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Parker Waichman, Orlando 'Yourlawyer' Spat Rages On

By **Julie Zeveloff**

Law360, New York (May 25, 2010) -- A federal judge has refused to dismiss a dispute between plaintiffs firms Parker Waichman Alonso LLP and the Orlando Firm PC over the "yourlawyer.com" trademark, finding that the court has personal jurisdiction over the case.

Judge Colleen McMahon of the U.S. District Court for the Southern District of New York on May 14 issued a ruling denying the Orlando Firm's motion to dismiss, noting that its representation of six New York residents in a mass tort action subjected it to personal jurisdiction there.

She also wrote that her court had transactional jurisdiction based on the interactivity of the Orlando Firm's website, which sits at the heart of the litigation.

Roger W. Orlando of the Orlando Firm said the ruling did not come as a surprise.

"I don't technically agree with the ruling, but it's not earth-shattering and it doesn't cause me any deep concern," he said.

Orlando also said he planned to file a counterclaim to have Parker Waichman's marks canceled.

Jerrold Parker of Parker Waichman said he was pleased the court found jurisdiction over the defendant in New York.

"It's important for people to protect the intellectual property they have," he said. "For Mr. Orlando to try to piggyback off the work I have done for more than a decade - I think it's unconscionable."

Parker Waichman lodged the suit in August, claiming the Orlando Firm infringed federally registered marks for "yourlawyer" and "yourlawyer.com" by registering and using the domain name "yourlawyer.tv."

According to the complaint, Parker Waichman has used the "yourlawyer.com" domain since 1999, spending millions of dollars annually to promote and market the website and associated services.

The Orlando Firm did not register its website until nearly a decade later, the suit alleges. Moreover, it offers a "speak to an attorney" service identical to one offered on Parker Waichman's site, the complaint contends.

"Defendant is, in whole or in part, offering the exact same type of legal services under its infringing mark as those offered by [Parker Waichman] under its marks — plaintiff's representations in the mass torts arena — such as in areas of workers' compensation, drug recalls, medical device recalls, food poisoning, medical malpractice, defective products, personal injury, aviation issues and premises liability," the suit said.

Parker Waichman first learned of the Orlando Firm's allegedly infringing actions in February 2009, according to the suit. Though the Orlando Firm initially agreed to transfer its domain name to Parker Waichman, it never did so, the suit states.

The plaintiff alleges trademark infringement, unfair competition and false designation of origin and common law unfair competition, as well as violations of New York's business code.

The suit seeks permanent injunctive relief, the destruction of any infringing items and a judgment including all profits the Orlando Firm derived from the website, as well as treble damages. It also asks for attorneys' fees and costs of suit.

Orlando said Tuesday that he purchased the domain name because he generally advertised on television and thought it would be cute, though he later decided it was sleazy.

He also said he tried to transfer the domain to Parker Waichman after that firm lodged a complaint with the Internet Corporation for Assigned Names and Numbers, but was unable to do so because ICANN locked the site.

A representative for Parker Waichman did not immediately respond to a request for comment on the ruling.

Parker Waichman is represented by Pryor Cashman LLP.

The Orlando Firm is represented by Samuel & Stein.

The case is Parker Waichman Alonso LLP v. The Orlando Firm PC, case number 09-cv-07401, in the U.S. District Court for the Southern District of New York.

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