APDX-A1

UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

ELBERT PARR TUTTLE COURT OF APPEALS BUILDING
56 Forsyth Street, N.W.
Atlanta, Georgia 30303

David J. Smith
Clerk of Court

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January 23, 2020

MEMORANDUM TO COUNSEL OR PARTIES

Appeal Number: 18-14410-HH
Case Style: Jysk Bed'N Linen v. Monosij Dutta-Roy
District Court Docket No: 1:12-cv-03198-TWT

The enclosed order has been entered on petition(s) for rehearing.

See Rule 41, Federal Rules of Appellate Procedure, and Eleventh Circuit Rule 41-1 for information regarding issuance and stay of mandate.

Sincerely,

DAVID J. SMITH, Clerk of Court

Reply to: Christopher Bergquist, HH/LT
Phone #: 404-335-6169

REHG-1 Ltr Order Petition Rehearing

APDX-A1

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 18-14410-HH

JYSK BED'N LINEN,
d.b.a. By Design Furniture,
as successor to Quick Ship Holding, Inc.,
d.b.a. By Design Furniture,

Plaintiff - Counter Defendant - Appellee,

versus

MONOSIJ DUTTA-ROY,

Defendant - Counter Claimant -

Appellant.

Appeal from the United States District Court
for the Northern District of Georgia

ON PETITION(S) FOR REHEARING AND PETITION(S) FOR REHEARING EN BANC

BEFORE: MARTIN, NEWSOM, and ANDERSON, Circuit Judges.

PER CURIAM:

The Petition for Rehearing En Banc is DENIED, no judge in regular active service on the Court having requested that the Court be polled on rehearing en banc. (FRAP 35) The Petition for Rehearing En Banc is also treated as a Petition for Rehearing before the panel and is DENIED. (FRAP 35, IOP2)

ORD-42

APDX-A2

[DO NOT PUBLISH]

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 18-14410
Non-Argument Calendar

D.C. Docket No. 1:12-cv-03198-TWT

JYSK BED'N LINEN,
d.b.a. By Design Furniture,
as successor to Quick Ship Holding, Inc.,
d.b.a. By Design Furniture,

Plaintiff-Counter Defendant-Appellee,

versus

MONOSIJ DUTTA-ROY,

Defendant-Counter Claimant-Appellant.

Appeal from the United States District Court
for the Northern District of Georgia

(September 23, 2019)

Before MARTIN, NEWSOM, and ANDERSON, Circuit Judges.

PER CURIAM:

Monosij Dutta-Roy ("Dutta-Roy"), proceeding pro se, appeals from the district court's grant of summary judgment in favor of Jysk Bed'N Linen ("Jysk"), a furniture retailer: (i) in its trademark infringement suit against Dutta-Roy under the Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d); and (ii) with respect to Dutta-Roy's state law counterclaims for breach of contract, unjust enrichment, quantum meruit, equitable accounting, and attorneys' fees. As it pertains to the district court's grant of summary judgment in favor of Jysk on Dutta-Roy's counterclaims, Dutta-Roy argues that the district court erred because his evidence and affidavits showed that there was a partnership agreement that entitled him to payment for his work. For the reasons described below, we affirm.

I.

We assume the parties are familiar with the case's history and summarize the proceedings and facts only insofar as necessary to provide context for our decision.

Jysk, a retail furniture seller, filed this suit against Dutta-Roy in 2012, alleging, among other claims, cybersquatting violations of the ACPA. Jysk alleged that it had continuously used the inherently distinctive "bydesignfurniture.com" trademark since 1999. In 2012, it discovered that its website was offline and inaccessible because Dutta-Roy, who had originally registered the website at Jysk's direction, had allowed the website registration to expire. Dutta-Roy had

listed himself as the website's owner, and Jysk could not renew the website without his permission. Dutta-Roy renewed the website in his own name, took control of the website to the exclusion of Jysk, and demanded payment for any transfer of ownership.

Dutta-Roy denied liability and asserted counterclaims for breach of contract, unjust enrichment, quantum meruit, and breach of fiduciary duty, and sought an equitable accounting and attorneys' fees, all under Georgia law. Dutta-Roy alleged that he and several individuals had formed BazaarWorks, LLC ("BazaarWorks") for the purpose of developing a website for Jysk's predecessor. He alleged that BazaarWorks entered into a "partnership agreement" with Jysk's predecessor; as part of that agreement, Dutta-Roy registered the domain "bydesignfurniture.com" and developed the website online. Dutta-Roy alleged that Jysk failed to compensate him for the work he performed, failed to disclose the revenue generated by the website, and failed to compensate him based on that revenue. He sought $1,000,000 in actual damages, the reasonable value of his labor, equitable accounting, and attorneys' fees.

Jysk moved for summary judgment on its affirmative claims and Dutta-Roy's counterclaims. It contended that it had asked Dutta-Roy's former employer to develop a website for its "By Design Furniture" mark, and that despite its instruction to register the domain in Jysk's name, Dutta-Roy registered it in his

own name. In addition to registering "bydesignfurniture.com", he also registered "bydesignfurniture.org", "bydesignfurnitures.com", and "bydesign-furnitures.com", before offering to sell these domain names to Jysk for millions of dollars. With respect to Dutta-Roy's counterclaims, Jysk contended that Dutta-Roy's equitable claims for quantum meruit and unjust enrichment were barred by the applicable four-year statute of limitations because Dutta-Roy never rendered any services for Jysk after 2005. And Jysk argued that the rest of Dutta-Roy's counterclaims failed for lack of privity of contract.

Jysk claimed that Dutta-Roy had produced no evidence of any partnership agreement between Jysk and BazaarWorks, and that any such agreement would not have included Dutta-Roy as a party. Jysk attached multiple sworn affidavits stating that neither Jysk nor Jysk's predecessor executed any written agreement with Dutta-Roy or BazaarWorks regarding the development of the "bydesignfurniture.com" website. It also attached an excerpt of Dutta-Roy's response to Jysk's interrogatories admitting that he was unaware of any fact, observation, document, or item of evidence showing that BazaarWorks and Jysk's predecessor ever executed a written agreement.

Dutta-Roy opposed Jysk's motion for summary judgment. With respect to his counterclaims, Dutta-Roy attached his own affidavit, to which he attached what he alleged to be a draft of the partnership agreement. This document indicated a

potential agreement between Jysk's predecessor and BazaarWorks, but was neither dated nor signed by any party. Dutta-Roy also attached an email exchange between himself and a Jysk employee that referenced an undescribed written agreement. Jysk responded to this by submitting additional affidavits, including one from the employee in the email exchange. This employee stated that the emails referred to an agreement to purchase servers that was unrelated to the litigation.

The district court granted Jysk's summary judgment motions. It concluded that Jysk held a trademark in its mark, and that Dutta-Roy violated the ACPA by registering "bydesignfurniture.com" and the other domain names in 2012. The district court ordered Dutta-Roy to transfer the domain names to Jysk. The district court also concluded that Dutta-Roy failed to demonstrate a contractual relationship between himself and Jysk, that his equitable claims were time-barred, that Dutta-Roy failed to demonstrate a fiduciary relationship, and that Dutta-Roy was not entitled to an equitable accounting or attorneys' fees because he could not succeed on his underlying claims.

After a lengthy procedural back-and-forth involving multiple appeals to this Court and post-judgment motions, Dutta-Roy filed a Rule 60(b) motion to vacate the district court's orders and sought a default judgment against Jysk, which the district court denied. Dutta-Roy filed a timely notice of appeal, designating the

district court's final judgment, which encompassed its grants of summary judgment, and the district court's order denying his Rule 60(b) motion. Dutta-Roy has since filed a motion for equitable accounting in this Court.

II.

We review a grant of summary judgment de novo and view all evidence and factual inferences reasonably drawn from the evidence in the light most favorable to the nonmoving party. Castleberry v. Goldome Credit Corp., 408 F.3d 773, 785 (11th Cir. 2005). Summary judgment is appropriate if the record evidence, including depositions, declarations, and affidavits, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(a). The moving party has the burden of demonstrating that there are no genuine issues of material fact, but once that burden is met the burden shifts to the nonmoving party to bring the court's attention to evidence demonstrating a genuine issue for trial. Paylor v. Harford Fire Ins. Co., 748 F.3d 1117, 1121 (11th Cir. 2014). Overcoming that burden requires more than speculation or a mere scintilla of evidence. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 252, 106 S. Ct. 2505, 2512 (1986). Rather, there must be enough of a showing that the jury could reasonably find for that party. Id.

III.

A. Abandonment of Claims of Error and Counterclaims

Issues on appeal must be raised plainly and prominently. Sapuppo v. Allstate Floridian Ins. Co., 739 F.3d 678, 680–82 (11th Cir. 2014). Passing reference to a claim without support or citation is not enough to preserve an issue. Id. Appellants should identify issues they wish the Court to address on appeal in their statement of issues and clearly devote a distinct section of their argument to those issues. Id. Issues not briefed are deemed abandoned. Timson v. Sampson, 518 F.3d 870, 874 (11th Cir. 2008). Notwithstanding our principle of reading pro se briefs liberally, these rules of abandonment apply to both represented parties and pro se litigants. Id.

We conclude that Dutta-Roy has abandoned any argument that the district court erred in granting summary judgment in favor of Jysk with respect to its ACPA claim because he failed to brief the issue on appeal. Timson, 518 F.3d at 874. Nowhere in his brief does Dutta-Roy expressly challenge the district court's grant of summary judgment against him on Jysk's ACPA claim, including in his Statement of the Issues. Dutta-Roy makes perfunctory reference to his argument that the ACPA is "non-retroactive," but fails to cite authority or devote a specific section of his brief to this issue; this is insufficient to preserve the issue on appeal. See Sapuppo, 739 F.3d at 680-82. Dutta-Roy's brief is focused instead on the

district court's grant of summary judgment against him on his counterclaims. Because Dutta-Roy fails to challenge adequately the district court's ruling on Jysk's ACPA claim, he has abandoned any argument on the issue.

Dutta-Roy has also abandoned his equitable claims. Georgia provides quantum meruit and unjust enrichment theories of recovery when, under certain circumstances, parties cannot recover under a contract. Hemispherx Biopharma, Inc. v. Mid-South Capital, Inc., 690 F.3d 1216, 1227 (11th Cir. 2012). These equitable theories permit a party who cannot recover under a contract to receive compensation for performing a valuable service (quantum meruit) or conferring a benefit on another (unjust enrichment). Id. at 1230. The statute of limitations on both claims is four years. O.C.G.A. § 9-3-26.

The district court concluded that Dutta-Roy produced no evidence that he had performed any work on Jysk's behalf since 2005. Dutta-Roy makes a fleeting reference to the limitations period in an otherwise unrelated section of his brief, but does not dedicate a discrete section to the issue and cites to no authority. He has therefore abandoned the statute of limitations issue. Timson, 518 F.3d at 874. In any event, Dutta-Roy does not refute Jysk's claim that the last time Dutta-Roy offered services to Jysk was in 2005. He therefore had until 2009 at the latest to assert his equitable claims; because he asserted them in 2012, they were time-barred.

Dutta-Roy has also abandoned any argument that the district court erred in denying his 60(b) motion. He does not argue in his brief that his motion should have been granted, and mentions Fed. R. Civ. P. 60(b) only once in his brief, in the heading of an unrelated section. This is not enough to raise the issue on appeal, and it is abandoned. Timson, 518 F.3d at 874.

B. Dutta-Roy's Remaining Counterclaims

The district court did not err by granting summary judgment in Jysk's favor with respect to the rest of Dutta-Roy's counterclaims.

Dutta-Roy did not present sufficient evidence to establish a breach of contract. In Georgia, a valid contract must have a subject matter, consideration, and mutual assent by all parties to all terms. Dibrell Bros. Int'l S.A. v. Banca Nazionale Del Lavoro, 38 F.3d 1571, 1582 (11th Cir. 1994). The agreement must be expressed plainly and explicitly enough to show what the parties agreed upon. Id.

Dutta-Roy presented no evidence from which a jury could reasonably infer the existence of an agreement between himself and Jysk. Anderson, 477 U.S. at 252, 106 S. Ct. at 2512. Several Jysk employees stated in sworn affidavits that there was no agreement between between Jysk and Dutta-Roy. In response, Dutta-Roy attached a partnership agreement between BazaarWorks—not Dutta-Roy—and Jysk's predecessor. This agreement was unexecuted, with blank spaces for the

parties' signatures and the date of execution. Dutta-Roy also attached an email that appears to relate to Jysk's recovery of computer equipment from Dutta-Roy.

An unexecuted agreement to which Dutta-Roy was not a party and an ambiguous email are together, at most, a "mere . . . scintilla" of evidence in support of Dutta-Roy's contention that a contract existed between the parties. Anderson, 477 U.S. at 252, 106 S. Ct. at 2512. Dutta-Roy has presented no evidence of mutual assent between himself and Jysk regarding a plain and explicit set of terms, and no reasonable jury could infer that Jysk breached a contract with Dutta-Roy. Id.; Dibrell Bros. Int'l S.A., 38 F.3d at 1582. The district court therefore did not err in granting summary judgment.

Dutta-Roy has also presented no evidence from which a reasonable jury could infer the existence of a fiduciary duty owed to him by Jysk. Under Georgia law, establishing a claim for breach of fiduciary duty requires proof of three elements: (1) the existence of a fiduciary duty; (2) breach of that duty; and (3) damage proximately caused by the breach. Atwater v. National Football League Players Ass'n, 626 F.3d 1170, 1183 (11th Cir. 2010). A fiduciary relationship "arises where one party is so situated as to exercise a controlling influence over the will, conduct, and interest of another or where, from a similar relationship of mutual confidence, the law requires the utmost good faith, such as the relationship between partners, principal and agent." Id. (internal citations omitted). The party

asserting the existence of a fiduciary or confidential relationship bears the burden of establishing its existence. Id. at 1183-84 (internal citations omitted).

Again, the non-executed agreement and ambiguous email constitute nothing more than a scintilla of evidence, at best, supporting the contention that a fiduciary obligation existed. Anderson, 477 U.S. at 252, 106 S. Ct. at 2512. Because Dutta-Roy cannot demonstrate the existence of a fiduciary duty, the district court's grant of summary judgment was appropriate.

Under Georgia law, equitable accounting requires a plaintiff to introduce evidence that would allow the fact finder to determine the amount owed. Therrell v. Ga. Marble Holdings Corp., 960 F.2d 1555, 1565 (11th Cir. 1992). Additionally, attorneys' fees are not recoverable where there is no award of damages or other relief on any underlying claim. Alea London Ltd. v. Am. Home Servs., 638 F.3d 768, 780 (11th Cir. 2011).

Because Dutta-Roy has not shown that he is entitled to any damages, there is no evidence that would allow a fact finder to determine the amount he is owed. He is therefore not entitled to an equitable accounting. Therrell, 960 F.2d at 1565. And because he is not entitled to damages or other relief, he is not entitled to attorneys' fees. Alea London Ltd., 638 F.3d at 780.

For these reasons, we affirm the judgment of the district court.[1]

AFFIRMED.

[1] All other arguments asserted by Dutta-Roy on appeal are denied without further discussion. Dutta-Roy's pending motion for an equitable accounting, which overlaps substantially with his claim in the district court for an equitable accounting, is likewise denied. Dutta-Roy's request for oral argument is denied.

ARDX-B1

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

JYSK BED'N LINEN, d/b/a By Design Furniture, as successor to Quick Ship Holding, Inc., d/b/a By Design Furniture, Plaintiff, v. MONOSIJ DUTTA-ROY Defendant.	Case No.: 1:12-cv-03198-TWT

FINAL ORDER AND OPINION

I. Background

The Plaintiff, Jysk Bed'N Linen as successor to Quick Ship Holding, Inc., d/b/a By Design Furniture ("Jysk" or the "Plaintiff"), has used the trade name By Design Furniture since 1990, and contends it holds a common law trademark in the name. The Plaintiff is a retailer of furniture that owns stores in Georgia, North Carolina, and New Jersey.

The Plaintiff contended it has used the bydesignfurniture.com trademark since approximately April 1999. The bydesignfurniture.com domain name, however, was registered in the name of the Defendant, Monosij Dutta-Roy ("Dutta-Roy" or the

"Defendant"). The Defendant contended he has continually paid for and monitored that website address pursuant to an agreement between the Defendant's predecessor and the Plaintiff. That agreement, entered into between BazaarWorks, LLC, a company the Defendant was affiliated with, and By Design Furniture, a company the Plaintiff has since absorbed, purportedly stated that BazaarWorks would produce a custom website for By Design (the "Partnership Agreement").

The Defendant contended he is the owner of BazaarWorks, and contended that he executed the Partnership Agreement on behalf of BazaarWorks and that Kjell Bratengen executed it for the Plaintiff. (Dutta-Roy Aff. ¶¶ 2-5, 7). Bratengen denies the existence of the Partnership Agreement and Shashi Sonnad, a former employee of BazaarWorks, also denies the existence of the agreement. (Third Bratengen Aff. ¶ 2; Third Sonnad Aff. ¶ 3). The Defendant had produced a document entitled Partnership Agreement with the names of By Design and BazaarWorks, but it was unsigned and otherwise incomplete. (Dutta-Roy Aff. Ex. A).

The Plaintiff contended it hired Sonnad to maintained the bydesignfurniture.com website from its inception in 1999 through April 2012, and only learned that it did not hold the domain's registration when the Defendant let the registration expire on April 9, 2012. When the registration for the bydesignfurniture.com website lapsed, the Plaintiff demanded that the Defendant turn

over the domain name. The Defendant refused and renewed his registration to the domain name on April 20, 2012. And on April 26, 2012, he registered the bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com domain names in his own name. (See Sorensen Decl. ¶¶ 1215; 20-23).

The Plaintiff accordingly demanded that the Defendant turn over the domain names at issue and that the Court award damages pursuant to the Anticybersquatting Consumer Protection Act ("ACPA"). The Defendant contended that his initial registration of the bydesignfurniture.com domain name was made before the ACPA went into effect, that there is at least an issue of fact as to whether "by design furniture" is a trade name or trademark associated with the Defendant, and that the Defendant's actions have been consistent with the Partnership Agreement.

The Plaintiff had filed two motions for summary judgment [Docs. 57, 58]. The first partial motion sought summary judgment on its claim under the ACPA. The second motion sought summary judgment on the Defendant's counterclaims for breach of contract, unjust enrichment, quantum meruit, for an equitable accounting, and for attorney's fees. The Defendant is proceeding pro se. On March 31, 2013, the Court held a hearing and granted the Plaintiff's motion for a preliminary injunction prohibiting the Defendant from doing anything with the bydesignfurniture.com domain name that would restrict the public's access to it, from transferring

ownership of the domain name to anyone other than the Plaintiff, and from otherwise altering the status quo. [Doc. 53]. The Defendant filed motions to delay summary judgment and to compel mediation, which the Court denied. [Docs. 37, 61]. On October 22, 2013 the Court granted the Plaintiff's Motion for Partial Summary Judgment [Doc. 57] and the Plaintiff's Motion for Summary Judgment on the Defendant's Counterclaims [Doc. 58], for the reasons set forth in the Court's Order and Opinion [Doc. 69] and therein, further ordered the Defendant to turn over the registration of the domain names bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com to the Plaintiff within fourteen (14) days of the date of the Order and Opinion [Doc. 69].

Thereafter, on November 5, 2013 the Defendant filed two motions, a motion to stay the Court Order issued on October 23, 2013, and a motion for reconsideration of the Court order issued on October 23, 2013 [Docs. 71, 72]. The Defendant, additionally on November 19, 2013, filed a Notice of Appeal [Doc. 76] as to the Order and Opinion [Doc. 69] and the Clerk's Judgment thereon [Doc. 70], the same day the Plaintiff had filed its Motion [Doc. 75] to Alter the Order and Opinion [Doc. 69] and the Clerk's Judgment thereon [Doc. 70].

On November 22, 2013, the USCA acknowledged the Defendant's Notice of Appeal [Doc. 76] and this case was appealed to the USCA-11th Circuit, Case No. 13-

15309-A [Doc. 80]. The Defendant's motions for stay and reconsideration [Docs. 71, 72] were denied by the Court on November 26, 2013 for lack of jurisdiction [Doc 81].

The Defendant, on December 18, 2013, filed another motion [Doc 84] to set aside the Order and Opinion [Doc. 69] and the Clerk's Judgment thereon [Doc. 70]. On January 6, 2014, the Plaintiff moved for an Order to Show Cause [Doc. 87] as to why the Defendant should not be held in contempt of the Order and Opinion [Doc. 69] and the Clerk's Judgment thereon [Doc. 70]. Two days later the Court ruled on the Plaintiff's motion to Alter [Doc. 75] and the Defendant's motion to set aside [Doc. 84], granting the former and awarding the Plaintiff $4,000 in statutory damages under ACPA, and denying the later for the reasons set for in the Court's Opinion and Order thereon [Doc. 88].

Consistent with the Defendant's litigiousness, the Defendant filed a notice of Appeal, his second, [Doc. 89] and a motion [Doc. 93] for reconsideration and to alter the Court's Opinion and Order [Doc. 88], on January 16, 2014. The Defendant's motion [Doc. 93] for reconsideration and to alter the Court's Opinion and Order [Doc. 88] was denied by the Court on February 26, 2014 for the reason set forth in the Court's Order [Doc. 96].

On March 5, 2014, the Court, after a hearing on the same day, issued the Court's Order [Doc. 98] on the Plaintiff's motion to Show Cause [Doc. 87], again ordering the

Defendant to transfer the domain names, and awarding attorney fees to the Plaintiff in the amount of $2,150.00. The Order [Doc. 98] was subsequently vacated in part on January 29, 2018, [Doc. 134] as to the award of attorney fees to the Plaintiff consistent with the October 20, 2017 opinion of the USCA-11th Circuit upon Defendant's appeal [Doc. 101] to the USCA-11th Circuit, Case No. 15-14859.

On March 18, 2014, the Defendant filed his third notice of Appeal in this case [Doc. 101] appealing the Court's Order [Doc. 98].

On March 24, 2014, the Plaintiff filed its notice of non-compliance [Doc. 105] as the Defendant had still yet to obey the Court's Order to transfer the domain names [Doc. 98]. The following day the Court issued an Order to set a show cause hearing for April 4, 2014 as to why the Defendant should not be taken into custody immediately for contempt of court and willful failure to comply with Orders of this Court [Doc. 106]. On March 27, 2014 the Defendant filed his motion to stay the hearing [Doc. 108]. On April 4, 2014 the Defendant's motion to stay [Doc. 108] was denied by the Court [Doc. 110].

At the hearing on April 4, 2014, the Defendant was found in contempt of Court, was Ordered to be taken into custody, however the Defendant then transferred the domain names and the Court released the Defendant from custody [Doc. 111].

On May 5, 2015, despite the fact two appeals based upon three notices of appeal [Docs. 76, 89, 101] were now pending in the USCA-11th Circuit, the Defendant again filed a motion [Doc. 114], duplicative of the Defendant's past motions, to vacate the Orders and Opinions of the Court [Docs. 69, 88, 98]. On May 26, 2015, the Court denied the motion of the Defendant to vacate [Doc. 114] as untimely [Doc. 115].

The notice of appeal of the Defendant [Doc. 101] was acknowledged by the USCA-11th Circuit on November 3, 2015 [Doc. 116] and assigned Case No. 15-14859.

On April 14, 2015, the Defendant's appeal [Doc. 69] in Case No. 13-15309-A was scheduled for oral argument before the USCA-11th Circuit, and subsequently on December 15, 2015 the USCA-11th Circuit issued its opinion [Doc. 117] affirming the Court's issuance of an injunction against the Defendant [Doc 69].

On October 20, 2017, after the filing of numerous, extensive and unmerited motions in the USCA-11th Circuit, the USCA-11th Circuit issued its opinion in Case No. 15-14859 [Doc. 129] affirming the finding of contempt against the Defendant and vacating the award of attorney fees to the Plaintiff. On November 27, 2017, the Defendant once again filed another motion with the Court [Doc. 131] this time moving to "adjudicate" all claims purportedly under the authority of Fed. R. Civ. P. 60(b). On January 29, 2018, the Court denied the Defendant's motion [Doc. 131] for the reasons

stated in the Court's Order [Doc. 135]. Additionally, this same day, as set forth above, the Court entered an Order [Doc. 134] vacating the award of attorney fees to the Plaintiff consistent with the October 20, 2017 opinion of the USCA-11th Circuit.

On March 19, 2018, the Plaintiff filed its motion to amend the Plaintiff's Complaint [Doc. 141], seeking to terminate this litigation at the District Court level. In response, the Defendant on March 26, 2018 and April 12, 2018 filed, respectively, a motion for a conference [Doc. 142] and the Defendant's own motion to "amend complaint" [Doc. 143]. On July 19, 2017 the Defendant filed a motion for a temporary restraining order [Doc. 144] against a non-party which was seeking to foreclose on real property of the Defendant. On July 23, 2018 the Court ruled on each of the forgoing motions [Docs. 141, 142, 143, 144] granting the Plaintiff's motion to amend the Plaintiff's complaint, and denying the Defendant the relief sought by each of the Defendant's motions [Doc 145], directing counsel for the Plaintiff to submit a proposed final judgment in favor of the Plaintiff consistent with the prior Orders of the Court and the Court of Appeals. On July 24, 2018, Plaintiff filed its Amended Complaint [Doc. 146].

II. Discussion

A. The Plaintiff's Motion for Partial Summary Judgment Under the ACPA

The standard for the grant or denial of summary judgment and the reasoning, opinion, and discussion concerning the grant of Plaintiff's Motion for Partial Summary Judgment Under the ACPA [Doc. 57] are set forth in full in the Court's Order and Opinion dated October 22, 2013 [Doc. 69] and the same is incorporated within this Final Order as if fully set forth herein.

B. The Plaintiff's Motion for Summary Judgment on the Defendant's Counterclaims

The standard for the grant or denial of summary judgment and the reasoning, opinion and discussion concerning the grant of the Plaintiff's Motion for Summary Judgment on the Defendant's Counterclaims [Doc. 58] are set forth in full in the Court's Order and Opinion dated October 22, 2013 [Doc. 69] and the same is incorporated within this Final Order as if fully set forth herein.

C. USCA-11th Circuit, Case No. 13-15309-A

The USCA-11th Circuit, in Case No. 13-15309-A stated correctly that the Defendant appeal[ed] these two decisions [the injunction requiring Monosij Dutta-Roy to transfer to Jysk four domain names and the grant of Plaintiff's Motion for Summary Judgment on the Defendant's Counterclaims] pursuant to 28 U.S.C. § 1291 as if, together, they constitute a final judgment in the case. [But] they do not because still pending resolution in the District Court are claims the Plaintiff brought against the

Defendant under §§ 43(a) and (c) of the Lanham Act, 15 U.S.C. §§ 1125(a) and (c), and state law. *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767 at 771 (11th Cir., 2015). The USCA-11th Circuit ultimately determined that while it lacked jurisdiction to entertain the Defendant's appeal under § 1291 it did have jurisdiction under 28 U.S.C. § 1292(a)(1) to review this Court's injunction, and in exercising that jurisdiction, found no merit in the Defendant's challenges to the injunction and therefore affirmed. Id. at 771.

D. USCA-11th Circuit, Case No. 15-14859

During the pendency of the appeal in the USCA-11th Circuit, Case No. 13-15309-A, the Defendant had filed two additional notices of appeal [Docs. 89, 101] which resulted in USCA-11th Circuit, Case No. 15-14859. The practical effect of the subsequent appeals by the Defendant was to divest this Court of jurisdiction, with the exception of the Court retaining jurisdiction over Plaintiff's motion to alter or amend judgment [Doc. 75] pursuant to the Federal Rules of Appellate Procedure, which is set forth more fully in the Court's Order and Opinion dated January 8, 2014 [Doc. 88] which said Order and Opinion is incorporated within this Final Order as if fully set forth herein. Additionally, pursuant to the October 20, 2017 Opinion of the USCA-11th Circuit, in Case No. 15-14859 [Doc. 129] even though the Defendant had appealed the Court's order granting partial summary judgment, the Court retained

jurisdiction to enforce the order, which required him to transfer disputed domain names to the Plaintiff. Absent entry of a stay on appeal, the [Court] retains jurisdiction to enforce its orders. *Sergeeva v. Tripleton Int'l Ltd.,* 834 F.3d 1194, 1201-02 (11th Cir. 2016).

The USCA-11th Circuit in this appeal, determined as it had prior, that a district court's order is not a final and appealable order under 28 U.S.C. § 1291 if it does not resolve all pending claims against all parties. *Nat'l Ass'n of Bds. of Pharmacy v. Bd. of Regents of the Univ. Sys. of Ga.,* 633 F.3d 1297, 1306 (11th Cir. 2011). This was because pending resolution in the Court at the time were claims the Plaintiff brought against the Defendant under §§ 43(a) and (c) of the Lanham Act, 15 U.S.C. §§ 1125(a) and (c), and state law.

The Defendant in this appeal raised a number of arguments challenging all of the Court's previous orders, as well as several state court garnishment actions, assigning error in all orders that have been entered in this case and contending that they were all reviewable in this appeal. As set forth above, the Defendant was wrong in his contention, and the USCA-11th Circuit determined that the only order properly before the USCA-11th Circuit was the order holding the Defendant in contempt, imposing a prospective fine, and ordering him to pay attorney's fees. *Combs v. Ryan's Coal Co.,* 785 F.2d 970, 976 (11th Cir. 1986).

The USCA-11th Circuit issued its opinion in Case No. 15-14859 [Doc. 129] affirming the finding of contempt against the Defendant and vacating the award of attorney fees to the Plaintiff, and remanding the attorney's fees order for further consideration. Consistent with the Opinion of USCA-11th Circuit [Doc. 129] the Order [Doc. 98] was subsequently vacated in part on January 29, 2018, [Doc. 134] as to the award of attorney fees to the Plaintiff. In that Order [Doc. 134], the Court stated that if the Plaintiff continues to seek an award of attorney fees, it must file an application in great detail with supporting affidavits. To date, the Plaintiff has not filed an application and the Plaintiff indicates that it no longer desires to continue with the matter of attorney fees, therefore the Court reaffirms its Order of January 29, 2018, [Doc. 134] that the prior award of attorney fees to the Plaintiff in the amount of $2,150 is VACATED.

E. Plaintiff's Amended Complaint

All Mandates of the USCA-11th Circuit, [Docs. 127, 136] having been issued and filed of record, the Court once again has jurisdiction the present lawsuit. In the 11th Circuit, the general rule is "the filing of a timely and sufficient notice of appeal acts to divest the trial court of jurisdiction over the matters at issue in the appeal, except to the extent that the trial court must act in aid of the appeal." *Shewchun v. United States,* 797 F.2d 941, 942 (11th Cir. 1986) (per curiam); *accord, Griggs v.*

Provident Consumer Discount Co., 459 U.S. 56, 58, 103 S. Ct. 400, 402 (1982) (per curiam); *Pacific Ins. Co. v. General Development Corp.,* 28 F.3d 1093, 1096 n.7 (11th Cir. 1994). The purpose of the rule is to promote judicial economy and avoid the confusion and inefficiency that would result from two courts considering the same issues at the same time. *See* 20 J. Moore *et al.,* Moore's Federal Practice § 303.32[1] (3d ed. 2009). Fed. R. Civ. P. 62(c) codifies this rule. As a result of the Plaintiff having been denied the opportunity prior to move to amend its Complaint, due to the divesture of jurisdiction of the Court through the appeals of the Defendant, the Plaintiff on March 19, 2018, moved the Court to amend its Complaint [Doc. 141]. the Plaintiff's reasoning for its motion to amend was twofold.

The first being that, in its Complaint, the Plaintiff alleged facts and causes of action related to only the Defendant's registration of bydesignfurniture.com. The Plaintiff never amended its complaint to allege anything about the registrations of bydesignfurniture.org, bydesignfurnitures.com, or bydesign-furnitures.com, prior to moving for summary judgment. In light of *Flintlock Const. Services, LLC* 710 F.3d1221, 1227-28 (11th Cir. 2013) (explaining that "we refuse [] to consider ... additional facts" not alleged in the complaint even though "[t]he defendants d[o] not object" and "the district court ... appear[s] to have considered the additional facts as if they had been alleged in the complaint") (citing *GeorgiaCarry.Org, Inc. v.*

Georgia, 687 F.3d 1244,1258 n.27 (11th Cir. 2012)), the question was raised in an April 6, 2015 *Memorandum to Counsel and Parties* from the USCA-11th Circuit, in Case No. 13-15309-A, if the district court could properly grant a summary judgment in favor of the Plaintiff on causes of action related to the three additional domain names. This issue was not addressed by the USCA-11th Circuit opinion [Doc. 117]. The Plaintiff desiring to not provide fodder for the Defendant on his next anticipated appeal (i.e. Defendant's coming appeal of this Final Order), added to its amended Complaint the factual basis concerning the Defendant's April 26, 2012, registration of the domain names *bydesignfurniture.org*, *bydesignfurnitures.com*, and *bydesign-furnitures.com.*

The second rational of the Plaintiff was to terminate this litigation, finally, with the Court. Addressing the issued raised by the USCA-11th Circuit in both opinions [Docs. 117, 129], the pending resolution in the Court of claims Plaintiff brought against Defendant under §§ 43(a) and (c) of the Lanham Act, 15 U.S.C. §§ 1125(a) and (c), and state law, the Plaintiff amended its Complaint to remove the forgoing causes of action, leaving only its cause of action under the ACPA, which was previously decided in favor of the Plaintiff per the Order and Opinion of the Court [Doc. 69].

The Plaintiff's motion to amend the Complaint was granted [Doc. 145] on July 23, 2018 and the next day the Plaintiff filed its Amended Complaint [Doc. 146].

III. Conclusion

It is apt and proper, now that this litigation has finally reached its termination in the Court, that the Court reiterates that the Defendant has throughout demonstrated a history of abusive litigation, including the filing of frivolous motions, has repeatedly ignored the Local Rules, and has openly, willfully, and without any justification defied Court Orders. It is only through the leniency of the Court, with respect to pro se defendants, that the Defendant did not find himself sanctioned for his abusive and egregious conduct. In light of the amendment of the Plaintiff's Complaint the Court finds that since all of the claims of the Plaintiff have been previously adjudicated, all of the counter-clams of the Defendant have been previously dismissed [Doc. 69], the Defendant having relinquished control of, and having transferred to Plaintiff the four domain names, and the Court and the USCA-11th Circuit having have both previously determined that Defendant's actions are those of a cybersquatter, and therefore granting an injunction to Plaintiff fulfills Congress's policy goals in enacting the ACPA, there are no further issues left to be decided between the parties, therefore after approximately six years of litigation:

IT IS ORDERED, ADJUDGED, AND DECREED that this ORDER in conjunction with in the Court's ORDER AND OPINION dated October 22, 2013 [Doc. 69] (which is fully incorporated herein as if fully set forth) and as modified by

the Court's OPINION AND ORDER dated January 8, 2014, awarding the Plaintiff $4,000 in statutory damages under ACPA [Doc. 88] is and shall be the FINAL ORDER of the Court.

There being no just reason for delay, pursuant to Rule 54(b) of the Federal Rules of Civil Procedure, the Clerk is ordered to enter this Final Judgment forthwith and without further notice.

SO ORDERED, this ____ day of _____, 2018.

/s/Thomas W. Thrash
THOMAS W. THRASH, JR.
United States District Judge

APDX-B2

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

JYSK BED'N LINEN
as successor to Quick Ship Holding, Inc., d/b/a By Design Furniture
doing business as
By Design Furniture,

Plaintiff,

v.

MONOSIJ DUTTA-ROY,

Defendant.

CIVIL ACTION FILE
NO. 1:12-CV-3198-TWT

OPINION AND ORDER

The Plaintiff moves to alter or amend this Court's prior judgment to award statutory damages to the Plaintiff under the Anticybersquatting Consumer Protection Act. The Defendant has appealed the judgment, and also moves for relief from the judgment under Rule 60. Despite the Defendant's notice of appeal, the Court retains jurisdiction over the Plaintiff's motion to alter or amend judgment pursuant to the Federal Rules of Appellate Procedure. However, the Court does not retain jurisdiction to dispose of the Defendant's motion for relief, which was filed over 28 days after the Court entered judgment. Because the Plaintiff has shown that it is entitled to statutory

damages under the Anticybersquatting Consumer Protection Act, its motion to alter or amend judgment should be granted.

I. Discussion

"When a party files a notice of appeal before a district court disposes of one of the motions listed in [Federal Rule of Appellate Procedure] 4(a)(4)(A), the notice of appeal 'becomes effective to appeal a judgment ... when the order disposing of the last such remaining motion is entered.'" Hertzner v. Henderson, 292 F.3d 302, 303 (2d Cir. 2002) (citing Fed. R. App. P. 4(a)(4)(B)(i)); see also Fed. R. Civ. P. 62.1 advisory committee's notes ("Appellate Rule 4(a)(4) lists six motions that, if filed within the relevant time limit, suspend the effect of a notice of appeal filed before or after the motion is filed until the last such motion is disposed of."). The motions that suspend the effect of a notice of appeal include timely filed motions "to alter or amend the judgment under Rule 59." Fed. R. App. P. 4(a)(4)(A)(iv). Here, the Plaintiff timely filed its motion to alter or amend the judgment under Rule 59 on the same day that the Defendant filed his notice of appeal. See [Docs. 75 and 76]. Because the Plaintiff's motion was timely, the Court retains jurisdiction to dispose of that motion despite the Defendant's notice of appeal.

The Plaintiff's motion to alter or amend the judgment should be granted because the Plaintiff has shown that it is entitled to statutory damages under the

Anticybersquatting Consumer Protection Act ("ACPA"). See St. Luke's Cataract and Laser Institute, P.A. v. Sanderson, 573 F.3d 1186, 1204-06 (11th Cir. 2009) (noting that a statutory damage award under the ACPA "serves as a sanction to deter wrongful conduct" and is not duplicative of an actual damage award serving to compensate a plaintiff). Accordingly, this Court's Order [Doc. 69] is amended to award the Plaintiff $1,000 in statutory damages for each domain name registered in violation of the ACPA. As stated in that Order, "[t]he Plaintiff is ... entitled to relief pursuant to the ACPA for the Defendant's 2012 registrations of bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com." [Doc. 69, at 14]. The Plaintiff should accordingly be awarded $4,000 in statutory damages.

Next, the Defendant seeks relief from judgment under Rule 60. [Doc. 84]. As noted, "Appellate Rule 4(a)(4) lists six motions that, if filed within the relevant time limit, suspend the effect of a notice of appeal filed before or after the motion is filed until the last such motion is disposed of." Fed. R. Civ. P. 62.1 advisory committee's notes. Those motions include motions "for relief under Rule 60 if the motion is filed no later than 28 days after the judgment is entered." Fed. R. App. P. 4(A). Here, because the Defendant's motion was filed more than 28 days after the Court entered judgment, it is not one of the motions that, under Rule 4(a)(4)(A), suspends the effect of the Defendant's notice of appeal. The Court thus concludes it does not have

jurisdiction to consider the Defendant's Rule 60 motion and accordingly the motion should be denied. See Green Leaf Nursery v. E.I. DuPont De Nemours and Co., 341 F.3d 1292, 1309 (11th Cir. 2003) (citing Griggs v. Provident Consumer Discount Co., 459 U.S. 56, 58 (1982) ("The filing of a notice of appeal is an event of jurisdictional significance - it confers jurisdiction on the court of appeals and divests the district court of its control over the aspects of the case involved in the appeal.")); Fed. R. App. P. 12.1 advisory committee's notes ("After an appeal has been docketed and while it remains pending, the district court cannot grant relief under a rule such as Civil Rule 60(b) without remand. But it can entertain the motion and deny it.").

II. Conclusion

For the reasons set forth above. The Plaintiff's Motion to Alter or Amend Judgment [Doc. 75] is GRANTED. The Plaintiff is awarded $4,000 in statutory damages under the ACPA. The Defendant's Motion for Relief Under Rule 60 [Doc. 84] is DENIED.

SO ORDERED, this 8 day of January, 2014.

/s/Thomas W. Thrash
THOMAS W. THRASH, JR.
United States District Judge

APPX-B3

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

JYSK BED'N LINEN
as successor to Quick Ship Holding, Inc., d/b/a By Design Furniture
doing business as
By Design Furniture,

Plaintiff,

v.

MONOSIJ DUTTA-ROY,

Defendant.

CIVIL ACTION FILE
NO. 1:12-CV-3198-TWT

OPINION AND ORDER

This is an action under the Anticybersquatting Consumer Protection Act. The Plaintiff contends that the Defendant registered website addresses using the Plaintiff's trademark in an effort to extort money from the Plaintiff. The Defendant, who is pro se, contends he owns the websites pursuant to a contract entered into between the parties' predecessors.

I. Background

The Plaintiff, Jysk Bed'N Linen as successor to Quick Ship Holding, Inc., d/b/a By Design Furniture ("By Design" or the "Plaintiff"), has used the trade name By Design Furniture since 1990, and contends it holds a common law trademark in the

name. The Plaintiff is a retailer of furniture that owns stores in Georgia, North Carolina, and New Jersey.

The Plaintiff contends it has used the bydesignfurniture.com trademark since approximately April 1999. The bydesignfurniture.com domain name, however, is registered in the name of the Defendant, Monosij Dutta-Roy. The Defendant contends he has continually paid for and monitored that website address pursuant to an agreement between the Defendant's predecessor and the Plaintiff. That agreement, entered into between BazaarWorks, LLC, a company the Defendant was affiliated with, and By Design Furniture, a company the Plaintiff has since absorbed, purportedly stated that BazaarWorks would produce a custom website for By Design (the "Partnership Agreement").

The Defendant now contends he is the owner of BazaarWorks, and contends that he executed the Partnership Agreement on behalf of BazaarWorks and that Kjell Bratengen executed it for the Plaintiff. (Dutta-Roy Aff. ¶¶ 2-5, 7). Bratengen denies the existence of the Partnership Agreement and Shashi Sonnad, a former employee of BazaarWorks, also denies the existence of the agreement. (Third Bratengen Aff. ¶ 2; Third Sonnad Aff. ¶ 3). The Defendant has produced a document entitled Partnership Agreement with the names of By Design and BazaarWorks, but it is unsigned and otherwise incomplete. (Dutta-Roy Aff. Ex. A).

The Plaintiff contends it hired Sonnad to maintained the bydesignfurniture.com website from its inception in 1999 through April 2012, and only learned that it did not hold the domain's registration when the Defendant let the registration expire on April 9, 2012. When the registration for the bydesignfurniture.com website lapsed, the Plaintiff demanded that the Defendant turn over the domain name. The Defendant refused and renewed his registration to the domain name on April 20, 2012. And on April 26, 2012, he registered the bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com domain names in his own name. (See Sorensen Decl. ¶¶ 12-15; 20-23).

The Plaintiff accordingly demands that the Defendant turn over the domain names at issue and that the Court award damages pursuant to the Anticybersquatting Consumer Protection Act ("ACPA"). The Defendant contends that his initial registration of the bydesignfurniture.com domain name was made before the ACPA went into effect, that there is at least an issue of fact as to whether "by design furniture" is a trade name or trademark associated with the Defendant, and that the Defendant's actions have been consistent with the Partnership Agreement.

The Plaintiff has filed two motions for summary judgment. The first partial motion seeks summary judgment on its claim under the ACPA. The second motion seeks summary judgment on the Defendant's counterclaims for breach of contract,

unjust enrichment, quantum meruit, for an equitable accounting, and for attorney's fees. The Defendant is proceeding pro se. On March 31, 2013, the Court held a hearing and granted the Plaintiff's motion for a preliminary injunction prohibiting the Defendant from doing anything with the bydesignfurniture.com domain name that would restrict the public's access to it, from transferring ownership of the domain name to anyone other than the Plaintiff, and from otherwise altering the status quo. [Doc. 53]. The Defendant filed motions to delay summary judgment and to compel mediation, which the Court denied. [Docs. 37, 61].

II. Motion for Summary Judgment Standard

Summary judgment is appropriate only when the pleadings, depositions, and affidavits submitted by the parties show that no genuine issue of material fact exists and that the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The court should view the evidence and any inferences that may be drawn in the light most favorable to the nonmovant. Adickes v. S.H. Kress & Co., 398 U.S. 144, 158-59 (1970). The party seeking summary judgment must first identify grounds that show the absence of a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323-24 (1986). The burden then shifts to the nonmovant, who must go beyond the pleadings and present affirmative evidence to show that a genuine issue of material fact does exist. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 257 (1986).

III. Discussion

A. The Plaintiff's Motion for Partial Summary Judgment Under the ACPA

"Under the Anti-Cybersquatting Consumer Protection Act a person alleged to be a cybersquatter is liable to the owner of a protected mark if the cybersquatter uses a domain name that is identical or confusingly similar to a distinctive mark and the cybersquatter had a bad faith intent to profit from the use of the mark." Eagle Hospital Physicians, LLC v. SRG Consulting, Inc., 509 F. Supp. 2d 1337, 1347 (N.D. Ga. 2007) (citing 15 U.S.C. § 1125(d)(1)). The Court concludes that the Plaintiff has shown that the Defendant violated the ACPA when he registered the domain names at issue in 2012.

First, the "By Design" mark was a distinctive mark by the time the Defendant registered the trade names in 2012. The Plaintiff has used the "By Design" mark since at least 1990. (First Bratengen Aff. ¶¶ 4,6-8; Sorensen Aff. ¶¶ 6-9). The Plaintiff has used the bydesignfurniture.com website in connection with offering its products to the public since 1999. (Sorensen Aff. ¶ 4). In general, distinctive marks "serve the purpose of identifying the source of the goods or services." Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1357 (11th Cir. 2007) (citing Colt Defense LLC v. Bushmaster Firearms, Inc., 486 F.3d 701, 705 (1st Cir. 2007)). "Some marks are inherently distinctive; some marks, though not inherently distinctive, acquire

distinctiveness by becoming associated in the minds of the public with the products or services offered by the proprietor of the mark; and some marks can never become distinctive." Id. (citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768-69 (1992)). With respect to distinctiveness,

> Trademarks are classified into four categories, in order of increasing strength: 1) generic--marks that suggest the basic nature of the product or service; 2) descriptive--marks that identify the characteristic or quality of a product or service; 3) suggestive--marks that suggest characteristics of the product or service and require an effort of the imagination by the consumer in order to be understood as descriptive; and 4) arbitrary or fanciful--marks that bear no relationship to the product or service, and the strongest category of trademarks.

Gift of Learning Foundation, Inc. v. TGC, Inc., 329 F.3d 792, 797-98 (11th Cir. 2003) (citing Frehling Enter., Inc. v. International Select Group, Inc., 192 F3d 1330, 1335 (11th Cir. 1999)). Here, in November 2012, the United States Patent and Trademark Office ("USPTO") suggested in its review of the application that the bydesignfurniture.com mark was inherently distinctive when it stated that the Plaintiff's application for acquired distinctiveness was "unnecessary because the mark appears to be inherently distinctive and is eligible for registration on the Principal Register without proof of acquired distinctiveness." (Def.'s Mot. for Partial Summ. J., Ex. F). Additionally, the term "by design" is not characteristic of the furniture industry and not merely descriptive of the products the Plaintiff sells. Because the Plaintiff is only a retailer of furniture, the "by design" phrase does not attach to a

primary characteristic of the company, such as custom furniture designing. During the hearing for a preliminary injunction in this case, the Plaintiff submitted numerous advertisements for By Design Furniture displaying the bydesignfurniture.com website and the "By Design" mark. (See [Doc. 52], Pl.'s Exs. 2 & 3). These advertisements do not suggest that the furniture is "designed" in any way. Instead, they indicate that the Plaintiff is selling a particular brand of furniture. "The distinction between descriptive and generic terms is a matter of degree." Id. at 798 (citing American Television & Communications Corp. v. American Communications & Television, Inc., 810 F.2d 1546, 1548-49 (11th Cir. 1987)). The Court concludes that the "By Design" and "bydesignfurniture.com" marks serve primarily to describe the origin of the products the Plaintiff sells, not the products themselves, and is therefore inherently distinctive and deserves trademark protection. See id. at 798 (citing American Television, 810 F.3d at 1548).

The Defendant argues that the ACPA cannot apply because the Plaintiff does not actually own the mark, it has only applied for federal registration of the mark. However, the Plaintiff has shown it has common law trademark rights to the mark at issue. "Common-law trademark rights are 'appropriated only through actual prior use in commerce.'" Crystal Entertainment & Filmworks, Inc. v. Jurado, 643 F.3d 1313, 1321 (11th Cir. 2011) (quoting Planetary Motion, Inc. v. Techspolsion, Inc., 261 F.3d

1188, 1193-94 (11th Cir. 2001)). In determining whether common law trademark rights have been established, district courts are directed to:

> inquire into the totality of the circumstances surrounding the prior use of the mark to determine whether such association or notice was present. [The Eleventh Circuit] has determined that a company proved prior use of a mark sufficient to establish ownership when, among other things, the distribution of the mark was widespread because the mark was accessible to anyone with access to the Internet; the evidence established that members of the targeted public actually associated the mark with the product to which it was affixed; the mark served to identify the source of the product; and other potential users of the mark had notice that the mark was used in connection with the product.

Id. (quoting Planetary Motion, 362 F.3d at 1193-97) (internal marks and alterations omitted). Here, the Plaintiff has used the bydesignfurniture.com mark since at least 1999 and the By Design name since 1990. The Plaintiff has distributed advertisements using the By Design name and displaying the bydesignfurniture.com website. The "By Design" mark and the bydesignfurniture.com mark serve to show the public the source of the Plaintiff's furniture products and does not describe the products themselves. The Plaintiff has not provided evidence concerning whether other potential users of the mark would be on notice about the mark. However, the Plaintiff only operates in Georgia, North Carolina, and New Jersey. The Court concludes that in the totality of the circumstances the Plaintiff has established

common law trademark rights through prior use of the "By Design" mark and the bydesignfurniture.com mark in commerce.[1]

The Defendant further argues that the "By Design" mark is unrelated to the "bydesignfurniture" series of websites and therefore the websites are outside the protection of the ACPA. The Court has already concluded that the bydesignfurniture.com mark is inherently distinctive and entitled to protection but, even assuming the Defendant had shown that the Plaintiff's mark was limited to "By Design," the Defendant's argument fails because the ACPA prevents the registration of "a domain name which is identical or confusingly similar to, or dilutive of, the trademark owner's mark." Victoria's Cyber Secret Ltd. v. V Secret Catalogue, Inc., 161 F. Supp. 2d 1339, 1345 (S.D. Fla. 2001) (citing 15 U.S.C. § 1125(d)(1)(A)). The domain names bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com are similar enough to the "By Design" mark to earn protection under the ACPA.

Having established that it is the owner of a protected mark, the Plaintiff is required to show that the Defendant registered the domain name under the mark in bad

[1] The Defendant argues that the Plaintiff's trade name is not registered pursuant to O.C.G.A. § 10-1-490. The Plaintiff does not respond to this argument, but there is nothing within O.C.G.A. § 10-1-490 suggesting that failure to comply with the statute diminishes the distinctiveness of a trademark or a business's ownership of the mark with respect to federal law.

faith. Here, although the Defendant may not have registered bydesignfurniture.com with bad faith in 1999 and 2001, the Plaintiff has shown that the registrations of bydesignfurniture.com and the related domain names in 2012 were made in bad faith. The Court considers nine non-exclusive factors when determining whether a defendant has used a domain name in bad faith. Those factors are whether the Defendant:

> has (1) intellectual property rights in the domain name, (2) used a domain name that consists of the legal name of a person, (3) used a domain name previously in connection with the bona fide offering of goods or services, (4) bona fide noncommercial or fair use of the mark, (5) intend[ed] to divert customers from the mark owner's location to a site that could harm the good will represented by the mark, (6) offered to sell the domain name to the mark owner, (7) provided material and false contact information when registering for the domain name, (8) registered or acquired multiple domain names which he knows are identical or confusingly similar to the marks of others, or (9) used a domain name that incorporates a distinctive or famous mark.

Eagle Hospital Physicians, 509 F. Supp. 2d at 1348 (citing 15 U.S.C. § 1125(d)(1)(B)(i)).

Here, the 2012 registrations of bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com were made in bad faith. The Defendant does not have intellectual property rights in the bydesignfurniture.com trade name. The Defendant has never used the websites for a bona fide offering of goods or services. The Defendant re-registered bydesignfurniture.com and registered

the three similar domain names after the Plaintiff approached him to recover the bydesignfurniture.com domain name. Further, the Defendant demanded payment from the Plaintiff for the domain names, and the Defendant admits he intends to profit from the registration and use of the domain name. (See Def.'s Mot. for Summ. J., Ex. G). The Defendant's actions satisfy at least five of the nine elements required to show bad faith under the ACPA.

The ACPA includes a safe harbor provision stating that bad faith "shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was fair use or otherwise lawful." Id. (citing 15 U.S.C. §§ 1125 (d)(1)(B)(i) & (ii)). Here, the Defendant contends he used the bydesignfurniture.com domain name under the Partnership Agreement between BazaarWorks and the Plaintiff. However, whatever relationship existed concerning the 1999 and 2001 registrations of bydesignfurniture.com, the Defendant cannot avail himself of the safe harbor provision of the ACPA with respect to the 2012 registrations, where the Defendant's bad faith is readily apparent. And the Partnership Agreement does not authorize the Defendant to take the Plaintiff's trademark hostage even if the Defendant was due payment under the agreement.

In Eagle Hospital Physicians, LLC v. SRG Consulting, Inc., 509 F. Supp. 2d 1337, 1347 (N.D. Ga. 2007), the plaintiff argued that the defendants violated the ACPA through their conduct following an agreement between the parties whereby the defendants would create a website for the plaintiff. The court noted that the case was "unique among cybersquatting suits because at the time Defendants registered the numerous domain names at issue, there was an agreement among the parties that Defendants would develop and utilize web sites as a means of attracting clients to Plaintiff's business. At the time, therefore, there was no evidence of bad faith on the part of the Defendants." Id. at 1350. However, a dispute arose after the agreement and the plaintiff demanded that the defendants return the domain names. The defendants refused because they believed the plaintiff owed them money under the previous agreements. The court noted that although the defendants refused to turn over the domain name because of the prior agreement, the amount of compensation the defendants were demanding for the domain name far exceeded what they could be owed under the agreement itself. The court suggested that this might be sufficient to show that the defendants were holding the domain names in bad faith, even if the defendants were only "holding the domain names hostage [] as leverage to secure" what they were owed under the agreement. Id.

Here, the evidence of bad faith exceeds the bad faith in Eagle Hospital Physicians. Even if the Defendant had shown he was directed initially to register the bydesignfurniture.com website in his name in 1999, the Defendant's re-registration in 2012 along with the registration of several similar domain names, followed by the Defendant's request for payment, demonstrates bad faith. (First Bratengen Aff. ¶¶ 22-27). Indeed, as noted, in response to the Plaintiff's requests for admission, the Defendant admitted he intended to profit from the registration and use of the domain name bydesignfurniture.com. (Def.'s Mot. for Partial Summ. J., Ex. G). The Defendant also admitted that he did not sell any bona fide goods or services through the website and that he did not fully understand the software operating the website. (Id.) The fact that the Defendant may have initially believed he could register the domain name in his own name under the Partnership Agreement does not undermine the bad faith associated with the 2012 transaction. See Victoria's Cyber Secret, 161 F. Supp. 2d at 1353 (quoting Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264, 270 (4th Cir. 2001) ("A defendant who acts even *partially* in bad faith in registering a domain name is not, as a matter of law, entitled to benefit from the [ACPA's] safe harbor provision.")). Accordingly, the Court concludes the Defendant acted in bad faith with respect to the 2012 registrations and cannot benefit from the safe harbor provision.

The Plaintiff is thus entitled to relief pursuant to the ACPA for the Defendant's 2012 registrations of bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com. "Under the ACPA, this Court may award the prevailing party damages 'in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.'" Victoria's Cyber Secret, 161 F. Supp. 2d at 1356 (quoting 15 U.S.C. § 1117(d)). The court may also "order the forfeiture or cancellation of the domain name or alternatively, transfer the domain name to the owner of the mark." Id. (quoting 15 U.S.C. § 1125(d)(1)(C)). The Court accordingly orders the transfer of the four domain names at issue, bydesignfurniture.com, bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com, from the Defendant to the Plaintiff within fourteen (14) days of the date of this Order. The Court declines to assess damages against the Defendant because of the prior relationship between the parties and because there is no evidence that the Plaintiff suffered actual damages. The Plaintiff's motion for partial summary judgment should accordingly be granted.

B. The Defendant's Counterclaims

The Plaintiff moves for summary judgment on the Defendant's counterclaims for breach of contract, unjust enrichment, quantum meruit, breach of fiduciary duty, for an equitable accounting, and for attorney's fees.

The Defendant argues that the Plaintiff breached its obligations under the Partnership Agreement. The Plaintiff argues for summary judgment because: (1) the Defendant has not produced an executed copy of the Partnership Agreement, and the Defendant denies the existence of such an agreement; and (2) the Defendant was not a party to the alleged Partnership Agreement. "The party claiming breach of contract has the burden of pleading and proving (1) the subject matter of the contract, (2) consideration, and (3) mutual assent by the parties to all of the contract terms." Importers Service Corp. v. GP Chemicals Equity, LLC, 652 F. Supp. 2d 1292, 1300 (N.D. Ga. 2009) (citing O.C.G.A. § 13-3-1).

Here, the Defendant has not met his burden. First, the Defendant has only produced an unsigned version of the Partnership Agreement with blanks on the signature and date blocks. The Plaintiff denies executing the Partnership Agreement, and attaches affidavits denying the execution of any such agreement and even an affidavit from its former attorney denying any knowledge of the agreement. (See Zipperman Aff. ¶ 3; Third Sonnad Aff. ¶ 4; Third Bratengen Aff. ¶ 4). Further, the Defendant does not explain how he is personally authorized to enforce a contract between the Plaintiff and BazaarWorks, which dissolved in 2005. The Defendant contends that he is now the 100% owner and operator of the dissolved company. However, the Defendant previously moved to join BazaarWorks as a party stating that

BazaarWorks is "the only other party to the Partnership Agreement with [the Plaintiff]." (Def.'s Mot. for Joinder, at 7). Even assuming he is a successor in interest to BazaarWorks, there is no discussion of why the Defendant himself has purportedly been maintaining a website for the Plaintiff for over seven years without compensation and apparently without the Plaintiff's knowledge. Additionally, the Defendant admits that he only has a "good idea" of the software used in creating the website hosted on bydesignfurniture.com. (Def.'s Mot. for Partial Summ. J., Ex. G). The Plaintiff has itself paid for maintaining the bydesignfurniture.com website since at least 1999. (See Bratengen Aff. ¶ 11; Def.'s Mot. For Summ. J., Ex. C, Sec. Sonnad Aff., ¶¶ 17-24). Without evidence that the Defendant has done anything with the Plaintiff since at the latest 2005 – as evidenced by the 2005 emails in which Bratengen demands the return of computer equipment from the Defendant and announces the end of their relationship – and without evidence of any specific part of the Partnership Agreement that supports his breach of contract claim in his own name, the Plaintiff's motion for summary judgment on the Defendant's breach of contract counterclaim should be granted. (See Sec. Bratengen Aff. Ex. A).

The Plaintiff next argues that the Defendant's claims for unjust enrichment and quantum meruit should be dismissed because there is no indication that the Defendant did anything of value for the Plaintiff since 2005, and the statutes of limitations with

respect to those causes of action bar the Defendant's claims. The counterclaims were filed on October 10, 2012. "The theory of unjust enrichment applies when as a matter of fact there is no legal contract, but where the party sought to be charged has been conferred a benefit by the party contending an unjust enrichment which the benefited party equitably ought to return or compensate for." Renee Unlimited, Inc. v. City of Atlanta, 301 Ga. App. 254, 258 (2009) (citing Smith v. McClung, 215 Ga. App. 786, 789 (1994)). The statute of limitations on unjust enrichment claims is four years. Id.; see also O.C.G.A. § 9-3-26. Similarly, "the essential elements of [quantum meruit] are: (1) the performance of valuable services; (2) accepted by the recipient or at his request; (3) the failure to compensate the provider would be unjust; and (4) the provider expected compensation at the time services were rendered." Amend v. 485 Properties, 280 Ga. 327, 329 (2006) (citing Hollifield v. Monte Vista Biblical Gardens, 251 Ga. App. 124, 128 (2001)). The statute of limitations on actions on implied contracts is also four years. O.C.G.A. § 9-3-26. The Defendant has produced no evidence suggesting that he did any work on behalf of the Plaintiff since at the latest 2005. The only evidence the Defendant produced shows an agreement between the Plaintiff and an LLC that the Defendant once worked for. That LLC, however, dissolved in 2005. There is no evidence of any renewed agreement between the Plaintiff and the Defendant and there is no evidence outside of the Defendant's own

declaration that he has done any work for the Plaintiff. Accordingly, the Defendant's claims for unjust enrichment and quantum meruit must fail, and the Plaintiff's motion for summary judgment should be granted in this respect.

The Defendant's counterclaim for breach of fiduciary duty similarly fails because the Defendant has presented no evidence to support his claim that there was a fiduciary relationship between himself and the Plaintiff. "A fiduciary or confidential relationship arises where one party is so situated as to exercise a controlling influence over the will, conduct, and interest of another or where, from a similar relationship of mutual confidence, the law requires the utmost good faith." Wright v. Apartment Inv. and Management Co., 315 Ga. App. 587, 592 (2012) (citing O.C.G.A. § 23-2-58). The Defendant has not established any such relationship with the Defendant. As noted, the Partnership Agreement was between BazaarWorks and the Plaintiff, not the Defendant and the Plaintiff. Additionally, there is no indication that Defendant had any contact with Plaintiff following the 2005 dissolution of BazaarWorks. Because the Defendant has not shown that the Plaintiff and the Defendant had any relationship that might have engendered a fiduciary relationship, the Plaintiff's motion for summary judgment should be granted on the Defendant's counterclaim for breach of fiduciary duty.

Likewise, the Defendant has not shown that he is entitled to an equitable accounting. "The sufficiency of a petition for an equitable accounting depends 'upon whether the facts alleged showed that on an accounting the petitioner will likely be entitled to recover judgment for some amount.'" Riverview Condominium Ass'n v. Ocwen Federal Bank, FSB, 285 Ga. App. 7, 8 (2007) (quoting Charles S. Martin Distrib. Co. v. Roberts, 219 Ga. 525, 532 (1964)). Here, as discussed above, the Defendant has not presented any facts to suggest that an equitable accounting of the bydesignfurniture.com website would lead to a recovery for the Defendant through either the Partnership Agreement or a fiduciary relationship. Finally, because the Defendant cannot succeed on any of his claims, he is not entitled to an award of attorney's fees. See Munson v. Strategis Asset Valuation and Management, Inc., 363 F. Supp. 2d. 1377 (2005) (concluding that plaintiff who did not prevail on substantive claims was not entitled to attorney's fees). Accordingly, the Plaintiff's motion for summary judgment on the Defendant's counterclaims should be granted.

IV. Conclusion

For the reasons set forth above, the Plaintiff's Motion for Partial Summary Judgment [Doc. 57] is GRANTED and the Plaintiff's Motion for Summary Judgment on the Defendant's Counterclaims [Doc. 58] is GRANTED. The Defendant is hereby ORDERED to turn over the registration of the domain names bydesignfurniture.com,

bydesignfurniture.org, bydesignfurnitures.com, and bydesign-furnitures.com to the Plaintiff within fourteen (14) days of the date of this Order.

SO ORDERED, this 21 day of October, 2013.

/s/Thomas W. Thrash
THOMAS W. THRASH, JR.
United States District Judge

Additional material from this filing is available in the Clerk's Office.