

No. 16-352

IN THE
Supreme Court of the United States

SECURITY UNIVERSITY, LLC, *et al.*,

Petitioners,

v.

INTERNATIONAL INFORMATION SYSTEMS
SECURITY CERTIFICATION CONSORTIUM, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

The Respondent owns the registered *certification mark* CISSP, used to denote an individual who has met certain requirements and standards of competency in the information security field. The Petitioner advertised that the instructor for its training services was a MASTER CISSP and CISSP MASTER. The Respondent claims these uses of MASTER CISSP and CISSP MASTER were likely to confuse consumers as to whether Petitioner's instructor had attained a new or advanced level of certification from the Respondent. The Second Circuit reversed the district court below because it took an erroneously narrow view of the types of confusion that can be at issue under the Lanham Act, and the ways in which *certification marks* may be infringed. It also became the first, and only, Court of Appeals to consider the issue of nominative fair use in the *certification mark* infringement context. The question presented is:

Where an individual describes the instructor for its training services using an altered certification mark, can such use of an altered certification mark be likely to cause consumer confusion as to whether the instructor had attained a new or advanced level or certification from the mark's owner?

CORPORATE DISCLOSURE STATEMENT

International Information Systems Security Certification Consortium, Inc. (“ISC²”) has no parent corporation, and no publically held company owns 10% or more of its stock.

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INTRODUCTION

This is a certification mark infringement case, not a trademark infringement case. While under the Lanham Act the term “mark” generally encompasses both, they are not the same thing. *See* 15 U.S.C. § 1127. They do not mean the same thing. They are not used in the same way. And, importantly, this distinction was significant to the Second Circuit’s holdings below. Pet App. 14a.

Yet, as evidenced by their Question Presented, the Petitioners disregard the fundamental distinction set forth in the text of the Lanham Act, and ask this Court to enunciate a legal standard applicable to the use of a *trademark* instead of a *certification mark*. The precise legal contours of nominative fair use under the Lanham Act for a trademark infringement case are not even implicated given the factual and legal basis of ISC²’s *certification mark* infringement claim.

Moreover, the Second Circuit advanced three independent grounds for reversal of the district court’s opinion. The petition challenges only the third of these independent errors, and does so only obliquely based on the imprecise and inaccurate framing of the issue. On remand, correction of the first two errors will drive the outcome in ISC²’s favor, and regardless of any doctrinal differences in the Circuit Courts of Appeals as to nominative fair use, this case ends the same.

Finally, even were the issue of nominative fair use presented for the Court’s consideration, this case is an exceedingly poor vehicle for addressing it. Neither the Second Circuit nor the district court have yet to apply

the Second Circuit's test. Moreover, it is an open question whether there is a meaningful difference in outcomes between the Second Circuit's test and others. Petitioner says there will be, but that is an empirical claim with no supporting evidence. Indeed, a page of history is worth a volume of logic. But it takes time for that history to be written. The Petition for a Writ of Certiorari should be denied.

STATEMENT OF THE CASE

A. FACTUAL BASIS FOR ISC²'s CLAIMS

ISC² is a non-profit organization that was formed in 1989 to develop standards for the information security industry. Pet. App. 6a. In March 1990, ISC² developed a certification program and began using¹ the certification mark "CISSP®" to denote a "Certified Information Systems Security Professional" who has met certain requirements and standards of competency in the information security field, including passing the CISSP® certification examination that ISC² administers. Pet. App. 6a.

ISC² grants licenses to use the CISSP mark to individuals who pass ISC²'s examination and otherwise meet its certification standards. Pet. App. 7a-8a n.1. The

1. On March 18, 1997, the United States Patent and Trademark Office registered ISC²'s CISSP® certification mark. Pet. App. 7a. The registration states: "The [CISSP®] certification mark is used by persons authorized by the certifier [ISC2] to certify completion of appropriate work experience and/or successfully passing examinations as established by the certifier in the field of security of information systems." *Id.*

license is governed by ISC²'s written Regulations, which prohibit certified individuals from either combining the CISSP mark with any of object, logic, icon, word, or graphic, or using the CISSP mark in any way that expresses or might imply any other affiliation, sponsorship, endorsement, certification, or approval besides receiving the CISSP certification. *Id.*

SU is a for-profit company formed by Sondra Schneider that offers various classes in the information security field, including a class to prepare individuals for ISC²'s CISSP certification examination. Pet. App. 7a. Importantly, it is undisputed that SU is allowed to use the CISSP mark to indicate that its services are directed to preparing students for the CISSP certification examination. *Id.* Moreover, it is undisputed and obvious that SU instructors, such as Schneider and Clement Dupuis, may accurately identify themselves as being CISSP-certified so long as they follow ISC²'s regulations. *Id.*

However, between May 2010 and 2012, SU engaged in an advertising campaign to seek to obtain an unfair advantage over other CISSP-certified individuals offering instruction classes by misrepresenting the credentials of one of its instructors, Clement Dupuis. Pet. App. 8a-9a. Specifically, SU began holding Dupuis out to the public as a "Master CISSP" or a "CISSP Master" so as to suggest that he had received some higher-level certification from ISC² (which in fact does not exist) so that individuals would be more likely to seek instruction from him. *Id.* For example, the advertisements state: "Register for CISSP® Prep class with Master CISSP Clement Dupuis today!" or "You are taught by CISSP Master Clement Dupuis" or "Master CISSP June 27-30 ... with MASTER CISSP®

Instructor Clement Dupuis.” *Id.* In order to protect the integrity and value of ISC²'s mark, ISC² needed to take action to stop this misleading advertising.

On June 9, 2010, ISC²'s counsel wrote to Schneider demanding that she cease using the phrase “Master CISSP” in SU's advertisements. Pet. App. 9a. Schneider responded by stating that “SU will continue to use the word Master. Master Clement Dupuis is a Male Teacher [and] thus he is a Master according to the dictionary.” *Id.* Notably, this explanation for SU's deceptive advertising is inconsistent, for example, with its ad referring to “MASTER CISSP® **Instructor** Clement Dupuis.” Counsel for ISC² again wrote to Schneider “requesting that she and SU cease and desist their improper advertising.” Pet. App. 9a. Nonetheless, SU continued at least until 2012. *Id.*

B. PROCEEDINGS IN THE DISTRICT COURT

ISC² filed its complaint against SU and Schneider on August 3, 2010, alleging, in relevant part, claims for infringement of a registered certification mark under 15 U.S.C. § 1114 and false advertising under 15 U.S.C. § 1125(a) based on the Petitioners confusing or deceptive use of “Master CISSP” as discussed above. Pet. App. 10a. The United States District Court for the District of Connecticut granted Petitioners' motion for summary judgment on August 7, 2014 based on the doctrine of nominative fair use. Pet. App. 10a-11a.

Critical to the district court's substantive analysis was its conclusion that “Defendants' addition of the word ‘Master’ before or after ‘CISSP®’ does not implicate the protection afforded by trademark *infringement*

laws, which are concerned with whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or indeed simply confused, as to the *source* of the goods in question.” Pet. App. 11a (emphasis in district court’s opinion as well). The court reasoned that “it is hard to imagine a case in which use of a certification mark by a person who has met the requirements for certification would likely lead to confusion as to source or origin, or would not be a nominative fair use.” Pet. App. 12a. It emphasized that none of the Petitioner’s advertisements “include[] language suggesting that (ISC)² itself is offering the classes.” Pet. App. 53a. Indeed, the court thought ISC²’s concession that it did not “argue that consumers would be confused that SU is the source of its own training courses” was fatal. Pet. App. 54a. Therefore, it was undisputed that “no one viewing Defendants’ advertisements referring to ‘Master CISSP®’ was likely to think that Plaintiff itself was offering classes to pass its own exam.” Pet. App. 55a.

In other words, the district court found that ISC²’s claim failed “because there is no confusion as to source or origin The trademark infringement laws protect against confusion as to the source or origin of a product, not confusion about a product.” Pet. App. 60a-61a n.6. Thus, since the district court found no evidence that people would be confused “about the identity of the entity offering” the training courses, summary judgment was entered in Petitioners’ favor. *Id.*

C. THE SECOND CIRCUIT'S OPINION

ISC² appealed to the United States Court of Appeals for the Second Circuit. Pet. App. 2a. The Second Circuit reversed and remanded based on three separate errors. First and most importantly, the Second Circuit found error in that the district court “held that the only type of confusion relevant in determining infringement is confusion as to *source*,” when the statute also explicitly protects against consumer confusion as to “sponsorship, affiliation or connection,” for example. Pet. App. 18a. “As is plain from [the] statutory text, the [Lanham] Act’s protection against infringement is not limited to any particular type of consumer confusion, much less exclusively to confusion as to source.” Pet. App. 19a. This basis alone was sufficient to reverse and remand to the district court to reassess Petitioners’ summary judgment motion.

Second, according to the Second Circuit, “the district court also took an erroneously narrow view of how certification marks can be infringed.” Pet. App. 22a. The district court believed that a certification mark could only be infringed in two ways: (i) using the mark on goods or services which have not been certified and (ii) establishing a confusingly similar certification system and mark. Pet. App. 23a. The district court reasoned that Petitioners’ use of the mark with respect to Dupuis’ credentials met neither standard because Dupuis is, in fact, CISSP-certified and was not attempting to set up a competing certification system. The Second Circuit disagreed. “Even though neither ISC² nor SU offers a ‘Master CISSP’ or ‘CISSP Master’ certification, customers may be led to believe ISC² has introduced a new line of certifications”

that Clement Dupuis has attained. Pet. App. 26a. While this ground for reversal was also outcome-determinative, Petitioners do not claim any error in the Second Circuit's analysis in this regard.

Finally, the Second Circuit explained how claims of nominative fair use are to be evaluated. It rejected the Third Circuit's view that nominative fair use is an affirmative defense because the Lanham Act itself lays out its affirmative defenses, and nominative fair use is not among them. Pet. App. 31a-33a. Then, with recognition that the Lanham Act's language is broad and encompassing in its protection against "any" type of consumer confusion, Pet. App. 19a, the Second Circuit sensibly and correctly held that any and all factors bearing on such confusion must be assessed, even where a defendant claims nominative fair use. Pet. App. 33a-37a. To be sure, the Ninth Circuit's nominative fair use factors will often play an important role in this analysis. Pet. App. 35a. However, it would be imprudent at the outset to limit the factors that can be considered, given the broad statutory language against consumer confusion and the myriad of unforeseeable commercial situations the Lanham Act was meant to govern. The Court therefore remanded the case to the district court for reconsideration of its ultimate conclusion as to confusion in view of any and all relevant factors and in view of the Second Circuit's corrections on the first two legal points. Pet. App. 37a.

Petitioners now seek a writ of certiorari limited to the intricacies of the third ground of the Second Circuit's decision without disputing that the district court erred in the first two ways identified by the Court of Appeals.

REASONS FOR DENYING THE PETITION

This case is an exceedingly poor vehicle to address the issue presented in the petition. First, this case is the first and only time that a Circuit Court of Appeals has passed upon the issue of nominative fair use in the context of a claim of certification mark infringement. Second, the Second Circuit advanced two independent errors that are unchallenged in the Petition that will resolve this case in ISC²'s favor on remand. Third, neither the Second Circuit nor the district court has applied the Second Circuit's test. Thus, the Petitioners offer little more than speculation as to whether there will be a meaningful difference in outcomes between the various tests. At a minimum this Court should wait for a case in which it need not guess whether it is even deciding an issue that is meaningful to the outcome of the parties' litigation. The Petition should be denied.

I. The Second Circuit is the Only Circuit to Discuss Nominative Fair Use in a Certification Mark Infringement Case.

As discussed above, the Petitioners frame their Question Presented in a manner that does not fit the facts of this case. It is undisputed that this is a *certification mark* infringement case (*see* Pet. at 5), yet the Petitioners ask the Court to resolve the standard for nominative use of a *trademark*. This imprecision is not surprising, though, because neither the Petitioners nor the Amicus have a single certification mark case to cite to this Court, let alone a certification mark case involving an alleged nominative use.

Notably, the Second Circuit’s discussion began by distinguishing between certification marks and trademarks. Pet. App. 14. This distinction was clearly foundational to its analysis. It ultimately “remand[ed] for reconsideration of the *Polaroid* factors in addition to the nominative use factors, keeping in mind the numerous types of confusion that are relevant to an infringement analysis other than mere source confusion and the numerous ways in which a certification mark may be infringed.” Pet. App. 37a. Thus, there is no split over the proper standard for analyzing whether a defendant’s use of a certification mark is likely to cause consumer confusion where a defendant claims to be using the mark nominatively. Only one Circuit has passed upon that issue of which the Respondent is aware.

Moreover, neither the Petitioners nor the Amicus clearly explain how the split they set forth is directly implicated given the factual context of this case, instead choosing to frame the issue in a manner inconsistent with the undisputed facts. Given this posture, the only way to reach the Petitioner’s Question Presented is for the Court to wade into the facts. But this Court does not “grant a certiorari to review evidence and discuss specific facts.” *United States v. Johnston*, 268 U.S. 220, 227 (1925). The Petition should be denied.

II. Due to the Additional Independent Grounds for Reversal Below, the Issue of Nominative Fair Use Is Not Implicated by This Case.

The precise contours of nominative fair use are simply not dispositive for this case. The Second Circuit advanced three independent grounds for reversal: (1) the district

incorrectly held that the only type of confusion relevant to infringement is confusion as to source, Pet. App. 18a; (2) the district court took an erroneously narrow view of the circumstances under which a certification mark can be infringed, Pet. App. 22a; and (3) the district court applied the incorrect standard for nominative use, Pet. App. 37a. On remand, a resolution of the first two errors will drive resolution of the third, under any standard.

The Second Circuit held that the district court incorrectly focused exclusively on source confusion. Immediately, the Second Circuit recognized that considering source confusion in the certification mark context makes “little sense” because certification marks, as opposed to trademarks, are not generally source designators. Pet. App. 18a. The Second Circuit correctly observed that the Lanham Act applies to “any” type of consumer confusion. Pet. App. 19a.

The Second Circuit also held that the district court took an erroneously narrow view of the circumstances under which a certification mark can be infringed. The district court believed that a certification mark could be infringed only in two ways: (i) using the mark on goods or services which have not been certified and (ii) establishing a confusingly similar certification system and mark. Pet. App. 23a. The Second Circuit soundly rejected both of the district court’s limitations. Pet. App. 22a-27a.

As to the district court’s first limitation, the Second Circuit found persuasive the Trademark Board’s reasoning in *Tea Board of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881 (T.T.A.B. 2006). Pet. App. 24a. There, the Trademark Board held that the mark

“Darjeeling Nouveau” was confusingly similar to the mark “Darjeeling.” Pet. App. 25a. It was not material to the Trademark Board’s consideration that the “Darjeeling Nouveau” tea was entirely genuine “Darjeeling” tea. Pet. App. 25a. Thus, the Second Circuit reasoned:

Just as it would infringe the “Darjeeling” certification mark for a competitor to identify genuine, certified Darjeeling tea with its own composite mark “Darjeeling Nouveau,” *id.*, the district court erred in failing to consider that SU may have infringed on ISC²’s certification mark by identifying its certified instructor as “Master CISSP” and “CISSP Master.”

Pet. App. 26a.

As to the second limitation, the Second Circuit concluded that “it is not a prerequisite to ISC²’s claim of infringement ‘that the defendant was using the allegedly infringing content as a certification mark.’” Pet. App. 26a. Rather, the Second Circuit said that “[e]ven though neither ISC² nor SU offers a ‘Master CISSP’ or ‘CISSP Master’ certification, customers may be led to believe ISC² has introduced a new line of certifications” that Clement Dupuis has attained. Pet. App. 26a.

Applying the Second Circuit’s above teachings to this case leads to the conclusion that on remand the district court will conclude that a reasonable finder of fact could find that SU infringed ISC²’s CISSP mark by advertising that Clement Dupuis was a “Master CISSP” or “CISSP Master.” Indeed, the Petitioners’ advertising is likely to confuse consumers as to *Clement Dupuis*’ affiliation or

sponsorship with ISC² regardless of whatever consumers think about the source, sponsorship, or affiliation of Security University's courses themselves.

The confusion from SU's use is apparent from the questions it obviously poses: What is a "MASTER CISSP"? Is it a higher level of certification than just a CISSP? How do you become a "MASTER CISSP"? As discussed above, the Second Circuit grasped the confusing nature of SU's use, and explained that "[e]ven though neither ISC² nor SU offers a 'Master CISSP' or 'CISSP Master' certification, customers may be led to believe ISC² has introduced a new line of certifications" that Clement Dupuis has attained. Pet. App. 26a. Of course, this is the very type of confusion at the core of the Lanham Act's purpose. *See* 15 U.S.C. § 1127. The prospect of being taught by a MASTER CISSP, a certification ISC² does not provide, gives SU an unfair competitive advantage and weakens the value of the CISSP mark to those individuals using the mark properly to ply their trade honestly and without the deception present in SU's ads.

Yet, while not purporting to challenge these aspects of the Second Circuit's ruling, Petitioners continue to misstate the type of confusion at issue in this case. The Petitioners claim that "[a]ccording to the Second Circuit, the district court failed to consider whether Security University's uses were likely to confuse consumers as to (ISC)²'s 'affiliation' with or 'sponsorship' of Security University's courses." Pet. at 35. The Second Circuit, decidedly, did not say that district court failed to consider whether consumers would be confused about ISC²'s sponsorship or affiliation of SU's courses. Rather, as mentioned above, the Second Circuit said that confusion is

not limited to any specific type, Pet. App. 19a, but instead, for example, that confusion could include confusion as to whether ISC² had introduced a new line of certification that SU's instructor had attained from ISC², Pet. App. 26a. ISC² has repeatedly conceded that SU can use the CISSP mark to advertise that it provides preparation classes for the CISSP exam. Pet. App. 7a. ISC² did so in the district court, in the Second Circuit, and again now. In contrast to this mischaracterization of its claim, ISC² takes issue with SU advertising Clement Dupuis as a "MASTER CISSP," a confusing representation as to a certification that ISC² does not offer and which Clement Dupuis has not attained.

Nonetheless, it is not surprising that the Petitioners cling to this mischaracterization of ISC²'s claim because, when the claim is properly framed, the significance of the standard for nominative fair use simply dissolves. Ultimately, each nominative use test addresses whether the alleged infringer did something in conjunction with the mark that was confusing. *See, e.g., New Kids on the Block v. News Am. Pub., Inc.*, 971 F.3d 302, 308 (9th Cir. 1992) ("[Third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder."); *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 ("Does the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services?"); Pet. App. 35a ("[W]hether the defendant did anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the plaintiff holder, that is, whether the defendant's conduct or language reflects the true and accurate relationship between plaintiff's and defendant's products or services.").

Here, SU did something with the mark that a reasonable finder of fact could find was likely to cause confusion by adding the word “MASTER.” Application of any nominative fair use test is not going to be the main event on remand. Rather, correction of the district court’s first two errors will necessarily drive the conclusion on the third issue regardless of what the precise formulation of the test might be. Therefore, ISC² simply has little interest in litigating this issue, and the Court should deny the Petition. *See The Monrosa v. Carbon Black Export, Inc.*, 359 U.S. 180, 184 (1959) (“While this Court decides questions of public importance, it decides them in the context of meaningful litigation. Its function in resolving conflicts among the Courts of Appeals is judicial, not simply administrative or managerial. Resolution here of [the doctrine of nominative fair use] can await a day when the issue is posed less abstractly.”).

III. This Case Is an Exceedingly Poor Vehicle for Resolving the Issue.

Petitioner does not suggest that the Second Circuit’s nominative use test strays from the ultimate inquiry of “likelihood of confusion,” but instead complains that the Second Circuit’s test is (1) likely to dilute protection of nominative uses, Pet. at 30, and (2) likely to produce inconsistent results, Pet. at 33. At bottom, Petitioner’s arguments are largely empirical claims. Tellingly, however, the Petitioner focuses on what they *believe* are “likely” outcomes, rather than relying on evidence of “actual” outcomes to support their arguments. The lack of evidence is not surprising, though, as neither the Second Circuit nor the district applied the Second Circuit’s test. There is not, therefore, a defined body of caselaw that

would be necessary to support a claim that something is “likely” to occur. Indeed, one is left with the sense that the Petitioners are offering a solution in search of a problem, as they do not even claim that they will lose this case on remand as it stands. Under these circumstances, the Court should decline review and allow the courts below to apply the Second Circuit’s test so that this Court may have a fully developed and defined body of law upon which to base its judgment. *See McCray v. New York*, 461 U.S. 961, 963 (1983) (Stevens, J.) (“[I]t is a sound exercise of discretion for the Court to allow the various [Circuit Courts of Appeals] to serve as laboratories in which the issue receives further study before it is addressed by this Court.”). The Petition should be denied.

CONCLUSION

For all of the above reasons, ISC² respectfully requests that the Court deny the petition for a writ of certiorari.

Respectfully Submitted,

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