

## **Chapter 2: We Can Work It Out**

**May 24, 2001**

### **Help Me Help You**

When I figured that I had learned as much about trademark law as I was likely to learn in a few days, I wrote back to Julie to discuss her accusations.

Before I replied to the substance of her note, I had to ask her about the aspect of the situation that bothered me most of all, which was: Why was her client threatening to sue me for creating a website that helped to publicize their mall?

Nothing about my site does (or will ever) detract from your client's business. In fact, by offering additional information about the mall, I can only heighten awareness in your client's property and, hopefully, increase their business. I would think that your client would want to encourage my endeavor, and I'm puzzled as to why they're trying to shut me down instead.

That out of the way, I summarized the things I had discovered about trademarks and cybersquatting, and I explained why I didn't think I was breaking any laws. Since she clearly seemed to think that I *was* breaking some laws, I asked her for some details:

Ms. Greenberg, if you still believe that my website causes trademark infringements or "cybersquatting" violations, I'd be grateful if you could steer me to the relevant sections of the laws that you believe I'm

violating. Since I have no desire to break any laws, I will surrender the domain name as soon as you convince me that I'm doing so, which could save both of us a lot of unnecessary work, time, and trouble.

At this point, I figured that one of two things was going to happen.

It seemed most likely that, being an attorney, Julie would respond with a detailed list of specific sections of specific laws that I was violating. If her arguments were convincing, I would turn my domain name over to her client, as I had said in my note. But what if I disagreed with her interpretations of those laws? That would put me in the uneasy position of arguing about the nuances of intellectual property law with an intellectual property lawyer – and if that happened, I had to believe that, sooner or later, we'd end up conducting that argument in front of a judge. (And I had other fish... well, you know what I mean...)

On the other hand, there was a good chance that I'd never hear from Julie again. I knew that companies sometimes paid lawyers to write threatening letters on the theory that many people are so terrified by the prospect of being sued that they'll go along with any demands, reasonable or otherwise, to avoid being dragged into court. And I also knew that, because paying a lawyer to write a letter is a whole lot less expensive than paying a lawyer to sue someone, many of these kinds of situations never get past the threatening-letter stage. In other words, the C&D letter could have been a bluff, a shot across my bow to see if the very thought of being sued would make me surrender without a fight.

I relaxed through a pleasant Memorial Day weekend. A week went by. Then a month. Hordes of junebugs crunched underfoot, then suddenly disappeared – as they do

every year. Spring gave way to summer, and a stifling heat descended on the Dallas area – as it does every year. I celebrated the Fourth of July in traditional Texas fashion with fireworks and too much food.

Still no word from Julie.

I began to think that I would never hear from her again.

Maybe the fight had ended before it even had a chance to begin.

**July 5, 2001**

**The Non-Responsive Response**

Ever since I've known Donna, she's boasted about the fireworks extravaganza that Detroit puts on for the Fourth of July. (More accurately, it's a joint celebration of Independence Day and Canada's Dominion Day, staged by Detroit in cooperation with Windsor, Ontario, as part of an event called the International Freedom Festival.<sup>1</sup>) I had always assumed that she was just bragging on her home town, but in 1997 we had arranged our vacation schedules so that we could be in Detroit for the Big Show. And I have to admit that it was everything that Donna had said it would be. Three barges anchored in the Detroit River (between the U.S. and Canada) fired round after round of heart-stopping rockets and breathtaking starbursts that lit up the sky for what seemed like hours. An awesome show.

I have no way of knowing whether Julie Greenberg was fortunate enough to catch the fireworks in Detroit in the summer of 2001, but she must have been inspired by *something*, because one of the first things she did when she got back to her office after the holiday was to sit down and fire off a response to my letter. And here's what she had to say:

Dear Mr. Mishkoff:

We are in receipt of your correspondence dated May 24, 2001.

Unfortunately, your concurrent use of our client's federally registered mark in connection with distributing information and other services pertaining to our client's

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<sup>1</sup> [TheParade.org/freedomfest](http://TheParade.org/freedomfest)

mall is likely to create the impression that it is sponsored by, affiliated with, or somehow related to the mall. This erroneous impression is the very confusion against which federal trademark law protects.

We hereby reiterate our demand that you immediately discontinue all use of this, and any other domain name or trademark incorporating the mark SHOPS AT WILLOW BEND, or other similar marks, and assist us in arranging for the transfer of the domain names to our client.

Our client is willing to prepare the necessary documentation for the transfer(s), and to reimburse you for your registration fee, if applicable.

However, if we are faced to obtain relief through legal action in federal court, we will seek all available remedies.

Please contact us immediately to confirm your intentions.

Sincerely yours,

Julie A. Greenberg

I pored over the letter, eager to learn the details of my lawless behavior – and I was more than a little surprised to discover that I wasn't about to learn them from Julie. I had offered to turn my domain name over to her client, all she had to do was to point me to the laws I had violated – but although she had taken the time to write a response, she had completely ignored the question that was at the heart of my letter, which was: What exactly is it that I'm doing that's illegal?

Instead of using her response as an opportunity to... well, to respond, Julie basically repeated the vague allegations and pointed threats that she had made in her first letter. She did offer to reimburse me for my domain registration fee – but this was not an

especially enticing offer, as it amounted to all of \$35. The only real specifics she offered were a few more details about the kinds of confusion my website might cause – and in gratitude for this semblance of a response, I beefed up my disclaimer to make it less likely that anyone would think that my website was “sponsored by, affiliated with, or somehow related to the mall”:

**This is an unofficial site. It is not sponsored by, affiliated with, or related to The Shops at Willow Bend in any way.**

**The official site is located at [www.ShopWillowBend.com](http://www.ShopWillowBend.com)**

But although I did not learn much from what Julie told me, what she *didn't* say spoke volumes. It seemed to me that, if she had persuasive evidence that I was breaking the law, she would have been eager to point out to me the laws that I was breaking. After all, she was a professional attorney, she did this kind of thing for a living, she must have been as familiar with the intricacies of trademark law as I was with the procedures for creating websites.

As you might imagine, Julie's puzzling unresponsiveness made me increasingly suspicious – and increasingly determined not to give up my domain name without a good reason. It seemed as though The Taubman Company felt like they were entitled to my domain name because (a) they wanted it, (b) they were bigger and more powerful than I was, and (c) they were not averse to throwing their weight around. But realistically, what could they do to me? It seemed unlikely that they would send someone around to break my legs – and while the thought of being sued didn't exactly fill my heart with joy, it

didn't necessarily terrify me, either. After all, if Julie couldn't tell *me* what I was doing wrong, how was she going to convince a judge and a jury that I had broken the law?

But it was *way* too early to be thinking about judges and juries. Even though threats of lawsuits seemed to be important tools in Julie's bag of rhetorical tricks, I doubted that her client would actually want to incur the expense of a lawsuit until they had exhausted all other possibilities. I mean, we were all reasonable people, weren't we? Just because we had a difference of opinion didn't mean that we had to go to the mattresses. After all, we were still talking to each other – and if we kept talking, we might be able to resolve our differences without having to resort to drastic measures.

To get the answers I was looking for, I would simply have to be more tenacious.

Time for another letter.

**July 17, 2001**

**Try, Try Again**

A couple of weeks later, I wrote back to Julie in another attempt to get her to tell me exactly why she was threatening to sue me.

I touted my disclaimer, which I had enhanced to reflect her own words. I emphasized that I had “absolutely no desire to violate any trademark or cybersquatting laws.” I explained, once again, that my research had led me to believe that I was not actually doing anything wrong. I added that, since I wasn’t an attorney, I could certainly be mistaken in my belief that I wasn’t breaking the law, and I implored her once again “to let me know exactly what language in which sections of what laws you believe me to be violating.” Since she was the one accusing me of being a lawbreaker, I pointed out, it was only fair for her to “provide me as much detail as you can about the exact nature of the transgressions of which I am accused.”

It occurred to me that Julie might feel that I was asking her to perform free legal research for me – and in a way, I suppose that I was. However, it seemed obvious to me that it would be in her client’s interest for her to spend a little time educating me about some of the fine points of trademark law – but in case she didn’t see it that way, I decided to spell it out for her:

Your investment of a small amount of effort could save all of us (me, you, and your client) a great deal of time, trouble, and money.



But as it turned out, Ms. Julie A. Greenberg was not especially concerned about how much trouble she created for me. And, I was to learn, I had woefully underestimated the amount of my time and her client's money she was prepared to waste.