

Introduction

In his opening brief (“MishBrf.”), appellant Henry Mishkoff (“Mishkoff”) argued, based on established First Amendment law, and on an analysis of the language and legislative history of the Lanham Act, for reversal of the injunctions against the websites that Mishkoff created to praise the Plano, Texas shopping mall built by plaintiff-appellee Taubman Company Limited Partnership (“Taubman”), and to criticize Taubman for its tactics in this litigation. Mishkoff argued that the Lanham Act does not extend to purely non-commercial websites such as his own, that the First Amendment protects his right to post those websites and to use Taubman’s trademarks in his domain names to accurately portray the contents of the websites, and that his use of Taubman’s trademarks in this fashion is both nominative fair use and non-confusing under the eight-factor test applied by this Court’s decisions.

Taubman’s brief (“TaubBrf.”) ignores most of these arguments. For example, the term “nominative fair use” does not appear in Taubman’s brief, and “fair use” is mentioned only in passing. Instead, in most respects, Taubman simply reiterates the arguments that it made below in obtaining preliminary injunctions against a pro se defendant, which were anticipated in Mishkoff’s opening brief and need not be further rebutted now. In several other respects, Taubman invents new reasons for the injunctions, which were not adopted by the court below or even argued there, or bases its defense of the decision below on facts that are not in the appellate record. For

example, Taubman makes repeated reference to alleged violations of its copyright, even though there is no evidence of this in the appellate record; Taubman did not even allege a copyright violation until March 2002, several months after the appeals were filed. We have not moved to strike these references in Taubman’s brief but simply note some examples in the course of the argument that follows, and urge the Court to disregard the pervasive factual statements that lack a record citation.¹

A. Domain Names Are A Webhost’s Description of His Website’s Contents and Hence Are Protected by the First Amendment Unless The Description Is False or Misleading.

Taubman disputes Mishkoff’s point that domain names often contain a communication about the contents of a website that is, therefore, protected by the First Amendment. According to Taubman, a domain name is nothing more than a “locator” for a website that describes its source, much as the placement of a brand name on a product describes its source, and is not a communicative act at all. TaubBrf. 46. On this theory, Taubman argues that, because the preliminary

¹ Taubman takes issue with Mishkoff’s reliance on the rule requiring de novo review in First Amendment cases. TaubBrf. 14. Neither of the cases it cites calls into question the applicability of *Bose Corp. v. Consumers Union*, 466 US 485 (1984), to this case. There were no First Amendment arguments in *Brookfield Communications v. West Coast Entertainment*, 174 F3d 1036 (CA9 1999), and the decision says nothing about the impact of the First Amendment on the standard of review; *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F2d 200 (CA2 1979) was decided before *Bose*.

injunctions do no more than prevent Mishkoff from placing a misleading source identifier on the websites, they do not violate the First Amendment and are justified by the Lanham Act. According to Taubman, the preliminary injunctions only prohibit the use of its trademark in domain names, and, even if the domain names enable Mishkoff to bring his website to the attention of web users, there is no First Amendment right “to enable web user accessibility.” *Id.* 48.

This argument is erroneous for several different reasons. Although Taubman is correct that domain names function primarily as locators or identifiers for their websites, that function is scarcely the same as identifying the **source** of the website. The “source” of the website is just one characteristic that the domain name may identify; the name may as easily identify the subject or title of the page. Moreover, as the Second Circuit has held in the line of cases beginning with *Rogers v. Grimaldi*, 875 F2d 994 (CA2 1989), cited in MishBrf. 21, the titles of literary works are expression protected by the First Amendment; consequently, even if a work is about a person or thing that has a trademarked name, the author is entitled to give the work that name. Taubman never grapples with this line of cases or responds to the point.²

²Indeed, contrary to Taubman’s argument, even source identification is “speech” protected by the First Amendment. *See* MishBrf. 20-21. The First Amendment does not protect mis-identification of source, especially in the commercial context, because false speech is not protected.

Taubman claims that Mishkoff's analysis is all theory, but has no record or case support. However, Mishkoff's brief cited cases discussing the propriety of using domain names as subject or title identifiers rather than source identifiers, MishBrf. 37, 44, and his argument is based on facts in the record and the common experience of Internet users.

Although it is unquestionably true that domain names are sometimes used to denote the source of a website, it is also true that they are used to denote subject or title (for example, www.apples.com). Sometimes source and subject and title may all be the same (as in www.gm.com), but there are many domain names that plainly do not denote their source at all – for example, the “sucks” domain names that are at issue in the second injunction. Taubmansucks.com, as apparent from the name, does not denote the source, but that the website is **about** how Taubman “sucks.”

More generally, one cannot tell, simply by examining a domain name in isolation, whether it identifies source, title or subject – whether, to use the analogy presented in MishBrf. at 37, the name is a subject, title or author card in the card catalogue of the Internet. (The predominant public image of the Internet is that of a library, as a source of information, and not as a place to go shopping. <http://www.markle.org/news/AccountabilityChapter1.pdf>, at 20-25.) Accordingly,

the more recent cases involving domain names, cited in MishBrf. at 41-42, reject the theory that a trademark owner can automatically win a Lanham Act claim by invoking the doctrine of initial interest confusion based on the domain name alone, and instead consider the domain name in the context of the underlying web site to decide whether the defendant had fairly used a domain name that either contains, or indeed, consists solely of, the plaintiff's trademark.

The case authority on which Taubman relies for a different theory of how domain names function did not rely on any more "evidence" in the records of their cases than Mishkoff has used in his briefs here. In *PACCAR v. TeleScan Technologies*, 115 F.Supp.2d 772 (EDMich 2000), on which Taubman relies at length, the court drew its "factual" assertions about the Internet from a lengthy blocked quotation from *Brookfield Communications v. West Coast Entertainment*, 174 F3d 1036 (CA9 1999). Moreover, not only was there no record on the question but the parties did not even brief the question; the court spoke ex cathedra, perhaps based on the judges' experience as Internet users.

Many of these early cases predicated their analyses on the proposition that, unless a trademark owner could control every domain name that was even close to their names, they would become invisible on the Internet because Internet users were not very bright and easily confused by similar names, and because there was,

supposedly, nothing analogous to the telephone directory to help Internet users searching for a particular company to find the official website. *See* TaubBrf at 45, citing cases.

More recent cases take a much more enlightened view of Internet users and a more skeptical attitude toward claims that web users will be easily confused by domain names. In part, this view is due to the evolving technology of search engines and increasing consumer awareness of how to use them. Thus, in *Strick Corp. v. Strickland*, 162 FSupp2d 372, 377, 380 (EDPa 2001), and *Chatam Int'l v. Bodum*, 157 FSupp2d 549, 558-559 (EDPa 2001), the courts dismissed the theory that Internet users would easily be distracted from finding the sites they were really seeking. Instead, these decisions recognize, if an Internet user does not succeed with her first “name guess,” she will guess another name or, indeed, use a search engine. The Ninth Circuit itself recently distinguished *Brookfield Communications* in a case in which there was a two-letter difference between plaintiff’s trademark and defendant’s domain name, dismissing plaintiff’s concerns about lost customers by saying that Internet users are aware of the importance of “very small differences” in domain names. *Entrepreneur Media v. Smith*, 279 F3d 1135, 1147 (CA9 2002). *See* MishBrf. at 41-42, 48.

This Court has yet to address the question of how domain names function; its

early rulings in such cases have been cautious and avoided broad pronouncements. *See Bird v. Parsons*, 2002 WL 1012175 (CA6 May 21, 2002); *Allard Enterprises v. Advances Programming Resources*, 249 F3d 564, 575 (CA6 2001); *Data Concepts v. Digital Consulting*, 150 F3d 620 (CA6 1998). To the extent that the Court is prepared to rule on the preliminary injunction without evidence from plaintiff carrying its burden of proof on the question whether Mishkoff's names not only create a likelihood of confusion, but create so great a likelihood as to outweigh Mishkoff's First Amendment right to identify the subject of his websites, the Court should employ an analysis similar to *Entrepreneur* and *Strick* and uphold Mishkoff's right to use the challenged domain names and websites.

Moreover, the evidence in the appellate record shows how effectively Internet users could employ search engines to find Taubman's official mall site if they reached Mishkoff's shops site or sucks site but wanted the official site instead. The district court entered the terms "shops at willow bend" into a search engine, and produced a search result in which the first two entries – and four of the first ten entries – were Taubman's own websites. REN53, JA201. No Mishkoff site appeared until the 32nd listing on the fourth page of search results. *Id.*, JA207. Indeed, Internet users would not have had to use a search engine had they reached Mishkoff's "shops" site in error, in light of the prominent link to Taubman's website that appeared at the very top of

Mishkoff's web site. (A copy of that page is attached to this brief as an addendum).

Thus, this case is about Taubman's effort to suppress any portrayal of its mall that it cannot control and to suppress criticism of its conduct in this litigation. Taubman's own brief makes this point most effectively, when it argues that the reason why it needs the domain name is to ensure that customers can find its site about the mall, TaubBrf. 45-46, but that it does not matter if some other person is barred from using a trademark in a domain name because there is no First Amendment right "to the best position to enable web user accessibility." *Id.* 48. According to Taubman, its trademark rights need not "yield to the exercise of First Amendment rights where adequate avenues of communication exist." *Id.* 55.

This argument is wrong as a matter of fact and law. It is wrong as a matter of law because the adequacy of alternative means of communication is a part of the analysis for time, place and manner limitations on speech. *City of Ladue v. Gilleo*, 512 US 43, 56 (1994). The preliminary injunctions in this case contain a content-based restriction – under Taubman's argument, Mishkoff is entitled to mount a website to praise or criticize it, so long as he does not use its name to describe the subject of his commentary.

Taubman suggests that content based speech restrictions **do** require an analysis of alternate means of communication because the misuse of its trademark constitutes

a trespass on its property, which therefore requires consideration of whether there are other ways the defendant could speak without using the trademark. TaubBrf., *citing Dr. Seuss Enterprises v. Penguin Books*, 924 FSupp 1559, 1573 (SDCal. 1996), and *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F2d 200, 206 (CA2 1979). In these cases, however, the defendants did not purport to be commenting on the plaintiff or its trademark, and *Dr. Seuss* expressly recognized that, if the defendant **had** been commenting on its books, the use of the trademark would be justified as necessary to describe those books. 942 FSupp at 1572, 1573 n21 (citing 604 F2d at 206). And in the case cited by *Dallas Cowboys* to support the consideration of adequacy of alternatives, the issue was whether members of the public could enter the property owner's mall to protest; the trespass was clear and the question was whether the trespass was justified. A trademark, however, does not grant an unqualified right to use certain words exclusively, and the question in a case like this is whether there is a trespass at all. Any assumption that Taubman has a "property right" to exclude Mishkoff, before the Court has decided there is fair use or a First Amendment right to use its mark in order to identify the subject of his speech, would be an exercise in question-begging.

Moreover, as a matter of fact, there is no adequate alternative to using the name of Taubman's mall and company to denote the subjects about which Mishkoff wishes

to speak. Given the vastness of the Internet, the right to post a website is useless unless the operator can bring his site to the attention of those who might be interested to know of its existence. Domain names play an important role in that process, and so long as the website is truly related to the words embodied in the domain name, its operator should be allowed to use a trademarked word in the name as an accurate description of the site.

Taubman also errs in contending that the injunctions under review are directed only at the domain names and not at the underlying websites. The district court has repeatedly characterized the first injunction as being directed at the site as well as the name. REN12, at 1, JA124; REN40, at 2, JA171. Plaintiff's preliminary injunction brief had likewise sought to "divest Defendants of their ring of websites" REN3, Memorandum 14, JA30. Not only does Taubman fail to show that the "shops" injunction is limited, its appellate brief repeatedly defends the injunction on the theory that "the website itself," and not just the domain name, infringes its trademark. TaubBrf. 184-185.

Indeed, the language of the "sucks" injunction is broader than the language of the "shops" injunction, and on its face bars the "sucks" web site. By its terms, the second injunction **both** forbids "using websites on the Internet with the following domain names," REN40 , page 15, **and** orders defendants to "remove the websites

with the following domain names . . . from the Internet.” *Id.* pages 15-16. These two portions of the injunction would be duplicative if both did no more than prevent Mishkoff from using certain domain names; rather, the second part of the injunction requires the removal of certain websites from the Internet, using the domain names at which they were posted to identify the material that was to be removed. Moreover, this two-part injunction contained the language that plaintiff had requested, on the theory that the “sucks” website contained defamatory statements and confidential information and hence was subject to being enjoined independent of the domain name issue. Indeed, plaintiff explained in the court below that it had crafted a proposed order not just to restrict use of the domain names, but also “to expressly require that these additional websites be shut down,” REN10 at 2, JA117. Following this request, the expanded preliminary injunction as issued by the Court first barred Mishkoff from using websites with the specified domain names, and in a separate paragraph ordered him to remove those websites from the Internet. REN 40, at 1, JA184. And, far from narrowing its preliminary injunction when Mishkoff noted its breadth in moving for a stay, the district court attempted to justify enjoining the site itself by mentioning, in a footnote, that it was “by no means implausible” that an Internet viewer could be confused about whether the contents of the “sucks” site were sponsored by Taubman. Accordingly, neither injunction can be defended on the theory that it is limited to the

domain names.

B. The Injunction Against the “Sucks” Site Must Be Reversed.

Taubman defends the preliminary injunction that it obtained against the “sucks” website by arguing that the site was created to criticize its legitimate trademark lawsuit against the “shops” site, TaubBrf. 49-50, and that as a “proven infringer” Mishkoff is not entitled to the same leniency as an “independent third party” with no history of trademark infringement. *Id.* 51-52.

Even assuming that the Court upholds the preliminary injunction against the shops site (and it need not reach the safe distance rule if it reverses that injunction), the safe distance rule does not protect the plaintiff in a valid lawsuit against being criticized publicly on the Internet. A defendant’s right to protest the administration of justice does not depend on whether the underlying lawsuit is justified, or on whether the defendant’s criticisms are wise or foolish. *Cf. In re Snyder*, 472 US 634, 646-647 (1985). Where the contents of the criticism are neither false nor otherwise improper – and the court below flatly rejected Taubman’s arguments in that regard, REN40 at 10, JA179 – the proper response to critical speech is not a lawsuit, it is more speech, such as Taubman’s explanation why its actions were justified:

The main remedy of the trademark owner is not an injunction to suppress the message, but a rebuttal to the message. As Justice Brandeis long ago stated, “If there be time to expose through discussion the

falsehoods and fallacies, to avert the evil by the process of education, the remedy to be applied is more speech, not enforced silence.”

5 McCarthy on Trademarks, § 31:148 at 31-216 (4th ed. 1999).

Taubman never addresses Mishkoff’s argument that every single case applying the “safe distance rule” did so following a final judgment of infringement, and involved minor variations on the names already found to be infringing rather than direct criticisms. MishBrf. 53-54. Indeed, the two “safe distance” cases cited at page 52 of Taubman’s brief involved post-judgment changes made by defendants that were characterized by those courts as contumacious defiance of the decree, reasoning that does not apply here because both the domain names and the “sucks” website were created in reaction to the lawsuit, but before the first preliminary injunction was entered. REN 26, Affidavit at 2 ¶ 7, JA163.

Taubman also invokes two cases where courts rejected First Amendment defenses put forward by defendants who posted supposed “protest” sites after they were sued over certain domain names. TaubBrf. 53-54, *citing Gallo Winery v. Spider Webs*, 286 F3d 270 (CA5 2002); *Shields v. Zuccarini*, 254 F3d 476 (CA3 2001). However, neither *Shields* nor *Gallo* supports the preliminary injunction here. Neither has any bearing on the “safe distance” rule, which was the only basis on which the second injunction was either sought or granted. Both were filed against true

“cybersquatters” who had registered thousands of domain names, many of them identical to various famous trademarks, but had never established any websites related to the names. Instead, they had tried to extort money from the trademark holders to buy the names (or, in the *Gallo* case, had acknowledged their intent to do this). Only after they were sued did these defendants establish what purported to be “protest sites” at the very domain names at issue in the case. The courts found that the sites had not been established in good faith, but simply to perpetrate the extortionate activity in which the defendants had previously been engaged, and refused to accept the post-hoc web sites as establishing the bona fides of the original domain name registrations. Neither case involved “sucks” domain names, and the *Gallo* court expressly recognized that the defendant might have a legitimate use for a domain name incorporating the trademark. 286 F3d at 280. Thus, these cases stand only for the proposition that the subsequent erection of protest sites will not avoid a judgment of cybersquatting.

By contrast, Mishkoff’s original website was devoted to The Shops at Willow Bend, and neither the appellate record, nor the arguments below, nor the decision under appeal even hint that Mishkoff sought to be paid for registering that name. When he was sued, he registered **new** domain names for the purposes of criticism, not to extort payment but to embarrass the plaintiff into dropping its suit. The names

embodied words of criticism, and he mounted a protest site, whose contents at the time of the injunction are on the CD in the Joint Appendix, at those addresses. The First Amendment protects both the sites and the names.

C. Because the Websites Are Noncommercial, They Are Not Covered by the Lanham Act and Are Fully Protected by the First Amendment.

Mishkoff's opening brief argued that both of his websites were non-commercial, and that, in light of the statutory requirement that a trademark be "used in commerce" to be considered infringing, the Lanham Act does not apply to either site. He also argued that, regardless of whether the Lanham Act applies, both of his websites are non-commercial speech fully protected by the First Amendment.

In taking issue with these arguments, Taubman invokes two cases: *Planned Parenthood v. Bucci*, 42 USPQ2d 1430 (SDNY 1997), *aff'd mem.*, 152 F3d 920 (CA2 1998), and *United We Stand America v. United We Stand America New York*, 128 F3d 86 (CA2 1997). Neither case discusses the language of the statute or its legislative history, and both involved the use of trademarks to raise money and sell goods. *See* MishBrf. 28-30. Taubman never addresses either the language of the statute or the legislative history cited in Mishkoff's opening brief, and it makes no effort to avoid the distinctions between the two cases and the facts here. Rather, Taubman implies that Mishkoff's argument is wrong because the statutory definition of "commerce,"

as reaching to the full extent of the commerce clause, has not changed since 1946, and because the Supreme Court took a broad view of the meaning of that term in 1952. TaubBrf 27. This argument is inapposite because Mishkoff's argument is not based on the definition of "commerce" but on the definition of "use in commerce." Not only was that language added to the statute only in 1962, but in 1988 it was defined for the specific purpose of **limiting** the reach of the Lanham Act to "the ordinary course of trade." *See* MishBrf. 27-28, citing legislative history.

Additionally, there is a stark contrast between Taubman's assertion that the Lanham Act covers domain names for purely non-commercial websites and its argument about why the First Amendment allegedly does not protect Mishkoff's domain names and websites. In making the latter argument, Taubman quotes *LL Bean v. Drake Publishers*, 811 F2d 26, 32 (CA1 1987): "The Constitution tolerates an incidental impact on the rights of expression **of commercial actors** in order to prevent a defendant from unauthorizedly **merchandizing his products** with another's trademark." TaubBrf. 43 (emphasis added). Taubman cannot have it both ways. It cannot avoid First Amendment scrutiny by limiting trademark to the commercial sphere, and then insist that trademark law applies even to wholly non-commercial websites.

Nor does Taubman's effort to portray the "shops" site as commercial succeed.

(Taubman never attempts to show that the “sucks” site is commercial.) The district court gave one reason and one reason only for finding the requisite use in commerce – the possibility that Mishkoff’s site could have an adverse effect on Taubman’s business because its links to the mall’s own tenants might discourage tenants from coming to the mall. But as Mishkoff showed below in his motion for a stay pending appeal, REN42, at 4, JA 190, Taubman’s own site also links to tenants, *see, e.g.*, <http://shopwillowbend.com/storeDetails.asp?lBusinessID=3331>, and, in any event, an adverse effect on the trademark holder does not make criticism commercial. Otherwise, the leaflets attacking the realtor in *Organization for a Better Austin v. Keefe*, 402 U.S. 415 (1971) would have been commercial, and the doctrine of prior restraints would not have been applicable.

Taubman does not defend the district court’s conclusions by rebutting these points; instead, it relies on four separate grounds for finding the site commercial, none of which were argued to or found by the district court, and none of which are valid.

First, Taubman relies on the fact that, at one time, the shops website contained a notice for a custom shirt business run by Mishkoff’s girlfriend. As shown by the date in the lower right hand corner of the web page printout attached to the motion for a preliminary injunction, JA 38, *compare* JA 12, the notice was removed from the

site before the motion for a preliminary injunction was filed; hence, it could not form the basis for the preliminary injunction. Second, Taubman falsely but repeatedly asserts that Mishkoff had an advertisement for his own internet business on the “shops” website, which increased the traffic to his home page. There is no advertisement for Mishkoff’s business on his site and there is no evidence (or record citation) showing any increase in traffic to Mishkoff’s home page. What Taubman is referring to is a small notice at the bottom of the “shops” site stating that the site is provided by defendants as a community service and provides links through which viewers can contact them (*see* addendum). This self-identification is part of the process of ensuring that no visitors would think that Taubman is the author of the site; moreover, the court can take judicial notice of the fact that the authors or creators of websites are commonly identified at the bottom of the home page, with both a mailto link and a link to their own home page. If mere self-identification by a person who is in business is enough to render a website commercial, then the statutory limitation of the Lanham Act to “use in commerce” is not a real one. Moreover, *Semco v. Amcast*, 52 F3d 108, 111-114 (CA6 1995), makes clear that the mere fact that an author is identified as a commercial entity is not sufficient to make its use of a trademark “commercial” under the Lanham Act; the contents of the speech must promote a commercial transaction. Third, the fact that the shops site contains links

to the mall and to its various tenants, thereby promoting them (in contradistinction to the district court's theory that the links hurt Taubman) does not render the site commercial, else any site about a commercial entity would itself be commercial, which is plainly not so.

Finally, Taubman appears to argue that Mishkoff transformed his site into a commercial enterprise when he accepted Taubman's offer that, if Mishkoff would give up his domain names and website and promise never to publish anything about Taubman in the future, Taubman would drop the lawsuit it had brought against him and pay him \$1000 as compensation for his efforts in creating the site. TaubBrf. 28; *see also id.* 37, 38 (variously characterizing Moshkoff's acceptance of the settlement offer as his "scheme to make a quick \$1000" or "making a quick profit"). Although the statement of the chronology is confusing in Taubman's brief, at 8, the correspondence shows that the offer was made after this suit was filed (the letters are on the "sucks" site, not the "shops" site as Taubman's brief states, as well as in exhibits to Mishkoff's opposition to the motion for a preliminary injunction, REN6, JA97-102). Accordingly, the settlement proposals and discussions are inadmissible under Rule 408. Moreover, the evidence does not support Taubman's argument. It shows only Taubman's willingness to buy both the domain names and Mishkoff's silence, and Mishkoff's willingness to give up the names to avoid having to defend

a lawsuit. Moreover, the \$1000 offer initiated by Taubman falls far short of the sort of exorbitant sums that have been held to constitute cybersquatting. *E.g.*, *Panavision Int'l v. Toeppen*, 141 F3d 1316 (CA9 1998) (prices beginning at \$10,000).³

In summary, Taubman's evidence of commercial use of its trademarks falls woefully short; its contentions were neither raised below, nor relied upon by the district court below. Consequently, the injunctions against both sites cannot stand.

D. There Is No Likelihood That Any Consumer Would Be Confused About Whether Taubman Is the Source of Mishkoff's Websites.

Taubman's brief attempts to justify the injunction against the "shops" site by performing the factor by factor analysis that this Court requires in trademark cases to establish a likelihood of confusion, but which the district court failed to perform. With respect to most of the factors, however, Taubman does not respond to the arguments in Mishkoff's opening brief, at 45-51. This section of the brief addresses only those factors on which Taubman advances arguments that were not anticipated there.⁴

³Nothing in the record supports Taubman's implication, TaubBrf. 37, that Mishkoff's cost for the six domain names and the website was only \$70.

⁴Although the district court theorized that some Internet users might be confused about whether the "sucks" page was sponsored by Taubman, because one line on the "sucks" home page expressed Mishkoff's continued admiration for the mall, REN 48 at 3 n1, JA197, Taubman does not defend this reasoning or otherwise argue that there is any likelihood of confusion about the source of the "sucks" page.

Relatedness of Services

The only aspect of this factor that was not addressed in Mishkoff opening brief is Taubman's argument, at 32, that the record does not support Mishkoff's characterization of his "shops" site as a fan site because it is not a testimonial about how the mall turned out and includes no memorabilia. This argument does not bear on the relatedness of services. In addition, it ignores the fact that Taubman filed this suit as soon as the mall opened, and a preliminary injunction was granted two months later. Even assuming that a fan site needs to have such contents, Mishkoff did not have the time to add memorabilia or personal experiences to the site before he was forced to remove it from the Internet. And, Taubman's contention that the "shops" site could not be a fan site because it is confusingly similar to Taubman's own website, TaubBrf. 32, 37, is belied by a side by side comparison of the "shops" site, which appears on the CD in the record as REN53, and www.shopwillowbend.com, which can be seen online and is obviously very different. (By contrast, several of the pages attached to the motion for a preliminary injunction, JA39-44, were not part of Mishkoff's website, as the URL's at the bottom left corner of each page reveal.)⁵

⁵ Taubman's argument about the relatedness of services is inconsistent with its argument that Mishkoff's site is commercial because it promotes Mishkoff's services as an Internet consultant. If **those** were the services that Mishkoff was using the trademark to promote, they are completely unrelated to the services for which Taubman has obtained the "The Shops at Willow Bend" trademark.

Likely Degree of Purchaser Care

Taubman argues that web visitors to a site about its shopping mall are looking for “deals” or information on opening dates and hours and are unlikely to exercise any “purchaser care.” Taubman has no evidence on this point, and its citation is to a case about packages of tea, not an upscale shopping mall. Nor does Taubman show that, in seeking such information, Internet users even care about whether they get it from the owner of the mall or from an independent third party. And yet, as the opening brief explained, this Court has held that there is no liability for infringement unless the use of the trademark has some tendency to deceive “prospective purchasers who care about source.” *MishBrf.* 31, citing cases. Because Taubman has not rebutted this point, this concession about the identity of the purchasers and their interest in the website condemns its claim against Mishkoff.

Taubman’s other argument, that the Court should assume that Internet users are stupid and that they will not notice small differences in domain names, was rebutted above at pages 5-6.

Mishkoff’s Intent in Selecting the Mark

To the extent that Taubman predicates its argument about Mishkoff’s intent in using the name “The Shops at Willow Bend” on his website and in its domain name on the allegation that he sought to “make a quick \$1000” by selling the name to

Taubman, or by diverting traffic to his home page, those claims are rebutted above, at pages 18-19.

Mishkoff's Prominent Disclaimer

Under this factor, Taubman cites *PACCAR v. Telescan, supra*, for the proposition that web surfers are easily confused and that disclaimers do not eliminate the likelihood of confusion by an otherwise confusing domain name. In *PACCAR*, however, the disclaimer was provided in tiny type, at the very bottom of a lengthy page where it could easily have been missed by the average internet viewer. (The home pages are set forth in an appendix to the opinion, 115 FSupp2d at 782, 785 *et seq.*) Here, by contrast, the disclaimer is set forth in a brightly colored box near the top of the home page, where no visitor to the page could possibly miss it, and it is accompanied by a hyperlink to the official site for The Shops at Willow Bend so that any viewer who prefers that site can go directly there. (See addendum to this brief).

Indeed, the disclaimer in *PACCAR* was even more obscure than the link to Mishkoff's home page, which Taubman has repeatedly proclaims to be an "advertisement" for Mishkoff's services that has increased traffic to Mishkoff's home page and that is Mishkoff's real reason for creating the page. If the WebFeats link is prominent enough to be considered in the case, so is the disclaimer.

* * *

In the end, this is a case where “all but the most obtuse consumer,” *Abercrombie & Fitch v. American Eagle Outfitters*, 280 F3d 619, 648 (CA6 2002), would recognize that Mishkoff’s websites are not sponsored by Taubman. This conclusion is equally true of the “shops” site, with respect to which Taubman has, at least, attempted to argue based on the eight factors, as of the “sucks” site, with respect to which Taubman makes no argument under the eight factors. Because there is no likelihood of confusion, the preliminary injunctions should be reversed.

E. There Is No Personal Jurisdiction Over Defendants in Michigan.

Taubman’s argument in favor of personal jurisdiction consists of citations to several district court decisions, mostly from within this Circuit, and some appellate decisions from other circuits, that supposedly stand for the proposition that a suit for misuse of a trademark in the Internet context may always be brought in the district where the plaintiff is based and thus, in theory, may suffer some injury. Taubman also argues that *Calder v. Jones*, 465 US 783 (1984), always allows claims of intentional tort violation, such as trademark claims, to be brought in plaintiff’s home jurisdiction.

Taubman miscites many of the lower court cases.⁶ More important, Taubman

⁶ The district court decision that was affirmed in *Nissan Motor Co. v. Nissan Computer Corp.*, 246 F3d 675 (CA9 2000) (table case), *aff’g* 89 FSupp2d 1154 (Taubman gives the wrong case name), reveals that the basis for personal jurisdiction

never shows how such decisions can overrule this Court's recent decision in *Neogen Corp. v. Neo Gen Screening*, 282 F.3d 883 (2002). That decision squarely rules that the maintenance of a passive website through which commercial transactions cannot be conducted, even a passive site that employs the plaintiff's trademark, is not a sufficient basis for personal jurisdiction in the plaintiff's home state. Although Taubman blithely characterizes *Neogen* as "support[ing] a broad application of the personal jurisdiction test," TaubBrf.23, the decision does not support personal jurisdiction based on a passive website.

Although *Neogen* does not discuss *Calder v. Jones* in holding that a passive website does not constitute purposeful availment, other cases have expressly distinguished *Calder* on the ground that it involved a print publication, of which a large number of copies were sold in the forum state in addition to the fact that the allegedly defamatory article was about a resident of that state. *E.g., Cybersell v.*

was that the defendant had entered into Internet advertising contracts with five California companies. In *Bancroft & Masters v. Augusta National*, 223 F3d 1082 (CA9 2000), jurisdiction was not based on the defendant's web site at all, but on the defendant's having sent a cease and desist letter challenging the domain name belonging to the California plaintiff. In *Panavision v. Toepfen*, 141 F3d 1316 (CA9 1998), the court agreed that merely establishing a web site with a domain name using the plaintiff's trademark is not enough to subject the defendant to personal jurisdiction, *id.* at 1322; the theory of the case was that by writing letters to the plaintiff in California demanding \$13,000 for a single domain name, the defendant had become subject to jurisdiction there. *Id.* 1323. However, there is no allegation that Mishkoff sent anything to Michigan about websites at issue here.

Cybersell, 130 F3d 414, 420 (CA9 1997). The courts have consistently treated Internet websites differently from print publications, whose sale can be more easily directed to or kept away from particular fora. “Otherwise, every complaint arising out of alleged trademark infringement on the Internet would automatically result in personal jurisdiction wherever the plaintiff’s principal place of business is located. That would not comport with traditional notions of what qualifies as purposeful activity invoking the benefits and protections of the forum state.” *Id.* Indeed, under *Keeton v. Hustler Magazine*, 465 U.S. 770 (1984), the plaintiff can choose to sue over a defamatory magazine article in a jurisdiction other than her home state, which a plaintiff might do to take advantage of a peculiarity of local law, or, indeed, to impose greater burdens on the defendant. If passive Internet websites are deemed analogous, it is apparent what the chilling effect would be on use of the Internet for purposes of communicating opinions about companies.

Taubman also asserts that “the brunt of the harm” is suffered in Michigan, but it introduced no evidence that Michigan consumers were at all likely to be interested in a Texas mall. Moreover, its argument about likelihood of confusion is based exclusively on the reaction of potential mall **visitors** who are interested in such matters as the mall’s opening hours or sales at the mall. Thus, the contention that impact on “Michigan customers and investors” should be considered in the personal

jurisdiction analysis, TaubBrf. 17, is makeweight.

In defending the district court's decision that Mishkoff waived his objections to personal jurisdiction while he was litigating this case pro se, Taubman relies on the district court's basis for that ruling, that Mishkoff allegedly answered the complaint and filed motions to dismiss without objecting to jurisdiction. However, Mishkoff's opening brief showed that these assertions are factually erroneous, that the district court improperly failed to decide motions invoking its discretion to amend any previous filings, and that as a pro se defendant Mishkoff should have any waiver excused. MishBrf. 15-17. Other than an apparent effort to avoid the force of *Haines v. Kerner*, 404 US 519 (1972), by implying that Mishkoff received assistance in opposing this lawsuit from unspecified attorney relatives, TaubBrf.15 (and nothing in the record supports that contention), Taubman does not respond to those arguments.⁷

⁷Taubman also suggests that opposing the preliminary injunction waived the personal jurisdiction defense. However, the Federal Rules do not provide for a waiver in that fashion, and because a preliminary injunction can be granted without personal service under Rule 65, *Corrigan Dispatch Co. v. Casa Guzman*, 569 F.2d 300, 303 (5th Cir. 1978), it is apparent that proceedings on such a motion are separate from responses to the complaint on the merits. Moreover, the denial of the motion to dismiss was contained in the same order that granted the preliminary injunction against the "sucks" site and contains the reasons for the injunction against the "shops" site that saves it from reversal for failure to comply with Rules 52(a) and 65(d). See MishBrf. 25 n4. In any event, Mishkoff's pro se status at the time of the initial preliminary injunction proceedings warrants recognition by the court before a waiver

CONCLUSION

The preliminary injunctions should be vacated.

Respectfully submitted,

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of the right not to be sued in Michigan is imposed on him.