

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MISSOURI  
EASTERN DIVISION

JOHN BEAL, INC., )  
 )  
 Plaintiff, )  
 )  
 v. ) No. 4:16 CV 1151 CDP  
 )  
 ROOFPROS, INC., et al., )  
 )  
 Defendants. )

**MEMORANDUM AND ORDER**

In this trademark infringement action, plaintiff John Beal, Inc., claims that defendants Roofpros, Inc. (a foreign corporation located in South Africa), and Web.com Group, Inc., wrongfully used its trademark and logo to solicit business from homeowners who thought they were doing business with plaintiff. Through the course of discovery, plaintiff learned that All Response Media, Ltd. (an entity located in the United Kingdom), committed the alleged offending conduct it had attributed to Web.com and that Web.com is not liable for the conduct at issue in this case. In a single motion filed with the Court, plaintiff now seeks to: 1) dismiss Web.com from this action without prejudice, 2) join a new foreign defendant to the case, and 3) amend the complaint to add this defendant and refine its claims of trademark infringement. I will dismiss Web.com from this action and permit plaintiff to amend its complaint. I will deny as moot plaintiff's request to join the newly named foreign defendant.

## **Motion to Dismiss Without Prejudice**

Under Fed. R. Civ. P. 41(a)(1), a plaintiff may voluntarily dismiss its complaint against a defendant without prejudice if the dismissal occurs before the defendant has either answered or moved for summary judgment. Otherwise, “an action may be dismissed at the plaintiff’s request only by court order, on terms that the court considers proper.” Fed. R. Civ. P. 41(a)(2).

Here, defendant Web.com answered plaintiff’s complaint and proceeded through discovery and other preliminary scheduling and motion practice. Web.com agrees that plaintiff’s case against it should be dismissed and does not object to a dismissal without prejudice. Web.com argues, however, that the circumstances of this case require that terms of dismissal be imposed, and specifically, that dismissal without prejudice be conditioned on plaintiff’s payment of its attorney’s fees and costs incurred in this action in the event plaintiff refiles the case against it. Plaintiff did not respond to this proposal. I agree with Web.com that this condition is proper here. Therefore, under Fed. R. Civ. P. 41(d), I will order that if plaintiff files an action based on or including the same claim against defendant Web.com, plaintiff shall pay to Web.com all of Web.com’s costs of this action, including its reasonable attorney’s fees incurred in defending the action. These costs and fees will be determined at the time of the new filing. *See Jeffries v. Missouri Metals, LLC*, No. 4:13-CV-1921 JAR, 2014 WL 1846305, at \*3 (E.D. Mo. May 8, 2014).

**Motion for Leave to File an Amended Complaint /  
Motion to Join Foreign Defendant**

Plaintiff seeks leave to file an amended complaint naming Roofpros, Inc., and All Response Media, Ltd., as defendants. I will grant this request. Plaintiff shall effect service of process upon these foreign defendants in accordance with the Federal Rules of Civil Procedure and shall promptly provide proof of service under Fed. R. Civ. P. 4(*l*), so that this action – which has now been pending in this Court for over a year<sup>1</sup> – may proceed.<sup>2</sup>

Because the amended complaint adds All Response Media, Ltd., as a defendant to this action, plaintiff's separate request to join this foreign defendant will be denied as moot.

Accordingly,

**IT IS HEREBY ORDERED** that plaintiff John Beal, Inc.'s Motion to Dismiss Web.com Group Without Prejudice, for Joinder of a New Foreign Defendant, and for Leave to File an Amended Complaint [40] is granted in part and denied as moot in part as described in this Memorandum and Order.

**IT IS FURTHER ORDERED** that plaintiff's claims against defendant Web.com Group, Inc., are dismissed without prejudice subject to the following

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<sup>1</sup> Plaintiff originally filed this action in State court in November 2015. After being named a defendant in May 2016, Web.com removed the action to this Court in July 2016 on the basis of federal question and diversity jurisdiction.

<sup>2</sup> I note that despite being served with process in October 2016, defendant Roofpros never answered or otherwise appeared in this action.

condition: If plaintiff refiles these claims against Web.com Group, Inc., it must pay to defendant Web.com Group, Inc., any costs, including reasonable attorney's fees, it incurred in this action.

**IT IS FURTHER ORDERED** that the Clerk of Court shall docket plaintiff's Proposed Amended Complaint (ECF #43) to reflect its filing date to be the date of this Memorandum and Order.

**IT IS FURTHER ORDERED** that the Case Management Order entered February 3, 2017 (ECF #34), the Supplemental Case Management Order entered June 2, 2017 (ECF #38), and the Order Referring Case to Alternative Dispute Resolution entered June 2, 2017 (ECF #39) are vacated.

  
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CATHERINE D. PERRY  
UNITED STATES DISTRICT JUDGE

Dated this 19th day of July, 2017.