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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

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| PACIFIC LAW CENTER, a Professional Law Corporation; and SOLOMON WARD SEIDENWURM & SMITH, LLP,<br><br>Plaintiffs<br><br>vs.<br><br>SHAHROK SAADAT-NEJAD, an individual,<br><br>Defendant. | CASE NO. 07cv0460-LAB (POR)<br><br>BRIEF OF *AMICUS CURIAE* ACLU OF SAN DIEGO & IMPERIAL COUNTIES |

## INTRODUCTION

In any case, civil or criminal, the constitutional right to counsel attaches whenever a person is faced with the prospect of imprisonment. Apparently unrepresented by counsel, Defendant was found in civil contempt and incarcerated by order of this Court on July 12, 2007. Before incarcerating Defendant for civil contempt, the Court was required to advise Defendant of the right to counsel and appoint counsel if necessary, or ensure that Defendant knowingly, voluntarily, and intelligently waived the right to counsel. Unless the Court previously notified Defendant of the right to counsel and Defendant properly waived counsel, the Court should

vacate the contempt order and release Defendant. Before instituting further contempt proceedings that could result in imprisonment, the Court should ensure that Defendant is represented by counsel or that Defendant validly waives the right to counsel.

## FACTS

The following is only a brief summary of the underlying record with which the Court is familiar. Plaintiffs initiated this action alleging cybersquatting and trademark infringement, among other claims. Plaintiffs claim that Defendant registered various website domain names similar to those of Plaintiffs and posted content to those websites with the intent to disparage and damage Plaintiffs by dissuading actual and potential clients from doing business with them. Complaint ¶¶ 21, 26 (Docket No. 1). According to the docket, it does not appear that Defendant has been represented by counsel at any stage of this action.

On Plaintiffs' motion, the Court entered a preliminary injunction prohibiting Defendant from the following:

1. Registering and trafficking in any internet website or domain name that contains the words Pacific, Law and Center, with or without other words or symbols, in any respect whatsoever;

2. Registering and trafficking in any internet website or domain name that contains the words Solomon and Ward, with our without other words or symbols, in any respect whatsoever;

3. Registering and trafficking in the service mark or trade name Pacific Law Center in any respect whatsoever; and

4. Registering and trafficking in the service mark or trade name Solomon Ward or Solomon Ward Seidenwurm & Smith in any respect whatsoever.

(Docket No. 26.)

Subsequently, Plaintiffs alleged that Defendant was violating the injunction by registering and maintaining various domain names, including but not limited to:

- pacificlawyerscenter.com
- solomonwardswsslawcom.aspx
- solomonwardpacificlawcenter.aspx

(Docket No. 36, 39.)

The Court ordered Defendant to show cause why he should not be held in contempt. (Docket No. 37.) At the hearing, the Court found Defendant in contempt and ordered him incarcerated. (Docket No. 42, 43.) It does not appear that the Court appointed counsel or took an express waiver of counsel before making a contempt finding and incarcerating Defendant, though a transcript of the hearing is not available for public review.

**DISCUSSION**

Under the Sixth Amendment, "absent a knowing and intelligent waiver, no person may be imprisoned for any offense, whether classified as petty, misdemeanor, or felony, unless he was represented by counsel at his trial." *Argersinger v. Hamlin*, 407 U.S. 25, 37 (1972). The right to counsel is the linchpin of due process. "Of all the rights that an accused person has, the right to be represented by counsel is by far the most pervasive for it affects his ability to assert any other rights he may have." *United States v. Cronic*, 466 U.S. 648, 654 (1984); *see also Powell v. Alabama*, 287 U.S. 45, 68-69 (1932) ("The right to be heard would be, in many cases, of little avail if it did not comprehend the right to be heard by counsel.").

The Court is therefore obligated to appoint counsel for "any financially eligible person" who is constitutionally "entitled to appointment of counsel" or "faces loss of liberty in a case, and Federal law requires the appointment of counsel." 18 U.S.C. § 3006A(a)(1)(H)-(I). "The right to counsel turns on whether deprivation of liberty may result from a proceeding, not upon its characterization as 'criminal' or 'civil.'" *Ridgway v. Baker*, 720 F.2d 1409, 1413 (5th Cir.

1983). It is "the defendant's interest in personal freedom, and not simply the special Sixth and Fourteenth Amendments right to counsel in criminal cases, which triggers the right to appointed counsel," and therefore, "an indigent litigant has a right to appointed counsel ... when, if he loses, he may be deprived of his physical liberty," whether the case is civil or criminal. *Lassiter v. Department of Social Services*, 452 U.S. 18, 25-27 (1981).

In particular, the Ninth Circuit has expressly recognized the right to counsel in civil contempt proceedings that may result in imprisonment. *Henkel v. Bradshaw*, 483 F.2d 1386, 1389 (9th Cir. 1973) ("if a lawyer is not appointed for Henkel's representation, Henkel cannot be confined even if found to have been contemptuous"); *In re Grand Jury Proceedings*, 468 F.2d 1368, 1369 (9th Cir. 1972) ("Threat of imprisonment is the coercion that makes a civil contempt proceeding effective. The civil label does not obscure its penal nature," and thus indigent witness was entitled to appointment of counsel if threatened with imprisonment for contempt).

Other circuits agree that the right to counsel extends to civil contempt hearings from which imprisonment may result. *See In re Di Bella*, 518 F.2d 955, 959 (2d Cir. 1975) (right to counsel "must be extended to a contempt proceeding, be it civil or criminal, where the defendant is faced with the prospect of imprisonment"); *In re Kilgo*, 484 F.2d 1215, 1221 (4th Cir. 1973) ("There can be no doubt that Kilgo was entitled to counsel at the civil contempt hearing"); *Ridgway*, 720 F.2d at 1415 (if civil contempt proceeding "holds the threat of jail over the defendant," court "must accord the defendant facing it due process, including the right to counsel"); *Sevier v. Turner*, 742 F.2d 262, 267 (6th Cir. 1984) (person "incarcerated for sixteen days as a result of the civil contempt hearing ... was entitled to have the assistance of counsel during that proceeding"); *United States v. Anderson*, 553 F.2d 1154, 1156 (8th Cir. 1977) ("the Constitution requires that counsel be appointed for indigent persons who may be confined pursuant to a finding of civil contempt"); *Walker v. McLain*, 768 F.2d 1181, 1185 (10th Cir. 1985) (due process requires that "indigent defendant threatened with incarceration for civil

contempt ... who can establish indigency under the normal standards for appointment of counsel in a criminal case, be appointed counsel to assist him in his defense"). Whether incarceration is deemed civil or criminal, "the jail is just as bleak no matter which label is used." *Walker*, 768 F.2d at 1183. Therefore, Defendant was entitled to representation by counsel, appointed if necessary, before he could be incarcerated for civil contempt.

In one case, the Ninth Circuit commented in passing that "criminal contempt proceedings, unlike civil contempt proceedings, require such protections as the sixth amendment right to counsel ...." *United States v. Rylander*, 714 F.2d 996, 998 (9th Cir. 1983). That statement does not contradict controlling authority that a person facing incarceration for civil contempt is entitled to counsel. In *Rylander*, the defendant appealed convictions for criminal contempt after he "was tried for both civil and criminal contempt in the same proceeding." *Id.* The Ninth Circuit noted that the "district court appointed an attorney to represent [defendant], and, after [defendant] discharged the attorney, appointed a second attorney, who was also subsequently discharged," after which the court found that defendant "knowingly, intelligently, and competently waived counsel." *Id.* at 1004-05. Because the defendant in *Rylander* validly waived counsel after discharging two appointed attorneys, any statements in that case about the right to counsel were dicta and do not undermine settled precedent that a person facing incarceration for civil contempt has a constitutional right to counsel.

Appointment of counsel is particularly important given the complicated issues at stake and the potential free speech ramifications. Because "invalidity of the underlying order is always a defense to a civil contempt charge," *In re Establishment Inspection of Hern Iron Works, Inc.*, 881 F.2d 722, 727 n.11 (9th Cir. 1989), counsel could have played a vital role in contesting the validity of the preliminary injunction. While it is beyond the scope of this brief to provide a comprehensive overview of the relevant law, and the Court need not decide the validity of its

preliminary injunction for purposes of appointing counsel, it is possible that Defendant may have meritorious arguments in opposition to the preliminary injunction.

According to the Ninth Circuit, "The Lanham Act, expressly enacted to be applied in commercial contexts, does not prohibit all unauthorized uses of a trademark," and thus noncommercial use of a trademark may not violate the Lanham Act. *Bosley Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005). *See also Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003) ("the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business. Such use is not subject to scrutiny under the Lanham Act," and where use of domain name "is not commercially misleading, the Lanham Act cannot be summoned to prevent it"). Defendant may thus have a defense to Plaintiffs' Lanham Act claims if his use of their trademarks was noncommercial.

While the Anticybersquatting Consumer Protection Act (ACPA) "does not contain a commercial use requirement," the defendant must have acted with "a bad faith intent to profit" to be liable under the ACPA. *Bosley Medical Institute*, 403 F.3d at 680-81. Moreover, domain names "*per se* are neither automatically entitled to nor excluded from the protections of the First Amendment, and the appropriate inquiry is one that fully addresses particular circumstances presented with respect to each domain name." *Id.* at 682. These issues require careful attention from counsel, particularly given the numerous factors relevant to whether Defendant acted with a bad faith intent to profit. *See* 15 U.S.C. § 1125(d)(1)(B).

As the Fourth Circuit has noted, "In its two most significant recent amendments to the Lanham Act, the Federal Trademark Dilution Act of 1995 ("FTDA") and the Anticybersquatting Consumer Protection Act of 1999 ("ACPA"), Congress left little doubt that it did not intend for trademark laws to impinge the First Amendment rights of critics and commentators." *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005). Due to "First Amendment concerns," the "dilution statute applies to only a 'commercial use in commerce of a mark,' and explicitly

states that the '[n]oncommercial use of a mark' is not actionable." *Id*. (citations omitted). "Similarly, Congress directed that in determining whether an individual has engaged in cybersquatting, the courts may consider whether the person's use of the mark is a 'bona fide noncommercial or fair use,'" in order to protect the rights of "all Americans in free speech and protected uses of trademarked names for such things as parody, comment, criticism, comparative advertising, news reporting, etc." *Id.*

In addition to these concerns, the issue arises whether there is "a likelihood of confusion" between Plaintiffs' and Defendant's websites. *Id.* at 314. In *Lamparello,* the Rev. Jerry Falwell sued a defendant who maintained the website www.fallwell.com, and the court noted:

> Reverend Falwell's mark is distinctive, and the domain name of Lamparello's website, www.fallwell.com, closely resembles it. But, although Lamparello and Reverend Falwell employ similar marks online, Lamparello's website looks nothing like Reverend Falwell's; indeed, Lamparello has made no attempt to imitate Reverend Falwell's website. Moreover, Reverend Falwell does not even argue that Lamparello's website constitutes advertising or a facility for business, let alone a facility or advertising similar to that of Reverend Falwell. Furthermore, Lamparello clearly created his website intending only to provide a forum to criticize ideas, not to steal customers.
>
> Most importantly, Reverend Falwell and Lamparello do not offer similar goods or services. Rather they offer opposing ideas and commentary. Reverend Falwell's mark identifies his spiritual and political views; the website at www.fallwell.com criticizes those very views. After even a quick glance at the content of the website at www.fallwell.com, no one seeking Reverend Falwell's guidance would be misled by the domain name - www.fallwell.com - into believing Reverend Falwell authorized the content of that website. No one would believe that Reverend Falwell sponsored a site criticizing himself, his positions, and his interpretations of the Bible.

*Id.* at 315. Defendant may have similar arguments at his disposal, which counsel could advance.

The Fourth Circuit also rejected a cybersquatting claim in *Lamparello,* noting that "Lamparello clearly employed www.fallwell.com simply to criticize Reverend Falwell's views," and such use "counsels against finding a bad faith intent to profit in such circumstances because 'use of a domain name for purposes of ... comment, [and] criticism' constitutes a 'bona fide

noncommercial or fair use' under the statute." *Id.* at 320. Again, Defendant may have similar arguments in response to the preliminary injunction.

Defendant might further argue that he has "created a gripe site" or multiple gripe sites. *Id.* at 321. Federal courts have "expressly refused to find that gripe sites located at domain names nearly identical to the marks at issue violated the ACPA." *Id.* (citing, e.g, *TMI, Inc. v. Maxwell*, 368 F.3d 433, 434-35, 438-39 (5th Cir. 2004) (no cybersquatting where customer of plaintiff registered domain name "which differed by only one letter" from plaintiff's mark and domain name and used site "to complain about his experience" with plaintiff, because site was noncommercial and designed only "to inform potential customers about a negative experience with the company")). Defendant would unquestionably benefit from the assistance of counsel in developing similar arguments.

Finally, the question arises whether a preliminary injunction is necessary to prevent irreparable harm. *See Taubman*, 319 F.3d at 778 ("Because Mishkoff is not using Taubman's mark to peddle competing goods, and because any damages would be economic in nature and fully compensable monetarily, we find no potential for irreparable harm to Taubman that should lead us to uphold the injunctions"). While Plaintiffs no doubt have legitimate arguments why Defendant's conduct is not legally protected and why an injunction is necessary, Defendant may also have substantial defenses, either on irreparable harm or on the merits. This case therefore presents substantial questions on which Defendant is entitled to have counsel appointed if the Court intends to incarcerate him for civil contempt.

This brief does not canvass every claim or possible defense or take a position on whether the Court's preliminary injunction is valid. Instead, this brief is submitted to uphold the constitutional right to counsel for anyone faced with imprisonment. Because of the complexity of the issues and the First Amendment implications, it is all the more important that the Court safeguard Defendant's right to counsel. It is respectfully suggested that the Court should uphold

the fundamental right to counsel by vacating the contempt finding and releasing Defendant, unless Defendant properly waived counsel at a previous hearing.

The "total deprivation of the right to counsel at trial" is structural error, not subject to harmless error review. *Arizona v. Fulminante*, 499 U.S. 279, 309 (1991); *see also Cordova v. Baca*, 346 F.3d 924, 925 (9th Cir. 2003) (complete "denial of the right to counsel at trial is not subject to harmless error review") (citing cases). Therefore, the contempt finding should be vacated without regard to whether denial of counsel prejudiced Defendant. And, in any case, as noted above, competent counsel may well have been able to articulate meritorious defenses.

Defendant's failure to request counsel, if any, cannot be construed as a waiver of his constitutional right to counsel. It is "settled that where the assistance of counsel is a constitutional requisite, the right to be furnished counsel does not depend on a request," and "when the Constitution grants protection against ... proceedings without the assistance of counsel, counsel must be furnished whether or not the accused requested the appointment of counsel," absent proper waiver. *Carnley v. Cochran*, 369 U.S. 506, 513 (1962). The Ninth Circuit has confirmed that the "right to the assistance of counsel is automatic; assuming the right is not waived, assistance must be made available ... whether or not the defendant has requested it," and any "request to proceed without counsel" must "be unequivocal." *Adams v. Carroll*, 875 F.2d 1441, 1444 (9th Cir. 1989).

Once the right to counsel has attached, a waiver of that right must be knowing, voluntary, and intelligent, and a defendant must be sufficiently advised of the dangers and disadvantages of self-representation. *Iowa v. Tovar*, 541 U.S. 77, 88 (2004); *Faretta v. California*, 422 U.S. 806, 835 (1975). Waiver cannot be inferred from silence in the record, particularly where Defendant did not have a right to appointment of counsel until the prospect of imprisonment arose. "Presuming waiver from a silent record is impermissible. The record must show ... that an accused was offered counsel but intelligently and understandingly rejected the offer. Anything

less is not waiver." *Carnley*, 369 U.S. at 516. Therefore, unless the Court notified Defendant of the right to counsel and Defendant expressly waived such right after sufficient warnings from the Court, Defendant did not properly waive his right to counsel, and the contempt finding should be vacated. *See Walker*, 768 F.2d at 1185 (vacating civil "contempt order entered without the assistance of counsel and without notice of the right to appointed counsel"). If further contempt proceedings are initiated against Defendant, the Court must "determine whether he meets the standards for appointment of counsel. If he does, counsel must be appointed to represent him," unless he validly waives the right to counsel. *Id.*

If Defendant will not be subject to imprisonment in the event of a subsequent contempt finding, appointment of counsel may not be necessary. *Cf. Ridgway*, 720 F.2d at 1415 ("the state may obviate the need for counsel by announcing that imprisonment will not result from the proceeding"). But if the Court intends to contemplate further imprisonment, the Court should determine if Defendant qualifies financially for appointment of counsel and appoint counsel from the Federal Defender or CJA panel if Defendant so qualifies, *see* 18 U.S.C. § 3006A(b), unless Defendant knowingly, voluntarily, and intelligently waives the right to counsel after sufficient warnings of the dangers and disadvantages of self-representation.

## CONCLUSION

For the foregoing reasons, the Court is respectfully requested to vacate the contempt finding, release Defendant, and appoint counsel if Defendant remains subject to further imprisonment for contempt, absent proper waiver or lack of financial eligibility by Defendant.

Dated this 23rd day of July 2007.

ACLU FOUNDATION OF SAN DIEGO & IMPERIAL COUNTIES

By: **s/David Blair-Loy**
David Blair-Loy