

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Norfolk Division**

THE RADIANCE FOUNDATION, INC. et al.,

Plaintiffs,

v.

CIVIL ACTION NO. 2:13cv53

**NATIONAL ASSOCIATION FOR THE
ADVANCEMENT OF COLORED PEOPLE,**

Defendant.

AMENDED MEMORANDUM OPINION AND ORDER

This Memorandum Opinion and Order is issued after a bench trial in the above-styled matter to resolve trademark infringement and trademark dilution claims.

On February 1, 2013, the Radiance Foundation, Inc. (“Radiance”) and Ryan Bomberger (“Bomberger”) brought this action for declaratory judgment against the National Association for the Advancement of Colored People (“Defendant” or “NAACP”). Radiance and Bomberger (together referred to as “Plaintiffs”) moved this Court to enter judgment declaring that their use of certain marks allegedly owned by the NAACP was not infringing, tarnishing or diluting in violation of common law or the Lanham Act. Radiance and Bomberger also requested that the Court declare their use of these trademarks protected under the First Amendment right to free speech. The NAACP filed four counterclaims against Radiance and Bomberger, asserting it is entitled to relief for trademark infringement and trademark dilution under the Lanham Act and the Virginia Code. The NAACP claimed Plaintiffs’ use of its federally registered trademarks “NAACP” and “Image Awards” and as well as the unregistered “National Association for the

Advancement of Colored People” name and Scales of Justice Seal (referred to collectively as “NAACP Marks”) was unlawful.

The Court held a bench trial, which commenced on December 10, 2013. The parties have filed post-trial briefs and this matter is now ripe for judicial determination. The Court issues the following Findings of Fact and Conclusions of Law, as required by Rule 52(a) of the Federal Rules of Civil Procedure. For the reasons set forth herein, Radiance and Bomberger’s request for declaratory judgment in their favor is **DENIED**. On the NAACP’s counterclaims, the Court **FINDS** that Plaintiffs are liable for trademark infringement and trademark dilution of the “NAACP” and “National Association for the Advancement of Colored People” trademarks.

I. FACTUAL FINDINGS

A. Factual and Procedural History

Radiance, a non-profit organization founded by Bomberger, educates the public about social issues from a Christian perspective. Compl. ¶¶ 1, 8. The NAACP is a civil rights organization that provides educational and outreach services to African Americans. Countercl. ¶¶ 8-9. After NAACP executives publicly criticized Plaintiffs’ anti-abortion billboards in 2010 and 2011, Bomberger wrote three news articles critiquing the NAACP’s position on abortion, employing the phrase “National Association for the Abortion of Colored People.”¹ Compl. ¶¶ 13-15. These articles were posted on Radiance’s websites TooManyAborted.com and TheRadianceFoundation.org as well as on a third party website LifeNews.com. Compl. ¶¶ 14-20. The first article, published June 21, 2011 on TooManyAborted.com, had a headline that read “NAACP: National Association for the Abortion of Colored People” and discussed Defendant’s

¹ Initially, California NAACP Chapter President Alice Huffman called Radiance’s billboards “horribly racist.” Trial Transcript 107:16-108:2 (hereinafter “Tr.”). Then, in June of 2011, the Huffington Post published an article about Radiance’s billboards in Georgia, quoting the NAACP’s Washington Bureau Director and Senior Vice President for Advocacy and Policy Hilary Shelton as criticizing the campaign for comparing abortion to slavery. Tr. at 108:6-109:10.

endorsement of the 2004 March for Women’s Lives. Compl. ¶ 15. The second article from July 6, 2011, published on LifeNews.com, included a graphic of the Scales of Justice Seal and stated that National Association for the Abortion of Colored People would be a fitting moniker for the NAACP. Compl. ¶¶ 19- 20. The third article, published on TheRadianceFoundation.org, LifeNews.com and TooManyAborted.com in January of 2013, discussed the NAACP’s Annual Image Awards. Compl. ¶¶ 23-26.² This article employed the phrase “National Association for the Abortion of Colored People” throughout its text and headline. *Id.* Additionally, Bomberger made a speech in December of 2012, during which he stated, “Groups such as the NAACP (which has become The National Association for the Abortion of Colored People) and the Congressional Black Caucus aid and abet this mass destruction of beautiful potential in the black community,” a statement that was later posted on TooManyAborted.com. Compl. ¶ 22.

The NAACP became aware of Radiance’s use of its marks through a Google Alert that identified the third article on LifeNews.com as a “hit” when a search for “NAACP” was performed. On January 28, 2013, the NAACP sent Plaintiffs a letter threatening to take legal action if Radiance and Bomberger did not cease to use the NAACP Marks. Compl., Ex. 7. On February 1, 2013, Radiance filed a Complaint for declaratory judgment, asserting that its use of the NAACP Marks does not constitute infringement, tarnishment or dilution and is protected speech under the First Amendment. On April 8, 2013, the NAACP filed counterclaims for trademark infringement and federal unfair competition under the Lanham Act, trademark dilution under the Trademark Dilution Revision Act, and Virginia common law trademark infringement and unfair competition.

² This third article, first published in January 2013, is the article upon which the NAACP bases its counterclaims. See *infra* Part I, Section C, point 14.

On April 29, 2013, Plaintiffs filed a motion for summary judgment simultaneously with their Answer to the counterclaims, which this Court denied. Order, Oct. 15, 2013, ECF No. 44. On November 11, 2013, after the completion of discovery, the NAACP filed a motion for summary judgment, which was also denied. Order, Dec. 6, 2013, ECF No. 70. This Court also granted-in-part and denied-in-part the motion in limine filed by the NAACP on November 6, 2013, limiting the testimony of Plaintiffs' expert Tracy Tuten, Ph.D. to opinions regarding general consumer survey principles and methodologies. Order, Dec. 11, 2013, ECF No. 76. Lastly, this Court denied the NAACP's request for a directed verdict in its favor as to its counterclaims. Order, Jan. 9, 2014, nunc pro tunc Dec. 12, 2013, ECF No. 83. The bench trial commenced on December 10, 2013 and ended on December 12, 2013.

B. Stipulated Facts

The parties have stipulated to the following facts, which the Court accepts and finds:

1. The NAACP is the nation's oldest and largest civil rights organization. It owns and maintains the website at www.naacp.org. The principal stated objectives of the NAACP are to ensure the political, educational, social, and economic equality of all citizens, and to achieve quality of rights and eliminate racial prejudice among citizens of the United States. The NAACP's leadership consists of prominent individuals in American society, including lawyers, government officials, clergy, physicians, policymakers, and social advocates.
2. The NAACP engages in and provides community outreach, informational, and educational services activities on a range of issues of importance to the African American community. With regard to health care issues, the NAACP has advocated for equal

access to quality health care for all Americans, including members of the African American community.

3. The Black community is the focus of the NAACP's activities and programs.
4. The NAACP actively solicits contributions from, among others, members of the African American community and other people of color to support its programs and outreach activities.
5. The NAACP sponsors billboards for the purpose of promoting its campaigns and outreach activities, which are focused on issues of pressing importance to members of the Black community.
6. The NAACP mark (U.S. Trademark Registration No. 1,188,182) is a valid and subsisting federally registered trademark. By virtue of this registration, the registered NAACP mark is entitled to protection under the Lanham Act, 15 U.S.C. § 1051, *et seq.*
7. The marks NAACP and NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF COLORED PEOPLE are owned and used by the NAACP, and are valid, protectable and distinctive.
8. The NAACP and NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF COLORED PEOPLE marks have achieved widespread recognition among the general public of the United States.
9. The NAACP and NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF COLORED PEOPLE are famous and strong marks.
10. The NAACP and NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF COLORED PEOPLE marks were famous before Plaintiffs' first use of them.

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