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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049339
Party	Defendant Bookman, Charles, Anthony
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Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Charles Bookman
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD

BITSTREAM, INC.,  
Petitioner,

v.

CHARLES ANTHONY BOOKMAN,  
Registrant.

Cancellation No.: 92049339

Registration No.: 2715836

MOTION TO DISMISS UNDER 37 C.F.R. §2.116 AND F.R.C.P. 12(b)(6)

Registrant, Charles Anthony Bookman (hereafter “Bookman”), pursuant to 37 C.F.R. §2.116 and Rule 12(b)(6) of the Federal Rules of Civil Procedure hereby moves the TTAB to dismiss the above-captioned Petition for Cancellation.

As grounds for its Petition for Cancellation, Bitstream alleges as follows:

1. “On May 12, 2008, Petitioner filed a trademark application on the Principal Register for THUNDERHAWK in International Class 009: Computer software, namely, software with data compression and caching functionality to enable enhanced Internet browsing via mobile telephones, personal digital assistants and wireless devices; and International Class 042: Providing a mobile Internet browser with data compression and caching functionality to enable enhanced Internet browsing via mobile telephones, personal digital assistants and wireless devices. This application was assigned Serial No. 77/472,223....” Petition for Cancellation at ¶4;

2. “On June 5, 2002, Registrant filed application Serial No. 78/133,290 for registration on the Principal Register for the mark THUNDERHAWK that ultimately issued in IC 035 for computer services, namely, address change notification services in the nature of posting notifications of changes of address for businesses via the Internet, and in IC 042 for Computer code conversion for others; computer consultation; computer graphics services; computer network design for others; computer programming for others; computer project management services; computer services, namely, creating and maintaining websites for others, computer services, namely, data recovery services, computer services, namely, designing and implementing web pages and web sites for others, computer services, namely, providing search

engines for obtaining data on a global computer network, computer services, namely, creating indexes of information, sites and other resources available on computer networks, computer services, namely, managing web sites for others, computer services, namely, redirecting electronic mail to changed personal electronic addresses, computer site design, computer software consultation, computer software design for others; computer software development, computer systems analysis. This application matured into Reg. No. 2,715,836 on May 13, 2003..." Petition for Cancellation at ¶15; and

3. "Petitioner is likely to be damaged by continued registration of said mark because the PTO Examining Attorney will likely refuse Petitioner's application bearing Serial No. 77/472,223 (identified above) on the grounds that, under 37 CFR §2d of the Lanham Act, there is a likelihood of confusion between the Petitioner's mark THUNDERHAWK and Registrant's mark THUNDERHAWK." Petition for Cancellation at ¶13

On October 23, 2002, Bookman filed a civil action against Bitstream for trademark infringement in the U.S. District Court for the District of Massachusetts, Civil Action No. 02-12078-NG. On March 31, 2005, the Court issued a Memorandum and Order finding that Bitstream's use of the mark THUNDERHAWK in connection with "a wireless web browser software product" did not create a likelihood of confusion with Bookman's use of the mark THUNDERHAWK in connection with "a variety of custom-tailored information technology consulting services, including analysis, programming, web design, web development, web hosting, technical training, Internet marketing, network design/implementation and database development." The Court's finding of no likelihood of confusion was based, in part, on its finding that a wireless web browser software product sold by Bitstream is substantially different than information technology consulting services provided by Bookman. A copy of the Court's Memorandum and Order is attached hereto.

In view of the prior litigation between Bookman and Bitstream and the Court's finding of no likelihood of confusion, Bitstream should be precluded from asserting that it would be damaged by U.S. Reg. No. 2,715,836 based upon a likelihood of confusion. As such, Bitstream has not set forth any grounds for cancellation of U.S. Reg. No. 2,715,836. Further, the Trademark Examining Attorney has not examined Bitstream's application and may not refuse

registration on the Principal Register. Bookman asserts that Bitstream's Petition for Cancellation is premature and it should wait until such time as the Examining Attorney refuses to register Bitstream's mark in view of U.S. Reg. No. 2,715,836.

For all of the above reasons, Bookman asserts that Bitstream's Petition for Cancellation fails to state a claim upon which relief can be granted and should be dismissed.

Respectfully submitted,

Dated: June 17, 2008

/s/ Charles Anthony Bookman  
Charles Anthony Bookman  
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of this document has been served upon all parties of record by first class mail, postage pre-paid, to Thomas M. Saunders, Esq., Seyfarth Shaw LLP, Two Seaport Lane, Suite 300, Boston, MA 02210-2028 on June 17, 2008.

/s/ Charles Anthony Bookman  
Charles Anthony Bookman

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

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CHARLES BOOKMAN, d/b/a/ THUNDER HAWK )  
INTERNET SYSTEMS, )  
Plaintiff, )  
 ) Civil No. 02-12078-NG  
v. )  
 )  
BITSTREAM, INC., )  
Defendant. )

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GERTNER, D.J.:

MEMORANDUM AND ORDER RE: MOTIONS FOR SUMMARY JUDGMENT ON  
PLAINTIFF'S TRADEMARK INFRINGEMENT AND DAMAGES CLAIMS

March 31, 2005

I. INTRODUCTION

Plaintiff Charles Bookman ("Bookman"), the owner of a small Internet consulting business, contends that he is the senior user of the service mark "THUNDERHAWK."<sup>1</sup> Pursuant to the federal Lanham Act and Massachusetts trademark law, he seeks injunctive relief and damages against defendant Bitstream, Inc. ("Bitstream"), a much larger software development company, alleging its infringing use of the trademark "ThunderHawk" in connection with its wireless web browser software product. Bookman believes that Bitstream's use of the mark has resulted in consumer confusion, causing irreparable harm to his reputation and goodwill, and to his ability to control his mark and reasonably expand his services.

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<sup>1</sup> Since service marks (which "distinguish one's services from those offered by others") and trademarks (which "distinguish one's goods from those made by others") are, for the most part, functional equivalents, "the distinction between the two types of marks is irrelevant . . . [and] cases discussing either apply." Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 23 n.1 (1st Cir. 1989).

Discovery was conducted, and every effort was made to resolve the claims, but these efforts failed. Bitstream moves this Court to grant summary judgment on Bookman's trademark infringement claims [docket entry # 62] under the theory that he cannot demonstrate ownership of a protectable mark, much less a likelihood of confusion. In addition, Bitstream moves for summary judgment on damages [docket entry # 66], arguing that Bookman clearly cannot make out a case for monetary damages or harm to his reputation, even if the facts are deemed less clear on the infringement claims.

Viewing the facts in the light most favorable to Bookman, I **GRANT** summary judgment to Bitstream on both motions.

## **II. RELEVANT FACTS**<sup>2</sup>

Bookman testified that his business, Thunder Hawk Internet Systems, provides a variety of custom-tailored information technology consulting services, including analysis, programming, web design, web development, web hosting, technical training, and Internet marketing. In addition, he represented that he offers network design/implementation and database development, that he is not simply an Internet Service Provider ("ISP"), and that he does not offer a web browser software product.

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<sup>2</sup> I draw these facts from Bitstream's Statement of Material Facts and Bookman's Statement of Disputed Material Facts.

Bookman's website, located at [www.thunderhawk.com](http://www.thunderhawk.com), depicts his alleged mark "THUNDERHAWK" as one word in black, lower case, block letters. The site lists his contact information and services, which are enumerated as web hosting, technical training, and domain registration. It has not substantively changed in format or content since at least October 2002 (i.e., the description of services and amounts charged for them have remained relatively constant).

Bookman filed his state trademark application for "THUNDERHAWK" on May 28, 2002. The registration states that his date of first use anywhere and in Massachusetts was January 2, 1995. Bookman filed his federal trademark application for "THUNDERHAWK" on June 5, 2002, and the registration issued on May 13, 2003. The federal trademark registration states that his first use anywhere and in commerce was January 2, 1994.

Bookman claims to have rendered his services to a number of customers since 1996, though he maintains limited records. During his deposition, he identified his past or active customers over the last five years as two local martial arts schools, Boston College, local entities called Brodeur Interactive and Project Place, a local individual named Ron Baker, and several local training centers.<sup>3</sup> He substantiated four of these transactions with invoices for services rendered.

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<sup>3</sup> The term "local" refers to the Boston area.

Defendant Bitstream licenses and distributes a wireless web browser software product under the name "ThunderHawk." The product may be downloaded to a customer over the Internet, or shipped to the customer directly from Bitstream.

Bitstream's current website displays the word "ThunderHawk" in red letters, with "T" and "H" in large capital letters and the remaining letters in small capitals. The word "ThunderHawk" is sometimes used in conjunction with the phrases "BROWSING FOR THE WIRELESS INTERNET" or "MOBILE BROWSING ANYTIME, ANYWHERE."

On June 6, 2001, Bitstream used its website, as well as press releases, to launch the wireless product under the name "ThunderHawk." Since the release of "ThunderHawk," more than 48,000 end users from across the United States and throughout the world have downloaded the software onto their wireless devices and signed up to use the product.

### **III. LEGAL ANALYSIS**

#### **A. Standard of Review for Summary Judgment**

The First Circuit has held, "[w]hile summary disposition is usually inappropriate in complex infringement and unfair competition cases, it is not unheard of." Pignons S.A. de Mecanique v. Polaroid Corp., 657 F.2d 482, 486 (1st Cir. 1981). Summary judgment in a trademark infringement case is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show

that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.'" Pignons, 657 F.2d at 486 (quoting Fed. R. Civ. P. 56(c)). A factual dispute is "material" if it impacts the outcome of the litigation, and "genuine" if manifested by substantial evidence beyond the allegations of the complaint. See id. In essence, the guiding question on summary judgment review is: Does the evidence present a sufficient disagreement to require submission to a jury, or is it so one-sided that one party must prevail as a matter of law?

In determining a motion for summary judgment, the court must view the record and draw inferences in the light most favorable to the opposing party. See id. Accordingly, I assess the facts with respect to the legal standards set forth below in the light most favorable to Bookman.

#### **B. Trademark Infringement Claims**

The purpose of trademark law is to "prevent one seller from using the same 'mark' as -- or one similar to -- that used by another in such a way that he confuses the public about who really produced the goods (or service)." DeCosta v. Viacom Int'l, Inc., 981 F.2d 602, 605 (1st Cir. 1992); see also Star Financial Services v. Aastar Mortgage Corp., 89 F.3d 5, 9 (1st Cir. 1996). Accordingly, "the law often permits a person to take a pre-existing name or mark and use it on a different product in

a different market" because these distinctions eliminate the likelihood of consumer confusion. DeCosta, 981 F.2d at 609.

To prevail, the plaintiff in a trademark infringement case must show that: 1) he uses, and thereby owns, a mark; 2) the defendant is using that same, or a similar, mark; and 3) the defendant's use is likely to confuse the public about the source of the goods or services, thereby harming the plaintiff. See DeCosta, 981 F.2d at 605 (citations omitted); see also Star Financial, 89 F.3d at 9.

As for the third factor, according to the First Circuit, two types of consumer confusion -- traditional and reverse -- are possible and lead to different harms. Bookman specifically claims only reverse confusion, which is sensible under these facts. See Pl.'s Mem. of Law in Opp'n to Def.'s Mot. for Summ. J. at 8 [hereinafter Pl.'s Mem.]. While, in a traditional case, the plaintiff is concerned that customers will think he makes the defendant's product, in a reverse confusion case, the concern is that customers will think the defendant makes the plaintiff's product.<sup>4</sup> See DeCosta, 981 F.2d at 607-608. Under the traditional model, the plaintiff may be harmed in two ways: 1) customers' dissatisfaction with the defendant's products or services may harm the reputation of the plaintiff's products or

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<sup>4</sup> Without the concept of reverse confusion, Bookman would have no case at all because it would be virtually impossible to believe, given his small consumer base, that people might think he makes Bitstream's wireless web browser.

services, or 2) even if the defendant's product is well-received, insofar as her customers are encouraged to buy it because they associate the plaintiff with it, the defendant free-rides on the plaintiff's efforts. See id. at 607-608. Under the reverse confusion model, if the defendant makes a poor product, the plaintiff's potential customers may decide that plaintiff's products come from a poorly managed company and thereby be reluctant to buy them. See id. at 608; Star Financial, 89 F.3d at 9-10.

For success on a trademark infringement claim under both Massachusetts and federal law, the First Circuit requires a showing that buyers are substantially likely to confuse the two marks at issue (mere possibility is not enough). See Star Financial, 89 F.3d at 10. Courts typically examine eight factors in making this determination: 1) the marks' similarity; 2) the similarity of the underlying goods or services; 3) the relation of the channels through which the parties trade; 4) the relation of the parties' advertising; 5) the kinds of prospective buyers; 6) evidence of actual confusion; 7) the defendant's reasons for using the mark; and 8) the strength of the plaintiff's mark. See DeCosta, 981 F.2d at 606; Star Financial, 89 F.3d at 10.

Because the requisite analysis involves multiple factors, I must determine "on the whole whether there is any genuine issue." Astra Pharmaceutical Products v. Beckman Instruments, 718 F.2d

1201, 1205 (1st Cir. 1983). Each factor must be considered, but "[n]o one factor is necessarily determinative." Id.

### 1. Ownership of the Mark

Bitstream argues that Bookman does not have priority rights over the trademark because his federal registration for the mark did not issue until after Bitstream launched its web browser product and had already invested substantial resources in developing recognition of its mark. In addition, Bookman has had few clients and engaged in limited advertising. See Bitstream's Mem. in Supp. of its Mot. for Summ. J. on Pl.'s Trademark Infringement Claims at 8 [hereinafter Bitstream's Mem.]. Nonetheless, construing the facts in the light most favorable to Bookman, I find that there remains a genuine issue as to Bookman's claim for ownership of the "THUNDERHAWK" mark and therefore that summary judgment cannot be granted on this ground.<sup>5</sup>

Bookman may well be entitled to protection under the Lanham Act, even if his federal trademark registration does not predate Bitstream's use of the mark. As the Supreme Court stated years ago, "the right to a particular mark grows out of its use, not its mere adoption . . . ." United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918). In CCBN.com, Inc. v. c-call.com,

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<sup>5</sup> Note that this analysis does not take into account the fact that, in theory, both Bookman and Bitstream could be owners of the same mark if their uses were deemed distinct enough to eliminate the likelihood of consumer confusion. See supra Part III.B.

Inc., 73 F. Supp. 2d 106 (D. Mass. 1999), Judge Saris concluded that the Lanham Act grants trademark protection for marks that are "'used in commerce.'" CCBN.com, 73 F. Supp. 2d at 109 (quoting U.S.C. § 1051). "Use in commerce" involves the use or display of the mark in the sale or advertising of services rendered in commerce. See id. at 109. "In the emerging world of the Internet, one court defined 'use in commerce' to include establishing a 'typical home page on the Internet, for access to all users.'" Id. at 110 (quoting Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1434 (S.D.N.Y. 1997)). While advertising and promotional activities alone, unaccompanied by the rendering of services, have not been deemed sufficient to constitute "use in commerce," Bookman contends that he rendered services under the mark prior to Bitstream's first use of the mark. See id. at 110. On summary judgment review, I must give him the benefit of the doubt.

Bookman has been continuously registered to do business within Boston under the business name "Thunder Hawk Internet Systems" since August 25, 1996. See Bookman's Statement of Disputed Material Facts, Ex. 6. Shortly after February 14, 1996, he expanded and promoted his services in commerce under the mark "Thunder Hawk"<sup>6</sup> by registering the domain name

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<sup>6</sup> Bookman contends that his use of the mark "THUNDERHAWK," as one word, began at least as early as May 2000. See Bookman's Statement of Disputed Material Facts ¶ 29.

"www.thunderhawk.com" and launching his own website. According to publicly archived records, the site was functional and promoted Bookman's services as of December 26, 1996. See Bookman's Statement of Disputed Material Facts ¶ 30. Bookman claims to have communicated with potential customers over e-mail via his website since that date as well. See id. ¶ 105. In addition, for many years, Bookman has promoted his mark by handing out business cards at events sponsored by companies such as Microsoft. See id. ¶ 30.

Furthermore, though Bookman does not appear to maintain records consistently, he claims to have rendered his services to a number of customers since 1996.<sup>7</sup> See id. ¶ 109. Bitstream essentially admits that Bookman has used the mark at least since 2000, which is before Bitstream launched its product publicly. See Bitstream's Statement of Material Facts ¶ 30.

On these facts, there remains a genuine issue as to the material fact of trademark ownership. Accordingly, I cannot grant summary judgment on the basis that Bookman does not own a protectable mark. Nonetheless, Bookman's failure to demonstrate

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<sup>7</sup> In his motion, Bookman does not even attempt to rely on his history of sales to prove ownership. Instead, he argues that the First Circuit has set forth a two-part test establishing prior use in the absence of actual sales: 1) adoption, and 2) use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark. See New England Duplicating Co. v. Mendes, 190 F.2d 415, 418 (1st Cir. 1951). He may take this approach due to a lack of record-keeping.

a substantial likelihood of confusion is enough to grant summary judgment. See infra Part III.B.3.

## 2. Similarity of the Marks

I address this factor in detail under the first prong of the confusion analysis. See infra Part III.B.3.a.

## 3. Confusion about the Marks

The eight criteria used to assess confusion all speak to the issue of whether a defendant's use of a mark would lead the public to confuse, with substantial likelihood, the source of goods or services. Likelihood of confusion is "'an essential element of a claim of trademark infringement,' whether it arises under state or federal law." Astra Pharmaceutical, 718 F.2d at 1205 (quoting Pignons, 657 F.2d at 486-87). In assessing confusion, the First Circuit has employed a rather exacting standard that Bookman fails to meet.<sup>8</sup>

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<sup>8</sup> For example, the First Circuit found the evidence of confusion adequate -- but not overwhelming -- even in Star Financial, where the facts favored the plaintiff substantially more than these facts favor Bookman. Plaintiff STAR began offering mortgage originating services throughout Massachusetts in 1993 and registered its service mark, which consisted of the word "STAR" in bold, capital letters, a five-point star symbol in the upper portion of the letter "R" and the word "MORTGAGE" in smaller capital letters below, in January 1994. See Star Financial, 89 F.3d at 8. In May 1994, AASTAR also started offering mortgage originating services in Massachusetts. It advertised in the same publication as STAR, using the name "AASTAR MORTGAGE CORP." in bold, capital letters and, initially, a five-point star symbol over the first "A." See id. at 9. Despite the companies' substantial overlap on most of the confusion factors, the Court noted that, "[w]hile the evidence supporting a substantial likelihood of confusion may not have been overwhelming, it was adequate; the court did not err in denying the motion for judgment as a matter of law, and we will not disturb the jury's verdict." Id. at 11.

a. Similarity of the "ThunderHawk" Marks

Bitstream argues that, while the "ThunderHawk" marks may seem similar at first, they are not likely to be confused given their total effect. See Bitstream's Mem. at 9. In contrast, Bookman argues that the marks are virtually identical and prominently displayed, such that a jury could reasonably infer that an Internet user who arrives at the parties' respective sites would easily notice the marks. See Pl.'s Mem. at 9.

Bookman's website prominently depicts his alleged mark "THUNDERHAWK" as one word in black, lower case, block letters. The word appears underneath a red eye logo and above the phrase "Internet Systems," which is in smaller black letters. A thick red line runs beneath the alleged mark and across the entire page. Otherwise, the background is white. See Bitstream's Statement of Material Facts, Ex. 7.

Bitstream's website contains the name "ThunderHawk," prominently displayed in red alongside descriptions of the company's news, products, support services and business partners, information for developers, and information regarding its font and software business. The site has a black and green color motif along the top and side of most of its pages, though a variety of colors are used throughout the pages. In addition, an eye logo is positioned adjacent to Bitstream's purported mark. See Chagnon Decl., Ex. A. The home page and many of the other

pages on Bitstream's site feature the company name across the top and display its diamond-shaped logo in the upper left corner. See id. However, at least one page of Bitstream's website prominently displays "ThunderHawk" in red along with an eye logo, all against a solid white background, without the Bitstream company name or logo. See Bookman's Statement of Disputed Material Facts, Exs. 20-21.

Bitstream focuses on the differences between the marks, while First Circuit law dictates emphasizing the similarities on summary judgment review. In Astra Pharmaceutical, like here, the First Circuit compared a house name trademark against a brand name trademark. Astra used brand names such as "Xylocaine" to identify its pharmaceutical preparations and syringes, and "Astra Pharmaceutical" and "ASTRA" as house names. See Astra Pharmaceutical, 718 F.2d at 1205. The company brought a trademark infringement action against Beckman, which used "ASTRA," accompanied by the words "Automatic Stat/Routine Analyzer," as a brand name on its blood analyzer instrument, and clearly printed "BECKMAN" on another part of the machine to indicate its source. See id. at 1205.

In analyzing the similarity of the marks, the Astra Pharmaceutical Court noted that it is "well settled that under certain circumstances otherwise similar marks are not likely to be confused where used in conjunction with the clearly displayed

name and/or logo of the manufacturer.” Id. at 1205. Thus, Bitstream is correct that, generally, the relevant standard for similarity of marks is the total effect of their designations, rather than their comparative individual features. See id. Nonetheless, the Court also recognized that, since the word “ASTRA” was used by both parties as a trademark, the marks were identical in terms of spelling and sound. See id. Accordingly, in considering the evidence in the light most favorable to the non-moving party, the Court found that the presence of the word “ASTRA” on both Beckman and Astra products made the marks, while not identical, at least similar for the purposes of the review. See id.

Viewing the marks in a light most favorable to Bookman, it is reasonable to conclude that, if not identical, they are at least similar, such that a jury could supportably find that their total effect creates a probability of confusion, particularly given that a consumer could first encounter the page lacking the company name and logo on Bitstream’s website. This finding by no means ends the summary judgment analysis. In fact, despite this very finding, the Astra Pharmaceutical Court affirmed the district court’s grant of summary judgment to the defendant under the eight-factor confusion analysis. See id. at 1203.

b. Similarity of Bookman's Services and Bitstream's Web- Based Application Program

According to Bitstream's expert, Sampo Kaasila, Bitstream sells a wireless web browser, which is an application program that provides the user a way to view and interact with information on the World Wide Web through a wireless connection on a small handheld device. See Bitstream's Statement of Material Facts, Ex. 1, Expert Report of Sampo Kaasila at 1-2. Meanwhile, Bookman provides technical training, web hosting services (i.e., providing individuals and companies the ability to publish websites), and a link to a third-party that offers domain name registration services -- "services completely different from Bitstream's wireless web browser product." Id. at 3. Moreover, Bookman does not sell a wireless web browser. See id.

Not surprisingly, Bookman's rebuttal expert, Raymond Janisch ("Janisch"), defines Bitstream's products and services in association with the mark "ThunderHawk" more broadly, to include font packages, custom fonts, custom programming and formatting, and custom content presentation.<sup>9</sup> See Bitstream's Statement of Material Facts, Ex. 9, Rebuttal Expert Report of Raymond B. Janisch at 3. He concludes that Bitstream's services and

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<sup>9</sup> These services essentially comprise the function of the software product, which enables users of wireless handheld devices to view standard Internet sites.

products, "although not identical, are certainly related to the services and products offered by Charles Bookman." Id.

The approach of Bookman's rebuttal expert is not persuasive. As Bitstream notes, the most favorable inference that can be drawn regarding the similarity of its product and Bookman's services based on Janisch's report is that they are both related to the Internet, which is hardly a significant similarity in the current world. See Bitstream's Mem. at 11. It is not sufficient to say -- as Bookman does -- that, through its web browser program, Bitstream also essentially provides hosting and infrastructure design for its web-based application programs. See Pl.'s Mem. at 11. Perhaps Bitstream does provide a web hosting function in the literal sense that, due to its web browser program, web content providers need not reconfigure their content in order for wireless users to see their sites. See Bitstream's Statement of Material Facts, Ex. A at 2. And by enabling providers to display full web pages on small color screens through font technology, Bitstream's product may, in the broadest sense, provide an infrastructure design service. See id. at 3. However, breaking down Bitstream's wireless web browser product into its component functions, even if they are similar to processes that Bookman employs in providing his services, distorts a fundamental distinction that consumers are

likely to perceive: Bitstream sells a software product, while Bookman provides personalized computer consulting services.

The First Circuit has explicitly held that involvement in the same industry -- here, Internet-related -- is inadequate to constitute the provision of similar goods and services. In Astra Pharmaceutical, where the plaintiff sold mainly anesthetics, cardiovascular medicines, and pre-filled syringes, and the defendant sold a blood analyzer instrument, the First Circuit concluded that the "most favorable inference that may be drawn . . . is that both parties' products are used in the medical or health care field . . . [, but] such a broad inference is not sufficient to demonstrate that a genuine issue exists concerning the likelihood of confusion as to the source of the products . . . ." Astra Pharmaceutical, 718 F.2d at 1205-1206.

Arguably, due to a number of distinguishing factors, including the nature of the relevant consumers and industries, the products at issue in Astra Pharmaceutical may be somewhat more distinct than the product and services at bar. However, these circumstances still fail to meet the First Circuit's high threshold for comparing goods and services in trademark cases. Consider, for instance, Pignons, where the Court distinguished the goods offered by two different single lens reflex camera manufacturers because one sold low-priced "instant" cameras, while the other sold high-priced traditional cameras with a

different look. See Pignons, 657 F.2d at 487-488. When examined under this exacting approach, even in a light most favorable to Bookman, the similarity between his services and Bitstream's web browser product evaporates.

**c. Channels of Trade, Methods of Advertising, Classes of Prospective Purchasers**

Channels of trade, methods of advertising, and classes of prospective purchasers are typically considered together by the First Circuit because they tend to be interrelated. See Astra Pharmaceutical, 718 F.2d at 1206; Pignons, 657 F.2d at 488-489; Beacon Mut. Ins. Co. v. OneBeacon Ins. Group, 376 F.3d 8, 19 (1st Cir. 2004). First, Bookman's and Bitstream's channels of trade are substantially different, despite the fact that they both advertise on the Internet. Bitstream's customers can download its wireless web browser product over the Internet or receive a shipment of the software. In contrast, Bookman's customers must have substantial interaction with him in order to receive custom-tailored services. See Bitstream's Mem. at 13. In fact, Bookman admittedly keeps descriptions on his website to a minimum so that customers will call him and give him the opportunity to discuss his services. See Bitstream's Statement of Material Facts, Ex. 3, Bookman Dep. Tr. at 92:11-16. Accordingly, I conclude that the parties' channels of trade are substantially different, just as I found in The Alta Vista Corp., Ltd. v. Digital Equipment Corp., 44 F. Supp. 2d 72, 78 (D. Mass. 1998), where the plaintiff

conducted "a labor-intensive, personal form of business," while the defendant was "a mass marketer of products and impersonal services."

Second, while both Bookman and Bitstream obtain clients from their Internet sites, their overall advertising schemes are quite distinct. Bookman also claims to advertise by handing out business cards at networking events throughout the country, and through an arm tattoo that prominently displays the eye logo associated with "THUNDERHAWK." See Bitstream's Statement of Material Facts ¶¶ 45, 46, 57; Bookman's Statement of Disputed Material Facts ¶¶ 45, 46, 57. He has testified that his total annual advertising, marketing and/or promotional expenditures are \$7,000 per year, including \$4,200 in operating expenses. See id. ¶¶ 48, 49.

Given Bitstream's significantly larger size, it promotes its wireless web browser much more extensively, in the following ways: 1) issuing press releases, which are displayed on its website and published online through the Business Wire service; 2) printing brochures describing the product; 3) advertising in numerous industry journals, such as Mass High Tech, Laptop Magazine, and Pocket PC Magazine; 4) conducting a free t-shirt campaign administered through its website; 5) publicizing through industry news sources; 6) attending conferences to promote the product; and 7) using its website to update users regarding

features of, and enhancements to, the product. Bitstream spends over \$100,000 annually to advertise and promote its wireless web browser product.

Thus, though both parties advertise through their websites and by attending conferences, Bitstream invokes a much more expansive and expensive advertising scheme. This brings me to the final factor of the triad -- class of prospective purchasers. By virtue of its size alone, Bitstream reaches a broader, and thereby different, clientele. This distinction, in and of itself, might not be enough to grant summary judgment in a reverse confusion case where the products or services are similar under the law, because the very point of reverse confusion is that the smaller business's reputation is likely to be engulfed by the larger enterprise's widespread advertising efforts. However, in the case at bar, Bitstream targets not only a broader customer base, but also one with entirely different needs (i.e., web browsing rather than web hosting needs).

Indeed, both parties do business with relatively sophisticated clients, who can be expected to know the difference between an Internet consulting service and a web browser software product. See Astra Pharmaceutical, 718 F.2d at 1206 (citing the sophistication of hospital chemistry lab staff and pharmacy staff as the primary reason confusion was unlikely to exist); see also Pignons, 657 F.2d at 489 ("Those most likely to buy an expensive,

sophisticated camera in a specialty camera store are also least likely to be confused by any similarities in Polaroid's and Pignons' marks." ).<sup>10</sup>

Bookman counters that the relatively modest cost of Bitstream's product suggests that a purchaser may not employ the kind of careful consideration necessary in selecting a much more expensive product, like the blood analyzer instrument described in Astra Pharmaceutical.<sup>11</sup> In addition, Bookman's and Bitstream's customers conceivably run the gamut of sophistication -- from individuals seeking to set up a web page for fun to companies engaging in more serious endeavors, and from individuals who are not technologically savvy in general but want to browse the web on a wireless connection to web content providers with larger pursuits. Granted, seven years ago, in Alta Vista, when the Internet was still a novelty, it was easier than it is today to conclude categorically that Internet users are "sophisticated" clients. See Alta Vista, 44 F. Supp. 2d at 78.

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<sup>10</sup> As noted supra in Part III.B., the First Circuit has emphasized that a finding of trademark infringement hinges on the determination that the public likely would be confused about the source of goods or services due to the defendant's use of a mark identical or similar to the plaintiff's mark. Intuitively speaking, a customer could reasonably assume that the same entity provides Internet consulting services and software products. However, the First Circuit has not taken such an intuitive approach to confusion analysis, otherwise it might have held that the customers in Pignons could reasonably be expected to assume that the same company makes expensive and inexpensive cameras.

<sup>11</sup> Bookman offers his services at a cost of \$149.95 to \$499.95 per month, while Bitstream charges \$49.95 per year or \$5.95 per month.

Nevertheless, even the least sophisticated of customers interested in web browsing on a small handheld device or in establishing their own websites are likely to have enough comfort with technology to make the basic distinction between Internet web hosting services and a software program (particularly in today's more technologically savvy world). Thus, viewed in a light most favorable to Bookman, the parties' channels of trade, methods of advertising, and classes of prospective purchasers are dissimilar for the purposes of likelihood of confusion.

**d. Actual Confusion**

While actual confusion is not necessary to prove likelihood of confusion, the absence of actual confusion creates a strong presumption that there is little likelihood of confusion. See Pignons, 657 F.2d at 490. Over the course of a couple of years during which both parties used the "ThunderHawk" trademark, Bookman cites roughly ten instances of actual confusion experienced by Bitstream's clients. See Pl.'s Mem. at 12; Bitstream's Mem. at 15. Bookman received six misdirected e-mails, allegedly reflecting the authors' confusion -- that they entered his website, saw his mark, and thought that they were on Bitstream's website. See Bitstream's Statement of Material Facts ¶¶ 50-52; Bookman's Statement of Disputed Material Facts ¶¶ 50-52. Additionally, he received five telephone messages (two from the same person) from individuals who thought that they were

contacting Bitstream.<sup>12</sup> See Bitstream's Statement of Material Facts ¶ 53; Bookman's Statement of Disputed Material Facts ¶ 53.

On the basis of this evidence, at least superficially, it is reasonable to infer that customers may actually confuse the parties' businesses. However, a closer look at the nature of the misdirected e-mails under the lens of First Circuit law suggests that these instances hardly further Bookman's cause.

Four of the cited e-mails came from individuals, already Bitstream's customers, seeking assistance with use of the web browser. On April 23, 2002, Ian Strachan, an affiliate of "Microsoft Services Operation, HP Consulting," sought to obtain a registration key that would enable him to run the wireless web browser. See Bitstream's Statement of Material Facts ¶ 50; id. at Ex. 11; Bookman's Statement of Disputed Material Facts ¶ 50. On January 20, 2003, Danny Backeljauw ("Backeljauw") posed questions regarding one of the web browser's toolbar features. See Bitstream's Statement of Material Facts ¶ 51; id. at Ex. 12 (Backeljauw wrote, "The hardware buttons make a clicking sound but the TH screen with the logo stays."); Bookman's Statement of Disputed Material Facts ¶ 51. Allen Brown wrote Bookman on September 2, 2003, seeking advice on improving the web browser's scroll and pan functions on his PocketPC. See Bitstream's

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<sup>12</sup> Since Bookman did not provide information about the substance of these phone messages, it is impossible to draw any specific conclusions on their basis.

Statement of Material Facts, Ex. 13. Lastly, Joseph Laub e-mailed Bookman on September 8, 2003 regarding a software installation problem. See id.

The other two e-mailers were potential customers. On September 6, 2003, Guy de Lussigny indicated that he had just created a new Internet site for the sale of software and wanted to enter a contract to resell Bitstream's software through his site. See id. And, finally, on September 16, 2003, R. Bloomfield inquired about the cost of the wireless web browser. See id. The substance of these e-mails clearly indicates the authors' belief that they had contacted Bitstream, when, in fact, they had written to Bookman.

Nonetheless, these examples do not tip the scale in Bookman's favor for several reasons. First, at best, a mere ten out of Bitstream's 48,000 clients have shown signs of confusion about the source of the web browser product. Perhaps ten instances of confusion would be substantial relative to Bookman's much smaller client base, but these examples are not drawn from his base.

Second, and more importantly, the customers cited by Bookman are confused about the source of a product that Bookman does not even sell. Thus, it is hard to see how such confusion could lead to the kind of harm that trademark law is designed to prevent. The Court in Astra Pharmaceutical dismissed evidence that two

purchasing directors at separate hospitals and several lab technicians had mistakenly associated Astra salesmen with the Beckman analyzer because "there [wa]s no evidence that any temporary confusion . . . had any effect whatever on the ultimate decision of a purchaser whether to buy a particular product." Astra Pharmaceutical, 718 F.2d at 1207. Likewise, here, most of the misdirected e-mails came from individuals who had already purchased the wireless web browser from Bitstream. The remaining e-mails indicated the authors' interest in purchasing or reselling the web browser software, which they could not have accomplished through Bookman under any circumstances, given that he does not sell such a product.

Third, while, admittedly, trademark law is concerned with more than just product sales, Bookman's evidence of actual confusion does not reflect these other concerns either. In EMC v. Hewlett Packard Co., 59 F. Supp. 2d 147 (D. Mass. 1999), Judge Tauro concluded that the First Circuit has not expressly rejected an "initial interest" claim -- the notion that infringement can be based on confusion that creates initial customer interest, even if no actual sale is completed as a result of that confusion. EMC, 59 F. Supp. at 150; see also Big Top USA, Inc. v. Wittern Group, 998 F. Supp. 30, 52 (D. Mass. 1998) ("[T]he Lanham Act 'forbids a competitor from luring potential customers from a producer by initially passing off its goods as those of

the producer's, even if confusion as to the source of the goods is dispelled by the time any sales are consummated.'" (citing Dorr-Oliver, Inc. v. Fluid-Quip, Inc., 94 F.3d 376, 382 (7th Cir. 1996)). It is equally hard to imagine Bookman coming up with evidence of actual initial interest confusion, given that customers in search of a web browser software would not otherwise be at his doorstep in the first place.<sup>13</sup>

Furthermore, in Beacon Mutual Insurance Co. v. OneBeacon Insurance Group, 376 F.3d 8 (1st Cir. 2004), the First Circuit held that "actual confusion is commercially relevant," not only if it diverts plaintiff's sales, but also if it inflicts injury in the form of "damage to goodwill, or loss of control over reputation.'" Beacon, 376 F.3d at 7 (quoting The Sports Authority, Inc. v. Prime Hospitality Corp., 89 F.3d 955, 963 (2d Cir. 1996)). Accordingly, Bookman argues the following: 1) the misdirected e-mails reflect customers' troubles with Bitstream's web browser product; 2) these troubles have tainted Bitstream's reputation; and 3) due to Bitstream's widespread use of the mark

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<sup>13</sup> Under the traditional infringement model, an initial interest claim obviously would not work to Bookman's advantage because the underlying idea is that the "junior user [gains] credibility during the early stages of a transaction and can possibly bar the senior user from consideration by the consumer once the confusion is dissipated." Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188, 204 (5<sup>th</sup> Cir. 1998). Meanwhile, Bookman's mark is rather weak, as discussed infra Part III.B.3.f., and he does not sell a wireless web browser. Still to no avail, Bookman argues under the reverse confusion model that Bitstream's stronger, though arguably more junior, mark would lead customers initially to think that Bookman's services are provided by Bitstream.

and, thereby, through reverse confusion, Bookman's reputation is also soiled.

This argument falters for two reasons. First, the misdirected e-mails reflect questions that purchasers of a new software product might commonly pose, rather than reputation-soiling product defects. Second, it is unclear that Bitstream's reputation for its software product, even if poor, could negatively impact Bookman's reputation for consulting services in a manner cognizable under trademark law.<sup>14</sup>

**e. Bad Faith**

Evidence of bad faith, while potentially probative of likelihood of confusion, is not required in a trademark infringement case. See Star Financial, 89 F.3d at 11. By the same token, a finding of good faith is not dispositive if likelihood of confusion is otherwise established. See id.

Bitstream claims that it was unaware of Bookman's services and alleged mark when it adopted the "ThunderHawk" name because it first adopted the name before Bookman filed his trademark applications. However, Bookman argues that a jury could

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<sup>14</sup> Compare, for example, Beacon Mutual, 376 F.3d at 17-18, where the Court found that 249 instances of actual confusion between two companies, both workers' compensation insurers, were commercially relevant because they reflected misdirected premium payments, claim forms, medical records, and legal correspondence, all of which impaired the goodwill and reputation for good service of the plaintiff company. In this light, the dissimilarity of Bookman's and Bitstream's goods and services, compounded by the innocuousness of the cited instances of actual confusion, fail to meet the standard for reputational harm established by the First Circuit.

reasonably infer that Bitstream knew about Bookman's use of the mark, at least as early as February 24, 2002, when its Chief Executive Officer registered the domain name "www.thunderhawk.biz" (and then later the name "www.thunderhawk.info"), rather than "www.thunderhawk.com." The idea is that Bitstream must have conducted a commonly used "WhoIs" search at the time of registration, revealing the existence of Bookman's site at www.thunderhawk.com, else it would not have chosen a ".biz" or ".info" domain name instead of a ".com" one.

Out of context, Bookman's argument makes intuitive sense. However, even if Bitstream knew that Bookman was using the mark before adopting it, no bad faith can be inferred because the "products and markets are sufficiently dissimilar to allow both parties to use the mark without confusion."<sup>15</sup> Astra Pharmaceutical, 718 F.2d at 1208 ("Astra's registered mark does not allow it to preempt the whole broad field of health care products, especially as to other goods in that field that are totally dissimilar to its products.").

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<sup>15</sup> The First Circuit has applied circular logic to the intent factor -- if bad intent is present, then confusion is more likely, and if confusion is unlikely, then bad intent is not present. Despite the rationale's pitfalls, it is workable in this context because the other factors in the eight-prong analysis do not indicate a substantial likelihood of confusion. If the other factors were relatively indeterminate, then a free-standing analysis of bad intent would have to be employed to tip the scale in the appropriate direction.

**f. Strength of Bookman's Mark**

In traditional confusion cases, "[u]nder the Lanham Act strong marks enjoy the greatest protection against infringement." International Ass'n of Machinists and Aerospace Workers, AFL-CIO v. Winship Green Nursing Center, 103 F.3d 196, 206 (1st Cir. 1996) (citation omitted). Though Bookman's mark appears weak relative to the First Circuit's standard for trademark strength, this does not determine his case under a reverse confusion rubric.

Although there is no consistent measure of trademark strength, five relevant factors can be gleaned from the case law: 1) registration of the mark; 2) longtime use of the mark; 3) wide promotion of the mark; 4) the mark's renown in the relevant field; and 5) the mark's distinctive or strong "secondary meaning." See Alta Vista, 44 F. Supp. 2d at 79 (citations omitted). The following categories of marks are listed in order, from least to most deserving of protection, according to their distinctiveness: 1) generic, 2) descriptive, 3) suggestive, and 4) arbitrary and fanciful. See id. (citation omitted).

Bookman argues that a jury could reasonably find that his mark is strong and therefore deserving of protection because it is registered on the federal and state levels, it has been in use longer than Bitstream's use of an identical mark, it is reasonably widely promoted through the Internet, and it is

arbitrary and fanciful relative to his services. This does not seem the appropriate outcome under First Circuit law given that, at best, Bookman spends only \$7,000 per year on advertising and his client-base is relatively small. See, e.g., Star Financial, 89 F.3d at 11 (the plaintiff's mark had been in use in the relevant market area for over two years at the time of trial and STAR had expended several thousand dollars a month in advertising, yet STAR admitted at oral argument that its mark was not very strong); Pignons, 657 F.2d at 491 (the First Circuit found Pignons' mark to be "relatively strong" because it had been in use for over thirty years and the record indicated that the plaintiff was a leader in its industry).

Nevertheless, the weakness of Bookman's mark is not a decisive factor here. First, "the strength of the mark is but one of eight factors to be considered in analyzing the likelihood of confusion issue," and sufficient evidence of other factors would sustain a grant of summary judgment, even if Bookman's mark were considered strong. Star Financial, 89 F.3d at 11 (quoting Equine Technologies, Inc. v. Equitechnology, Inc., 68 F.3d 542, 546 (1st Cir. 1995)); see also Astra Pharmaceutical, 718 F.2d at 1209 (despite the strength of its mark, Astra lost its trademark infringement claim on summary judgment in view of the dissimilarity of the goods, the diverse channels of trade, the

differences in the markets, and the sophistication of the purchasers).

Second, while the strength of the plaintiff's mark is important under a traditional confusion framework, the relative weakness of Bookman's mark actually bolsters his reverse confusion claim. In particular, it supports the notion that he is susceptible to losing control over his reputation in the face of Bitstream's fervent advertising efforts. See Alta Vista, 44 F. Supp. 2d at 80 ("The more widely renowned a junior user's mark is, the more likely it is to do whatever harm it might do to the senior user.").

Nonetheless, Bookman's potential vulnerability to trademark infringement of the reverse confusion variety is insignificant given the low likelihood of reverse confusion (i.e., the substantial differences between Bookman's services and Bitstream's product, their channels of trade, methods of advertising, and types of prospective customers, and the lack of evidence of meaningful actual confusion).

**C. Damages Claims**

Cases under the Lanham Act show a distinction between establishing a right to injunctive relief and establishing a right to damages. The First Circuit has held that while a showing that a defendant's activities are likely to cause confusion is enough for injunctive relief, a plaintiff must show

one of the following to recover damages: 1) actual harm, such as the diversion of sales to the defendant; 2) that the products directly compete, such that defendant's profits would have gone to plaintiff if there was no violation; 3) that the defendant acted fraudulently or palmed off inferior goods, such that actual harm is presumed (and the general rule of direct competition is loosened); or 4) where defendant's inequitable conduct warrants bypassing the usual rule of actual harm, that damages may be assessed on an unjust enrichment or deterrence theory. See Aktiebolaget Electrolux v. Armatron Intern, Inc., 999 F.2d 1 (1st Cir. 1993).

Since I find that there is not a substantial likelihood of confusion between Bookman's services and Bitstream's product, Bookman's claim for damages is automatically disposed of as well. There can be no claim for harm as a result of confusion that has not been found to exist, particularly given the higher standard for damages.

#### **IV. CONCLUSION**

For the reasons discussed above, I find as a matter of law that there is no substantial likelihood of confusion between Bookman's technology consulting services and Bitstream's web

browser product. Accordingly, I **GRANT** both of Bitstream's motions for summary judgment [docket entries ## 62, 66].

**SO ORDERED.**

**Date: March 31, 2005**

**/s/NANCY GERTNER, U.S.D.J.**