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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

THE NETWORK NETWORK,
Plaintiff,
vs.
CBS, INC., AND DOES 1 TO 10,
Defendants.

Case No.: No. CV 98-1349 NM (ANx)

ORDER DENYING DEFENDANT'S
MOTION FOR SUMMARY
JUDGMENT AND GRANTING
PLAINTIFF'S MOTION FOR
SUMMARY JUDGMENT IN PART

I

Introduction

Plaintiff The Network Network brought this case against defendant CBS, Inc.¹ on February 5, 1998, seeking a declaratory judgment that its use of the Internet domain name "tnn.com" does not infringe any of defendant's rights. Defendant filed a motion for summary judgment on June 23, 1999, alleging that plaintiff's use of the domain name infringed and diluted its trademark under both federal and state law. Plaintiff filed its own summary judgment motion on June 30, claiming that it is entitled to a declaratory judgment of non-infringement and non-dilution as a matter of law, and contending that defendant is barred from its

¹ Defendant states in its answer to the complaint that suit should have been filed against "Network Enterprises, Inc.," a wholly-owned subsidiary of CBS that acquired The Nashville Network on October 1, 1997.

1 counterclaim under federal and state laches doctrine.

3 II

4 Background Facts

5 The following facts are undisputed unless otherwise indicated.

6 Opryland USA, Inc. registered the service mark “TNN” on the Principal
7 Register of the United States Patent and Trademark Office on January 20, 1987.
8 The mark is shorthand for “the Nashville Network,” described as “a cable
9 television network that broadcasts country music and country lifestyle programs.”
10 Def. Mot. At 1. According to the trademark registration form, the mark was
11 intended for use in “television program production services and distribution of
12 television programming to cable television systems.” The form lists April 1, 1981
13 as the first date the mark was used in commerce. See Wilson Dec., Exh. A. The
14 cable station went on the air March 7, 1983. See Daly Dec. ¶ 4. To avoid
15 confusion, the cable station (and its parent company, unless otherwise specified)
16 will be referred to herein as “Nashville.”² The stock of Opryland USA, Inc was
17 spun off to Gaylord Entertainment, Co., on October 23, 1991. See Wilson Dec. ¶
18 8.

19 Clive Hermann formed The Network Network (“Network”) in October
20 1986. See Clive Hermann Dec. ¶ 3; id. Exh. 1. Network “provide[s] consulting
21 and training to IT [Information Technology] managers and professionals
22 concerning the establishment and maintenance of computer networks.” Pl. Mot. at
23 1. The business was incorporated in California November 30, 1988. See id. ¶ 6.
24 Hermann alleges that plaintiff has been using “TNN” as a common law service
25 mark for the company continuously since October 1986, and has used the same
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28 ² The designation is necessary to refer to the cable station entity because the entity’s
promotion of the mark, apart from the ownership of the station at the time of the promotion, is at
issue in this case.

1 stylized logo with the initials since 1989 during the company’s seminars, on its
2 training manuals, and on some correspondence. See id. ¶¶ 708; C. Hermann Dec.
3 Exh. 4.

4 Plaintiff registered the Internet domain name “tnn.com” on January 7, 1994.
5 It immediately began using the domain name for email addresses, and several
6 months later created a website at www.tnn.com. It began publicizing both the site
7 and the mail addresses to clients during this period. See Pl. Mot. at 3.

8 On September 30, 1997, CBS, Inc. acquired Nashville from Gaylord and
9 assigned ownership rights of the “TNN” mark to a subsidiary, NEI. See Wilson
10 Dec. ¶ 9. On December 16, 1997, an attorney from CBS sent Hermann a “cease
11 and desist” letter regarding the use of the domain name.

12 13 **III**

14 **Analysis**

15 ***A. Summary Judgment Standard***

16 Summary judgment is appropriate when “the pleadings, depositions,
17 answers to interrogatories, and admissions on file, together with the affidavits, if
18 any, show that there is no genuine issue as to any material facts and that the
19 moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c).

20 In a trio of 1986 cases, the Supreme Court clarified the applicable standards
21 for summary judgment. See Celotex, supra; Anderson v. Liberty Lobby, Inc., 477
22 U.S. 242, 106 S.Ct. 2505 (1986); Matsushita Electrical Industry Co. v. Zenith
23 Radio Corp., 475 U.S. 574, 106 S. Ct. 1348 (1986). The moving party bears the
24 initial burden of demonstrating the absence of a genuine issue of material fact.
25 See Anderson, 477 U.S. at 256, 106 S.Ct. at 2514. The governing substantive law
26 dictates whether a fact is material; if the fact may affect the outcome, it is material.
27 See id. At 248, 2510. If the moving party seeks summary adjudication with respect
28 to a claim or defense upon which it bears the burden of proof at trial, it must

1 satisfy its burden with affirmative, admissible evidence. By contrast, when the
2 non-moving party bears the burden of proving the claim or defense, the moving
3 party can meet its burden by pointing out the absence of evidence submitted by the
4 non-moving party. The moving party need not disprove the other party's case. See
5 Celotex Corporation v. Catrett, 477 U.S. 317, 325, 106 S.Ct. 2548, 2554 (1986).

6 If the moving party meets its initial burden, the "adverse party may not rest
7 upon the mere allegations or denials of the adverse party's pleadings, but the
8 adverse party's response, by affidavits or as otherwise provided in this rule, must
9 set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ.
10 P. 56(e).

11 When assessing whether the non-moving party has raised a genuine issue,
12 the court must believe the evidence and draw all justifiable inferences in the non-
13 movant's favor. Anderson, 477 U.S. at 255, 106 S.Ct. at 2513 (citing Adickes v.
14 S.H. Kress and Company, 398 U.S. 144, 158-59, 90 S.Ct. 1598, 1608-09 (1970)).

15 Nonetheless, "the mere existence of a scintilla of evidence" is insufficient to
16 create a genuine issue of material fact. Id. At 252, 2512. As the Supreme Court
17 explained in Matsushita,

18 [w]hen the moving party has carried its burden under
19 Rule 56(c), its opponent must do more than simply show
20 that there is some metaphysical doubt as to the material
21 facts.... Where the record taken as a whole could not lead
22 a rational trier of fact to find for the nonmoving party,
23 there is no "genuine issue for trial."

24 Id. At 586-87, 106 S.Ct. at 1356 (citations omitted).

25 To be admissible for purposes of summary judgment, declarations or
26 affidavits must be based on personal knowledge, must set forth "such facts as
27 would be admissible in evidence," and must show that the declarant or affiant is
28 competent to testify concerning the facts at issue. Fed. R. Civ. P. 56(e).

Declarations on information and belief are insufficient to establish a factual

1 dispute for purposes of summary judgment. Taylor v. List, 880 F.2d 1040, 1045
2 (9th Cir. 1989).

3 4 ***B. Claim Analysis***

5 ***1. Dilution***

6 a. Federal Law: The FTDA

7 The Federal Trademark Dilution Act (FTDA), codified as 15 U.S.C. §
8 1125(c)(1), allows a famous mark's owner to secure an injunction against another
9 party's "commercial use in commerce" of the mark "if such use begins after the
10 mark has become famous and causes dilution of the distinctive quality of the
11 mark." The parties dispute whether Nashville's "TNN" mark is famous within the
12 meaning of the statute, as well as the meaning of the phrase "begins after the mark
13 has become famous." The latter dispute, in turn, has sparked two subsidiary
14 debates: whether "such use begins" refers to the first date of any use of the mark
15 (here, Network used the initials "TNN" in business correspondence in November
16 1987, and used "TNN" in its seminars by 1989,³ see C. Hermann Dec. Exhs. 2, 4
17 and accompanying videotape), or the first date the mark was used in a manner the
18 mark's holder finds objectionable (here, the date that Network registered the
19 initials "TNN" as its domain name – January 1994); and, if Nashville's mark is
20 indeed "famous" under the meaning of the statute, when it became so.

21 Professor McCarthy explains this timing issue as follows:

22 [O]ne should not be liable for dilution by the use of a mark which
23 was legal when first used. That is, if at the time of first use, Zeta's
24 mark did not dilute Alpha's mark because Alpha's mark was not
25 famous, then Alpha will not at some future time have a federal
26 dilution claim against Zeta's mark. Thus, the junior user must be
27 proven to have first used its mark after the time that plaintiff's mark
28 achieved fame. This requires evidence and proof of the timing of two

27 ³ At oral argument, defendant's counsel alleged that Network's early use of "TNN" was
28 always in conjunction with "The Network Network." Although graphics at the outset of
Network's videotaped seminar from 1989 do indeed say "TNN: The Network Network," the
presentation itself uses the "TNN" logo alone as a backdrop.

1 events: when the plaintiff's mark achieved that elevated status called
2 "fame" and when the defendant made its first use of its mark.

3 4 McCarty 24:96 at 24-169. McCarthy's reading is consistent with the language
4 of the statute, which speaks of a party's right to injunctive relief against another's
5 "commercial use in commerce of a mark or tradename, *if such use* begins after the
6 mark has become famous. . . ." 15 U.S.C. § 1125(c)(1) (emphasis added). Under
7 ordinary rules of construction, the term "such use" must relate back to
8 "commercial use in commerce." The term "use in commerce" is defined in the
9 Lanham Act as "the bona fide use of a mark in the ordinary course of trade, and
10 not made merely to reserve a right in a mark." A mark, in turn, "shall be deemed
11 in use in commerce . . . on services when it is used or displayed in the sale or
12 advertising or services and the services are rendered in commerce" 15 U.S.C.
13 § 1227. It is undisputed that Network was using the mark "TNN" in commerce at
14 least as early as 1989.

15 It appears from this formulation that the statute looks to the mark's fame at
16 the time of the mark's first commercial use, not when the first use occurs that the
17 mark's owner finds objectionable. Indeed, if this latter formulation were the rule,
18 the requirement that infringing use begin after the mark becomes famous would be
19 stripped of all meaning. Owners of famous marks would have the authority to
20 decide when an allegedly diluting use was objectionable, regardless of when the
21 party accused of diluting first began to use the mark. Nashville contends that
22 Network's proposed formulation would allow *any* prior single use by another
23 party to strip the famous mark's owner of its ability to protect its mark. Because
24 the evidence indicates that Network's use of "TNN" has been continuous since at
25 least 1989, the Court need not decide whether an isolated previous use is sufficient
26 to change the date of the famousness analysis. Nashville has not set forth any
27 evidence of the famousness of its mark as of 1989.

28 Also relevant to Nashville's dilution claim is the fact that it did not

1 complain about Network’s registration of the “tnn.com” domain name for nearly
2 four years, indicating it did not sense a threat of dilution from Network’s use of
3 the domain until relatively recently. Regardless of when Nashville discovered that
4 Network had registered the domain name, it certainly should have been aware of
5 the existence of the Internet, of the practice of registering domain names, and of
6 the likelihood that an existing organization with the initials TNN would seek the
7 most obvious domain name for its website – just as Nashville now wishes it had
8 done. Indeed, a Nashville employee was aware of Network’s site at “tnn.com” as
9 of December 12, 1996, yet Nashville took no action at that time. See C. Hermann
10 Dec. Exh. 10. The length of time of concurrent usage of “tnn” before Nashville
11 complained indicates that Network’s activity did not seriously dilute the value of
12 Nashville’s trademark. See Accuride Int’l, Inc. v. Accuride Corp., 871 F.2d 1531,
13 1539 (9th Cir. 1989).

14 Nashville has not shown that its mark was famous in 1989. Furthermore, it
15 did not allege that Network’s use of its domain name diluted its mark for almost
16 four years after Network first registered the domain. For these reasons, the Court
17 finds that Nashville’s claim under the FTDA cannot survive summary judgment.

18 b. State Law: Cal. Bus. & Prof. Code § 14330

19 Dilution under state law is subject to essentially the same analysis as
20 dilution under the FTDA.⁴ See Panavision Int’l v. Toeppen, 141 F.3d 1316, 1324
21 (9th Cir. 1998) (“Panavision’s state law dilution claim is subject to the same
22 analysis as its federal claim.”). The parties dispute whether California law
23 requires that a mark be “famous” or merely “strong and well recognized” to merit
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25 ⁴ The relevant California provision holds as follows:

26 Likelihood of injury to business reputation or of dilution of the distinctive quality
27 of a mark registered under this chapter, or a mark valid at common law, or a trade
28 name valid at common law, shall be a ground for injunctive relief
notwithstanding the absence of competition between the parties or the absence of
confusion as to the source of goods or services.

Cal. Bus. & Prof. Code § 14330

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3 protection. However, the Ninth Circuit recently held that § 14330 applies only to
4 famous marks, and that the allegedly diluting use must occur after the mark has
5 become famous for the statute to apply. See Avery Dennison Corp. v. Sumpton,
6 189 F.3d 868, 874-75 & n.4 (9th Cir. 1999). Accordingly, the same reasoning
7 applies under both California state law and the FTDA, and the same outcome must
8 result.

9 ***2. Infringement***

10 a. Federal Law: Lanham Act

11 The Lanham Act provides the owner of a valid protectable trademark from
12 an infringing use of the mark that creates a likelihood of confusion. See 15 U.S.C.
13 §§ 1114, 1125(a)(1). Much of the briefs of both parties is therefore devoted to
14 determining whether intrepid Internet explorers, in search of information about
15 Nashville’s programming, are potentially confused when they alight,
16 inadvertently, on Network’s website.

17 Traditionally, likelihood of confusion analysis involves application of the
18 eight-factor test enunciated in AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49
19 (9th Cir. 1979).⁵ As noted in Bally Total Fitness Holding Corp. v. Faber, 29 F.
20 Supp. 2d 1161 (C.D. Cal, 1998), however, the Sleekcraft test applies only to
21 related goods, which are those goods or services “which would reasonably be
22 thought by the buying public to come from the same source, or thought to be
23 affiliated with, connected with, or sponsored by, the trademark owner.” Bally, 29
24 F. Supp. 2d at 1163 (quoting 4 McCarthy § 24:6 at 24-13 (1997)). The products at
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26 ⁵The Sleekcraft factors are as follows: strength of the allegedly infringed mark, proximity
27 of the goods, similarity of the marks, evidence of actual confusion, marketing channels used,
28 type of goods and degree of care likely to be exercised by purchasers, the intent of the alleged
infringer in selecting the mark, and the likelihood of the expansion of the product lines of both
parties. See Sleekcraft, 599 F.2d at 348-49.

1 issue here, “a cable television network that broadcasts country music and country

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1 lifestyle programs,” Def. Mot. at 1, and a service providing “consulting and
2 training to I[nformation] T[echnology] managers and professionals concerning the
3 establishment and maintenance of computer networks,” Pl. Mot. at 1, could not
4 possibly be associated by a rational buying public. The fact that both use the
5 Internet as an advertising mechanism does not render the services related. As the
6 Bally court noted, “The Internet is a communications medium. It is not itself a
7 product or a service.” Bally, 29 F. Supp. 2d at 1163. Because the services of
8 Nashville and Network are not reasonably related, there is no need to conduct the
9 Sleekcraft analysis to determine the likelihood of confusion.⁶

10 Nashville contends that Network’s choice of domain name has caused
11 substantial confusion. In support of this proposition, it cites several emails sent to
12 Network asking for information on Nashville’s programming. See Boese Dec.
13 Exhs. F, G, H, I; Peterson Dec. It also produced several declarations of Internet
14 users who attempted to reach Nashville’s home page by entering “www.tnn.com”
15 on their web browsers, and were disappointed upon arriving at Network’s home
16 page. See Posey Dec., Frauenfelder Dec., Ridgway Dec.

17 There is a difference between inadvertently landing on a website and being
18 confused. Thousands of Internet users every day take a stab at what they think is
19 the most likely domain name for a particular website. Given the limited number
20 of letters in the alphabet, and the tendency toward the use of abbreviations in
21 commerce generally and in domain names in particular, it is inevitable that
22 consumers will often guess wrong. But the fact that aficionados of The Nashville
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25 ⁶ Nashville contends that, because it has licensed its mark to a hunting simulation
26 computer game, “[i]t is not unreasonable for television viewers of TNN’s other customers to
27 believe that TNN is sponsoring or affiliated with other computer-related products or services.”
28 D’s Opp. At 14. This argument is wholly unpersuasive. The computer game, which publicity
material bills as “the most realistic hunting simulation to date,” P’s Reply at 13, cannot arguably
be confused as overlapping even slightly with Network’s services, which include “a complete
range of publicly offered training seminars, that meet the needs of IT executives, IT personnel,
and marketing personnel.”

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2 Network may initially type “tnn.com” into their browsers in the hope of locating
3 Grand Ole Opry programming information does not, standing alone, demonstrate
4 confusion.

5 Of the few example put forth by Nashville, only five can be said to show
6 any degree of actual confusion. See Boese Dec. Exhs. F, G, H, I; Peterson Dec.
7 Others quickly realized that they were in the wrong website. Contrary to
8 Nashville’s assertion, the fact that someone was momentarily confused does not
9 resolve the question. The test of actual confusion is not whether anyone *could*
10 *possibly* be confused, but whether the “reasonably prudent consumer” is likely to
11 be confused. Brookfield Communications v. West Coast Entertainment Corp.,
12 174 F. 3d 1036, 1060 (9th Cir. 1999); Dreamworks Production Group, Inc. v. SKG
13 Studio, 142 F. 3d 1127, 1129 (9th Cir. 1998); Sleekcraft, 599 F.2d at 353. The
14 Court can conceive of few, if any, circumstances in which a person of average
15 intelligence, seeking information on NASCAR racing schedules, would be
16 seriously confused upon reaching Network’s website which, by its terms, offers
17 “Strategic Planning, design, implementation, and management of Broadband
18 Voice/Data/Video Networks.”

19 Nashville responds by suggesting that the number of users actually
20 confused is much greater than the examples proffered to the Court. Especially in
21 relation to low-cost goods, Nashville argues, deceived customers will often not
22 realize their confusion, or will not be sufficiently motivated to voice their concern
23 at having been deceived. See Def. Reply at 9.

24 Nashville quotes AmBrit, Inc. v. Kraft, Inc., 812 F. 2d 1531 (11th Cir. 1987)
25 at length in support of these propositions. AmBrit involved an ice cream bar
26 manufacturer’s trade dress suit against a competitor. After describing the
27 similarity of the products at issue, the court declared, “Actual consumer confusion
28 is the best evidence of likelihood of confusion. There is no absolute scale as to

1 how many instances of actual confusion establish the existence of that factor.
2 Rather, the court must evaluate the evidence of actual confusion in the light of the
3 totality of the circumstances involved.” AmBrit, 812 F.2d at 1543. In conducting
4 its contextual analysis, the court stated that confusion is especially difficult to
5 detect when “the goods are relatively inexpensive and their actual properties are
6 exactly identical,” and reflected that many victims of confusion, upon realizing
7 that they had been duped, “chose not to spend the time to register a complaint with
8 a faceless corporation about the packaging of an item that retails for
9 approximately \$2.50 per six-pack.” Id. At 1544. Finally, the court noted that the
10 evidence of confusion was “far from overwhelming,” but sufficient to meet the
11 clear error standard applied in reviewing the case. Id. At 1544-45.

12 AmBrit’s propositions, while valid in their particular context, do not apply
13 to the instant case. Consumers in search of information about Nashville’s
14 broadcasts will realize that the information they have inadvertently acquired from
15 Network’s web site is not what they were looking for, regardless of the low cost of
16 the product at issue. Far from being “exactly identical,” the information available
17 from Nashville and Network has no overlap. Furthermore, the convenience of
18 email communication – especially when one is already engaged in Internet use –
19 eviscerates Nashville’s cost-of-customer communication argument. If one is
20 frustrated during a search for information, she can communicate this frustration
21 electronically to the operator of the offending web site with a few mouse clicks
22 and keystrokes, taking virtually no time at all. While Nashville’s email
23 communications evidence might indicate that a number of users accidentally
24 accessed Network’s site while looking for Nashville’s information, the evidence
25 does not show that ongoing consumer confusion results from Network’s use of the
26 “tnn.com” domain.

27 The recent Ninth Circuit decision in Interstellar Starship Servs., Ltd. V.
28 Epix, 184 F.3d 1107 (9th Cir. 1999) shed some light on Internet domain name

1 confusion issues, but is ultimately inapplicable to the instant dispute. In
2 Interstellar, Epic, Inc., a manufacturer of video imaging hardware and software,
3 had registered the name “EPIX” with the United States Patent and Trademark
4 Office. Epix sought the rights to the domain name “epix.com,” currently owned
5 by Interstellar Starship Services (ISS). ISS’s Michael Tchou, a photographer
6 affiliated with a dramatic group that stages performances of the Rocky Horror
7 Picture Show, uses the site to display his photos of some of these performances,
8 and hopes to use it in the future “as a photo gallery and as a showcase for my work
9 and for the work of other photographers who specialize in unusual or difficult
10 fields of photography.” Michael R. Tchou, Question: What is the Purpose of this
11 Web Site? (last modified July 26, 1999) <<http://www.epix.com>>.

12 Because the Interstellar court recognized the legitimacy of an infringement
13 claim based on “initial interest confusion” (addressed *infra*), and because it found
14 that the possibility of an Epix customer inadvertently finding Tchou’s site and
15 becoming interested in ISS’s services arguably existed, see Interstellar, 184 F.3d
16 at 1111, sufficient likelihood of confusion existed to warrant a trial on the
17 trademark infringement issue. This conclusion apparently resulted from the
18 court’s impression that customers in the market for Epix, Inc.’s video imaging
19 services would tend to have an interest in Tchou’s method of photograph
20 alteration and display. ISS would therefore be capitalizing on Epix’s goodwill
21 with every new customer it derived through this channel.⁷ See Id. Despite a lack
22 of confusion in this scenario, the court’s conclusion is clearly premised on at least
23 a tangential relationship between the goods offered by Epix and those of ISS,
24 creating the possibility that “[a]n Epix customer might read about ISS on the
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26 ⁷ Nashville does not – and indeed, could not – claim that Network is attempting to
27 appropriate its goodwill in the latter’s use of the “tnn.com” domain name. In a letter to
28 Nashville’s counsel, Network offered to negotiate to include a link from its website to
Nashville’s “www.country.com.” See Boese Supp. Dec. Exh. W. Nashville apparently decided
not to pursue this avenue of discussions.

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3 ‘epix.com’ site and decide to give ISS’s services a try . . .” Id. Because the
4 services offered by Nashville and Network are wholly distinct, the scenario
5 described in Interstellar is not even arguably a possibility in the instant case. Its
6 reasoning, therefore, does not apply.

7 Nashville also claims that Network's use of the “tnn.com” domain name
8 creates “initial interest confusion” among Internet users, thus infringing the
9 “TNN” mark in violation of the Lanham Act. It points to Brookfield
10 Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036 (9th Cir.
11 1999) to support this proposition. An examination of Brookfield shows this claim
12 is without merit.

13 Brookfield, a company offering information for entertainment industry
14 professionals, wanted to use “moviebuff.com” as the domain name for its site
15 selling “MovieBuff” software that featured “comprehensive, searchable,
16 entertainment-industry databases and related software applications.” Brookfield,
17 174 F.3d at 1041. Brookfield had obtained a California state trademark for the
18 “MovieBuff” mark applying to “computer software” in 1994, and in late
19 September 1998 it secured federal registration for “the MovieBuff” mark
20 designating “computer software providing data and information in the field of the
21 motion picture and television industries” as its goods, and describing its services
22 as the provision of “multiple-user access to an on-line network database offering
23 data and information in the field of the motion picture and television industries.”
24 Id. At 1042.

25 West Coast, a large video rental chain, registered “moviebuff.com” in
26 February, 1996. It claimed to have chosen the name based on its service mark,
27 “The Movie Buff’s Movie Store,” which it began using in 1986 and federally
28 registered in 1991. See Id. At 1042-43. In October, 1998, Brookfield became

1 aware of West Coast’s intent to launch a web site at “moviebuff.com” offering a
2 searchable database with material similar to that offered by Brookfield’s
3 “MovieBuff” software.

4 The district court denied Brookfield’s motion for a preliminary injunction.
5 On appeal, the Ninth Circuit granted the injunction. The panel found that
6 Brookfield was the senior user of the “MovieBuff” mark and that West Coast’s
7 use of “moviebuff.com” created a likelihood of confusion.

8 The court based its finding of seniority on several factors. First, because
9 West Coast had only used the two-word phrase “Movie Buff” in its advertising,
10 and as part of a longer phrase, the court found the date of registration and use of
11 the phrase was “simply irrelevant” to the determination of its rights to the
12 “moviebuff.com” domain name. Id. At 1049. Second, the court had to decide
13 when West Coast’s first use of the “moviebuff.com” site occurred. It concluded
14 that such use could not be dated from West Coast’s registration of the site, or even
15 from when it first used the site name in correspondence with attorneys and
16 customers (allegedly occurring in mid-1996). See id. at 1052. Instead, the court
17 focused on November 11, 1998, the date that West Coast issued a press release
18 about the site. Because Brookfield had obtained federal registration of
19 “MovieBuff” over a month prior to this date, the court determined that Brookfield
20 was the senior user.

21 In passing on the likelihood of consumer confusion, the court began with an
22 analysis of the eight Sleekcraft factors. This investigation revealed that the marks
23 were identical, the consuming public was likely to associate the goods and
24 services offered by the parties,⁸ and the use of overlapping marketing channels
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27 ⁸“Just as Brookfield’s ‘MovieBuff’ is a searchable database with detailed information on
28 films, West Coast’s web site features a similar searchable database, which Brookfield points out
is licensed from a direct competitor of Brookfield. Undeniably, then, the products are used for
similar purposes.” Brookfield, 174 F.3d at 1056.

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2 was likely to exacerbate this confusion,⁹ all factors weighing in Brookfield’s
3 favor. The court found the strength of the mark and user intent factors
4 inconclusive, and held that the final three factors – evidence of actual confusion,
5 likelihood of product line expansion, and purchaser care¹⁰ – would not affect the
6 court’s “ultimate conclusion regarding the likelihood of confusion.” Id. at 1060.

7 The court then turned to the issue of “initial interest confusion,” the
8 situation that results when customers realize that the site they have accessed is not
9 the one they were looking for, but decide to use the offerings of the infringing site
10 regardless. Id. at 1062. While the Brookfield court examined the issue in light of
11 “metatags” that may be programmed into one’s web site invisibly to communicate
12 the site’s content to search engines, Nashville argues, and this Court agrees, that
13 the same analysis should apply when the inadvertent access occurs as a result of
14 domain name similarities.

15 The Brookfield initial interest confusion analysis envisions an Internet user
16 in search of one specific product who inadvertently comes upon a related one and
17 uses that product instead. See Brookfield, 174 F.3d at 1062-65. The court noted
18 that the infringer in this scenario “improperly benefits from the goodwill that [the
19 infringed-upon owner] developed in its mark.” Id. at 1062. To illustrate, the court
20 posits a situation in which B erects signs purporting to lead the buying public to
21 A’s store, but actually directs them to B’s establishment. Upon arriving at B’s

23 ⁹ The court outlined a number of possible ways in which consumers might be confused
24 by the concurrent use of Internet marketing by both parties. These included misperceptions
25 about the site’s ownership, the incorrect inference of an agreement between the parties, and a
26 belief that one party’s services were no longer offered. See id. at 1057.

27 ¹⁰ While the court noted several standards for determining purchaser care when different
28 classes of relevant consumers could be expected to use varying levels of care, it refused to
decide the issue because “the purchaser confusion factor, even considered in the light most
favorable to West Coast, is not sufficient to overcome the likelihood of confusion strongly
established by the other factor” the court examined. Id. at 1060.

1 store, customers are fully aware that the store is not A's, but buy from B out of
2 convenience. As Brookfield explains, customers are not confused in this example,
3 but B is nevertheless "misappropriating [A]'s acquired goodwill" in violation of
4 federal trademark law. Id. at 1064. Nashville explicitly recognizes that improper
5 benefit from a mark holder's store of goodwill is a fundamental aspect of the
6 initial interest confusion dynamic. See Def. Mot. at 23.

7 The instant case differs from Brookfield in each of these particulars, and as
8 such warrants a different conclusion. First, Network has used exactly the same
9 mark as the one it registered as a domain name – "TNN" – to denote its goods
10 since at least as far back as 1989. Furthermore, much of the Brookfield likelihood
11 of confusion analysis either explicitly or implicitly depended on the similarity of
12 the products offered by the parties. Two of the three Sleekcraft factors the
13 Brookfield court found important – association of the goods and services by the
14 consuming public and the increased confusion created by overlapping marketing
15 channels – are not present here. Though both companies use the Internet as a
16 marketing device, the types of confusion potentially created by such a situation are
17 not present where the goods are services offered are wholly distinct.

18 Brookfield itself bolsters this conclusion. The court state, "If . . .
19 Brookfield and West Coast did not compete to any extent whatsoever, the
20 likelihood of confusion would probably be remote." Id. at 1056. The hypothetical
21 the court used to illustrate this point is instructive; "A Web surfer who accessed
22 'moviebuff.com' and reached a web site advertising the services of Schumberger
23 Ltd. (a large oil drilling company) would be unlikely to think that Brookfield had
24 entered the oil drilling business or was sponsoring the oil driller." Id. This
25 conclusion would no doubt resonate even if evidence were produced that a
26 consumer in search of information about Alfred Hitchcock's oeuvre had dashed
27 off a quick inquiry on the subject to Mr. Schlumberger.

28 Dissimilarity of goods and services resolves the initial interest confusion

1 question. A trademark violation based on initial interest confusion involves the
2 junior user capitalizing on the senior user's goodwill. The senior user's
3 customers, at least tangentially in the market for the junior user's services,
4 accidentally access the infringing site while in search of information on the senior
5 user's products. Thus, relatedness of products is an important component in the
6 analysis, even if the products need not be closely related. See Interstellar, 184
7 F.3d at 1111. Clearly, the instant dispute does not provide such a case. Unlikely
8 indeed is the hapless Internet searcher who, unable to find information on the
9 schedule of upcoming NASCAR broadcasts or "Dukes of Hazzard" reruns,
10 decided to give up and purchase a computer network maintenance seminar instead.

11 b. Unfair Competition: 15 U.S.C. § 1125(a) and California Business &
12 Professions Code § 17200

13 Nashville bases this claim on Lanham Act § 43(a), which outlaws any use
14 of a mark that is "likely to cause confusion, or to cause mistake, or to deceive as to
15 the affiliation, connection, or association" of the good with the owner of the mark.
16 As described above, the Court finds no danger of confusion among reasonable
17 consumers, so summary judgment must be granted on this claim in favor of
18 Network.

19 Nashville also seeks an injunction based on California's Unfair Competition
20 Act, Cal. Bus. & Prof. Code §§ 17200 et seq. Analysis under this code is
21 "substantially congruent to a trademark infringement claim under the Lanham
22 Act." Academy of Motion Picture Arts and Sciences v. Creative House
23 Promotions, Inc., 944 F.2d 1446, 1457 (9th Cir. 1991) (internal quotations
24 omitted). Because this section also depends on deception or confusion of the
25 public, this claim must be rejected as well.

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IV

Conclusion

Nashville's claim may be reduced to the argument that because its three-initial registered mark is now famous, and would be the most convenient website name for The Nashville Network, it should be entitled to enjoin The Network Network from using the same three initials as part of the domain name it registered nearly half a dozen years ago and has been using continuously ever since – a domain name based on Network's prior use in commerce of the same three initials since 1989. The fact that Nashville missed its opportunity to select the domain name it would now like to have is not sufficient to state a claim of infringement under the federal trademark law, particularly where, as here, there can be no genuine risk of confusion – initial or otherwise – by any consumer of reasonable prudence, and no argument that Network has sought or is now seeking to trade on Nashville's good name.

Based on the foregoing, defendant's motion for summary judgment is denied, and plaintiff's motion for summary judgment is granted as to both the infringement and the dilution claims.

IT IS SO ORDERED.

DATED:

January 16, 2000


Nora M. Manella
United States District Judge