

1
2
3
4
5
6
7 **IN THE UNITED STATES DISTRICT COURT**
8 **FOR THE WESTERN DISTRICT OF WASHINGTON**
9 **AT SEATTLE**

10 In re www.lawsociety.com

11 S.H. INC Plaintiff,

12 v.

13 THE LAW SOCIETY, United Kingdom

14 Defendant
15

) Case No:
)
)

) COMPLAINT FOR INJUNCTIVE AND
) DECLARATORY RELIEF
)

) **DEMAND FOR JURY TRIAL**
)
)
)
)

16
17 COMES NOW, Plaintiff, S.H. INC by and through its attorney of record Noah Davis of IN
18 PACTA PLLC:

19 Providing notice to eNom.com (Registrar) that the Registrar must refrain from
20 transferring, suspending or otherwise modifying the domain name during the pendency of the
21 action, except upon order of the Court; and

22 Alleging as follows:
23

24 **I. NATURE OF THE CASE**

25 1. This is an action for injunctive and declaratory relief, involving a domain name
26 dispute between Plaintiff S.H. Inc and Defendant The Law Society of the United Kingdom
27
28

1 (a/k/a the Law Society of England and Wales), concerning the domain name:

2 www.lawsociety.com;

3 2. Plaintiff is the lawful registrant of the domain name;

4 3. Defendant is allegedly a mark holder of a similar name in the United Kingdom;

5 4. This Action is brought pursuant to 15 U.S.C. § 1125 the Anti-Cybersquatting
6 Protection Act (ACPA) and United States law shall apply;

7
8 5. This case arose from a complaint filed by the Defendant with ICANN, compelling a
9 non-binding form of alternative dispute resolution under UDRP through a WIPO
10 administrative panel as Case No. D2009-1520 – a process (including selection of ‘arbiters’)
11 which did not afford the Plaintiff with a full and fair opportunity to defend his lawful
12 registration and use of the domain name at issue, nor did the process provide Plaintiff with an
13 independent and fair adjudication of his rights;

14
15 6. The decision of the WIPO panel should be sealed or otherwise prevented from
16 consideration as a basis of the Court’s future decision in this action;

17
18 7. Based on the merits of his position, registration, use and intended use, as well as the
19 Defendant not having superior rights to use and registration of the domain name at issue,
20 Plaintiff prays for a declaration as to the lawful registration of the domain name, as well as a
21 preliminary and permanent injunction against any transfer of the domain name to the
22 Defendant;

23
24 **II. JURISDICTION AND VENUE**

25 8. This action is brought by Plaintiff seeking relief pursuant to 28 U.S.C. § 1331
26 (federal question) by way of 15 U.S.C. § 1114 et seq.;

1 9. The Registrar of the site eNom, including the server of the Registrar, is located in
2 Bellevue, King County Washington;

3 10. By Plaintiff's registration and Defendant's institution of a Complaint under UDRP,
4 the Parties have consented to personal jurisdiction and venue in King County, Western
5 District of Washington;

6 11. Otherwise, an in-rem action could be maintained, since the property in dispute
7 (www.lawsociety.org) is located in Bellevue, Washington;

8 12. Thus, venue is proper under 28 U.S.C. §1391, et al. and 15 U.S.C. §1125(d);

9
10 **III. PARTIES**

11 13. Plaintiff is a corporation, located in Belize City and organized under the laws of
12 Belize;

13 14. Defendant is a non-profit, or other entity, organized as an association of lawyers
14 (a/k/a a bar association), located in London, and organized under the laws of England or the
15 United Kingdom;

16 **IV. FACTS**

17 15. Plaintiff is the lawful registrant of the domain name "lawsociety.com", registered
18 with eNom (the initial registration of the site traces back to January 6, 1999);

19 16. Plaintiff's use and intended use of the site and generic name "lawsociety.com" is
20 for lawful purposes, including dissemination of information to the public about legal
21 services, lawyers, and the law;

22 17. Plaintiff's use and operation of the site is in good faith, and independent of the
23 Defendant's website or other lawfully recognizable trademarks;

1 18. The current site found at www.lawsociety.com presents itself in a developmental
2 stage, but nevertheless one presents information to a society of law – one which is free to the
3 public, and supported by advertisements of various legal providers and related entities (not
4 quite the level of lawyers.com or findlaw.com but also not so dissimilar);

5 19. Plaintiff's registration does not infringe on any United States' registered and
6 recognized trademark of the Defendant or other person or entity (nor any common law
7 trademark of the generic name "law society" – which is incapable of registration);

8 20. Plaintiff does not hold itself out as "the law society", but instead presents as an
9 online society of legal information and law, i.e., the "law society" for the public;

10 21. Defendant disagrees with Plaintiff's ability to register the domain name "law
11 society.com" and asserts some global ownership of the name "lawsociety" – even though the
12 Defendant's main domain name is actually "www.lawsociety.org.uk";

13 22. The Defendant's position is such that the similar generic name "bar association"
14 would be capable of trademark ownership by some entity, as would perhaps even "lawyer" or
15 "the lawyer" if used long enough;

16 23. Even if Defendant's use of the name "the law society" somehow distinguishes itself
17 from the commonality and generic nature of the phrase "law society", the Defendant's use
18 and registration in the UK of the word "the" before the name "law" further distinguishes
19 itself from the Plaintiff's registration in this case;

20 24. The Defendant does not have, and could not foreseeably have a famous mark or
21 global trademark of the name "law society";

22 25. Furthermore, "the law society" of the UK is known by many in and outside the UK
23 as "the law society of the UK" or "the law society of England and Wales";

1 26. The attempted registration of “law society” or “bar association” or “lawyer” or
2 “legal association” or “association of lawyers” is simply not distinct enough (nor is
3 Defendant famous enough) to permit registration of such a name in the United States;
4

5 **VI. FIRST CAUSE OF ACTION**

6 **ANTI-CYBERSQUATTING CONSUMER PROTECTION ACT (ACPA)**
7 **Reverse Hi-Jacking Claim 15 U.S.C. §1114(2)(D)(v) and 15 U.S.C. §1125(d)**

8 Plaintiffs incorporate by reference each and every allegation set forth in paragraphs 1 through
9 24 with the same force and effect as though fully set forth herein.

10 28. Plaintiff does not have a bad faith intent to profit from a protected and recognized
11 mark and instead, uses and intends to use the domain name, in part, for non-commercial
12 speech and fair use; and
13

14 29. Regardless, the domain name “lawsociety.com” is generic and incapable of
15 trademark protection;
16

17 30. Defendant’s mark, which may be registered in the United Kingdom, is not
18 registered in the United States, and is otherwise not distinctive within the meaning of Section
19 1125(c)(1) of the Lanham Act;

20 30. The Defendant does not have a “famous mark”;

21 31. Plaintiff’s domain name was wrongfully ordered to be transferred to the
22 Defendant;
23

24 32. Plaintiff reserves the right to Amend this Complaint as Discovery unfolds;

25 **VII. PRAYER FOR RELIEF**

26
27 WHEREFORE, Plaintiff prays that transfer of the domain www.lawsociety.com be
28 enjoined, that Plaintiff be declared the lawful registrant of this domain and that attorney fees

1 and costs be awarded to Plaintiff pursuant to 15 U.S.C. Chapter 22, Subchapter III or other
2 provisions of law as may be applicable.
3
4

5 DATED this 9th day of October, 2010

6 IN PACTA, PLLC

7 s/Noah Davis

8 Noah C. Davis, WSBA#30939
9 801 Second Ave. Suite 307
10 Seattle, Washington 98104
11 Telephone (206) 709-8281
12 Facsimile (206) 860-0178
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28