

No. 06-16219

**IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

TIM OEY AND JANE DOE OEY,
Petitioner/Appellant,
v.
THE FREECYCLE NETWORK, INC.
Respondent/Appellee

**MOTION OF JAMES BOYLE, LAUREN GELMAN, LAWRENCE
LESSIG, DECLAN MCCULLAGH, DAVID POST, GLENN HARLAN
REYNOLDS, MARTIN SCHWIMMER, JIMMY WALES, AND
JONATHAN ZITTRAIN TO FILE A BRIEF OF *AMICI CURIAE***

**BRIEF OF *AMICI CURIAE* IN SUPPORT OF
PETITIONERS/APPELLANTS' TIM OEY AND JANE DOE OEY
AND ALSO IN SUPPORT OF VACATING THE PRELIMINARY
INJUNCTION**

From A Preliminary Injunction Of The United States District Court
For The District of Arizona
(Hon. Raner C. Collins, Presiding)
No. CV-06-00173-TMC-RCC

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MOTION OF JAMES BOYLE, LAUREN GELMAN, LAWRENCE LESSIG, DECLAN MCCULLAGH, DAVID POST, GLENN HARLAN REYNOLDS, MARTIN SCHWIMMER, JIMMY WALES, AND JONATHAN ZITTRAIN FOR LEAVE TO FILE A BRIEF OF *AMICI CURIAE*

James Boyle, Lauren Gelman, Lawrence Lessig, Declan McCullagh, David Post, Glenn Harlan Reynolds, Martin Schwimmer, Jimmy Wales, and Jonathan Zittrain respectfully move this Court for leave to file a brief of *amici curiae*. *Amici* include law professors who teach and write about the internet, individuals who frequently participate in policy discussions about the future of the internet, and individuals who host various web sites or blogs on the internet. *Amici* have no personal connection to the parties on appeal.

Amici hope that the attached brief can help the court by illustrating how the reasoning of the District Court's decision could harm broad public commentary – including commentary in scholarly work, in journalism, in Weblogs, and in encyclopedias – about trademark controversies.

For the foregoing reasons, *amici* respectfully request this Court to grant leave for *amici* to file the attached brief.

July 20, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. Adelstein', written over a horizontal line.

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INTEREST OF *AMICI*

James Boyle is William Neal Reynolds Professor of Law at Duke Law School and Faculty Co-Director of the Center for the Study of the Public Domain.¹ He has written extensively on intellectual property, including trademark law.

Lauren Gelman is the Associate Director of Stanford Law School's Center for Internet and Society. She writes and speaks about how the law – including intellectual property law – interacts with new technologies, represents clients in litigation and advocacy, and supervises students in the Cyberlaw Clinic. She also teaches Law, Technology and Privacy at the Law School and is an Adjunct Lecturer in Stanford's School of Engineering.

Lawrence Lessig is a Professor of Law at Stanford Law School and founder of the school's Center for Internet and Society. He has won many awards, including the Free Software Foundation's Freedom Award, and was named one of Scientific American's Top 50 Visionaries, for arguing “against interpretations of copyright that could stifle innovation and discourse online.” He is the author of *Free Culture* (2004), *The Future of Ideas* (2001) and *Code and Other Laws of Cyberspace* (1999). He chairs the Creative

¹ The titles of the individuals as well as the institutions, centers, and organizations with which they are associated are provided for identification purposes only.

Commons project, and serves on the board of the Free Software Foundation, the Electronic Frontier Foundation, the Public Library of Science, and Public Knowledge. He is also a columnist for Wired.

Declan McCullagh is the chief political correspondent and senior writer for CNET's News.com; he writes and speaks often on various technology and law topics, including intellectual property. From 1998 to 2002, he was the Washington bureau chief for Wired News; before that, he was a reporter for Time Magazine, Time Digital Daily, and The Netly News, as well as a correspondent for HotWired. He is an adjunct professor at American University in Washington, D.C., where he has taught a graduate journalism class. He moderates Politech, a well-known mailing list dedicated broadly to politics and technology, which he founded in 1994. He was the first online reporter to join the National Press Club; he participated in the first White House dot com press pool; and he was one of the first online journalists to receive credentials from the press gallery of the U.S. Congress.

David G. Post is I. Herman Stern Professor of Law at Temple University's Beasley School of Law, and a contributor to the Volokh Conspiracy (www.volokh.com) and IcannWatch (www.icannwatch.org)

blogs. He writes extensively on intellectual property matters, including trademark law.

Glenn Harlan Reynolds is a professor of law at the University of Tennessee, Knoxville. He is also the author of the Instapundit weblog, instapundit.com, on which he expresses his opinion about many issues, including intellectual property controversies.

Martin Schwimmer writes The Trademark Blog, which is among the most widely read trademark publications, and in the process regularly comments about the validity and strength of trademarks. He is a partner in the Schwimmer Mitchell Law Firm, Mt. Kisco, New York.

Jimmy Wales is the co-creator of Wikipedia, a free online open-source encyclopedia, and is the Chair of the Board of Trustees of Wikimedia Foundation, which operates Wikipedia. Wikipedia articles cover a wide range of material, including trademarks generally and the controversy about the term “freecycling” in particular, *see* <http://en.wikipedia.org/wiki/Freecycling>.

Jonathan Zittrain is Professor of Internet Governance and Regulation at Oxford University, where he teaches and writes about the social impact of networked technologies and intellectual property matters, including trademarks.

ARGUMENT

We understand that, in light of the preliminary procedural posture of this case, the Court is unlikely to address the underlying question of trademark law – whether plaintiff has trademark rights in the word “freecycle,” at it contends, or, alternatively, whether “freecycle” is a generic term to which trademark rights cannot attach, as defendant contends – and we express no opinion about it.

We may, indeed, have opinions on that question. Our concern, and the reason that we have submitted this brief, is precisely that any such opinions that we might have, and that we might choose to express – opinions we might hold as lawyers, as law professors, as journalists, as editors, or simply as interested citizens – *could themselves, under the reasoning of the district court, constitute an infringement of plaintiff’s trademark*, subjecting us to an injunction (and, quite possibly, an assessment of monetary damages).

We write, in other words, not as experts on any particular aspect of trademark law, but as participants in the global conversation *about* trademark law. It is a conversation, we are happy to say, that has become as robust and free-wheeling as one might hope for in a democratic society,

facilitated by, though by no means confined to, the Internet. Rulings like the one at issue in this appeal, however, put it at substantial risk.

The district court concluded that, because plaintiff had “established a recognizable logo and name . . . through over three years of use,” and because defendant “recognized [plaintiff’s] legitimate trademark rights” in the past, any “comments that could be construed as to disparage upon the *possible* trademark” rights associated with that logo and name would likely constitute an actionable infringement of those rights. The breadth of this principle, and its potential for silencing constitutionally-protected speech on and off the Internet, is quite breath-taking.

For instance, the law professors among us might opine, in a media interview, an op-ed article, or a classroom discussion about the principles of trademark “genericide,” that some registered U.S. trademark – “Kleenex™,” perhaps, or “Xerox™,” or “Starbucks™,” or “Google™,” or “Aqua-Lung™,” or “Hot Wheels™,” or “Miracle Whip™,” etc. – is not valid because of its generic use; one of the public interest advocacy groups among us might make the same (or the contrary) argument in a press release published on its web site; one of the journalists among us might take up the argument (for or against) in a news analysis or opinion column; so might a commenter or editor at an online encyclopedia, or at one of the many

thousands of blogs and websites across the Internet at which questions of trademark law and policy are discussed.²

Our comments might look very much like the defendant's in this case³: "In my opinion, the word 'xerox' is generic and therefore in the

² An internet search at www.google.com on July 20, 2006 on the phrase "trademark law' and 'trademark policy'," for example, yielded over 19,000 results, including corporate websites, *e.g.*,

www.mozilla.org/foundation/trademarks/faq.html

www.redhat.com/about/corporate/trademark/guidelines/index.html
public interest/advocacy sites, *e.g.*,

www.discourse.net/archives/law_trademark_law/index.html

<http://www.publicknowledge.org/articles/58>

blog.ericgoldman.org/archives/trademark/

andrewsinclair.org/archive/google_changes_trademark_policy.htm

<http://www.k.lenz.name/LB/>

news.com.com/2100-1030_3-6089307.html

wiki.mako.cc/TrademarkFreedom

www.ad-mkt-review.com/public_html/air/ai200111.html

searchenginewatch.com/searchday/article.php/3404071

www.clickz.com/news/

educational and academic sites, *e.g.*,

www.utsystem.edu/OGC/Intellectualproperty/trdmrk.htm

www.law.washington.edu/lct/swp/Law/trademark.html

islandia.law.yale.edu/isp/search_papers/zieger.doc

and law firm sites, *e.g.*,

www.schwimmerlegal.com

<http://www.patenttrademarkblog.com/>

trademarks.smiglaw.com/blog/

<http://trademark-blawg.com/>

www.venable.com/practice.cfm?action=view&practice_id=403

www.loundy.com

www.oppedahl.com

³ The district court's Order requires defendant to "remove all postings from the internet and any other public forums that he has previously made that

public domain.⁴ The best way to keep ‘xerox’ (and the terms ‘xeroxed,’ ‘xeroxing,’ etc.) in the public domain is for as many people and groups as possible to continue to use the terms generically.”⁵

It might even be the case that we had changed our minds about this very question in the past – surely something we have all done many times, and which is both a part of, and in many ways the point of, the public debate on these questions.

Under the district court’s reasoning, our comments alone could be “construed as disparaging the possible trademark” associated with the “Xerox” name and subject us to liability for infringing the “Xerox” trademark. And this would be so even though we offered no goods or services in competition with Xerox, Inc., nor confused or misled any consumers about the source or origin of any goods or services.

disparage [plaintiff’s] possible trademark and logo,” and goes on to note that the Order “specifically refers to, but is not limited to, the exhibits used by [plaintiff] in this case.”

⁴ This example, of course, is for illustrative purposes only; we do not mean to express any opinion about the validity of the “Xerox” trademark, but only to illustrate the kind of opinion that would be suppressed under the district court’s reasoning here.

⁵ See Exhibit D to Plaintiff’s Complaint [quoting defendant’s comment that “The best way to keep ‘freecycle’ in the public domain is for as many people and groups as possible to continue to use the term generically.”] and Exhibit E to Plaintiff’s Complaint [quoting defendant’s comment that “it is legal for everyone to use the term freecycle, freecycling, freecycled, freecycler, etc.”]

And under Plaintiff's reasoning, each such statement – even in a law review article, a newspaper column, or a web site – would constitute commercial speech, simply because it “draw[s] ‘attention to [Xerox’s services]’ and directly impacts [Xerox’s] ability to attract new [users], and retain current [users] and sponsors by harming [Xerox]’s commercial reputation via its Marks,” and “because it relates to [Xerox’s] Marks and the public’s perception of [Xerox].”⁶

We cannot believe that the First Amendment tolerates such a restriction on the rights of academics, advocates, or public-minded citizens to express their opinions about the validity *vel non* of specific trademark claims. Trademark rights, of course, are *public* rights; they are granted by the people through our duly authorized representatives in the legislatures, courts, and administrative offices. Unfettered public discussion about those rights – about how law is made and applied, in the abstract and in the particular, and about whether it is or is not being made and applied (in the speaker’s opinion) correctly – lies at the very heart of the First Amendment freedom of speech. It is difficult to imagine an Order more at odds with this principle than the one issued by the district court in this case, and we respectfully urge you to overturn it.


⁶ Plaintiff’s Response to Motion for a Stay Pending Appeal at 13.

CONCLUSION

For the foregoing reasons, the district court's injunction should be vacated.

July 20, 2006

Respectfully submitted,



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CERTIFICATE OF SERVICE

I, Greg Bucklin, declare as follows:

I am a resident of the State of California and over the age of eighteen years, and not a party to the within action. On July 20, 2006, I served the foregoing document(s) described as:

MOTION OF JAMES BOYLE, LAUREN GELMAN, LAWRENCE LESSIG, DECLAN MCCULLAGH, DAVID POST, GLENN HARLAN REYNOLDS, MARTIN SCHWIMMER, JIMMY WALES, AND JONATHAN ZITTRAIN TO FILE A BRIEF OF *AMICI CURIAE*

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By placing the document(s) listed above in a sealed Federal Express overnight service envelope and affixing a pre-paid air bill, and causing the envelope to be delivered to a Federal Express agent for overnight delivery to:

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By personally delivering the document(s) listed above in a sealed envelope to:

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on July 20, 2006.

A handwritten signature in black ink, appearing to read "Greg Bucklin", is written over a horizontal line.

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