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**ORDER AND JUDGMENT*, U.S. COURT OF
APPEALS FOR THE TENTH CIRCUIT
(APRIL 18, 2024)**

UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

ERIK M. UNDERWOOD, a Colorado citizen;
MY24HOURNEWS.COM, INC.,
a Colorado corporation,

Plaintiffs - Appellants,

v.

BANK OF AMERICA CORPORATION,
a Delaware corporation,

Defendant - Appellee.

No. 22-1402
(D.C. No. 1:18-CV-02329-RM-MEH) (D. Colo.)
Before: BACHARACH, MCHUGH, and MORITZ,
Circuit Judges.

* This order and judgment is not binding precedent, except under the doctrines of law of the case, res judicata, and collateral estoppel. But it may be cited for its persuasive value. *See* Fed. R. App. P. 32.1(a); 10th Cir. R. 32.1(A).

ORDER AND JUDGMENT

Erik Underwood and My24HourNews.com, Inc. (collectively, plaintiffs) appeal the district court’s order granting summary judgment to defendant Bank of America (BoFA) on their trademark-infringement claim for the service mark “E.R.I.C.A.” Because plaintiffs fail to establish any triable issue of fact about whether the service mark clearly distinguished the services offered, they cannot show a protectable interest in their unregistered mark, and we affirm.

Background

In October 2010, Underwood obtained a Georgia state trademark registration for the mark “E.R.I.C.A.” Plaintiffs later launched the website www.my24erica.com, which allows users to search for movies and actors in its online database.¹

In October 2016, BoFA filed an intent-to-use application for the mark “ERICA” with the United States Patent and Trademark Office (USPTO). After the USPTO approved the application, BoFA launched ERICA as a virtual financial assistant in its mobile banking application, and the USPTO formally issued the ERICA registration to BoFA in July 2018.

Plaintiffs then filed this action, asserting as relevant here that BoFA was infringing on their trademark. The district court granted BoFA’s motion to cancel

¹ The parties dispute the date on which this website became publicly accessible: plaintiffs assert it was in March 2015; BoFA contends it was not until June 2018. As we later explain, this dispute is not material to our decision; for purposes of this appeal, we accept plaintiffs’ alleged date of publication.

plaintiffs' Georgia trademark registration and its motion for summary judgment.

Plaintiffs appealed, and we affirmed the trademark cancellation and much of the summary-judgment order, but we vacated and remanded on a single issue—whether plaintiffs had established protectable trademark rights through a theory of actual use of the E.R.I.C.A. mark in commerce. *See Underwood v. Bank of Am. Corp.*, 996 F.3d 1038, 1059 (10th Cir. 2021). Setting out the correct legal framework for assessing “actual use,” we remanded for the district court to determine whether plaintiffs could establish that: (1) *www.my24erica.com* was publicly accessible before October 2016; (2) search-engine and personal-assistant services on the website “were ‘rendered to others’ before October 2016”; and (3) “the E.R.I.C.A. mark ‘clearly identif[ied] and distinguish[ed]’ the services offered ‘on the website.’” *Id.* at 1057 (alterations in original) (first quoting *Morningside Grp. Ltd. v. Morningside Cap. Grp., L.L.C.*, 182 F.3d 133, 138 (2d Cir. 1999), and then quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 16:32.70 (5th ed. Mar. 2021 update)).

On remand, the district court again granted summary judgment for BofA, finding that (1) even assuming the website was publicly accessible before October 2016, plaintiffs failed to create a genuine issue of material fact as to (2) whether plaintiffs rendered search-engine and personal-assistant services to others and (3) whether the mark clearly identified and distinguished the services offered by *www.my24erica.com*. It later denied plaintiffs' motion for reconsideration.

Plaintiffs appeal.

Analysis

Plaintiffs challenge summary judgment for BofA on their trademark-infringement claim. We review a summary-judgment order de novo and apply the same legal standard as the district court. *GeoMetWatch Corp. v. Behunin*, 38 F.4th 1183, 1200 (10th Cir. 2022). Summary judgment is proper when there is “no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law,” Fed. R. Civ. P. 56(a), meaning that a reasonable jury could not return a verdict for the nonmoving party, *see Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). On summary judgment, we view all facts and inferences in the light most favorable to the nonmoving party. *GeoMetWatch*, 38 F.4th at 1200.

As we explained in our prior decision in this case, “[t]he principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.” *Underwood*, 996 F.3d at 1045 (quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015)). And the overarching “rule of trademark ownership in the United States is priority of use,” established by using a symbol or word to identify and distinguish the source of goods of services. *Id.* (quoting 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 16:1 (5th ed. Mar. 2021 update)). To establish a claim for trademark infringement under federal law, “a plaintiff must show ‘(1) that the plaintiff has a protectable interest in the mark; (2) that the defendant has used an identical or similar mark in commerce; and (3) that the defendant’s use is likely to confuse customers.’” *Id.* (quoting *1-800 Contacts, Inc. v. Lens.com, Inc.*,

722 F.3d 1229, 1238 (10th Cir. 2013). For purposes of this appeal, we assume that the last two elements are established. So at issue here, as in the prior appeal, is only the first element: a protectable interest. *See id.* at 1052–53.

A plaintiff can establish a protectable interest in an unregistered service mark through “actual use in the market.” *Id.* at 1053 (quoting *Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 354 (6th Cir. 1998)). To do so, a “plaintiff must show use of the mark as a service mark, which means use ‘to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services, even if that source is unknown.’” *Id.* (quoting 15 U.S.C. § 1127). And actual use must take place in commerce, meaning that it consists of “attempt[s] to complete genuine commercial transactions,” as opposed to uses merely intended “to reserve a mark for later use.” *Id.* at 1053–54 (alteration in original) (quoting *Allard Enters.*, 146 F.3d at 359). As particularly relevant here, use of a mark on a website “may constitute a bona fide use in commerce,” but “the website must ‘identify [the] goods or services . . . provided through or in connection with the website.’” *Id.* at 1054 (alteration in original) (quoting *Specht v. Google, Inc.*, 747 F.3d 929, 934 (7th Cir. 2014)).

Here, as to actual use in commerce, recall that the district court assumed plaintiffs’ website was publicly accessible before October 2016 but concluded both that plaintiffs did not render search-engine and personal-assistant services to others and that plaintiffs’ use of the mark did not clearly identify and distinguish the services they provided. We will similarly assume public

accessibility and will go one step further and assume that plaintiffs did render services to others.

Turning our focus to whether plaintiffs' use of the mark clearly identified and distinguished their services, we first note that the district court's analysis on this point lacked detail. It simply stated that plaintiffs' use did not meet this standard and offered as an "example" that "[p]laintiffs point[ed] to no evidence that any individuals who visited its website during that time-frame associated the mark with the website's services." App. vol. 7, 1658.

Taking off from this example, plaintiffs argue on appeal that the district court "erred by *requiring* proof that a particular individual subjectively associated the ERICA mark with the website's services."² Aplt. Br. 19 (emphasis added). But as defendant identifies, the phrase "for example" indicates that the district court did not *require* such subjective proof; rather, it merely noted the absence of such proof when concluding that the use of the mark on the website did not clearly identify and distinguish the services provided. And it is not clear that doing so was erroneous: even plaintiffs acknowledge that this inquiry turns on the

² Plaintiffs also argue that the district court erred by providing inadequate notice of the basis for its ruling. But our prior decision included significant detail about the three issues to be decided on remand, and the district court ordered the parties to file supplemental briefing addressing those issues. Then, the district court issued its summary-judgment ruling based on those three issues. So we reject plaintiffs' notice argument. *Cf. Oldham v. O.K. Farms, Inc.*, 871 F.3d 1147, 1150–51 (10th Cir. 2017) (finding plaintiff was prejudiced by district court's grant of summary judgment on ground not raised or addressed by either party and instead raised sua sponte by court during hearing).

totality of the circumstances and thus could include the possibility of subjective proof. *See Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1195–96 (11th Cir. 2001) (explaining that courts look at totality of circumstances to determine use in commerce, including “evidence that members of the targeted public actually associated the mark . . . with the [good or service] to which it was affixed”). In any event, we need not definitively resolve whether the district court erred by discussing the lack of subjective evidence in this case. We must simply assess, on de novo review, whether plaintiffs can show a genuine issue of material fact on actual use in commerce based on the totality of the circumstances.

Seeking to do so, plaintiffs point to the About ERICA and Terms of Service sections of the website, which both mention either “E.R.I.C.A.” or “ERICA.” As an initial matter, to reach either of these webpages, a website visitor must scroll to the bottom of the information-heavy homepage and locate and click on a link in small-point, all-lowercase font in the bottom right corner.³ Such an obscure use of the mark is unlikely to “‘clearly identif[y] and distinguish’ the services offered ‘on the website.’” *Underwood*, 996 F.3d at 1057 (quoting 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 16:32.70 (5th ed. Mar. 2021 update)); *see also In re Osterberg*, 83 U.S.P.Q.2d 1220, at *3 (T.T.A.B. 2007) (finding no connection between use of mark and goods where “viewers of the webpage will have to search through the descriptive text even to find the purported mark”); *In*

³ For reference, we attach an image of the homepage as an appendix to this Order and Judgment. *See* App. vol. 6, 1443–45.

re Azteca Systems, Inc., 102 U.S.P.Q.2d 1955, at *1–3 (T.T.A.B. 2012) (finding no connection between use of mark and goods where “the mark [wa]s distant from the description of the software, . . . separated from the description by more than fifteen lines of text concerning marginally[]related topics,” and located “in the lower[,] left-hand, bottom corner of the first webpage”).

Moreover, even if a website visitor manages to reach these linked webpages, these pages still do not establish “E.R.I.C.A.” as a protectable service mark. The use of a service mark must allow for a “direct association” between the mark and the services offered. *In re Vicki Roberts*, 87 U.S.P.Q.2d 1474, at *3 (T.T.A.B. 2008) (quoting *In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1649 (T.T.A.B. 2006)). And it is not “enough that the mark and a reference to the services both appear in the same” location. *In re Osmotica Holdings Corp.*, 95 U.S.P.Q.2d 1666, at *3 (T.T.A.B. 2010).

Here, the webpages at issue do not allow for a direct association between the mark and the services offered. The About ERICA webpage states that “[t]he acronym E.R.I.C.A.[.] stands for Electronic Repetitious Informational Clone Application” and describes “ERICA” as “an artificial intelligence mobile search engine that infuses software and holographic digital technology seamlessly together[,] to create an environment where your digital device is alive and interactive with the consciousness of E.R.I.C.A.,” as well as “the first artificial intelligence to have a personality and a real image.” App. vol. 1, 238. The Terms of Service webpage, under the heading “Description of Website Services Offered,” states that “ERICA” is “a talking . . . [a]rtificial [i]ntelligence[] interactive search engine.” *Id.* at 221. These summaries merely describe a technology

and do not directly connect to the search services provided in a traditional search box on the homepage of www.my24erica.com. For one thing, the alleged service mark itself has two, indiscriminately used iterations: “E.R.I.C.A.” and “ERICA.” And perhaps more importantly, the alleged service described on these webpages is aspirational, not definitive. The “About ERICA” page specifically states that the application is “[c]urrently . . . in further development to implement the full vision on mobile and search engines to verbally tell you information and deliver entertainment news, restaurant reviews, financial updates, and so much more.” *Id.* at 238. These descriptions do not indicate the *source* of any offered search-engine or personal-assistant services; they simply describe the idea behind an application still “in development.” *Id.*

Plaintiffs further argue that the use of the service mark on the website established its use in commerce because at the top of the homepage, there is a line of text just below a search bar that reads “ERICA’S CURRENT MOVIE PICKS”; plaintiffs say this “demonstrat[es] [E.R.I.C.A.’s] ability to provide the customer with recommendations.” App. vol. 7, 1557. But this phrase does not clearly identify or distinguish search-engine or personal-assistant services. Indeed, the word “ERICA” in this title appears in the same font, size, and style as the other descriptive terms. *See* 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 3:4 (5th ed. Mar. 2024 update) (“Some of the common markers of whether a word, phrase[,], or picture is being used as a trademark are: larger-sized print, all capital letters or initial capitals, distinctive or different print style, color, and prominent position on label or in advertising.”); *see also In re Post*

Properties, Inc., 227 U.S.P.Q. 334, at *2 (T.T.A.B. 1985) (finding “use in the manner of a service mark” in part because mark was “set off distinctively from the text of the ad copy in an extremely large typeface” and was “not an ordinary informational statement”); *Jaymo’s Sauces LLC v. Wendy’s Co.*, No. 19-cv-01026, 2021 WL 4712685, at *7 (C.D. Ill. Oct. 8, 2021) (unpublished) (“[T]he nonprivileged placement and emphasis on other terms coupled with the comparatively small, plain font of the term fail to adequately demonstrate it is being used as a source indicator on the bottle labels.”). If anything, the phrase “ERICA’S CURRENT MOVIE PICKS”, in matching text, implies that a person named Erica is curating suggestions and not that the mark clearly identifies the source of any services. *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 13:2 (5th ed. Mar. 2024 update) (personal names are subject to trademark protection only if their use “acquire[s] distinctiveness and secondary meaning”).

In a final attempt to demonstrate actual use in commerce, plaintiffs highlight evidence showing, in their view, that visitors to the website associated the E.R.I.C.A. mark with the services being offered. In support, plaintiffs discuss references to “an E.R.I.C.A. search engine” in an affidavit from Kim Opler, Underwood’s former roommate, App. vol. 5, 1211, and to “E.R.I.C.A. search results” in testimony from Todd Olson, Underwood’s business colleague, App. vol. 3, 509. But neither of these statements mention the placement of the word “ERICA” on the website, nor do they suggest “that any such placement clearly identified and distinguished the services offered on the website.” Aplee. Br. 33. And what matters here is whether the

mark was actually used in commerce, meaning that it “identif[ied] [the] goods or services . . . provided through or in connection with the website.” *Underwood*, 996 F.3d at 1054 (quoting *Specht*, 747 F.3d at 934). Without testimony about the placement of the mark, we cannot determine if Opler and Olson naturally associated the mark with the services or if they relied on prior knowledge.

In sum, we agree with the district court that plaintiffs presented no evidence that the E.R.I.C.A. mark, as used on the website, clearly distinguishes the source of the services offered by www.my24erica.com. Plaintiffs therefore fail to show actual use in commerce of their mark, meaning that they cannot establish a protectable interest in their mark as required for their trademark-infringement claim.⁴

Conclusion

We affirm summary judgment for BofA on plaintiffs’ trademark-infringement claim because plaintiffs cannot establish actual use of their mark prior to BofA’s priority date of October 2016.

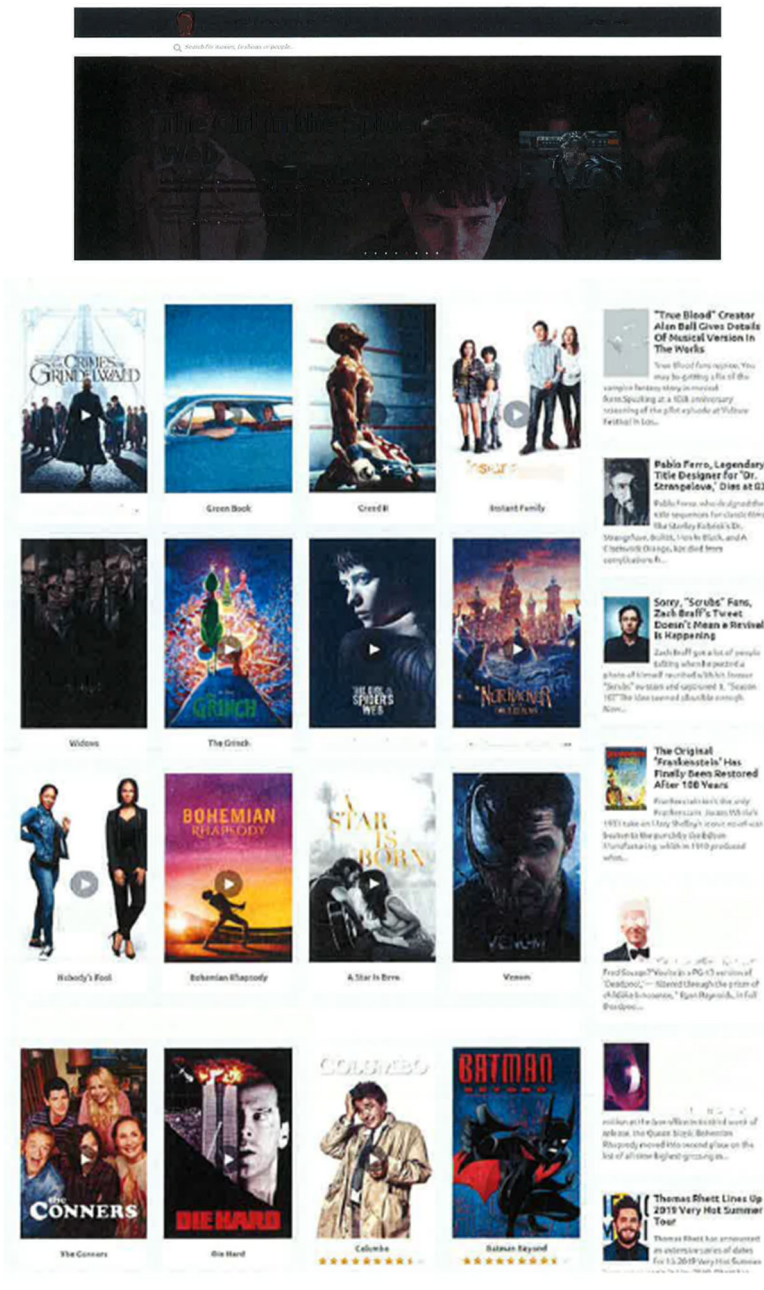
Entered for the Court

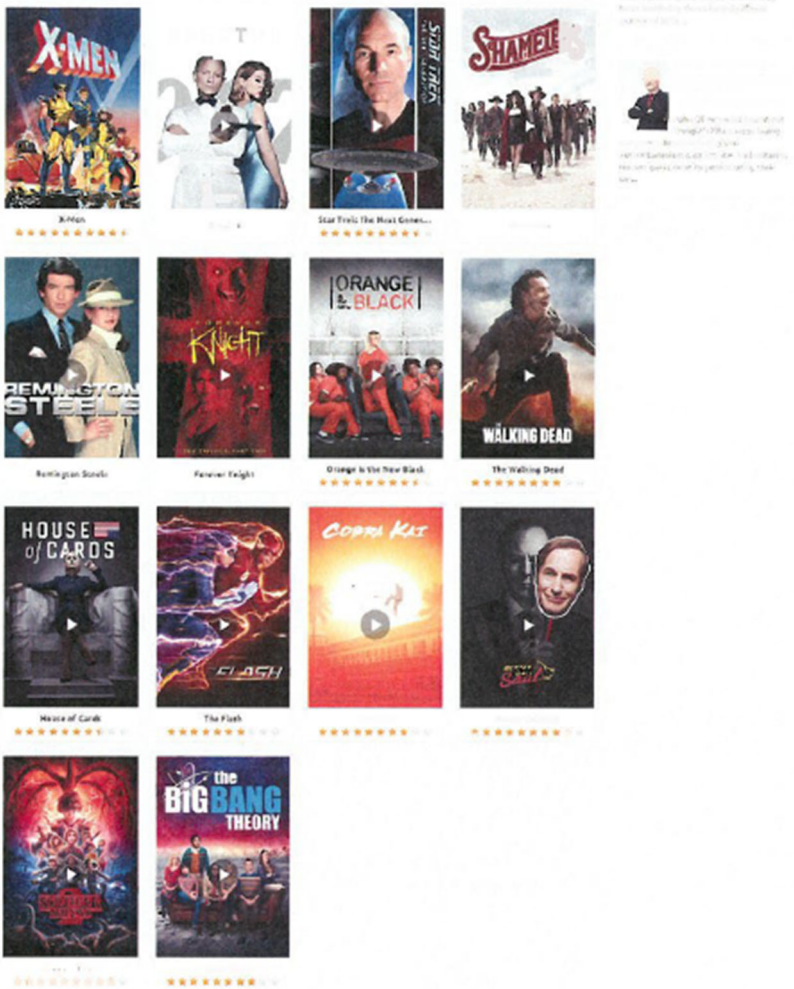
/s/ Nancy L. Moritz

Circuit Judge

⁴ Because we conclude that the district court correctly awarded summary judgment to BofA, we need not separately address plaintiffs’ argument that the district court later erred in denying their motion for reconsideration.

Appendix [to the 10th Circuit Opinion]





Transcription Note:

This exhibit is presented for its image, not for the specific text. Thus, no transcription of the software code is provided.

App.14a



**OPINION, U.S. COURT OF APPEALS
FOR THE TENTH CIRCUIT
(APRIL 30, 2021)**

PUBLISH

UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

ERIK M. UNDERWOOD, a Colorado resident, and
MY24HOURNEWS.COM, INC., a Colorado
corporation,

Plaintiffs - Appellants,

v.

BANK OF AMERICA CORPORATION, a Delaware
corporation,

Defendant - Appellee.

No. 19-1349

No. 20-1087

Appeal from the United States District Court
For the District of Colorado
(D.C. No. 1:18-CV-02329-RM-MEH)

Before: MATHESON, EBEL, and MORITZ,
Circuit Judges.

MATHESON, Circuit Judge.

Erik Underwood and My24HourNews.Com, Inc., (“Mr. Underwood” or the “Plaintiffs”), own two putative service marks: “E.R.I.C.A.” and “my24erica.com.” Mr. Underwood claims to have used these marks in his business, which offers internet-based search engine and personal assistant services. Bank of America Corporation (“BofA”) owns a registered federal trademark for a mobile banking application known as “ERICA.”

Mr. Underwood sued BofA for infringing his marks. BofA counterclaimed to cancel Mr. Underwood’s Georgia registration of his E.R.I.C.A. mark. The district court granted BofA’s motions for summary judgment on its cancellation counterclaim and on Mr. Underwood’s infringement claims. Exercising jurisdiction under 28 U.S.C. § 1291, we affirm in part and vacate and remand in part.

I. BACKGROUND

A. Legal Background

“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.” *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015).¹ “The basic rule of trademark ownership in the United

¹ The marks at issue in this case are service marks. Service marks are used to identify services, while trademarks are used to identify goods. For the most part, “[s]ervice marks and trademarks are governed by identical standards.” *See Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1156 (9th Cir. 2001). And “the term ‘trademark’ is generally understood to include marks used in the marketing of either goods or services.” Restatement (Third) of Unfair Competition § 9 cmt. f (Am. L. Inst. 1995).

States is priority of use,” which occurs through “use of a symbol to identify the goods or services of one seller and distinguish them from those offered by others.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 16:1 (5th ed. Mar. 2021 update) [hereinafter McCarthy].

“The foundation of current federal trademark law is the Lanham Act.” *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017). “[T]he purpose of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection.” *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring). “Under the Lanham Act, trademarks that are used in commerce . . . may be federally registered.” *Tam*, 137 S. Ct. at 1752 (quotation omitted). Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), “protects an unregistered mark.” See *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1220 (2d Cir. 1987), *overruled on other grounds by Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 585 (2d Cir. 1993). Federally unregistered marks also “can be enforced under state common law, or if it has been registered in a State, under that State’s registration system.” *Tam*, 137 S. Ct. at 1753. Federal and state trademark protections generally parallel each other, and the former do not preempt the latter. See *id.*

B. Factual Background

1. Initial Development of E.R.I.C.A.

In 2009, Mr. Underwood developed a business plan including a virtual assistant called E.R.I.C.A.—named for Mr. Underwood’s sister and a backronym

for Electronic Repetitious Informational Clone Application. Mr. Underwood envisioned E.R.I.C.A. as an animated application “that you ask and you get information in return,” and that would “mimic[] human interaction.” App., Vol. 4 at 489.² Mr. Underwood explained that in 2009 E.R.I.C.A. was not “launched, but there was a demo associated with her” that appeared on his website, My24HourNews.Com. *Id.* at 489-90.

Mr. Underwood took steps in 2009 to attract investor interest in his business. He used a PowerPoint presentation at business pitch meetings containing the following picture of E.R.I.C.A. to show “the concept of how E.R.I.C.A. would look” and “what she might say while interacting with the viewer as a finished end-product”:



² Unless otherwise noted, citations are to the Appendix and the parties' briefs in case No. 20-1087.

Transcription:

Hello My Name is E.R.I.C.A.,

Welcome to My24HourNews.Com.

I can offer you varied news and current events of your region or country. In addition, specify your particular interest, such as, international events, political news, financial world markets, weather, sports, or Entertainment.

App. (No. 19-1349), Vol. 2 at 314, 319, 321. Mr. Underwood gave a presentation at the Small Business Administration office in Atlanta. Between 2009 and 2011, he distributed nearly 1,500 business cards featuring a picture of E.R.I.C.A. Beginning in February 2010, he distributed roughly 200 DVDs containing the E.R.I.C.A. demo.

2. Georgia Registration

In October 2010, Mr. Underwood applied to register a service mark in Georgia for “a multi national computer animated woman . . . [named] Erica.” App. (No. 19-1349), Vol. 1 at 142. On the application, Mr. Underwood explained the service associated with the mark: “E.R.I.C.A. verbally tells the news and current events through cell phone and computer applications.” *Id.* The mark was approved for registration in Georgia.

3. Proposed Joint Venture

In 2012, Mr. Underwood gave a presentation to AT&T. AT&T and My24HourNews.Com, Inc. discussed forming a joint venture, but it never came to fruition.³

4. my24erica.com

In 2012, Mr. Underwood registered the domain name my24erica.com with GoDaddy.com.⁴ my24erica.com functioned “as a search engine . . . where [E.R.I.C.A.] can recall queries of movies [and] television shows.” App., Vol. 3 at 517. A user could enter a title into the search bar on my24erica.com, and E.R.I.C.A. could “offer her picks of her favorite kind of movies through an algorithm code.” *Id.* The same picture of the computer-generated human face that appeared on the PowerPoint presentation appeared in the top left corner of my24erica.com. my24erica.com also had a hyperlink to a Facebook page for My24HourNews.Com, which received 772 “likes” by September 2018.

According to Mr. Underwood, my24erica.com became publicly accessible in March 2015. *See* App., Vol. 5 at 1061. BofA claims that my24erica.com was

³ The failed joint venture has spawned multiple lawsuits. *See My24HourNews.Com, Inc. v. AT&T Corp.*, 791 F. App’x 788 (11th Cir. 2019) (unpublished); *My24HourNews.Com, Inc. v. AT&T Corp.*, No. 1:17-cv-06657-RA (S.D.N.Y. 2017); *My24HourNews.Com, Inc. v. AT&T Corp.*, No. 1:15-cv-012120-RM-NYW (D. Colo. 2015). None is relevant to this appeal.

⁴ GoDaddy.com “is a domain name registrar and a web hosting provider.” It is a “company that other companies and individuals rely on to register their Internet domain names, and to host their website on [the GoDaddy] servers.” App., Vol. 2 at 301.

not publicly accessible until June 2018. *See* Aplee. Br. at 40.

In support of his assertion, Mr. Underwood points to, among other things, declarations of individuals who claim to have visited my24erica.com in the relevant time frame. The parties also introduced dueling expert reports. BofA submitted the report of Keena Willis, the Director of Global Subpoena Compliance at GoDaddy .com, LLC, the hosting platform on which my24erica .com was allegedly hosted. She reviewed voluminous business records from GoDaddy.com and concluded the “records indicate that, on or about June 27, 2018, Mr. Underwood began hosting my24erica.com with GoDaddy.” App., Vol. 2 at 302. Mr. Underwood, on the other hand, relied on the expert report of Jonathan Hochman, who investigated records associated with my24erica.com and my24erica.com’s web hosting control panel, database administration tool, and administrator portal. He concluded the website was launched on March 18, 2015.

5. BofA’s Registered Mark

In October 2016, BofA filed an “intent to use” application with the United States Patent and Trademark Office (“USPTO”) for ERICA, a mark associated with “voice controlled information and personal assistant devices in the field of banking and personal finance.” App., Vol. 1 at 36. The USPTO registered the mark in July 2018. The mark had a priority date based on the October 2016 filing date. *See* 15 U.S.C. § 1057(c).

C. Procedural Background

1. Complaint

Alleging that BofA's mark infringed his E.R.I.C.A. and my24erica.com marks, Mr. Underwood sued BofA for (1) false association under Section 43(a) of the Lanham Act, (2) common law service mark infringement, (3) common law unfair competition, (4) violations of the Colorado Consumer Protection Act, and (5) service mark infringement under Georgia law.

2. Counterclaims

BofA answered the complaint and brought six counterclaims: one for cancellation of the Georgia registration for the E.R.I.C.A. mark, and five for declarations under the federal Declaratory Judgment Act that BofA had not violated (1) Section 43(a) of the Lanham Act, (2) common law service mark protections, (3) common law unfair competition protections, (4) the Colorado Consumer Protection Act, and (5) Georgia service mark protections.

3. Motion for Partial Summary Judgment

BofA moved for partial summary judgment on its cancellation counterclaim. The district court granted the motion and ordered the Georgia Secretary of State to cancel the registration. The court found that the "plaintiffs did not have valid grounds to register the trademark at the time of filing," as required under Georgia law. App. (No. 19-1349), Vol. 2 at 396. Mr. Underwood filed an interlocutory appeal from the district court's grant of partial summary judgment.

4. Motion for Summary Judgment

BofA moved for summary judgment on Mr. Underwood's infringement claims. The district court granted the motion. It found that Mr. Underwood had failed to demonstrate a protectable interest in his marks. On that basis, the district court dismissed Mr. Underwood's claims for (1) violation of Section 43(a) of the Lanham Act, (2) common law service mark infringement, and (3) common law unfair competition.⁵

The district court entered final judgment, and Mr. Underwood timely appealed. We consolidated the two appeals and now resolve both.

II. DISCUSSION

We address (A) our appellate jurisdiction, (B) BofA's cancellation counterclaim, and (C) Mr. Underwood's infringement claims.

We review the district court's grant of summary judgment de novo, applying the same standard applied by the district court. *See Sandoval v. Unum Life Ins. Co. of Am.*, 952 F.3d 1233, 1236 (10th Cir. 2020). We view the evidence and draw all reasonable inferences in the light most favorable to Mr. Underwood. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). Summary judgment is proper "if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a).

⁵ The district court did not expressly address BofA's remaining counterclaims. It also declined to exercise supplemental jurisdiction over Mr. Underwood's claims under Colorado and Georgia law, and it dismissed those claims without prejudice.

A. Jurisdiction

Before the district court entered final judgment, BofA moved to dismiss Mr. Underwood’s interlocutory appeal, arguing we lack appellate jurisdiction. We need not address this issue because Mr. Underwood filed a second notice of appeal from the final judgment the district court entered after granting summary judgment on Mr. Underwood’s infringement claims. The district court’s summary judgment order and final judgment constituted a “final decision” appealable under 28 U.S.C. § 1291.⁶

Even if Mr. Underwood’s interlocutory appeal was premature, the interlocutory “notice of appeal filed before the district court dispose[d] of all claims” became effective when Mr. Underwood obtained a “final

⁶ Ordinarily, a “grant of summary judgment [is] not an appealable final order [if] a counterclaim . . . remain[s] adjudicated when the district court enter[s] summary judgment.” *See Lewis v. B.F. Goodrich Co.*, 850 F.2d 641, 642 (10th Cir. 1988) (en banc). But here, BofA’s five adjudicated counterclaims do not deprive us of jurisdiction. In them, BofA sought declarations that it was not liable to Mr. Underwood for his claims against BofA. When the district court granted BofA’s motion for summary judgment on Mr. Underwood’s infringement claims, BofA’s five adjudicated counterclaims became moot. Adjudicating them would not have “settled . . . some dispute which affect[ed] the behavior of [Mr. Underwood] toward [BofA].” *See Rio Grande Silvery Minnow v. Bureau of Reclamation*, 601 F.3d 1096, 1110 (10th Cir. 2010) (quotations omitted). Thus, notwithstanding the adjudicated counterclaims, the district court’s order disposing of Mr. Underwood’s infringement claims was a final appealable order under 28 U.S.C. § 1291 because it “end[ed] the litigation on the merits and left nothing for the court to do but execute the judgment.” *Miami Tribe of Okla. v. United States*, 656 F.3d 1129, 1137 (10th Cir. 2011) (quoting *Coopers & Lybrand v. Livesay*, 437 U.S. 463, 467 (1978)).

adjudication before the court of appeals consider[ed] the case on its merits.” *Ruiz v. McDonnell*, 299 F.3d 1173, 1179 (10th Cir. 2002); *see also* *Cook v. Baca*, 625 F. App’x 348, 352 (10th Cir. 2015) (unpublished) (“Because final judgment has entered in these consolidated cases, [the appellant’s] first notice of appeal has ripened.”).⁷

Thus, we have jurisdiction over both of the district court’s orders. We deny as moot BofA’s motion to dismiss Mr. Underwood’s first appeal.⁸

B. Cancellation Counterclaim

The district court found that the Georgia registration for Mr. Underwood’s E.R.I.C.A. mark should

⁷ Although not precedential, we find the reasoning of unpublished decisions cited in this opinion instructive. *See* 10th Cir. R. 32.1 (“Unpublished decisions are not precedential, but may be cited for their persuasive value.”); *see also* Fed. R. App. P. 32.1.

⁸ We also deny BofA’s request for attorney fees and costs in connection with moving to dismiss the interlocutory appeal. Although BofA points to out-of-circuit authority suggesting Mr. Underwood had no non-frivolous arguments that we had interlocutory jurisdiction, it is unsettled in this circuit whether a district court’s order directing cancellation of a trademark registration is immediately appealable under 28 U.S.C. § 1292(a)(1). We cannot say that an award of fees and costs is appropriate under 28 U.S.C. § 1927 because Mr. Underwood’s attorneys did not act “recklessly or with indifference to the law.” *See Steinert v. Winn Grp., Inc.*, 440 F.3d 1214, 1221 (10th Cir. 2006) (quotations omitted). Similarly, an award is inappropriate under Federal Rule of Appellate Procedure 38 because Mr. Underwood’s arguments on interlocutory appellate jurisdiction were not “wholly without merit.” *Braley v. Campbell*, 832 F.2d 1504, 1510 (10th Cir. 1987) (en banc) (quotations omitted).

be cancelled because the registration was improperly granted under Georgia law. We agree.

1. Additional Legal Background

“[W]hen interpreting Georgia trademark law, we look for guidance to general principles of American trademark law as reflected in persuasive federal precedents . . . and in trademark law treatises.” *McHugh Fuller Law Grp., PLLC v. PruittHealth, Inc.*, 794 S.E.2d 150, 154 (Ga. 2016).

a. Georgia trademark applications

An applicant for a Georgia trademark must provide “[a] description of the goods or services in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods or services,” and “[t]he date when the trademark or service was first used anywhere,” and in Georgia. Ga. Code Ann. § 10-1-442(a)(2)-(3). A service mark is “used” “when it is used to identify the services of one person and to distinguish them from the services of others and such services are sold or otherwise rendered in [Georgia].” *Id.* § 10-1-440(c). Unlike federal law, which allows for registration on the basis of intent to use a mark, *see* 15 U.S.C. § 1051(b); *VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, 921 F.3d 1364, 1369 (Fed. Cir. 2019), Georgia law requires the registrant to use the mark before registration, *see* Ga. Code Ann. § 10-1-440(c); *id.* § 10-1-442(a)(2)-(3).

b. Cancellation

A party seeking cancellation of a trademark registration “must prove two elements: (1) that it has standing; and (2) that there are valid grounds for

canceled the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000). The standing element in the cancellation context is distinct from Article III standing and is not jurisdictional. *See id.* Cancellation standing requires “that the party seeking cancellation believe that it is likely to be damaged by the registration.” *Id.*

In Georgia, “[t]he Secretary of State shall cancel . . . [a]ny registration concerning which a court of competent jurisdiction shall find that [t]he registration was granted improperly.” Ga. Code Ann. § 10-1-448(a)(3) (C). Thus, a valid ground for cancellation arises when a Georgia mark is registered and the registrant did not “use” the mark prior to registration within the meaning of Georgia law. *See Aycock v. Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009) (“The registration of a mark that does not meet the use requirement is void ab initio.”).

c. Reforming a registration

In some instances, reformation of a registration is appropriate rather than full cancellation. An “applicant’s nonuse of its mark on some of the identified services” in the registration is distinct from an “applicant’s complete failure to make use of its mark before filing the application on any of its identified services.” *Grand Canyon W. Ranch v. Hualapai Tribe*, Opp. No. 91162008, 2006 WL 802407, at *2 (T.T.A.B. 2006). Although “the harsh remedy of voiding the application [i]s appropriate” for complete failure to use the mark before registration, “applicants that have used the mark in connection with some of the goods or services identified in their applications, but not others, may cure this problem by amending their applications to

delete the offending goods and services.” *See Kelly Servs., Inc. v. Creative Harbor, LLC*, 846 F.3d 857, 869 (6th Cir. 2017) (quotations omitted).

2. Analysis

Mr. Underwood’s Georgia registration should be cancelled because the registration was “granted improperly” and there is no basis for reformation.

a. Registration was “granted improperly”

The registration for the E.R.I.C.A. mark was “granted improperly.” *See* Ga. Code Ann. § 10-1-448 (a)(3)(C).⁹

⁹ BofA pled its cancellation counterclaim under Ga. Code Ann. § 10-1-448(a)(3)(D), contending the registration was “fraudulently obtained.” App. (No. 19-1349), Vol. 1 at 28, 31, 48. Without amending the counterclaim, BofA moved for partial summary judgment under Ga. Code Ann. § 10-1-448(a)(3)(C), arguing the registration “was granted improperly.” *See id.* at 78. In his response brief to the motion for summary judgment, Mr. Underwood acknowledged that “[t]he Defendant does not seek summary judgment under the fraud prong of the Georgia statute, but rather pursuant to section (C) pertaining to an improperly granted registration.” App. (No. 19-1349), Vol. 2 at 153 (citation omitted). And the district court granted the motion on the ground that the registration was “granted improperly,” not that it was “fraudulently obtained.” *Id.* at 398. The district court thus properly decided the issue of cancellation on the “granted improperly” ground by consent of the parties under Federal Rule of Civil Procedure 15(b)(2). Rule 15(b)(2) provides: “When an issue not raised by the pleadings is tried by the parties’ express or implied consent, it must be treated in all respect as if raised in the pleadings. . . . [F]ailure to amend does not affect the result of the trial of that issue.” *See also Sinclair Wyo. Refin. Co. v. A&B Builders, Ltd.*, 989 F.3d 747, 777 n.18

First, Mr. Underwood does not contest in his briefs that BofA has standing because “being sued for infringement is sufficient to support standing for a counterclaim for cancellation.” *World Mkt. Ctr. Venture, LLC v. Tex. Int’l Prop. Assocs.*, No. 2:08-cv01753-RCJ-GWF, 2009 WL 3303758, at *3 (D. Nev. Oct. 14, 2009). The continuing Georgia registration gave BofA “a reasonable belief that there is a likelihood of damage caused by the continuing registration of the [E.R.I.C.A.] mark,” *see* 3 McCarthy § 20:46, by jeopardizing the incontestability of BofA’s registered federal service mark, *see* 15 U.S.C. § 1065 (describing the “incontestable” rights of a federal registration holder “except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State . . .”).

Second, BofA has valid grounds to seek cancellation of Mr. Underwood’s Georgia registration. In opposing BofA’s motion for partial summary judgment, Mr. Underwood “admit[ted] . . . that prior to 2015 [he] did not use the Georgia trademark in connection with a service that ‘verbally tells the news and current events through cell phone and computer applications.’” App. (No. 19-1349), Vol. 2 at 151. His admission that he had not used the Georgia trademark with the services specified on the Georgia registration resolves the question whether the services were “used” before October 2010. *See* Ga. Code Ann. § 10-1-442(a)(2)-(3); *id.* § 10-1-440(c). Because Mr. Underwood did not satisfy

(10th Cir. 2021) (noting that Rule 15(b) can apply to counterclaims at summary judgment).

the statutory use requirement for registration, the district court correctly ordered that it be cancelled.¹⁰

b. No basis for reformation of the registration

Mr. Underwood argues that rather than cancelling the registration, the district court should have reformed the registration to reflect that he used the E.R.I.C.A. mark “in partial conformity with the registration.” Aplt. Br. (No. 19-1349) at 6. We disagree.

Mr. Underwood cannot show any basis to reform his Georgia registration. The Georgia registration lists only a single service associated with the E.R.I.C.A. mark: “E.R.I.C.A. verbally tells the news and current events via cell phones and computer applications.” App. (No. 19-1349), Vol. 1 at 141 (capitals omitted). Mr. Underwood’s admission that he did not use the mark in connection with the only service listed on the registration before October 2010 means that he cannot show a necessary precondition for reformation—that he used the mark with “*some* of the goods or services identified in the[] application[], but not others.” *Kelly Servs.*, 846 F.3d at 869 (emphasis added).

Mr. Underwood’s suggestion that the district court could have reformed the registration to “a computer animated woman” lacks merit. Aplt. Br. (No. 19-1349) at 7. The “computer animated woman”

¹⁰ Mr. Underwood is incorrect that cancellation “is reserved for a finding of fraud.” See Aplt. Br. (No. 19-1349) at 9. In Georgia, cancellation because a “registration was obtained fraudulently,” Ga. Code Ann. § 10-1-448(a)(3)(D), and cancellation because a “registration was granted improperly,” *id.* § 10-1-448(a)(3)(C), are separate grounds.

language comes from the registration's description of the E.R.I.C.A. mark, not from the registration's list of services that the mark purported to identify or distinguish. *See* App. (No. 19-1349), Vol. 1 at 141. Under trademark law principles, "it is the trade, and not the mark, that is to be protected." *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 416 (1916), *superseded on other grounds by* 15 U.S.C. § 1072. Without a showing of the relevant services the mark identifies and distinguishes, the mark itself is not protectible. *See* 2 McCarthy § 16:1 ("The way to obtain rights in a business symbol is to actually *use* it as a mark.").

Finally, Mr. Underwood's argument that mitigating circumstances counsel against complete cancellation is unavailing. He urges that his statement of use in the Georgia application was harmless or unintentional rather than fraudulent. But because the basis for cancellation here is that the registration was "granted improperly," not that it was "obtained fraudulently," it is irrelevant that Mr. Underwood "did not purposely misstate his use," or that "the Georgia Secretary of State directly led [Mr.] Underwood to believe that his website-use and promotional-use were sufficient to file a use-based application." *Aplt. Br.* (No. 19-1349) at 11.

* * * *

We affirm the cancellation of Mr. Underwood's Georgia registration.

C. Infringement Claims

The district court granted summary judgment to BofA on Mr. Underwood's claims that BofA infringed

his E.R.I.C.A. and my24erica.com service marks. On appeal, Mr. Underwood argues he established a protectable interest in both marks through actual and analogous use. On the E.R.I.C.A. mark, we vacate summary judgment because the district court applied the wrong legal standard for actual use. We affirm summary judgment on the my24erica.com mark.

1. Additional Legal Background

a. Section 43(a)

Section 43(a) of the Lanham Act prohibits anyone, “in connection with any goods or services, . . . [from] us[ing] in commerce any word, term, name, symbol, or device, or any combination thereof, . . . which is likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A).¹¹ To prevail under Section 43(a), a plaintiff must show “(1) that the plaintiff has a protectable interest in the mark; (2) that the defendant has used an identical or similar mark in commerce; and (3) that the defendant’s use is likely to confuse customers.” *1-800 Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1238 (10th Cir. 2013) (citation and quotations omitted).

¹¹ The opinion’s discussion of the Lanham Act Section 43(a) claim is applicable to the other two claims on which the district court granted summary judgment: common law service mark infringement and common law unfair competition. *See Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1219 (10th Cir. 2004) (common law service mark infringement has similar elements as a claim under Section 43(a)); *Suntree Techs., Inc. v. Ecosense Int’l, Inc.*, 693 F.3d 1338, 1345 (11th Cir. 2012) (same for common law unfair competition); *see also* 1 McCarthy § 1:19.50 (noting that Section 43(a) “federalized” the common law of trademark infringement and unfair competition).

This appeal addresses only the first element, whether Mr. Underwood has a protectable interest in the E.R.I.C.A. and my24erica.com marks. When, as here, the plaintiff's marks are unregistered, the plaintiff has the "burden to demonstrate that [the mark] is protectable under § 43(a)." *Donchez*, 392 F.3d at 1216.

b. Protectable interest

A plaintiff acquires a protectable interest by "us[ing] a distinct mark in commerce." *See B&B Hardware*, 576 U.S. at 142. "[S]o long as a person is the first to use a particular mark," that person will prevail against subsequent users of the mark. *See ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 147 (2d Cir. 2007). Under the Lanham Act, the plaintiff must make "bona fide use of a mark in the ordinary course of trade, and not . . . merely to reserve a right in a mark." 15 U.S.C. § 1127. A service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce." *Id.*

The plaintiff's "use of a mark in commerce . . . must be sufficient to establish *ownership rights* for a plaintiff to recover against subsequent users under section 43(a)." *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1195 (11th Cir. 2001). This requirement has its roots in the common law "rule of trademark ownership in the United States[,] priority of use." 2 McCarthy § 16:1.¹² Whether such prior use is

¹² As stated above, the first element of a § 43(a) claim requires a plaintiff to establish a protectable interest in a mark, while the second and third elements correspond to the defendant's infringing conduct. Both a plaintiff's protectable interest and a defendant's

sufficient to confer a protectable interest in the mark does not turn on whether the use was for profit, but instead on whether the activities “bear elements of competition, notwithstanding [a] lack of an immediate profit-motive.” *Planetary Motion*, 261 F.3d at 1200; *see id.* at 1199 (“Common law unfair competition protection extends to non-profit organizations because they nonetheless engage in *competition* with other organizations.”).

The parties agree that a plaintiff may show use sufficient to establish a protectable interest through (1) “actual use in the market,” *Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 354 (6th Cir. 1998) (quotations omitted); or (2) “prior use analogous to trademark or service mark use,” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002). As to either, the plaintiff must show use of the mark as a service mark, which means use “to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.” 15 U.S.C. § 1127.

infringing conduct require use of a mark in commerce. In this appeal, we need only address the first element.

The “use of commerce” language in § 43(a) serves the further purpose of “reflect[ing] Congress’s intent to legislate to the limits of its authority under the Commerce Clause, rather than to limit the Lanham Act to profit-seeking uses of a trademark.” *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997); *see* 15 U.S.C. § 1127 (“The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”). The conduct in this case is regulable because both the plaintiff’s marks and the defendant’s mark are used on the internet, and “the Internet is generally an instrumentality of interstate commerce.” *Id.*

i. Actual use

Actual use of a mark consists of “attempt[s] to complete genuine commercial transactions.” *Allard Enters.*, 146 F.3d at 359. A service mark is used in commerce when services are “rendered to others,” that is, “[when] the service provider *in fact* benefits third parties, regardless of its reason for providing its services.” *Morningside Grp. Ltd. v. Morningside Cap. Grp., LLC*, 182 F.3d 133, 138 (2d Cir. 1999) (quotations omitted). To establish actual use, “[t]he extent or duration of use is of no particular significance other than to the extent that it demonstrates [an] intention to adopt.” *Drexel Enters., Inc. v. Richardson*, 312 F.2d 525, 527 (10th Cir. 1962). Even “a single use in trade may sustain trademarks rights if followed by continuous commercial utilization.” *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975). The use must be part of a bona fide transaction, and not, for example, use indicating “the *mere* intent to reserve a mark for later use.” *Allard Enters.*, 146 F.3d at 359 (emphasis added).

Although “a website that bears a trademark may constitute a bona fide use in commerce,” the website must “identify [the] goods or services [the owner] could have provided through or in connection with the website.” *Specht v. Google Inc.*, 747 F.3d 929, 934 (7th Cir. 2014); *see also Schreiber v. Dunabin*, 938 F. Supp. 2d 587, 598 (E.D. Va. 2013) (noting that merely “operating a website available on the Internet is not equivalent to use in United States commerce”). “The important question is not how readily a mark will be noticed but whether, when noticed, it will be understood as identifying and indicating the origin of the services.” TMEP § 1301.02 (8th ed. Oct. 2018).

ii. Analogous use

In contrast to actual use, which is use of the mark in a genuine transaction involving the provision of goods or services, analogous use is use in commerce that is non-transactional. It typically consists of “promotional efforts” for the goods or services at issue, *FN Herstal SA v. Clyde Armory Inc.*, 838 F.3d 1071, 1081 (11th Cir. 2016), such as “advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications,” *T.A.B. Sys. v. Pactrel Teletrac*, 77 F.3d 1372, 1375 (Fed. Cir. 1996). No genuine transaction is required to acquire a protectable interest in the mark.

Although actual use need not have a “substantial impact on the purchasing public,” analogous use must be “of such a nature and extent as to create public identification of the target term with the [user’s] product or service.” *See T.A.B. Sys.*, 77 F.3d at 1375-76. “[A]nalogous use must be use that is open and notorious,” that is, “of such a nature and extent that the mark has become popularized in the public mind so that the relevant segment of the public identifies the marked goods with the mark’s adopter.” *Am. Express v. Goetz*, 515 F.3d 156, 161-62 (2d Cir. 2008) (quotations omitted).

2. Analysis

Mr. Underwood argues that before BofA’s October 2016 priority date, he established protectable interests through both actual use and analogous use of the E.R.I.C.A. mark and the my24erica.com mark. On the E.R.I.C.A. mark, we find the district court (1) addressed actual use but did so under an incorrect legal standard, and (2) correctly found there was

insufficient analogous use of the E.R.I.C.A. mark. On the my24erica.com mark, we find it was not actually or analogously used as a service mark.

a. E.R.I.C.A. mark

i. Actual use

Mr. Underwood argues he can show actual use of the E.R.I.C.A. mark because, “by March 2015, [he] was using the E.R.I.C.A. . . . mark[] on his My24erica.com website . . . to provide actual search-engine and personal-assistant services to the public.” Aplt. Br. at 31; *see id.* at 5 (“The record demonstrates that Mr. Underwood used the E.R.I.C.A. mark in conjunction with *actual* services provided to the general public no later than March 2015 . . .”). The district court passed upon this issue but applied the wrong legal standard. We therefore vacate the summary judgment in favor of BofA on Mr. Underwood’s infringement claims concerning the E.R.I.C.A. mark and remand for the district court to apply the correct actual use standard.

1) District court passed on actual use

BofA asserts that Mr. Underwood failed to present an actual use argument to the district court. *See* Aplee. Br. at 15. Even so, we may consider actual use on appeal if the “district court explicitly consider[ed] and resolve[d] [the] issue of law on the merits.” *Tesone v. Empire Mktg. Strategies*, 942 F.3d 979, 991 (10th Cir. 2019). Courts may review a question “not pressed so long as it has been passed upon.” *Lebron v. Nat’l R.R. Passenger Corp.*, 513 U.S. 374, 379 (1995) (quotations omitted).

A district court “passes upon an issue when it applies the relevant law to the relevant facts.” *Tesone*, 942 F.3d at 992 (quotations omitted). The district court’s order addressed actual use by considering and rejecting it as a basis for Mr. Underwood’s protectable interest in the E.R.I.C.A. mark.¹³ Because the district court “recognized that the [actual use] theory [Mr. Underwood] presents on appeal was at play in the litigation and rejected it,” the issue is properly before us. *See Mid Atl. Cap. Corp. v. Bien*, 956 F.3d 1182, 1195 n.6 (10th Cir. 2020).

The district court identified two ways to meet the Lanham Act’s protectable-interest requirement: (1) when “actual sales have occurred,” or (2) through “analogous use.” App., Vol. 6 at 1450. In its explanation of the background legal principles, the court’s discussion of analogous use dwarfed its brief mention of “actual sales.” And if the court had not discussed actual sales further, we might conclude it had not passed upon the issue of actual use.

But the district court addressed whether Mr. Underwood had a protectable interest in the E.R.I.C.A. mark in two sections that were clearly set off with

¹³ Mr. Underwood did not waive through inadequate appellate briefing the argument that the district court passed upon the issue of actual use. Responding to BofA’s response brief argument that he forfeited the actual use issue in district court, Mr. Underwood cited “authority” and provided “analysis” to argue that the district court passed upon the issue of actual use. *See Burke v. Regalado*, 935 F.3d 960, 1018 n.44 (10th Cir. 2019). Nor did he waive this argument by presenting it for the first time in the reply brief. We will consider such an argument when, as here, the “new issue argued in the reply brief is offered in response to an argument raised in the appellee’s brief.” *Beaudry v. Corr. Corp. of Am.*, 331 F.3d 1164, 1166 n.3 (10th Cir. 2003).

“[f]irst” and “[s]econd” identifiers. *See id.* at 1450-51. In the first section on actual use, the court found that “it [wa]s undisputed that no customers purchased goods or services offered under the mark,” and that the Plaintiffs had not “generated any revenue from their use of the mark.” *Id.* at 1450. It also found that the Plaintiffs had never used the mark in connection with the services described in the Georgia registration. *Id.* at 1450-51. The court therefore rejected that Mr. Underwood had established a protectable interest in the E.R.I.C.A. mark through actual sales and use of the mark.¹⁴ In the second section on analogous use, the court explained that “Plaintiffs have not presented evidence of any promotional activities, including hosting of the website, demonstrating that a substantial share of the consuming public was reached or came to identify the E.R.I.C.A. mark with their services.” *Id.* at 1451. It therefore rejected Mr. Underwood’s reliance on analogous use.

The district court’s actual use analysis applied what it believed to be “relevant law to the relevant facts.” *Tesone*, 942 F.3d at 992 (quotations omitted). The court identified as “relevant law” that actual use sufficient to establish a protectable interest arises when “customers purchase[] goods or services offered under the mark,” or when the user “generates any

¹⁴ In the introductory part of the order, the district court stated, “In determining that Plaintiffs had failed to satisfy the prerequisites for Georgia registration, the Court did not reach the issue of whether Plaintiffs had presented sufficient evidence of ‘analogous use’ that would establish priority over Defendant’s use of its mark. On that basis, Defendant now moves for summary judgment and dismissal of the entire case.” App., Vol. 6 at 1449 (citation omitted). This passage does not alter that the court also addressed the issue of actual use.

revenue from their use of the mark.” App., Vol. 6 at 1450. It identified the “relevant facts” as follows: (1) “it is undisputed that no customers purchased goods or services offered under the mark”; (2) “nor have Plaintiffs generated any revenue from their use of the mark”; and (3) “Plaintiffs have not shown that they ever used their mark with any service . . . as described in the Georgia registration.” *Id.* at 1450-51. The court did not simply address actual use in passing, but instead “develop[ed] additional facts” concerning whether Mr. Underwood could establish a protectable interest through actual use by reference to sales, revenue, and use of the mark in connection with services. *See United States v. Criollo-Casteneda*, 89 F. App’x 173, 175 (10th Cir. 2004) (unpublished).¹⁵

Although the district court’s analysis of actual use lacked case citations, the court “resolve[d] an issue of law on the merits.” *See United States v. Hernandez-Rodriguez*, 352 F.3d 1325, 1328 (10th Cir. 2003).¹⁶

¹⁵ As explained below, the district court made two legal errors in its actual use analysis. A district court need not decide an issue correctly to have passed upon the issue. The “passed upon” argument usually arises when an appellant seeks reversal on an issue that the appellee argues was forfeited in district court. *See Tesone*, 942 F.3d at 991-93.

¹⁶ In fact, the entire order had few citations. The district court cited only two district court opinions for the analogous use standard, *see* App., Vol. 6 at 1450, and its analogous use analysis cited only an additional district court and Ninth Circuit opinion, *see id.* at 1451-52. Also, until today, we have discussed the actual use standard in any depth only once, in *Drexel Enterprises, Inc. v. Richardson*, 31 F.2d 525, 526-27 (10th Cir. 1962). Thus, in context, the order’s lack of citations to actual use authorities does not mean the court failed to apply “relevant law” to the “relevant facts.” *See Tesone*, 942 F.3d at 992.

The court's reasoning, though brief, "evaluate[d] th[e] legal issue" of actual use to the extent it believed was required to give a "comprehensive resolution." See *Criollo-Casteneda*, 89 F. App'x at 175.

2) Legal error and remand

The district court applied the wrong legal standard to the issue of actual use of the E.R.I.C.A. mark. We therefore remand for the court to apply the correct standard.

"When the court of appeals notices a legal error, it is not ordinarily entitled to weigh the facts itself and reach a new conclusion; instead, it must remand to the district court for it to make a new determination under the correct law." *United States v. Hasan*, 609 F.3d 1121, 1129 (10th Cir. 2010). When the district court has taken "an erroneous view of the law, a remand is the proper course unless the record permits only one resolution of the factual issue." *Pullman-Standard v. Swint*, 456 U.S. 273, 292 (1982).

Here, the district court committed two legal errors. First, it assumed that customers must have "purchased" the services offered or that Mr. Underwood must have generated revenue to qualify as actual use. App., Vol. 6 at 1450-51. But a service mark is used when "the service provider *in fact* benefits third parties, regardless of its reason for providing its services." *Morningside Grp.*, 182 F.3d at 138. Second, the court erred by limiting the services at issue to those listed in the Georgia registration. It should have considered the search engine and personal assistant services that Mr. Underwood claims my24erica.com offered and that form the basis of Mr. Underwood's Section 43(a) claim. See, e.g. App., Vol. 1 at 18 (describing my24erica.com

in the complaint as, among other things, “an interactive global search engine platform”).

Under the correct view of the law, to establish a protectable interest in the E.R.I.C.A. mark based on actual use, Mr. Underwood must establish (1) my24erica.com—the only place where Mr. Underwood claims services were offered in connection with the mark—was publicly accessible before BofA’s priority date of October 2016; (2) search engine and personal assistant services on my24erica.com were “rendered to others” before October 2016, *Morningside Grp.*, 182 F.3d at 138 (quotations omitted); and (3) as it appeared on the my24erica.com website display, the E.R.I.C.A. mark “clearly identif[ied] and distinguish[ed]” the services offered “on the website,” 2 McCarthy § 16:32.70.

We decline to address these factual issues under the correct actual use legal standard in the first instance. Instead, we remand “out of an abundance of caution and in the interest of justice, because we have difficulty concluding that the record leads ineluctably to only one result” on the issue of actual use. *See In re Woods*, 743 F.3d 689, 707 (10th Cir. 2014).¹⁷

ii. Analogous use

Our remand is limited to the actual use issue because the district court did not err in concluding that Mr. Underwood could not show analogous use of the E.R.I.C.A. mark. Thus, on remand, Mr. Underwood

¹⁷ As explained above, BofA’s counterclaims became moot in light of the district court’s disposition of Mr. Underwood’s infringement claims. On remand, the district court should address BofA’s counterclaims.

may not pursue his analogous use theory for the E.R.I.C.A. mark.

For a finding of analogous use of the E.R.I.C.A. mark before October 2016, Mr. Underwood relies on evidence of (1) use at business meetings, (2) distribution of around 1,500 business cards to undisclosed people, (3) distribution of around 200 promotional DVDs to undisclosed people, and (4) use at a meeting with AT&T in preparation for the failed joint venture. He also cites the my24erica.com website itself and the 772 Facebook likes purportedly associated with the my24erica.com website. No reasonable jury could find analogous use from this evidence.

First, there is no evidence that any of the promotional activities in the years 2009 to 2012—the use of the mark in a PowerPoint presentation at business meetings, on business cards, on promotional DVDs, and with AT&T—were known outside of a small handful of industry actors. Such behind-the-scenes activities are insufficient to show that the mark was “popularized in the public mind.” *See Goetz*, 515 F.3d at 162 (quotations omitted) (using a slogan “only in communications with a few commercial actors within the credit card industry” was insufficient to demonstrate an association in the public mind). When “the use of . . . marks in the provision of services [i]s limited to a handful of presentations [and] seminars,” that is the “sort of minimal activity [that] is insufficient to satisfy the ‘use’ element of the test.” *Int’l Healthcare Exch. v. Glob. Healthcare Exch., LLC*, 470 F. Supp. 2d 365, 371 (S.D.N.Y. 2007). Based on the lack of evidence that members of the general public received the business cards or the DVDs, these promotional activities do not demonstrate a “substantial impact on the

purchasing public.” See *FN Herstal*, 838 F.3d at 1081 (quotations omitted).

Second, the evidence concerning my24erica.com itself—the fact of its existence and the Facebook likes—is insufficient to demonstrate widespread association in the public mind between the Plaintiffs’ search engine services and the E.R.I.C.A. mark. Even assuming that the 772 likes on the My24HourNews.Com Facebook page as of October 2018 indicate that 772 people visited my24erica.com at some point and used its services, that evidence would not create a fact question about analogous use.

Mr. Underwood needed to establish protectability as of October 2016. But the record does not show how many people visited my24erica.com before October 2016. Even if we credited all 772 likes to the period before October 2016, the website usage is insufficient to show that a significant segment of the public associated the E.R.I.C.A. mark with the search engine services. In *T.A.B. Systems*, the Federal Circuit found that “purchaser perception must involve more than an insubstantial number of potential customers. For example, if the potential market for a given service were 10,000 persons, then advertising shown to have reached only 20 to 30 people as a matter of law could not suffice.” *T.A.B. Sys.*, 77 F.3d at 1377.

T.A.B. Systems shows the weakness of Mr. Underwood’s analogous use argument because there is a wide gap between the “potential market” for his internet services and the actual number of users. Though he claims to have offered services globally over the internet, Mr. Underwood can point to evidence of no more than 772 users total before October 2016. See *Westrex Corp. v. New Sensor Corp.*, Opp. Nos. 91168152

& 91170940, 2007 WL 1676790, at *5 (T.T.A.B. 2007) (finding no analogous use when despite efforts to publicize the business, there was little, if any, response). The low number of users relative to the “potential market” demonstrates that no more than “an insubstantial number of potential customers” were aware of my24erica.com, let alone that they were aware of the services offered on the website and associated the E.R.I.C.A. mark with those services.

Thus, Mr. Underwood’s analogous use theory lacks merit.

b. my24erica.com mark

Mr. Underwood has failed to establish a protectable interest in the my24erica.com mark.¹⁸ To qualify as a service mark that has been used in commerce, whether under an actual or analogous use theory, the mark must “identify and distinguish the services of one person . . . from the services of others.” 15 U.S.C. § 1127. Because there is no dispute of fact that my24erica.com did not perform this function, it is not protectable.

¹⁸ The district court did not separately address whether the my24erica.com mark is protectable, even though Mr. Underwood’s complaint, App., Vol. 1 at 19, and opposition to summary judgment, App., Vol. 2 at 428, asserted that his infringement claims were based on his ownership of the E.R.I.C.A. and my24erica.com marks. The parties have fully briefed the issue of the protectability of the my24erica.com mark on appeal, the record is fully developed, our review is de novo, and the outcome is clear. We therefore exercise our discretion to address the issue rather than remand. *See Anixter v. Home-Stake Prod. Co.*, 77 F.3d 1215, 1229 (10th Cir. 1996) (reaching an issue not reached by the district court when it was properly before the district court, fully briefed on appeal, and no further fact-finding was necessary).

In certain situations, a domain name may be protectable under the Lanham Act. *See U.S. Pat. & Trademark Off. v. Booking.com B. V.*, 140 S. Ct. 2298, 2308 (2020). But the “mere registration of a domain name [i]s not sufficient.” *Brookfield Comm’cns v. W. Coast Ent’mnt Corp.*, 174 F.3d 1036, 1052 (9th Cir. 1999). Like all marks, a domain name must be “used to identify and distinguish the source of goods or services” to be protectable. 1 McCarthy § 7:17.50. “Out of the millions of domain names, probably only a small percentage also play the role of a trademark or service mark.” *Id.* A domain name is protectable if the domain itself has an “association with [the services] in the mind of the public based on the evidence of the length and nature of the use of the [domain name] mark.” *St. Luke’s Cataract & Laser Inst. v. Sanderson*, 573 F.3d 1186, 1209 (11th Cir. 2009).

The baseline association the public has with a domain name is to use it to “identif[y] an address on the Internet,” *Booking.com*, 140 S. Ct. at 2303 n.1, “an identifier somewhat analogous to a telephone number,” *Brookfield Comm’cns*, 174 F.3d at 1044; 1 McCarthy § 7:17.50 (“Like a street address or telephone number, every domain name serves the purely technological function of locating a web site in cyberspace.”). It is thus normally difficult for a plaintiff to show that, beyond serving this logistical location-identifying function, the domain name is also “used to identify and to distinguish goods or services.” *See Brookfield Comm’cns*, 174 F.3d at 1051.

Mr. Underwood cannot show that my24erica.com is one of the “small percentage” of domain names that qualify as service marks. There is no evidence Mr. Underwood deployed the designation my24erica.com

for anything more than “as an address by means of which one may reach [his] Internet website.” *In re Vicki Roberts*, Serial No. 76649075, 2008 WL 1944634, at *4 (T.T.A.B. 2008). For example, there is no evidence that my24erica.com, as opposed to the E.R.I.C.A. mark, had a prominent place on the website, or that anything in the display “focused the web-user’s attention on that name.” *See St. Luke’s*, 573 F.3d at 1207. Nor did the my24erica.com domain name appear on any advertisements or other promotional materials, in contrast to the My24HourNews.Com name. *See id.*

The my24erica.com mark is thus not entitled to protection.

III. CONCLUSION

On BofA’s cancellation counterclaim, we affirm summary judgment against Mr. Underwood. On Mr. Underwood’s infringement claims, (1) we vacate summary judgment for BofA on the E.R.I.C.A. mark and remand for the district court to apply the correct actual use standard, and (2) we affirm summary judgment for BofA on the my24erica.com mark. Proceedings on remand shall be consistent with this opinion.

**ORDER, U.S. DISTRICT COURT FOR THE
DISTRICT OF COLORADO
(AUGUST 9, 2022)**

IN THE UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF COLORADO

ERIK M. UNDERWOOD, a Colorado citizen,
and, MY24HOURNEWS.COM, INC.,
a Colorado corporation,

Plaintiffs,

v.

BANK OF AMERICA CORPORATION,
a Delaware corporation,

Defendant.

Civil Action No. 18-cv-02329-RM-MEH

Before: Raymond P. MOORE,
United States District Judge.

ORDER

This service mark infringement case is before the Court on remand from the United States Court of Appeals for the Tenth Circuit. *See Underwood v. Bank of Am. Corp.*, 996 F.3d 1038 (10th Cir. 2021). The Tenth Circuit vacated summary judgment in Defendant's favor on Plaintiffs' infringement claims premised on their prior actual use of their purported E.R.I.C.A.

service mark but otherwise affirmed summary judgment for Defendant. The Court now considers whether there is evidence Plaintiffs had a protectable interest in the E.R.I.C.A. mark through actual use before October 2016, focusing on the three relevant factual issues identified by the Tenth Circuit:

Under the correct view of the law, to establish a protectable interest in the E.R.I.C.A. mark based on actual use, [Plaintiffs] must establish (1) my24erica.com—the only place where Mr. Underwood claims services were offered in connection with the mark—was publicly accessible before [Defendant's] priority date of October 2016; (2) search engine and personal assistant services on my24erica.com were rendered to others before October 2016; and (3) as it appeared on the my24erica.com website display, the E.R.I.C.A. mark clearly identified and distinguished the services offered on the website.

Id. at 1057 (citations, quotation marks, and brackets omitted).

I. Legal Standard

Summary judgment is appropriate only if there is no genuine dispute of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986); *Stone v. Autoliv ASP, Inc.*, 210 F.3d 1132, 1136 (10th Cir. 2000); *Gutteridge v. Oklahoma*, 878 F.3d 1233, 1238 (10th Cir. 2018). Applying this standard requires viewing the facts in the light most favorable to the nonmoving party and resolving all factual disputes and reasonable inferences in his

favor. *Cillo v. City of Greenwood Vill.*, 739 F.3d 451, 461 (10th Cir. 2013). However, “if the nonmovant bears the burden of persuasion on a claim at trial, summary judgment may be warranted if the movant points out a lack of evidence to support an essential element of that claim and the nonmovant cannot identify specific facts that would create a genuine issue.” *Water Pik, Inc. v. Med-Sys., Inc.*, 726 F.3d 1136, 1143-44 (10th Cir. 2013). “The mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact.” *Scott v. Harris*, 550 U.S. 372, 380 (2007) (citation omitted). A fact is “material” if it pertains to an element of a claim or defense; a factual dispute is “genuine” if the evidence is so contradictory that if the matter went to trial, a reasonable jury could return a verdict for either party. *Anderson*, 477 U.S. at 248.

II. Background

In October 2016, Defendant filed a successful application to register its ERICA mark with the United States Patent and Trademark Office. Because Plaintiffs’ purported E.R.I.C.A. mark is unregistered, Defendant is entitled to summary judgment on claims premised on the use of its mark and to declaratory relief on its counterclaims unless Plaintiffs have raised a genuine issue of material fact as to their actual use of the E.R.I.C.A. mark before October 2016.¹

¹ Pursuant to the Tenth Circuit’s ruling, Plaintiffs may not pursue their analogous use theory for the E.R.I.C.A. mark and

Having considered supplemental briefing following remand (ECF Nos. 180, 181), the Court concludes there is no evidence raising a genuine issue of material fact as to the second and third issues identified above, and therefore Defendant is entitled to prevail on the last remaining issue in this case.

III. Discussion

Because the E.R.I.C.A. mark is not registered, Plaintiffs bear the burden of establishing that it is protectable. *See Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1050 (10th Cir. 2008); *see also United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97, (1918) (“[T]he right to a particular mark grows out of its use, not its mere adoption.”). As pertinent here, a service mark is “in use in commerce . . . when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.” 15 U.S.C. § 1127. Thus, while an actual sale of the services is not required, services not solely for the benefit of the performer must be rendered to others. *See Burns v. Realnetworks, Inc.*, 359 F. Supp. 2d 1187, 1192 (W.D. Okla. 2004); *Morningside Grp. Ltd. v. Morningside Cap. Grp., L.L.C.*, 182 F.3d 133, 138 (2d Cir. 1999). “Further, the claimant must have used the claimed mark to identify its services.” *Morningside Grp.*, 182 F.3d at 138.

For present purposes, the Court assumes there is sufficient evidence in the record to present a genuine issue as whether Plaintiffs’ website was publicly accessible before October 2016. Lacking, however, is

have failed to establish a protectable interest—either through actual or analogous use—in their purported my24erica.com mark.

any evidence that search engine or personal assistant services were rendered to anyone who accessed the website before October 2016.² Plaintiffs have adduced evidence merely showing that certain individuals “visited” or “interacted with” the website before October 2016 and, vaguely, that “content was available” at the website in 2015. (ECF No. 180 at 7.) However, they fail to cite any evidence of content suggestions, recommendations, or search results that were provided to anyone at all, much less any evidence that shows any such services were rendered before October 2016. As a result, Plaintiffs have adduced no evidence that they *in fact* benefited third parties during the relevant timeframe. *See Morningside Grp.*, 182 F.3d at 138.

Also lacking is any evidence that the E.R.I.C.A. mark, as it appeared on Plaintiffs’ website before October 2016, clearly identified and distinguished any such services allegedly being provided. For example, Plaintiffs point to no evidence that any individuals who visited its website during that timeframe associated the mark with the website’s services. *See Schreiber v. Dunabin*, 938 F. Supp. 2d 587, 598 (E.D. Va. 2013) (“[O]perating a website available on the Internet is not equivalent to use in United States commerce.”); *Spect v. Google Inc.*, 758 F. Supp. 2d 570, 592 (N.D. Ill. 2010) (“[M]ere advertising is not a bona fide use in commerce of a mark.”). Accordingly, the Court finds Plaintiffs have failed to adduce evidence sufficient to

² It is undisputed that Plaintiffs have provided no evidence of any customers that purchased goods or services under the E.R.I.C.A. mark and that Plaintiffs have generated no revenue from their use of it. (ECF No. 122 at 7-8, ¶¶ 6, 7.)

show their mark was in use in commerce before October 2016.

IV. Conclusion

In the absence of any evidence that Plaintiffs rendered search engine or personal assistant services before October 2016, or that such services were clearly identified and distinguished by their E.R.I.C.A. mark, they cannot establish a protectable interest in the mark based on actual use. Therefore, Defendant is entitled to summary judgment on Plaintiffs' remaining infringement claims and on its counterclaims for declaratory relief. The Clerk is directed to ENTER JUDGMENT accordingly and CLOSE this case.

DATED this 9th day of August, 2022.

BY THE COURT:

/s/ Raymond P. Moore
United States District Judge

**ORDER DENYING PETITION FOR
REHEARING, U.S. COURT OF APPEALS FOR
THE TENTH CIRCUIT
(MAY 28, 2024)**

UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

ERIK M. UNDERWOOD, a Colorado citizen, et al.,

Plaintiffs - Appellants,

v.

BANK OF AMERICA CORPORATION,
a Delaware corporation,

Defendant - Appellee.

No. 22-1402

(D.C. No. 1:18-CV-02329-RM-MEH) (D. Colo.)

Before: BACHARACH, McHUGH, and MORITZ,
Circuit Judges.

ORDER

Appellants' petition for rehearing is denied.

The petition for rehearing en Banc was transmitted to all of the judges of the court who are in regular active service. As no member of the panel and no judge in regular active service on the court requested that the court be polled, that petition is also denied.

App.55a

Entered for the Court

/s/ Christopher M. Wolpert
Clerk

**PLAINTIFFS' SUPPLEMENTAL BRIEF
FILED IN THE U.S. DISTRICT COURT
FOR THE DISTRICT OF COLORADO,
RELEVANT EXCERPTS
(JUNE 24, 2022)**

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

ERIK M. UNDERWOOD, a Colorado citizen and
resident, and MY24HOURNEWS.COM, INC., a
Colorado corporation,

Plaintiffs and Counterclaim Defendants,

v.

BANK OF AMERICA CORPORATION, a Delaware
corporation,

Defendant and Counterclaimant.

Civil Action No. 1:18-cv-02329-RM-MEH

**PLAINTIFFS' SUPPLEMENTAL BRIEF IN
RESPONSE TO BANK OF AMERICA
CORPORATION'S MOTION FOR SUMMARY
JUDGMENT (ECF NO. 74)**

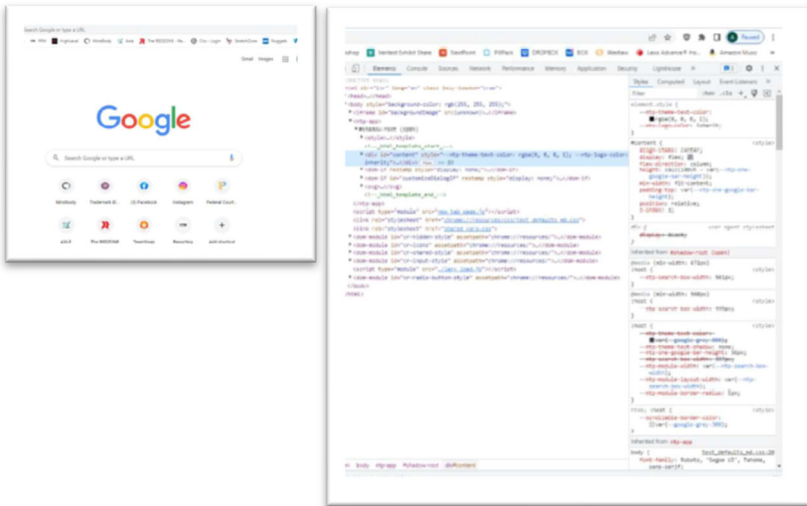
...

33. The My24Erica.Com website, since March 2015, has also included html code that provides information about Erica and the services offered through

the My24Erica.Com website. A screenshot showing the header information in the current version of the source code for the My24Erica.Com home page is shown in Exhibit 1.

34. In order to “INSPECT” the code on any website, a user can right click on the screen and the option to “INSPECT” is provided. When you click on “INSPECT,” the underlying code of the website is revealed for inspection by the public. Below is an example of what it looks like when you “INSPECT”

Google’s landing page:

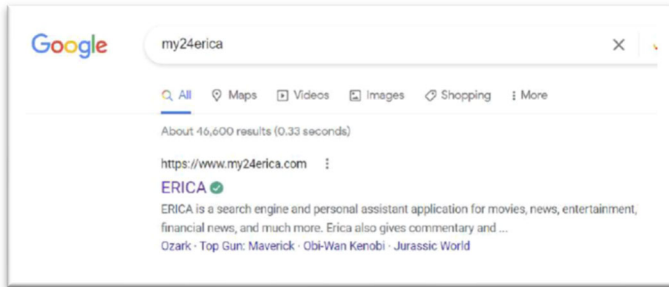


Transcription Note:

This exhibit is presented for its image, not for the specific text. Thus, no transcription of the software code is provided.

[...]

37. The tag title also causes ERICA to appear as the title of the My24Erica.Com home page in search engine results as shown in Figure 19 below.



**Figure 19: Search Results
for my24ERICA Search on Google**

Transcription:

Google my24ERICA

About 46,600 results (0.33 seconds)

<https://www.my24ERICA.com>

ERICA

ERICA is a search engine and personal assistant application for movies, news, entertainment, financial news, and much more. Erica also gives commentary and . . .

[. . .]

41. The header shown in Exhibit 1 also includes a metatag called a meta description. The description metatag for My24Erica.Com is shown in Figure 21 below. Because the text is too small to read when the entire meta description is shown across the page, I have split it into two lines in Figure 21.

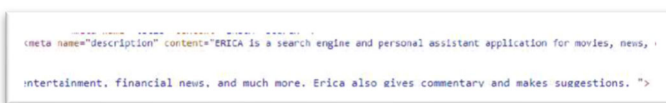
A screenshot of a code editor window with a light blue background. It displays an HTML meta description tag. The text is: `<meta name="description" content="ERICA is a search engine and personal assistant application for movies, news, entertainment, financial news, and much more. Erica also gives commentary and makes suggestions.">`. The code is color-coded: `<` is blue, `meta` is red, `name="description"` is blue, `content="` is red, the text inside the quotes is black, and `">` is red.

Figure 21: Meta Description for My24Erica.Com Home Page

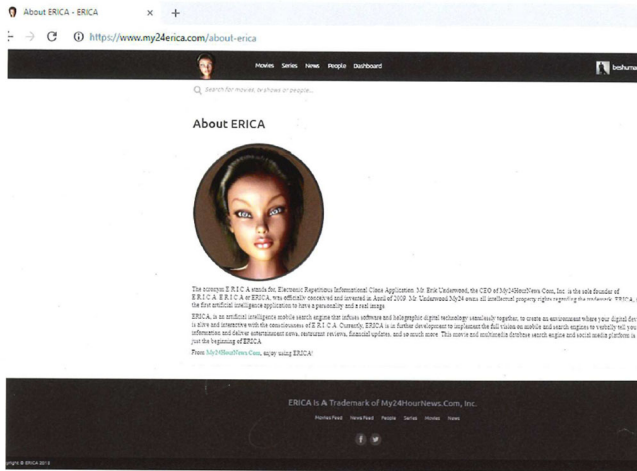
Transcription:

`<meta name="description" content="ERICA is a search engine and personal assistant application for movies, news, Entertainment, financial news, and much more. Erica also give gives commentary and makes suggestions.">`

42. The description metatag is an HTML element that allows developers to provide a brief summary of the web page. The meta description causes the associated text—here, “Erica is a search engine and personal assistant application for movies, news, entertainment, financial news, and much more. Erica also gives commentary and makes suggestions”—to appear as the header shown in the summary in search engine results as shown in Figure 21 above (although the last part of the description is cut off here).

[. . .]

E.R.I.C.A. INFORMATION (APRIL 5, 2019)



Transcription:

The acronym E.R.I.C.A stands for, Electronic Repetitious Informational Clone Application. Mr. Erik Underwood, the CEO of My24HourNews.Com, Inc. is the sole founder of E.R.I.C.A. E.R.I.C.A or ERICA, was officially conceived and invented in April of 2009. Mr. Underwood/My24 owns all intellectual property rights regarding the trademark. ERICA, is the first artificial intelligence application to have a personality and a real image.

ERICA, is an artificial intelligence mobile search engine that infuses software and holographic digital technology seamlessly together; to create an environment where your digital device is alive and interactive with the consciousness of E.R.I.C.A. Currently, ERICA is in further development to implement the full vision

on mobile and search engines to verbally tell you information and deliver entertainment news, restaurant reviews, financial updates, and so much more. This movie and multimedia database search engine and social media platform is just the beginning of ERICA.

From My24HourNews.Com, enjoy using ERICA!
