fairness. The District Court's conclusion of infringement of the registered stylized mark of Jews for Jesus, as well as the Court's ruling of incontestability, should be reversed.

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

A generic term functions as the common descriptive name of a thing, and as such is not protectible. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) ("shredded wheat"). It connotes the "basic nature" of the thing. *Blinded Veterans Ass'n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 1039 (D.C. Cir. 1989). Once the defense of genericness of an unregistered mark has been raised, the burden is on the mark's proponent to prove non-genericness. *Id.* at 1041. The District Court rejected Mr. Brodsky's defense that the words "Jews for Jesus" are generic, and in so doing committed yet another reversible error.

The facts in *Blinded Veterans* are much like those here. A *27 veterans group

claimed that it had unique rights to the term "blinded veterans," and the District Court agreed. The Circuit Court reversed, explaining that "'[B]linded veterans' simply designates the twice-circumscribed category of people who are both blinded and veterans." *Id.* at 1041. Similarly, in [Liquid Controls Corp. v. Liquid Control Corp.](#), 802 F.2d 934, 936 (7th Cir. 1986), the Seventh Circuit ruled that "liquid controls" was a generic term, not entitled to protection. The court wrote:

The noun "control" is defined in Webster's Third New International Dictionary (1967 ed.) as an "automatic mechanism used to regulate or guide the operation of a machine or an apparatus or system." When "liquid" is added to "controls" the effect is to identify the type of mechanism, thus identifying a genus of products.

Id. at 937 (footnotes omitted). Here, too, the purported mark "Jews for Jesus" is merely a "twice-circumscribed category," as the *Blinded Veterans* court put it, encompassing self-identified "Jews" who are "for Jesus," or the simple addition of "Jews" and the generic term "for Jesus" to describe the group's self-identity in terms of what it is "for."

Appellee's own statements show that the words "Jews for Jesus" are generic. It has frequently used these words as a generic portrayal of Jews who practice Christianity. For example, in an article by its Executive Director David Brickner, Brickner states:

In the early days of Jews for Jesus, even our name (which actually came from our opposition, much as the first-century Christians were named) was considered extremely confrontational. Yet the label Jews for Jesus was effective - a clear ***28** communication of who we are and who we are for.

http://www.jews-for-jesus.org/PUBLICATIONS/NEWSLETTERS/1-57570ct9_6/critics.html (visited 2/3/98), A178. Other official statements at appellee's own website support Brickner's assertion that "Jews for Jesus" is a generic term. Thus:

3. When did Jews for Jesus start?

About 32 A.D., give or take a year! That's because the first followers of Jesus were Jews, as was Jesus himself.

* * *

4. How many Jews for Jesus are there?

The number on the staff of the organization is 145. However, the number of Jews in the U.S. who believe in [Jesus] range from twenty-five to sixty thousand.

<http://www.jews-for-jesus.org/BASICINFO/faq.html#IAQ> (visited 2/5/98), A180- 81. And:

Most people know Jews for Jesus were a reality in apostolic times ...

* * *

[O]ur name tells who we are, who we stand for and what we are doing.

<http://www.jews-for-jesus.org/BASICINFO/4Js/4Js.html> (visited 2/5/98), A184. And:

If you know anything about Jews for Jesus, you know we like to eat and we like good food.

A118.

Appellee has been consistent: the words "Jews for Jesus" are a generic self-description. These words are used in a generic fashion by appellee precisely because it wishes to communicate and describe the core concept of its organization: that Jews who practice Christianity are, and always have been, Jews for Jesus, and not merely former Jews who are now Christians. For purposes *29 of trademark law, appellee must be taken at its word. As Professor McCarthy has explained:

If the proponent of trademark status itself uses the term as a generic name, this is strong evidence of genericness. A kind of estoppel arises when the proponent of trademark use is proven to have itself used the term before the public as a generic name, yet now claims that the public perceives it as a trademark.

McCarthy § 12:13 at 12-27 (emphasis added), citing, e.g., *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 U.S.P.Q.2d 1534 (T.T.A.B. 1987) (proponent's use of term in generic, non-source-indicating manner is persuasive evidence of genericness).

The District Court, presented with this evidence, nonetheless rejected the argument by Mr. Brodsky that the nonstylized word combination "Jews for Jesus" is a generic mark. The court below found that "although the Plaintiff Organization sometimes refers to its members as 'Jews' who are 'for Jesus,' during the past twenty-four years the Plaintiff Organization has consistently used the phrase 'Jews for Jesus' to refer to the organization itself." A381. [FN7] Yet the District Court cited no authority for its novel proposition that a generic mark becomes un-generic by virtue of long-standing use. There is none. In fact, the same Court has recently restated the well-known rule that "A generic term is never protectible." *FM 103.1, Inc. v. Universal Broadcasting, Inc.*, 929 F. Supp. 187, 194 (D.N.J. 1996) *30 (Lechner, J.) (emphasis added).

FN7. But see the discussion in the previous paragraph contradicting the District Court's finding of "consistency" in this regard and demonstrating frequent generic use of the term.

The District Court continued its genericness analysis by distinguishing "Jews for Jesus" from "Blinded Veterans" through examples of other ways the idea of "Jews for Jesus" might be expressed. A382. The Court below found that, by this test, the term "Jews for Jesus" is not generic because it does not leave "so few alternatives so as to monopolize the concept and debilitate potential competitors," *id.*, citing *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1442 (3rd Cir. 1994). *Duraco*, however, was a trade dress case, and while in the process of its analysis this Court restated one formulation of genericness, it did not apply this formulation to facts comparable to those here.

In contrast, *Blinded Veterans*, authored by now-Justice Ruth Bader Ginsburg, makes clear that the exercise indulged in by the District Court, of suggesting alternative names that "prove" that there are possible alternative descriptions, is not a proper method of answering the genericness question. "A term need not be the sole designation of an article in order to be generic..." *Id.*, 872 at 1041. All that the District Court demonstrated by its list of other names is that there are other

generic names by which Jews who are for Jesus may be described. See, e.g., *Union Carbide Corp. v. W. R. Grace & Co.*, 213 U.S.P.Q. 400 (T.T.A.B. 1982), *aff'd*, 581 F. Supp. 148 (S.D.N.Y. 1983) (multiple generic names for product); *McCarthy* § 12:8 at 12-18. *31 Put differently, if the District Court were right, there could be virtually no generic marks. The English language, rich with synonyms, can almost always divine multiple ways to express the same idea. That capacity, however, does not make a generic description such as "Jews for Jesus" a protectible one.

In light of its own generic use of the words "Jews for Jesus," appellee should not be permitted to claim that these words at once describe a phenomenon dating back millennia, and that the same words - absent some stylized format as in its registration - comprise a specific source identifier referring to a specific organization founded in San Francisco in 1973 (well after "apostolic times"). Given the burden of proof on appellee to show lack of genericness, the District Court's finding of nongenericness upon these undisputed facts was reversible error.

VI. 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*.

Injunctive relief is an extraordinary remedy that should be granted only if the proponent produces evidence sufficient to demonstrate the following four factors: (1) the likelihood that the proponent will prevail on the merits at final hearing; (2) the extent to which the proponent is being irreparably harmed by the conduct complained of; (3) the extent to which the opponent will suffer irreparable harm if the preliminary injunction is issued; and (4) the public interest. *AT&T *32Co. v. Winback and Conserve Program, Inc.*, 42 F.3d 1421, 1427 (3d Cir. 1994), *cert. denied*, 514 U.S. 1103 (1995). Besides the usual interests balanced in an injunction application, courts are particularly reluctant to issue an injunction, even in a Lanham Act case, where there are delicate questions implicating First Amendment rights. See, e.g., *Stop Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112, 1123 (S.D.N.Y. 1980).

Liability under the Lanham Act requires a showing, *inter alia*, of likelihood of confusion as to source. *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1228 (3d Cir. 1978). But, appellee has submitted no admissible proof to support a finding that confusion is likely. Even the evidence submitted to support a claim of actual confusion tends in Mr. Brodsky's direction by indicating just how little confusion there is. Nonetheless, the District Court, purporting to apply the *Scott* factors, erroneously found that there was a likelihood of confusion. A398.

Similarity. The District Court relied heavily on *Planned Parenthood* for its finding that Mr. Brodsky's all-word domain name and appellee's stylized registered mark are "virtually identical." A397. The court below ignored the fact that there

was no stylized mark in *Planned Parenthood*. The District Court also erroneously focused on whether defendant "could have" used a Star of David in his domain name, holding him liable for what he "would have" done, though he admittedly could ***33** not do so. A281-82, A291, A377-78. Appellant is aware of no legal authority, nor did the District Court cite any, for the proposition that a party can be held statutorily liable for an act he "would have" done if he "could have." Indeed, such an idea is antithetical to fundamental justice.

The court below cited cases in which defendants sought to distinguish their marks from the plaintiffs' trademarks by pointing to differences in spacing or capitalization. A397. But, unlike here, in none of these cases were the plaintiffs' marks stylized registrations disclaiming the critical words in the domain name, nor were the spaces and capitalization set forth as essential elements of the registrations. In fact, in each case the marks infringed were protectible word marks. The District Court's failure to even address, much less apply, this critical distinction was error.

Strength of the mark. As demonstrated above, the phrase "Jews for Jesus" is a generic mark entitled to no protection. Here the District Court held, as discussed above, that "the mark" is incontestable, ignoring the distinction between the registered stylized mark and the generic (or, by the court below's own reckoning, descriptive) word phrase used by Mr. Brodsky.

As to the alleged common law mark comprised by the words Jews for Jesus, even if it were not generic, and were descriptive as suggested by the District Court, appellee has still fallen far short, under the stiff standard for a preliminary injunction, of ***34** demonstrating secondary meaning. Secondary meaning is shown when the primary significance of the term in the public mind is not the thing described but a specific source. *Scott Paper*, 589 F.2d at 1228.

Of this there is no evidence whatsoever in this record. What little has been submitted - affidavits of plaintiff's Associate Director and three obviously affiliated persons, as recognized by the court below (A403) - is entitled to little weight. "Trademark law is skeptical of the ability of an associate of a trademark holder to transcend personal biases to give an impartial account of the value of the holder's mark." *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995). In contrast, here the District Court found, "If supporters of the Plaintiff Organization were confused ... then, in all likelihood, individuals who are not familiar with the views of [appellee] also have been and will continue to be confused" (A403) - erroneously giving these biased witnesses enhanced credibility and weight precisely because of their bias!

In a preliminary injunction hearing, this failure of evidence is critical. All the more is this so where secondary meaning is necessary to establish rights to an unregistered phrase (as opposed to the stylized registered mark) used generically by its own champions and found to be descriptive by the District Court. "The more

descriptive the term, the greater *35 the evidentiary burden on plaintiff to prove secondary meaning." McCarthy § 11.25 at 11-45. Plaintiff has fallen far short of that burden, and has therefore failed to show that the unregistered words "Jews for Jesus" comprise a distinctive mark, entitled to protection.

Care and attention of users. As indicated in the Chellathurai, Kalstein and Sanchez affidavits, it takes virtually no time for even self-described "unsophisticated" users to quickly realize they are at Mr. Brodsky's site, not that of appellee. The honesty of the non-confusing message on Mr. Brodsky's website is in stark contrast to the defendant's website in *Planned Parenthood*:

Because the words on the top of the page load first, the user is first greeted solely with the "Welcome to the Planned Parenthood Page!" It is highly likely that an Internet user will still believe that she has found plaintiff's web site at that point.

42 U.S.P.Q.2d at 1438. That kind of confusion is simply impossible in the case of Mr. Brodsky's website, as indicated by Chellathurai and Kalstein - appellee's own affiliated affiants.

In response to this argument, the District Court found that

an individual may be a sophisticated consumer of the Internet but may be an unsophisticated consumer of information about religious organizations. Such a user may find his or her way to the Defendant Internet site and then be confused; the Defendant Internet site advocates views antithetical to those of the Plaintiff Organization.

A400. The last two clauses in the excerpt above constitute a nonsequitur. They also make no sense in the context of the actual website at issue, which explicitly states its opposition to "the *36 Jews for Jesus cult" and disclaims any affiliation with appellee. Concluding that Mr. Brodsky is not part of a Jews for Jesus organization does not require any particular "sophistication." It only requires the ability to read.

In fact, the courts routinely define "sophistication" in much less "sophisticated" terms than did the court below, where a simple grasp of the obvious is all that is required to negate confusion. Thus, in *Girls Scouts v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969), the court ruled that "rational analysis" precluded confusion about whether the Girl Scouts were the source of a poster depicting a pregnant girl in the well-known uniform of the Girl Scouts appearing with the caveat "BE PREPARED." Similarly, in *Stop the Olympic Prison v. United States Olympic Committee, supra*, 489 F. Supp. at 1123, a poster reading "Stop the Olympic Prison" was held not to violate the trademark of the United States Olympic Committee. The court reasoned as follows:

On the basis of its own examination of the poster, the Court finds it extremely unlikely that anyone would presume it to have been produced, sponsored or in any way authorized by the U.S.O.C. While at a fleeting glance, someone might conceivably mistake it for a poster advertising the Olympics, nobody could conceivably retain such a misconception long enough to do any harm: for example, there is no

danger that anyone would purchase or display it as such.

Id. This principle has been applied to domain name disputes as well. In [*Interstellar Starship Svcs. v. Epix, Inc.*, 983 F. Supp. 1331 \(D. Ore. 1997\)](#), a domain name infringement case, it was held that content, not merely a domain name, must be evaluated to ***37** define confusion. This is why courts have routinely held that mere registration of trademarks as domain names, without confusing use, does not constitute infringement. See, e.g., [*Academy of Motion Picture Arts and Sciences v. Network Solutions Inc.*, 45 U.S.P.Q.2d 1463 \(C.D. Cal. 1997\)](#).

As in *Girl Scouts* and *Olympic Prison*, no rational person could believe that Mr. Brodsky's message was in any way affiliated with appellee. The District Court nonetheless held that confusion is likely because Mr. Brodsky's site is "related" to that of appellee. A401. The court below inexplicably rejected the inescapable conclusion that consumers can dispel any confusion if they merely trouble to read Mr. Brodsky's message, the way Chellathurai, Kalstein and Sanchez did.

The court below also used this section of its opinion to discard the suggestion that the explicit disclaimer used by Mr. Brodsky of any affiliation with "the Christian organization Jews for Jesus" prevented confusion. For this, the District Court cited *Planned Parenthood*. A402. But, it did not in any way explain its reasoning. In fact, there was no disclaimer at all in *Planned Parenthood*. To the contrary, the content of defendant's website deceptively began, "WELCOME TO THE [PLANNED PARENTHOOD HOME PAGE!](#)" [42 U.S.P.Q.2d at 1432](#). The topic of a possible disclaimer is only mentioned in that decision in the context of crafting the appropriate injunctive relief. *Id.* at 1441.

Length of time of defendant's use of the mark before actual ***38** confusion. Plaintiff has submitted no competent evidence on this score. Mr. Brodsky uploaded his website around the third week of December. The Chellathurai, Kalstein and Sanchez affidavits, if credited, just happen to claim access to the [www.jewsforjesus.org](#) website within days of the filing of suit on January 21st. A136, A081, A258. Appellee's affiants instantly realized that defendant's website was not appellee's.

Intent. The District Court made various findings of fact as to Mr. Brodsky's intentions - a critical component throughout the opinion below - based substantially on inadmissible hearsay. Other findings by the Court were also based on hearsay. A360, A362, A385, A403-04. Given the extraordinarily high standard of proof required on a preliminary injunction application, such reliance is improper.

Appellee claims that it has a registered trademark, but the record does not show it ever using the (R) symbol or otherwise indicating registration as provided by [15 U.S.C.A. § 1111](#). In none of its letters to Mr. Brodsky did appellee address the issues raised by Mr. Brodsky regarding the distinction between the rights claimed by appellee and its actual stylized trademark registration, leading him to continue his reasonable (and correct) belief that he was not infringing on a registered

trademark. Furthermore, the nonconfusing content of his website contrasts starkly with the website of the *Planned Parenthood* defendant. The District Court erroneously ignored all of these facts in its opinion.

***39** Evidence of actual confusion. As discussed above, the only purported evidence of actual confusion is the hardly credible trio of affidavits from Chellathurai, Kalstein and Sanchez. Their "confusion" ended almost instantaneously upon reading the website. There is no authority for the idea that confusion between domain names and purported trademarks is evaluated in a vacuum, i.e., without reference to the content of the website. As set forth above, the law is to the contrary. *Interstellar Starship*, 45 U.S.P.Q.2d at 1304.

Identity of media. As discussed under "similarity," this factor is not easily analyzed as applied to domain names. Plaintiff claims, apparently, broad trademark rights in all media for the unregistered phrase "Jews for Jesus," but Mr. Brodsky is only using a version of that phrase in one narrow manner: as a domain name.

Identical audiences. Mr. Brodsky's only interest, as demonstrated by the content of his website and his unrebutted certification, is in reaching potential Jewish apostates, not non-Jews. Appellee's affiants, while put forth by appellee as intended members of the audience for its website, do not claim to be Jewish. Thus, they are not members of Mr. Brodsky's intended audience. The District Court ruled, however, that both websites seek the same audience - without explaining why Mr. Brodsky would have any interest in the attention of Chellathurai, Kalstein or Sanchez, none of whom claims a Jewish background. A405. The District Court found Mr. Brodsky's assertion that he seeks only Jews at his ***40** website "curious," but simple perusal of the subject website would have sated its curiosity.

Relationship of goods in the public mind. The District Court ignored this criterion. In fact, there is no evidence of possible confusion between Mr. Brodsky's message and appellee's services in the public mind, and this should have been a factor weighing decisively against a finding of likelihood of confusion.

VII. THE DISTRICT COURT ABUSED ITS DISCRETION BY ISSUING A PRELIMINARY INJUNCTION DESPITE APPELLEE'S FAILURE TO PROVE A REASONABLE LIKELIHOOD OF SUCCESS ON THE MERITS OF ITS CLAIMS CONCERNING THE SCOPE AND STATUS OF ITS REGISTERED AND ALLEGED COMMON LAW TRADEMARKS

In addition to the foregoing errors by the court below, there is no evidentiary record before this Court, nor was there one before the District Court, of the scope and status of the marks claimed by appellee. Unperturbed by this failure of proof, the court below erroneously extended appellee's trademarks rights beyond the terms of its registration.

The complaint alleges that appellee "has a valid, federally registered service mark incorporating the name 'Jews for Jesus,'" and that the single page of the registration reproduced as Exhibit A of the Complaint is that registration. A011.

The complaint further alleges in ¶16, "By virtue of its long use and registration, the Jews for Jesus mark [FN8] is 'incontestable' pursuant *41 to the Lanham Act, 15 U.S.C. § 1065" (A012), which provides for incontestability of the exclusive right to use a mark for such goods and services in connection with which the mark has been in continuous use for five years following the date of registration. Incontestability only accrues when

FN8. Earlier in the Complaint, at ¶15, appellee describes its registered mark as "Jews for Jesus (stylized)." The qualification, "stylized," is omitted from ¶16, in which appellee alleges incontestability. A011-12.

(1) there has been no final decision adverse to registrant's claim of ownership of such mark for such goods and services, or to registrant's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name of the goods or services or a portion thereof, for which it is registered.

Besides the conclusory allegation that its mark is incontestable "by virtue of its long use and registration" (A012), there is no competent proof that appellee ever filed the affidavit required under subsection (3) above, and that the conditions required by the statute have been met. Indeed, appellee did not even allege the filing of the affidavit.

This gap in appellee's prima facie case was brought to the attention of the District Court at the preliminary injunction *42 hearing on February 13, 1998. A283. Appellee's response was to refer to appellant's papers, incorporating the contents of a commercial trademark report generated by Westlaw. [FN9] A284. The Court apparently considered this unsworn representation sufficient, because it refused, without comment, a written request by Mr. Brodsky that appellee submit an authenticated copy of the Section 1065 affidavit to complete the record. A310, A314-15. Thus, the District Court ruled that the Jews for Jesus registered mark is incontestable based on an unsworn representation by counsel plus a copy of a commercial trademark search.

FN9. In fact, counsel for appellee referred solely to a single, vague reference in the trademark search stating simply, "[I]n that Thomson and Thomson search, is a reference to affidavit Section 8-15, May 4, 1989." A284.

Besides its curious refusal to instruct appellee to complete the record and simply submit the alleged affidavit of incontestability, the District Court's ap-

proach to this issue raises other a serious questions: What is the incontestable use set forth in the [Section 1065](#) affidavit? This is not only a logical but a legal problem, because [15 U.S.C. § 1115](#) provides as follows:

To the extent that the right to use the registered mark has become incontestable under [section 1065](#) of this title, the registration shall be conclusive evidence of the validity of the registered mark ... Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under [section 1065](#) of this title, or in the renewal application filed under section 1059 of this title if the goods and services specified in the renewal are fewer in number, subject to any conditions or limitations in the ***43** registration or in such affidavit or renewal application.

(Emphasis added). Taking counsel's representation to the District Court at face value, and accepting that such would be an acceptable basis on which the court below could make a finding of incontestability, still this record is bare of any description of what goods or services are specified in the affidavit required by the statute. The District Court could not know what conditions or limitations are contained in the affidavit with regard to the use of the stylized mark.

The District Court's refusal to order production of the [§ 1065](#) affidavit, in the face of Mr. Brodsky's request to complete the record, was improper. Even if it were proper, there was no record before the court below of exactly what uses of the registered mark that court has now deemed incontestable.

All this raises another question, raised originally by Mr. Brodsky below: How is appellee entitled to rights in its registered trademark as a domain name when, even by the terms of the registration (which cannot be expanded by [§ 1065](#)), the only use claimed was for hard-copy "religious pamphlets"?

Besides improperly seeking to expand its stylized mark to a non-stylized text mark, appellee would expand its only registered use - "religious pamphlets," Goods Class 16 ([37 C.F.R. §§ 6.1-6.4](#)) - to the boundless rights claimed by it in this lawsuit. The District Court reasoned that *Natural Footwear* did not apply here because "the category of goods [i.e., the website] is identical ***44** to those listed in the Registration, i.e., 'Religious Pamphlets.'" But an Internet website is not a good or an "online pamphlet" for purposes of trademark classifications. The U.S. Patent and Trademark Office has declared as follows:

Only hard copy publications, e.g., printed magazines and books, are considered to be Class 16 goods.... Magazines or books that are downloadable from a computer network are not considered to be 'hard goods' and they are classified in International Class 42 rather than Class 16.

U.S.P.T.O., "Identification and Classification of Certain Computer Related Goods and Services," <http://www.uspto.gov/web/offices/tac/domain/domcl.html> (visited 2/5/98). A391.

The District Court cavalierly rejected the PTO's determination and found that the Jews for Jesus website on the Internet is a "hard copy publication." A391. The

Court found this to be appropriate because of the various materials on appellee's website, "none of which can be downloaded," referring to the Perlman Amended Affidavit at ¶ 17 - a reference that says nothing to the effect that appellee's Internet materials are not downloadable. A109. But this finding is palpably incorrect. Mr. Brodsky's submissions demonstrate that these materials are in fact easily downloaded and printed. A177-189. In fact, so does the Perlman Amended Affidavit! A109, A115-A123.

Based on this reinvention of the record, the District Court found that no class was an appropriate match to the "religious services" provided by Jews for Jesus, but that Goods Class 16, *45 "printed matter," was the closest. A391. The court below did not explain why class 41, "education and entertainment" - a service, and not a good - was not in fact a closer match to appellee's missionary activities.

Furthermore, the District Court's fanciful categorization of appellee's services as "goods," in the face of the PTO's contrary determination, actually misses a bigger point. Appellee's website is not "the category of goods the Plaintiff Organization seeks to protect." That website is practically irrelevant to this litigation, and in fact its contents are not even in the record. Appellee has made no claim to any trademark rights in its domain name *per se*. It is Steven Brodsky's website that is the subject of this litigation, and the question is whether that website infringes on a right protected by appellee's registration. Steven Brodsky, however, may provide a service, but he certainly does not provide any goods. There is no way, under *Natural Footwear*, that a registration for a good categorized as "printed matter" and described as "religious pamphlets" is infringed by Steven Brodsky's services.

Yet the District Court ruled that the description of appellee's registration was irrelevant in determining appellee's trademark rights. "Even if the *Natural Footwear* holding were applicable to this case ... it would not affect the common law rights of the Plaintiff Organization to prevent the use by the Defendant in his domain name of the name of the Plaintiff *46 Organization." [FN10] A393. But the distinction between infringement of a registered trademark and of common law rights is critical. Common-law rights must be proved, which as demonstrated above appellee has not done here. And common-law rights do not entitle a plaintiff to a presumption of validity in the case of descriptive marks, a holding of incontestability, or any other benefit of registration.

FN10. This broad statement by the District Court actually goes further than even appellee urged. Taken at face value, it would prevent any use of appellee's organizational name "in" a domain name, including, for example, "ihatejewsforjesus.org" -- a name that would not be confusing and that would be protected as fair use.

The District Court made a stunning number of twists and turns in order to find Steven Brodsky liable to appellee, but appellee has never actually made the case

that it has protectable rights in the unstylized generic words "Jews for Jesus." The rulings of the court below are incorrect as a matter of law and should be reversed.

VIII. APPELLEE DID NOT SUSTAIN ITS BURDEN OF PROVING *IRREPARABLE HARM*.

An applicant for a preliminary injunction must make a clear showing of "immediate irreparable injury" or a "presently existing actual threat." *Acierno v. New Castle County*, 40 F.3d 645, 655 (3rd Cir. 1994). As the District Court recognized, this means that appellee was required to demonstrate that a preliminary injunction "must be the only to protect [it] from injury or harm." A424. The District Court, finding infringement, concluded that appellee had demonstrated irreparable harm. A427.

*47 As demonstrated above, however, appellee fell far short of demonstrating a substantive right to relief. Thus, there is simply no factual basis for a finding of irreparable harm. The Chellathurai, Kalstein and Sanchez affidavits indicate that Internet users are eminently capable of quickly and easily finding the address and website they want. All three affidavits suggest momentary experiences of emotional upset, but appellee offers no authority for the proposition that this is a basis for recovery under the intellectual property laws.

Indeed, it is the capacity to give just such "offense" that the First Amendment protects. The decision of the District Court finding irreparable harm should be reversed.

CONCLUSION

For the foregoing reasons, appellant Steven C. Brodsky respectfully requests that this Court reverse and vacate the order of the District Court.

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