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UNITED STATES DISTRICT COURT  
 DISTRICT OF OREGON  
 PORTLAND DIVISION

**COLLEGENET, INC.,**

No. 3:10-cv-01211-HU

Plaintiff,

v.

Defendant, Google Inc.'s  
**REPLY MEMORANDUM IN SUPPORT  
 OF ITS MOTION TO DISMISS  
 PURSUANT TO FED. R. CIV. P. 12(b)(1),  
 (6)**

**GOOGLE INC.,**

**ORAL ARGUMENT REQUESTED**

Defendant.

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## **Introduction**

As is evident from CollegeNET's Complaint, there is no definite and concrete dispute between the parties. CollegeNET's action for trademark infringement is predicated on a product that CollegeNET does not even allege exists, does not allege was offered for sale, and does not allege was advertised. Aside from alleging the Google has filed an intent-to-use application for the SPEEDBOOK mark, CollegeNET's Complaint fails to identify any other activity Google has undertaken regarding the SPEEDBOOK mark. Thus, the Complaint presents only a hypothetical question based on Google's assumed use of the SPEEDBOOK mark in an undefined way in connection with the sale of undefined computer hardware, at an undefined price point, marketed through undefined channels, using undefined marketing materials. Because these "facts" are too conditional to permit meaningful evaluation and a definitive declaration of rights, no actual case or controversy exists and subject matter jurisdiction is lacking.

In addition, CollegeNET's speculation about Google's use of the SPEEDBOOK mark is wrong—both as to the imminence of any use of the mark and as to the hardware that it might be used with. The Chrome OS tablet computer that is the centerpiece of CollegeNET's speculation, and the subject of the media reports it cites, is not why Google filed its intent-to-use application; Google is not even considering using the SPEEDBOOK mark with the Chrome OS tablet and has never considered using the mark for that purpose. Internet rumors to the contrary based on two isolated and unrelated pieces of information do not change this fact. Nor do they provide any justification for finding a case or controversy or valid cause of action.

Irrespective of whether a case or controversy exists sufficient to establish subject matter jurisdiction, CollegeNET's trademark infringement claims must be dismissed for failure to state a claim because the Complaint does not allege a critical element—that Google has used the

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SPEEDBOOK mark in commerce. Collegenet concedes there is no such allegation, and it fails to cite any precedent holding that use in commerce is not an element of a trademark infringement action.

**Relevant Background Facts**

Collegenet has not alleged that Google:

- advertised a product called “Speedbook,”
- solicited any customers for a product called “Speedbook,”
- shipped, or is ready to ship, units of a product called “Speedbook,”
- has a prototype of a computer hardware product called “Speedbook,”
- printed packaging or labels using the SPEEDBOOK mark, or
- solicited licensees to distribute a product called “Speedbook.”

Instead, Collegenet conclusorily alleged: “On information and belief, Google intends to launch sales of a computing device under the SPEEDBOOK mark on November 26, 2010” and “On information and belief, Google has already taken concrete steps in furtherance of its intention to launch sales of a personal computing device under the SPEEDBOOK mark.” Compl. ¶¶ 26, 27. Collegenet does not identify what alleged “concrete steps” Google has allegedly taken.

Based on media reports about the launch of such a tablet computer running a Chrome Operating System, Collegenet argues that Google will use the SPEEDBOOK mark on the Chrome OS tablet. (See Opp. Br. at 3.) Judging from the timing of the media reports relating to the Chrome OS computer and the intent-to-use application, Collegenet assumes that the two pieces of information must be related. They are not. See Perry Decl. ¶ 4, Ex. C. Google’s intent-to-use application was not filed for the purpose of using SPEEDBOOK in connection with a Chrome Operating System tablet. *Id.* And Google has not—with regard to a Chrome OS tablet

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to any other computer hardware contemplated by Google—offered to sell, advertised, distributed, or sold any products or services in connection with the SPEEDBOOK mark, nor has it entered into any agreements to manufacture, provide, advertise, distribute, offer, or sell any product or service, in whole or in part, in connection with the SPEEDBOOK mark. Rubin Decl. (Dkt. No. 24) ¶¶ 5, 7, 8.

### Argument

#### **I. THERE IS NO CASE OR CONTROVERSY**

CollegeneNET cannot bear its burden of proving that subject matter jurisdiction exists in these facts. *Robinson v. United States*, 586 F.3d 683, 685 (9th Cir. 2009) (“Once challenged, the party asserting subject matter jurisdiction has the burden of proving its existence.”) (citation omitted). For a court to have jurisdiction, the parties’ dispute must be “definite and concrete,” “real and substantial” and “of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007) (citations and quotations omitted). Consistent with Article III of the U.S. Constitution, the court may not issue “an opinion advising what the law would be upon a hypothetical state of facts.” *Id.* CollegeneNET concedes that the *MedImmune* standard controls, but seeks exactly what *MedImmune* prohibits: an opinion advising what the law would be upon a hypothetical set of facts—i.e., if Google makes plans to proceed in a certain way regarding the SPEEDBOOK mark, sets those plans in motion, and is prepared to carry them out, would successful implementation of those hypothetical plans be likely to cause confusion among CollegeneNET’s elite set of customers and potential customers? This is too abstract a question to qualify as anything but one seeking an advisory opinion.



**A. Post-MedImmune Authority Supports That Google's Actions Do Not Justify Finding A Case Or Controversy.**

Judicial decisions following *MedImmune* confirm that more is required to establish a case or controversy than filing an intent-to-use application and undefined “concrete steps” toward use. For example, in *Geisha, LLC v. Tuccillo*, the defendant had filed an intent-to-use application for a stylized “JAPONAIS” mark, had “played around with” ideas for the menu, and had attempted to find a location for the restaurant. 525 F.Supp.2d 1002, 1007 (N.D. Ill. 2007). The court concluded that notwithstanding the defendant’s undisputed intent to use the mark, his intent was too lacking in specificity or immediacy to justify a declaratory judgment. *Id.* at 1015-16.

Similarly, in *Vantage Trailer Corp. v. Beall Corp.*, the Fifth Circuit affirmed the dismissal of a declaratory judgment action even though the potential infringer had “worked with an engineer on product development, beg[un] construction of a new manufacturing facility, purchased specialized equipment, built a sub-frame, and offered to sell its new model trailers.” 567 F.3d 745, 749 (5<sup>th</sup> Cir. 2009). Although the potential infringer unequivocally intended to complete and sell its trailers, the court confirmed that the allegedly infringing use needed to be sufficiently definite at the time the complaint was filed to permit a meaningful evaluation of the likelihood of confusion, and it was not. *Id.* at 750. The Fifth Circuit reasoned that the district court had appropriately relied on a decision that had concluded that no immediate and real controversy existed where “[b]ecause the design was fluid on the date the complaint was filed, it was impossible to determine—on that date—whether any eventual design ... would infringe [the] patents.” *Id.* (quoting *Sierra Applied Sciences, Inc. v. Advanced Energy Industries, Inc.*, 363 F.3d 1361 (Fed. Cir. 2004)).

As in *Geisha*, *Vantage Trailer*, and *Sierra Applied Sciences*, at the time CollegeNET filed its complaint—and today—any use Google may make of SPEEDBOOK in the future is insufficiently defined to present a real and immediate threat or permit a meaningful evaluation of likelihood of confusion. This is true even from the face of the Complaint. Paragraph 26 of the Complaint, alleging upon information and belief that Google would launch a SPEEDBOOK product on Nov. 26, 2010, need not be credited. *See* Court’s October 15, 2010 Order (Dkt. No. 27); *L.H. v. Schwarzenegger*, 645 F.Supp.2d 888, 891 n.1 (E.D. Cal. 2009) (noting it is unnecessary for a court to take judicial notice of its own orders). Nor does Paragraph 27’s conclusory allegation that on “information and belief, Google has already taken concrete steps in furtherance of its intention to launch sales of a personal computing device under the SPEEDBOOK mark,” because it fails to identify what specific concrete steps Google has allegedly taken. *E.g.*, *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9<sup>th</sup> Cir. 2001) (holding the court is not required to accept as true “allegations that are merely conclusory, unwarranted deductions of fact”).

Because Google’s motion to dismiss for lack of sufficient case or controversy is a motion brought under Rule 12(b)(1) of the Federal Rules of Civil Procedure, the Court’s analysis of the sufficiency of the case or controversy allegations “is not confined by the facts contained in the four corners of the complaint—it may consider facts and need *not* assume the truthfulness of the complaint.” *Americopters, LLC v. F.A.A.*, 441 F.3d 726, 732 n.4 (9<sup>th</sup> Cir. 2006); *see also* *Robinson v. United States*, 586 F.3d at 685 (holding “[n]o presumptive truthfulness attaches to plaintiff’s allegations” in a Rule 12(b)(1) motion) (citations omitted); *McCarthy v. United States*, 850 F.2d 558, 560 (9<sup>th</sup> Cir. 1988), Charles Alan Wright & Arthur R. Miller, 5B Federal Practice and Procedure § 1350 (3d ed. 2004). As further demonstrated in the Declarations of Google

Vice President Andy Rubin (Dkt. No. 24), Google has no SPEEDBOOK computer, will not release one this year, and has not engaged in the sort of pre-sale commercial uses of a mark that can justify subject matter jurisdiction. *Id.* at ¶¶ 5,7, 8.

**B. The Authority CollegeNET Relies Upon Supports The Inadequacy Of An Intent-To-Use Application To Establish A Case Or Controversy.**

In its Opposition Brief, CollegeNET discusses two opinions that found “sufficient immediacy” to warrant finding jurisdiction in support of its argument that an actual immediate controversy exists between the parties. (*See* Opp. Br. at 16-17.) Both aligned themselves with pre-*MedImmune* precedent, which one opinion characterized as providing “a useful framework for determining when a dispute is of sufficient ‘immediacy and reality’ to constitute a controversy.” *AARP v. 200 Kelsey Assocs.*, 2009 WL 47499 \*8 (S.D.N.Y. Jan. 8, 2009); *accord Young v. Vannerson*, 612 F. Supp. 2d 829, 843 (S.D. Tex. 2009). As this precedent demonstrates, on one side of the line—the unripe controversies—are cases in which “a party has not yet identified a name or location of a business, has not conducted any sales activity, or has not secured the necessary components for production.” 612 F. Supp. 2d at 843-44; *accord* 2009 WL 47499 \*8. On the other side of the line—where the case or controversy requirement is satisfied—are cases in which the junior user “has taken steps such as producing prototypes or samples of the allegedly infringing products, soliciting business from and sending advertising to potential customers, or otherwise investing significant funds in preparation to produce the products.” 612 F. Supp. 2d at 844; *accord* 2009 WL 47499 \*9.

Consistent with these guideposts, the *Young v. Vannerson* court found a case or controversy where the junior user had allegedly filed an intent-to-use application, expended considerable sums to develop and market the marks, designed and produced decals and T-shirts

using the marks, contracted with a manufacturing company to produce decals and T-shirts with the marks, produced samples of other products incorporating the marks, and tested the market with these samples. 612 F. Supp. 2d at 845-46. Significantly, the *Young* defendants had also threatened to sue the plaintiffs for use of Vince Young's developed (but unregistered) trademarks using his initials and "invincible" slogan. *Id.*; *see also id.* at 837-38, 840. Thus, the *Young* defendants were also, in essence, brick-and-mortar cybersquatters.

Similarly, the *AARP* court found that the disagreement between the parties had "taken on fixed and final shape so that a court can see what legal issues it is deciding, what effect its decision will have on the adversaries, and some useful purposes to be achieved in deciding them." 2009 WL 47499, at \*4 (citation omitted). After the American Association of Retired Persons discontinued using the "Modern Maturity" title on its membership magazine, the defendants filed an intent-to-use application for "Modern Maturity," a "[m]agazine published periodically in the field of mature lifestyles." *Id.* at \*1. When the Trademark Trial and Appeal Board rejected defendants' application, they petitioned to cancel plaintiff's registered mark. *Id.* The defendants also actively sought licensees to publish a magazine called "Modern Maturity" and conducted an extensive analysis of the publishing industry. *Id.* at \*2. Assuming that the defendants had already "made a number of concrete decisions concerning the proposed content, design, and layout," the court concluded that the controversy warranted the issuance of declaratory judgment. *Id.* at \*9.

Unlike the facts in *Young* and *AARP*, CollegeNET has not alleged that Google threatened it with an infringement suit or tried to cancel its trademark registration, and has not alleged that Google produced any allegedly infringing prototypes or sought licensees for the SPEEDBOOK mark. In sum, CollegeNET does not allege any specific actions *Google* took regarding the

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SPEEDBOOK mark in the United States other than filing an intent-to-use application. Therefore, this action squarely fits with the long-standing precedent that an intent-to-use application is not enough to give rise to a case or controversy. *See United Am. Indus., Inc. v. Cumberland Packing Corp.*, No. CV-06-1833-PHX-FJM, 2007 WL 38279, at \*2 (D. Ariz. Jan. 5, 2007); *Rexel, Inc. v. Rexel Int'l Trading Corp.*, 540 F.Supp.2d 1154, 1161 (C.D. Cal. 2008); *Macia v. Microsoft Corp.*, 152 F.Supp.2d 535, 539 (D. Vt. 2001).

**C. An Intent-To-Use Application Does Not Justify Finding A Case Or Controversy.**

The line of authority holding that the mere filing of an intent-to-use application is insufficient to warrant finding a case or controversy is entirely consistent with the practical reality of intent-to-use applications. A valid intent-to-use application requires a declaration of intent to use; it does not require a promise to use a mark, form a contract to use a mark, or obligate the applicant to perfect its application. If the applicant does wish to obtain a registration, it has up to three years after a Notice of Allowance issues to file an affidavit of actual use. *See* 15 U.S.C. §1051(d). Thus, filing an intent-to-use application does not inherently portend immediacy of use. In fact, according to U.S. Patent and Trademark Office statistics, fewer than half of all intent-to-use applications filed since 2007 were perfected and actually registered within even one or two years of the application being filed. *See* Perry Dec. dated Oct. 26, 2010, ¶¶ 2, 3, Exs. A-B (attaching statistics obtained from [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/ann\\_rpt\\_intermed.htm](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/ann_rpt_intermed.htm) and summary regarding same).

As one of the decisions cited by CollegeNET confirms, a “bona fide” intent to use the mark can be contingent on future events, such as market research or product testing. *Commodore Electronics. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d. 1503, 1507 n.7

(T.T.A.B. 1993) (quoting Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988), *reprinted in* United States Trademark Association, The Trademark Law Revision Act of 1988 176-77 (1989)). This is consistent with the fact that applicants can file multiple intent-to-use applications for a single good: the applicant has a bona fide intent to use all of the marks applied for, but events over time help the applicant decide which, if any, of the marks it will create formal plans to use in connection with goods or services. *Id.* Thus, the fact that Google had a bona fide intent to use the mark, but currently has no concrete plans to affix the mark to a particular good is entirely consistent with the TTAB's requirements concerning intent.

**D. ColledgeNET Fails to Distinguish Precedent Holding An Intent-To-Use Application Insufficient To Establish Jurisdiction.**

Given the non-binding and slow-moving nature of intent-to-use applications, federal courts have uniformly recognized that filing an intent-to-use application is not enough standing alone to support jurisdiction. *E.g., Wham-O Inc. v. Manley Toys, Ltd.*, 92 U.S.P.Q.2d 1750, 2009 WL 6361387, at \*4 (C.D. Cal. 2009); *Geisha*, 525 F.Supp.2d 1002; *Cumberland Packing*, 2007 WL 38279; *Rexel*, 540 F.Supp.2d 1154; *Macia*, 152 F.Supp.2d 535. If the law were otherwise, more than 150,000 cases or controversies would potentially be created every year simply from filing intent-to-use applications. *See Perry Decl.* ¶¶ 2, Ex. A.

ColledgeNET argues no reason other than chronology that *MedImmune* would undermine the commonsense, pre-2007 authority on intent-to-use applications. Indeed, the very decisions ColledgeNET relied on recognized the basic principles applied by these cases as still valid after *MedImmune*. *See AARP*, 2009 WL 47499 \*7 (citing standards); *Young*, 612 F. Supp. 2d at 843-44 (same and specifically citing *Cumberland Packing*, 2007 WL 38279). And the *Vantage*

*Trailer Corp. v. Beall Corp.*, 567 F.3d 745 (5<sup>th</sup> Cir. 2009), *Geisha, LLC v. Tuccillo*, 525 F.Supp.2d 1002 (N.D. Ill. 2007), and *Wham-O Inc. v. Manley Toys, Ltd.*, 92 U.S.P.Q.2d 1750, 2009 WL 6361387, at \*4 (C.D. Cal. 2009), opinions with similar holdings are all post-*MedImmune*.

CollegeneNET also invites this Court to ignore established precedent based on opinions by the Ninth Circuit in 2004 and the Second Circuit in 2009 that keyword advertising can constitute an actionable use in commerce under the Lanham Act. (Opp. Br. at 10-11). However, nothing in those opinions suggests that mere expression of intent to use a mark, including by virtue of filing an intent-to-use application, can qualify as an actionable use in commerce. *See Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009); *Playboy Enters., Inc. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9<sup>th</sup> Cir. 2004). Nor do any of the facts of the opinions CollegeneNET strains to distinguish involve keyword advertising or any other use that Second or Ninth Circuit suggested might be an actionable use in commerce. *See Cumberland Packing*, 2007 WL 38279; *Rexel*, 540 F.Supp.2d 1154; *Macia*, 152 F.Supp.2d 535; *see also Geisha*, 525 F.Supp.2d 1002. Thus, neither Circuit opinion nullifies the requirement that the defendant use the mark in commerce or casts doubt on the correctness of the decisions holding that merely filing an intent-to-use application constitutes an actionable use in commerce. *See Rescuecom*, 562 F.3d at 127; *Playboy*, 354 F.3d at 127.

Presumably recognizing that holding the filing of an intent-to-use application sufficient to establish a case or controversy would constitute a departure from established law, CollegeneNET proposes a radical justification—that Google should be subject to a different standard. CollegeneNET argues that the situation here presents a “vastly different scenario” than those in numerous federal decisions holding that an intent-to-use application is not enough because

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“[a]ny trademark application filed by Google is different from those of the average filer.” (Opp. Br. at 20.) Because Google is the subject of intense media attention, CollegenET asserts, it should be held liable not just for what it says and does, but for what unrelated third parties say about it. (Opp. Br. at 20, 19, 4-5.) Unsurprisingly, CollegenET cites no authority for this theory, nor does it provide any persuasive reason to adopt it.

## **II. COLLEGENET’S VARIOUS PROCEDURAL ARGUMENTS DO NOT SALVAGE ITS PREMATURE LAWSUIT**

CollegenET asserts that Google’s motion to dismiss its Lanham Act-based claims for lack of subject matter jurisdiction should be “disfavored.” (Opp. Br. at 13.) Yet it cites not a single decision involving the Lanham Act in connection with that argument. Although numerous decisions address subject matter jurisdiction challenges based on the ripeness of a Lanham Act claim, none of the ones CollegenET cites condemn those challenges as “disfavored.” See Section I. Instead, CollegenET relies upon decisions addressing the applicability of federal statutes such as the Resource Conservation and Recovery Act, *Safe Air for Everyone v. Meyer*, 373 F.3d 1035, 1040 (9th Cir. 2004), and the Petroleum Marketing Practices Act, *Sun Valley Gasoline, Inc. v. Ernst Enterprises, Inc.*, 711 F.2d 138 (9<sup>th</sup> Cir. 1983). These decisions do not provide any grounds for refraining from deciding the case or controversy requirement necessary under Article III.

In addition, the Court need not consider Google’s motion to dismiss pursuant to Rule 12(b)(6) as a motion for summary judgment. Nowhere in Section II of its Opening Memorandum does Google cite to the Rubin Declaration, or rely on anything other than the lack of allegations in the Complaint sufficient to state a claim for relief. Even if the Court were to consider matters outside the pleadings, discovery regarding Google’s intent would be of little use



at this point. *See* Google’s Response to CollegeNET’s Motion to Expedite Discovery (Dkt. No. 23); Oct. 15, 2010 Tr. (Dkt. No. 28) at 4:16-19; 18:8-17; 23:12-14. Accordingly, CollegeNET’s request for discovery should be denied. *See Wells Fargo & Co. v. Wells Fargo Exp. Co.*, 556 F.2d 406, 430 (9th Cir. 1977) (holding denial of discovery appropriate “when it is clear that further discovery would not demonstrate facts sufficient to constitute a basis for jurisdiction”).

### **III. THE COMPLAINT MUST BE DISMISSED FOR FAILURE TO STATE A CLAIM BECAUSE IT FAILS TO ALLEGE ANY ACTIONABLE USE IN COMMERCE**

Filing an-intent-to use application is not sufficient to establish a use in commerce, which is one of the required elements of a trademark infringement action. *E.g., Wham-O*, 92 U.S.P.Q.2d 1750, 2009 WL 6361387; *Rexel*, 540 F.Supp.2d 1154; *Geisha*, 525 F.Supp.2d 1002; *Cumberland Packing*, 2007 WL 38279; *Macia*, 152 F.Supp.2d 535. As discussed above in Section I.D, none of CollegeNET’s efforts to escape this basic principle succeed. Although CollegeNET points to various allegations in its Complaint other than the intent-to-use application—including the number of online references speculating about Google’s use of the SPEEDBOOK mark based on its intent-to-use application and Google’s alleged knowledge about media buzz surrounding its intent-to-use application and supposedly imminent release of a Chrome OS tablet computer—the Complaint remains devoid of any actual use *by Google* of the SPEEDBOOK mark apart from its intent-to-use application. (Opp. Br. at 6-7; Complaint.) True, Google need not have made a public sale or even advertised its product, but to maintain a claim for trademark infringement there must be an allegation of some actual *use by Google* other than filing an intent-to-use application.

CollegeNET cites many opinions that it asserts support its position that its trademark infringement claims can survive, but not a single one finds infringement—or an adequately pled

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cause of action—over the junior user’s objection without some additional use by the junior user. (See cases cited in Opp. Br. at 8-9).<sup>1</sup> Nor do any of these opinions rely on allegations concerning third parties’ actions. Rather, they all involved an actual use in commerce by the potential infringer:

- *Standard Oil Co. v. Standard Oil Co.*, 56 F.2d 973 (10<sup>th</sup> Cir. 1932): The junior user had selected essentially the same name as the senior user for its corporate business name, both parties had corporate authority to “engage generally in the business of producing, manufacturing, and marketing, petroleum, and petroleum products,” and the junior user had incorporated under the disputed name in several states, issued capital stock, held a shareholders’ meeting, and elected a board of directors and executive officers. Although *Standard Oil* was decided more than a decade before the Lanham Act was passed, such corporate activity as incorporating a company and holding shareholder meetings and elections would undoubtedly qualify as use in commerce.

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<sup>1</sup> In two of the opinions CollegenET relies upon, the junior users apparently never argued that the dispute was not ripe or that there had been no use in commerce. *Kassab Jewelers, Inc. v. C. Kassab Designs, LLC*, No. Civ. 05-265-MO, 2005 WL 1278938\*2 (D. Or. May 25, 2005) (identifying other arguments made by the defendants); *Western Bank v. Western Bancorporation*, 617 P.2d 258 (Or. App. 1980) (addressing only the protectability of the interest in the name “Western Banc” and the appropriate scope of injunctive relief, which the junior user had stipulated to in part). In any event, the junior users in *Kassab* did not dispute that they intended imminently to open a jewelry store in the same metropolitan area as the senior jewelry store and had signed a lease for the store. Presumably, the lease was signed using the allegedly infringing name of the store, which would have been a use in commerce. Similarly, in *Western Bank*, the junior user did not contest the imminent release of its “Western Bancard” bank card, and its senior vice president conceded that it planned to introduce a bank card bearing the “West Bancard” mark through “an extensive newspaper, radio, and television promotional campaign.” 617 P.2d at 263.

- *National Federation of the Blind, Inc. v. Loompanics Enterprises, Inc.*, 936 F. Supp. 1232 (D. Md. 1996): The junior user had *published a book* using the mark to illustrate how to scam money using the names of charitable organizations. After dismissing the direct infringement claims, the court declined to dismiss the contributory infringement theory because, at the pleading stage, it was plausible that some of the book's readers had followed the defendants' instructions and used the plaintiff's mark in an infringing way. *Id.* at 1244-46. It was undisputed that the defendant had used the mark in commerce.
- *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1328 (E.D. Mo. 1996): The junior user had advertised its allegedly infringing service on its website and solicited customers for it. *Id.* at 1335-36.
- *Essie Cosmetics, Ltd. v. Dae Do International, Ltd.*, 808 F. Supp. 952 (E.D.N.Y. 1992): The defendants conceded that the allegedly infringing bottles had been manufactured, were in their possession, and that they were ready to offer their product for sale nationwide. *Id.* at 955.
- *Bertolli USA, Inc. v. Filippo Bertolli Fine Foods, Ltd.*, 662 F. Supp. 203 (S.D.N.Y. 1987): The junior user purchased 2,500 cartons and 12,000 bottles to use in his olive oil business, brought nine bottles of his product to the United States, had printed the allegedly infringing labels and cartons, and shipped a bottle of the olive oil to a potential distributor. *Id.* at 205.

CollegeneNET alleges no remotely comparable actions to those found sufficient in these opinions.

The Complaint does not allege that Google has formed a company with the name SPEEDBOOK that has issued stock and had a shareholders meeting, that Google has published a book using the

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SPEEDBOOK mark, that Google has advertised a SPEEDBOOK computer and solicited customers for it using a webpage, that it has possession of SPEEDBOOK computers that it is ready to offer sale nationwide, or that it has shipped a SPEEDBOOK computer to a potential distributor. Accordingly, none of CollgeNET's authority can salvage its claims.

CollegeneNET's also argues that the Complaint should not be dismissed in its entirety because its state law unfair competition and trademark infringements are not limited by the Lanham Act's "use in commerce" requirement. (Opp. Br. at 11.) Tellingly, CollegeneNET points to no authority holding that Oregon unfair competition and trademark infringement claims can be maintained in the absence of a use in commerce—which is a logical prerequisite for finding that a junior user's actions (as opposed to unwarranted speculation by third parties) are likely to cause confusion.

Lacking allegations of *any* identified use by Google other than filing an intent-to-use application, the Complaint, on its face, fails to allege any trademark claim on which relief can be granted and should be dismissed.

**Conclusion**

For the foregoing reasons and those set forth in Google's motion and other pleadings submitted in support thereof, CollegeNET's Complaint for Trademark Infringement should be dismissed.

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