TTAB

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November 18, 2004

VIA EXPRESS MAIL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re:	**Cancellation No.**	**92043766** 75905816
	Registrant:	**Jupitermedia Corporation**
	Registration No.:	**2,514,183**
	Mark:	**SEARCH ENGINE STRATEGIES**
	Registration Date:	**December 4, 2001**

Dear Sir:

On behalf of Jupitermedia Corporation, Registrant in the above-referenced Cancellation Proceeding, please find enclosed (i) Registrant's Answer to Petition for Cancellation (in triplicate); and (ii) Motion to Suspend Cancellation Proceeding and Memorandum in Support (in triplicate).

If you have any questions, I can be reached at the above-referenced number.

Very truly yours,

Claudia Cantarella

CC:ng
Enclosures

11-18-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

056635/10040 - 2701400.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APR Network, Inc. **A California corporation** **Petitioner,** **v.** **Jupitermedia Corporation,** **A Delaware corporation** **Registrant**	**Cancellation No.: 92043766** **Registration No.: 2,514,183** **Date of Issue: December 4, 2001**

REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Registrant, Jupitermedia Corporation ("Jupitermedia" or "Registrant"), by its undersigned attorneys, hereby submits its answer (the "Answer"), in response to a petition to cancel ("Petition for Cancellation") filed by APR Network, Inc. ("Petitioner") on September 15, 2004. Jupitermedia responds to the Petition as follows:

1. Jupitermedia denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 of the Petition for Cancellation.

2. Jupitermedia denies any knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 of the Petition for Cancellation.

3. Jupitermedia denies the allegations in paragraph 3 of the Petition for Cancellation.

4. Jupitermedia admits that it applied for and obtained registration for the trademark SEARCH ENGINE STRATEGIES, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations as set forth by Petitioner in paragraph 4 of the Petition. Registrant respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

5. Jupitermedia denies the allegations in paragraph 5 of the Petition for Cancellation, and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

6. Jupitermedia denies the allegations in paragraph 6 of the Petition for Cancellation, except states that to the extent paragraph 6 of the Petition sets forth legal conclusions, no response is required.

7. Jupitermedia denies any allegations set forth in paragraph 7 of the Petition for Cancellation, and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

8. Jupitermedia denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 of the Petition for Cancellation, except states that to the extent paragraph 8 of the Petition sets forth legal conclusions, no response is required.

9. Jupitermedia denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 9 of the Petition for Cancellation, except states that to the extent paragraph 9 of the Petition sets forth legal conclusions, no response is required.

10. Jupitermedia denies the allegations as set forth in paragraph 10 of the Petition for Cancellation.

11. Jupitermedia denies the allegations set forth by Petitioner in paragraph 11 of the Petition for Cancellation.

12. Jupitermedia denies the allegations as stated in paragraph 12 of the Petition for Cancellation, and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

13. Jupitermedia denies the allegations set forth in paragraph 13 of the Petition for Cancellation and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

14. Jupitermedia denies the allegations as stated in paragraph 14 of the Petition for Cancellation, and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

15. Jupitermedia denies the allegations set forth in paragraph 15 of the Petition for Cancellation and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents. To the extent paragraph 15 of the Petition sets forth legal conclusions, no response is required.

16. Jupitermedia denies any allegations as stated in paragraph 16 of the Petition for Cancellation, and respectfully refers the TTAB to the PTO file wrapper for Jupitermedia's

registered trademark SEARCH ENGINE STRATEGIES (Reg. No. 2514183) for a full and accurate description of its contents.

17. Jupitermedia denies that Petitioner is entitled to cancellation of Jupitermedia's Registration No. 2514183 for SEARCH ENGINE STRATEGIES, or to any relief whatsoever against Jupitermedia.

18. Jupitermedia denies each and every allegation of Petitioner's not specifically admitted or otherwise responded to therein.

AFFIRMATIVE DEFENSES OF JUPITERMEDIA

First Affirmative Defense

19. Jupitermedia repeats and realleges each and every allegation set forth in paragraph 1 through 18 as fully set forth therein.

20. The Petition fails to state a claim upon which relief can be granted.

Second Affirmative Defense

21. Jupitermedia repeats and realleges each and every allegation set forth in paragraph 1 through 20 as fully set forth therein.

22. Petitioner is barred from obtaining any relief sought in the Petition by reason of its unclean hands and its use of the infringing domain name <searchenginestrategies.biz>, which is confusingly similar to Jupitermedia's trademark SEARCH ENGINE STRATEGIES®.

Third Affirmative Defense

23. Jupitermedia repeats and realleges each and every allegation set forth in paragraph 1 through 22 as fully set forth therein.

24. Petitioner's claims are barred because Petitioner has failed to mitigate, minimize or avoid any damage it allegedly sustained.

Fourth Affirmative Defense

25. Jupitermedia repeats and realleges each and every allegation set forth in paragraph 1 through 24 as fully set forth therein.

26. Petitioner has suffered no losses or damages as a result of any alleged acts or omissions of Jupitermedia.

Fifth Affirmative Defense

27. Jupitermedia repeats and realleges each and every allegation set forth in paragraph 1 through 26 as fully set forth therein.

28. Jupitermedia reserves the right to amend and/or supplement its Answer to include other, different or additional defenses in its Answer, based upon, among other things, continuing investigation and discovery, and the failure of Jupitermedia to include same herewith is not intended, and should not be construed as a voluntary waiver.

PRAYER FOR RELIEF

WHEREFORE, having fully answered Petitioner's Petition, Registrant, Jupitermedia, respectfully prays that the TTAB dismiss the Petition and enter judgment in favor of Jupitermedia on each and every claim and count thereof, and award Jupitermedia such other and further relief as is proper.

Respectfully submitted,

JUPITERMEDIA CORPORATION

Dated: November 18, 2004

By: _____
Claudia Cantarella
Emily L. Schonbraun
Attorneys for Registrant

WILLKIE FARR & GALLAGHER LLP
787 Seventh Avenue
New York, New York 10019-6099
(212) 728-8000

056535.10040/2692651.2

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail label number EL363519047US

I, Lee Thayer, hereby certify that this REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service addressed to "BOX TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514," on November 18, 2004.

Lee Thayer

CERTIFICATE OF SERVICE

I, Lee Thayer, hereby certify that I have this 18th day of November, 2004, mailed by first-class United States mail, postage prepaid, the foregoing REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION to the following:

Dana B. Robinson, Esq.
3803 Mission Blvd., Suite 100
San Diego, CA 92019

Lee Thayer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APR Network, Inc. **A California corporation** **Petitioner,** **v.** **Jupitermedia Corporation,** **A Delaware corporation** **Registrant**	**Cancellation No.: 92043766** **Registration No.: 2,514,183** **Date of Issue: December 4, 2001**

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P.O. Box 1451
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Respectfully submitted,

JUPITERMEDIA CORPORATION

Dated: November 18, 2004

By: _____
Claudia Cantarella
Emily L. Schonbraun
Attorneys for Registrant

WILLKIE FARR & GALLAGHER LLP
787 Seventh Avenue
New York, New York 10019-6099
(212) 728-8000

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Lee Thayer

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Dana B. Robinson, Esq.
3803 Mission Blvd., Suite 100
San Diego, CA 92019

Lee Thayer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APR Network, Inc.,	)	
Petitioner	)	**Cancellation No. 92043766**
v.	)	**Registration No. 2,514,183**
	)	**Date of Issue: December 4, 2001**
Jupitermedia Corporation,	)	
Registrant.	)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO SUSPEND CANCELLATION PROCEEDING
AND MEMORANDUM IN SUPPORT

Pursuant to Trademark Rule 2.117(a), Registrant, JUPITERMEDIA CORPORATION ("Jupitermedia" or "Registrant"), hereby requests that the cancellation proceeding (the "Cancellation Proceeding") filed by Petitioner, APR NETWORK, INC. ("APR" or "Petitioner"), against the registration of Jupitermedia's mark SEARCH ENGINE STRATEGIES (the "Mark"), be suspended pending the outcome of a civil suit between the parties.

THE FACTS

On September 13, 2004, Petitioner, as plaintiff, commenced a declaratory judgment action against Jupitermedia, as defendant, in the United States District Court for the Central District of California, Case No. CV04-7578 (the "Civil Action"). As revealed by Petitioner's

complaint in the Civil Action (the "Complaint"),[1] Petitioner seeks a declaratory judgment that Petitioner has not violated any trademark or other intellectual property rights of Jupitermedia in continuing to use the domain name <searchenginestrategies.biz> (the "Domain Name"). Complaint ¶¶ 29–40, Silbert Dec. Exhibit 1. APR alleges that Jupitermedia's Mark is generic or, alternatively, is merely descriptive, has not acquired secondary meaning, and is thus unprotectable and should be cancelled. Complaint ¶¶ 29, 37–38, Silbert Dec. Exhibit 1. Petitioner also alleges that Petitioner's use of Petitioner's Domain Name does not cause a likelihood of confusion between the parties or their goods or services in the mind of the consumer because it pertains to services not competing with Jupitermedia's services, Complaint ¶¶ 12–13, 40, Silbert Dec. Exhibit 1, or because third parties have used terms similar to Jupitermedia's Mark to describe their goods or services. Complaint ¶¶ 30–35, 39, Silbert Dec. Exhibit 1.

Petitioner asks the court to declare that Petitioner's use of the Domain Name does not infringe or otherwise violate any of Jupitermedia's rights. Complaint at Prayer for Relief ¶ (3), Silbert Dec. Exhibit 1. Petitioner also requests that the court cancel Jupitermedia's registration for the Mark. Complaint at Prayer for Relief ¶ (4), Silbert Dec. Exhibit 1.

On or about October 18, 2004, Jupitermedia filed in the Civil Action an answer and counterclaims (the "Answer" Silbert Dec. Exhibit 2).[2] The Answer alleges and admits that Jupitermedia owns exclusive trademark rights in its Mark, that Petitioner has infringed Jupitermedia's Mark by use of Petitioner's Domain Name, and that Petitioner's Domain Name is

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[1] Copies of the pleadings in *APR Network Inc. v. Jupitermedia Corporation* are attached as exhibits to the accompanying declaration of Sarah Silbert (attached hereto as Exhibit A), dated November 18, 2004 ("Silbert Dec.").

[2] *See id.* n.1.

confusingly similar to Jupitermedia's Mark. Answer at Nature of the Case, Silbert Dec. Exhibit 2. Jupitermedia also alleges and admits in its Answer that it informed Petitioner that Jupitermedia intended to protect its exclusive rights in the Mark, and that Petitioner should cease using the infringing Domain Name in a manner likely to cause confusion and should transfer Petitioner's Domain Name to Jupitermedia. Answer ¶ 19, Silbert Dec. Exhibit 2. Except as so admitted, the Answer denies the remainder of allegations set forth in Petitioner's "Nature of the Case." Answer at Nature of the Case, Silbert Dec. Exhibit 2. Further, the Answer asserts counterclaims against Petitioner for, among other things, trademark infringement and violation of the Anticybersquatting Consumer Protection Act.[3] The counterclaim for trademark infringement asserts that APR's use of the infringing Domain Name aims to "trade off the [Mark's] goodwill" and is likely to "create a likelihood that consumers will be misled and confused as to the source of the services." Answer at ¶¶ 9–10, Silbert Dec. Exhibit 2.

In the Civil Action, Jupitermedia asks the court to enjoin Petitioner's use of the infringing Domain Name, or any other designation, in a manner likely to cause consumer confusion between Jupitermedia and Petitioner or their respective goods or services, and to enjoin Petitioner from making false representations of origin regarding Petitioner's goods or services under the Lanham Act. Answer at Counterclaims ¶¶ 17, 22, Silbert Dec. Exhibit 2. Jupitermedia also asks the court for relief under state and common law trademark and unfair competition laws, and the Anticybersquatting Consumer Protection Act. Answer at Counterclaims ¶¶ 26, 29 & 38, Silbert Dec. Exhibit 2. Finally, Jupitermedia requests that the court award Jupitermedia damages and profits. Answer at Counterclaims ¶¶ 18, 23, 26, 29 & 39, Silbert Dec. Exhibit 2.

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[3] The other counterclaims alleged by Jupitermedia include: California state trademark infringement and unfair competition, and common law unfair competition.

On or about September 15, 2004, Petitioner filed a petition to cancel the Mark in the instant proceeding (the "Petition for Cancellation"), alleging that Jupitermedia's Mark is merely descriptive of the goods and services provided and should thus be cancelled.

THE LAW

"Whenever it comes to the attention of the Board that the . . . parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action." TTAB Manual of Procedure § 510.02(a); *see also* 37 CFR §2.117(a); *PHC Inc. v. Pioneer Healthcare, Inc.*, 75 F.3d 75, 78 (1st Cir. 1996); *Argo & Co., Inc. v. Carpetsheen Mfg, Inc.*, 187 U.S.P.Q. 366, 367 (TTAB 1975) (suspending TTAB proceeding pending outcome of civil suit in state court); *The Other Tel. Co. v. Connecticut Nat'l Tel. Co.*, 181 U.S.P.Q. 125 (TTAB 1974); *Townley Clothes Inc. v. Goldring, Inc.*, 100 U.S.P.Q. 57, 58 (1953).

Here, the Cancellation Proceeding derives directly from the Complaint in the Civil Action, which states a claim for cancellation of the registration, and which discloses Petitioner's intent to file a cancellation proceeding to cancel Jupitermedia's Mark. Moreover, the outcome of the Civil Action will most likely determine whether Jupitermedia's Mark is entitled to continued registration and whether Petitioner will be enjoined from using Petitioner's Domain Name due to infringement of Jupitermedia's Mark, the registration of which Mark is the subject of the Cancellation Proceeding. If the court in the Civil Action rules that the Jupitermedia's Mark is not generic or descriptive but inherently distinctive, or has acquired secondary meaning, the court will most likely enjoin APR's use of the Domain Name, and APR will lose its standing to oppose Jupitermedia's Mark. The outcome of the Civil Action may therefore control Petitioner's standing to maintain the Cancellation Proceeding and thus have a bearing on the Board's case.

Likewise, a ruling that Jupitermedia's Mark is descriptive and subject to cancellation would be dispositive of the claims raised in the Cancellation Proceeding. "To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." TTAB Manual of Procedure § 510.02(a). Therefore, under such circumstances, Board proceedings are generally suspended in accordance with Rule 2.117(a). *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933, 1937 (TTAB 1992) (abrogated on other grounds); *Whopper-Burger Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971); *Dwinell-Wright Co. v. Nat'l Fruit Product Co., Inc.*, 129 F.2d 848 (1st Cir. 1942). For the reasons stated above, it would be premature for the TTAB to consider the merits of the Cancellation Proceeding until the conclusion of the Civil Action.

CONCLUSION

For the reasons set forth herein, Registrant respectfully requests that the Motion to Suspend the Cancellation Proceeding be granted.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: November 18, 2004

By: _____
Claudia Cantarella
Emily L. Schonbraun
Attorneys for Registrant

Willkie Farr & Gallagher LLP
787 Seventh Avenue
New York, New York 10019-6099
(212) 728-8000

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CERTIFICATE OF MAILING BY EXPRESS MAIL

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Lee Thayer

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Dana B. Robinson, Esq.
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Lee Thayer

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Petitioner	)	**Cancellation No. 92043766**
v.	)	
Jupitermedia Corporation,	)	
Registrant.	)	

Commissioner for Trademarks
P.O. Box 1451
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DECLARATION OF SARAH SILBERT IN SUPPORT OF JUPITERMEDIA CORPORATION'S MOTION TO SUSPEND CANCELLATION PROCEEDING AND MEMORANDUM IN SUPPORT

I, SARAH SILBERT, under penalty of perjury, declare and say:

1. I am an associate at Fulbright & Jaworski, L.L.P. ("Fulbright"). I have held this position since August 2003. Along with two others attorneys at Fulbright, John C. Rawls and Mark N. Mutterperl, I represent Jupitermedia Corporation ("Jupitermedia") in the civil action filed by APR NETWORK, Inc. in the Northern District of California (the "Court"), Case No. 04-7578 DSF (the "Civil Action").

2. I submit this declaration in support of Jupitermedia's motion to suspend this proceeding pending a resolution of the Civil Action.

proceeding pending a resolution of the Civil Action.

3. If called as a witness, I could testify to the following based upon personal knowledge and/or my review of Fulbright's records in the Civil Action.

4. APR NETWORK, Inc. filed a Complaint for Declaratory Relief and Cancellation of Registration ("Complaint") in the Civil Action with the Court on or about September 13, 2004.

5. Attached as Exhibit 1 is a true and correct copy of the Complaint as filed by APR NETWORK, Inc.

6. On behalf of Jupitermedia, Fulbright filed the Answer and Counterclaims in the Civil Action with the Court on or about October 18, 2004.

7. Attached as Exhibit 2 is a true and correct copy of the Answer and Counterclaims as filed by Jupitermedia.

Executed on November 18, 2004 at Los Angeles, California.

Sarah Silbert

Sarah Silbert

056535.10040/2694646.1

FILED

DANA ROBINSON (California Bar #208265)
DANA ROBINSON & ASSOCIATES
3803 Mission Blvd. Suite 100
San Diego, California 92109
(858) 488-2545
(858) 488-3980 (fax)

Attorneys for Plaintiff
APR NETWORK, INC.

2004 SEP 13 PM 3:42

CLERK U.S. DISTRICT COURT
CENTRAL DIST. OF CALIF.
LOS ANGELES

BY _____

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

APR NETWORK INC., a California corporation, Plaintiff, vs. JUPITERMEDIA CP a Delaware corporation; Defendant.	CV04-7578 DSF(RNBx) **COMPLAINT FOR DECLARATORY RELIEF & CANCELLATION OF REGISTRATION** **JURY DEMAND**

Plaintiff APR NETWORK, INC. ("APR"), for its complaint against Defendant JUPITERMEDIA CP ("JUPITER") alleges as follows:

NATURE OF THE CASE

Defendant has threatened to take legal action against APR arising out of the use of a domain name comprised of the text "searchenginestrategies.biz" ("DOMAIN NAME") in connection with internet optimization services provided online by Tarzana, California-based APR. Defendants claim trademark rights in the phrase "SEARCH ENGINE STRATEGIES" ("JUPITER NAME") in connection with in-person training events, such as conferences and tradeshows, on internet search engine strategies hosted by JUPITER in various locations. JUPITER owns a U.S. federal trademark registration, which APR has

Dana Robinson & Associates
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petitioned to cancel, for SEARCH ENGINE STRATEGIES, in International Class 41, for educational services, namely conducting professional seminars in the field of information technologies. However, JUPITER claims in its demands to APR, that it owns exclusive rights to use the combination of terms "SEARCH ENGINE STRATEGIES" in connection with "internet optimization" and demands that APR cease using its DOMAIN NAME, and has demanded that APR transfer the DOMAIN NAME to JUPITER. APR believes that Defendant does not own exclusive rights to use "SEARCH ENGINE STRATEGIES" in connection with internet optimization services. Moreover, APR believes that Defendant's business and APR's business can peacefully co-exist. To resolve the dispute, APR requests that this Court declare that APR's use of these words does not violate any of Defendant's alleged rights in the phrase "SEARCH ENGINE STRATEGIES." In addition APR believes that the mark is, or has become generic and petitions the court to cancel the registration pursuant to 15 U.S.C.A. § 1064.

JURISDICTION

1. This Court has subject matter jurisdiction pursuant 28 U.S.C. §§ 1331 and 1338(a).

2. Plaintiff APR Network, Inc. is a corporation formed under the laws of the State of California with its principal place of business in Tarzana, California.

3. Upon information and belief, Defendant JupiterMedia CP is a Delaware corporation with its principal place of business in Darien, Connecticut.

4. Upon information and belief, this Court has general and specific personal jurisdiction over the Defendant. The Court has general jurisdiction over the Defendant based on, among other things, the Defendant's operation of an interactive web site on the Internet through which consumers can register to attend events organized by the Defendant. The Court has specific jurisdiction over the Defendant based on the fact that the Defendant has expressly aimed its conduct at APR in the State of California knowing that such conduct would cause injury to APR in the State of California. APR's claim

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arises out of Defendant's contacts with the State of California, and, in particular, its demand letters and threats to APR.

5. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b).

FACTUAL ALLEGATIONS

6. APR operates a website located at: http://www.searchenginestrategies.**biz**.

7. On or about February of 2004, APR acquired the domain searchenginestrategies.**biz** from a third-party named Paul Viele.

8. APR operates a service through this website that offers consulting services for customers who wish to optimize their website: APR is paid to offer search engine strategies for its customers, and assist customers in obtaining better search engine ranking.

9. Upon information and belief, Paul Viele registered the DOMAIN NAME "searchenginestrategies.**biz**" on or about June 12, 2002, to provide information and services related to search engine optimization. The DOMAIN NAME has been in use since at least August 2, 2002.

10. Defendant operates a website at: http://www.searchenginestrategies.**com**.

11. Upon information and belief, Defendant uses the phrase "SEARCH ENGINE STRATEGIES" in connection with educational conferences and tradeshows. Customers register to attend events, in various cities, **where attendees are taught "search engine strategies"**. Upon information and belief, Defendant does not sell internet optimization consulting services.

12. Defendant's alleged mark is registered in International Class 41 which covers services dealing with: Education; providing of training; entertainment; sporting and cultural activities. Upon information and belief, Defendant's alleged mark is not registered in International Class 42, the class which covers the services offered by APR.

13. Upon information and belief, Defendant does not offer services competitive with APR.

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14. On or about January 28, 2000, Defendant applied for a federal trademark registration on the Principal Register for "SEARCH ENGINE STRATEGIES" for professional seminars.

15. On July 17, 2000, the United States Patent and Trademark Office ("USPTO") issued an office action (1) requesting that the applicant amend its services; and (2) refusing to register SEARCH ENGINE STRATEGIES on the grounds that it is merely descriptive because the Defendant offers seminars which provide attendees with strategies for marketing their search engines; JUPITER teaches people "search engine strategies."

16. On or about January, 2001, Defendant responded to the USPTO's office action by amending the recitation of services to: educational services, namely conducting professional seminars in the field of information technologies; and by claiming that the mark was suggestive and not merely descriptive, setting forth various arguments.

17. On April 26, 2001, the USPTO withdrew its refusal to register the Defendant's mark, provided that the Defendant inserted a disclaimer of the term "SEARCH ENGINE" into the trademark application. The Defendant made no claim to the exclusive right to use "Search Engine" apart from the mark as a whole, but received registration for the mark SEARCH ENGINE STRATEGIES for the specified services.

18. JUPITER's MARK, has not been registered for five years and therefore has not yet been granted incontestable status by the USPTO. Therefore, it is subject to challenge. APR has petitioned to cancel the registration.

19. On May 26, 2004, Defendant's counsel contacted APR, via a customer inquiry form available on APR's website, alleging: (1) that APR was infringing upon Jupiter's alleged mark SEARCH ENGINE STRATEGIES; and (2) that there was a likelihood of confusion between the APR domain name and Jupiter's alleged mark. Defendant requested that APR immediately cease all use of "Jupitermedia's trademark" and that APR transfer the APR domain name, searchenginestrategies.biz, to JUPITER. Defendant warned that, if APR refused to comply, Defendant would take whatever action

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is deemed necessary to preserve JUPITER's rights. Defendant gave APR five (5) days to respond.

20. On June 2, 2004, an attorney hired by APR sent a letter to Defendant's counsel denying that there was any likelihood of confusion or actual confusion; explaining that APR did not market the types of services or products that would result in confusion; and that the JUPITER NAME was not sufficiently strong to justify or support an infringement action against APR. APR expressed a desire to resolve the matter in an amicable matter.

21. On June 11, 2004, Defendant's counsel sent a letter to APR's counsel stating that APR's domain name was "clearly confusing" and insisted that APR stop infringing on JupiterMedia's "mark." Defendant again expressed that it shall not be deterred from taking any and all action that it deem necessary.

22. On June 18, 2004, APR's former counsel wrote an e-mail to Defendant's counsel indicating a desire to engage in confidential settlement communication.

23. On June 21, 2004, Defendant's counsel accepted the idea of confidential settlement communications.

24. On or about July 8, 2004, APR's counsel spoke to Defendant's counsel to discuss the dispute and to determine whether there were any potential bases on which the dispute could be resolved. Settlement communications took place until early September with Defendant often stating that it would soon "begin steps necessary to protect its rights." Defendant offered as much as a nine-month period of time for APR to phase-out its searchenginestrategies.biz domain name before transferring the name to JUPITER.

25. APR subsequently considered Defendant's proposed resolution of this dispute inadequate and concluded that the dispute could not be resolved in an amicable manner. JUPITER'S counsel stated that "all settlement offers" were withdrawn and that he would turn "this over to counsel to commence proceedings."

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26. Concurrent with this complaint, APR has petitioned the Trademark Trial and Appeals Board to cancel JUPITER'S trademark registration on the grounds that the mark is generic and/or descriptive and should not have been registered.

27. Upon information and belief, JUPITER never contested Paul Viele's use of the domain name searchenginestrategies.biz or the words "search engine strategies" during the two years that he used the domain prior to JUPITER'S demand letter to APR.

28. Upon information and belief, as of the date that JUPITER sent its demand letter to APR, JUPITER had not registered searchenginestrategies.info, searchenginestrategies.net, searchenginestrategies.org, searchenginestrategies.name, or any other version of the "search engine strategies" domain names. The names were free to register by any third party for a fee as low as $6.00 per year.

29. JUPITER's Mark "SEARCH ENGINE STRATEGIES" is generic and should be cancelled. The term "search engine strategies" is used widely by many companies offering various internet related services and does not only refer to JUPITER's goods and services.

30. Dozens, if not hundreds, of parties use the phrase "search engine strategies" to describe strategies related to search engine optimization.

31. Upon information and belief, as early as 1999 and continuing until now, third parties used the term "search engine strategies" to describe strategies related to search engine optimization.

32. Upon information and belief, many website operators use the words "search engine strategies" and even pay money to have these words as "keywords" to direct consumers to their websites, which offer services that are related to search engine optimization.

33. Upon information and belief, third parties use the term "search engine strategies" in relation to seminars that teach consumers about search engine optimization.

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34. Upon information and belief, prior to JUPITER'S trademark application in January 2000, dozens, if not hundreds, of articles referenced "search engine strategies" and many seminars used this phrase to describe search engine optimization.

35. The relevant consumer in this case does not associate the term SEARCH ENGINE STRATEGIES only with JUPITER's goods and services, but identifies the term with all such goods and services that refer to strategies for search engine optimization.

36. Upon information and belief, JUPITER has not taken any legal action against the numerous third-party commercial users of the term "search engine strategies."

37. Defendant's "SEARCH ENGINE STRATEGIES" NAME is generic, or merely descriptive as used by Defendant and, therefore, is not protectable and registration should not have been granted.

38. Defendant's "SEARCH ENGINE STRATEGIES" NAME has not acquired secondary meaning among consumers and, therefore, is not protectable.

39. There is no likelihood of confusion between Defendants' "SEARCH ENGINE STRATEGIES" NAME and the APR DOMAIN NAME, as the term "search engine strategies" is widely used by businesses that offer search engine optimization services.

40. There is no likelihood of confusion between Defendant's "SEARCH ENGINE STRATEGIES" NAME and the APR DOMAIN NAME, because the services offered by APR are not the same as those offered by the JUPITER.

CLAIM FOR DECLARATORY RELIEF
(28 U.S.C. § 2201)

41. APR incorporates the allegations set forth in each of the preceding paragraphs as if fully set forth herein.

42. An actual case and controversy exists between APR and Defendant.

43. There is an adversarial conflict between APR and Defendant.

44. APR has a reasonable apprehension of litigation.

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45. This controversy is ripe for adjudication.

CLAIM FOR CANCELLATION OF REGISTRATION
(15 U.S.C.A. § 1064)

46. APR incorporates the allegations set forth in each of the preceding paragraphs as if fully set forth herein.

47. Defendant's trademark "SEARCH ENGINE STRATEGIES" has become Generic and is not longer entitled to protection.

48. Defendant's Mark should be cancelled.

PRAYER FOR RELIEF

WHEREFORE, APR respectfully requests that the Court enter a declaratory judgment that:

(1) Defendant's "SEARCH ENGINE STRATEGIES" NAME is merely descriptive as used by Defendant and, therefore, are not protectible.

(2) Defendant's "SEARCH ENGINE STRATEGIES" NAME has not acquired secondary meaning among consumers and, therefore, are not protectible.

(3) APR has not infringed or otherwise violated any rights of Defendant arising from or relating to APR's use of the APR DOMAIN NAME or the words "search engine strategies."

(4) APR further requests that the court cancel JUPITER's federal trademark registration for "SEARCH ENGINE STRATEGIES."

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a jury trial on all issues triable by a jury.

DATED this 13th day of September, 2004.

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DANA ROBINSON & ASSOCIATES

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Attorneys for Plaintiff
APR Network, Inc.

CT System

Service of Process Transmittal Form
Wilmington, Delaware

09/14/2004

Via Federal Express (2nd Day)

TO: Mitchell Eisenberg General Counsel
Jupitermedia Corporation
23 Old Kings Highway South
Darien, CT 06820

Phone: (203) 662-2800 ex:
FAX: (203) 655-4686

RE: **PROCESS SERVED IN DELAWARE**

FOR Jupitermedia Corporation Domestic State: De

ENCLOSED ARE COPIES OF LEGAL PROCESS RECEIVED BY THE STATUTORY AGENT OF THE ABOVE COMPANY AS FOLLOWS:

1. TITLE OF ACTION: AOR Network, Inc., Pltfs. vs JupiterMedia Corp., Defts.

2. DOCUMENT(S) SERVED: Summons, Complaint, Jury Demand

3. COURT: United States District Court, Central District of California
Case Number CV04-7578

4. NATURE OF ACTION: Complaint for Declaratory Relief & Cancellation of Registration

5. ON WHOM PROCESS WAS SERVED: The Corporation Trust Company, Wilmington, Delaware

6. DATE AND HOUR OF SERVICE: By Process server on 09/14/2004 at 14:30

7. APPEARANCE OR ANSWER DUE: Within 20 days after service

8. ATTORNEY(S): Dana Robinson
3803 Mission Blvd.
Ste. 100
San Diego, CA 92109

9. REMARKS:

SIGNED CT Corporation System

PER Greg Borgese /CS
ADDRESS 1209 Orange Street
Wilmington, DE 19801
SOP WS 0006609450

9.14.04
2:30
OD

CT

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

APR Network, Inc., a California corporation PLAINTIFF(S) v. JupiterMedia CP, a Delaware corporation Corp DEFENDANT(S).	CASE NUMBER CV04-7578 DSF(RNBx) **SUMMONS**

TO: THE ABOVE-NAMED DEFENDANT(S):

YOU ARE HEREBY SUMMONED and required to file with this court and serve upon plaintiff's attorney Dana B. Robinson, whose address is:
3803 Mission Blvd. Ste. 100, San Diego, CA 92109

an answer to the ☒ complaint ☐ _____ amended complaint ☐ counterclaim ☐ cross-claim which is herewith served upon you within 20 days after service of this Summons upon you, exclusive of the day of service. If you fail to do so, judgement by default will be taken against you for the relief demanded in the complaint.

Clerk, U.S. District Court.

Dated: 9/13/04

By: DENISE H. LAZO TVES
Deputy Clerk

(Seal of the Court)

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Attorneys for Defendant and Counterclaimant
JUPITERMEDIA CORPORATION,
erroneously sued as "JUPITERMEDIA CP"

IN THE UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

APR NETWORK INC., a California corporation, Plaintiff and Counterclaim-Defendant, v. JUPITERMEDIA CORPORATION, a Delaware corporation, Defendant and Counterclaimant.	Civil Action No. CV 04-7578 DSF(RNBx) JUPITERMEDIA CORPORATION'S ANSWER TO COMPLAINT FOR DECLARATORY RELIEF AND CANCELLATION OF REGISTRATION AND COUNTERCLAIMS FOR TRADEMARK INFRINGEMENT, UNFAIR COMPETITION, AND VIOLATION OF ANTICYBER-SQUATTING CONSUMER PROTECTION ACT DEMAND FOR JURY TRIAL

Defendant and counterclaimant Jupitermedia Corporation ("Jupitermedia"), erroneously named in the Complaint as "Jupitermedia CP," hereby submits its Answer to the Complaint and Counterclaims against plaintiff and counterclaim-defendant APR Network, Inc. ("APR").

ANSWER TO COMPLAINT

Defendant and counterclaimant Jupitermedia, for its Answer to the Complaint of plaintiff and counterclaim-defendant APR, herein admits, denies and alleges as follows:

NATURE OF THE CASE

Jupitermedia admits and alleges that it owns a U.S. trademark registration for "SEARCH ENGINE STRATEGIES," and that it claims exclusive trademark rights in that phrase in connection with, *inter alia*, training events, Internet search engine strategies, and Internet search engine optimization. Jupitermedia further admits and alleges that it has informed plaintiff and counterclaim-defendant of Jupitermedia's intent to protect those rights, that plaintiff and counterclaim-defendant should stop using the infringing Search Engine Strategies business name and <searchenginestrategies.biz> domain name, and that plaintiff and counterclaim-defendant should transfer the domain name to Jupitermedia. Jupitermedia denies the remainder of the allegations set forth in plaintiff and counterclaim-defendant's "Nature of the Case."

JURISDICTION

1. As to the allegations in paragraph 1 of the Complaint, Jupitermedia admits and alleges that the plaintiff and counterclaim-defendant has purported to raise claims over which this Court has original jurisdiction under 28 U.S.C. §§ 1331 and 1338.

2. Jupitermedia admits the allegations in paragraph 2 of the Complaint.

3. Jupitermedia admits and alleges that it is a corporation formed and existing under the laws of the State of Delaware, with its principal place if business

is located at 23 Old Kings Highway South, Darien, Connecticut, 06820. Jupitermedia denies that its name is "Jupitermedia CP."

4. Jupitermedia does not contest that this Court has jurisdiction over it, as alleged in the first sentence of paragraph 4 of the Complaint. Jupitermedia admits and alleges that it offers services including, but not limited to, providing global real-time news, information, research and media resources for information technology, Internet industry and graphics professionals; producing conferences and tradeshows related to, among other things, information technology; publishing, among other things, email newsletters; maintaining and providing online databases and lists, including lists and/or databases of Web Hosting providers, Web site designers and ISPs; licensing software applications to Web sites and Web site owners and operators; selling on-line advertising to clients including Web Hosting providers; and training events, Internet search engine strategies, and Internet search engine optimization. Jupitermedia further admits that it operates an interactive website through which consumers can register to attend events it has organized. Except as so admitted and alleged, Jupitermedia denies the remaining allegations in paragraph 4 of the Complaint.

5. Jupitermedia does not contest venue in this judicial district.

FACTUAL ALLEGATIONS

6. Jupitermedia admits the allegations in paragraph 6 of the Complaint.

7. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 7 of the Complaint, and on that basis denies all such allegations.

8. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 8 of the Complaint, and on that basis denies all such allegations.

9. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 9 of the Complaint, and on that basis denies all such allegations.

10. Jupitermedia admits the allegations in paragraph 10 of the Complaint.

11. Jupitermedia denies that it does not sell internet optimization consulting services, as alleged in the final sentence in paragraph 11 of the Complaint. Jupitermedia admits the remaining allegations in paragraph 11 of the Complaint.

12. In answering paragraph 12 of the Complaint, Jupitermedia admits that its "SEARCH ENGINE STRATEGIES" mark is registered in International Class 41 mark and not registered in International Class 42 mark. The remainder of Paragraph 12 of the Complaint constitutes legal definitions and, to the extent is intended to convey factual allegations, Jupitermedia denies the remainder of the allegations in paragraph 12 of the Complaint.

13. Jupitermedia denies the allegations in paragraph 13 of the Complaint.

14. Jupitermedia admits the allegations in paragraph 14 of the Complaint.

15. Jupitermedia admits and alleges that, on or about July 17, 2000, the United States Patent and Trademark Office issued an office action provisionally refusing registration of SEARCH ENGINE STRATEGIES® on the ground that it was merely descriptive because Jupitermedia's specimens made reference to "search engines." Jupitermedia denies the remaining allegations in paragraph 15 of the Complaint.

16. Jupitermedia admits the allegations in paragraph 16 of the Complaint.

17. Jupitermedia admits the allegations in paragraph 17 of the Complaint.

18. Answering Paragraph 18 in the Complaint, the allegations in the first two sentences of paragraph 18 constitute legal conclusions and, to the extent are intended to convey factual allegations, Jupitermedia denies those allegations. Jupitermedia is without knowledge or information sufficient to form a belief as to

the truth or falsity of the remainder of the allegations in paragraph 18 of the Complaint, and on that basis denies all such allegations.

19. As to the allegations in paragraph 19 of the Complaint, Jupitermedia admits and alleges that that its counsel has stated in writing that the <searchenginestrategies.biz> domain name is confusingly similar to Jupitermedia's "SEARCH ENGINE STRATEGIES" mark and <searchenginestrategies.com> domain name; that plaintiff and counterclaim-defendant's use of the <searchenginestrategies.biz> domain name is injurious to Jupitermedia; and has demanded that plaintiff and counterclaim-defendant stop using the <searchenginestrategies.biz> domain name in a manner likely to cause confusion.

20. Jupitermedia admits the allegations in paragraph 20 of the Complaint.

21. Jupitermedia denies the allegations in paragraph 21 of the Complaint. Jupitermedia admits and alleges that, on June 4, 2004, counsel for Jupitermedia sent an email response to counsel for APR Domain Name Dispute Lawyers stating that APR's use of SEARCH ENGINE STRATEGIES is clearly confusingly similar to Jupitermedia's SEARCH ENGINE STRATEGIES trademark and domain name. Counsel further stated in the June 4, 2004 email that Jupitermedia would not be deterred from taking any and all action that Jupitermedia deemed necessary to protect its valuable SEARCH ENGINE STRATEGIES mark.

22. Jupitermedia denies the allegations in paragraph 22 of the Complaint.

23. Jupitermedia denies the allegations in paragraph 23 of the Complaint.

24. Jupitermedia admits that the parties entered into settlement negotiations during the months of July, August and September 2004. Jupitermedia denies the remainder of the allegations in paragraph 24 of the Complaint.

25. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of the first sentence of paragraph 25 in the Complaint, and on that basis denies all such allegations. Jupitermedia admits and allege that, on September 10, 2004, after counsel for APR, Ari Goldberger,

failed on multiple occasions to respond to Jupitermedia's settlement offers, counsel for Jupitermedia stated that "all settlement offers" were withdrawn and that he turn the matter over to outside counsel "to commence proceedings." Jupitermedia further alleges that, at Mr. Goldberger's request, counsel for Jupitermedia agreed to further extend the deadline for APR to respond to Jupitermedia's settlement offer. APR did not respond to the settlement offer and, on September 13, 2004, filed its Complaint in the Central District of California.

26. Jupitermedia admits that plaintiff has petitioned the Trademark Trial and Appeals Board to cancel Jupitermedia's trademark registration for SEARCH ENGINE STRATEGIES on the ground that the mark is descriptive. Jupitermedia denies the remaining allegations in paragraph 26.

27. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 27, insofar as they allege that Paul Viele used the domain name <searchenginestrategies.biz> and the words "search engine strategies," and on that basis denies the allegations. Jupitermedia admits that it has not contacted Paul Viele with respect to any such use.

28. Jupitermedia denies the allegations of Paragraph 28 insofar as they suggest that, on May 26, 2004, <searchenginestrategies.com> was the only domain name owned by Jupitermedia containing the string of characters "searchenginestrategies." Jupitermedia admits and alleges that, as of May 26, 2004, it owned the registrations to the <searchenginestrategies.com>, <searchenginestrategies.net>, <searchenginestrategies.org> and <searchenginestrategies.co.uk> domain names.

29. Jupitermedia denies the allegations in the first sentence in paragraph 29 of the Complaint. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in the second sentence in paragraph 29, and on that basis denies those allegations.

30. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 30, and on that basis denies those allegations.

31. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 31, and on that basis denies those allegations.

32. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 32, and on that basis denies those allegations.

33. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 33, and on that basis denies those allegations.

34. Jupitermedia is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 34, and on that basis denies those allegations.

35. Jupitermedia denies the allegations in paragraph 35 of the Complaint.

36. Jupitermedia denies the allegations in paragraph 36 of the Complaint.

37. Jupitermedia denies the allegations in paragraph 37 of the Complaint.

38. Jupitermedia denies the allegations in paragraph 38 of the Complaint.

39. Jupitermedia denies the allegations in paragraph 39 of the Complaint.

40. Jupitermedia denies the allegations in paragraph 40 of the Complaint.

CLAIM FOR DECLARATORY RELIEF
(28 U.S.C. § 2201)

41. In response to paragraph 41 of the Complaint, Jupitermedia incorporates herein by reference each and every admission, allegation, and denial contained in paragraphs 1 through 40, above.

42. Jupitermedia admits the allegations in paragraph 42 of the Complaint.

43. Answering paragraph 43 in the Complaint, Jupitermedia admits that a present dispute exists as to plaintiff and counterclaim-defendant's use of Jupitermedia's "SEARCH ENGINE STRATEGIES" Mark.

44. Jupitermedia denies the allegations in paragraph 44 of the Complaint.

45. Jupitermedia admits the allegations in paragraph 45 of the Complaint.

CLAIM FOR CANCELLATION OF REGISTRATION (15 U.S.C. § 1064)

46. In response to paragraph 46 in the Complaint, Jupitermedia incorporates herein by reference each and every admission, allegation, and denial contained in paragraphs 1 through 45, above.

47. Jupitermedia denies the allegations in paragraph 47 of the Complaint.

48. Jupitermedia denies the allegations in paragraph 48 of the Complaint.

COUNTERCLAIMS

For its Counterclaim in this action against plaintiff and counterclaim-defendant APR, defendant and counterclaimant Jupitermedia alleges as follows:

INTRODUCTION

1. Plaintiff and counterclaim-defendant APR has sought improperly to profit from Jupitermedia's investment in its trademarks and the reputation Jupitermedia has developed by registering the infringing domain name <searchenginestrategies.biz> and operating from that domain name a Web site that offers services under the name "Search Engine Strategies" that are closely related to those offered by Jupitermedia.

2. APR seeks to connect its <searchenginestrategies.biz> domain name and "Search Engine Strategies" business name in the minds of consumers with Jupitermedia's "SEARCH ENGINE STRATEGIES" mark and its <searchenginestrategies.com> domain name. Thus, APR seeks simultaneously to trade off of the goodwill the SEARCH ENGINE STRATEGIES® mark has come to enjoy among consumers, and to reduce the overall value of that goodwill by

associating the SEARCH ENGINE STRATEGIES® mark with services from unrelated sources. As a result of APR's actions, the value of Jupitermedia's mark is being diminished and consumers are being mislead and confused. Jupitermedia's counterclaims seek damages for the harm APR has caused to date and injunctive relief to prevent any further injury to Jupitermedia.

JURISDICTION AND VENUE

3. Subject matter jurisdiction over the claims asserted in this Counterclaim is based upon: (i) 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338(a) as an action arising under the Lanham Act, 15 U.S.C. §§ 1051 et. seq., and the Anticybersquatting Consumer Protection Act, 15 U.S.C. §§ 1125(d); and (ii) 28 U.S.C. § 1332(a) as an action between citizens of different states where the matter in controversy exceeds the sum or value of $75,000, exclusive of interest and costs. Subject matter jurisdiction over those of Jupitermedia's claims that arise under state law is based upon the principles of supplemental jurisdiction set forth in 28 U.S.C. § 1367, and the provisions of 28 U.S.C. § 1338(b) as an action asserting a claim for trademark infringement and unfair competition joined with a substantial and related claim under the federal trademark laws.

4. Jupitermedia is informed and believes and thereupon alleges that venue of this action is proper in the district pursuant to 28 U.S.C. § 1391(b).

The Parties

5. Defendant and Counterclaimant Jupitermedia is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business located in Darien, Connecticut. Jupitermedia is the owner of United States Trademark Registration No. 2514183 for the mark SEARCH ENGINE STRATEGIES®. Jupitermedia is also the registrant of the Internet domain names <searchenginestrategies.com>, <searchenginestrategies.net>, <searchenginestrategies.org> and <searchenginestrategies.co.uk>. Jupitermedia uses the <searchenginestrategies.com> domain name as Uniform Resource Locator

("URL") for a Web site that provides information about services offered under the SEARCH ENGINE STRATEGIES® mark. Jupitermedia "points" the <searchenginestrategies.co.uk> to the Web site at the Internet address <http://www.searchenginestrategies.com>.

6. Plaintiff and counterclaim-defendant APR is a corporation organized under the laws of the State of California, with its principal place of business in Tarzana, California. Jupitermedia is informed and believes, and on that basis alleges, that APR offers internet optimization services.

APR's Misappropriation and Misuse of the SEARCH ENGINE STRATEGIES® Mark

7. Jupitermedia is informed and believes, and on that basis alleges, that APR engaged in a scheme to register a domain name, use a business name and operate a Web site incorporating "SEARCH ENGINE STRATEGIES," a phrase identical to Jupitermedia's trademark and corresponding Web site, while offering services closely related to those offered by Jupitermedia under the SEARCH ENGINE STRATEGIES® mark. On a date unknown to Jupitermedia but believed to have been in or after June 2002, APR registered the domain name <searchenginestrategies.biz>. Sometime thereafter, APR began to operate an Internet Web site from that URL offering internet optimization services.

8. Jupitermedia is informed and believes, and on that basis alleges, that APR has purchased the phrase "search engine strategies" as a "key word" on one or more Internet search engines so that its <searchenginestrategies.biz> Web site will appear in the search results when consumers use the search engine or engines to search for information concerning Jupitermedia's Search Engine Strategies Conference & Expo and/or Jupitermedia's <searchenginestrategies.com> Web site.

9. Jupitermedia first became aware of APR's scheme after June 2002. Jupitermedia is informed and believes and thereupon alleges that APR chose to use the <searchenginestrategies.biz> domain name and Search Engine Strategies

business name, and purchased the phrase "search engine strategies" as "key words," with the intent and purpose of trading off of the goodwill that the Jupitermedia "SEARCH ENGINE STRATEGIES® mark currently enjoys and/or misleading consumers.

10. The APR <searchenginestrategies.biz> domain name, business name, and Web site create a likelihood that consumers will be misled and confused as to the source of the services offered by APR and/or the affiliation, sponsorship or endorsement of APR by Jupitermedia. The likelihood of such confusion is increased by the fact that APR chose a domain name that incorporates the exact words of the SEARCH ENGINE STRATEGIES® mark, and that APR offers services that are closely-related to the services offered by Jupitermedia under the SEARCH ENGINE STRATEGIES® mark.

11. As a result of the foregoing, Jupitermedia's reputation is being injured and the value and distinctiveness of the SEARCH ENGINE STRATEGIES® mark is being diminished. Jupitermedia is informed and believes and thereupon alleges that, absent the intervention of this Court, APR's illegal actions will continue and Jupitermedia and consumers will continue to be harmed.

12. Defendant and counterclaimant is informed and believes, and on that basis alleges, that plaintiff and counterclaim-defendant is receiving financial gain by reason of its unauthorized use of the <searchenginestrategies.biz> domain name, operation of the eponymous Web site, use of the "Search Engine Strategies" business name, and use of "search engine strategies" as key words. Moreover, APR can, absent an injunction, further profit from its infringing activities by using the <searchenginestrategies.biz> domain name in other ways, such as linking to third-party Web sites, allowing advertising on the <searchenginestrategies.biz> Web site in exchange for commissions, "selling" the name, or pointing Internet users who seek to reach the <searchenginestrategies.biz> Web site to third-party sites in exchange for "click-through" revenues from such sites.

First Claim for Relief

(for Trademark Infringement, 15 U.S.C. § 1114(1))

13. Jupitermedia specifically realleges and incorporates by reference each and every allegation set forth above in paragraphs 1 through 11.

14. Jupitermedia owns the federal trademark registration for the mark "SEARCH ENGINE STRATEGIES®" as set forth above in paragraph 5 of this Counterclaim. Jupitermedia uses the SEARCH ENGINE STRATEGIES® mark as a designation of source and quality for its services.

15. APR is using a colorable imitation of the SEARCH ENGINE STRATEGIES® mark in a manner that is likely to confuse, deceive and/or cause mistake among consumers and therefore is infringing defendant and counterclaimant's rights in the SEARCH ENGINE STRATEGIES® in violation of 15 U.S.C. § 1114(1).

16. Jupitermedia has no adequate remedy at law for APR's infringement of the SEARCH ENGINE STRATEGIES® mark, in that: (i) the SEARCH ENGINE STRATEGIES® mark is unique and valuable property, injury to which cannot adequately be compensated by monetary damages; (ii) the injury to Jupitermedia resulting from the infringement are not precisely and fully ascertainable; (iii) the infringement injures and threatens to continue to injure Jupitermedia' reputation and goodwill; and (iv) the injury resulting to Jupitermedia from APR's wrongful conduct, and the conduct itself, are continuing, and Jupitermedia would be required to bring a multiplicity of suits to achieve full redress for the injuries caused thereby.

17. Unless restrained, APR's infringement of the SEARCH ENGINE STRATEGIES® mark will continue to cause irreparable injury to Jupitermedia, both during the pendency of this action and thereafter. Jupitermedia is therefore entitled to an order from this Court preliminarily and permanently enjoining APR and its agents, employees and others acting in concert with them, from directly or

indirectly infringing the SEARCH ENGINE STRATEGIES® mark in any manner, including by using the <searchenginestrategies.biz> domain name, or any other name, mark, domain name, design or logo that is confusingly similar to the SEARCH ENGINE STRATEGIES® mark, in connection with the sale, offer for sale, advertising or promotion of any goods or services.

18. Jupitermedia is further entitled to recover damages sustained in consequence of APR's wrongful conduct, in an amount to be determined; to recover APR's profits; and to recover Jupitermedia's attorneys' fees and costs herein. Based upon the circumstances of the case, including the willful nature of APR's conduct, Jupitermedia is further entitled to recover treble the amount found as actual damages pursuant to 15 U.S.C. § 1117.

Second Claim for Relief

(for violation of 15 U.S.C. § 1125(a))

19. Jupitermedia specifically realleges and incorporates herein by reference each and every allegation set forth above in paragraphs 1 through 11.

20. The acts of APR alleged herein, including its use of the SEARCH ENGINE STRATEGIES® mark, are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of APR or APR's services with Jupitermedia, or as to the sponsorship or approval of APR's services or commercial activities by Jupitermedia. APR's actions further misrepresent the nature, characteristics, or qualities of APR's services or commercial activities.

21. Jupitermedia has no adequate remedy at law for the foregoing wrongful conduct of APR, in that: (i) APR's actions injure and threaten to continue to injure Jupitermedia' unique and valuable property, injury to which cannot adequately be compensated by monetary damages; (ii) the injury to Jupitermedia from APR's wrongful actions is not precisely and fully ascertainable; (iii) the wrongful acts of APR injure and threaten to continue to injure Jupitermedia' reputation and goodwill; and (iv) the injury resulting to Jupitermedia from APR's

wrongful conduct, and the conduct itself, are continuing, and Jupitermedia would be required to bring a multiplicity of suits to achieve full compensation for the injuries caused thereby.

22. Unless restrained, the foregoing wrongful acts of APR will continue to cause irreparable injury to Jupitermedia, both during the pendency of this action and thereafter. Jupitermedia is therefore entitled to an order from this Court preliminarily and permanently enjoining APR and its agents, employees and others acting in concert with them, from directly or indirectly: (i) manufacturing, producing, distributing, circulating, selling, offering for sale, advertising, promoting or displaying any product or service which tends to relate or connect such product in any way to Jupitermedia or to any goods or services offered, provided, sold, manufactured, sponsored or approved by, or connected with Jupitermedia; (ii) using the SEARCH ENGINE STRATEGIES® mark, marks incorporating the phrase "SEARCH ENGINE STRATEGIES," or any other domain name or mark that is confusingly similar to the SEARCH ENGINE STRATEGIES® mark; and/or (iii) making any false description or representation of origin concerning any services offered for sale by plaintiff and counterclaim-defendant.

23. Jupitermedia is further entitled to recover damages sustained in consequence of APR's wrongful conduct, in an amount to be determined; to recover APR's profits; and to recover its attorneys' fees and other costs herein. Based upon the circumstances of the case, including the willful, deliberate and intentional nature of APR's conduct, including the extent of the unlawful conduct, Jupitermedia is further entitled, pursuant to 15 U.S.C. § 1117, to recover triple the amount found as actual damages.

Third Claim for Relief

(for Trademark Infringement and Unfair Competition California Business and Professions Code § 17200, *et seq.*)

24. Jupitermedia specifically realleges and incorporates herein by this reference each and every allegation contained in paragraphs 1 through 11, inclusive.

25. The acts and conduct of plaintiff and counterclaim-defendant, as alleged above, constitute trademark infringement and unfair competition under California Business and Professions Code §§ 17200, *et seq.*, by reason of which Jupitermedia has suffered, and will continue to suffer, irreparable injury.

26. Jupitermedia is entitled to an injunction preliminarily and permanently enjoining plaintiff and counterclaim-defendant from engaging in continued or further acts of unfair competition, and to disgorgement of all sums earned by reason of such unfair competition.

Fourth Claim for Relief

(Common Law Unfair Competition)

27. Jupitermedia specifically realleges and incorporate herein by reference each and every allegation set forth above in paragraphs 1 through 11.

28. The acts of APR alleged herein, including its use of the SEARCH ENGINE STRATEGIES® mark, are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of APR or APR's services with Jupitermedia, or as to the sponsorship, or approval of APR's services or commercial activities by Jupitermedia. APR's actions further misrepresent the nature, characteristics or qualities of APR's services or commercial activities.

29. By reason of the foregoing, APR has engaged in, and continues to engage in, acts of unfair competition in violation of California common law for which Jupitermedia has been harmed. Jupitermedia is entitled to an injunction preliminarily and permanently enjoining plaintiff and counterclaim-defendant from engaging in continued or further acts of unfair competition, and to damages

according to proof. Further, in committing the foregoing acts of unfair competition, plaintiff and counterclaim-defendant is guilty of fraud, oppression and malice, and APR is thereby entitled to recover punitive and exemplary damages.

Fifth Claim for Relief

(Violation of Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125)

30. Jupitermedia specifically realleges and incorporates herein by reference each and every allegation contained in paragraphs 1 through 11 hereof.

31. The SEARCH ENGINE STRATEGIES® mark distinctive at the time APR registered the <searchenginestrategies.biz> domain name.

32. Jupitermedia is informed and believes and thereupon alleges that APR registered the <searchenginestrategies.biz> domain name with a bad faith intent to profit from the SEARCH ENGINE STRATEGIES® mark and the <searchenginestrategies.com> domain name, and that APR uses, with a bad faith intent to profit from the SEARCH ENGINE STRATEGIES® mark, the <searchenginestrategies.biz> domain name by using it as the Internet address of the infringing Web site, to sell services that are closely-related to services offered by Jupitermedia under the SEARCH ENGINE STRATEGIES® mark.

33. APR's <searchenginestrategies.biz> domain name is confusingly similar to the SEARCH ENGINE STRATEGIES® mark.

34. APR never, prior to the date that Jupitermedia's trademarks became valid, made use of the <searchenginestrategies.biz> domain name in connection with a *bona fide* offering of any goods or services.

35. APR's choice of <searchenginestrategies.biz> as a domain name was not based in any way on APR's legal name or any name that otherwise was commonly used to identify APR.

36. The acts of APR alleged herein are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Jupitermedia with APR's services or commercial activities. APR's actions further

misrepresent the nature, characteristics or qualities of its goods, services or commercial activities.

37. Jupitermedia has no adequate remedy at law for the foregoing wrongful conduct of plaintiff and counterclaim-defendant, in that: (i) APR's actions damage and threaten to continue to damage Jupitermedia's unique and valuable property, injury to which cannot adequately be compensated by monetary damages; (ii) the damages to Jupitermedia from APR's wrongful actions are not precisely and fully ascertainable; (iii) the wrongful acts of APR injure and threaten to continue to injure Jupitermedia's reputation and goodwill; and (iv) the damages resulting to Jupitermedia from APR's wrongful conduct, and the conduct itself, are continuing, and Jupitermedia would be required to bring a multiplicity of suits to achieve full compensation for the injuries caused thereby.

38. Unless restrained, the foregoing wrongful acts of plaintiff and counterclaim-defendant will continue to cause irreparable injury to Jupitermedia, both during the pendency of this action and thereafter. Therefore, this Court should enter orders preliminarily and permanently enjoining APR and its subsidiaries, agents, employees and others acting in concert with them from directly or indirectly: (i) using or trafficking in the <searchenginestrategies.biz> domain name; (ii) registering, using or trafficking in Internet domain names that are dilutive of or confusingly similar to the SEARCH ENGINE STRATEGIES® mark; and (iii) requiring APR to forfeit and to transfer to Jupitermedia the <searchenginestrategies.biz> domain name and any and all other domain names that the Court determines to be confusingly similar to or to dilute the SEARCH ENGINE STRATEGIES® mark.

39. Jupitermedia is further entitled to recover damages sustained in consequence of APR's wrongful conduct, in an amount to be determined; to recover APR's profits; and to recover its attorneys' fees and other costs herein. Based upon the circumstances of the case, including the willful, deliberate and intentional

nature of APR's conduct, including the extent of the unlawful conduct, Jupitermedia is further entitled, pursuant to 15 U.S.C. § 1117(c), to recover statutory damages of $100,000.

WHEREFORE, Jupitermedia prays for judgment as follows:

1. On each and every Claim for Relief alleged herein, for preliminary and permanent injunctive relief, including the transfer of the <searchenginestrategies.biz> domain name and any other domain names that are confusingly similar to the SEARCH ENGINE STRATEGIES® mark, as hereinabove described;

2. On each and every Claim for Relief alleged herein, for damages according to proof;

3. On the First, Second and Fifth Claims for Relief alleged herein, for attorneys' fees, disgorgement of plaintiff and counterclaim-defendant's profits and enhanced or statutory damages as provided by law;

4. For its costs of suit herein; and

5. For such other, further or different relief as this Court may deem just and proper.

DATED: October 18, 2004

JOHN C. RAWLS
SARAH SILBERT
FULBRIGHT & JAWORSKI L.L.P.

By _____
John C. Rawls
Sarah Silbert
Attorneys for Defendant and
Counterclaimant Jupitermedia Corporation

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), defendant and counterclaimant Jupitermedia hereby demands trial by jury of all issues so triable that are raised herein or which hereinafter may be raised in this action.

DATED: October 18, 2004

JOHN C. RAWLS
SARAH SILBERT
FULBRIGHT & JAWORSKI L.L.P.

By

John C. Rawls
Sarah Silbert
Attorneys for Defendant and
Counterclaimant Jupitermedia Corporation

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the county of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is Fulbright & Jaworski L.L.P., 865 South Figueroa Street, 29th Floor, Los Angeles, California 90017.

On **October 18, 2004**, I served the foregoing document(s) described as

JUPITERMEDIA CORPORATION'S ANSWER TO COMPLAINT FOR DECLARATORY RELIEF AND CANCELLATION OF REGISTRATION AND COUNTERCLAIMS FOR TRADEMARK INFRINGEMENT, UNFAIR COMPETITION, AND VIOLATION OF ANTICYBER-SQUATTING CONSUMER PROTECTION ACT; DEMAND FOR JURY TRIAL

on the interested parties in this action as follows:

Dana Robinson, Esq.
Dana Robinson & Associates
3803 Mission Blvd., Suite 100
San Diego, CA 92109
(858) 488-3980 (fax)

X (By Mail) I am "readily familiar" with this firm's practice of collection and processing of correspondence for mailing with the United States Postal Service on that same day with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing affidavit.

__ (By Facsimile)I caused said document to be transmitted electronically to the interested parties at the facsimile numbers as stated above.

__ (By Federal Express) – overnight mail on the person listed above.

__ (Personal Service) I caused the aforementioned document to be personally served on the person listed above.

Executed on **October 18, 2004**, at Los Angeles, California.

X (Federal) I declare that I am employed by an attorney admitted to practice before the United States District Court, Central District of California.

Laura Murphy

Laura Murphy