

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK**

RICHARD MINSKY, an individual, d/b/a
SLART® Enterprises,
Plaintiff,

No. 08-CV-819
(LEK/DRH)

v.

LINDEN RESEARCH, INC., d/b/a Linden Lab,®
a Delaware corporation; JOHN DOE,
an individual a/k/a Victor Vezina; PHILIP
ROSEDALE, an individual; MITCHELL KAPOR,
an individual; and OTHER DEFENDANTS
presently unknown to Plaintiff,

Defendants.

APPEARANCES:

OF COUNSEL:

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**DAVID R. HOMER
U.S. MAGISTRATE JUDGE**

MEMORANDUM-DECISION AND ORDER

Plaintiff pro se Richard Minsky ("Minsky") brought this action pursuant to (1) the Lanham Act, 15 U.S.C. § 1141 et seq., alleging trademark infringement, trademark dilution, contributory infringement, and dilution; and (2) New York law alleging tortious interference and fraud. Am. Comp. (Docket No. 6). On September 12, 2008, a temporary restraining order was entered which established a procedure for Minsky to protect his alleged mark. Docket No. 23 ("TRO"). Presently pending pursuant to the TRO is Minsky's motion to compel defendants to (1) serve notice to cease and desist upon an alleged infringer, and (2) remove an alleged infringing use. Docket No. 30. Defendants oppose Minsky's motion. Docket No. 34. For the reasons which follow, Minsky's motion is denied.

I. Background

The facts have been set forth in the district court's Decision and Order dated September 4, 2008, familiarity with which is assumed. See Docket No. 11.

The stipulated TRO here provides that if Minsky identifies an instance of infringement in the Second Life Virtual World, he must give notice of such infringement to defendants. TRO at 2. This notice must "include a detailed description of the alleged infringement, the user identity associated with the alleged infringement, the specific search which [Minsky] used to identify the use, and the precise location of the alleged infringing use" Id. If possible, Minsky must include a picture of the alleged infringement with a time and date stamp. Id. If Minsky sends such information to the defendants, defendants must forward Minsky's notice to the identified user with a cease-and-desist letter describing the pending litigation and requiring the user to discontinue the infringing use. Id. at 2-3. Additionally,

defendants must provide Minsky with confirmation that the notice and the cease-and-desist letter were sent to the user. Id. at 3. If the infringing activity is not discontinued within three business days, defendants must remove the use from the Second Life Virtual World. Id.

The TRO does not require defendants to forward Minsky's notice or a cease-and-desist letter if "the alleged infringing use is anything other than the use of 'SLART' as one word with all letters depicted in a uniform size, font and color" Id. at 3. If Minsky disagrees with defendants' refusal to pursue the alleged infringing use, the TRO establishes an expedited method for resolving disputes before the undersigned. Id. The TRO also provides that the parties

shall each preserve [*inter alia*]: (a) all materials reflecting communications between [parties] related to any notice of alleged infringement . . . , [and] (b) all materials reflecting any use with respect to which [Minsky] has claimed infringement, including, to the extent possible, evidence of date and time stamps associated with the use

Id. at 3-4. Additionally, where Minsky requests "disclosure of any personal identifying information of a Second Life user . . . , [Minsky] shall file a motion with [the undersigned] setting forth a *prima facie* case of infringement and detailing the reasons the requested disclosure is necessary." Id. at 4.

On September 19, 2008, Minsky sent defendants a notice of infringing use pursuant to the TRO. Docket No. 30, Exs. A, B. The alleged infringement was posted by a Second Life user in the Cannery Rezzable virtual world advertising for a "SLart Show Viewer." Docket No. 30, Ex. A at 1-2. Minsky served the virtual user with a notice to cease-and-desist and forwarded the relevant information to defendants. Id. at 1, 3-4. On September 24, 2008, defendants responded, stating that they were "declining to forward [Minsky's] notice to the

Second Life user . . . identified . . . [because (1) defendants] did not locate this use either in the . . . region [Minsky identified] . . . or after searching for the use under the 'All' search tab," and (2) the use was not initially infringing under the terms of paragraph 3 of the TRO. Docket No. 30, Ex. B at 1. This motion followed.

II. Discussion

Minsky argues that defendants (1) violated the provisions of the TRO by refusing to send notification to the identified infringing user since the advertised "Slart Show Viewer" was an infringing use within the scope of the TRO, and (2) are effectively failing to preserve evidence by refusing to provide Minsky with data which may confirm or lead to additional information pertaining to the alleged infringement. Defendants assert that (1) the term "SLart Show Viewer" is not an infringing use contemplated by the TRO, (2) the absence of the "SLart Show Viewer" appearing in the Second Life Virtual World upon investigation by defendants moots the current controversy, and (3) to the extent that the images Minsky captured were contained within the Second Life back-up data, that data includes proprietary information.

The plain language of the TRO clearly and unambiguously identifies uses that are infringing as those employing "'SLART' as one word with all letters depicted in a uniform size, font and color" TRO at 3; see e.g., Yash Raj Films (USA), Inc. v. Bobby Music Co. & Sporting Goods, Inc., No. 01-CV-8378 (JFB/CLP), 2006 WL 2792756, at *7 (E.D.N.Y. Sept. 27, 2006) (analyzing the clarity and lack of ambiguity presented by the terminology utilized in a preliminary injunction as a factor in considering the parties' motions). While Minsky asserts

a creative argument which would distinguish the capitalization of letters from the size of letters, the clear and intended meaning of the disputed clause encompasses letters formatted in different capitalizations. The use of capitalization, even "Small Caps," produces a noticeable difference in the appearance of the font such that the letters vary in size. Therefore, the "SLart Show Viewer" was not included within the types of infringing use contemplated by the TRO since it was not one word of uniformly sized lettering.

Additionally, both parties consented to the language of the TRO. This language should not now be reinterpreted by the Court. See N.L.R.B. v. American Mfg. Co., 132 F.2d 740, 742 (5th Cir. 1943) (holding that the language of a final consent agreement "may not be defied or disobeyed[, especially where i]ts terms are clear and comprehensive and if they read more broadly than respondent intended that they should, the time and manner of avoiding that breadth was by objections to the decree before its entry"). Minsky had an opportunity to object to the language in question. In fact, Minsky objected urging the same arguments presented here.¹ However, minsky ultimately consented to the TRO with the present language intact. Thus, the alleged infringing use at issue here does not fall within the scope of the TRO to which both parties consented. Since both parties have agreed to the precise terms of the TRO, those precise terms must be applied here.

¹ In response to the proposed TRO language, Minsky stated that the language "constitute[d] Unfair Competition and extend[ed] the Tortious Interference that was the basis of [his] original complaint," and that instead of the current language, infringing use should have included "us[ing] the mark in any font, style, size, case, or other element of font or style as are often used in typography." Docket No. 34-4, ¶ 3.

In the alternative, even if the "SLart Show Viewer" constitutes infringing use, its non-existence at the time of defendants' investigation suffices to moot the present controversy. Defendants complied with the terms of the TRO by attempting to find the alleged infringing use to determine if it was in fact an infringing use and to determine whether to send notification and a cease-and-desist order. It is not defendants' burden to police Minsky's trademark. See, e.g., Tiffany (NJ) Inc. v. eBay, Inc., No. 04 Civ. 4607(RJS), 2008 WL 2755787, at *56 (S.D.N.Y. July 14, 2008) ("[T]he law is clear: it is the trademark owner's burden to police its mark, and [defendants] . . . cannot be held liable for trademark infringement based solely on their generalized knowledge that trademark infringement might be occurring on their websites."). Therefore, defendants' obligations do not include searching through vast amounts of back-up data to attempt to find an instance of infringement which may previously have occurred. Defendants' involvement in the prosecution and termination of infringing use begins after and upon the notification provided by Minsky. Thus, defendants are not failing to preserve evidence by choosing not to provide Minsky with back-up data of the regions identified by Minsky's notification to defendants reporting an infringing use.²

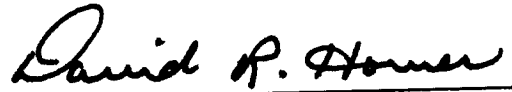
² The presence of the images which Minsky captured and included in his notification to defendants serves the evidentiary purposes articulated in the TRO. Moreover, if Minsky insisted upon being provided the back-up data, Minsky would be required to make a *prima facie* showing of infringement since the information requested concerns non-public, personal, proprietary information. No such showing has been made and.

III. Conclusion

For the reasons stated above, it is hereby **ORDERED** that Minsky's motion (Docket No. 30) is **DENIED**.

IT IS SO ORDERED.

DATED: December 8, 2008
Albany, New York

A handwritten signature in cursive script that reads "David R. Homer". The signature is written in black ink and is positioned above a horizontal line.

David R. Homer
U.S. Magistrate Judge