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NOT FOR PUBLICATION

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF ARIZONA

PRODUCTIVE PEOPLE, LLC, an Illinois) limited liability company,  
Plaintiff,  
vs.  
IVES DESIGN, a sole proprietorship;) AMELIA IVES, an individual;) GODADDY.COM, INC.,  
Defendants.

No. CV-09-1080-PHX-GMS

**ORDER AND TEMPORARY  
RESTRAINING ORDER**

Pending before the Court is the Application for a Preliminary Injunction or Alternatively for a Temporary Restraining Order of Plaintiff Productive People, LLC, against Defendants Ives Design, a Colorado company, and Amelia Ives, a resident of Colorado (“the Ives Defendants”). (Dkt. # 6.) For the following reasons, the Court declines to grant a preliminary injunction, but grants a temporary restraining order.

**BACKGROUND**

Plaintiff is an Illinois company that, in its own words, “focuses on electronic publishing services, namely, publication of text and graphic works of others online featuring information and accomplishments of individuals and publishing of electronic publications.” (Dkt. # 1 at 4.) In 2008, Plaintiff began making use of the term “namedrop” in conjunction

1 with offering these services. At some point, Plaintiff began using www.namedroponline.com,  
2 which offers “extraordinary access” to “connect [users] with the world’s biggest names.”  
3 (Dkt. # 6 Ex. F ex. 2.) Plaintiff attests that it has spent approximately \$20,000 promoting the  
4 “namedrop” brand as a “news and entertainment source for the world’s celebrities,” including  
5 by sponsoring an Oscar’s party in Los Angeles for celebrities during the Academy Awards,  
6 by making presentations to potential partners, and by using the mark on promotional  
7 materials. (Dkt. # 6 Ex. F at 1.)

8 Defendant Ives Design, however, holds the internet registration for the website  
9 www.namedrop.com, which was first purchased in 1997. The website was not used until  
10 2000, at which point it purported to offer custom branding services for business promotion,  
11 but the site lacked any ordering or contact capability. (See Dkt. # 6 Ex. E ex. 14.) In 2004  
12 the site had an “under construction” statement with general web information listed. (*Id.* ex.  
13 15.) By 2007 even this page had been removed (*id.* ex. 16), and the site remained vacant  
14 until after litigation in this matter commenced.

15 In 2008, Plaintiff contacted the Ives Defendants and attempted to purchase the  
16 website. On January 14, 2009, after attempts at negotiation were unavailing, Plaintiff filed  
17 a trademark application for the word mark “NAMEDROP” with the United States Patent and  
18 Trademark Office. (Dkt. # 6 Ex. F ex. 1.) Two weeks later, on January 28, Plaintiff filed suit  
19 against the Ives Defendants in the United States District Court for the Central District of  
20 California, asserting various claims for trademark infringement, cybersquatting, and unfair  
21 competition.

22 After the complaint was filed in the California district court, the Ives Defendants  
23 updated the www.namedrop.com website. The site again purports to offer “custom  
24 branding” services (such as on mugs, pins, magnets, and other merchandise) to “promote  
25 your organizations and events,” but it now includes “contact us” and “get a quote” links.  
26 (Dkt. # 6 Ex. E ex. 10.) In an affidavit, Plaintiff’s founding partner attests that:

27 multiple celebrity providers, partners, and media contacts have  
28 expressed explicit confusion over the domain name  
“namedrop.com,” believing the content on that website to be

1 that of Productive People, forming a negative opinion  
2 concerning Productive People and its services. These  
3 individuals have personally told me that they had thought that  
4 website was associated with Productive People or expressed  
concern, or may not even be doing business, with Productive  
People because of the Ives Defendants['] use of the domain  
name.

5 (Dkt. # 6 Pt. 7 at 2.) Plaintiff further asserts that it is planning a “national marketing blitz”  
6 for the “next few weeks,” and it anticipates that the damage that it suffers from this confusion  
7 will increase significantly during that time. (*Id.*)

8 In the California case, Plaintiff eventually advanced a motion for a preliminary  
9 injunction. (Dkt. # 6 Ex. C.) The Ives Defendants responded, and they also argued that the  
10 case should be dismissed for lack of personal jurisdiction. (Dkt. # 6 Ex. H.) The court  
11 agreed that the case should be dismissed without prejudice for a lack of personal jurisdiction,  
12 and the court denied the application for a preliminary injunction as moot. (Dkt. # 6 Ex. L.)

13 After the California action was dismissed, Plaintiff’s trademark application was  
14 published for opposition on the principal register. (Dkt. # 6 Ex. K ex. 19.) The publication  
15 states that the applied-for mark will cover “[e]lectronic publishing services, namely,  
16 publication of text and graphic works of others online featuring information and  
17 accomplishments of individuals; publishing of electronic publications.” (*Id.*)

18 On May 20, 2009, Plaintiff filed the Complaint underlying this action, asserting claims  
19 for trademark infringement under federal law, cybersquatting, common law trademark  
20 infringement, unfair competition, and unjust enrichment against the Ives Defendants, as well  
21 as federal and common law contributory infringement against Defendant GoDaddy.com.<sup>1</sup>  
22 (Dkt. # 1.) In the instant motion, Plaintiff argues that the Court should accept the briefing  
23 submitted on this issue in the California case and summarily grant a preliminary injunction  
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27 <sup>1</sup>Defendant Ives Design registered the domain names at issue with Defendant  
28 GoDaddy.com, Inc., an Arizona corporation. (Dkt. # 6 Ex. E ex. 9.)

1 against the Ives Defendants transferring the www.namedrop.com website to Plaintiff.<sup>2</sup> (Dkt.  
2 # 6.) In the alternative, Plaintiff requests a temporary restraining order enjoining infringing  
3 use of the website pending resolution of the motion for a permanent injunction.<sup>3</sup> (*Id.*)

## 4 DISCUSSION

### 5 I. Application for a Summary Preliminary Injunction

6 Plaintiff's argument that the Court should accept the briefing from the California case  
7 and summarily grant a preliminary injunction – without giving Defendants an opportunity  
8 to respond – is meritless. Plaintiff has moved for a preliminary injunction under Federal  
9 Rule of Civil Procedure 65, and that rule “has been interpreted to mean that parties have a  
10 right to be heard in opposition to a motion for a preliminary injunction.” *Int'l Molders' &*  
11 *Allied Workers' Local Union No. 164 v. Nelson*, 799 F.2d 547, 554 (9th Cir. 1986). Plaintiff  
12 offers no authority in support of its argument that a response to a similar application in  
13 another court divests a party of the right to respond to a new application for a preliminary  
14 injunction in a different court. Plaintiff's only citation is to Federal Rule of Civil Procedure  
15 1, which requires that the rules be “construed and administered to secure the just, speedy, and  
16 inexpensive determination of every action and proceeding.” But to deprive Defendants of  
17 the right to respond simply because they have responded before is not “just,” and it does not  
18 comport with Defendants' right to be heard in opposition to the motion.

19 Plaintiff's argument that the California district court has already decided this issue  
20 likewise does not hold water. Plaintiff asserts that the court determined that “upon proof of  
21 ownership, Plaintiff has suffered actual harm by the Ives Defendants' use” of the websites  
22 at issue. (Dkt. # 6 at 7.) The California district court made no such determination. Rather,

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23  
24 <sup>2</sup>Plaintiff requests that the injunction also apply to the websites www.name-drop.com  
25 and www.name-drops.com. (Dkt. # 62.) These websites are likewise owned by Defendant  
26 Ives Design (Dkt. # 6 Ex. E ex. 3), and as of the date of this Order they are identical to  
27 www.namedrop.com. As there is no evidence in the record to distinguish between the sites,  
28 the Court will evaluate all three under the same analysis.

<sup>3</sup>As discussed at the hearing on this matter on May 28, 2009, Plaintiff provided  
Defendants with adequate notice of their Application and of the date and time of the hearing.

1 the court, in the course of evaluating whether it had personal jurisdiction, undertook to  
2 determine whether specific jurisdiction existed. The specific jurisdiction test required the  
3 court to determine whether the Ives Defendants “purposefully directed” activities toward  
4 California or “purposefully availed” themselves of the privilege of conducting activities in  
5 California. *See Boschetto v. Hansing*, 539 F.3d 1011, 1016 (9th Cir. 2008). As part of its  
6 analysis, the court utilized the “effects test” from *Calder v. Jones*, 465 U.S. 783 (1984),  
7 which requires that a defendant have “(1) committed an intentional act, (2) expressly aimed  
8 at the forum state, (3) causing harm that the defendant knows is likely to be suffered in the  
9 forum state.” *Yahoo! Inc. v. La Ligue Contre Le Racisme Et L’Antisemitisme*, 433 F.3d 1199,  
10 1206 (9th Cir. 2006) (quoting *Schwarzenegger v. Fred Martin Motor Co.*, 374 F.3d 797, 803  
11 (9th Cir. 2004)).

12 After determining that the Ives Defendants had not “expressly aimed” any act at  
13 California, the court also went on to reach the third prong of the *Calder* “effects test.” In the  
14 course of holding that Plaintiff had not established that the Ives Defendants knew that their  
15 actions were likely to cause harm in California, the court noted in passing that Plaintiff had  
16 sufficiently alleged the causation aspect of the third prong: “In the instant case, Plaintiff  
17 sufficiently alleges a prima facie case for the causation component. If Productive People  
18 indeed had rights in the Namedrop mark, it suffered harm in California, where it conducts  
19 significant business, when Defendants inappropriately used the mark.” (Dkt. # 6 Ex. L at  
20 13.)

21 The finding that Plaintiff sufficiently alleged a prima facie case of causation for  
22 purposes of the “effects test” in no way equates to a finding that Plaintiff actually suffered  
23 harm for the purposes of granting a preliminary injunction. The court’s statement, which in  
24 any event is dicta, goes no further than to discuss the sufficiency of allegations of causation;  
25 it does not make any finding regarding actual harm. Regardless, as explained below, a  
26 finding of harm is not sufficient to establish that a preliminary injunction is warranted.  
27 Rather, the relevant inquiry involves consideration of the balance of the hardships, the  
28 likelihood of success on the merits, and several other facets. *See Bernhardt v. Los Angeles*

1 County, 339 F.3d 920, 925 (9th Cir. 2003). Thus, summary grant of a preliminary injunction  
2 would still not be proper.<sup>4</sup> The Court therefore will not enter a preliminary injunction before  
3 Defendants have had an opportunity to be heard.

## 4 **II. Application for a Temporary Restraining Order**

5 Because summary entry of a preliminary injunction is not warranted, the Court is left  
6 with Plaintiff's alternative request for a temporary restraining order. (Dkt. # 6 at 12.) "The  
7 standard for issuing a temporary restraining order is identical to the standard for issuing a  
8 preliminary injunction." *Brown Jordan Int'l, Inc. v. Mind's Eye Interiors, Inc.*, 236 F. Supp.  
9 2d 1152, 1154 (D. Haw. 2002). "[T]o obtain a preliminary injunction, the moving party must  
10 show either (1) a combination of probable success on the merits and the possibility of  
11 irreparable injury or (2) that serious questions are raised and the balance of hardships tips in  
12 its favor." *Roe v. Anderson*, 134 F.3d 1400, 1402 (9th Cir. 1998) (quoting *United States v.*  
13 *Nutri-cology, Inc.*, 982 F.2d 394, 397 (9th Cir. 1992)). "These two formulations represent  
14 two points on a sliding scale in which the required degree of irreparable harm increases as  
15 the probability of success decreases." *Id.* (quoting *Nutri-cology*, 982 F.2d at 397). The Court  
16 will address each of the two ends of the spectrum in turn.

### 17 **I. Probability of Success on the Merits**

18 Under the briefing as it now stands, Plaintiff has sufficiently established a likelihood  
19 of success on the merits to warrant entry of a temporary restraining order.<sup>5</sup> "To prevail on  
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21 <sup>4</sup>Plaintiff's only other argument is that the Ives Defendants "continue to dodge  
22 service." (Dkt. # 6 at 9.) Plaintiff makes no attempt to attach this to any legal argument  
23 regarding the motion for a preliminary injunction. The only authority Plaintiff offers is  
24 several criminal cases pointing out that a factfinder can infer consciousness of guilt from  
25 flight and evasive behavior. These cases have nothing to do with the underlying issues of  
26 the Application and provide no basis for granting a preliminary injunction.

27 <sup>5</sup>"In a trademark infringement claim, irreparable injury may be presumed from a  
28 showing of likelihood of success on the merits. This presumption effectively conflates the  
dual inquiries of this prong into the single question of whether the plaintiff has shown a  
likelihood of success on the merits." *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199,  
1205 n.4 (9th Cir. 2000) (internal quotations and citations omitted).

1 a claim under the Lanham Act, [the plaintiff] must establish that [the defendant] is using a  
2 mark confusingly similar [to] its own.” *GoTo.com*, 202 F.3d at 1205. “[M]ore precisely,  
3 because we are at the preliminary injunction stage, [a plaintiff] must establish that it is likely  
4 to be able to show a likelihood of confusion.”<sup>6</sup> *Id.* (quotation and ellipsis omitted). A  
5 likelihood of confusion is established by use of the eight factors outlined in *AMF Inc. v.*  
6 *Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).<sup>7</sup> Those factors are: (1) the strength  
7 of the mark; (2) the proximity of the goods; (3) the similarity of the marks; (4) evidence of  
8 actual confusion; (5) marketing channels used; (6) the type of goods and the degree of care  
9 likely to be exercised by the purchaser; (7) the defendant’s intent in selecting the mark; and  
10 (8) the likelihood of expansion of the product lines. *Id.*

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12         <sup>6</sup>In addition to showing a likelihood of confusion, Plaintiff must also show that it owns  
13 a valid trademark. *See Grocery Outlet Inc. v. Albertson’s Inc.*, 497 F.3d 949, 951 (9th Cir.  
14 2007). The Ives Defendants did not offer any argument to the contrary in the California  
15 action, and thus this point does not appear to be at issue between the parties. Regardless, on  
16 review of the record as it now stands, Plaintiff has sufficiently established ownership of a  
17 valid trademark to succeed on its Application for a temporary restraining order. In the  
18 absence of a registered trademark presumption (as in this case), the Court must determine the  
19 distinctiveness of the mark and which party first made commercial use thereof. *See Glow*  
20 *Indus., Inc. v. Lopez*, 252 F. Supp. 2d 962, 976-77, 980-81 (C.D. Cal. 2002). Here, the term  
21 “namedrop” is suggestive, and therefore inherently distinctive, because it does not actually  
22 describe the service’s features, but rather it only suggests them, requiring a degree of  
23 imagination or reasoning to understand the nature of the service. *See id.* at 977. Also, it  
24 appears from the record that Plaintiff was the first to engage in commercial use of the mark  
25 by advertising for the Academy Awards party, making sales presentations, and using  
26 promotional materials. The Ives Defendants’ earlier registration of a domain name was not  
27 inherently commercial use, *see Acad. of Motion Picture Arts & Sciences v. Network Solutions*  
28 *Inc.*, 989 F. Supp. 1276, 1281 (C.D. Cal. 1997), and until after litigation began the website  
itself was either blank or lacked sufficient functionality to constitute prior commercial use,  
*see Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1156-57 (9th Cir. 2001). Alternatively,  
any use would not be continuous given the fact that the site was blank for years before the  
California action was filed, with no indication of an intent to resume use, and thus any  
trademark rights would have been abandoned. *See Star-Kist Foods, Inc. v. P.J. Rhodes &*  
*Co.*, 769 F.2d 1393, 1396 (9th Cir. 1985). Therefore, as the record now stands, Plaintiff has  
established ownership of a valid trademark.

<sup>7</sup>*Sleekcraft* has been abrogated in part on other grounds. *See Mattel, Inc. v. Walking*  
*Mountain Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003).

1            “In the context of the Web in particular, the three most important *Sleekcraft* factors  
2 are (1) the similarity of the marks, (2) the relatedness of the goods or services, and (3) the  
3 simultaneous use of the Web as a marketing channel.” *GoTo.com*, 202 F.3d at 1205 (internal  
4 quotations omitted). The Court will address those three factors first and then go on to  
5 address the remaining five factors. On balance, the Court finds this case analogous to  
6 *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir.  
7 1999), and therefore concludes that Plaintiff has established a likelihood of consumer  
8 confusion based on the record as it now stands.

9            **(1) The Similarity of the Marks**

10           “The similarity of the marks will always be an important factor,” and “the more  
11 similar the marks in terms of appearance, sound, and meaning, the greater the likelihood of  
12 confusion.” *Id.* at 1054. Moreover, “similarities [are] weighed more heavily than  
13 differences.” *Id.* However, “the marks must be considered in their entirety and as they  
14 appear in the marketplace.” *Id.* (internal quotations omitted).

15           Here, there is complete identity between the allegedly infringing [www.namedrop.com](http://www.namedrop.com)  
16 and Plaintiff’s use of “namedrop” as a trademark. The Ninth Circuit has found that the use  
17 of the same term as a trademarked word in an internet address does not undermine the  
18 complete identity of the marks. *See id.* at 1055 (collecting cases and finding that the  
19 mark “MOVIEBUFF” and the website [www.moviebuff.com](http://www.moviebuff.com) were, “for all intents and  
20 purposes, identical in terms of sight, sound, and meaning,” and concluding that “the  
21 similarity factor weighs heavily in favor of [granting a preliminary injunction]”). Thus, this  
22 factor strongly suggests a likelihood of confusion.

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1           **(2) The Relatedness of the Goods or Services**

2           “Related goods are generally more likely than unrelated goods to confuse the public  
3 as to the producers of the goods.” *Id.* Where, as here, the marks are identical, “confusion  
4 would follow as a matter of course” if the marks “were used with identical products or  
5 services.” *Id.* at 1056. If, on the other hand, the parties “did not compete to any extent  
6 whatsoever, the likelihood of confusion would probably be remote.” *Id.* “Relatedness of  
7 each company’s prime directive isn’t relevant” to this inquiry; rather, “the focus is on  
8 whether the consuming public is likely somehow to associate [the defendant’s] products with  
9 [the plaintiff’s].” *Id.*; *see also Garden of Life v. Letzer*, 318 F. Supp. 2d 946, 964 (C.D. Cal.  
10 2004) (“The parties’ goods need not be identical or directly competitive . . . . They need only  
11 be related in some manner, or the conditions surrounding their marketing be such that they  
12 could be encountered by the same purchaser under circumstances that could give rise to the  
13 mistaken belief that the goods come from a common source.”).

14           Here, the relatedness factor weighs at least slightly in favor of finding a likelihood of  
15 consumer confusion. The services offered by the Ives Defendants – custom branding of  
16 merchandise for business and event promotion (*see* Dkt. # 6 Ex. E ex. 10) – are clearly not  
17 “identical” to the services offered by Plaintiff, which involve “[e]lectronic publishing  
18 services, namely, publication of text and graphic works of others online featuring information  
19 and accomplishments of individuals; publishing of electronic publications” (Dkt. # 6 Ex. K  
20 ex. 19). However, neither are the services so completely dissimilar as to forestall any  
21 possibility of consumer confusion.

22           *Brookfield* is again instructive on this point. In that case, the plaintiff owned the mark  
23 for “MOVIEBUFF,” under which it operated a searchable online database with detailed  
24 information on films, while the defendant owned [www.moviebuff.com](http://www.moviebuff.com), which rented and  
25 sold video tapes, facilitated by an online database of more general film information. 174  
26 F.3d at 1056. The Ninth Circuit held that the services were sufficiently related even though  
27 the plaintiff’s prime directive was to sell movie information, while the defendant’s prime  
28 directive was to rent and sell video tapes. *Id.* at 1056-57. The court so held because the

1 products were related “to some extent” and because the parties “offer[ed] products and  
2 services relating to the entertainment industry generally” and “to movies specifically.” *Id.*  
3 at 1056.

4 Similarly, in this case, the fact that Plaintiff’s prime directive is to sell promotional  
5 information, while the Ives Defendants’ is to sell promotional labels, does not render the  
6 services completely unrelated. Both services generally involve the promotions industry, both  
7 make use of graphical works, and both offer the opportunity for self-promotion. Plaintiff’s  
8 website, which employs the “namedrop” mark, advertises the opportunity for clients to  
9 “connect with the world’s biggest names” and to gain “extraordinary access” thereto. (Dkt.  
10 # 6 Ex. F ex. 2). Similarly, www.namedrop.com offers clients the opportunity for self-  
11 promotion through “custom branding” to “promote your organizations and events” (Dkt. #  
12 6 Ex. E ex. 10). Because Plaintiff’s services likewise involve “publication of text and  
13 graphic works” (Dkt. # 6 Ex. K ex. 19), there is, like *Brookfield*, a great deal of potential  
14 overlap between the parties’ consumers. *See* 174 F.3d at 1056 (“The relatedness is further  
15 evidenced by the fact that the two companies compete for the patronage of an overlapping  
16 audience.”). While the relatedness of the services is not as compelling as that in *Brookfield*,  
17 the services are related enough to suggest that the consuming public is “to some extent”  
18 likely to associate the Ives Defendants’ services with Plaintiff’s. *See id.* Thus, this factor  
19 weighs at least slightly in favor of granting the temporary restraining order.

### 20 (3) The Simultaneous Use of the Web as a Marketing Channel

21 If both parties use the Web as a marketing and advertising facility, “courts have  
22 consistently recognized [this factor] as exacerbating the likelihood of confusion.” *Id.* at  
23 1057. Here, both parties use the Web as their primary marketing channel. Thus, this factor  
24 strongly weighs in favor of a finding that consumer confusion is likely.

25 The first and third factors strongly suggest a likelihood of confusion, while the second  
26 does so slightly. On balance, then, these three key factors counsel that there is a likelihood  
27 of consumer confusion. Although these three factors are the most important in this context,  
28 *see GoTo.com*, 202 F.3d at 1205, the Court will also address the other factors to the extent

1 that they apply to determine whether they “tip the scale back the other way.” *Brookfield*, 174  
2 F.3d at 1058.

#### 3 **(4) The Strength of the Mark**

4 “The stronger a mark – meaning the more likely it is to be remembered and associated  
5 in the public mind with the mark’s owner – the greater the protection it is accorded by the  
6 trademark laws.” *Id.* As discussed above in footnote six, the “namedrop” mark is  
7 suggestive. “[S]uggestive marks are presumptively weak,” *id.*, and thus this factor would  
8 seem to favor the Ives Defendants’ position. However, “[w]hether a mark is weak or not is  
9 of little importance where the conflicting mark is identical and the goods are closely related.”  
10 *Id.* at 1059 (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair*  
11 *Competition* § 11:76 (4th ed. West 2009)). Here, the marks are identical and the services are,  
12 if not closely related, at least related enough to indicate a likelihood of consumer confusion.  
13 Thus, this factor carries only slight weight.

#### 14 **(5) Evidence of Actual Confusion**

15 “Evidence that the use of the two marks has already led to confusion is persuasive  
16 proof that future confusion is likely.” *Sleekcraft*, 599 F.2d at 352. Here, Plaintiff has  
17 produced evidence of confusion in the form of an affidavit attesting that “multiple celebrity  
18 providers, partners, and media contacts have expressed explicit confusion over the domain  
19 name ‘namedrop.com,’ believing the content on that website to be that of Productive  
20 People.”<sup>8</sup> (Dkt. # 6 Pt. 7 at 2.) While the affidavit is undeniably vague, it offers at least some  
21 evidence of actual confusion. Therefore, this factor weighs somewhat in favor of Plaintiff.<sup>9</sup>

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23 <sup>8</sup>Although this is hearsay evidence, the Court may consider it on a motion for a  
24 preliminary injunction or temporary restraining order. *See Houdini Inc. v. Goody Baskets*  
25 *LLC*, 166 F. App’x 946, 947 (9th Cir. 2006) (“[T]he district court did not abuse its discretion  
26 in considering hearsay and biased evidence of actual confusion because the rules of evidence  
do not strictly apply to preliminary injunction proceedings.”).

27 <sup>9</sup>Even if it did not, this factor could not weigh in favor of the Ives Defendants. *See*  
28 *GoTo.com*, 202 F.3d at 1208 (“While evidence that the use of the two marks has already led  
to confusion is persuasive proof that future confusion is likely, the converse is not true. . . .

1                   **(6) The Degree of Care Likely to be Exercised by the Purchaser**

2                   This factor does not significantly weigh in either direction. On the one hand, if the  
3 “reasonably prudent customer” is relatively sophisticated, there is less of a likelihood of  
4 confusion. *See Brookfield*, 174 F.3d at 1060. Here, the Ives Defendants seem to target  
5 businesses and events promoters for custom branding, and Plaintiff seems to target celebrity,  
6 business, and media professionals. All of these are relatively sophisticated consumers, and  
7 thus there is less of a likelihood of confusion.<sup>10</sup> *See id.* On the other hand:

8                   In the Internet context, in particular, entering a web site takes  
9 little effort – usually one click from a linked site or a search  
10 engine’s list; thus, Web surfers are more likely to be confused  
as to the ownership of a web site than traditional patrons of a  
brick-and-mortar store would be of a store’s ownership.

11 *Id.* at 1057; *see also GoTo.com*, 202 F.3d at 1209 (“Navigating amongst web sties involves  
12 practically no effort whatsoever, and arguments that Web users exercise a great deal of care  
13 before clicking on hyperlinks are unconvincing.”). Here, both parties make use of the  
14 internet, a medium inherently susceptible to easy confusion, which weighs in favor of  
15 Plaintiff. The Court concludes that, under the circumstances, these competing considerations  
16 cancel out, rending this factor indeterminate.

17                   **(7) The Defendant’s Intent in Selecting the Mark**

18                   “‘This factor favors the plaintiff where the alleged infringer adopted his mark with  
19 knowledge, actual or constructive, that it was another’s trademark.” *Brookfield*, 174 F.3d at  
20 1059. Evidence that a party was attempting to engage in cybersquatting is relevant to a  
21 determination of malicious intent. *See id.* n.20 (citing *Minn. Mining & Mfg. Co. v. Taylor*,

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23  
24 [E]ven if [a defendant] could show . . . that no one was actually confused, it would by no  
means refute a likelihood of confusion.”) (internal quotation omitted).

25  
26 <sup>10</sup>The Court is viewing the Ives Defendants’ case at its strongest, for it is also possible  
27 that relatively unsophisticated consumers are envisioned by both parties’ services. If both  
28 sophisticated and unsophisticated consumers are at issue, then the degree of care exercised  
by both should be considered, *see Brookfield*, 174 F.3d at 1060, and that would add even  
more weight to Plaintiff’s argument that consumer confusion is likely.

1 21 F. Supp. 2d 1003, 1005 (D. Minn. 1998)). Under the Anticybersquatting Consumer  
2 Protection Act:

3 A person shall be liable in a civil action by the owner of a mark  
4 . . . if, without regard to the goods or services of the parties, that  
5 person (i) has a bad faith intent to profit from that mark . . . and  
6 (ii) registers, traffics in, or uses a domain name that . . . is  
7 identical or confusingly similar to that mark.

8 15 U.S.C. § 1125(d)(1)(A) (Supp. 2008). A person’s failure to use the domain name “in  
9 connection with the bona fide offering of any goods or services,” and a person’s “registration  
10 or acquisition of multiple domain names which the person knows are identical or confusingly  
11 similar to marks of others,” are both indicative of a bad faith intent to profit from the mark.  
12 *Id.* § 1125(d)(1)(B)(i)(III), (VIII).

13 Here, Plaintiff provides evidence that the Ives Defendants have registered 140  
14 websites, 125 of which contain only “parked” pages with no content and the remainder of  
15 which have no functional content (i.e., the links are dead, link to each other, or link to third-  
16 party websites without serving any apparent purpose). (Dkt. # 6 Ex. E at 1.) Plaintiff points  
17 out that, until litigation was filed in this case, the websites at issue here were similarly  
18 “parked” or functionally useless pages without contact capabilities for any goods or services.  
19 (See Dkt. # 6 Ex. E ex. 10, 14-16.) The Ives Defendants characterized this behavior in the  
20 California action as “mere coincidence” (Dkt. # 6 Ex. H at 14), but the Court concludes that  
21 Plaintiff has made out a colorable claim for cybersquatting based on this evidence. Thus, as  
22 the record now stands, this factor weighs in favor of Plaintiff.<sup>11</sup> See *Brookfield*, 174 F.3d at  
23 1059 n.20; *Taylor*, 21 F. Supp. 2d at 1005.

### 24 **(8) The Likelihood of Expansion of Product Lines**

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25 <sup>11</sup>Even if this is insufficient evidence of cybersquatting, this factor would not weigh  
26 in favor of the Ives Defendants, but rather would be indeterminate. See *Brookfield*, 174 F.3d  
27 at 1059 (“[T]he presence of intent can constitute strong evidence of confusion. The converse  
28 of this proposition, however, is not true: the lack of intent by a defendant is largely irrelevant  
in determining if consumers likely will be confused as to source.”) (quotation omitted).

1            “[A] ‘strong possibility’ that either party may expand his business to compete with the  
2 other will weigh in favor of finding that the present use is infringing.” *Sleekcraft*, 599 F.2d  
3 at 354. There does not appear to be any evidence in the record relating to the possible  
4 expansion of product lines. However, both parties operate generally in the promotions  
5 industry, and both involve self-promotion by graphic works, and thus there is some potential  
6 for each party’s future expansion into the other’s market. Given these considerations, this  
7 factor does not mitigate against the entry of a temporary restraining order in this context.

8            Upon consideration, these five additional factors do not change the Court’s conclusion  
9 that there is likelihood of consumer confusion. The strength of the mark weighs weakly  
10 against Plaintiff, while evidence of actual confusion and the Ives Defendants’ intent weighs  
11 more strongly in Plaintiff’s favor (and even if they did not, could not weigh in favor of the  
12 Ives Defendants). The degree of consumer care and the likelihood of expanding product  
13 lines do not weigh in either direction. On balance, these five factors confirm the Court’s  
14 conclusion based on the three most important factors that consumer confusion is indeed  
15 likely. Plaintiff has therefore established a probability of success on the merits of its  
16 infringement claim.

## 17 **II. Balance of the Hardships**

18            At the other end of the injunctive relief spectrum is the inquiry of whether “serious  
19 questions are raised [by the movant] and the balance of hardships tips in its favor.” *Roe*, 134  
20 F.3d at 1402. As the foregoing discussion demonstrates, Plaintiff clearly raises serious  
21 questions about the merits of its claim. However, Plaintiff has not demonstrated that the  
22 “balance of hardships tips sharply in [its] favor.” *GoTo.com*, 202 F.3d at 1205 (internal  
23 quotations omitted). Plaintiff states that it has been contacted by “celebrity providers,  
24 partners, and media contacts,” who have stated that they may be forming a negative opinion  
25 of Plaintiff because of the nature of the services offered on [www.namedrop.com](http://www.namedrop.com). (Dkt. # 6  
26 Pt. 7 at 2.) Plaintiff further suggests that its upcoming media “blitz” may increase such  
27 confusion. (*Id.*) This is some indication that Plaintiff would suffer harm from continued  
28 operation of the websites at issue, although the extent of that harm cannot be determined



