

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
AUSTIN DIVISION**

**Daniel R. Castro  
Plaintiff**

v.

**ENTREPRENEUR MEDIA, INC.  
Defendant**

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**CIVIL ACTION NO: 10CA695**

**CASTRO’S MOTION TO EXTEND PAGE LENGTH**

Now Comes Plaintiff, Daniel R. Castro (“Castro”) and files this Motion To Extend Page Length of his Response to Entrepreneur Media, Inc’s Rule 12(b)(6) motion to dismiss, and would show unto the Court as follows.

**I. NATURE OF THE CASE**

This is a trademark dispute. The plaintiff, Daniel R. Castro (“Castro”) is the owner of three marks: (1) “EntrepreNeurology”; (2) “Entrepreneur.Ology;” and (3) “EntrepreneurOlogy.” Castro is an attorney who owns several companies, an award-winning author and speaker, and also operates a *passive* website at [www.EntrepreneurOlogy.com](http://www.EntrepreneurOlogy.com). Castro does not publish a magazine. The Defendant, EMI, owns the mark “entrepreneur” and publishes a magazine and operates an *interactive* website at [www.Entrepreneur.com](http://www.Entrepreneur.com). Castro filed this declaratory judgment action in response to a letter from EMI threatening a lawsuit if he did not “cease and desist” from using the word “EntrepreneurOlogy” and ordering him to immediately turn over the title of his registered domain name: [www.EntrepreneurOlogy.com](http://www.EntrepreneurOlogy.com).

**II. THE NEED FOR ADDITIONAL PAGES**

On this same date, Castro filed a Motion to File Separate Responses to EMI’s Motion to Dismiss, proposing to file *five* separate responses to EMI’s Rule 12(b)(6) motions to dismiss

because EMI's motion seeks the dismissal of *eight* separate causes of action. Each of Castro's responses is no more than ten pages. However, one of them is thirty-four (34) pages – the one that combines the arguments dealing with the unconstitutionality of two provisions of the Lanham Act and the arguments dealing with the “generic” nature of the noun “entrepreneur” into one brief. This the response for which a page length extension is needed. Below are the reasons why.

Although EMI couched its motion as a Rule 12(b)(6) motion, the motion is more akin to a motion for summary judgment because it consists almost entirely of argument on the merits, which is improper under the Rule 12(b)(6) standard. *See Jones v. M.L. Greninger*, 188 F.3d 322, 324 (5<sup>th</sup> Cir. 1999). In order for this court to determine whether Castro has stated a cognizable claim under each separate cause of action, it is necessary to understand what the law requires as to each claim. This is not the run of the mill trademark case. It involves a very complex interaction of Constitutional Law, Antitrust Law, Trademark Law and the Anticybersquatting Consumer Protection Act. It is not physically possible for Castro to explain to the court how each of these doctrines applies on the facts of this case in one single brief of ten pages or less.<sup>1</sup>

If EMI wanted to argue simply that “Castro has pled insufficient facts” under each cause of action, it could have done so in just a few pages. This would have enabled Castro to simply identify the paragraph numbers in his complaint where the facts supporting each cause of action could be found – making the court's job much easier.

However, EMI did not do that. Instead, EMI chose to make many substantive arguments on each cause of action and attempted to persuade the court why Castro should not prevail on the merits. EMI needed fifteen (15) pages to do that. Castro did not oppose EMI's motion to extend

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<sup>1</sup> The complaint itself is 27 pages long, and it only provides a “short plain statement” of each claim as required by the Supreme Court in *Bell Atlantic Corp. v. Twombly*, 127 S.Ct. 1955, 1965-1966, n.5 (2007).

page length. More importantly, EMI left out many significant facts and established doctrines of law that show clearly why EMI cannot prevail on the merits. This put Castro in a precarious position because if he does not point out how and where EMI had misguided the court, it was possible that the court might have made an ill-informed, and, indeed, an incorrect decision. The problem is – it is physically impossible to address each and every one of EMI’s legal arguments (and omissions) on all eight causes of action in one single ten (10) page brief. By the time Castro explained the dispute, and set forth the facts, there would be *less than one page* for each of his eight (8) causes of action. Accordingly, Castro respectfully submits the following reasons why he should be entitled to file separate responses to EMI’s motion.

### **III. WHY IS THIS CASE SO IMPORTANT TO THIS COURT’S JURISPRUDENCE?**

Regardless of who wins or loses, this case will be appealed to the Fifth Circuit and the U.S. Supreme Court. It is that important. This is the first time the “incontestable” provisions of the Lanham Act have been challenged on Free Speech grounds. These provisions are unconstitutional as applied to the facts of this case because they have a “chilling effect” on free speech and because EMI has never been required to prove that the consuming public associates the word “entrepreneur” with the publisher of a magazine, or that it even serves the public good by preventing confusion or deception - as required by law. *See Aloe Cream Labs v. Milson, Inc.*, 423 F.2d 845, 849 (5<sup>th</sup> Cir. 1970)(requiring proof that the consuming public associates the mark “with a single thing coming from a single source”).

This case is also important because no one has ever challenged EMI’s trademark on the ground that the word “entrepreneur” is generic. No one has submitted evidence that this is a common noun of French origin that is several hundred years old. EMI does not deny that even a mark that has attained “incontestable” status can be cancelled as a matter of law because it is

generic. See 15 U.S.C. 1064(c); and 1119 (giving federal district courts the right to cancel any trademark). Because of the impact of this court's ruling on the body of trademark jurisprudence and First Amendment law, this court's opinion will likely be discussed in every Trademark Law classroom in every law school across the U.S. for years to come.<sup>2</sup>

#### IV. EMI'S ILLEGAL PATTERN AND PRACTICE

For many years now, EMI has been sending threatening letters to innocent victims, claiming to own the noun "entrepreneur" and acting as the self-appointed gatekeeper of who can and can't use this word, and how and in what context. Although it only takes a few lines of space for EMI to claim "our trademark is valid and incontestable" and "the Ninth Circuit said so," it takes *many more pages* to show why EMI is misrepresenting the facts and the law to the court. Below are just a few of the facts and legal doctrines that EMI omitted which Castro must include in his response in order for the court to make an informed decision. Castro submits them here – solely for the purpose of demonstrating to the court how much "white space" is required to respond to EMI's substantive arguments.

As mentioned above, no one has ever challenged the constitutionality of the "incontestable" provisions of the Lanham Act until now. EMI has attempted to hide this fact. It is unclear whether EMI made a mistake or whether it intentionally attempted to deceive the Court, but in its Motion to Dismiss, EMI actually states that Castro wants a declaration that the *entire* Lanham Act is unconstitutional. See heading of Section B, at page 2 of EMI's Motion. However, Castro made it very clear in his complaint that there are *only two small provisions* of the Lanham Act that are unconstitutional "as applied" to the facts of this case. See para. 7.1 – 7.9 of First

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<sup>2</sup> Castro has already received numerous emails and phone calls from all across the U.S., including calls from trademark attorneys, antitrust attorneys, news reporters, and a professor from Stanford Law School who teaches trademark law. The Texas Lawyer has already published an article about it. A local TV station, KXAN, recently interviewed Castro about it.

Amended Complaint. Section 1065 is the statute that allows a trademark to become “incontestable” without a showing that the mark ever had or continues to have “secondary meaning,” or that it continues to serve the public good by designating a single, exclusive source of the goods or services at issue. Section 1115(b) is the section that prohibits the defendant in an infringement action from submitting evidence that the mark lacks “secondary meaning” or that consumers simply do not associate that mark with a single, exclusive provider of the goods or services at issue.

EMI argues that the speech at issue here is not Castro’s right to call himself an entrepreneur, or to write articles and books about entrepreneurship, and give speeches and hold workshops about entrepreneurship, but rather his right to brand himself, his book, articles, keynote speeches and workshops under the marks “EntrepreneurOlogy” or “Entrepreneur.Ology.”

This is an argument on the merits because it raises a very complex issue of whether the speech being restricted is “commercial” or “non-commercial” in nature. Although Castro tried and tried, he found it physically impossible to address this issue, plus all the other eight causes of action, in the few inches of space that would have been available in the current ten (10) page limit. Below is a sampling of the arguments Castro must make in order to respond to EMI’s argument on the merits – to show the court how impossible it is to fit the arguments on the merits in the allotted amount of “white space.”

It is important for the court to be aware that regulations restricting non-commercial speech receive “strict scrutiny” analysis. *See Board of Trustees of the State University of New York v. Fox*, 492 U.S. 469, 475-485 (1989). Regulations that restrict purely commercial speech receive “intermediate scrutiny” analysis. *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447, U.S. 557 (1980). The Supreme Court itself acknowledges that

the line between “commercial” and “non-commercial” speech is often blurry. *Id.* at 581, n. 4. Even the Supreme Court justices themselves cannot agree on what is and what is not “commercial speech.” *Id.* (three judges concurring and one dissenting).

Despite the fogginess over the conceptual differences, the U.S. Supreme Court agrees that speech by professional speakers, authors and journalists is *non-commercial* speech, and is, therefore, entitled to the full protection of the First Amendment. *See Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557, 580, n. 2 (“Little purpose would be served by a first amendment which failed to protect newspapers, paid public speakers, political candidates with partially-economic motives and professional authors.”)(quoting with approval a law review article). With this statement, the Supreme Court confirmed that “partially-economic motives” do not transform non-commercial speech into purely free speech. It would be illogical to conclude that branding Castro’s artistic and literary endeavors under a trademark suddenly transforms Castro’s trademark into purely “commercial speech.”

To make things easier on the lower courts, the Supreme Court has decided that when the literary, artistic, and commercial aspects of the speech at issue appear to be “inextricably intertwined,” the regulation at issue is still to receive “strict scrutiny” analysis. *See Riley v. National Federation of Blind, Inc.*, 487 U.S. 781, 796, (1988)(“Thus where, as here, the component parts of a single speech are ‘inextricably intertwined,’ we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. Such an endeavor would be both artificial and impractical”).

Castro submits that, in accordance with *Central Hudson Gas & Electric*, his trademarks at issue here are purely literary and artistic because they brand purely literary and artistic works.

Economic motive is not the determining factor. The Supreme Court has ruled that, “The mere fact that these pamphlets are conceded to be advertisements clearly does not compel the conclusion that they are commercial speech. Similarly, the reference to a specific product does not by itself render the pamphlets commercial speech.” *Bolger v. Youngs Drug Products*, 463 U.S. 60, 66 (1983). The Court also made it clear that having an economic motive alone, “would clearly be insufficient by itself to turn the materials into commercial speech.” *Id.* at 67.

However, even if this court finds that the two aspects of the speech appear to be inextricably intertwined, this court is required to apply strict scrutiny analysis. *Riley*, 487 U.S. at 796.

Moreover, EMI forgets that even purely “commercial speech” is entitled to First Amendment protection. *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 759 (“speech does not lose its First Amendment protection because money is spent to project it .... speech likewise is protected even though it is carried in a form that is sold for profit.”). It is true that the First Amendment does not protect commercial speech that is deliberately deceptive, false or misleading. *Id.* at 771. But the undisputed facts, which must be taken as true, show that this type of speech is not at issue here. Even if the speech at issue here were purely commercial, regulations that have the effect of suppressing honest, truthful, non-deceptive, non-coercive speech are still subject to “strict scrutiny” analysis. *See Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557, 578 (“We have not suggested that the ‘commonsense differences’ between commercial speech and other speech justify relaxed scrutiny of restraints that suppress truthful, non-deceptive, non-coercive commercial speech.”). In other words, regulations that suppress honest, truthful speech (even if it is commercial speech) have always, and still do, receive “strict scrutiny” analysis. *Id.*

The Fifth Circuit has already ruled that any law, even in a purely commercial speech case, that has the effect of limiting the use of a common noun that is *not inherently deceptive* is an unconstitutional violation of the First Amendment. *See Piazza's Seafood World, v. Odom*, 448 F.3d 744, 753 (5<sup>th</sup> Cir. 2006)(finding that the state's interest in preventing deception in commercial speech was not furthered by a regulation that limited the commercial use of common nouns ["Cajun Boy" and "Cajun Delight"] that were not inherently deceptive.)

In order for Castro to fully respond to EMI's argument on the merits, he would also have to explain why Section 1065 and 1115(b) fail the First Amendment "strict scrutiny" analysis. Below is a sample of what he would have to argue.

These regulations: (1) are NOT designed to further a "compelling" governmental interest because they protect a common noun that has never been shown to designate the single, exclusive provider of a magazine. This is antithetical to the very purpose of the Lanham Act, not in furtherance of it; (2) are NOT "narrowly tailored" to achieve that compelling interest because it has the effect of suppressing the honest, non-deceptive use of a common noun; and (3) do NOT use the "least restrictive" means to further that interest because Congress could easily have required that the owner of the mark show tangible proof that it had attained "secondary meaning" as a condition of obtaining "incontestable" status. *See Park 'N Fly*, 469 U.S. at 219 (J. Stevens dissenting)(Congress could "simply require the owner of a merely descriptive mark to prove secondary meaning before obtaining any benefit from incontestability").

Sections 1065 and 1115(b) are not designed to further a legitimate governmental interest for the following reasons. First, the net result of giving the mark "entrepreneur" incontestable status is that it suppresses the right of the average citizen to use that word to identify their goods and services in an honest, non-deceptive manner. *See Central Hudson*, 447 U.S. at 578; *In re MJ*,



4445 U.S. at 199. Second, it illegally makes EMI the gatekeeper and allows it to dictate who can and can't use that word and in what context. No legitimate government interest can be furthered by allowing a rogue dictator to dictate the use of a common noun. Third, EMI obtained a registered trademark on a common noun without ever having to prove the public automatically associates it with the publisher of a particular magazine. Fourth, EMI obtained "incontestable" status for its trademark without ever having to prove the public automatically associates it with the publisher of a particular magazine. Fifth, if both of those sections are applied here, it will prohibit Castro from submitting evidence that the noun does not have "secondary meaning" and is not entitled to trademark protection.

The purpose of the Lanham Act is not furthered at all by allowing a common noun to achieve "incontestable" status without a showing that the public automatically associates that noun with the publisher of a particular magazine. It is also antithetical to the purpose of the Lanham Act to prohibit the introduction of evidence at trial that that noun lacks "secondary meaning." The Lanham Act is very specific in prohibiting the registration of trademarks that are "merely descriptive" of the goods and services unless and until they have acquired "secondary meaning." See 15 U.S.C. 1052(e)(f). To then prohibit the introduction of evidence that the mark lacks "secondary meaning" is not only inconsistent with the purpose of the Lanham Act, but it also results in the restriction of speech Congress never intended to restrict (i.e. the public's honest, non-deceptive use of that same noun to identify goods and services). At least one Supreme Court Judge agrees, stating: "First to permit one person to appropriate exclusively a mark which is merely the ordinary language to describe the good or services involved would obviously be detrimental to others who deal in the same good or services by *hindering their use of normal language* in association with their goods or services." *Park 'N Fly v. Dollar Park and Fly, Inc.*,

469 U.S. 189, 215 (Justice Stevens, dissenting)(quoting from the Patent & Trademark Office's own handbook)(emphasis added). As the court can now see, it would be physically impossible to make all these arguments (plus all the arguments addressing the other seven causes of action) in one single ten page brief.

#### **V. ALTERNATIVE REQUEST**

In the alternative, if the court is not inclined to grant Castro's motion to extend page length, then in the alternative, Castro requests an extension of time to attempt *with great effort* to comply with the court's ruling. Castro will be leaving for the Christmas holidays on December 23<sup>rd</sup> and will not return until January 11. Therefore, Castro requests until January 24, 2010 to comply with the court's order.

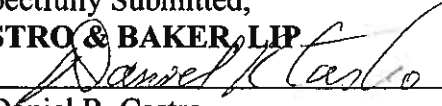
#### **VI. EMI WILL NOT BE PREJUDICED**

EMI will not be prejudiced by the page length extension because it has the opportunity to file a reply – and Castro has already agreed (via email) to give EMI as many pages as it needs and as much time as it needs (especially during the holidays).

This is one of those cases where it is critical for the court to have as much information as possible because, regardless of how it rules, this case will be appealed to the Fifth Circuit and the U.S. Supreme Court. Moreover, both parties are likely to request that this court's opinion be published and used as precedent.

WHEREFORE, Castro respectfully requests that the Court grant his page length extension to allow him to file a thirty-four (34) page response to EMI's Motion to Dismiss his constitutional claims.


Respectfully Submitted,  
**CASTRO & BAKER, LLP**

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### **CERTIFICATE OF CONFERENCE**

The undersigned hereby certifies that he attempted to obtain the agreement of opposing counsel to this motion, but opposing counsel denied the request.

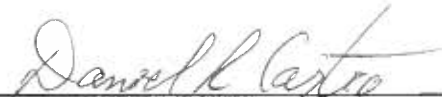


**Daniel R. Castro**

### **CERTIFICATE OF SERVICE**

This is to certify that a true and correct copy of this pleading was filed with the Clerk of the Court using CM/ECF system, which will send a notification of a Notice of Electronic Filing to the following counsel of record on December 15, 2010:

	<p>William G. Barber Pirkey Barber, LLP 600 Congress Avenue, Suite 2120 Austin, Texas 78701</p>
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**Daniel R. Castro**