

FILED

DEC - 9 2004

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

NANCY MAYER WHITTINGTON, CLERK
U.S. DISTRICT COURT

AMERICAN CHEMICAL SOCIETY
1155 16th Street NW
Washington, DC 20036,

Plaintiff,

v.

GOOGLE, INC.
160 Ampitheatre Parkway, Bldg. 41
Mountain View, California 94043,

Defendant.

Civil Action

CASE NUMBER 1:04CV02131

JUDGE: Reggie B. Walton

DECK TYPE: General Civil

DATE STAMP: 12/09/2004

JURY
ACTION

**COMPLAINT AND JURY DEMAND FOR TRADEMARK
INFRINGEMENT AND UNFAIR COMPETITION**

Plaintiff American Chemical Society ("ACS" or "Plaintiff"), by its undersigned attorneys, alleges as follows, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters:

Nature of the Action

1. This is a civil action for trademark infringement and unfair competition arising under federal and District of Columbia common law. ACS brings this action against Defendant Google, Inc. because Google recently launched a new research tool directed to scientists under the trademark SCHOLAR. This use infringes ACS's federally registered SCIFINDER SCHOLAR trademark and common-law SCHOLAR mark, both of which ACS has used for the very same services.

The Parties

2. ACS is a not for profit corporation of the United States organized and existing under an act of Congress, Public Law 358, 75th Congress, first Session, with a principal place of business at 1155 16th Street NW, Washington, DC 20036. See 36 U.S.C. § 20501, et seq.

3. Defendant Google, Inc. is a Delaware corporation with a principal place of business at Building 41, 160 Amphitheatre Parkway, Mountain View, California 94043 (“Google”).

Jurisdiction and Venue

5. This action arises under the federal Trademark Act, 15 U.S.C. § 1051, *et. seq.*, and under the common law of the District of Columbia. Subject matter jurisdiction over this action is conferred upon this Court by 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and (b). Pursuant to 28 U.S.C. § 1367, this Court has supplemental jurisdiction over Plaintiff’s common-law claims because those claims are substantially related to Plaintiff’s federal Lanham Act claims.

6. This court has personal jurisdiction over Defendant, and venue is proper in this District pursuant to 28 U.S.C. § 1391(b) and (c), because Plaintiff is being harmed in this District, Google is doing business in this District, and Google is using the infringing SCHOLAR mark in this District.

ACS and its SCIFINDER SCHOLAR and SCHOLAR Trademarks

7. ACS is an internationally known professional and scientific society that provides, among other services, scientific and technical information, primarily in the field of chemistry and related disciplines, to the scientific community. ACS disseminates information through printed publications, electronic media (including the Internet), committee work, and other ways.

8. ACS's Chemical Abstracts Service ("CAS") division comprises hundreds of scientists and technical professionals whose mission is to create and deliver the most complete and effective digital information environment for scientific research and discovery.

9. Since 1907, CAS has indexed and summarized chemistry-related articles from more than 40,000 scientific journals, in addition to patents, conference proceedings, and other documents relating to chemistry, life sciences, and many other scientific fields. In total, abstracts for more than 24 million documents are accessible online through CAS. CAS offers a variety of search tools (including computer research tools) to navigate and access its immense database of scientific literature and materials.

10. One of CAS's core products is its SCIFINDER SCHOLAR research tool. First offered in early 1998, SCIFINDER SCHOLAR is an online, scientific and technical information research tool for scientists, faculty, and students in academic institutions. It allows scientists to explore research topics and browse journal and patent references, substance information, regulated chemicals, chemical reactions, and chemical supplier information through CAS's high quality, world leading chemistry and related scientific

information databases. Among other things, the SCIFINDER SCHOLAR research tool allows users to conduct searches by author, keyword, (sub)structure, sequence, and more, and to analyze, sort, and visualize results. Scientists can also link on the web to the full-text documents of more than 5,400 scientific journals from 270 scientific, technical, and medical publishers.

11. The SCIFINDER SCHOLAR online research product has long been a mainstay in the scientific community and is licensed to nearly 1,000 universities and colleges in the United States and around the world. SCIFINDER SCHOLAR is used by more than 100,000 scientists, researchers, students, graduate students and professors.

12. ACS owns Federal Trademark Registration No. 2,712,735 for a design version of its SCIFINDER SCHOLAR mark for “providing an online computer database in the scientific and technical information fields” and “computer software enabling users to locate and access scientific and technical information on an electronic database and to browse and search on-line scientific and technical literature, together with manuals sold therewith.” That registration issued on May 6, 2003.

13. Plaintiff and users of the SCIFINDER SCHOLAR research tool often refer to the product simply as “SCHOLAR.”

14. Since its first use of its SCIFINDER SCHOLAR and SCHOLAR marks, ACS has advertised and promoted its marks and services in a variety of media, including, for example in trade publications, at trade shows and conferences, on the Internet.

15. Plaintiff has established considerable and valuable trademark rights and goodwill in its SCIFINDER SCHOLAR and SCHOLAR marks by virtue of its long use

of those marks, substantial promotional and marketing efforts, substantial advertising and promotional expenditures, the significant number of licenses and users, strong sales and revenues in connection with the marks, and third-party acclaim and attention.

Google and Its Wrongful Conduct

16. Google operates the GOOGLE Internet search engine.

17. Google recently announced that it plans to launch a new research tool directed toward scientists under the name and trademark SCHOLAR.

18. Google's SCHOLAR scientific research tool is currently in the beta testing phase, and can be accessed on the Internet at "www.scholar.google.com."

19. Like Plaintiff's SCIFINDER SCHOLAR/SCHOLAR research tool, Google's SCHOLAR research tool purports to provide scientists with access to scientific literature, including peer-reviewed papers, theses, books, preprints, abstracts, and technical reports from broad areas of research.

20. On November 19, 2004, one day after the public announcement of Google SCHOLAR, the ACS wrote to Google and expressed concern over Google's use of SCHOLAR for its scientific research tool. Google's counsel responded on December 1, 2004 denying liability and refusing to stop using SCHOLAR.

Harm to Plaintiff and the Public

21. Google's unauthorized use of the SCHOLAR mark is likely to cause confusion, mistake, and deception as to the source or origin of Google's services, and is likely to suggest falsely a sponsorship, connection, license, or association of Google, its services, and its commercial activities with Plaintiff.

22. Alternatively, Google's actions are likely to cause "reverse confusion," i.e., Google will saturate the market with its SCHOLAR trademark such that consumers are likely to erroneously believe that Plaintiff's services emanate from, are sponsored by, or are somehow connected to or affiliated with Google.

23. Google's activities have irreparably harmed and, if not enjoined, will continue to irreparably harm Plaintiff, its long-used and federally registered SCIFINDER SCHOLAR mark, and its SCHOLAR mark.

24. Google's activities have irreparably harmed, and if not enjoined, will continue to irreparably harm the public, who has an interest in being free from confusion, mistake, and deception.

25. Plaintiff has suffered actual damages to be proven at trial.

26. Plaintiff has no adequate remedy at law.

FIRST CLAIM FOR RELIEF
Federal Trademark Infringement Under
Section 32(1) of the Lanham Act
15 U.S.C. § 1114(1)

27. Plaintiff repeats and realleges every allegation set forth in paragraphs 1 through 26.

28. Without Plaintiff's consent, Google used and continues to use in commerce a reproduction, copy, and colorable imitation of the registered SCIFINDER SCHOLAR trademark in connection with the offering, distribution, and advertising of services, which use is likely to cause confusion, or to cause mistake, or to deceive, in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

SECOND CLAIM FOR RELIEF
Federal Trademark Infringement, False Designation
of Origin, Passing Off, and Unfair Competition
Under Section 43(a)(1)(A) of the Lanham Act,
15 U.S.C. § 1125(a)(1)(A)

29. Plaintiff repeats and realleges every allegation set forth in Paragraphs 1 through 28.

30. Google's actions are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Google with Plaintiff, or as to the origin, sponsorship, or approval of Google, its services, and its commercial activities by or with Plaintiff (or vice versa), and thus constitute infringement of an unregistered mark and false designation of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

THIRD CLAIM FOR RELIEF
Common-Law Trademark Infringement and Unfair Competition

31. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1 through 30.

33. Defendant's actions constitute common-law trademark infringement, misappropriation of Plaintiff's goodwill, and unfair competition under District of Columbia common law.

Prayer For Relief

WHEREFORE, Plaintiff requests that this Court enter judgment in its favor on each and every claim for relief set forth above and award it relief including, but not limited to, the following:

A. An order declaring that Google's use of SCHOLAR in connection with its scientific research tool, and/or related goods and services, infringes Plaintiff's SCIFINDER SCHOLAR and SCHOLAR marks, and constitutes federal and common-law trademark infringement and unfair competition, as detailed above.

B. A permanent injunction enjoining Google, its respective officers, directors, employees, agents, subsidiaries, distributors, dealers, and all persons in active concert or participation with any of them from using any name, mark, domain name, source-identifier, or designation comprised of or containing SCHOLAR, or any confusingly-similar name, mark, domain name, source-identifier, or designation in any manner in connection with the offering, operation, advertising, or promotion of scientific research tools, search engines and/or related goods and services.

C. An order enjoining Google from representing, by any means whatsoever, directly or indirectly, that Google, its services, its goods, and/or its activities originate from, are sponsored by, or are associated, affiliated, or connected with Plaintiff in any way.

D. An order requiring Google to destroy and/or immediately retract all materials comprised of or containing the SCHOLAR name and mark.

E. An order requiring Google to disseminate corrective advertising to address the likely confusion that it has caused from its use of SCHOLAR.

F. An Order requiring Google to account for and pay to Plaintiff all profits arising from Google's unlawful acts and that such profits be increased, pursuant to 15 U.S.C. § 1117 and other applicable laws.

G. An Order requiring Google to pay Plaintiff damages, in an amount to be determined, resulting from Google's unlawful acts and that such damages be trebled, pursuant to 15 U.S.C. § 1117 and other applicable laws.

H. An Order requiring Google to pay Plaintiff's costs and attorneys' fees in this action, pursuant to 15 U.S.C. § 1117 and other applicable laws.

I. Such other relief as the Court may deem appropriate.

JURY DEMAND

Plaintiff demands a trial by jury.

December 9, 2004

By: Roberta Horton
Roberta Horton (D.C. Bar No. 413577)

ARNOLD & PORTER LLP
555 12th Street, N.W.
Washington, D.C. 20004

Tel: (202) 942-5000
Fax: (202) 942-5999

Counsel for Plaintiff, American
Chemical Society

Of Counsel:
Flint Lewis
David T. Smorodin, D.C. Bar No. 366260
American Chemical Society
1155 Sixteenth Street, N.W.
Washington, D.C. 20036