

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLORADO**

Civil Action No. 1:09-CV-00636-REB-KLM

**VIDEO PROFESSOR, INC.**  
Plaintiff,

v.

**AMAZON.COM, INC.**  
Defendant.

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**DEFENDANT'S RESPONSE TO PLAINTIFF'S CROSS-MOTION  
FOR SUMMARY JUDGMENT [Docket No. 45, filed December 4, 2009]**

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Defendant Amazon.com, Inc. ("Amazon"), respectfully submits this Response to the Cross-Motion for Summary Judgment of Plaintiff Video Professor, Inc. ("VPI"). Amazon certifies that it has read and complied with this Court's Practice Standards governing the formatting and marshalling of this Response, and states as follows:

**INTRODUCTION**

VPI's Cross-Motion for Summary Judgment ("Cross-Motion") is baseless. As Amazon explained in its motion for summary judgment, there is no genuine issue of material fact that Amazon's use of the VIDEO PROFESSOR mark was authorized by VPI pursuant to the plain language of the parties' vendor agreement. Because lack of authorization is an essential element of VPI's claims—all of which stem from Amazon's use of the VIDEO PROFESSOR mark—this disposes of VPI's claims and therefore this cross-motion.

VPI's likelihood of confusion argument, which the Court need not even reach, does little more than pound the table and rehash VPI's facile assertions from its

response to Amazon's own Motion. If the Court were to reach the issue of likelihood of confusion, Amazon would be entitled to summary judgment of no infringement based on its nominative fair use of the VPI mark. Even if the Court disagreed, VPI would not be entitled to summary judgment because VPI has failed to meet its burden of proving that no reasonable trier of fact could find for Amazon on this issue.

### **STATEMENT OF DISPUTED MATERIAL FACTS**

Regarding VPI's claims for trademark infringement under the Lanham Act (Sections 32 and 43(a)) and VPI's claim for violation of the Colorado Consumer Protection Act ("CCPA"), for which VPI seeks summary judgment, there is no genuine issue of material fact, but it is Amazon that is entitled to judgment as a matter of law dismissing these claims. See Defendant's Motion for Summary Judgment and Memorandum in Support Thereof (Dkt. No. 30) ("Amazon's Motion"). VPI's Statement of Undisputed Material Facts includes a number of allegations that are not material to VPI's motion. Nonetheless, Amazon disputes VPI's allegations as follows:<sup>1</sup>

**Allegation No. 6:** There is no dispute that Amazon bid on "video professor" as a keyword to generate sponsored links in Internet search engines to direct consumers to Amazon's website. However, Amazon disputes VPI's argumentative characterization that Amazon used VPI's trademark to "divert" computer users "away from VPI's Web site." VPI fails to meet its burden of producing substantial evidence to support this allegation. In particular, VPI has offered no evidence that consumers who type "video professor" in an Internet search engine are necessarily seeking VPI's website.

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<sup>1</sup> To the extent Amazon does not dispute VPI's factual allegations contained in its Cross-Motion, Amazon admits such allegations only for purposes of VPI's Cross-Motion.

**Allegation No. 7:** There is no dispute that, between December 2003 and April 2009, there were 6,188 hits or click-throughs to amazon.com originating from Amazon sponsored links displayed in response to Amazon's bid on the keyword "video professor" through any search engine, not just Google. See Ex. 9 (Supp. Response to Interrog. No. 10). There is no evidence to support VPI's allegation that these click-throughs came solely from Google.

**Allegation No. 11:** For purposes of this Cross- Motion, Amazon does not dispute that the manufacturer of "Professor Teaches" products, Individual Software, Inc. ("ISI"), is an Amazon vendor and Amazon, among other resellers, sells ISI's Professor Teaches products to consumers on amazon.com. This is explicitly disclosed on the amazon.com website pages displaying Professor Teaches products. See Ex. A-4. However, Amazon disputes VPI's argumentative characterization that because Amazon buys Professor Teaches products from the manufacturer and resells them, "therefore, they are Amazon's products."

**Allegation No. 12:** For purposes of this Cross- Motion, Amazon does not dispute that Exhibit B to the Complaint is a print-out of an amazon.com landing page. Amazon disputes VPI's argumentative characterization of that landing page. See Defendant's Reply to Plaintiff's Response to Defendant's Motion for Summary Judgment (Dkt. No. 44) ("Amazon's Reply") at 6-7.

**Allegation No. 14:** Amazon disputes VPI's allegation that consumers expect search results to be ordered in a particular manner. VPI has failed to meet its burden of presenting substantial evidence to support its allegation that "consumers expect to see search results in a natural order of relevance, with exact word matches first, and then in

descending order of relevance.” To the extent VPI is suggesting that confusion occurs when search results are ordered differently than consumers expect, this is a legal conclusion that has been rejected. See, e.g., *Designer Skin, L.L.C. v. S & L Vitamins, Inc.*, 560 F. Supp. 2d 811, 819 (D. Ariz. 2008).

**Allegation No. 15:** VPI has no evidence to support its accusations that Amazon manipulates search results so that Professor Teaches products always appear before VPI products. VPI has failed to produce any evidence to contradict Mr. Herrmann’s testimony that “Amazon’s search function helps provide consumers with relevant results” and that “[t]hese results often will include not only products in which the consumer has expressed interest, but also related products that may appeal to the consumer.” See Amazon’s Motion, Herrmann Decl. ¶ 3. Further, the sample landing page attached to Mr. Herrmann’s declaration as Exhibit A-2, which shows a Video Professor product listed first in a search result for “video professor,” contradicts VPI’s unsupported claim.

**Allegation No. 17:** Amazon disputes the implication that Professor Teaches products always appear first when Internet users search on amazon.com for “video professor.” They do not. See Ex. A-2.

**Allegation No. 18:** VPI fails to cite evidence to support its claim that “[e]ach year, hundreds of individuals who have purchased ‘Professor Teaches’ products . . . attempt to return the products by mailing them to VPI believing that they are VPI’s products.”

#### **STANDARD FOR SUMMARY JUDGMENT**

Summary judgment is appropriate if “there is no genuine issue as to any material fact and . . . the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P.

56(c). When the moving party bears the burden of proof at trial, as VPI does here, that party must produce evidence in support of *each and every* element of its claim. Further, in cases such as this one, where the parties have filed cross motions, courts “must rule on each party’s motion on an individual and separate basis, determining, for each side, whether a judgment may be entered in accordance with the Rule 56 standard.” 10A Wright & Miller, *Federal Practice & Procedure* § 2720 (3d ed. 2009); *see also Buell Cabinet Co., Inc. v. Sudduth*, 608 F.2d 431, 433 (10th Cir. 1979).

### **ARGUMENT**

VPI is not entitled to summary judgment on either its Lanham Act claims or its CCPA claim, which is based on the same factual predicate. VPI’s motion necessarily fails because, as argued in Amazon’s Motion, there is no genuine issue of material fact that Amazon’s use of the VIDEO PROFESSOR mark was authorized per the parties’ vendor agreement. Because VPI cannot establish the essential element of unauthorized use, Amazon is entitled to summary judgment.

Even if the Court were to hold otherwise, VPI has failed to show there is no genuine issue of fact that Amazon’s use was unauthorized. In fact, VPI has stated that there are genuine issue of material fact on the authorization issue. See Plaintiff’s Response in Opposition to Defendant’s Motion for Summary Judgment (Dkt. No. 39) (“VPI’s Response”) at 7–8. Because VPI’s claims all stem from Amazon’s use of the VIDEO PROFESSOR mark, this is dispositive of VPI’s Cross-Motion and it should be denied. The Court thus does not need to reach the issue of likelihood of confusion.

If the Court were to reach the issue of likelihood of confusion, Amazon would still be entitled to summary judgment dismissing VPI’s claims. As more fully explained in

Amazon's Motion, there cannot be a likelihood of confusion because Amazon did nothing in connection with its nominative use of VIDEO PROFESSOR to suggest that VPI had sponsored or endorsed any of the products presented to a user who searched for "video professor" and clicked on one of Amazon's sponsored advertisements. If the Court were to determine otherwise, VPI still would not be entitled to summary judgment because VPI has failed to meet its burden of showing that no reasonable trier of fact could find for Amazon on likelihood of confusion.

**I. VPI Is Not Entitled to Summary Judgment on Its Lanham Act Claims.**

**A. Burden of Proof:** The parties agree that VPI has the burden of proof.

**B. Elements:** Under *both* 15 U.S.C. § 1114(1)(a) (registered marks) and 15 U.S.C. § 1125(a) (unregistered marks), VPI must prove that Amazon used VPI's VIDEO PROFESSOR mark without authorization. *See, e.g., Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 22 F.3d 1527, 1529 (10th Cir. 1994). Otherwise, Amazon agrees with VPI's articulation of the elements for the Lanham Act claims.

**C. Material Disputed Facts:** *See* Statement of Material Disputed Facts, *supra*.

**D. VPI Has Failed to Meet its Burden to Show that There is No Genuine Issue of Material Fact and That Amazon's Use of VIDEO PROFESSOR Was Unauthorized.**

VPI acknowledges that its Lanham Act claims fail if Amazon had authorization to use its trademarks. Regarding the essential elements of its Lanham Act claims, VPI states, "the only elements of the Lanham Act claims in dispute are whether: (1) Amazon's use was unauthorized; (2) whether likelihood of confusion exists; and (3) whether VPI suffered injury." Cross-Motion at 6 (emphasis added). Lack of

authorization is a necessary element of VPI's claims because all of VPI's claims stem from Amazon's use of the VIDEO PROFESSOR mark to trigger sponsored advertising that leads consumers to the allegedly offending landing pages on amazon.com.<sup>2</sup>

Thus, to prevail on its Cross-Motion, VPI must initially show there is no genuine issue of material fact that Amazon's use of VIDEO PROFESSOR was unauthorized. VPI has failed to meet this threshold burden. As set forth in Amazon's Motion, when VPI became an Amazon vendor in 2003, it signed Amazon's Vendor Manual and granted Amazon a "perpetual, royalty-free license" to "use all trademarks and trade names included in the Product Information." See Amazon's Motion at 7–8; Ex. A-6 (section 4). This license undisputedly survived the termination of the agreement. *Id.* Ex. A-6 (section 19) ("The provisions of these Resale Terms and Conditions will survive the termination of any or all of this Vendor Manual.").

There is no genuine issue of material fact as to the language in the Vendor Manual. The plain and unambiguous language of the Vendor Manual authorizes Amazon to use the VIDEO PROFESSOR mark without restriction. VPI acknowledges that it granted Amazon a license to use VPI's trademarks to advertise and sell VPI's products. VPI's Response at 6. Nothing in the Vendor Manual limits the manner of Amazon's use of the VIDEO PROFESSOR mark in advertising such products. In particular, nothing in the Vendor Manual prohibits Amazon from using the VIDEO

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<sup>2</sup> As VPI characterized its Lanham Act claims to the Court in response to Amazon's Motion: "Amazon's use of VPI's marks caused initial interest confusion, as well as subsequent actual direct confusion." VPI's Response at 6 (emphasis added). Likewise, this is how VPI described its claims in the Scheduling Order: "VPI's claims arise out of Amazon.com, Inc.'s . . . conduct in purchasing from Google, Inc., and other search engine operators, VPI's trademarked name 'Video Professor.'" Scheduling Order (Dkt. No. 20) at 2 (emphasis added). Finally, the basis for VPI's claims is verified by its damages theory: VPI seeks lost

PROFESSOR mark in sponsored advertising to bring consumers to amazon.com, where they can see the amazon.com website's natural search results for "video professor," which include Video Professor products among other products. This authorization entitles Amazon to judgment as a matter of law on VPI's claims. Amazon Motion at 6-8; Amazon's Reply at 1-4.

VPI's argument that the license so interpreted is unenforceable is baseless. As set forth in Amazon's Motion, Amazon's use of the VIDEO PROFESSOR mark is not an infringement of the mark. But even if this use were assumed to be an infringement, the license would protect Amazon from any such claim. VPI cites no authority whatsoever for the proposition that a license granting a licensee permission to use a mark which may otherwise be an infringement is unenforceable as against public policy or a violation of the implied covenant of good faith and fair dealing. There is no such authority because this assertion contradicts the entire concept of a license: "By definition, a party who holds a valid license to use a trademark and is not in breach of the license, cannot be an infringer of the licensed mark." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 18.40 at 18-83 (4th ed. 2009) (emphasis added); *accord Segal v. Geisha NYC LLC*, 517 F.3d 501 (7th Cir. 2008) ("[W]here the trademark holder has authorized another to use its mark, there can be no likelihood of confusion and no violation of the Lanham act if the alleged infringer uses the mark as authorized.").<sup>3</sup>

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profits "due to Amazon's improper diversion of potential VPI customers" through its use of "video professor" in its keyword advertising. Cross-Motion at 14.

<sup>3</sup> VPI's position on this issue is not even credible given its own failure to challenge Amazon's use of "video professor" to trigger sponsored advertising until after its termination of the Vendor Manual in 2008, nearly



In addition, VPI cannot be entitled to summary judgment on the issue of authorization because, by its own admission, it has failed to meet its burden. In responding to Amazon's Motion on the issue of authorization, incorporated by reference in VPI's Cross-Motion, see Cross-Motion at 6, VPI stated that "[w]hether Amazon is authorized to use VPI's trademarks to sell Amazon's products in direct competition with VPI" is a disputed issue of material fact." See VPI's Response at 2 (Statement of Disputed Material Facts No. 1). VPI continued: "a genuine issue of material fact exists regarding the intentions of the parties, the scope of the license and Amazon's actions, thereby precluding summary judgment." VPI's Response at 7–8.

As explained in Amazon's Reply, this argument has no merit. Amazon's Reply at 2–3. Whether the language of a contract is plain is a question of law, *Syrovoy v. Alpine Res., Inc.*, 841 P.2d 1279, 1281 (Wash. Ct. App. 1992), and once found unambiguous, it is not proper to consider parol evidence regarding the parties' intent. *Universal/Land Const. Co. v. City of Spokane*, 745 P.2d 53, 55 (Wash. Ct. App. 1987). Regardless, given VPI's position that there is a genuine issue of fact on the question of authorization, as presented in its response to Amazon's Motion, VPI cannot, by its own admission, meet its burden to show there is no genuine issue of fact that Amazon's use of the VIDEO PROFESSOR mark is unauthorized.

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five years after Amazon's use of the mark for sponsored advertising began. See Amended Undisputed Facts (Dkt. No. 24) ¶ 1; Herrmann Decl. ¶ 7.

**E. The Nominative Fair Use Doctrine Protects Amazon from Liability Because Amazon Has Done Nothing in Connection With its Use of VIDEO PROFESSOR in Keyword Advertising to Indicate that VPI Sponsors or Endorses Any Products Presented to a Consumer Who Clicked on a Sponsored Link.**

Whether or not Amazon had permission to use VPI's trademark, Amazon's use of the VIDEO PROFESSOR mark in connection with keyword advertising is not infringing because it is a protected nominative fair use of the mark. As discussed in Amazon's Motion, Amazon is entitled to summary judgment dismissing VPI's claims because there is no genuine issue of material fact that Amazon has done nothing in connection with its use of VIDEO PROFESSOR to indicate that VPI sponsors or otherwise endorses any products presented to a consumer who clicked on an Amazon sponsored link, whether they be Video Professor products, Professor Teaches products, or any other products. To the extent the Court disagrees, VPI has failed to meet its burden of establishing that there is no genuine issue of fact that confusion is likely.

**1. The nominative fair use doctrine is widely accepted and has been applied by this Court.**

VPI is just wrong that the nominative fair use doctrine has been adopted only in the Ninth Circuit and is "disfavored" elsewhere. See Cross-Motion at 15, 17. Although different jurisdictions have adopted different formulations of the doctrine, it is widely accepted, including in the District of Colorado. See *Health Grades, Inc. v. Robert Woods Johnson Univ. Hosp., Inc.*, 634 F. Supp. 2d 1226 (D. Col. 2009); *Frontrange Solutions USA v. Newroad Software, Inc.*, 505 F. Supp. 2d 821 (D. Col. 2007); 4 McCarthy, *supra* § 23:11 at 23-70 & n.24 (noting that the First, Second, Third, Fifth, and Eleventh Circuits have all "reached results consistent with those in the Ninth Circuit

without using a separate ‘nominative fair use’ test”). Among the uses protected by the doctrine is the use of a trademark by a reseller to advertise that it sells the trademark product, so long as the reseller does not indicate that its sales are sponsored or authorized by the trademark owner. See, e.g., *Trail Chevrolet, Inc. v. General Motors Corp.*, 381 F.2d 353, 354 (5th Cir. 1967) (owners of used car dealer “should be free to advertise that they sell used Chevrolets, that they repair Chevrolet cars, that they have a number of Chevrolets to choose from, or that they sell used Chevrolets and other fine cars or the like”).

VPI’s baseless attack on the concept of nominative fair use is all the more surprising because VPI is an undisputed beneficiary of it. VPI liberally uses the trademarks of other companies without authorization in a nominative way to identify that VPI’s products are designed to help consumers learn how to use other companies’ trademarked software. See Amazon’s Motion at 9. In doing so, VPI cannot at the same time argue that Amazon is liable for using VPI’s marks in a nominative way to identify the products offered for sale on amazon.com. To do so would constitute unclean hands depriving VPI of a remedy against Amazon. See *Procter & Gamble Co. v Ultreo, Inc.*, 574 F. Supp. 2d 339, 356 (S.D.N.Y. 2008) (having availed itself of making advertising claims based on laboratory studies “at a time when it was in P&G’s commercial interests to do so, P&G may not now claim to be irreparably harmed when a new market entrant takes the same position it once did”).

**2. *Australian Gold* did not reject the nominative fair use doctrine.**

VPI is wrong that the Tenth Circuit “necessarily rejected by implication” the nominative fair use doctrine in *Australian Gold, Inc. v. Hatfield*, 436 F.3d 1228 (10th Cir.

2006). See Cross-Motion at 13. As explained in Amazon’s motion, the defendants in *Australian Gold* did not raise the doctrine of nominative fair use and therefore the court did not consider it. See Amazon’s Motion at 14. The procedural posture of *Australian Gold*, which is critical to understanding its holding, demonstrates that the Tenth Circuit’s decision is not in conflict with nominative fair use. In *Australian Gold*, the Court upheld the district court’s denial of defendant’s motion for judgment as a matter of law after a jury verdict of infringement. The jury had found the defendants, the principals of a terminated distributor, liable for trademark infringement where they “continued to use the trademarks to divert internet traffic to their Web sites even when they were not selling Products.” *Id.* at 1239 (emphasis added). This is the type of “bait and switch” conduct that the initial interest confusion doctrine was designed to address and thus supported the jury verdict of infringement.

Based on the undisputed facts, no bait and switch ever occurred in this case. It is undisputed that at all relevant times, VPI products have been available for sale from resellers on amazon.com. See Am. Undisputed Facts (Dkt. No. 24) ¶ 5; see also Herrmann Decl. ¶ 8. *Australian Gold* cannot be read to hold that a reseller such as Amazon cannot use a product’s trademark in connection with sponsored advertising that directs consumers to a website where the product is—and, for all relevant periods, has been—for sale. The Tenth Circuit did not address that question in *Australian Gold*.

Other authorities have held that where a reseller uses a trademark of a product it sells to trigger sponsored advertising on an Internet search engine, the availability of competing products from the reseller is of no consequence. The presentation of

competing products by itself does nothing to suggest that the trademark owner has sponsored or endorsed the products shown. As the *Designer Skin* court wrote:

S&L Vitamins uses Designer Skin's marks to truthfully inform internet searchers where they can find Designer Skin's products. . . . The fact that these customers will have the opportunity to purchase competing products when they arrive at S&L Vitamins' sites is irrelevant. The customers searching for Designer Skin's products find exactly what they are looking for when they arrive at these sites. S&L Vitamins is not deceiving consumers in any way.

*Designer Skin*, 560 F. Supp. 2d at 819.

Although the *Designer Skin* court believed that this result was “at odds” with the Tenth Circuit’s decision in *Australian Gold*, in fact, it is not. The fact pattern in *Designer Skin* case is materially different from *Australian Gold*. As recognized by the *Designer Skin* court, “there is a meaningful distinction between (1) using a mark to attract potential customers to a website that only offers products of the mark holder’s competitors”—which is what the defendants in *Australian Gold* did when they continued to use the plaintiff’s marks even when they were not selling plaintiff’s products—“and (2) using a mark to attract potential customers to a website that offers the mark holder’s genuine products as well as the products of competitors”—which is what the defendants in *Designer Skin* did. *Id.* at 820.

VPI is also mistaken in relying on *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009), to argue that the undisputed availability of Video Professor products along with competing products is “irrelevant” to the confusion issue. In *Rescuecom*, the Second Circuit acknowledged that “non-deceptive product placement does not result in liability under the Lanham Act . . . because it is a benign practice.” *Id.* at 130 (emphasis added). In reversing the district court’s order granting Google’s motion to dismiss the

case on the pleadings, the Second Circuit merely allowed *Rescuecom* to attempt to prove its case that Google was doing something more deceptive than benign product placement. *Id.*

In this case, however, all that Amazon is doing on its landing page is benign product placement. There is no evidence that Amazon has done anything to deceive consumers into believing that VPI sponsors or endorses any of the products listed on the Amazon landing page. VPI has admitted that it is unaware of any instance in which a consumer who entered “video professor” in a search engine and then clicked on an Amazon advertisement believed that Amazon was a favored or authorized dealer of the VPI products displayed. See Amazon’s Motion, Ex. A-9 (Answer to Req. for Admission No. 2). This is a critical admission that undermines VPI’s entire confusion argument. For if no consumer would believe that Video Professor products presented on Amazon’s landing page were authorized or endorsed by VPI, there is no way that a consumer could believe that products with different names, such as Professor Teaches, were authorized or endorsed by VPI.

**3. VPI’s arguments regarding confusion from Amazon’s sale of Professor Teaches products are immaterial.**

VPI spends much of its own Cross-Motion focusing on alleged confusion stemming from the sale of Professor Teaches products. In doing so, VPI misapplies the confusion analysis to its claims against Amazon. VPI has never contended in this case that Amazon is liable for trademark infringement by offering Professor Teaches products for sale. VPI’s claim in this case is that Amazon is liable for using the VIDEO PROFESSOR mark in connection with sponsored advertising that directs consumers to

an amazon.com webpage where Video Professor products are offered for sale, among other products. The Professor Teaches products enter into this case *only* in the context of VPI's claim that a consumer who clicked on an Amazon sponsored advertisement triggered by the consumer's search for "video professor" might also see a Professor Teaches product on the amazon.com landing page and, because of that, somehow be led to believe that VPI was somehow connected to the Professor Teaches product. See *supra* note 2 and accompanying text.

None of VPI's alleged evidence of actual confusion supports this claim. This putative evidence of actual confusion is wholly immaterial, as VPI failed to show that any consumer who attempted to return a Professor Teaches product to VPI bought that product from Amazon, much less after clicking on an Amazon sponsored advertisement. VPI has failed to identify a single consumer who, after entering "video professor" in an Internet search engine and clicking on an Amazon advertisement, mistakenly believed VPI to be the source or sponsor of any products displayed on the landing page. See Amazon's Motion, Lévy Decl. ¶ 5 & Ex. A-8 (Am. Answer to Int. No. 10).

If VPI intends in its Cross-Motion to argue that Amazon is liable for trademark infringement simply by virtue of its sale of Professor Teaches products, such a claim is not in this case and VPI should not be granted leave to amend at this late date. The deadline for amendments to pleadings has long since passed and Amazon would be severely prejudiced by any such an amendment, which would transform this entire case, expanding the scope of relevant discovery and potentially requiring the joinder of additional parties, including the manufacturer of the Professor Teaches products,

Individual Software, Inc. See Scheduling Order (Dkt. No. 20) at 4 (setting September 1, 2009 deadline for amendments to pleadings).

**4. VPI has failed to show there is no genuine issue of material fact that there is a likelihood of confusion.**

VPI has failed to meet its burden of showing that no reasonable trier of fact could find for Amazon on the issue of likelihood of confusion. VPI's confusion analysis is unsound primarily because it fails to acknowledge that Amazon is using the VIDEO PROFESSOR mark to direct consumers to VPI's own products which undisputedly have been available at amazon.com since 2003. In this context, the typical likelihood of confusion factors of similarity of marks and similarity of goods are not useful. They are not useful because they fail to assist the Court in separating infringing from noninfringing conduct. For example, Amazon has long used the VIDEO PROFESSOR mark on its website to advertise VPI products that are offered for sale. This usage of VPI's mark is not infringing and VPI does not allege to the contrary. See, e.g., *Trail Chevrolet*, 381 F.2d at 354. Yet, if the factors of similarity of the marks and similarity of the goods were rigidly applied without analysis, they would incorrectly support a finding of likelihood of confusion.

This is why, as this Court has already acknowledged in *Frontrange*, the focus of the likelihood of confusion analysis in a case such as this one should be on the additional nominative fair use factors. This approach is fully consistent with the Tenth Circuit's flexible approach to the likelihood of confusion factors. See, e.g., *Univ. Money Ctrs.*, 22 F.3d at 1530 (10th Cir. 1994) ("This list is not exhaustive. All of the factors are interrelated, and no one factor is dispositive."); *Beer Nuts, Inc. v. Clover Club Foods*



Co., 711 F.2d 934, 940 (10th Cir. 1983) (“The facts of a particular case may require consideration of other variables as well”). As discussed in Amazon’s Motion, an analysis of likelihood of confusion in this case focusing on the nominative fair use factors demonstrates that no reasonable trier of fact could find that Amazon’s use of VIDEO PROFESSOR is likely to cause confusion. See Amazon’s Motion at 8–14.

The other likelihood of confusion factors discussed by VPI do not support VPI’s position. Concerning the intent factor, VPI has failed to identify any evidence that Amazon has sought to confuse consumers. For example, VPI has failed to identify any evidence of any nefarious attempt by Amazon to manipulate its natural search results so that Professor Teaches products always appear before VPI’s products. In fact, the evidence before the Court contradicts that assertion. See Ex. A-2.

Similarly, the degree of care factor does not favor VPI. VPI has presented no evidence that consumers of software products on Amazon’s website do not exercise substantial care in making purchases. Amazon’s product pages themselves, which provide a wealth of product information to consumers, including consumer reviews and ratings, belie VPI’s position. See, e.g., Exs. A-2, A-4.

The strength or degree of distinctiveness of the mark factor also does not favor VPI. The VIDEO PROFESSOR mark is descriptive of the video-based learning products on which it is used. As such, the VIDEO PROFESSOR mark is among the weakest of marks. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“Marks which are merely descriptive of a product are not inherently distinctive.”). VPI’s declaration evidence in support of its claim of acquired distinctiveness is only of a general and summary nature lacking any documentary backup. VPI’s Response, Ex. 1.

Finally, the actual confusion factor does not support VPI because, as discussed above, none of VPI's purported evidence of actual confusion is linked to the conduct by Amazon that VPI contends is infringing. *See supra*, at 15.

In sum, none of the likelihood of confusion factors, properly applied to Amazon's use of the VIDEO PROFESSOR mark that VPI claims is infringing, supports VPI's claim that a consumer who searched for "video professor" on Google and clicked on an Amazon ad that took him to a search results page for "video professor" on amazon.com, would believe that any of the products listed there (whether Video Professor, Professor Teaches or any other products) were sponsored, endorsed or otherwise connected to VPI.

**II. VPI Is Not Entitled to Summary Judgment on its CCPA Claim.**

- A. **Burden of Proof:** The parties agree that VPI has the burden of proof.
- B. **Elements:** The parties agree as to the elements VPI must prove.
- C. **Material Disputed Facts:** *See* Statement of Material Disputed Facts, *supra*.
- D. **Amazon is Entitled to Judgment on VPI's CCPA Claim; Even if It's Not, Genuine Issues of Material Fact Preclude Judgment in Favor of VPI.**

VPI essentially abandoned its claim under the CCPA in its response to Amazon's Motion, *see* Amazon's Reply at 10, and its attempt to now obtain summary judgment on that claim is not only half-hearted but also disingenuous. VPI's CCPA claim, like its trademark claims, is based on Amazon's use of "video professor" as a keyword and its sale of Professor Teaches products to consumers who click on sponsored links

generated by that keyword. See Cross-Motion at 18–19.<sup>4</sup> Because the predicate of VPI’s CCPA claim is the same as its trademark infringement claims, VPI’s CCPA claim fails for all the reasons discussed above and in Amazon’s own Motion and Reply in support thereof. See *Harvey Barnett, Inc. v. Shidler*, 338 F.3d 1125, 1135–36 (10th Cir. 2003) (dismissing both claims under Lanham Act and CCPA where plaintiff failed to show likelihood of confusion and failed to present evidence of damages).

In addition, VPI has failed to meet its burden of establishing that there is no genuine issue of material fact as to other essential elements of the CCPA claim, including injury to a legally protected interest, that Amazon’s actions caused that injury and that those actions significantly impact the public. VPI’s interest in web traffic is not a legally protected interest. See *Tiffany, Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 473, 496 (S.D.N.Y. 2008). Similarly, VPI has failed to show no genuine issue of material fact that Amazon caused its alleged injury. VPI’s entire theory of liability is based on the assumption that Internet users who type “video professor” in a search engine are looking for VPI’s website. VPI has produced no evidence to support this assumption, let alone enough evidence to preclude a genuine issue of material fact on this matter. Finally, VPI has failed to show that there is no genuine issue on whether there is a significant public impact. In fact, VPI has failed to produce any evidence of actual confusion stemming from Amazon’s alleged infringing actions. For all of these reasons, VPI is not entitled to summary judgment on its CCPA claim.

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<sup>4</sup> The only new argument VPI raises in connection with its CCPA claim—that Amazon disparaged VPI’s products through its five-star ranking system (Cross-Motion at 19)—is not valid. C.R.S. § 6-1-105(n)(II) does not itself articulate a deceptive trade practice. Rather, a person may commit a deceptive trade

## CONCLUSION

As set forth in its own Motion, and based on construction of the facts in the light most favorable to VPI, it is Amazon—not VPI—that is entitled to judgment as a matter of law in this case. However, to the extent the Court disagrees, VPI would not be entitled to summary judgment for two independent reasons: (1) VPI has failed to sustain its burden of showing that there is no genuine issue of fact that Amazon's use was unauthorized, and (2) VPI has failed to sustain its burden of establishing that no reasonable trier of fact could find for Amazon on the likelihood of confusion issue. VPI's Cross-Motion should be denied in its entirety.

Dated: December 21, 2009

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practice by employing bait and switch advertising if he also disparages the advertised goods. See C.R.S. § 6-1-105(n).

**CERTIFICATE OF SERVICE (CM/ECF)**

I hereby certify that on December 21, 2009, I electronically filed the foregoing **DEFENDANT'S RESPONSE TO PLAINTIFF'S CROSS MOTION FOR SUMMARY JUDGMENT [Docket No. 45, filed December 4, 2009]** with the Clerk of Court using the CM/ECF system which will send notification of such filing to the following persons at the given email addresses:

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/s/ Lori E. True  
Lori E. True