

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

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WEB-ADVISO, J. TAIKWOK YUNG, <i>pro se</i> ,	:	
	:	
Plaintiff-Counterclaim	:	
Defendant,	:	<u>OPINION AND ORDER</u>
	:	11-cv-1413 (DLI) (VVP)
-against-	:	
	:	
DONALD J. TRUMP,	:	
	:	
Defendant-Counterclaim	:	
Plaintiff.	:	
	:	
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DORA L. IRIZARRY, U.S. District Judge:

Pro se plaintiff-counterclaim defendant J. Taikwok Yung, who purportedly does business under the name Web-adviso (“Plaintiff”),¹ brought this action against defendant-counterclaim plaintiff Donald J. Trump (“Defendant”) seeking a declaration that he is entitled to use the internet domain names trumpabudhabi.com, trumpbeijing.com, trumpindia.com and trumpsmbai.com (collectively, the “Domain Names”), because his use of the Domain Names does not infringe on any of Defendant’s trademark rights or violate the Anti-Cybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C. § 1125(d). (*See* Compl., Dkt. Entry 1, ¶¶ 2, 17-23.) Defendant brought counterclaims against Plaintiff for: 1) federal trademark infringement; 2) federal unfair competition; 3) federal trademark dilution; 4) violation of the ACPA; 5) New York State law unfair competition; 6) violation of New York State Deceptive and Unfair Trade Practices Act; and 7) New York State law trademark dilution. (*See* Counterclaim, Dkt. Entry 4, ¶¶ 26-60.)

¹ It does not appear that Web-Adviso is an entity with a separate legal existence from Yung. Therefore, the court uses the term Plaintiff to refer to Yung personally and Yung as his d/b/a, Web-Adviso, interchangeably.

Defendant moved for partial summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure on Plaintiff's declaratory judgment claims and Defendant's counterclaims for federal and state trademark infringement, federal and state unfair competition and violation of the ACPA. (*See* Mem. in Supp. of Def.'s Mot. for Partial Summ. J., Dkt. Entry 39 ("Def.'s Mem."), at 1.) Plaintiff opposed the motion. (*See* Pl.'s Aff. in Opp'n to Def.'s Mot. for Partial Summ. J., Dkt. Entry 44 ("Pl.'s Opp'n").) For the following reasons, Defendant's motion is granted with respect to the ACPA claim and denied as moot as to all other claims.

BACKGROUND

Plaintiff is a self-described "domainer," which he defines as somebody who "acquire[s] interesting and high value domain names and park[s] them initially with domain parking service providers and/or build[s] the website, if feasible, with interesting content which takes significant time to program, customize and debug the back-end codes." (Pl.'s Opp'n ¶ 27.) Plaintiff explains that getting "high quality" domain names means "getting domain names that make sense, easy to remember, concise in spelling and convey a knowledge of quality of the internet in its name." (*Id.*) Besides the Domain Names, Plaintiff owns almost 200 other domain names, many of which contain names of well-known businesses, such as *barclayscapitallehman.com*, *citigroupwachovia.com*, *goldmansachsgroup.com*, *hulufriend.com*, *milanvogue.com*, *silversurfergame.com* and *xbox360sdk.com*. (Decl. of James D. Weinberger in Supp. of Def.'s Mot. for Partial Summ. J, Dkt. Entry 41 ("Weinberger Decl."), Ex. 9.)

Defendant is, among other things, a real estate developer and hotelier. (*See* Decl. of Eric F. Trump in Supp. of Def.'s Mot. for Partial Summ. J., Dkt. Entry 40 ("Trump Decl."), ¶ 9.) He has authored several books and hosts the nationally broadcast television shows *The Apprentice* and *The Celebrity Apprentice*. (*Id.* ¶¶ 12-13; Compl. ¶ 4.) In connection with his business

interests, Defendant has registered his last name in capital letters, “TRUMP,” as a trademark with the United States Patent and Trademark Organization (“USPTO”). (*See* Trump Decl. Ex. 1.) He has used this mark, personally and through a privately held business entity, The Trump Organization, to promote myriad goods and properties, including residential buildings, hotels, golf courses, clothing and home furnishings. (*See id.* ¶¶ 4-5, 10.) Defendant also has affirmed to the USPTO that he has used the TRUMP mark continuously for five years or more in connection with hotel services, bottled water and golf course services. (*See* Weinberger Decl. Ex. 1.)

Defendant also holds various domain names that he uses to promote his “brand.” (Trump Decl. ¶ 17.) While the “main website” for The Trump Organization is located at trump.com, Defendant also holds domain names with the word “trump” followed by a geographic location, which promote “TRUMP-branded” real estate projects in the location indicated by the domain name. (*Id.* ¶¶ 17-19.) These domain names include trumpchicago.com, triumphollywood.com and trumpistanbul.com.tr, promoting real estate bearing the TRUMP mark in Chicago, Illinois, Hollywood, Florida, and Istanbul, Turkey, respectively. (*Id.* ¶ 19.)

In 2007, Defendant’s son, who is an Executive Vice President of the Trump Organization, announced plans to build TRUMP-branded hotels and condominiums in Mumbai and Bangalore, India. (*Id.* ¶ 21 & Ex. 4.) Subsequently, in September and November 2007, Plaintiff registered the Domain Names, trumpbeijing.com, trumpindia.com, trumpmumbai.com and trumpabudhabi.com. (Pl.’s Opp’n ¶ 16.) Plaintiff states that the websites are not run for profit and host political and non-political commentary, satire and “shared complaints of the poor quality ultra-low budget reality TV show ‘The Apprentice.’” (*Id.* ¶¶ 5, 17.) The websites contain disclaimers that they are not affiliated with Defendant, such as: “The content and this website has [sic] NOT been approved by Donald Trump, or by the Trump Organization, or by

the shows “The Apprentice’/’The Celebrity Apprentice.’” (*Id.* ¶ 6 & Ex. C.)

On October 27, 2010, an attorney representing the Trump Organization wrote a letter to Plaintiff asserting that his use of trumpmumbai.com and trumpindia.com violated Defendant’s common law and federal trademark rights, and subjected Plaintiff to liability under the ACPA. (Trump Decl. Ex. 5.) The letter threatened Plaintiff with litigation if he did not transfer the domain names to Defendant. (*Id.*) By e-mail dated November 4, 2010, Plaintiff declined to comply with Defendant’s demands, but consented to negotiate “in the hope of reaching a more mutually beneficial agreement.” (*Id.* Ex. 6.) The same day, counsel for the Trump Organization offered to pay \$100 for trumpmumbai.com and trumpindia.com to cover “reasonable” transfer and registration costs incurred by Plaintiff. (*Id.* Ex. 7.) On November 8, 2010, Plaintiff replied that he “agrees to negotiate with your organization in hopes of reaching a more mutually agreeable terms [sic] [Plaintiff] believes the domain names, the large internet traffic from the site, and the development programming labor/work that has gone into building the site have significant value.” (*Id.* Ex. 8.)

On December 17, 2010, Defendant brought an arbitration proceeding against Plaintiff before the World Intellectual Property Organization pursuant to the Uniform Domain Name Resolution Policy (“UDRP”), asserting that the Domain Names infringed on the TRUMP mark. (Weinberger Decl. Ex. 4, ¶ 50.) Plaintiff opposed Defendant’s claims. (*See id.* Ex. 5.) On March 5, 2011, the arbitrator ruled in favor of Defendant, and directed that Plaintiff transfer the Domain Names to Defendant. (*Id.* Ex. 6 at 9.) In a written decision, the arbitrator found that the Domain Names were confusingly similar to the TRUMP trademark, Plaintiff had no legitimate interest in the Domain Names, and Plaintiff had registered and used the Domain Names in bad

faith.² (*Id.* at 6-9.)

On March 22, 2011, Plaintiff filed the instant action seeking a declaration that he is entitled to use the Domain Names because they do not infringe on Defendant's trademarks or violate the ACPA. (*See* Compl. ¶¶ 2, 17-23.) Defendant brought counterclaims against Plaintiff for: 1) federal trademark infringement pursuant to Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1); 2) federal unfair competition pursuant to Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A); 3) federal dilution pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); 4) violation of the ACPA; 5) unfair competition under New York State common law; 6) violation of New York State Deceptive and Unfair Trade Practices Act pursuant to Section 349 of the New York State General Business Law; and 7) New York State law trademark dilution under Section 360-1 of the New York State General Business Law. (*See* Counterclaim ¶¶ 26-60.)

Defendant moved for partial summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure on both of Plaintiff's declaratory judgment claims and Defendant's counterclaims for federal and state trademark infringement, federal and state unfair competition and violation of the ACPA. (*See* Def.'s Mem. 1.) Defendant contends that there is no genuine issue of material fact that: 1) he has a protectable right in the TRUMP mark; 2) Plaintiff's use of the mark is likely to cause confusion; and 3) Plaintiff is a "cybersquatter" under the ACPA. (*See id.*) Plaintiff opposed the motion, contending that: 1) the word "trump" is generic; 2) Plaintiff

² The parties have not addressed the implications of the UDRP proceeding on this action, but it appears that it has no precedential value. As one court in this circuit has explained: "[t]he UDRP process has been described as 'adjudication lite' because the proceedings are handled entirely upon written submissions and the arbitration panel has total discretion to determine the application of precedent and rules of evidence. The UDRP decisions are not binding on the courts." *Gen. Media Comm'ns, Inc. v. Crazy Troll, LLC*, 2007 WL 102988, at *4 (S.D.N.Y. Jan. 16, 2007) (internal citation omitted).

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