

JAMES S. TYRE, State Bar Number 083117  
LAW OFFICES OF JAMES S. TYRE  
10736 Jefferson Blvd., #512  
Culver City, CA 90230-4969  
310.839.4114  
Fax 310.839.4602

CHERIE M. CHAPPELL  
(*Pro Hac Vice*)  
A Member of CHAPPELL LAW FIRM, P.L.L.C.  
P.O. Box 5243  
Edmond, OK 73083-5243  
405.340.7755  
Fax 405.340.7757

**ATTORNEYS FOR DEFENDANT**

**UNITED STATES DISTRICT COURT FOR THE  
CENTRAL DISTRICT OF CALIFORNIA**

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24

---

---

**UNICOM SYSTEMS, INC.**, a ) Civil Action No. 01-09386-GHK (SHx)  
California corporation, )  
 )  
Plaintiff, ) **DEFENDANT’S MEMORANDUM**  
 ) **OF LAW IN REPLY TO**  
vs. ) **PLAINTIFF’S OPPOSITION TO**  
 ) **DEFENDANT’S MOTION TO**  
 ) **DISMISS FOR LACK OF**  
**LEONARD ADAM ROSENTHAL**, ) **PERSONAL JURISDICTION, FOR**  
aka Chip Rosenthal dba **UNICOM** ) **IMPROPER VENUE, AND FOR**  
**SYSTEMS DEVELOPMENT**, an ) **FOR FAILURE TO STATE A**  
individual, ) **CLAIM.**  
 )  
Defendant. )  

---

---

JUDICIAL OFFICER: Hon. George H. King, United States District  
Judge.

Hearing Date: January 28, 2002, 9:30 a.m., Courtroom 660

**TABLE OF CONTENTS**

TABLE OF CONTENTS.....-i-  
TABLE OF AUTHORITIES.....-ii-  
INTRODUCTION.....-1-  
I. PLAINTIFF HAS NOT MET ITS BURDEN OF SHOWING THAT  
PERSONAL JURISDICTION IS PROPER. . . . . -1-  
    A. Hong Declaration Paragraph 4 and Exhibit A. . . . . -2-  
    B. Hong Declaration Paragraph 5 and Exhibit B. . . . . -4-  
    C. Hong Declaration Paragraph 6 and Exhibit C. . . . . -4-  
    D. Hong Declaration Paragraph 7 and Exhibit D. . . . . -4-  
    E. Hong Declaration Paragraph 8 and Exhibit E. . . . . -5-  
    F. Hong Declaration Paragraph 9 and Exhibit F. . . . . -5-  
    G. The Law Does Not Allow for Personal Jurisdiction to be Asserted  
    in this Matter. . . . . -6-  
II. PLAINTIFF’S CLAIMS SHOULD BE DISMISSED AS  
A MATTER OF LAW . . . . . -13-  
    A. Plaintiff has Abandoned its Trademark in the Name “UNICOM” . . -13-  
    B. Plaintiff’s Trademarks are Generic . . . . . -16-  
    C. Plaintiff’s Trademarks Are Subject to Cancellation At Any Time . . -18-  
    D. Retroactive Application of the Law is Not An Issue of Fact . . . . . -19-  
III. PLAINTIFF ACKNOWLEDGES THAT IT’S CYBERPIRACY CLAIMS  
ARE FAULTY . . . . . -20-  
CONCLUSION . . . . . -20-

## TABLE OF AUTHORITIES

### CASES

<u>American Tel. &amp; Tel. Co. v. Compagnie Bruxelles Lambert</u> 94 F.3d 586 (9 <sup>th</sup> Cir. 1996).....	2
<u>Bensusan Restaurant Corp. v. King,</u> 126 F.3d 25 (2 <sup>nd</sup> Cir. 1997).....	3
<u>Brand v. Menlove Dodge,</u> 796 F.2d 1070 (9 <sup>th</sup> Cir. 1986).....	3
<u>Cybersell, Inc. v. Cybersell, Inc.,</u> 130 F.3d 414 (9 <sup>th</sup> Cir. 1997) .....	7,8
<u>Doe v. Unocal Corp.</u> 248 F.3d 915 (9 <sup>th</sup> Cir. 2001).....	1
<u>Durning v. First Boston Corp.,</u> 815 F.2d 1265 (9 <sup>th</sup> Cir. 1987) .....	16
<u>La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.,</u> 495 F.2d 1265 (2 <sup>d</sup> Cir. 1974).....	14
<u>Lone Star Steakhouse &amp; Saloon, Inc. v. Alpha of Virginia, Inc.,</u> 43 F.3d 922 (4 <sup>th</sup> Cir. 1995).....	14
<u>Mink v. AAAA Development LLC,</u> 190 F.3d 333 (5 <sup>th</sup> Cir. 1999) .....	11,12
<u>New Kids on the Block v. News Am. Publ’g, Inc.,</u> 971 F.2d 302 (9 <sup>th</sup> Cir. 1992) .....	16
<u>Park`N Fly, Inc. v. Dollar Park and Fly, Inc.,</u> 469 U.S. 198 (1985).....	17,18
<u>Reno v. American Civil Liberties Union,</u> 521 U.S. 844 (1997).....	3

## CASES

<u>Roth v. Garcia Marquez,</u> 942 F.2d 617 (9th Cir. 1991) .....	16
<u>Steckman v. Hart Brewing, Inc.,</u> 143 F.3d 1293 (9th Cir. 1998) .....	16
<u>Stomp, Inc. v. NeatO, LLC,</u> 61 F.Supp.2d 1074 (C.D. Ca 1999).....	9,10,12
<u>Sweetheart Plastics, Inc. v. Detroit Forming, Inc.,</u> 743 F.2d 1039 (4th Cir.1984).....	14
<u>Taylor v. Portland Paramount Corp.,</u> 383 F.2d 634 (9 <sup>th</sup> Cir. 1967).....	2
<u>Tech Heads, Inc. v. Desktop Service Center, Inc.,</u> 105 F.Supp.2d 1142 (D. Or. 2000).....	9,10,11
<u>World-Wide Volkswagen Corp. v. Woodson,</u> 444 US 286 (1980).....	9

## STATUTES, CONSTITUTION, AND RULES

15 U.S.C. § 1052.....	18
15 U.S.C. § 1054.....	18
15 U.S.C. § 1064.....	17,18,19
15 U.S.C. § 1065.....	18, 19
15 U.S.C. § 1115.....	14,15,19
15 U.S.C. § 1125.....	19

**STATUTES, CONSTITUTION, AND RULES**

15 U.S.C. § 1127 .....17

FED. R. CIV. P. 12(b)(6) .....19

**OTHER AUTHORITIES**

3 Callmann, Unfair Competition, Trademarks, and Monopolies § 19.65  
(4th ed. 1992).....14

3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition  
§ 17.03 (3d ed.).....17, 18

4 McCarthy, Trademarks and Unfair Competition, § 31:41-46 (4th ed.1996).....14



1 Complaint must be taken as true. American Tel. And Tel. Co. v, Compagnie  
2 Bruxelles Lambert 94 F.3d 586, 588-89 (9th Cir. 1996). However, where the  
3 allegations of the Complaint are controverted by Defendant's declarations or  
4 evidence, Plaintiff cannot merely rely on the allegations.<sup>2</sup> Taylor v. Portland  
5 Paramount Corp., 383 F.2d 634, 639 (9<sup>th</sup> Cir. 1967).

6 Plaintiff has not demonstrated facts which, if true, would support  
7 jurisdiction over Rosenthal. Thus, without the need for an evidentiary hearing,  
8 Rosenthal's motion to dismiss for lack of personal jurisdiction should be granted.  
9 The facts on which Plaintiff relies are set forth in paragraphs 4 through 9 and  
10 accompanying Exhibits A through F of the Hong Declaration, which we review  
11 *seriatim*. After we discuss the facts which Plaintiff has set forth, we will discuss  
12 the applicable law.

13 **A. Hong Declaration Paragraph 4 and Exhibit A.**

14 Hong asserts that, from his site, <[www.unicom.com](http://www.unicom.com)>, Rosenthal hyperlinks  
15 to various California companies, including the Mail Abuse Prevention System,  
16 known as MAPS, located on the Internet at <<http://www.mail-abuse.org/>>. Hong  
17 is correct that Rosenthal's site has such a hyperlink, and Rosenthal has no reason  
18 to dispute, for purposes of this motion, that MAPS is a California company.  
19 However, other than the bare fact that Rosenthal has chosen to hyperlink to  
20 MAPS, Hong offers no other connection between MAPS and Rosenthal. There is  
21 no showing, for example, nor can there be, that Rosenthal owns or controls either  
22 MAPS itself or the MAPS web site. Further, though Hong refers to the MAPS site  
23 as an advertisement, there is no showing, nor can there be, that MAPS or anyone

---

1 <sup>2</sup>Plaintiff alleges in paragraphs 12 - 14 of the Complaint that Rosenthal attempted to sell  
2 the domain name to Plaintiff for \$50,000. However, Rosenthal specifically refuted the allegation  
3 in paragraphs 6 - 9 of his Declaration in support of the motion, and provided the Court with the  
4 relevant e-mail exchanges between himself and Hong. Unrebutted by anything in Plaintiff's  
5 opposition, it is clear that it was Hong who was trying, unsuccessfully, to buy the domain name  
6 from Rosenthal, rather than Rosenthal trying to sell it to Hong.

1 else paid Rosenthal to include the hyperlink.<sup>3</sup>

2       Hyperlinks can be either internal pointers to another location within the  
3 same web site or external pointers to an entirely different web site. For example,  
4 one of the hyperlinks on the home page of <[www.unicom.com](http://www.unicom.com)> is to  
5 <<http://www.unicom.com/people/chip/>>. Clicking on the hyperlink would take  
6 the viewer to another page within Rosenthal's web site. However, it is just as easy  
7 to hyperlink to an external site, and being able to do so is one of the reasons why  
8 the Internet has become "a unique and wholly new medium of worldwide human  
9 communication." Reno v. ACLU, 521 U.S. 844, 849 (1997).

10       ... more elaborate documents, commonly known as Web "pages," are also  
11 prevalent. Each has its own address--"rather like a telephone number."  
12 Web pages frequently contain information and sometimes allow the viewer  
13 to communicate with the page's (or "site's") author. They generally also  
14 contain "links" to other documents created by that site's author or to other  
15 (generally) related sites.

16 Id. at 852, footnote omitted.

17       There is no logical basis to assert that personal jurisdiction is proper where  
18 a defendant does nothing more than provide an external link to a web site in the  
19 forum state which in no way is controlled by the defendant. To hold that such  
20 external linking, without more, could establish personal jurisdiction would create  
21 an intolerable chilling effect on Internet speech. Plaintiff can cite no case which  
22 allows for personal jurisdiction to be asserted on the basis of such external linking,

---

1       <sup>3</sup>In paragraph 13 of his Declaration in support of the motion, Rosenthal states that, for a  
2 few months in late 1997 and early 1998, he did a small amount of work for Vixie Enterprises.  
3 Paul Vixie, at least in lay terms, is the principal of MAPS. However, that small amount of work  
4 was the only work which Rosenthal, using the dba Unicom Systems Development, has done for  
5 any California company. It is insufficient to support personal jurisdiction, see Brand v. Menlove  
6 Dodge, 796 F.2d 1070, 1073 (9<sup>th</sup> Cir. 1986) and there can be no claim that Rosenthal included the  
7 hyperlink as part of any business arrangement with MAPS.



1 and the law is to the contrary. Bensusan Restaurant Corp. v. King, 126 F.3d 25,  
2 29 (2<sup>nd</sup> Cir. 1997). (External link to web site in forum state, along with other  
3 contacts, insufficient to confer personal jurisdiction.)

4 **B. Hong Declaration Paragraph 5 and Exhibit B.**

5 Here, Hong points out that there is a hyperlink from Rosenthal's site to the  
6 site for Wind River Systems, Inc.,  
7 <[http://www.wrs.com/products/html/bsd\\_os.html](http://www.wrs.com/products/html/bsd_os.html)>. Hong asserts that Wind River  
8 is a California company, and Rosenthal has no reason to dispute that for purposes  
9 of this motion. However, the showing which Hong has made with respect to the  
10 Wind River external link is no more than with the MAPS link, and there can be no  
11 showing that Rosenthal has any control of any kind over either the company or the  
12 company's web site.

13 **C. Hong Declaration Paragraph 6 and Exhibit C.**

14 Plaintiff's desperation in trying to find a basis for personal jurisdiction  
15 begins to show even more here. Hong asserts that Rosenthal links to an external  
16 site, <<http://www.thelist.com/areacode/512/>>,<sup>4</sup> which, in turn, lists and links to  
17 "hundreds of Internet Service Providers ("ISP"), including approximately twenty  
18 links to California-based ISPs ...." (See Exhibit C, pages 24 - 32.) Hong makes no  
19 assertions over what control, if any, Rosenthal may have over <[www.thelist.com](http://www.thelist.com)>  
20 (he has none), and does not even state where that site may be located. Thus, we  
21 presume, Hong would posit that personal jurisdiction is established if the  
22 defendant provides an external link to another's site, over which the defendant has  
23 no control, in an unknown jurisdiction, which, in turn, links to third party sites,  
24 also not controlled by the defendant, some in the forum state, some elsewhere. We  
25 do not imagine this to be the law.

26 **D. Hong Declaration Paragraph 7 and Exhibit D.**

---

1 <sup>4</sup>The Court may judicially notice that "512" is the area code for Austin, Texas.

1 Here, Hong asserts that Rosenthal has a link called "Regional Newsgroups  
2 Information Center" (<<http://www.unicom.com/regional/>>, an internal link) which  
3 has a database of regional newsgroups. Hong asserts that approximately 18 of the  
4 database entries (see Exhibit D, pages 37 - 42) are for newsgroups maintained by  
5 California residents. We do not know if that is the case, but it does not matter.  
6 There is no showing that Rosenthal has any control over any of those 18  
7 newsgroups, or that he has any connection with them at all. Indeed, Hong's  
8 exhibit shows who the maintainers are of the various newsgroups, and it is telling  
9 that the only newsgroups for which Rosenthal is the maintainer are in the  
10 <austin.\*> hierarchy, meaning that they are intended for Austin residents or those  
11 with an interest in Austin.

#### 12 **E. Hong Declaration Paragraph 8 and Exhibit E.**

13 Next, Hong asserts that Rosenthal has an internal link to his (outdated)  
14 resume, <<http://www.unicom.com/people/chip/resume.html>>, and that the resume  
15 contains a link to a prior employer of Rosenthal, Covad Communications, a  
16 California company. We fail to see how a link to a former California-based  
17 employer has anything to do with the alleged wrongs Rosenthal has committed  
18 while using the assumed name Unicom Systems Development.<sup>5</sup>

#### 19 **F. Hong Declaration Paragraph 9 and Exhibit F.**

20 Hong concludes his recitation of facts allegedly supporting personal  
21 jurisdiction by referring to the guestbook on Rosenthal's site at  
22 <<http://save.unicom.com/guestbook.php>>.

23 The first thing the Court should note is the URL: not <[www.unicom.com/](http://www.unicom.com/)>,  
24 but rather <[save.unicom.com/](http://save.unicom.com/)>. That is a specific site which was set up in

---

1 <sup>5</sup>The resume states that Rosenthal was employed by Covad in Austin, not in California,  
2 which is consistent with Rosenthal's statements in his Declaration in support of the motion  
3 (paragraphs 12 and 15) that he has lived in Texas since 1986.

1 response to the filing of the lawsuit, to talk about why Rosenthal's <unicom.com>  
2 domain name should be saved. It did not exist when the Complaint was filed, and  
3 thus cannot be the basis for jurisdiction over the allegations made in the  
4 Complaint. The "comments or suggestions" which the user may fill in are  
5 specifically directed to this lawsuit, not to the general business of Rosenthal.  
6 Indeed, Hong simply is incorrect when he asserts that the guestbook page is linked  
7 to Rosenthal's home page, <[www.unicom.com](http://www.unicom.com)>; it is linked only to the  
8 <save.unicom.com> site.

9 Second, Hong asserts that at least one person who made a guestbook entry is  
10 identified as being from California. He is correct that a person identifies herself as  
11 being in San Diego. However, we neither know, nor care, if the poster was being  
12 truthful or if the poster meant San Diego, California, as opposed to some other San  
13 Diego. Aside from multiple hearsay problems, the question of whether one or  
14 more guestbook posters are from California has no bearing on the jurisdictional  
15 analysis. Such posts necessarily were made after this lawsuit was filed, and the  
16 content of the guestbook posts, individually or collectively, cannot in any way  
17 lead to a claim of confusion by Plaintiff. To the contrary, the guestbook posts  
18 make it abundantly clear that the readers fully understand the difference between  
19 Plaintiff and Defendant.<sup>6</sup>

20 **G. The Law Does Not Allow for Personal Jurisdiction to be Asserted in this**  
21 **Matter.**

22 In this part, we will not reiterate what was said in our initial memorandum,  
23 rather, we will limit our focus to the legal arguments made by Plaintiff. We have

---

1 <sup>6</sup>In footnote 3 of the Opp. Memo (page 9), Plaintiff asserts that discovery will establish  
2 the exact number of messages on Rosenthal's web page that came from California residents. We  
3 submit that such discovery would not even rise to the level of a fishing expedition, since the fish  
4 (California resident posters) if found, have no relevance of any kind to any recognized personal  
5 jurisdiction analysis.

1 no quarrel with the general statements of law set forth in Part IIIA of Plaintiff's  
2 Opp. Memo, so we turn to Part IIIB.

3 Plaintiff properly begins the discussion with Cybersell, Inc. v. Cybersell,  
4 Inc., 130 F.3d 414 (9<sup>th</sup> Cir. 1997). However, it is clear from the facts of Cybersell  
5 that Plaintiff misapprehends what is meant by a passive web site in contrast to an  
6 active one.

7 In Cybersell, an Arizona corporation of that name sued a Florida  
8 corporation of that name on account of a web site maintained by the latter. The  
9 action was brought in federal court in Arizona, and Plaintiff alleged trademark  
10 infringement, among other things. The District Court found that Cybersell Florida  
11 had not purposely availed itself of the privilege of conducting activity in Arizona,  
12 and thus granted defendant's motion to dismiss for lack of personal jurisdiction.  
13 The Ninth Circuit affirmed. At 130 F.3d 418, the Court stated: "Courts that have  
14 addressed interactive sites have looked to the level of interactivity and commercial  
15 nature of the exchange of information that occurs on the Web site to determine if  
16 sufficient contacts exist to warrant the exercise of jurisdiction." (Internal citation  
17 omitted; emphasis added.) Looking at the commercial nature of defendant's web  
18 site, at 130 F.3d 419, the Court observed:

19 Here, Cybersell FL has conducted no commercial activity over the Internet  
20 in Arizona. All that it did was post an essentially passive home page on the  
21 web, using the name "CyberSell," which Cybersell AZ was in the process of  
22 registering as a federal service mark. While there is no question that  
23 anyone, anywhere could access that home page and thereby learn about the  
24 services offered, we cannot see how from that fact alone it can be inferred  
25 that Cybersell FL deliberately directed its merchandising efforts toward  
26 Arizona residents.

27 Cybersell FL did nothing to encourage people in Arizona to access its site,

1 and there is no evidence that any part of its business (let alone a continuous  
2 part of its business) was sought or achieved in Arizona. To the contrary, it  
3 appears to be an operation where business was primarily generated by the  
4 personal contacts of one of its founders. While those contacts are not  
5 entirely local, they aren't in Arizona either. No Arizonan except for  
6 Cybersell AZ "hit" Cybersell FL's web site. There is no evidence that any  
7 Arizona resident signed up for Cybersell FL's web construction services. It  
8 entered into no contracts in Arizona, made no sales in Arizona, received no  
9 telephone calls from Arizona, earned no income from Arizona, and sent no  
10 messages over the Internet to Arizona. The only message it received over  
11 the Internet from Arizona was from Cybersell AZ. Cybersell FL did not  
12 have an "800" number, let alone a toll-free number that also used the  
13 "Cybersell" name. The interactivity of its web page is limited to receiving  
14 the browser's name and address and an indication of interest--signing up for  
15 the service is not an option, nor did anyone from Arizona do so. No money  
16 changed hands on the Internet from (or through) Arizona. In short,  
17 Cybersell FL has done no act and has consummated no transaction, nor has  
18 it performed any act by which it purposefully availed itself of the privilege  
19 of conducting activities, in Arizona, thereby invoking the benefits and  
20 protections of Arizona law.

21 Those facts are surprisingly similar to those set forth by Rosenthal in his  
22 Declaration, which are not refuted by Plaintiff at all. Rosenthal never solicited  
23 business from potential clients in California; the actual business he has done with  
24 Californians is limited to the small amount of work for a short period of time for  
25 Vixie Enterprises; and the vast majority of Rosenthal's work is local not just to the  
26 State of Texas but to the Austin area. Further, Plaintiff has not put forth any  
27 evidence that anyone, let alone anyone in California, could or did hire Rosenthal  
28 through interaction with his web site, or that any money changed hands through

1 the web site. This is not for lack of discovery, Plaintiff can ascertain for itself  
2 from browsing through Rosenthal's site that it is incapable of such transactions.

3 When courts such as Cybersell speak of interactive sites engaging in  
4 commercial activity, they contemplate so-called "e-commerce" sites, where one  
5 can complete a business transaction solely by interaction with the web site,  
6 regardless of the locale of the visitor to the site. Those who run e-commerce sites  
7 know, or reasonably should know, that their customers can come from anywhere  
8 in the country, or perhaps even the world. Using booksellers as an example,  
9 regardless of whether the bookseller is a global operation such as  
10 <[www.amazon.com](http://www.amazon.com)> or essentially a local independent brick and mortar  
11 bookstore such as The Tattered Cover in Denver, <[www.tatteredcover.com](http://www.tatteredcover.com)>,  
12 which also sells books though its web site, the site owner reasonably can expect to  
13 attract customers from around the country, and their e-commerce web sites place  
14 no limitation on the geographic area in which they will do business. If a reader in  
15 Alabama wants to purchase J.R.R. Tolkein's "The Lord of the Rings", she can do it  
16 just as easily from The Tattered Cover's e-commerce site as from Amazon's; in  
17 each case, the reader need do nothing to consummate the purchase except to  
18 interact with the web site. Thus, though the volume of The Tattered Cover's  
19 business in Alabama no doubt is lower than Amazon's, The Tattered Cover  
20 reasonably must expect that it may attract customers from Alabama, and thus  
21 reasonably must expect the possibility of legal action involving those customers.  
22 See World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 297 (1980).

23 Rosenthal's site, in marked contrast, has no e-commerce features, no one can  
24 hire his services simply by interacting with his web site. It is not the sort of  
25 interactive commercial web site which is contemplated in Cybersell.

26 Plaintiff relies heavily on two District Court decisions, Tech Heads, Inc. v.  
27 Desktop Service Center, Inc., 105 F.Supp.2d 1142 (D.Or. 2000) and Stomp, Inc. v.  
28 NeatO, LLC, 61 F.Supp.2d 1074 (C.D.Ca 1999). Neither is helpful to Plaintiff,

1 because the nature of the web sites at issue in those actions have little resemblance  
2 to Rosenthal's site.

3 In the instant case, the nature of NeatO's website is highly commercial.  
4 Although NeatO's website provides information about the company,  
5 customer service, and technical support, a substantial portion of the site is  
6 dedicated to allowing the consumer to purchase NeatO's products on-line.  
7 NeatO's on-line sales constitutes conducting business over the Internet, and  
8 therefore under the test enumerated in Zippo, 952 F.Supp. at 1124, asserting  
9 personal jurisdiction comports with due process.

10 Stomp, 61 F.Supp.2d at 1078.

11 Desktop's Internet Web site is comprised of staffing, training, and "web and  
12 multimedia development and design" sections. In terms of "staffing,"  
13 Desktop acts as an intermediary in finding employment in the Virginia area  
14 for prospective job-seekers and seeks to find qualified employees for  
15 businesses. It screens, interviews, and enters into agreements with  
16 individuals submitting resumes to the Web site and claims it has received  
17 over 500 resumes....

18 Potential employers are precluded from directly contacting individuals  
19 because the individuals are identified only by code names on Desktop's web  
20 site. Therefore, interviews or any other contact with these individuals can be  
21 arranged only by Desktop. If the individual passes Desktop's screening,  
22 then Desktop places that individual's resume on the Web site for potential  
23 employers to review.... Potential employers may select and schedule  
24 interviews with selected candidates through the Web site.

25 Tech Heads, 105 F.Supp.2d at 1145.

26 However, though Tech Heads found that sufficient contacts existed to  
27 satisfy due process, it did not do so solely on the basis of defendant's web site, as

1 the Court was troubled by a showing that defendant had done business with only  
2 one resident of Oregon, the forum state. Rather, the Court found the necessary  
3 jurisdictional facts only after coupling the nature of defendant's web site with a  
4 showing that defendant engaged in national (non-Internet) advertising and had a  
5 toll-free telephone number. Id. at 1150-51.<sup>7</sup> No such showing has been or can be  
6 made by Plaintiff here.

7 One out of circuit case is worth mention because, though Rosenthal's site  
8 clearly is not an e-commerce site, it does at least have a link to his e-mail address,  
9 so that those possibly interested in his services can contact him through e-mail. In  
10 Mink v. AAAA Development LLC, 190 F.3d 333, 336-37 (5<sup>th</sup> Cir. 1999) the Court  
11 affirmed the lower court's grant of defendant's personal jurisdiction motion, stating  
12 as follows:

13 Applying these principles to this case, we conclude that AAAA's website is  
14 insufficient to subject it to personal jurisdiction. Essentially, AAAA  
15 maintains a website that posts information about its products and services.  
16 While the website provides users with a printable mail-in order form,  
17 AAAA's toll-free telephone number, a mailing address and an electronic  
18 mail ("e-mail") address, orders are not taken through AAAA's website.  
19 This does not classify the website as anything more than passive  
20 advertisement which is not grounds for the exercise of personal jurisdiction.  
21 See Zippo, 952 F.Supp. at 1124.

22 This case does not fall into the spectrum of cases where a defendant clearly  
23 conducted business over the Internet nor does it fall into the middle

---

1 <sup>7</sup>Tech Heads also is instructive about the email exchanges between Rosenthal and Hong  
2 which preceded this action and which were initiated by Hong. "Because the correspondence was  
3 initiated by Tech Heads, both by inviting Desktop to negotiate and by threatening legal action,  
4 Desktop cannot be subject to jurisdiction on this basis. Only those contacts with the forum that  
5 were created by the defendant, rather than those manufactured by the unilateral acts of the  
6 plaintiff, should be considered for due process purposes." Id. at 1151, internal citation omitted.



1 spectrum of interactivity where the defendant and users exchange  
2 information through the Internet. There was no evidence that AAAA  
3 conducted business over the Internet by engaging in business transactions  
4 with forum residents or by entering into contracts over the Internet. See  
5 CompuServe v. Patterson, 89 F.3d at 1264-67 (6th Cir.1996); Zippo, 952  
6 F.Supp. at 1125-26.

7 We note that AAAA's website provides an e-mail address that permits  
8 consumers to interact with the company. There is no evidence, however,  
9 that the website allows AAAA to do anything but reply to e-mail initiated  
10 by website visitors. In addition, AAAA's website lacks other forms of  
11 interactivity cited by courts as factors to consider in determining questions  
12 of personal jurisdiction. For example, AAAA's website does not allow  
13 consumers to order or purchase products and services on-line. See, Stomp,  
14 Inc., v. NeatO, LLC, SA CV 99-669, 1999 WL 635460, \*3 & n. 7 (C.D.Cal.  
15 Aug.6, 1999) (describing consumers' ability to purchase and pay for  
16 products on-line).

17 (Footnote omitted.)

18 Finally, in Part IIID of its Opp. Memo, Plaintiff returns to Stomp for the  
19 proposition that the inconvenience to Rosenthal of having to travel from Austin to  
20 Los Angeles does not render the assertion of jurisdiction over him  
21 unconstitutional. First, while we do not know from Stomp how large of an  
22 organization NeatO was, we do know that it was engaged in battles with Stomp as  
23 far away as Germany, 61 F.Supp.2d at 1075, and that NeatO was an LLC, not an  
24 individual like Rosenthal. Second, inconvenience becomes a factor only if  
25 Plaintiff otherwise satisfies due process requirements, but Plaintiff clearly has not  
26 done so here.

27 As we said at the beginning, Plaintiff must demonstrate facts that if true

1 would support jurisdiction over the defendant. Here, even if all of the facts put  
2 forth by Plaintiff are true, they are inadequate to support jurisdiction over  
3 Rosenthal. The fact that he links to external web sites, some in California, but  
4 none controlled by him, is of no legal significance. Neither is the fact that Internet  
5 users can interact with the guestbook at the <save.unicom.com> site. Plaintiff has  
6 asserted no basis for jurisdiction over Rosenthal other than the content of his web  
7 site, but his site simply is not the sort of interactive commercial site over which the  
8 case law allows personal jurisdiction to be asserted. Rosenthal's motion to dismiss  
9 for lack of personal jurisdiction should be granted, without the need for an  
10 evidentiary hearing.

## 11 **II. PLAINTIFF'S CLAIMS SHOULD BE DISMISSED AS**

### 12 **A MATTER OF LAW**

13 In its Opposition to Defendant's Motion to Dismiss, Plaintiff predicates its  
14 arguments on the mistaken belief that the Lanham Act can be applied  
15 retroactively. That is simply not the case. Plaintiff also predicates its arguments  
16 on the shaky foundation that Plaintiff holds valid, incontestible Trademarks. This,  
17 likewise, is not the case.

#### 18 **A. Plaintiff has Abandoned its Trademark in the Name "UNICOM"**

19 In its Opposition to Defendant's Motion to Dismiss, Plaintiff Unicom  
20 Systems Inc., offers proof of a registered Trademark, serial number 74483489,  
21 allegedly first used in commerce in 1981, and filed on January 26, 1994. The  
22 Trademark is a typed drawing of the word "UNICOM". The Trademark claims as  
23 its uses in the category of goods and services: "computer programs and manuals  
24 sold therewith, computer consulting services, educational training services,  
25 programming services and design services." The Plaintiff also correctly states that  
26 the Trademark was abandoned approximately one year after its filing.

27 Plaintiff's use of an abandoned trademark is most curious because , "when a

1 trademark owner abandons its mark, it thereby forfeits all its rights in that mark.”  
2 4 McCarthy, Trademarks and Unfair Competition, § 31:41-46 (4th ed.1996).  
3 Because federal registration is nationwide, abandonment must also be national.  
4 Sweetheart Plastics, Inc. v. Detroit Forming, Inc., 743 F.2d 1039, 1046 (4th  
5 Cir.1984) (stating that abandonment results in a loss of rights as against the whole  
6 world). Further, pursuant to 15 U.S.C. § 1115(b)(2), **proof that a registrant**  
7 **abandoned a mark defeats the registrant's exclusive right to use the mark.** Id.  
8 See also, 3 Callmann, Unfair Competition, Trademarks, and Monopolies § 19.65  
9 (4th ed. 1992); Lone Star Steakhouse & Saloon, etc., et al. vs. Alpha of Virginia,  
10 Inc., etc., 43 F.3d 922 (4th Cir. 1995).

11         Simply put, the law ceases to protect the owner of an abandoned mark.  
12 Rather than countenancing the "removal" or retirement of the abandoned mark  
13 from commercial speech, trademark law allows it to be used by another.  
14 Accordingly, courts have held that an unused mark may not be held in abeyance  
15 by its original owner. See, e.g., La Societe Anonyme des Parfums Le Galion v.  
16 Jean Patou, Inc., 495 F.2d 1265, 1272 (2d Cir. 1974).

17         Plaintiff's introduction of proof of abandonment is also most curious in that  
18 the filing date of the trademark (serial number 74483489) is in January 1994, more  
19 than four years **after** Defendant Rosenthal began using the name "Unicom  
20 Systems Development" in commerce, and four years **after** Defendant Rosenthal  
21 registered his <unicom.com.> domain name. See, Rosenthal Decl.

22         Plaintiff's abandoned mark also lists a date of first use in commerce that is  
23 entirely inconsistent with Plaintiff's June 1997 filings of Trademarks (serial  
24 numbers 75311438, 75311386, and 75311390 ). Not only do the June 1997  
25 Trademark filings occur more than three years **after** the filing of the abandoned  
26 Trademark (serial number 74483489), but the first use in commerce date in the  
27 1997 filings is April 1, 1989. The April 1989 first use in commerce date is  
28 approximately nine years **after** the claimed first use in commerce date in

1 Plaintiff's 1994 abandoned Trademark filing.

2         The nine year date inconsistency in official federal agency filings could lead  
3 an ordinary person to question Plaintiff's veracity regarding the actual date that  
4 Plaintiff started using its business name in commerce. Additionally, it could lead  
5 an ordinary person to question the veracity of Plaintiff's CEO Corry Hong and the  
6 statements he offers under oath in his Declaration. See, Declaration of Corry  
7 Hong, at ¶¶ 11 and 12. Moreover, the date inconsistency could cause the USPTO  
8 to reexamine Plaintiff's registration of its marks as possibly fraudulent. See, 15  
9 U.S.C. § 1115(b). In the very least, the discrepancy must be brought to the  
10 Court's attention, because Plaintiff relies heavily on its assertion of a highly  
11 suspect date contained in an abandoned Trademark application, rather than the  
12 date contained in Plaintiff's later (1997) Trademarks.

13         This time lapse is a critical flaw in the Plaintiff's argument and is most  
14 disconcerting because Trademark rights can be acquired only through use rather  
15 than adoption or appropriation in gross. Failure to use a mark after acquisition of  
16 legal protection may constitute a bar to continued protection.

17         In abandoning a mark, the Trademark owner is deemed to have impliedly  
18 consented to confusingly similar uses of the mark. The deeming occurs when the  
19 USPTO considers the mark abandoned, in this case, January 30, 1995. See, 15  
20 U.S.C. § 1115(b)(2). Plaintiff's CEO Corry Hong acknowledges that the USPTO  
21 considered the 1994 Trademark filing abandoned as of January 30, 1995. See,  
22 Declaration of Corry Hong, at ¶12.

23         Plaintiff has submitted evidence to the Court that its claim to the word mark  
24 "UNICOM" was deemed abandoned by the USPTO on January 30, 1995,  
25 effectively stripping any and all rights Plaintiff may have ever had in the word  
26 mark "UNICOM." Moreover, the Plaintiff has affirmatively pled itself out of its  
27 claims of Trademark Infringement, Dilution, Unfair Competition, and False

1 Designation of Origin by submitting proof to the Court that Plaintiff, did in fact,  
2 abandon the word mark “UNICOM.” The Ninth Circuit has “held that a plaintiff  
3 can plead himself out of a claim by including unnecessary details contrary to his  
4 claims.” Steckman v. Hart Brewing, Inc., 143 F.3d 1293, 1295-96 (9th Cir. 1998);  
5 Roth v. Garcia Marquez, 942 F.2d 617, 625 n.1 (9th Cir. 1991) (citing Durning v.  
6 First Boston Corp., 815 F.2d 1265, 1267 (9th Cir. 1987)).

7 Plaintiff has failed to meet its *prima facie* burden of proof and has failed to  
8 state any Trademark or Trademark-related claims for which relief may be granted.  
9 As such, Plaintiff’s claims should be dismissed.

### 10 **B. Plaintiff’s Trademarks are Generic**

11 Just as Trademark registrations must be maintained, through affidavits, fees,  
12 and renewal applications, marks must be maintained, through proper use and due  
13 diligence. A generic term cannot be a mark. Generic terms are in the public  
14 domain, and may be used freely by anyone. The terms, "escalator," "shredded  
15 wheat," "kerosene," "aspirin," "yo-yo," "zipper," and "trampoline," all began as  
16 marks. Through lack of proper use, and/or enforcement, these marks became  
17 generic. Today, any company may use them to describe certain types of products.  
18 Marks generally lose their source-identifying function through abandonment. As  
19 the term suggests, an abandoned mark is one which has been "thrown away."

20 Trademark law withdraws its protection from a mark that has become  
21 generic and deems it available for general use. Given that, “the primary cost of  
22 recognizing property rights in trademarks is the removal of words from (or  
23 perhaps non-entrance into) our language, . . . the holder of a trademark will be  
24 denied protection if it is (or becomes) generic, i.e., if it does not relate exclusively  
25 to the trademark owner's product. New Kids on the Block v. New American Pub.,  
26 Inc., 971 F.2d 302, 306 (9th Cir. 1992).

1 "A generic term is one that refers to the genus of which the particular  
2 product is a species." Park`N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 198,  
3 194 (1985).<sup>8</sup> The Lanham Act sets out the test for generic-ness: "The primary  
4 significance of the . . . mark to the relevant public . . . shall be the test for  
5 determining whether the . . . mark has become the generic name of goods or  
6 services on or in connection with which it has been used." 15 U.S.C. § 1064(3).<sup>9</sup>

7 Through lack of proper use and/or enforcement, a mark also becomes  
8 generic. If trademark enforcement consists of pursuing adverse users (an adverse  
9 user being defined as one who is not authorized to use a mark, but uses it anyway,  
10 or who is authorized to use a mark, but uses it improperly) then the failure to  
11 police or enforce a mark can lead to abandonment, and hence generic use. See, 15  
12 U.S.C. §§ 1064 and 1127.

13 A mark will also be deemed abandoned when any course of conduct of the  
14 owner, including acts of omission as well as commission, causes the mark to  
15 become the generic name for the goods or services on or in connection with  
16 which it is used or otherwise to lose its significance as a mark. See, 15 U.S.C. §  
17 1127<sup>10</sup>; see also, J. Thomas McCarthy, McCarthy on Trademarks and Unfair

---

1 <sup>8</sup> The classic example of a Trademark that became generic is "aspirin", Bayer A.G.'s  
2 trademarked name for salicylic acid.

1 <sup>9</sup>15 U.S.C. S 1064(3), states:

2 If the registered mark becomes the generic name for less than all of the goods or services  
3 for which it is registered, a petition to cancel the registration for only those goods or  
4 services may be filed. A registered mark shall not be deemed to be the generic name of  
5 goods or services solely because such mark is also used as a name of or to identify a  
6 unique product or service. The primary significance of the registered mark to the relevant  
7 public rather than purchaser motivation shall be the test for determining whether the  
8 registered mark has become the generic name of goods or services on or in connection  
9 with which it has been used.

1 <sup>10</sup>15U.S.C. § 1127 provides in pertinent part:

2 A mark shall be deemed to be "abandoned" if the following occurs:

3 ... (2) When any course of conduct of the owner, including acts of omission as well as

(continued...)

1 Competition § 17.03 (3d ed.). Plaintiff’s abandonment of its 1994 Trademark  
2 filing of the word mark “UNICOM,” constitutes the commission of an act that  
3 caused the mark to become generic and lose significance as a mark. Further, no  
4 incontestable right shall be acquired in a mark which is the generic name for the  
5 goods or services or a portion thereof, for which it is registered. 15 U.S.C.  
6 §1065(4). Plaintiff’s Trademarks and name have become generic through  
7 Plaintiff’s own acts and omissions.

8 Plaintiff has failed to meet its *prima facie* burden of proof and has failed to  
9 state any Trademark or Trademark-related claims for which relief may be granted.  
10 As such, Plaintiff’s claims should be dismissed.

11 **C. Plaintiff’s Trademarks Are Subject to Cancellation At Any Time**

12 Section 15 of the Lanham Act incorporates by reference subsections (c) and  
13 (e) of Section 14, 15 U.S.C. §1064. “An incontestable mark that becomes generic  
14 may be canceled at any time pursuant to 14(c).” *Id.* That section also allows  
15 cancellation of an incontestable mark at any time if it has been abandoned, if it is  
16 being used to misrepresent the source of the goods or services in connection with  
17 which it is used, or if it was obtained fraudulently or contrary to the provisions of  
18 15 U.S.C. 1054, or 2(a)-(c), 15 U.S.C. 1052(a)-(c). Park’N Fly Inc., v. Dollar Park  
19 And Fly, Inc., 469 U.S. 189, 196 (1985). Because Plaintiff abandoned the word  
20 mark “UNICOM” in 1995, any and all of Plaintiff’s existing Trademarks claiming  
21 exclusive use of the word mark “UNICOM” are subject to cancellation at any time  
22 by the USPTO. See, 15 U.S.C. §1064.

23 Notwithstanding that the USPTO has deemed Plaintiff’s 1994 Trademark  
24 filing of the word mark “UNICOM” to be abandoned, the Lanham Act provides

---

<sup>10</sup>(...continued)

1 commission, causes the mark to become the generic name for the goods or services on or  
2 in connection with which it is used or otherwise to lose its significance as a mark....

1 Defendant with nine affirmative defenses against an otherwise incontestable  
2 registration. 15 U.S.C. § 1115(b) states in relevant part:

3       Such conclusive evidence of the right to use the registered mark  
4       shall be subject to proof of infringement as defined in section 1114  
5       of this title, and shall be subject to the following defenses or  
6       defects: (1) That the registration or the incontestable right to use  
7       the mark was obtained fraudulently; or (2) **That the mark has**  
8       **been abandoned by the registrant;** or (9) That equitable  
9       principles, **including laches**, estoppel, and acquiescence, are  
10      applicable. 15 U.S.C. § 1115(b).

11 An otherwise incontestable registration is also subject to cancellation if the  
12 trademark becomes a common descriptive term or a generic name for an item. 15  
13 U.S.C. §§ 1064(3), 1065(4).

14       In 1995, Plaintiff was deemed to have abandoned the name “UNICOM” and  
15 its Trademarks and business name have subsequently become generic based on  
16 Plaintiff’s own acts and omissions. As such, Plaintiff has failed to state any claim  
17 for which relief may be granted and its claims should be dismissed.

18                   **D. Retroactive Application of the Law is Not An Issue of Fact**

19       Plaintiff continues to ask the Court to retroactively apply the Lanham Act to  
20 a lawful registration of a domain name by Mr. Rosenthal. Plaintiff asks the Court  
21 to disregard federal statutes requiring that a Trademark be in use and be famous  
22 **before** an alleged infringing event occurs. Because the actual pre-existence of a  
23 trademark constitutes an essential element of any claim under 15 U.S.C. § 1125,  
24 and corresponding state-law theories, Plaintiff has failed, as a matter of law, to  
25 state a claim on these counts. Because it is impossible for the Plaintiff to support  
26 an essential element of each such count, dismissal is required under Rule 12(b)(6).



1 **III. PLAINTIFF ACKNOWLEDGES THAT IT'S CYBERPIRACY CLAIMS**  
2 **ARE FAULTY**

3 Defendant accepts Plaintiff's acknowledgment that there is no basis for the  
4 Plaintiff's Cyberpiracy/Cybersquatting cause of action. See, Opposition to Motion  
5 to Dismiss, at 3, ¶¶27-28. However, Defendant respectfully requests that the Court  
6 dismiss the claim with prejudice.

7 **CONCLUSION**

8 Defendant respectfully prays for dismissal of this civil action, or  
9 alternatively that venue be transferred.

Respectfully submitted,  
January 18, 2002

---

JAMES S. TYRE, State Bar Number 083117  
LAW OFFICES OF JAMES S. TYRE

and

CHERIE M. CHAPPELL (*Pro Hac Vice*)  
A Member of CHAPPELL LAW FIRM, P.L.L.C.

Attorneys for Defendant