

18-9089

No. USAP2 NO. 18-1536

Supreme Court, U.S.  
FILED

SEP 25 2018

OFFICE OF THE CLERK

In The

**SUPREME COURT OF THE UNITED STATES**

---

Itoffee R. Gayle

v.

Home Box Office, Inc

---

On Petition for Writ Of Certiorari

To The Second Circuit United States Court of Appeals

---

**PETITION FOR WRIT OF CERTIORARI**

**Itoffee R. Gayle**

***Pro Se***

2010 Powell Avenue Apt. 2F

Bronx, New York 10472

**ORIGINAL**

RECEIVED

MAR - 4 2019

OFFICE OF THE CLERK  
SUPREME COURT, U.S.

## Question(s) Presented

The plaintiff's intellectual property was featured in defendant's (HBO) series, Vinyl. Judge Jesse M. Furman of the New York Southern District granted the defendant's motion to dismiss and terminated my case on 5/2/18. This prompted me to appeal this decision to the Second Circuit US Court of Appeals in which circuit judges John M. Walker Jr., Dennis Jacobs, and Rosemary S. Pooler ordered my motion and appeal dismissed on 9/13/18. The plaintiff, Itoffee R. Gayle respectfully asks the US Supreme Court to grant the writ of certiorari.

## Table of Contents

OPINIONS .....	1
STATEMENT OF JURISDICTION .....	2
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED ...	3
STATEMENT OF THE CASE .....	15
REASONS FOR GRANTING THE PETITION .....	16
CONCLUSION .....	17

## Index to Appendices

### APPENDIX A

United States Court of Appeals of the Second Circuit

### APPENDIX B

New York Southern District Court

# Opinions

For cases from federal courts:

The opinion of the United States district court appears at Appendix A to the petition and is unpublished.

The opinion of the United States court of appeals appears at Appendix B to the petition and is reported at :

lobe.com, techdirt.com, savareselegal.com, leagle.com, biglawbusiness.com, ipo.org, ilnipinsider.com, linkedin.com, plagiarismtoday.com, blog.robinskaplantrialattorneys.com, jdsupra.com, thompsoncoburn.com, clanco.com, advertisinglaw.fkks.com, tvttattle.com, grossmanllp.com, thepassivevoice.com, 4conservative.com, 4rightwing.com, baltrel.com, reason.com, techrights.org, stieornan.ga,

## JURISDICTION

For cases from federal courts:

The date on which the United States Court of Appeals decided my case was 09/13/2018.

No petition for rehearing was timely filed in my case.

## CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

### ***(1) federal trademark infringement under 15 U.S.C. §1114(a) which***

***states:*** any person who shall, without the consent of the registrant—use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive

### ***(2) federal unfair competition under 15 U.S.C. §1125 which states:***

#### **(a) CIVIL ACTION**

**(1)** Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

#### **(A)**

is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

#### **(B)**

in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

**(2)** As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

**(3)** In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

**(b)IMPORTATION**

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

**(c)DILUTION BY BLURRING; DILUTION BY TARNISHMENT**

**(1)INJUNCTIVE RELIEF**

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

**(2)DEFINITIONS**

**(A)**For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

**(i)**

The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

**(ii)**

The amount, volume, and geographic extent of sales of goods or services offered under the mark

**(iii)**

The extent of actual recognition of the mark.

(iv)

Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i)

The degree of similarity between the mark or trade name and the famous mark.

(ii)

The degree of inherent or acquired distinctiveness of the famous mark.

(iii)

The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv)

The degree of recognition of the famous mark.

(v)

Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi)

Any actual association between the mark or trade name and the famous mark.

(C)

For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) **EXCLUSIONS** The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—



(i)

advertising or promotion that permits consumers to compare goods or services; or

(ii)

identifying and parodying, criticizing, or commenting upon the famous mark or goods or services of the famous mark owner.

(B)

All forms of news reporting and news commentary.

(C)

Any noncommercial use of a mark.

**(4) BURDEN OF PROOF** In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A)

the claimed trade dress, taken as a whole, is not functional and is famous; and

(B)

if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

**(5) ADDITIONAL REMEDIES** In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A)

the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i)

by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii)

by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

**(6) OWNERSHIP OF VALID REGISTRATION A COMPLETE BAR TO ACTION** The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A)

is brought by another person under the common law or a statute of a State; and

(B)

(i)

seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii)

asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

**(7) SAVINGS CLAUSE**

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

**(d) CYBERPIRACY PREVENTION**

(1)

**(A)** A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i)

has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

**(ii)** registers, traffics in, or uses a domain name that—

(I)

in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II)

in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III)

is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)

(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I)

the trademark or other intellectual property rights of the person, if any, in the domain name;

(II)

the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III)

the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV)

the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V)

the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI)

the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use,

the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII)

the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII)

the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX)

the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii)

Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C)

In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D)

A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E)

As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)

(A) The owner of a mark may file an in rem civil action against a domain name in the judicial

district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i)

the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner—

(I) is not able to obtain in person jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa)

sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb)

publishing notice of the action as the court may direct promptly after filing the action.

(B)

The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i)

the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii)

documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

**(D)**

(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain registration, to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

**(I)**

expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

**(II)**

not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court

**(ii)**

The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

**(3)**

The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

**(4)**

The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in person.

***(3) copyright infringement and statutory damages under 17 U.S.C. §504 et seq. which states:***

**(a)IN GENERAL.**—Except as otherwise provided by this title, an infringer of copyright is liable for either—

**(1)**

the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or

**(2)**

statutory damages, as provided by subsection (c).

**(b)ACTUAL DAMAGES AND PROFITS.—**

The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.

**(c)STATUTORY DAMAGES.—**

**(1)**

Except as provided by clause (2) of this subsection, the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally, in a sum of not less than \$750 or more than \$30,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.

**(2)**

In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than \$150,000. In a case where the infringer sustains the burden of proving, and

the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than \$200. The court shall remit statutory damages in any case where an infringer believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under section 107, if the infringer was:

(i) an employee or agent of a nonprofit educational institution, library, or archives acting within the scope of his or her employment who, or such institution, library, or archives itself, which infringed by reproducing the work in copies or phonorecords; or (ii) a public broadcasting entity which or a person who, as a regular part of the nonprofit activities of a public broadcasting entity (as defined in section 118(f)) infringed by performing a published nondramatic literary work or by reproducing a transmission program embodying a performance of such a work.

**(3)**

**(A)**

In a case of infringement, it shall be a rebuttable presumption that the infringement was committed willfully for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name used in connection with the infringement.

**(B)**

Nothing in this paragraph limits what may be considered willful infringement under this subsection.

**(C)**

For purposes of this paragraph, the term "domain name" has the meaning given that term in section 45 of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes" approved July 5, 1946 (commonly referred to as the "Trademark Act of



1946"; 15 U.S.C. 1127).

**(d) ADDITIONAL DAMAGES IN CERTAIN CASES.—**

In any case in which the court finds that a defendant proprietor of an establishment who claims as a defense that its activities were exempt under section 110(5) did not have reasonable grounds to believe that its use of a copyrighted work was exempt under such section, the plaintiff shall be entitled to, in addition to any award of damages under this section, an additional award of two times the amount of the license fee that the proprietor of the establishment concerned should have paid the plaintiff for such use during the preceding period of up to 3 years.

*(4) unfair competition and trademark infringement under related state laws*

§

## STATEMENT OF THE CASE

HBO has deliberately copied and appropriated the plaintiff's protectable expression. The plaintiff's intellectual properties – trademark registration 5108721, copyright VA 2006958, and copyright VA 2088822 were featured in the background during the night time scene of HBO's Vinyl, Season 1 Episode 5 without permission, compensation, or attribution.

HBO's art department never attempted to contact the plaintiff or pay appropriate licensing fees to the plaintiff so that HBO can legally use the plaintiff's intellectual property.

## REASONS FOR GRANTING THE PETITION

The plaintiff, Itoffee R. Gayle respectfully asks the US Supreme Court to grant the writ of certiorari because the court of appeals has failed to specifically elaborate its actual reasons on why the plaintiff's case has been terminated. The plaintiff has provided sufficient evidence to the lower courts to support copyright and trademark infringement.

## CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

*Itoffee Gayle*  
Itoffee Gayle

Pro se

2010 Powell Ave Apt 2F.

Bronx, NY

17

SAMANTHA D GARRIQUES AHMEED  
Notary Public - State of New York  
NO. 01GA6373742  
Qualified in Bronx County  
My Commission Expires Apr 16, 2022

On this 26<sup>th</sup> day of February 2019, personally appeared before me,  
Itoffee Gayle. City of New York, State of New York,  
County of Bronx.

*[Signature]*