

United States District Court
District of Minnesota

FAEGRE & BENSON, LLP,
FELICIA J. BOYD, and
JOHN H. HINDERAKER,

Plaintiffs,

v.

ORDER

Civil. File No. 03-6472 (MJD/JGL)

WILLIAM S. PURDY, SR.,
PLEASE DON'T KILL YOUR BABY, and
DOES 1-10,

Defendants.

Felicia J. Boyd, Faegre & Benson LLP, for, and on behalf of, Plaintiffs.

William S. Purdy, pro se.

I. INTRODUCTION

On January 5, 2004, Plaintiff Faegre & Benson LLP ("Faegre") argued its Motion for Temporary Restraining Order and Preliminary Injunction [Doc. No. 2] before the undersigned United States District Judge. Defendant failed to appear for the hearing. Based upon the affidavits, memorandum, arguments of counsel, and proceedings herein, this Court makes the following ruling.

II. DISCUSSION

The Eighth Circuit Court of Appeals has established the standard for considering

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RICHARD D. SIETTEN, CLERK
JUDGMENT ENTD. _____
DEPUTY CLERK _____

preliminary injunctions. Dataphase Sys. Inc. v. CL Sys., Inc., 640 F.2d 109, 113 (8th Cir. 1981) (en banc). This Court must consider (1) the threat of irreparable harm to the moving party if an injunction is not granted, (2) the harm suffered by the moving party if injunctive relief is denied as compared to the effect on the non-moving party if the relief is granted, (3) the public interest, and (4) the probability that the moving party will succeed on the merits.

Id.

A. Likelihood of Success on the Merits

It is probable that Plaintiff Faegre & Benson LLP (“Faegre”) will succeed on the merits of its claims.

1. Anticybersquatting Claim and Lanham Act Claims

To succeed on a claim for cyberpiracy under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)(1), a plaintiff must show that the defendant has registered, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a mark that is distinctive or famous at the time of defendant’s registration of the domain name. To succeed on a claim for trademark and trade dress infringement under the Lanham Act, 15 U.S.C. §§ 1114(a) and 1125(a); the Minnesota Deceptive Trade Practices Act, Minn. Stat. Ann. § 325D.44; and the common law of Minnesota, a plaintiff must establish that (1) the trademark or trade dress in question is inherently distinctive or has acquired secondary meaning; (2) it is primarily nonfunctional; and (3) its imitation in connection with goods or services has resulted in a likelihood of confusion as to the source

of the product. Federally-registered marks are entitled to the presumption that they are distinctive and nonfunctional.

Defendants William S. Purdy, Sr., and Please Don't KILL Your Baby, Inc., or those acting in active concert or participation with them, have registered numerous Internet domain names, including faegre-benson.com, faegre-benson.org, faegre.biz, startribunc-faegre-bensonlawfirm.com, startribune-faegre.com, faegrebensonlawfirm.com, and startribunenewspaper.com, with an Internet registrar.

Defendants knowingly and intentionally have registered these Internet domain names that incorporate and are identical or confusingly similar to Faegre's distinctive and protected marks, including its federally-registered mark, FAEGRE & BENSON LLP®. Faegre's marks were distinctive at the time that Defendants registered domain names that incorporate these marks or that were confusingly similar to these marks. Faegre has conducted substantial advertising and promotion of its services in connection with these marks and its trade dress, as a result of which, its name, marks, and trade dress are known to the public as an indicator of source that designates Faegre and its services.

Defendants have registered these domain names with a bad-faith intent to profit from them. The Court has reviewed the factors related to bad faith that are enumerated in the statute. 15 U.S.C. § 1225(d)(1)(B). Defendants have no intellectual property in faegre-benson.com, faegre-benson.org, faegre.biz, startribune-faegre-bensonlawfirm.com, startribune-faegre.com, or faegrebensonlawfirm.com. None of the domain names at issue

contain or consist of a name by which any of Defendants are known. Defendants have not previously used the above domain names in connection with the bona fide offering of goods or services. Defendants have registered multiple domain names that are identical or confusingly similar to Faegre's distinctive marks. Finally, Defendants intend to profit from the domain names by tarnishing and diluting Faegre's marks and by relying on Faegre's good name and goodwill in order to divert Internet traffic to pages displaying Defendants' graphic images to generate publicity for Defendants' cause.

The web pages located at Defendants' registered domain names (a) feature Faegre's nonfunctional trade dress; (b) prominently display Faegre's trademarks; and (c) display content - including color pictures that purport to be dismembered aborted fetuses - that do not originate from, are not sponsored by, and are not affiliated with, Plaintiffs. Defendants' use of Faegre's marks and of a trade dress, the appearance of which is confusingly similar to the trade dress of Faegre's web site, has created a likelihood of confusion as to the source of the domain names and the web pages located at these domain names.

Defendants' use of a disclaimer on their web sites does not insulate their conduct, because their misleading use of Faegre's trademark to divert consumers to their websites creates initial interest confusion.

Finally, Defendants' use of domain names incorporating Faegre's mark is in connection with goods or services, because it is designed to, and is likely to, prevent some Internet users from reaching Faegre's official website. See, e.g., Jews for Jesus v. Brodsky,

993 F. Supp. 282, 309 (D. N.J. 1998) (noting that “in connection with goods and services” requirement met because “the conduct of the Defendant is not only designed to, but is likely to, prevent some Internet users from reaching the Internet site of the Plaintiff Organization”); Planned Parenthood Fed. of America, Inc. v Bucci, No. 97 Civ. 0629, 1997 WL 133313, at *4 (S.D.N.Y. March 24, 1997) aff’d 152 F.3d 920 (2d Cir. 1998) (holding that defendant’s use of domain name “plannedparenthood.com” was “in connection with the distribution of services” because “[p]rospective users of plaintiff’s services who mistakenly access defendant’s web site may fail to continue to search for plaintiff’s own home page, due to anger, frustration, or the belief that plaintiff’s home page does not exist.”).

For the foregoing reasons, it is probable that Plaintiffs will succeed on their claims under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)(1); the Lanham Act, 15 U.S.C. §§ 1114(a) and 1125(a); the Minnesota Deceptive Trade Practices Act, Minn. Stat. Ann. § 325D.44; and the common law of Minnesota.

2. Appropriation of Name Claim

To succeed on a claim for appropriation of name under the common law of Minnesota, Plaintiffs must show that Defendants intentionally appropriated Plaintiffs’ names for their own benefits. Lake v. Wal-Mart Stores, Inc., 582 N.W.2d 231, 233 (Minn. 1998). Defendants have posted the names of Faegre’s attorneys, including the names of Plaintiffs Hinderaker and Boyd, on their web sites. They have done so in order to take advantage of the goodwill, reputation, prestige, and other value associated with these names, to divert

traffic to their web sites, to generate publicity, and to create the impression that the Defendants' actions enjoy the support of these sources. Thus, Plaintiffs are likely to succeed on their appropriation of likeness claim.

B. Threat of Irreparable Harm

Defendants have failed to heed Plaintiffs' cease and desist demand letter. Defendants' past actions indicate that they will continue to violate Plaintiffs' rights. Defendants' actions have irreparably harmed, and will continue to irreparably harm, Faegre, Hinderaker, and Boyd.

C. Balance of the Harms

The irreparable harm that has been, and will continue to be, suffered outweighs any potential harm Defendants may suffer from the issuance of this Order.

D. Public Interest

It is in the public interest to protect Faegre's marks and trade dress because Defendants' infringing domain names and use of Faegre's marks and trade dress are likely to confuse the public as to both the source and sponsorship of Defendants' web page, to divert Internet users from their intended online destinations, and to tarnish Faegre's good name and goodwill.

III. CONCLUSION

Accordingly, based upon the files, records, and proceedings herein, **IT IS HEREBY ORDERED:**

1. Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are temporarily and preliminarily prohibited and enjoined from using the domain names faegre-benson.com, faegre-benson.org, faegre.biz, startribune-faegre-bensonlawfirm.com, startribune-faegre.com, and faegrebensonlawfirm.com.

2. Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are also preliminarily enjoined from registering or using any domain name that both (1) incorporates, and is identical or confusingly similar to, Faegre's distinctive and protected marks FAEGRE & BENSON, FAEGRE, FAEGRE.COM or FAEGRE & BENSON LLP or any other marks identical or confusingly similar to any marks used or owned by Faegre, and (2) does not alert the Internet user to the protest or critical commentary nature of the attached web site within the language of the domain name itself.

3. Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are also preliminarily enjoined from transferring any and all domain names in their ownership that incorporate or are confusingly similar to Faegre's protected marks to any entity or individual other than Faegre and do not alert the Internet user to the protest or critical commentary nature of the attached web site within the language of the domain name itself.

4. Defendants' transfer of the domain name faegre.biz to another individual who did

not agree to be bound by the judgment of this Court, after the Plaintiffs filed the Complaint in this action, constituted a violation of Paragraph 8 of the Uniform Domain-Name Dispute-Registration Policy. This transfer is deemed cancelled and the domain name registrar for faegre.biz is ordered to rescind that transfer.

5. Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are also preliminarily enjoined from using any trademark that is identical or confusingly similar to Faegre's distinctive and protected marks FAEGRE & BENSON, FAEGRE, FAEGRE & BENSON LLP, and FAEGRE.COM, or any other mark used or owned by Faegre.

6. All Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are temporarily and preliminarily prohibited and enjoined from displaying any web site, the appearance of which is identical or confusingly similar to the trade dress of Faegre's web site at faegre.com.

7. This Order applies to all persons and entities acting in concert with, or in the custody, care, and control of, Defendant William S. Purdy, Sr., including but not limited to all person or entities listed as registrants of, or as technical or administrative contacts for, any of the following domain names: faegre-benson.com, faegre-benson.org, faegre.biz, startribune-faegre-bensonlawfirm.com, startribune-faegre.com, and

faegrebensonlawfirm.com.

8. Defendants are directed forthwith to advise all domain name registrars and internet service providers they have previously or currently employed of this Order and to instruct them to take all actions necessary to stop the functioning of the identified domain names.

9. Defendants must, within three days of this Order, transfer to Faegre ownership of each and all domain names that both incorporate any mark belonging to, or confusingly similar to, any mark owned by Faegre and do not alert the Internet user to the protest or critical commentary nature of the attached web site within the language of the domain name itself.

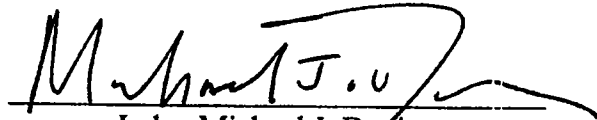
10. Defendants shall, within five days from the date of this Order, file a report with the Court, with a copy to the Plaintiffs, setting forth the manner in which they have complied with the terms of this Order.

11. All Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order are ordered to cease illegal appropriation of the names of the Plaintiffs and all individuals associated or affiliated with the Plaintiffs.

12. All Defendants and their officers, agents, servants, employees, attorneys, and all persons in active concert or participation with them who receive actual notice of this Order, shall pay a sum of \$50 per day for each name of an individual associated with Faegre that they continue to display on web sites prohibited by this Order.

13. Plaintiffs Motion for a Temporary Restraining Order and Preliminary Injunctions [Docket No. 2] is **GRANTED**. This Order is effective upon the date recited below, and shall remain in effect until further Order of this Court, provided that, within 10 days of the date of this Order, Plaintiffs post a bond with the Clerk of this Court, pursuant to Rule 65(c) of the Federal Rules of Civil Procedure, in the sum of \$5,000.

Jan. 5, 2004
Date


Judge Michael J. Davis
United States District Court