

AMICUS BRIEF OF  
THE INTERNATIONAL TRADEMARK ASSOCIATION  
IN *ROSETTA STONE LTD. v. GOOGLE, INC.*

RECORD NUMBER: 10-2007

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**United States Court of Appeals**  
*for the*  
**Fourth Circuit**

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ROSETTA STONE LTD.,

*Plaintiff-Appellant,*

– v. –

GOOGLE, INCORPORATED,

*Defendant-Appellee.*

ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA AT ALEXANDRIA

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**BRIEF OF AMICUS CURIAE**

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DAVID H. BERNSTEIN  
DEBEVOISE & PLIMPTON LLP  
919 Third Avenue  
New York, NY 10022  
(212) 909-6696  
*Counsel of Record*

KURT E. ANDERSON  
GIORDANO, HALLERAN &  
CIESLA, P.C.  
125 Half Mile Road, Ste. 300  
Red Bank, NJ 07701  
(732) 741-3900

A. JUSTIN OURSO, III  
JONES, WALKER, WAECHTER,  
POITEVENT, CARRERE &  
DENEGRÉ L.L.P.  
8555 United Plaza Boulevard  
Baton Rouge, LA 70809  
(225) 248-2022

*Counsel for Amicus Curiae,  
International Trademark Association*

**CORPORATE DISCLOSURE STATEMENT**

Pursuant to Fed. R. App. P. 26.1, amicus curiae International Trademark Association (“INTA”) states that it is not a publicly-held corporation or other publicly-held entity. INTA does not have any parent corporation and no publicly-held corporation or other publicly-held entity holds 10% or more of INTA’s stock.

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### INTRODUCTION

This case is one of a growing number in which courts are being asked to consider the propriety of “keyword advertising” practices, which generally involve the use and sale of trademarks as keywords to trigger advertisements that appear next to Internet search results, such as on the <www.google.com> website. The District Court held, on cross-motions for summary judgment, that Google is not liable as a matter of law for direct, contributory or vicarious trademark infringement, unfair competition, or trademark dilution as a result of its use of Rosetta Stone’s trademarks as keywords or in the resulting advertisements displayed on its website.

Although INTA does not take a position on the question of whether Rosetta Stone has a valid claim against Google, it supports Rosetta Stone’s request to vacate the decision because the District Court misstated and misapplied settled trademark law on the issues of functionality and dilution. INTA’s primary goal in participating in this case as *amicus curiae* is to urge this Court to correct the District Court’s errors of law so that these important issues of trademark law are stated clearly and correctly, thus promoting clarity and certainty in the law and ensuring that litigants in future trademark cases will not suffer as a result of mistakenly analyzed precedent.

Both parties have consented to this filing.

**STATEMENT OF INTEREST OF THE AMICUS CURIAE**<sup>1</sup>

INTA is a not-for-profit organization whose more than 5,600 members have a special interest in trademarks. INTA's membership includes trademark owners, law firms, advertising agencies, and professional associations from the United States and more than 190 other countries. All share the goals of emphasizing the importance of trademarks and of promoting an understanding of the essential role trademarks play in fostering informed decisions by consumers, effective and efficient commerce, and fair competition. INTA members frequently are participants in trademark litigation, and therefore are interested in the development of clear and consistent principles of trademark and unfair competition law. INTA has substantial expertise in trademark law and has selectively participated as *amicus curiae* in numerous cases involving significant trademark issues, including in this Court.<sup>2</sup>

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<sup>1</sup> Both parties are members of INTA, and the law firms representing the parties are associate members of INTA. Attorneys associated with the parties and their law firms have not participated in the preparation or submission of this *amicus curiae* brief. This brief was authored solely by INTA and its counsel.

<sup>2</sup> Cases in which INTA has filed *amicus* briefs include: *Tiffany (NJ), Inc. v. eBAY, Inc.*, No. 10-300, in support of petition for certiorari to U.S. Supreme Court, *pending* (filed Oct. 20, 2010); *Contessa Premium Foods, Inc. v. Berdex Seafood, Inc.*, 546 U.S. 957 (2005) (mem.); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V. Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Major League Baseball Players Assoc. v. Cartoonists, L.C.*, 531 (continued...)

INTA was founded in 1878 as the United States Trademark Association in part to encourage the enactment of federal trademark legislation after this country's first trademark act was declared unconstitutional. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with all major pieces of federal trademark legislation, including the Lanham Act in 1946, the U.S. Trademark Counterfeiting Act of 1984, the Federal Trademark Dilution Act of 1995, the Anti-Counterfeiting Consumer Protection Act of 1996, the Anticybersquatting Consumer Protection Act of 1999, the Stop Counterfeiting in Manufactured Goods Act of 2006, and the Trademark Dilution Revision Act of 2006 ("TDRA"). INTA also has promulgated

(...continued)

U.S. 873 (2000) (mem.); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000); *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank.*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *Levi Strauss & Co. v. Abercrombie & Fitch. Trading Co.*, No. 09-16322 (9th Cir. filed Nov. 19, 2009); *Chloé v. Queen Bee of Beverly Hills, LLC*, 616 F.3d 158 (2d Cir. 2010); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*, 507 F.3d 252 (4th Cir. 2007); *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559 (5th Cir. 2005); *Playboy Enters., Inc. v. Netscape Comm'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004); *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982); *ITC Ltd. v. Punchgini, Inc.*, 880 N.E.2d 852 (N.Y. 2007).

a Model State Anti-Counterfeiting Act and has been active in the international arena, including by promoting treaties and model laws, such as the Madrid Protocol, the Trademark Law Treaty, the World Intellectual Property Organization's Model Provisions for National Laws on Enforcing IP Rights, the World Customs Organization's model law implementing counterfeiting-related provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights, and the Anti-Counterfeiting Trade Agreement, which is currently under discussion.

INTA does not take a position on which party should ultimately prevail in this case. However, its members have a particular interest in the District Court's analysis because the Court has applied well-established trademark law in unorthodox ways that, if not corrected, will cause confusion and uncertainty. Moreover, the issue at hand is important to INTA, which has members with interests aligned with each of the parties, but all of whom seek clarity in the law with respect to keyword advertising practices. A clear and cogent decision on the important issues raised by the case will give trademark owners, advertisers, and website operators clarity on the appropriate standards for keyword advertising practices so that all parties can compete fairly in the marketplace.

### **SUMMARY OF ARGUMENT**

In this brief, INTA addresses two aspects of the District Court's analysis in which the Court made fundamental errors of trademark law: functionality and dilution. INTA's silence with respect to other aspects of the District Court's decision is not meant to indicate either agreement or disagreement with the Court's other rulings.

First, the District Court erred when it held that Google's conduct was protected by the functionality doctrine. The functionality doctrine is intended to prevent a producer from using trademark law, instead of patent law, to monopolize useful physical features of its product. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995). As such, it usually is a threshold test of whether plaintiff has relevant trademark rights. The District Court, though, misapplied this doctrine. Instead of evaluating whether the ROSETTA STONE mark was a functional feature of Rosetta Stone's language learning products (and hence unprotectable), the Court looked at Google's use of Rosetta Stone's marks and concluded that, because Google used Rosetta Stone's marks to perform an "essential indexing function" as part of its method of delivering advertisements to consumers, Google's use was immunized from any liability. That was legal error. The functionality doctrine is inapplicable to the facts of this case because Rosetta Stone's marks serve no utilitarian function with respect to Rosetta Stone's goods

other than as trademarks – that is, they identify the source of Rosetta Stone’s goods. To the extent that Google or its advertisers have a legitimate need to use Rosetta Stone’s marks to refer to Rosetta Stone itself and to legitimate (not counterfeit) Rosetta Stone products, Google might urge the applicability of the “nominative fair use” doctrine, but it may not seek to insulate its keyword advertising practices under the irrelevant functionality doctrine.

The District Court’s analysis of the dilution claim was also mistaken, this time in two important respects. First, the District Court erred when it ruled, as a matter of law, that Google could not be liable for dilution because it did not use Rosetta Stone’s marks to identify its own goods or services. This was error because trademark dilution, as defined by the TDRA, does not require that the defendant use the mark on its own goods or services. Nor does the TDRA require that the parties be competitors. The TDRA only requires that the challenged use, whatever its character, be a use in commerce. 15 U.S.C. § 1125(c)(1). The District Court erred in requiring more than this.

Second, the District Court erred when it ruled that the apparently increasing fame of the ROSETTA STONE brand name disproved dilution as a matter of law. *Op.* at 44-45. The practical effect of this ruling was that Rosetta Stone was essentially required to prove that actual dilution had already occurred, even though Congress explicitly rejected that standard in the TDRA. Instead, the

District Court should have considered whether Google's challenged conduct was likely to cause dilution over time.

Although INTA asserts that these analytical errors require that the District Court's judgment be vacated and remanded, it does not take a position with respect to whether Rosetta Stone's claims against Google are valid. Those are largely questions of fact, to be assessed once the proper law is applied. Whether those issues can be resolved on summary judgment, or whether there are genuine disputes of material fact on those issues, should be further considered by the District Court. Because, though, the Court erroneously rejected Rosetta Stone's claims as a matter of law, the District Court did not have occasion to consider the real trademark issue at the heart of this case: How it should balance (1) Google's and its advertisers' rights to make nominative fair use of trademarks with (2) Rosetta Stone's and other trademark owners' rights to protect their marks against counterfeiters, infringement, and dilution.

## ARGUMENT

### I. THE DISTRICT COURT ERRED AS A MATTER OF LAW WHEN IT APPLIED THE FUNCTIONALITY DOCTRINE

#### A. Summary of District Court's Errors Regarding Functionality

The application by the District Court of the functionality doctrine in the Internet keyword advertising context is unprecedented and erroneous.

As the Supreme Court has explained, the functionality doctrine prevents a producer from using trademark law, instead of patent law, to monopolize useful physical features of a product:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If the product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995). Typically, the doctrine is used in trade dress infringement actions to bar trademark protection for elements of trade dress that perform a useful function. *See, e.g., Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001) (when "a product feature is . . . essential to the use or purpose of the article or when it affects the cost or quality of the article," that element is "functional" and cannot be protected under



trade dress principles); *Shakespeare Co. v. Silstar Corp. of Am.*, 9 F.3d 1091 (4th Cir. 1993) (applying functionality doctrine in considering whether clear tip at end of fishing rod was functional element and hence not protectable as trade dress), *abrogated by statute on other grounds*; *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654 (4th Cir. 1996) (applying functionality defense to the trade dress of an automotive equipment catalog).

As these cases show, the functionality doctrine is used to determine whether the plaintiff's trade dress serves a useful or functional role and hence should not be protected by trademark law. The functionality doctrine provides a defense to infringement in circumstances in which the defendant has used a "functional" and therefore unprotectable element of plaintiff's trade dress. It does not, however, confer immunity on a defendant who claims that its unauthorized use of plaintiff's trademark as a trademark (that is because of its ability to identify source) serves a "function" in defendant's product. Nevertheless, in a radical reinterpretation of the functionality doctrine, the District Court considered whether the *defendant's* use of the plaintiff's marks serves a useful or functional role, in which case, the Court held, it would be immunized from a finding of infringement or counterfeiting. In particular, the Court held that *Google's* use of Rosetta Stone's marks as part of its method of delivering advertisements was functional and therefore insulated Google from liability. That was legal error.

The ROSETTA STONE mark is not a utilitarian, functional feature of Rosetta Stone's products. It serves only as an indication of source. Unlike the clear tip in *Shakespeare*, the ROSETTA STONE mark serves no function other than to identify the source of Rosetta Stone's goods. Nor do Google and its advertisers sell any product that needs to use Rosetta Stone's marks as a functional feature of a competitive product.

The District Court nevertheless applied what it characterized as the functionality doctrine in considering "whether *Google's* use of Rosetta Stone's trademarks as keyword triggers under its advertising program is functional and, therefore, a non-infringing use." (Op. at 2, emphasis added). Answering its own erroneous question, the Court then ruled that "Google uses Rosetta Stone's trademark to identify relevant information to users searching on those trademarks" and that this "use is a functional and non-infringing one." *Id.* at 3. This is a fundamental misapplication of the functionality doctrine.

**B. The District Court Erred in Relying on the Functionality Doctrine To Address Google’s Alleged Functional Use of Rosetta Stone’s Marks**

As *Qualitex* makes clear, the functionality doctrine typically focuses on a *physical feature* of the *trademark owner’s* product and bars protection of that feature when the evidence shows that it serves a utilitarian function. Although, as the District Court noted, courts in a handful of cases have applied the functionality doctrine to word marks, in those cases, it was the *plaintiff’s* own use of their trademarks in a functional manner that justified the application of the functionality doctrine. See, *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1531 (9th Cir. 1992) (Sega’s functional use of its word mark as part of the initialization code for its video game system software caused its mark to appear in the start-up sequence of its video games, thereby requiring third parties, who needed to use the initialization code to make compatible games, to use Sega’s mark in the start-up sequence of their competitive games); *Compaq Computer Corp. v. Procom Tech., Inc.*, 908 F. Supp. 1409, 1423 (S.D. Tex. 1995) (Compaq programmed its software to require third parties to use its trademark functionally, as a password, to identify devices that Compaq’s diagnostic software would monitor).

The District Court improperly relied on *Sega* and *Compaq* to support the conclusion that Google’s use of Rosetta Stone’s marks performs an “essential

indexing function” and is therefore protected under the functionality doctrine.<sup>3</sup> Op. at 30-31. That holding reflects a misunderstanding and misapplication of the functionality doctrine. Unlike the plaintiffs in *Sega* and *Compaq*, Rosetta Stone is not using its brand name to control access to its software, and neither Google nor its advertisers need to use or display Rosetta Stone’s marks to make products or services that are compatible with Rosetta Stone’s software. Rather, Google is using Rosetta Stone’s trademarks as a keyword to trigger advertising, and advertisers are using Rosetta Stone’s trademarks to indicate that they are reselling Rosetta Stone’s products or are offering related (and sometimes counterfeit) products or services. Although such use by Google and its advertisers may be a nominative fair use in some situations (as discussed further below, *infra* at Section I.C), such trademark-related uses are never “functional” under the functionality doctrine. Rather, Google and its advertisers are using the marks in a paradigmatic

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<sup>3</sup> The District Court also relied on two other decisions in support of its conclusions, but neither of those addressed functionality. In *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 803-04 (9th Cir. 2002), the Ninth Circuit decided a trademark infringement claim under the nominative fair use doctrine; in *Designer Skin, L.L.C. v. S & L Vitamins, Inc.*, 560 F. Supp. 2d 811, 819 n. 7 (D. Ariz. 2008), the Court addressed a trademark infringement claim under the “initial interest confusion” doctrine, and a trademark dilution claim under the nominative fair use doctrine. The potential application of the nominative fair use doctrine to the facts of this case is discussed in Section I.C, *infra*.

*trademark* manner, and that use cannot be immunized merely because it serves some function in Google’s delivery of advertising.

Significantly, the Ninth Circuit already has rejected application of the functionality defense on analogous facts. In *Playboy Enters., Inc. v. Netscape Commc’ns Corp.*, 354 F.3d 1020 (9th Cir. 2004), Playboy challenged Netscape’s use of trademarks as keywords to trigger advertisements, just as Rosetta Stone has done in this case. Like Google, Netscape claimed that its practices were protected under the functionality defense, but the Ninth Circuit rejected that argument out of hand: “That the marks make *defendants’* computer program more functional is irrelevant.” *Id.* at 1031 (emphasis in original) (functionality doctrine inapplicable to use of “playboy” and “playmate” as keywords to trigger banner ads for sexually oriented businesses). Furthermore, the Ninth Circuit held that the PLAYBOY and PLAYMATE trademarks were not a functional part of the design of Playboy’s products and services; rather, they served a source-identifying function. As the Ninth Circuit concluded, “[Playboy] could easily have called its magazine and its models entirely different things without losing any of their intended function.” *Id.* For the same reasons, Rosetta Stone’s marks are not “functional” in the sense used by the functionality doctrine, and thus that doctrine is wholly inapposite to the facts of this case.

**C. On Remand, the District Court Should Consider Whether the Nominative Fair Use Doctrine Applies to Google's Use of Rosetta Stone's Marks as Keywords**

In attempting to apply what it characterized as the “functionality” doctrine to Google’s keyword advertising practices, the District Court appears to have been trying to recognize that some use of Rosetta Stone’s trademarks, as trademarks, might be appropriate both for Google and its advertisers (for example, so that they could communicate that they are resellers of Rosetta Stone’s products, or are making fair, comparative advertising claims with respect to Rosetta Stone’s products). Trademark law already recognizes that such practices, when properly pursued, may be permitted, but it does so under the nominative fair use doctrine. *See generally, Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 218 (3d Cir. 2005); *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 306-08 (9th Cir.1992); *see also*, 15 U.S.C. § 1125(c)(3)(A) (providing defense from dilution claim when advertiser is using, or website operator is facilitating the use of, trademark in a nominative fair use manner for, *inter alia*, comparative advertising).

On remand, this Court should direct the District Court to consider whether Google’s keyword practices are protected under the nominative fair use

doctrine (rather than the functionality doctrine).<sup>4</sup> The District Court may have been reluctant to do so because this Court has not yet endorsed that doctrine, and at least two district courts in this Circuit have suggested that the nominative fair use doctrine may not be applicable in the Fourth Circuit. *Lorillard Tobacco Co. v. S & M Brands, Inc.*, 616 F. Supp. 2d 581, 588-89 (E.D. Va. 2009); *National Fed'n of the Blind v. Loompanics Enters.*, 936 F. Supp. 1232, 1241 (D. Md. 1996). This appeal thus provides this Court with an appropriate opportunity to expressly consider the nominative fair use doctrine.

As explained by the Third and Ninth Circuits, “nominative fair use” protects an advertiser’s right to use another’s trademark, such as in comparative advertising, as long as: (1) the product or service in question is one not readily identifiable without the use of the trademark, (2) the use of the mark or marks is only so much as is reasonably necessary to identify the product or service, and (3) the user does not do anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder. *New Kids on the Block*, 971

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<sup>4</sup> A related doctrine, known as descriptive or statutory fair use, considers whether a trademark is being used “fairly and in good faith only to describe the goods or services of such party, or their geographic origin.” *Lorillard Tobacco Co. v. S & M Brands, Inc.*, 616 F. Supp. 2d 581, 588 (E.D. Va. 2009), *citing* 15 U.S.C. § 1115(b)(4). That type of fair use is not at issue in this case because the Rosetta Stone trademarks are not being used in their descriptive, English-language meaning; rather, they are being used only in their trademark meaning.

F.2d at 306-08; *Playboy*, 354 F.3d at 1030 (rejecting application of the nominative fair use doctrine to use of “playboy” and “playmate” that were used to trigger adult-oriented advertisements where competitors’ ads did not refer to plaintiff); *Century 21*, 425 F.3d at 218. Commentators and other courts alike have adopted this doctrine, or at least the principles underlying the doctrine, to immunize a defendant’s fair use of another’s trademark in this manner. *E.g.*, *Board of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co.*, 550 F.3d 465, 489 (5th Cir. 2008); *Univ. of Florida v. KPBB, Inc.*, 89 F.3d 773, 777 (11th Cir. 1996); *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42 (1st Cir. 1991); *Audi AG v. Shokan Coachworks, Inc.*, 592 F. Supp. 2d 246, 269 (N.D.N.Y. 2008); 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.11.

Rather than distort the functionality defense to fit the instant facts, it would have been more appropriate for the District Court to consider whether Google or its advertisers could invoke rights under nominative fair use. INTA takes no position on how the District Court should rule when it applies the nominative fair use doctrine to the facts of this case, but INTA does urge this Court to clarify that, if Google’s and its advertisers’ use of the Rosetta Stone trademarks is to be permitted, it would be because Google and its advertisers may be making a nominative fair use, rather than because Google is allegedly making a “functional” use of those trademarks.



When the District Court does consider whether Google’s use of the Rosetta Stone trademarks constitutes a protected nominative fair use, one important issue that it should acknowledge is that nominative fair use cannot be used to immunize the sale or advertising of counterfeit goods. As a matter of law, the use of a mark for counterfeit or other unlawful purposes cannot constitute a “fair use.” *Century 21*, 425 F.3d at 244; *New Kids on the Block*, 971 F.2d at 308.

## **II. THE DISTRICT COURT ERRONEOUSLY INTERPRETED THE TRADEMARK DILUTION REVISION ACT**

### **A. Summary of the District Court’s Errors Regarding Dilution.**

The District Court made two critical errors in analyzing the dilution claim. First, the District Court erred when it ruled, as a matter of law, that Google could not be liable for dilution because it does not sell language learning software and did not use Rosetta Stone’s marks to identify its own goods or services. *Op.* at 43. This was error because the TDRA does not require competition or use of the plaintiff’s mark as a trademark to identify the source of the defendant’s goods or services. 15 U.S.C. § 1125(c)(1). The District Court’s analysis confuses “use in commerce” with “fair use” under the TDRA. *Op.* at 43.

Second, the District Court erred when it ruled that, because the ROSETTA STONE mark was famous and its brand awareness actually increased during the relevant time period, it could not prove dilution as a matter of law. *Op.*

at 44-45. In so doing, the District Court effectively required Rosetta Stone to prove actual dilution, instead of *likelihood* of dilution, which is the standard under the TDRA. 15 U.S.C. § 1125(c)(1). Rosetta Stone should not be foreclosed from presenting evidence to prove that Google's conduct is likely to impair the distinctiveness of Rosetta Stone's marks in the future merely because its marks have not yet been harmed by the challenged keyword advertising practices. Under the District Court's ruling, though, a famous mark owner would have to wait until its fame was diminishing before taking action to prevent dilution. This is exactly the opposite of what Congress intended by enacting the TDRA and requiring that only "likelihood of dilution" be established.

**B. The District Court Erred When It Required Proof That Google Uses the ROSETTA STONE Marks On Google's Goods Or Services**

The District Court misinterpreted the plain language of the TDRA when it stated: "Insofar as Google does not sell language learning software, it cannot be held liable for trademark dilution." Op. at 41. On its face, this statement suggests that the District Court erroneously held that Google could not be found liable for dilution because it is not a competitor of Rosetta Stone. Op. at 41. If so, this was error.

As the plain language of the TDRA makes clear, the doctrine of trademark dilution applies in the absence of competition between parties: "the

owner of a famous mark that is distinctive . . . shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution . . . *regardless of the presence or absence* of actual or likely confusion, *of competition*, or of actual economic injury." 15 U.S.C. § 1125(c)(1) (emphasis added). Despite that plain language, the District Court erroneously held that, "insofar as Google does not sell language learning software, it cannot be held liable for trademark dilution." Op. at 41.

Not only does the express language of the statute contradict the District Court's apparent holding, but so does the legislative history. The House Judiciary Committee Report prepared in connection with the TDRA's adoption expressly affirms that injunctive relief is appropriate "even if there is no . . . competition between the owner and the person." H.R. Rep. No. 109-23, at 7 (2006), reprinted in 2006 U.S.C.C.A.N 1091. The District Court's apparent holding that a defendant could not be found liable for dilution because it did not sell competing goods or services was legal error.

The District Court did not appear to rely later in its Opinion on the fact that Google is not in direct competition with Rosetta Stone. It may be that the Court cited the fact that "Google does not sell language learning software," Op. at 41, in order to support its conclusion that Google could not be held liable for

dilution “[a]bsent proof that Google uses the Rosetta Stone Marks to identify its *own* goods and services.” Op. at 43-44 (emphasis in original). If that was the District Court’s intention, that also was error because the Court improperly applied the TDRA’s “use” requirement.

The “use” required by the TDRA is “use in commerce,” which means “interstate commerce.” 15 U.S.C. § 1125(c)(1); 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:99, 24:101. The statute on its face does not require that, to be found liable, Google must have used Rosetta Stone’s marks “as a designation of source” of its own goods or services. Rather, Google must only have “used” the marks “in commerce” in some fashion.

The drafting history of the TDRA makes clear why the District Court’s analysis is not correct. An early draft of the TDRA that was considered by Congress prior to its enactment did, in fact, require that the defendant utilize the mark as a “designation of source.” Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. On Courts, the Internet, and Intellectual Property of the H. Comm. On the Judiciary, 109th Cong. 15-17 (2005) (statement of Anne Gundelfinger, President, INTA) (hereinafter Hearing on H.R. 683). However, both the American Intellectual Property Law Association and the American Bar Association Section of Intellectual Property Law argued that the “designation of source” requirement should be removed. Hearing on H.R. 68 at

48-49 (statement of William G. Barber on behalf of AIPLA); *id.* at 107-108 (statement of Susan Barbieri Montgomery, Vice Chair of the ABA Section of Intellectual Property Law). Following the amendment to the final bill, the designation of source language was removed and the final statute merely required that the mark be used “in commerce.” *See* 15 U.S.C. §1125(c)(1). Thus, the requirement that dilution require use by a defendant as a designation of source was clearly put before Congress and was just as clearly rejected.<sup>5</sup>

Although the District Court in this case failed properly to analyze the issue of whether Google’s sale of trademark keywords constitutes “use in commerce,” other courts have, and they universally have concluded that the sale of keywords is a “use in commerce” for purposes of the Lanham Act. *See, GEICO v. Google, Inc.*, 330 F. Supp. 2d 700 (E.D. Va. 2004); *Google Inc. v. American Blind & Wallpaper Factory, Inc.*, No. C 03-5340, 2007 WL 1159950 (N.D. Cal. April 18, 2007) (denying summary judgment based on a finding of use in commerce); *Vulcan Golf, LLC v. Google, Inc.*, 552 F. Supp. 2d 752 (N.D. Ill. 2008). Most recently, the Second Circuit considered the same issue and came to the same

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<sup>5</sup> The rejection of the designation of source requirement was memorialized in the following statement of Rep. Berman: “[D]ifferent intellectual property owners voiced disagreement at the hearing regarding the designation of source language in the bill. After some negotiation between the parties, the conflict has been resolved, and both AIPLA and INTA support the bill.” *See* H.R. Rep. No. 109-23, at 25 (2005).

conclusion. *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009). In *Rescuecom*, the Second Circuit held that Google’s recommendation and sale to its customers of the plaintiff’s trademark as a keyword, coupled with the fact that Google “displays, offers, and sells [the plaintiff’s] mark to Google’s advertising customers when selling its advertising services,” is tantamount to use in commerce. *Id.* at 129. The Second Circuit distinguished previous cases in which district courts in its Circuit concluded that such use did not constitute trademark use under the Lanham Act (*e.g.*, where a trademark was being used but not displayed to consumers, such as in metadata or as an internal keyword trigger). *Id.* (*citing S & L Vitamins, Inc v. Australian Gold, Inc.*, 521 F. Supp. 2d 188, 199-202 (E.D.N.Y. 2007); *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402, 415 (S.D.N.Y. 2006)). With respect to the very keyword advertising practices that are at issue in this case, the *Rescuecom* court explained that Google’s external display and use of the plaintiff’s mark in connection with its AdWords and Keyword Suggestion Tool constitutes use in commerce. *Id.* at 129; *see also, Hearts On Fire Co. v. Blue Nile, Inc.*, 603 F. Supp. 2d 274, 282-83 (D. Mass. 2009); *Morningware, Inc. v. Hearthware Home Products, Inc.*, 673 F. Supp. 2d 630, 635-36 (N.D. Ill. 2009); *J.G. Wentworth SSC v. Settlement Funding LLC.*, No. 06-0597, 2007 WL 30115, at \*6 (E.D. Pa. Jan. 4, 2007); *800-JR Cigar, Inc. v. GoTo.com, Inc.*, 437 F. Supp. 2d 273, 285 (D.N.J. 2006); *Buying for the Home, LLC v. Humble Abode*

*LLC*, 459 F. Supp. 2d 310, 323 (D.N.J. 2006); *Edina Realty, Inc. v. TheMLSonline.com*, No. 04-4371, 2006 WL 737064, at \*3 (D. Minn. Mar. 20, 2006); *GEICO v. Google, Inc.*, 330 F. Supp. 2d 700, 704 (E.D. Va. 2004); *North Am. Medical Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1218 (11th Cir. 2008).

**C. The District Court Erred In Ruling that the Increasing Fame of the ROSETTA STONE Mark Barred a Claim For Dilution**

The District Court erred in finding that dilution cannot occur in any period during which a famous mark owner's brand awareness increases. *See Op.* at 44. In so doing, the Court effectively imposed a requirement of actual dilution and economic harm, which is directly at odds with the express language and purpose of the TDRA. 15 U.S.C. § 1125.

Congress introduced and passed the TDRA in the wake of the Supreme Court's ruling in *Moseley v. Victoria's Secret Catalogue, Inc.*, 537 U.S. 418 (2003), in which the Court had held that a plaintiff must show *actual* dilution – as opposed to likelihood of dilution – in order to prevail under the then-current Federal Trademark Dilution Act. *Id.* at 428-434. The TDRA was enacted with the express purpose of overturning *Moseley*. Hearing on H.R. 683 at 71 (statement of Marvin J. Johnson, Legislative Counsel, American Civil Liberties Union); *see also* H.R. Rep. No. 109-23, at 4-6 (2006), *reprinted in* 2006 U.S.C.C.A.N 1091. The

plain language of the TDRA now makes it clear that a claim for dilution is actionable when use of a famous mark in commerce “is *likely* to cause dilution . . . regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C. § 1125(c)(1) (emphasis added).

1. *Fame is a prerequisite for protection under the TDRA.*

The TDRA applies only to trademarks that are “famous” within the meaning of the statute. *Id.* Thus, the plaintiff must establish that its mark is famous as a condition precedent before any dilution of its mark can be found. Under the statute, a famous mark is one which is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the marks’ owner.” *Id.* at §1125(c)(2)(A).

To prove the fame of its marks, Rosetta Stone submitted evidence that its “brand awareness” had reached 75% by 2009. *Op.* at 42. Based on this evidence, the District Court concluded that the Rosetta Stone trademarks were, in fact, famous within the meaning of the TDRA. *Id.*

2. *Rosetta Stone is not required to show actual dilution or harm.*

Dilution occurs when a famous mark is harmed or impaired due to an association arising out of the similarity between the famous mark and another mark. As described above, the TDRA’s inclusion of the “likelihood of dilution”



standard was one of the principal changes implemented by the TDRA. The purpose of this change was to allow famous brand owners to obtain injunctive relief without having to prove actual damage to the mark. *Hearing on H. R. 683* at 28 (statement of Anne Gundelfinger, President, INTA).

In this case, the District Court ruled that, because Rosetta Stone's brand awareness had increased during the relevant period, no dilution could have occurred as a matter of law. *Op.* at 44. In so doing, the District Court, in essence, required the famous brand owner to prove *actual* dilution rather than adhering to the *likelihood* of dilution standard implemented by the TDRA. Not only does the District Court's holding in this regard contradict the express text of the statute, it also contravenes one of the very purposes for which the TDRA was enacted.

The District Court also mistakenly interpreted *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), to support its ruling. *Op.* at 45. *Louis Vuitton* involved the parody use of the designation "Chewy Vuiton" in connection with pet toys. On appeal, this Court held that no likelihood of dilution occurred under the TDRA because the defendant's use as a parody avoided any impairment of the distinctiveness of the famous mark as a designation of source for Louis Vuitton's products. *Louis Vuitton*, 507 F.3d at 268. Contrary to the District Court's assertion in this case, *Op.* at 45, the Court in *Louis Vuitton* did *not* find an increase in brand awareness of the "Louis Vuitton" brand, but

merely noted that a successful parody may enhance the fame of its target. *Louis Vuitton*, 507 F.3d at 267. *Louis Vuitton*, therefore, does **not** support the proposition that dilution cannot occur along with an increase in brand awareness. It would be perverse if a counterfeiter or infringer could defend its misconduct by arguing that its use of a mark in connection with **counterfeit** goods (as Rosetta Stone alleged here) or other unlawful use of a mark actually **helps** a brand owner by increasing brand awareness.

The District Court's holding that evidence of increasing brand awareness precludes a finding of dilution liability eviscerates the pre-emptive purpose of the TDRA's **likelihood** of dilution standard. "Because dilution is a process by which the value of a famous mark is diminished over time, either by one or multiple users, the owner of the famous mark should not be required to wait until the harm has advanced so far that the damage is already done." *Hearing on H.R. 683* at 28 (statement of Anne Gundelfinger, President, INTA). The mere fact that a famous mark owner's brand recognition is rising should not, as a matter of law, serve to bar a claim for dilution. Dilution protection should not be barred merely because consumers' overall awareness of a famous brand is increasing at the same time as diluting uses of that brand are having a countervailing effect, and may over time cause the brand to lose its ability to uniquely identify a single source.

The District Court improperly used Rosetta Stone's own survey evidence, which it submitted to prove the fame of its mark, as evidence that no actual dilution of the plaintiff's mark had occurred.<sup>6</sup> That holding undermines one of the fundamental purposes for which the TDRA was enacted, namely, to "relieve trademark owners of the unreasonable burden – in most cases virtually impossible to satisfy – of proving actual dilution." *Hearing on H. R. 683* at 52 (statement of William G. Barber on behalf of AIPLA). Under the District Court's application of the statute, any famous mark owner who successfully establishes its fame by proffering evidence to prove the extent of actual recognition of the mark is at risk of a finding that its mark's fame undermines a showing that dilution is likely. Such an interpretation of the statute is obviously not what Congress intended and contravenes the plain language of the statute. The District Court's ruling on Rosetta Stone's dilution claim is therefore legal error.

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<sup>6</sup> The survey evidence submitted by Rosetta Stone to demonstrate the fame of its mark was not required for it to demonstrate a likelihood of dilution under the TDRA. Rather, a likelihood of dilution may be established merely by the inherent characteristics of the marks at issue without reference to survey evidence. *Visa Int'l Serv. Assoc. v. JSL Corp.*, 610 F.3d 1088, 1091 (9th Cir. 2010).

### CONCLUSION

The District Court's judgment should be vacated and remanded because of its erroneous analysis of both the functionality doctrine and the dilution claim.

The functionality analysis was flawed because the Court wrongly ignored that Rosetta Stone's trademarks are not functional features of Rosetta Stone's products. Inventing new and misguided law, the District Court focused only on Google's purported "functional use." This was a fundamental and critical error. Moreover, as a consequence of the error, the District Court avoided reaching an important issue in the case – determining the proper balance between (1) Google's and its advertisers' rights to make fair use of trademarks, and (2) Rosetta Stone's and other trademark owners' rights to protect their marks against counterfeiting, infringement, and dilution.

The District Court similarly erred on the dilution claim by not properly analyzing whether Google's sale of Rosetta Stone's marks as keywords constitutes use in commerce under the TDRA. Instead, the District Court found that Google was not a competitor of Rosetta Stone, did not use Rosetta Stone's marks as a designation of source of Google's own services, and therefore its sale of Rosetta Stone's marks to trigger advertisements could not, as a matter of law,

constitute trademark dilution. The District Court also erred by finding that Rosetta Stone could not prove dilution as a matter of law because its brand awareness actually increased during the relevant time period. In so doing, the District Court effectively applied an “actual dilution” requirement, which the TDRA expressly replaced with a likelihood of dilution standard. INTA urges this Court to vacate and remand the District Court’s findings on the dilution claim to ensure that the District Court correctly analyzes this case under the proper standards, in line with the plain language and express purpose of the TDRA.

Dated: November 1, 2010

Respectfully submitted,

/s/ David H. Bernstein  
David H. Bernstein  
DEBEVOISE & PLIMPTON LLP  
919 Third Avenue  
New York, NY 10022  
Tel: (212) 909-6696  
email: dhbernstein@debevoise.com

*Counsel for Amicus Curiae International  
Trademark Association*

*Of Counsel:*

International Trademark Association  
655 Third Avenue, 10th Floor  
New York, NY 10017  
(212) 768-9887

Kurt E. Anderson  
Giordano, Halleran & Ciesla, P.C.  
125 Half Mile Road, Ste. 300  
Red Bank, NJ 07701-6777

A. Justin Ourso III  
Jones, Walker, Waechter, Poitevent, Carrère & Denègre L.L.P.  
8555 United Plaza Boulevard  
Baton Rouge, LA 70809

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Mitchell Scott Ettinger  
Direct: 202-371-7444  
Email: mitchell.ettinger@skadden.com  
SKADDEN, ARPS, SLATE, MEAGHER & FLOM, LLP  
1440 New York Avenue, NW  
Washington, DC 20005-2107

Clifford M. Sloan  
Direct: 202-371-7040  
Email: cliff.sloan@skadden.com  
SKADDEN, ARPS, SLATE, MEAGHER & FLOM, LLP  
1440 New York Avenue, NW  
Washington, DC 20005-2107

Jennifer L. Spaziano  
Direct: 202-371-7000  
Email: jen.spaziano@skadden.com  
SKADDEN, ARPS, SLATE, MEAGHER & FLOM, LLP  
1440 New York Avenue, NW  
Washington, DC 20005-2107

Margret Mary Caruso, Attorney  
Direct: 650-801-5000  
Email: margretcaruso@quinnemanuel.com  
QUINN, EMANUEL, URQUHART & SULLIVAN, LLP  
5th Floor  
555 Twin Dolphin Drive  
Redwood Shores, CA 94065

Jonathan David Frieden, Esq., Attorney  
Direct: 703-218-2125  
Email: jdf@ofplaw.com  
ODIN, FELDMAN & PITTLEMAN, PC  
Suite 1100  
9302 Lee Highway  
Fairfax, VA 22031-1215



Cheryl Galvin  
Direct: 650-801-5000  
Email: cherylgalvin@quinnemanuel.com  
QUINN, EMANUEL, URQUHART & SULLIVAN, LLP  
5th Floor  
555 Twin Dolphin Drive  
Redwood Shores, CA 94065

Henry Lien  
Direct: 650-801-5089  
Email: henrylien@quinnemanuel.com  
QUINN, EMANUEL, URQUHART & SULLIVAN, LLP  
5th Floor  
555 Twin Dolphin Drive  
Redwood Shores, CA 94065

/s/ Catherine B. Simpson  
Counsel Press LLC  
1011 East Main Street  
Suite LL-50  
Richmond, Virginia 23219  
(804) 648-3664

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David H. Bernstein 212 909 6696  
Name (printed or typed) Voice Phone

Debevoise & Plimpton LLP 212 521 7696  
Firm Name (if applicable) Fax Number

919 Third Avenue

New York, NY 10022 dhbernstein@debevoise.com  
Address E-mail address (print or type)

OR, I, \_\_\_\_\_, AM NOT PARTICIPATING IN THIS CASE.  
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