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# DAILY REPORT

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► VERDICTS & SETTLEMENTS



ALISON CHURCH

From left: Latif Oduola-Owoo, Michael Mason and Robert Arrington Jr. represented a man in a case that shed light on domain-hosting companies planting advertising on dormant sites.

## New firm wins Web site case

LEGAL-DOCUMENTS FIRM loses trademark infringement claim  
against Atlanta man who owned 'WeThePeople.com'

BY GREG LAND

THREE FORMER King & Spalding litigators who struck out on their own five months ago have notched a win for an Atlanta man who owns the Internet domain name WeThePeople.com.

We The People is also the name of a national legal-documents franchise that brought arbitration proceedings against the man, community activist Dwayne Marshall, claiming he violated the company's trademark.

While the case was between

Marshall, who acquired the domain name in 1999 to encourage political discussion, and We The People, it also sheds light on the practice of domain-hosting companies planting

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### New firm wins Web site case against trademark claim

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advertising on dormant sites that can cause headaches for the site owners.

Marshall had incorporated a company, WTP Group, in 1999, and hired designers to come up with a logo for his political discussion site, but he got involved in other pursuits, and his site sat unused, or “parked,” with an “under construction” notice its only adornment.

And so things rested until this past July 23, when We The People filed an arbitration action against Marshall’s site alleging trademark violation and demanding that Marshall’s Web site be turned over to the company, which maintains its own Web site at WeThePeopleUSA.com.

“There was never any cease-and-desist letter or anything like that,” said Marshall’s lawyer, Michael C. Mason of Essentia Legal. “They just filed straight for arbitration. They moved very quickly.”

Marshall was among the first clients to cross the threshold of Essentia Legal, which had set up shop in Camp Creek Marketplace on July 1. Along with Mason, who left K&S after eight years as a trademark lawyer in their intellectual property section, the firm includes Robert L. Arrington Jr., who was with the K&S product liability group, and Latif Oduola-Owoo, who was also in the IP group.

The lawyers were initially eager to accept the case, but they lost their enthusiasm after paying a visit to Marshall’s site, which was loaded with links to law firms and document preparation services.

“We were like, ‘We can’t help you, man. We looked at your Web site; you’re selling legal documents,’” recalled Mason, suggesting that by competing with We The People’s business, Marshall could be liable.

“What the hell are you talking about?” asked Marshall, according to Mason. “I looked at it a month

ago, and there was nothing on it,” the lawyer recalls his client saying.

Unbeknownst to Marshall, the company hosting his site, Network Solutions, had been posting links to sites likely to interest Web-surfers looking for services related to the domain name.

In return, Network Solutions presumably reaps a profit whenever anyone links from a site it hosts to one of the advertising sites, known as “pay-per-click,” said Mason. He added that the practice is widespread and, in general, legal, because most domain-hosting companies require site owners to give permission to use parked sites for such purposes.

Mason said his client had bought the domain from another individual nine years earlier, and the domain-hosting company had itself been bought by Network Solutions in the intervening years.

“As soon as he found out, he contacted Network Solutions and they took down the links,” said Mason. Nonetheless, We The People pursued its case before a three-member panel of the National Arbitration Forum.

On Sept. 19, in a 2-1 decision, the panel ruled that Marshall had not infringed on We The People’s trademark, largely because the documents company’s registered mark includes the company name, as well as a distinctive Liberty Bell design, with the crack formed by the profiles of two faces.

Panelists Neil Anthony Brown and Bruce E. Meyerson found that Marshall domain name “is neither identical nor confusingly similar the complainant’s registered ‘We the People’ trademark.”

The panel rejected We The People’s assertions that Marshall’s was acting in competition with the company, noting that he had clearly demonstrated his intent to set up a political Web site. It also dismissed the company’s charges that Marshall had acted in bad faith, writing that he had clearly not registered the domain name in order to re-sell it to the company or a competitor, or to create “a likelihood of confusion with the

plaintiff’s mark.”

Once made aware of the offending links on July 25, Marshall quickly acted to have Network Solutions remove them, and they were gone by Aug. 14, the panel decision noted.

The decision noted that panelist David H. Bernstein dissented, arguing that We The People’s federally registered mark should have been given deference, despite the addition of the Liberty Bell logo and that, given Marshall’s admitted eight-year abandonment of the Web site, “it appears that [Marshall] has lost all interest in pursuing the Web site devoted to discussions of public affairs.”

An appeal is possible, said Mason, to ICANN (Internet Corporation for Assigned Names and Numbers). But he added that ICANN, which regulates Internet names and protocols, “gives great deference to the arbitrators’ decision.”

We The People’s attorney, Hillary B. Miller of Greenwich, Conn., said her client had requested that she not discuss the case.

“I expect it’s going to be the subject of a lot of discussion,” said Mason, noting that neither We The People nor his client would have been in dispute had not Network Solutions decided to cash in on one of its user’s registered domains.

“Unfortunately, the case didn’t point to Network Solutions,” he said.

Marshall, he said, is still fuming and is considering further legal action against the domain-hosting company.

“We’re still discussing it,” he said. “He really wants us to move forward.”

A request for comment from Network Solutions made Monday morning had not been granted by press time.

The case, before the National Arbitration Forum, is *We The People v. WTP Group*, No. FA0807001217134.

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