ELECTRONIC FRONTIER FOUNDATION
Protecting Rights and Promoting Freedom on the Electronic Frontier

May 16, 2014

VIA EMAIL: tm-enf@google.com

Re: google-nest.org

Dear Google Trademark Team,

The Electronic Frontier Foundation represents the Peng! Collective in connection with your complaints regarding the above-listed website.

We reviewed with dismay your email of May 8, 2012, asking that Peng! revise the site and transfer the domain name to Google. Instead of a cease and desist, we would have expected you to take a page from Linden Labs and issue a "proceed and permit" letter instead (see here if this doesn't ring a bell: http://terranova.blogs.com/terra_nova/2007/01/proceed_and_per.html).

The site is a pure political commentary. Indeed, its launch has long since been recognized as such by a variety of news organizations. U.S. authorities consistently support the basic notion that trademark law does not reach, much less prohibit, this kind of speech regarding a matter of substantial public concern.[1] Simply put, "The Lanham Act regulates only economic, not ideological or political, competition . . . Competition in the marketplace of ideas is precisely what the First Amendment is designed to protect." *Koch Ind. v. John Does 1-25*, 2011 WL 1775765, D.Utah (May 9, 2011).

First, use of the Google name and logo on the site is fully protected by the nominative fair use doctrine. *See, e.g. Century 21 Real Estate Corp. v. Lendingtree*, 425 F.3d 211, 218-221 (3d Cir. 2005); *New Kids on the Block v. New America Pub.*, 971 F.2d 302, 308 (9th Cir.1992). Indeed, courts have noted that nominative fair uses are particularly likely to be found in parodies. *Mattel v. Walking Mountain Prods.*, 353 F.3d 792, 80 n.14 (9th Cir. 2003).

Second, given the content of the site, and the ample publicity the spoof has generated, all of which recognized as satirical and parodical commentary, it is difficult to imagine that any Internet user would be confused.

Third, the site is sheltered by the First Amendment, *see L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987); *Cliff Notes v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 495 (2d Cir. 1989); *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456 (4th Cir. 2000); *Mattel, Inc. v. MCA Records,* 296 F.3d 894, 906 (9th Cir. 2002). Again, there is nothing

[1] We do not concede at this juncture that U.S. courts have jurisdiction over this matter. Because Google's corporate headquarters is based in the U.S., however, we expect you would be familiar with, and respect, the cited statutory and case law.

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on the site that would lead consumers to purchase goods or services based on a mistaken affiliation.

Finally, my client's action is entirely noncommercial and, therefore, statutorily exempt from the Lanham Act. *See* 15 U.S.C. §§ 1127, 1125; *Bosley Med. Inst. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003); *CPC Int'l v. Skippy*, 214 F.3d 456, 461 (4th Cir. 2000).

Nonetheless, Peng! feels confident that it has accomplished its initial purpose of raising awareness about and commenting on Google privacy policies. Accordingly, it has revised the site to discuss the parody, and Google's response to it. As a practical matter, we believe that revision has largely met your demands. However, we also believe it is important for Internet users to have a full document of the hoax and Google's response, and that such documentation be housed in the most logical place, i.e., at the existing domain name. Therefore, my client is not willing to transfer the domain name.

I sincerely hope this ends this matter. If you have further concerns, please direct them to my attention.

Best regards,

Corynne McSherry

Corynne McSherry
IP Director

cc: Thorsten Feldmann