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UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

TINA RENNA,

Plaintiff,

vs.

THE COUNTY OF UNION

Defendant.

CIVIL ACTION NO.: 11-3328

BRIEF FOR SUMMARY JUDGMENT

On the Brief:

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STATEMENT OF FACTS

Plaintiff, Tina Renna, initiated the present action by filing a complaint on May 26, 2011 in the United States District Court, District of New Jersey. (See Statement of Material Facts, para. 4). Plaintiff alleges that the actions of defendant, the County of Union (hereinafter “the County”), deprived the plaintiff of her rights to free speech and expression under the First Amendment to the United States Constitution by demanding that the Township of Cranford public access television station cease and desist use of the Seal of the County of Union on her program. (See Statement of Material Facts, para. 5). Plaintiff seeks a Declaratory Judgment declaring that the County has no protection against use of the County Seal. (See Statement of Material Facts, para. 5). The County contends that the Seal of the County of Union is protected under 15 U.S.C. § 1125 of the Lanham Act and therefore the plaintiff’s complaint fails to state a claim upon which relief can be granted. The County also argues that the demand to cease and desist was to a third party and thus the plaintiff has not been damaged since the County never pursued any legal action against plaintiff nor deprived plaintiff of any of her rights. Therefore, the County moves for an Order granting Summary Judgment in its favor dismissing the present Complaint pursuant to Fed. R. Civ. P. 56 or in the alternative, dismissing the complaint pursuant to Fed. R. Civ. P. 12 (b)(6) for failure to state a claim upon which relief can be granted.

LEGAL ARGUMENT

As demonstrated below, plaintiff’s claim fails as a matter of law. Accordingly, the court should grant summary judgment to the defendant pursuant to Fed. R. Civ. P. 56 or in the alternative, the complaint should be subject to dismissal under Fed R. Civ. P. 12(b)(6).

I. WHERE, AS HERE, THERE ARE NO GENUINE ISSUES AS TO ANY

MATERIAL FACTS AND PLAINTIFF HAS FAILED TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED, DEFENDANT IS ENTITLED TO JUDGMENT AS A MATTER OF LAW

Summary judgment may be entered when the pleadings, answers, and depositions show that there are no genuine disputes as to any material fact. Fed. R. Civ. P. 56(c). This standard provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986). When a properly supported motion for summary judgment is made, the adverse party must set forth specific facts showing that there is a genuine issue for trial. Id. Once the moving party has demonstrated that there appear to be no genuine disputes of material fact, the non-moving party must come forward with specific facts showing that there is. Schoch v. First Fid. Bancorporation, 912 F.2d 654, 657 (3d Cir. 1990). There is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. Anderson, at 242. If the evidence is merely colorable or is not significantly probative, summary judgment may be granted. Id. If the nonmoving party cannot produce sufficient evidence to establish an element essential to his case summary judgment is appropriate. Celotex Corp. v. Catrett, 477 U.S. 317, 322-323 (1986).

When a plaintiff fails to state a claim upon which relief may be granted, the court should dismiss the complaint pursuant to Fed. R. Civ. P. 12(b)(6). A motion to dismiss under Fed. R. Civ. P. 12(b)(6) tests the legal sufficiency of a complaint. Browning v. Clinton, 292 F.3d 235, 242 (D.C. Cir. 2002). The relevant question is whether, assuming the factual allegations are true, the plaintiff has stated a ground for relief that is plausible. Ashcroft v. Iqbal, 556 U.S. 662, 696 (2009). Dismissal is appropriate when a plaintiff fails to allege enough facts to state a claim to relief that is plausible on its face. Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007). Factual allegations must be enough to raise a right to relief above the speculative level. Id. When the plaintiff's

complaint is legally insufficient to state claims upon which relief can be granted, the complaint should be dismissed. Trudeau v. FTC, 456 F.3d 178, 191 (D.C. Cir. 2006).

In this case, the facts are not disputed. As there is no genuine dispute regarding defendant's protection with respect to the Seal of the County, the matter is ripe for summary judgment. The letter the County sent was to a third party to cease and desist use of the County Seal. The County never brought any legal action against plaintiff for using the seal nor did the County ever contact the plaintiff personally to cease and desist using the Seal. The County did not involve the plaintiff. It simply sought to prevent use of the County Seal in the manner likely to cause viewer confusion over who produced what on the Township of Cranford's public access television channel 35. The County sought protection for a protected activity against the television station, not the plaintiff. The complaint is fatally flawed because it seeks an Order allowing plaintiff free use of the County Seal because it is not "protected." For the following reasons she is not entitled to such relief.

II. THE SEAL OF THE COUNTY OF UNION IS PROTECTED UNDER THE LANHAM ACT AND THUS THE COMPLAINT FAILS TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED

The Seal of the County of Union is protectable under 15 U.S.C. § 1125 of the Lanham Act. The Lanham Act prohibits the commercial use of any copy or colorable imitation of a valid mark in connection with the advertising of any goods or services on or in connection with which such use is likely to cause confusion, to cause mistake or to deceive. 15 U.S.C. § 1114(1)(a). As defined by 15 U.S.C. § 1127, a service mark is "any word, name, symbol, or device...used to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown."

Further, Section 1125 (a)(1) provides:

“(1) Any person who, on or in connection with any goods or services, ... uses in commerce any word, term, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person....shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.” 15 U.S.C. § 1125(a)(1)(A).

The Lanham Act protects unregistered marks to the same extent as registered marks because trademark rights emanate from use and not merely registration. Duffy v. Charles Schwab & Co., Inc., 97 F.Supp.2d 592 (D.N.J.2000). To prevail on a trademark infringement claim for an unregistered mark, the plaintiff must show that (1) the mark is valid and legally protectable, (2) the plaintiff owns the mark, and (3) the defendant's use of a similar mark is likely to create confusion concerning the origin of the plaintiff's goods or services. 15 U.S.C. § 1125(a)(1); Freedom Card, Inc. v. JPMorgan Chase & Co., 432 F.3d 463, 470 (3d Cir.2005); Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466, 472 (3d Cir.1994).

Although unregistered marks have no presumption of validity, an unregistered mark may be valid and protectable. Duffy, at 593. An unregistered mark is valid and legally protectable if the plaintiff shows that the mark is inherently distinctive or has secondary meaning. Id. Distinctiveness of a mark is measured by classifying the mark into one of four categories ranging from strongest to weakest, with strong marks receiving the greatest protection: (1) arbitrary or fanciful ; (2) suggestive; (3) descriptive; and (4) generic. Freedom Card, Inc., at 472. Suggestive or fanciful marks are inherently distinctive and are protected under the Lanham Act without a showing that it has acquired secondary meaning. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992). A ‘fanciful’ mark is a combination of letters or other symbols signifying

nothing other than the product or service to which the mark has been assigned. Champions Golf Club, Inc. v. The Champions Golf Club, Inc., 78 F.3d 1111, 1117 (6th Cir. 1996).

In determining whether a likelihood of confusion exists between marks, the following factors are usually considered by the courts: (1) degree of similarity between the owner's mark and alleged infringing mark; (2) strength of the owner's mark; (3) price of services and other factors indicative of care and attention expected of consumers; (4) length of time defendant has used mark without evidence of actual confusion arising; (5) intent of defendant in adopting mark; (6) evidence of actual confusion; (7) whether services, though not competing, are marketed through same channels and advertised through same media; (8) extent to which targets of parties' sales efforts are the same; (9) relationship of services in minds of public because of similarity; and (10) other facts suggesting that consuming public might expect the owner to be providing services. Interspace Corp v. Lapp, Inc., 721 F.2d 460, 463 (3d. Cir. 1989). The likelihood of confusion exists when consumers viewing the mark would probably assume that the service it represents is associated with the source of the different service identified by the similar mark. Jews for Jesus v. Brodski, 993 F. Supp. 282, 306 (D.N.J. 1998).

In the present case, plaintiff alleges that the County has no protection with respect to the Seal of the County of Union. In New Jersey, every county clerk shall have an official seal for the office of the county clerk. N.J. Stat. Ann. § 40A:9-66 (West). Therefore, it is well-established that the County, specifically the county clerk, is the owner of the Seal and that the Seal is a symbol used to identify services provided by the County. The Seal is considered a service mark under the Lanham Act since its combination of letters and symbols represent the history of the County and signify nothing other than the County of Union and the services to which it provides. The Seal of the County is displayed at County and Freeholder meetings, used on every

correspondence from the County and is displayed on every official County document and commercial contract with vendors to identify the County's involvement. Therefore, the Seal is fanciful thus inherently distinctive service mark, and is valid and legally protectable under the Lanham Act.

Furthermore, plaintiff's display of the Seal was likely to create confusion between the plaintiff's use and the County's. The plaintiff used the Seal of the County of Union in the television show "Union County Citizen's Forum." By using the Seal, any reasonable person would believe that the show and plaintiff were somehow involved with the County. The display of the Seal was likely to create the illusion that whatever was presented on the show was associated with the County, and was likely to confuse the public into believing that the County was affiliated and/or sponsored the show.

The argument that the County has no protection because the Seal has not been used in connection with the advertising of goods and services simply has no merit. Plaintiff's display of the Seal was in connection with her news and public information programming making it absolutely commercial in nature. Plaintiff was not only using the Seal to merely criticize the County's good or services as she contends. By displaying the Seal on both her television show and the Union County Watchdog Association website, plaintiff used the Seal in connection with rendering the news to the public. In a recent decision by the Superior Court of New Jersey, the court held that plaintiff's blog was connected with the news media since she was reporting and commenting on local government news on the website with the purpose of disseminating news. In re January 11, 2013 Subpoena by the Grand Jury of Union County, 2013 N.J. Super. LEXIS 124, 33, 2013 WL 4779696 (Law Div. Apr. 12, 2013). Almost identical to plaintiff's blog, plaintiff's television show "Union County Citizen's Forum," also reported and commented on

current events in Union County with the purpose of disseminating news to the public. Plaintiff has even admitted that the use of the Seal on the show was in connection with the provision of news and information. (See Plaintiff's Complaint, attached as Exhibit "A"). Therefore, the Seal has been used in connection with the advertising of services as required by the Lanham Act.

Undoubtedly, the Seal of the County of Union is an unregistered service mark protected under the Lanham Act. The Seal is valid and legally protectable since the County is owner of the Seal and the Seal as a service mark is fanciful thus inherently distinctive. Plaintiff's use and display of the Seal was likely to cause confusion as to whether the County was affiliated and/or sponsored the "Union County Citizen's Forum." Thus, the County does have protection with respect to the Seal of the County of Union under the Lanham Act and plaintiff's display of the Seal on her television show was an infringing use. Therefore, all claims in the Complaint should be dismissed.

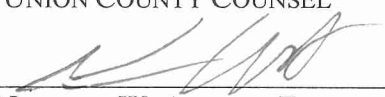
CONCLUSION

For the foregoing reasons, it is respectfully requested that Summary Judgment be granted in favor of the defendant or the motion be dismissed for failure to state a claim, and that plaintiff's claim be dismissed with prejudice.

Furthermore, the facts of this case do not warrant the case surviving this motion. Defendant did not stop plaintiff from any activity but simply demanded a third party cease showing its seal on a show not connected in any way to official or sanctioned activity of county government.

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DATED: 10/11/13

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