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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

TINA RENNA,

Plaintiff,

-vs-

**THE COUNTY OF UNION,
NEW JERSEY**

Defendant.

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Civil Action No. 11-3328 (KM) (MAH)

**BRIEF IN SUPPORT OF
PLAINTIFF'S MOTION FOR
SUMMARY JUDGMENT,
FED. R. CIV. P. 56, 57**

RETURNABLE NOV. 4, 2013

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
INTRODUCTION	1
ARGUMENT	2
I. A REAL AND JUSTICIABLE CONTROVERSY EXIST OVER THE COUNTY’S RIGHT TO CLAIM TRADEMARK PROTECTION OVER THE SEAL, ALLOWING RENNA TO REQUEST A DECLARATORY JUDGMENT	2
II. THE COUNTY MAY NOT CLAIM TRADEMARK PROTECTION FOR ITS SEAL AND MAY NOT RESTRICT THE DISPLAY OF THE SEAL BY RENNA FOR A NON-COMMERCIAL PURPOSE	5
A. A Government Insignia Is Not Protected By Trademark Laws	5
B. Renna’s Use of the Seal Does Not Constitute Infringement.....	8
III. RENNA HAS A FIRST AMENDMENT RIGHT TO DISPLAY THE SEAL IN CONNECTION WITH NEWS AND INFORMATION REPORTING AND THE COUNTY’S ASSERTION THAT SUCH DISPLAY IS TRADEMARK INFRINGEMENT VIOLATES RENNA’S RIGHT TO FREEDOM OF SPEECH.....	11
CONCLUSION	15
CERTIFICATE OF SERVICE.....	17

TABLE OF AUTHORITIES

Cases

Anderson v. Liberty Lobby, 477 U.S. 242 (1986).....2

Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672 (9th Cir.2005)9, 11

Closed Loop Marketing, Inc. v. Closed Loop Marketing LLC, 589 F. Supp. 2d 1211 (E.D. Cal. 2008)7

Farah v. Esquire Magazine, Inc., 863 F. Supp. 2d 29 (D.D.C. 2012).....11

Green Edge Enterprises, LLC v. Rubber Mulch Etc., LLC, 620 F.3d 1287 (Fed. Cir. 2010)4

Howard Johnson Intern., Inc. v. Vraj Brig, LLC, 2010 WL 215381 (D.N.J. Jan. 14, 2010)2, 9

L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987).....9

Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002)11

MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007)4, 5, 13

Regan v. Time, Inc., 468 U.S. 641 (1984).....14

Rothamel v. Fluvanna County, Va., 810 F. Supp. 2d 771 (W.D. Va. 2011)12, 13

Schwan’s IP, LLC v. Kraft Pizza Co., 379 F. Supp. 2d 1019 (D. Minn. 2005).....8

Shapiro v. Essex County Bd. of Chosen Freeholders, 177 N.J. Super. 87 (Law Div. 1980)6

Simmonds Aerocessories, Ltd. v. Elastic Stop Nut Corp. of America, 257 F.2d 485 (3d Cir. 1958).....3

Spence v. Washington, 418 U.S. 405 (1974)14

Syntex Laboratories, Inc. v. Norwich Pharmacal Co., 437 F.2d 566 (2d Cir. 1971)7

Terrace v. Thompson, 263 U.S. 197 (1923).....13

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992).....9

Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research, 527 F.3d 1045 (10th Cir. 2008)9

Velvet Underground v. Andy Warhol Foundation for the Visual Arts, Inc., 890 F. Supp. 2d 398 (S.D.N.Y. 2012)3

Windsurfing Int'l, Inc. v. AMF Inc., 828 F.2d 744 (Fed. Cir. 1987)4

Statutes

15 U.S.C. § 1052(b)6, 7, 8

15 U.S.C. § 1114(1)(a).....9

28 U.S.C. § 22012, 5

28 U.S.C. § 22022, 5

N.J. Stat. Ann. § 56:3-13.2(c)6

Rules

Fed. R. Civ. P. 56(c)(2).....2

Fed. R. Civ. P. 56(e)(2).....2

Constitutional Provisions

U.S. Const. amend. Ipassim

INTRODUCTION

The instant case involves the rights of citizens to engage in news and information reporting free from government threats to impose civil liability under the trademark laws for the manner in which such reporting takes place. Tina Renna is a journalist and citizen activist who seeks to bring to light the workings of the government of the Defendant, the County of Union, New Jersey (hereinafter “the County”) through the production and dissemination of a locally-broadcast television show, “Union County Citizen’s Forum.” In connection therewith, Renna includes a display of the Seal of the County of Union, New Jersey (hereinafter “the Seal”) with a spotlight shining on it, a symbolic demonstration of her purpose of uncovering the activities of the County. However, the County squelched that symbolic expression by demanding display of the Seal cease and desist and threatening to assert legal claims for infringement. As discussed, *infra*, the County’s claim to trademark protection is legally baseless, particularly as it applies to the display of the Seal by Renna, which was speech and expression affirmatively protected by the First Amendment.

Because the essential facts in this case are largely undisputed, and are set forth in the Plaintiff’s Statement of Material Facts Not in Dispute which is incorporated by reference herein, summary judgment should be entered in favor of Renna declaring the County’s assertion of trademark protection is baseless and

invalid. Summary Judgment is proper when “the pleadings, the discovery and disclosure materials, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c)(2). In resolving a motion for summary judgment, the Court must determine “whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law.” *Howard Johnson Intern., Inc. v. Vraj Brig, LLC*, 2010 WL 215381, at *2-*3 (D.N.J. Jan. 14, 2010) (quoting *Anderson v. Liberty Lobby*, 477 U.S. 242, 251–52 (1986)). More specifically, summary judgment should be granted if the evidence available would not support a jury verdict in favor of the nonmoving party. *Anderson*, 477 U.S. at 248–49. Accordingly, if the movant’s motion is supported by facts, the party opposing summary judgment “may not rely merely on allegations or denials in its own pleading; rather, its response must ... set out specific facts showing a genuine issue for trial.” Fed. R. Civ. P. 56(e)(2).

ARGUMENT

I. A REAL AND JUSTICIABLE CONTROVERSY EXIST OVER THE COUNTY’S RIGHT TO CLAIM TRADEMARK PROTECTION OVER THE SEAL, ALLOWING RENNA TO REQUEST A DECLARATORY JUDGMENT

Renna has requested a declaratory judgment under 28 U.S.C. §§ 2201-2202 regarding the County’s right to claim it has the exclusive right to control the

display and use of the Seal under trademark law (Comp. at 6-7). It is clear that disputes involving trademarks and purported trademarks are cognizable in an action for declaratory judgment. In *Simmonds Aeroaccessories, Ltd. v. Elastic Stop Nut Corp. of America*, 257 F.2d 485, 489 (3d Cir. 1958), the court stressed that the Declaratory Judgment Act should be construed liberally and allows a federal court to exercise jurisdiction when “the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” The Third Circuit there went on to rule that such a controversy did exist where the defendant claimed in collateral proceedings that the plaintiff was infringing on its trademark; moreover, the fact that the defendant had not made a direct threat to sue the plaintiff or asserted formally a claim of infringement did not prevent an actual, justiciable controversy from existing. *Id.* at 490.

Thus, “[u]nder the Declaratory Judgment Act, a party who wishes to engage in conduct that may infringe another’s intellectual property rights may seek a declaration that those rights are invalid without first exposing itself to liability.” *Velvet Underground v. Andy Warhol Foundation for the Visual Arts, Inc.*, 890 F. Supp. 2d 398, 403-04 (S.D.N.Y. 2012). Recent decisions have identified a two-part test for determining if a declaratory judgment action lies in the trademark

context: (1) has the defendant's conduct created a real and reasonable apprehension of litigation on the part of the plaintiff, and (2) has the plaintiff engaged in a course of conduct which has brought it into adversarial conflict with the defendant. *Windsurfing Int'l, Inc. v. AMF Inc.*, 828 F.2d 744, 757-58 (Fed. Cir. 1987).

As to the first prong, there is little doubt that the County has given Renna every reason to believe she might be sued and held liable if she displays the Seal in connection with news reporting she engages in. In its September 17, 2010 letter, the County made clear it believed that the Seal was protected by trademark laws and asserted that display of the Seal constituted "trademark infringement." The letter demanded that the "unauthorized use" must "cease and desist." (Statement of Material Facts Not in Dispute ¶ 8; Comp. Exh. A). Issuance of such a "cease and desist" letter has been found to demonstrate that a plaintiff seeking a declaratory judgment had a substantial apprehension of liability. *Green Edge Enterprises, LLC v. Rubber Mulch Etc., LLC*, 620 F.3d 1287, 1301 (Fed. Cir. 2010) (citing *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007)).

As to the second prong, it was manifestly Renna's conduct which caused the controversy. This is demonstrated again by the County's letter of September 17, 2010, in which not only asserted trademark infringement, but identified "Union County Citizens Forum," the television show produced by Renna, as the source of

the infringement (Statement of Material Facts Not in Dispute ¶ 9; Comp. Exh. A). Although Renna is not presently using the Seal, this is as a result of the threat of the County to enforce a claim of trademark infringement and does not prevent an actual, justiciable controversy from existing (Statement of Material Facts Not in Dispute ¶ 28). A party's own action in refraining from to take action that may expose her to liability does not prevent Article III jurisdiction from existing to challenge the threat that is the basis for the fear of liability. *MedImmune*, 549 U.S. at 128-29.

In this case, there is an actual and subsisting controversy between Renna and the County over the trademark protection to be afforded the Seal. Renna may seek a declaratory judgment under 28 U.S.C. §§ 2201-2202 to establish whether her use and display of the Seal violates the valid interests of the County.

II. THE COUNTY MAY NOT CLAIM TRADEMARK PROTECTION FOR ITS SEAL AND MAY NOT RESTRICT THE DISPLAY OF THE SEAL BY RENNA FOR A NON-COMMERCIAL PURPOSE

A. A Government Insignia Is Not Protected By Trademark Laws

Despite the claim in its September 17, 2010 letter that display of the Seal in connection with the production of "Union County Citizen's Forum" constituted an act of trademark infringement, and its later assertion that the Seal "is . . .

trademarked under Federal Law,”¹ the County is not entitled to restrict use or display of the Seal under federal trademark law. As pointed out to the County in the April 2011 letter on Renna’s behalf (Statement of Material Facts Not in Dispute ¶ 16; Comp. Exh. B), federal law specifically precludes trademark protection for the County Seal. Thus, 15 U.S.C. § 1052 provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

* * * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

The County is a subdivision of the State of New Jersey, *Shapiro v. Essex County Bd. of Chosen Freeholders*, 177 N.J. Super. 87, 98-99 (Law Div. 1980), and so its Seal falls within the exclusion of protection set forth in 15 U.S.C. § 1052(b).²

Any doubt on this score is removed by the decisions the County has received on its applications with the United States Patent and Trademark Office (USPTO) to have the Seal registered as a trademark. In June 2010, the County submitted an

¹ As discussed *infra*, at the time the County made this representation, it had already received a decision from the United States Patent and Trademark Office refusing registration of the Seal as a trademark because it was a government insignia (Statement of Material Facts Not in Dispute ¶ 19, Exh. 2).

² New Jersey law similarly precludes trademark protection for the flag or coat of arms or other insignia of the United States, or of any State or municipality. N.J. Stat. Ann. § 56:3-13.2(c).

application for the Seal of the County of Union (Statement of Material Facts Not in Dispute, ¶ 18, Exh. 1). On October 18, 2010, the USPTO issued an Office Action on the County's request for trademark registration on the Seal. The action provided that "[r]egistration is refused because the applied-for mark consists of an insignia of a U.S. municipality," and cited 15 U.S.C. § 1052(b). The October 18 action also noted that the cited statute is an "absolute bar to registration[.]"(Statement of Material Facts Not in Dispute, ¶ 19, Exh. 2).

Thereafter, the USPTO, upon a revived application for registration of the Seal of the County of Union, again refused registration. The August 24, 2011 USPTO Office Action adhered to the original determination that the Seal could not be registered as a trademark because it is an insignia of a state or municipality and registration is barred by 15 U.S.C. § 1052(b) (Statement of Material Facts Not in Dispute, ¶ 22, Exh. 4). On March 21, 2012, the USPTO issued a Notice of Abandonment with respect to the trademark application for the County's Seal (Statement of Material Facts Not in Dispute, ¶ 23, Exh. 5).

While the USPTO determination may not be binding, its determination is entitled to great weight and is persuasive authority that the Seal is not protectable under the trademark laws. *Syntex Laboratories, Inc. v. Norwich Pharmacal Co.*, 437 F.2d 566, 569 (2d Cir. 1971); *Closed Loop Marketing, Inc. v. Closed Loop Marketing LLC*, 589 F. Supp. 2d 1211, 1217 (E.D. Cal. 2008); *Schwan's IP, LLC*

v. Kraft Pizza Co., 379 F. Supp. 2d 1019, 1021-22 (D. Minn. 2005). There is no reason in the instant case not to follow the considered judgment of the USPTO that the County's Seal is not protectable by virtue of 15 U.S.C. § 1052(b). Therefore, it should be declared that Renna's use and display of the Seal does not infringe on the trademark rights of the County.

B. Renna's Use of the Seal Does Not Constitute Infringement

Even if the Seal were protectable under trademark laws, Renna's use of the Seal as a graphic display in connection with her production of the news and information show "Union County Citizen's Forum" is not a commercial use that could constitute infringement of the County's hypothetical rights. Renna displayed the Seal with the added element of a spotlight shining on it, expressing symbolically the purpose of "Union County Citizen's Forum" to shed light on the workings and activities of the County government (Statement of Material Facts Not in Dispute, ¶ 4). Renna does not receive any income as a result of the show; the rights to display "Union County Citizen's Forum" are not sold to others nor does she sell advertising time on the show (Statement of Material Facts Not in Dispute, ¶ 5).

In light of the fact that Renna's sole purpose in displaying the Seal is in connection with providing news, public information and education, her use cannot

be considered infringement. To constitute infringement, use of a trademark must be “in connection with the sale, offering for sale, distribution, or advertising of any goods or services.” 15 U.S.C. § 1114(1)(a). Thus, the U.S. District Court for New Jersey recently held as follows:

Case law also supports the proposition that infringing use is only illegal if it is done in connection with the defendant’s offer or provision of goods or services. In cases in multiple circuits, courts have held that individuals who use protected marks in the course of merely criticizing the trademark holders’ goods or services do not violate the Lanham Act. . . . Courts have identified multiple reasons for holding that the Act does not apply in this situation, the most important of which for the case at bar is that such speech does not fall within the purview of the act because it bears no connection to the provision of goods or services.

Howard Johnson Intern., Inc., 2010 WL 215381 at *6 (citing *Bosley Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 677-680 (9th Cir.2005)).

It is established that the trademark laws are meant “to protect the ability of consumers to distinguish among competing producers,” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992), not to prevent all unauthorized uses, and the case law emphasizes that trademark rights cannot be used “to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.” *Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research*, 527 F.3d 1045, 1052-53 (10th Cir. 2008) (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)); *Bosley*, 403 F.3d at 679. In *Utah*

Lighthouse Ministry, 527 F.3d at 1053, the court held that the use of a trademark on a website that was a parody and intended to criticize the trademark owner did not constitute infringement because the trademark use was not in connection with the provision of goods or services but in connection with expressing opinions about the trademark owner's activities.

The same reasoning and principle applies here and requires a decision that Renna's use of the Seal does not constitute trademark infringement. It is undisputed that Renna's display of the Seal was in connection with the reporting of news and information and that she sells no products or services in connection with the display (Statement of Material Facts Not in Dispute ¶¶ 4-5). Her use of the Seal in order to make a political statement concerning examination and criticism of the County's activities, and in particular those of the County's Board of Freeholders, is beyond the scope of trademark-related activities forbidden by the federal trademark laws. As such, Renna is entitled to a declaration that her display of the Seal in connection with news and information reporting is not a violation of the trademark laws.

III. RENNA HAS A FIRST AMENDMENT RIGHT TO DISPLAY THE SEAL IN CONNECTION WITH NEWS AND INFORMATION REPORTING AND THE COUNTY'S ASSERTION THAT SUCH DISPLAY IS TRADEMARK INFRINGEMENT VIOLATES RENNA'S RIGHT TO FREEDOM OF SPEECH

The fact that the County has sought to suppress Renna's expression, and in particular expression on matters of public concern involving the workings of local government, also raises serious constitutional questions. Indeed, courts have acknowledged that the trademark laws regulate and restrict speech and as such must not be extended too far lest they trample on fundamental rights protected by the Free Speech Clause of U.S. Const. amend. I. "While the First Amendment does not protect a competitor who labels his commercial good with a confusingly similar mark, such 'trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.'" *Farah v. Esquire Magazine, Inc.*, 863 F. Supp. 2d 29, 40-41 (D.D.C. 2012) (quoting *Bosley*, 403 F.3d at 677). As one court has held, "[w]ere we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment." *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

In this case, whether or not it has trademark rights in the Seal, the County deprived Renna of her First Amendment rights and chilled her in the exercise thereof by issuing its cease and desist letter and threatening her with legal action for engaging in constitutionally-protected political expression. That such a deprivation occurred in this case is shown by the decision in *Rothamel v. Fluvanna County, Va.*, 810 F. Supp. 2d 771 (W.D. Va. 2011), which also involved a county's attempt to prevent a citizen blogger from using a county seal in connection with news and information reporting. In ruling that the blogger had shown harm to his First Amendment rights, the court rejected the idea that an ordinance forbidding display of the county's seal had to have actually been enforced against the blogger in order for his First Amendment rights to have been harmed. The court noted that the Supreme Court has made clear that it is not necessary that a person expose himself to arrest or prosecution in order to challenge a law a violative of the First Amendment; a credible threat of present or future prosecution itself works an injury. *Id.* at 778. Application of this rule is particularly appropriate where the threat tends to chill the exercise of First Amendment rights. *Id.*

Renna was similarly injured in the exercise of her constitutional rights by the County's cease and desist letter and threat to impose trademark

liability on her if she used the Seal in her news and information reporting. Although the County here did not threaten a criminal sanction as in *Rothamel*, the Supreme Court indicated in *MedImmune, Inc.*, 549 U.S. at 128-29, that a threat to impose liability for violating intellectual property rights is the equivalent of a government threat to enforce a criminal statute. In doing so, the Court cited *Terrace v. Thompson*, 263 U.S. 197, 214 (1923), where the Court ruled that a person threatened with enforcement of a civil forfeiture statute could seek relief in federal court on the basis that enforcement would violate his constitutional rights. Even though the County here threatened enforcement of a civil statute against Renna, it still had the effect of chilling and infringing upon her exercise of First Amendment rights.

The *Rothamel* decision also demonstrates that Renna's use of the seal in connection with news and information reporting constitutes an exercise of her First Amendment rights. In *Rothamel*, 810 F. Supp. 2d at 783-84, the blogger asserted a right to display the seal next to blog entries reporting on activities of the county government, and the court agreed that the restriction on this activity was subject to First Amendment scrutiny. The Supreme Court has recognized that displays of government symbols by private persons as a means of commentary or political speech is expression

protected by the First Amendment even if the government has some interest in the symbol that is subject to protection. *See Spence v. Washington*, 418 U.S. 405 (1974)(public display of an upside-down flag to which a peace symbol had been attached was a form of expression protected by the First Amendment) and *Regan v. Time, Inc.*, 468 U.S. 641 (1984) (display of pictures of U.S. currency was expression for purposes of First Amendment). Renna’s display of the “spotlighted” County Seal falls comfortably within this precedent and must be considered constitutionally-protected speech.

The undisputed facts here show that the County improperly threatened enforcement of the trademark laws against Renna and this caused her to refrain from using the symbolic display of the spotlighted County Seal. Indeed, although the County’s April 21, 2011 reply to Renna’s request that the County renounce its claim to trademark protection for the Seal asserted that the Seal “is . . . trademarked under Federal Law” (Statement of Material Facts Not in Dispute ¶ 17; Comp. Exh. C), at the time it sent this letter it had already received a decision from the USPTO on its application for registration of the Seal refusing registration and informing the County that 15 U.S.C. § 1052 (b) is an “absolute bar to registration[.]” (Statement of Material Facts Not in Dispute ¶ 19, Exh. 2). Therefore, Renna is entitled to a judgment that the County deprived her of her First Amendment rights.

CONCLUSION

For the reasons set forth above, the Plaintiff, Tina Renna, respectfully requests that this Court grant her motion for summary judgment and enter an order declaring (1) that the Defendant County of Union, New Jersey, has no claim to trademark rights or protection with respect to the Seal of the County of Union, New Jersey, and (2) that the Plaintiff's display of the Seal of the County of Union, New Jersey in connection with the production, airing and/or broadcasting of news and information television shows does not constitute trademark infringement, and (3) that the Defendant deprived the Plaintiff of her First Amendment rights in threatening enforcement of the trademark laws against the Plaintiff with respect to Plaintiff's display of the Seal of the County of Union, New Jersey.

Respectfully submitted,

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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

TINA RENNA,	: CIVIL ACTION No. 11-3328 (KM) (MAH)
<i>Plaintiff,</i>	:
	:
-vs-	: CERTIFICATE OF SERVICE
	:
THE COUNTY OF UNION,	:
NEW JERSEY,	:
<i>Defendant.</i>	:

The undersigned hereby certifies that on October 11, 2013, a true copy of the Brief in Support of Plaintiff’s Motion for Summary Judgment was served upon Defendant’s counsel of record by operation of the Court’s CM/ECF system.

Law Office of Walter M. Luers, LLC
By: /s Walter M. Luers

Dated: October 11, 2013

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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

	:	
TINA RENNA,	:	Civil Action No. 11-3328 (KM) (MAH)
<i>Plaintiff,</i>	:	
	:	LOCAL RULE 56.1(A)
-vs-	:	STATEMENT OF MATERIAL
	:	FACTS NOT IN DISPUTE
THE COUNTY OF UNION,	:	
NEW JERSEY	:	
<i>Defendant.</i>	:	
	:	

This statement is submitted in support of Plaintiff’s Motion for Summary Judgment.

1. The Plaintiff, Tina Renna (hereafter “Renna”), is an adult citizen of the United States and a resident of the Township of Cranford, Union County, New

Jersey (Comp. ¶ 1; Ans. ¶ 1; Renna Declaration ¶1 (attached hereto as Exhibit 6 (hereafter “Renna Dec.”))).

2. The Defendant, The County of Union, New Jersey (hereafter “the County”), is a body politic and corporate, created and existing under the laws of the State of New Jersey. The County and its officers and agents acted and will act under color of the law of the State of New Jersey (Comp. ¶ 2; Ans. ¶ 2).

3. Beginning in December 2009, Renna produced the television show “Union County Citizen’s Forum,” which aired and was shown on the Township of Cranford’s public access cable channel, Channel 35, a.k.a, TV35. “Union County Citizen’s Forum” is a news and information show and consisted primarily of a reading of the resolutions presented at the meetings of the Union County Board of Chosen Freeholders (Comp. ¶ 6; Ans. ¶ 6; Renna Dec. ¶ 3).

4. From the inception of “Union County Citizen’s Forum” until September 2010, Renna included a graphic illustration of the Seal of the County of Union (hereinafter “the Seal”) with a light shining on it to symbolize the purpose of the television show, which is to shed light on the workings of the County of Union government. This graphic illustration of the Seal was visible behind Renna as she read resolutions or interviewed guests (Comp. ¶ 11; Ans. ¶ 11; Renna Dec. ¶ 4).

5. Renna did not, and does not intend to, receive any monetary compensation as a result of producing and airing “Union County Citizen’s Forum” or the Seal (Renna Dec. ¶ 5).

6. A pictorial representation of the Seal is attached hereto and included within Exhibit 1.

7. Renna has been an outspoken critic of the County’s governing body, the Union County Board of Chosen Freeholders (Comp. ¶ 7; Ans. ¶ 7).

8. In a letter dated September 17, 2010 addressed to the Township of Cranford and signed by Union County Counsel Robert E. Barry, the County of Union demanded that the Township of Cranford cease and desist any display of the Seal of the County of Union in any way, including all television shows, asserting that a trademark for the Seal was pending and the display constitutes trademark infringement. The letter asserted that any display of the seal without the authorization of the County constitutes trademark infringement (Comp. ¶ 12, Exh. A; Ans. ¶ 12).

9. The reference line of the September 17, 2010 letter specifically referred to “Union County Citizens Forum,” the television show Renna aired on the Township of Cranford’s public access cable station TV35 (Comp. ¶ 12, Exh. A).

10. On September 21, 2010, Karen Durana, Executive Secretary Administration of the Township of Cranford, sent an e-mail message to Renna informing Renna of the existence of the September 17 letter, the demand made by the County that the Seal not be displayed on television shows, and the County's assertion that such display constitutes trademark infringement (Renna Dec. ¶ 6).

11. Thereafter, Renna discussed the letter and the County's assertion of trademark protection over the Seal with TV35's station manager Ed Davenport. Davenport asked that Renna not use the display of the spotlighted Seal because of the County's cease and desist letter (Renna Dec. ¶ 8).

12. At the time Renna was told about the September 17 cease and desist letter, TV35's facilities were undergoing renovation and Renna was not producing or taping episodes of "Union County Citizen's Forum" (Renna Dec. ¶ 7).

13. In January 2011 after renovations of the TV35 facilities were complete, Renna resumed taping episodes of "Union County Citizen's Forum" at the TV35 facilities for airing on TV35. However, because of the threat contained in the September 17 cease and desist letter and the fear of legal liability, Renna did not use the spotlighted Seal graphic. Instead, she used a picture of the Union County Manager with a spotlight on it (Renna Dec. ¶ 9).

14. On February 8, 2011, Renna received an e-mail message from Davenport notifying her that he had been contacted by the Cranford Township

attorney, and the attorney had asked that Renna remove the image of the County Manager from the graphic used on “Union County Citizen’s Forum” (Renna Dec. ¶ 10).

15. Thereafter, Renna sought legal advice concerning her right to use the Seal on her news and information show and the validity of the County’s claim to trademark protection for the Seal (Renna Dec. ¶ 11).

16. In a letter dated April 5, 2011 on behalf of Renna to Union County Counsel Barry, The Rutherford Institute asserted that the County’s claim to trademark protection for the Seal was unfounded and that Renna had a right under the First Amendment to use and depict the seal as she had been doing in the production of “Union County Citizen’s Forum.” The letter advised County Counsel Barry of federal and state trademark statutes that forbid trademark registration on insignias of states and municipalities. The Rutherford Institute letter also cited to court decisions holding that a trademark may only be claimed in connection with the production and sale of tangible goods, that use of a trademark must be for a commercial purpose in order to constitute infringement, and that the First Amendment protects the use of trademarks for expressing ideas or points of view. The letter demanded that the County withdraw its claim to trademark protection over the Seal and its demand that TV35 and Renna cease and desist display of the Seal (Comp. ¶ 18, Exh. B; Ans. ¶ 18).

17. The County responded in a letter dated April 21, 2011, signed by First Deputy County Counsel Norman W. Albert. Albert wrote on behalf of the County that the seal of the County of Union “is: (1) trademarked under Federal Law and the New Jersey statute you cite precludes use of the Counties [sic] insignia by others[.]” The letter also asserted that the County’s claim to trademark protection and cease and desist demand do not chill or inhibit the Plaintiff’s First Amendment rights (Comp. ¶ 19, Exh. C; Ans. ¶ 19).

18. On July 10, 2010, the County of Union submitted an application with the United States Patent and Trademark Office (hereinafter “USPTO”) requesting trademark registration for the Seal of the County of Union. A copy of that application is attached hereto as Exhibit 1, and on file with the USPTO under Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=APP20100702100015#docIndex=12&page=1>.

19. On October 18, 2010, the USPTO issued an Office Action on the County’s request for trademark registration on the Seal. The action provided that “[r]egistration is refused because the applied-for mark consists of an insignia of a U.S. municipality,” and citing 15 U.S.C. § 1052(b). The October 18 action also noted that the cited statute is an “absolute bar to registration[.]” A copy of this Office Action is attached hereto as Exhibit 2, is on file with the USPTO under

Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=OOA20101018131116#docIndex=8&page=1>.

20. On May 16, 2011, the USPTO issued a Notice of Abandonment on the County's trademark registration application for the Seal. A copy of this Notice of Abandonment is attached hereto as Exhibit 3, is on file with the USPTO under Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=NOA20110516223221#docIndex=7&page=1>.

21. On July 13, 2011, the County submitted a Petition to Revive the trademark registration application for the County Seal, which was accepted and the application was revived to pending status. A copy of this Petition to Revive is on file with the USPTO under Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=POA20110713181347#docIndex=5&page=1>.

22. On August 24, 2011, the USPTO issued an Office Action on the revived application. The action adhered to the original determination that the Seal could not be registered as a trademark because it is an insignia of a state or municipality and registration is barred by 15 U.S.C. § 1052(b). A copy of this Office Action is attached hereto as Exhibit 4, is on file with the USPTO under

Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=OOA20110824110957#docIndex=1&page=1>.

23. On March 21, 2012, the USPTO issued a Notice of Abandonment with respect to the trademark application for the County's Seal. The Notice advised that any petition to revive the application had to be filed within two months of the notice. A copy of this Notice of Abandonment is attached hereto as Exhibit 5, is on file with the USPTO under Serial No. 76703608, and is available for viewing at <http://tsdr.uspto.gov/documentviewer?caseId=sn76703608&docId=NOA20120321223017#docIndex=0&page=1>

24. As a result of the County's continuing claim to trademark protection in the Seal and the fear that a legal action would be brought against her if she used or displayed the spotlighted Seal graphic, Renna continued to refrain from using the spotlighted Seal graphic in connection with the production of "Union County Citizen's Forum" (Renna Dec. ¶ 14).

25. In or about February 2011, the management of TV35 presented Renna with a "Producer Agreement and Indemnification Agreement." The terms of this Agreement required that Renna, as a Producer of a program aired on TV35, would "indemnify, defend and hold and save harmless" the Township of Cranford and

TV35 for any and all claims, demands or lawsuits “in any way arising from, related to, connected with or occasioned by” the program I produce and air on TV35. The proposed agreement to indemnify included any claims for “copyright, trademark, patent or other intellectual property right infringement, and similar claims, and any other claims.” (Renna Dec. ¶ 15).

26. Renna was told by the TV35 management that my execution of the “Producer Agreement and Indemnification Agreement” was required in order for her to air “Union County Citizen’s Forum” on TV35 (Renna Dec. ¶ 16).

27. Because of the breadth of the indemnification agreement demanded by TV35 and the risk of personal liability it placed on her because of the County of Union’s assertion that it has a trademark on the Seal, Renna refused to sign the “Producer Agreement and Indemnification Agreement” (Renna Dec. ¶ 17).

28. Renna desires to resume producing and airing “Union County Citizen’s Forum” on TV35 and would do so if it were declared by a court of competent jurisdiction that the County of Union has no trademark rights to claim in the Seal and may not restrict depictions or uses of the seal in connection with the dissemination of news and information (Renna Dec. ¶ 18).

Respectfully submitted,

/s Walter M. Luers
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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

TINA RENNA,	:	CIVIL ACTION No. 11-3328 (KM) (MAH)
<i>Plaintiff,</i>	:	
	:	
-vs-	:	CERTIFICATE OF SERVICE
	:	
THE COUNTY OF UNION,	:	
NEW JERSEY,	:	
<i>Defendant.</i>	:	

The undersigned hereby certifies that on October 11, 2013, a true copy of the Local Rule 56.1(a) Statement of Material Facts Not in Dispute in Support of Plaintiff’s Motion for Summary Judgment was served upon Defendant’s counsel of record by operation of the Court’s CM/ECF system.

Law Office of Walter M. Luers, LLC

By: /s Walter M. Luers

Dated: October 11, 2013