

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

U.S. DISTRICT COURT
N.D. OF N.Y.
FILED

SEP 04 2008

LAWRENCE K. BAERMAN, CLERK
ALBANY

RICHARD MINSKY, an individual, d/b/a
SLART® ENTERPRISES,

Civil Case No.: 08-CV-819

LEK/DRH

Plaintiff

vs.

**ORDER TO SHOW CAUSE:
TEMPORARY RESTRAINING
ORDER AND PRELIMINARY
INJUNCTION**

Linden Research, Inc., d/b/a Linden Lab®,
a Delaware corporation, John Doe (a/k/a
Victor Vezina), an individual, Philip
Rosedale, an individual, Mitchell Kapor,
an individual, other Does, presently
unknown to Plaintiff

Defendants

MEMORANDUM OF LAW

1. Plaintiff owns the Federal Registered Trademark SLART, Reg. No. 3399258. Section 33(a) of the Lanham Act, 15 U.S.C. § 1115(a), provides that any registration issued under the act shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce. Defendants have no legal justification for publishing the infringing material or otherwise presenting it to the public. As long as Plaintiff owns the registered trademark, as registrant he is entitled to the exclusive right to use it. There is more than a presumption of validity of a registered trademark. An opposing party can seek remedies if they believe the trademark should not have been issued, but unless and until a decision is made in any cancellation action the opposing party may take, the registrant retains the rights codified in the Lanham Act. If anyone is allowed to violate trademark rights merely because they claim that the USPTO made a mistake, and if the

rights are taken from the registrant for two years while defending the mark, then the trademark system fails. In order to protect these rights the registrant must be able to serve notices of infringement and dilution during the defense of the trademark.

2. Fed. R. Civ P. 65(b) says that the court may issue a temporary restraining order without written or oral notice to the adverse party or its attorney only if:

(A) specific facts in an affidavit or a verified complaint clearly show that immediate and irreparable injury, loss, or damage will result to the movant before the adverse party can be heard in opposition; and

(B) the movant's attorney certifies in writing any efforts made to give notice and the reasons why it should not be required.

Every day that infringement or dilution continues weakens a trademark. The defendants appear to be using that as a strategy in their business plan. They also have made groundless claims of ownership and control of the SLART mark. If they are allowed to continue encouraging others to use the mark for goods and services similar to those of the registrant, the mark will be diluted and the term may become generic. Plaintiff is and has been actively enforcing proper use of the mark, and Defendants are vigorously attempting to prevent Plaintiff from protecting the mark. In the Matter of Vuitton et Fils S.A., 606 F.2d 1,5 (2nd. Cir. 1979), a significant factor in granting a writ of mandamus for an ex parte order was that the evidence would be removed by the defendants. Upon being served with the original Complaint in the present matter, Linden caused the infringing matter to disappear and refused to provide any information about who had created, produced and presented the infringing matter, or by what means and with what notice the

matter had been removed. That made it impossible to prosecute the offending party, if it was not Linden themselves.

3. Since movant is the trademark registrant and owner, the threatened harm to movant due to infringement and dilution outweighs whatever damage the proposed injunction may cause to the opposing party.
4. The facts of the case are clear, and there is a substantial likelihood of Plaintiff's success on the merits.
5. The injunction would not be adverse to the public interest. To the contrary, it is in the public interest to protect trademark rights in general, and in this case, it would help preserve the public's knowledge of the true source of Plaintiff's goods and services.
6. No bond or security should be required of movant for this order, because any harm done to the defendants from it will be due to their violation of movant's rights.

AFFIDAVIT

7. Linden Research, Inc. [hereinafter "Linden"] maintained an infringing use of movant's trademark SLART inside its Second Life[®] virtual world [hereinafter SL] after being notified that it was infringing [as set forth in the Amended Complaint, ¶¶24-26]. An infringement notice was sent to Linden on April 22, 2008, along with follow-up e-mails and conversations, and Defendants refused to recognize the validity of the federal registered trademark, in violation of 15 U.S.C. § 1115(a). [Amended Complaint, ¶¶26 *et seq.*]

8. For a period of time the infringing use disappeared, then reappeared. [ibid. ¶¶27] and 34]
9. Linden refused to recognize my registered trademark, and continued presenting the infringing use. [ibid. ¶¶28, 33, 35]
10. Following my filing of the Civil Complaint, the infringing use disappeared again. [ibid., ¶¶38-39]
11. On August 14, the day of the filing of the Amended Complaint, Linden refused a request to provide a copy of any notice it may have sent to its user that resulted in the disappearance of the infringing use described in the complaint, and to identify the means by which such notice, if any, was served. [ibid. ¶¶43-47, 49-50, 52]
12. Linden has on several occasions ordered me to stop contacting “residents” of SL (users of their service) who infringe my registered trademark, in an attempt to deprive me of my trademark rights, and have claimed they own the SLART mark, calling it “our mark” and claim they can control its use. [ibid., ¶33]
13. . This is part of a new strategy that Linden has been aggressively pushing on many businesses that operate within its Second Life[®] virtual world [hereinaftes “SL”], following its issuing a Brand Center License on March 24, 2008 [ibid. Appendix D]. For several years prior to that Linden had encouraged and promoted businesses in SL that used SL as part of their business name, and had used the term SL and promoted the use of the term SL among users of its service and others to describe things related to its Second Life virtual world, such as SL art, SL fashion, SL architecture, etc. From the inception of my use of SLART in 2006 until I asked Linden to remove infringing material in a letter sent April 22, 2008 [ibid., ¶¶24-33], Linden made no objection to the SLART trademark,

either before, during, or after it was published for opposition, though Linden was well aware of its existence. I showed a SLART publication to Linden CEO Philip Rosedale on August 25, 2007, and Mr. Rosedale said “This is great.” Other Linden employees also were shown the SLART book then, as a paper edition, and I sent them copies of the 3D virtual edition inside the SL virtual environment.

14. Last week I received a notice from the Trademark Trial and Appeal Board [TTAB] that on August 21, 2008 Linden filed a Petition for Cancellation of the SLART mark with the TTAB.
15. The TTAB schedule for papers in this case runs through November, 2009, and their decision time is projected to be six months after all papers are in, making a decision expected in May 2010.
16. Linden is continuing its aggressive unilateral policy of deciding what can and cannot be a trademark, and is likely to infringe or support infringement on the SLART mark during the TTAB proceeding, which I expect will be dismissed. It is in their business interest to do so and causes me irreparable harm. [ibid. ¶¶28-29, 40-48, 51-53, Exhibit D].
17. I called the TTAB office and was told that during the TTAB proceeding I am the owner of the trademark. In order to protect my trademark rights I have to be able to continue enforcing it during this period. If I cannot enforce it, Linden’s strategy of encouraging infringement and dilution will succeed.
18. Since an infringing use of my registered trademark has already disappeared and reappeared, then disappeared again, and may reappear again, it seems that Linden has control of that and can use it tactically whenever it suits their strategy. My fear is that

without a restraining order and/or injunction infringements will continue to pop up and disappear during the TTAB proceeding, making it difficult or impossible to pursue remedies on an individual basis.

19. This morning, September 2, 2008, a search of “Classifieds” inside the SL world revealed an art gallery with an infringing and diluting use of SLART [Exhibit A]. It advertises products or services that may easily be identified by the use of non-infringing terms, and in fact does so [Exhibit B]. It also may be construed as suggesting my sponsorship or endorsement. Linden has told me to stop demanding that other “residents” of SL stop using SLART. The last infringing use I reported to Linden disappeared only after I filed a Civil Complaint, and I was not able to serve proper notice on the infringer, nor even identify if it was a real person outside Linden’s company who created the infringing material. If it was an outside person, I don’t know what Linden told them, and if they said things similar to what they have said to me [¶12 above], then they may have told them that their use of SLART infringes on a Linden trademark, a statement which would in itself dilute my SLART mark and would be an infringement that caused confusion about the source of my goods and services.

PRAYER FOR RELIEF

Wherefore, Plaintiff respectfully requests that this court grant the following relief

20. Issue Temporary Restraining Orders [TRO] compelling defendants to desist and refrain from:

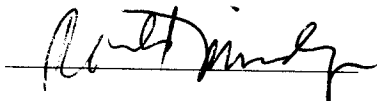
- a. Presenting unauthorized uses of the SLART federal registered trademark or encouraging, enabling or condoning infringement of the mark by others, in the

Second Life[®] virtual world or any other medium, including but not limited to websites, blogs and printed matter;

- b. hiding the identity(ies) of user(s) of its service who infringe on the SLART trademark;
 - c. harassing Plaintiff with threats and/or directives to stop contacting other users of Linden's services for the purpose of stopping infringement and enforcing his registered trademark SLART ;
 - d. claiming ownership of, control of, affiliation with, endorsement by, or other legal relationship to the SLART mark or Slart Enterprises.
21. Issue Preliminary Injunctions addressing the same activities, with a hearing scheduled to provide continuity from the TRO.

I declare under penalty of perjury that the foregoing is true and correct.

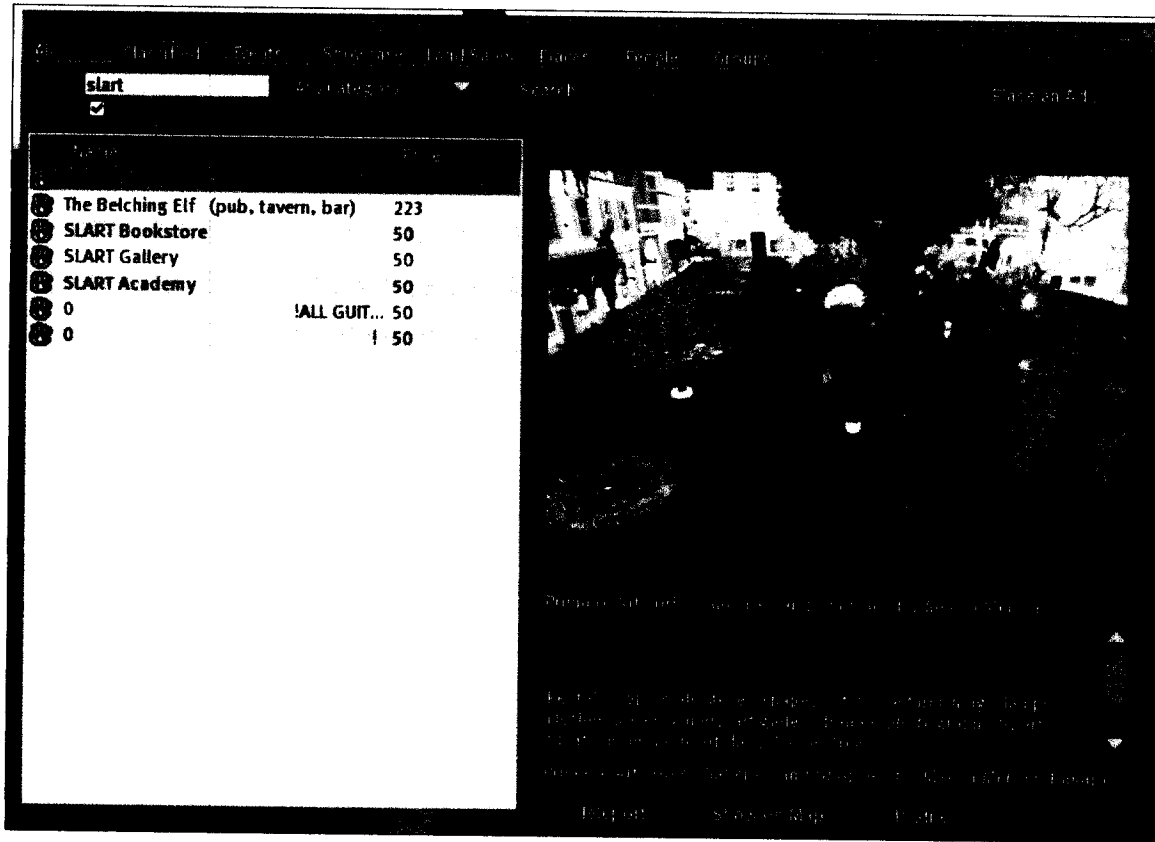
DATED: September 2, 2008

A handwritten signature in black ink, appearing to read "Robert M. Jones", written over a horizontal line.

Signature of Movant (Plaintiff)

EXHIBIT A

Classified ad search inside the Second Life virtual world for "SLART", September 2, 2008



This shows an art gallery I discovered in my search this morning that has used my trademark SLART without permission, which may be construed as my sponsorship, endorsement, or some other relationship with this gallery that does not exist. In SL the amount you pay for a classified ad determines placement, so someone who is looking to find the SLART Gallery through the classified search will find the above gallery at the top of the list. This is likely to cause a consumer to click on the "Teleport" button and go to that gallery instead of my gallery. Note that the gallery also includes the descriptive term SL art as well as my trademark. That gets them listed where they belong (see Exhibit B).

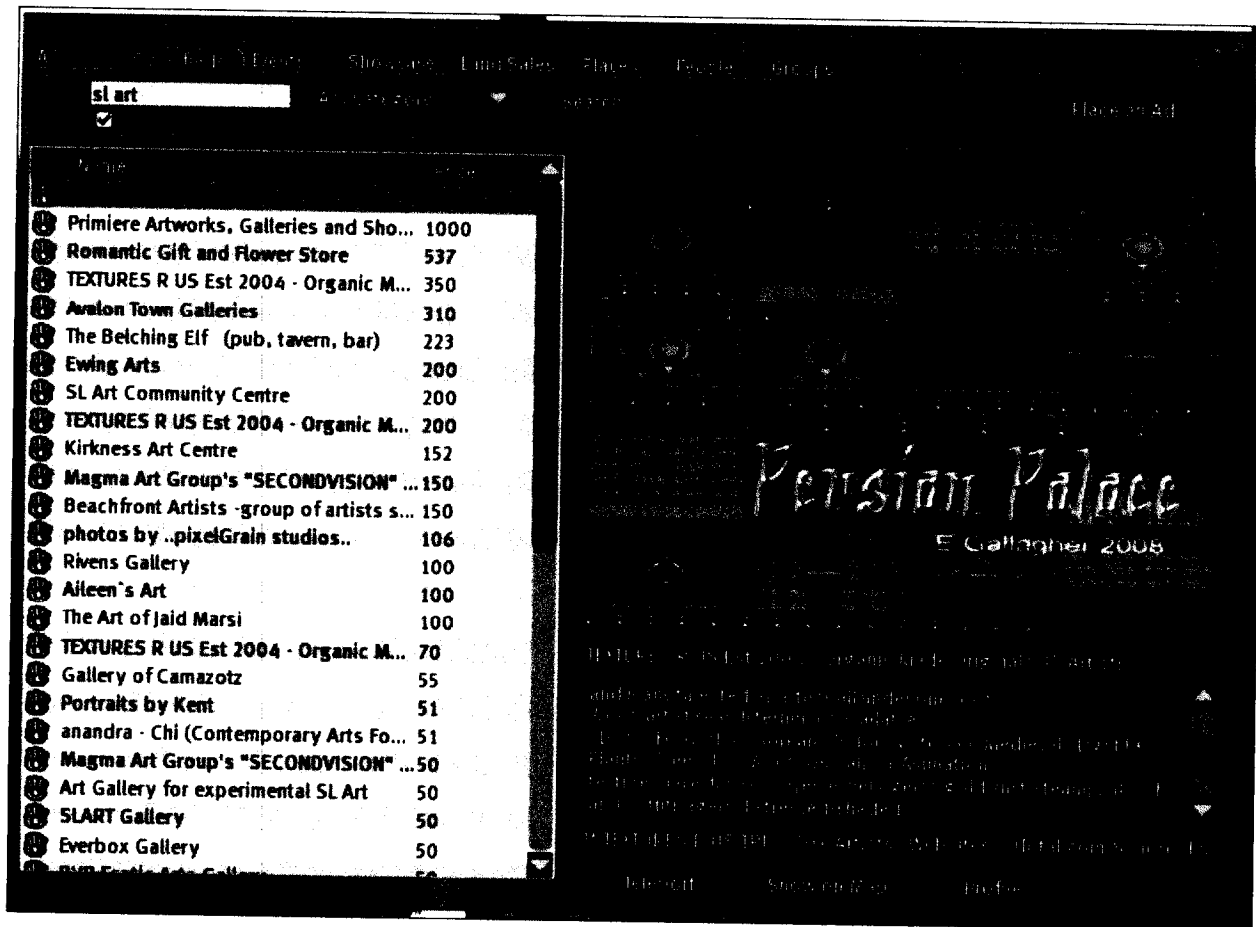
Note that "The Belching Elf" listing just below the infringing art gallery is not an infringing use of SLART, though it does appear in the search. It is a pub, tavern, bar, and the use of the word "slart" in their ad is "slart botgirl." That is a different signification of "slart": a girl who is in between a "slut" and a "tart," and the implication in their ad seems to be that you will meet that sort of girl in their pub. In SL many residents engage in virtual sex, and that seems to be what they are advertising. There also are "bots" in SL. These are programmed avatars that have scripted behavior. I assume that a "slart botgirl" might be an avatar programmed with sex animations.

In the prosecution of my SLART trademark I presented evidence of several such alternative meanings of SLART, as part of what differentiates it from the descriptive "SL ART" and this was decided in my favor by the USPTO. [Amended Complaint ¶¶ 19-20]

The three listings beginning SLART are mine. The two that follow are permitted, and appear because the listing includes a link to my review of this artist at slartmagazine.com.

EXHIBIT B

Classified ad search inside the Second Life virtual world for "SL ART", September 2, 2008



This shows the beginning of the list that comes up when the descriptive term "SL art" is entered in a search of the Classifieds.

In the prosecution of my SLART trademark I stated to the USPTO that I did not consider the common descriptive term "SL art" to infringe on the SLART mark. The USPTO ruled that "SL art" and SLART were distinct.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

RICHARD MINSKY, an individual, d/b/a SLART®
ENTERPRISES,

Civil Case No.: 08-CV-819

Plaintiff

LEK/DRH

vs.

**GRANT OF TEMPORARY RESTRAINING
ORDERS; NOTICE OF PRELIMINARY
INJUNCTION HEARING AND SUMMONS**

Linden Research, Inc., d/b/a Linden Lab®,
a Delaware corporation, John Doe (a/k/a Victor
Vezina), an individual, Philip Rosedale, an
individual, Mitchell Kapor, an individual, other
Does, presently unknown to Plaintiff

Defendants

It appears from the specific facts set out in the Verified Complaint filed with the clerk of this Court that immediate or irreparable loss or damage will result to the Plaintiff. Accordingly, at _____ o'clock . ____ M., this _____ day of _____, 200____, Defendant(s) and his/her/their employees and agents are ordered to desist and refrain from:

1. **Presenting unauthorized uses of the SLART federal registered trademark or encouraging, enabling or condoning infringement of the mark by others, in the Second Life® virtual world or any other medium, including but not limited to websites, blogs and printed matter;**
2. **hiding the identity(ies) of user(s) of its service who infringe on the SLART trademark;**
3. **harassing Plaintiff with threats and/or directives to stop contacting other users of Linden's services for the purpose of stopping infringement and enforcing his registered trademark SLART ;**
4. **claiming ownership of, control of, affiliation with, endorsement by, or other legal relationship to the SLART mark or Slart Enterprises.**

This Temporary Restraining Order EXPIRES ten days from the date and time it was granted, BUT IT MAY BE RENEWED in the form of a preliminary injunction. At the Plaintiff's request, a hearing to decide if a preliminary injunction should be issued has been scheduled for the _____ day of _____, 2008, at _____ o'clock . ____ M.

Upon _____ days' notice to the Plaintiff, the Defendant(s) may apply to the Court to dissolve or modify the Temporary Restraining Order. Further, the Defendant(s) must answer (respond to) the Plaintiff's Motion within _____ days of the date on which this Summons and a copy of the Motion are _____. The Answer must be in writing and must be filed with this Court and delivered to the Plaintiff. Failure to do so shall result in the entry of a default judgment against the Defendant(s) for the relief requested in the Motion.