

Annex 19



June 11, 2019

Mr. Wayne B. Giampietro
Poltrock & Giampietro
123 W. Madison Street, Suite 1300
Chicago, IL 60602

Via Email (wgiampietro@giampietrolaw.com)

Re: Unauthorized Use of Your Brain On Porn Trademark

Dear Mr. Giampietro:

We provide this in response to your May 9, 2019, letter.

Your letter implies that Dr. Prause is not behind the RealYourBrainOnPorn.com website and related social media featuring “Real Your Brain On Porn” and directing and encouraging Internet users to visit the RealYourBrainOnPorn.com website. Please inform us of Dr. Prause’s connection and affiliation with the RealYourBrainOnPorn.com domain name registration and website, if she herself is not the registrant. As you referenced in your letter, we also sent the cease and desist letter to the other experts featured by Dr. Prause on the RealYourBrainOnPorn.com website. Several of those experts responded to us, specifically stating that, after receiving our letter, they wrote to Dr. Prause to ask/direct that Dr. Prause remove them from the RealYourBrainOnPorn.com website. We see from the updated list of experts currently featured on the RealYourBrainOnPorn.com website that Dr. Prause has honored those requests. Another of the experts responded to us that Dr. Prause contacted that expert in April, 2019, to ask if the expert wanted to be listed in the RealYourBrainOnPorn.com website. In light of these facts, it is disingenuous for Dr. Prause to represent that she is not responsible for or in control of the RealYourBrainOnPorn.com website. If we should be addressing our complaints to someone or some entity other than Dr. Prause or Liberos LLC, then kindly inform us whom we should be in contact with because clearly your client knows who that person or entity is.

In your letter, you claim that we mis-state the law on trademarks. We do not. In the U.S., trademark rights arise from use of mark in connection with offering a good or service and not from ownership of a federal or state registration. *See Heinemann v. General Motors Corp.*, 342 F. Supp. 203, 206, 174 U.S.P.Q. 296 (N.D. Ill. 1972), *aff’d*, 478 F.2d 1405 (7th Cir. 1973) (“It has long been held that trade or service mark rights are acquired by appropriation and use, not by registration.”). In the U.S., the rule is that ownership of a mark goes to the first-to-use and not to the first-to-file. Mr. Wilson’s many years of prior common law use and adoption of the YOUR

BRAIN ON PORN trademark for his publications and his educational and informational services throughout the U.S. give Mr. Wilson priority over your client as to the YOUR BRAIN ON PORN trademark. This priority of use would also apply in a trademark opposition before the U.S. Patent and Trademark Office against your client's U.S. Application Serial No. 88281342, should Dr. Prause not withdraw that application before the opening of the opposition period on June 25, 2019.

We also confirm that Mr. Wilson does use his YOUR BRAIN ON PORN trademark with offering goods and services in commerce. As explained in the May 1, 2019, letter, Mr. Wilson features the YOUR BRAIN ON PORN trademark as the source identifier for his publications on the subjects of addiction and effects of pornography on viewers. Mr. Wilson also features his YOUR BRAIN ON PORN trademark as the source identifier for his informational and educational services and for his YourBrainOnPorn.com website from which he provides educational and informational resources about the effects of pornography on viewers. U.S. trademark law protects the use of trademarks by for-profit and not-for-profit entities alike.

You also allege that Mr. Wilson's YOUR BRAIN ON PORN trademark is descriptive or generic. The YOUR BRAIN ON PORN trademark is neither descriptive nor generic and is at least protectible as a mark suggestive of Mr. Wilson's services. Mr. Wilson has also used and promoted the YOUR BRAIN ON PORN mark for his services for nearly nine years, building up consumer and industry recognition in the mark as a source identifier for his services. As a result of these facts and efforts, Mr. Wilson owns protectible common law trademark rights in his YOUR BRAIN ON PORN trademark. In fact, the YOUR BRAIN ON PORN brand of Mr. Wilson is so popular and well known that Dr. Prause's use of the REAL YOUR BRAIN ON PORN is itself evidence of how well known Mr. Wilson's brand is. Mr. Wilson is prepared to enforce his common law trademark rights in his YOUR BRAIN ON PORN mark that he has built over the last nine years of use of that mark in the U.S.

Mr. Wilson's efforts to enforce and protect his YOUR BRAIN ON PORN trademark in no way prevent your client from communicating her views on pornography and the effects of viewing pornography. Trademark law protects consumers from being confused by the use of significantly similar trademarks. In the current situation, we think Dr. Prause purposefully chose a trademark and web address to confuse consumers. All that she has done is put the word "Real" in front of Mr. Wilson's trademark. Dr. Prause does not need to use Mr. Wilson's trademark as a source identifier or as a web address in order for her to communicate to the public her views on pornography and the effects of viewing pornography. Dr. Prause may express and disseminate her views, opinions, and research without using a trademark that is confusingly similar to Mr. Wilson's trademark. Dr. Prause clearly knows this because of the other web addresses that she uses to link to the RealYourBrainOnPorn.com website, such as ScienceofArousal.com and PornographyResearch.com, for example. Dr. Prause could easily choose to use these or other names that are not identical or confusingly similar to Mr. Wilson's trademark to identify her website and the source of her services.

The only difference between your client's mark and web address and those of Mr. Wilson is the addition of the word "Real," which will mislead consumers into thinking that your client's

services and web site are connected to Mr. Wilson and his YOUR BRAIN ON PORN brand (confusion that we cannot imagine that your client wants) or mislead consumers into thinking that your client's website is the true YOUR BRAIN ON PORN site, when that is not the case. Your client's continued use of Mr. Wilson's YOUR BRAIN ON PORN trademark in the "Real Your Brain On Porn" mark and in the RealYourBrainOnPorn web address to provide competing services and a website featuring information about the effects of viewing pornography, as well as on social media, is likely to cause consumer confusion. We request your client's cooperation with undertaking immediately the actions set forth in our May 1, 2019, letter and providing the requested assurances in writing that she has done so. We look forward to hearing from you on whether Dr. Prause will now end her current actions and unfair use of Mr. Wilson's trademark without the need for parties to put forward more resources towards this dispute.

As far as we have been made aware, Mr. Wilson stands by the factual summary of the communications and interactions between him and Dr. Prause presented on the YourBrainOnPorn.com website.

We look forward to receiving your client's cooperation with ending the current infringement of Mr. Wilson's YOUR BRAIN ON PORN trademark.

Sincerely,

FITCH, EVEN, TABIN & FLANNERY LLP



Alisa C. Simmons