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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

THE FREecycle NETWORK, INC., an Arizona non-profit organization,	} No. CV 06-173-TUC-RCC
Plaintiff,	
vs.	
TIM OEY and JANE DOE OEY,	
Defendant.	

ORDER

On April 24, 2006, the Court held oral argument regarding a motion for a Temporary Restraining Order against Defendant Tim Oey ("Oey"). That motion was granted (Docket # 18). Now pending before the Court is Plaintiff The Freecycle Network, Inc.'s Notice of *Ex Parte* Motion and *Ex Parte* Motion for Order to Show Cause Against Defendant Tim Oey Regarding Contempt Due to Failure to Comply with Temporary Restraining Order (Docket # 20) as well as whether a preliminary injunction should be issued on The Freecycle Network's ("Freecycle") behalf enjoining Oey from making comments that infringe on Freecycle's Trademark.

I. BACKGROUND

The Freecycle Network is a nonprofit Arizona corporation with member groups throughout the world dedicated to encouraging and coordinating the reusing, recycling,

1 and gifting of goods. Starting with a single community in Tucson, Freecycle has grown
2 to a worldwide organization with thousands of local recycling groups and more than two
3 million members.

4 Freecycle has been using the trademarks FREecycle, THE FREecycle
5 NETWORK and "The Freecycle Network" logo since May 2003. On November 22,
6 2005, Freecycle's trademark and logo were approved for publication on the Principal
7 Register by the United States Patent and Trademark Office ("USPTO"). A notice of
8 publication was issued on December 28, 2005, but that registration is being opposed by a
9 group in California making the trademark's application pending.

10 Defendant Oey was actively involved with Freecycle from early 2005 until late
11 2005. Part of Defendant's duties included participating in an intellectual property group
12 tasked with developing guidelines for protecting Freecycle's intellectual property. As part
13 of his duties, Defendant has authored emails which have defended Freecycle's trademark
14 rights.

15 In mid-September 2005 Defendant resigned from his position with Freecycle.
16 Subsequently, Defendant began making public remarks disagreeing with the validity
17 Freecycle's trademark rights. In support of this, Defendant has emailed remarks
18 disparaging Freecycle's trademark as well as posting comments on the internet
19 disparaging Freecycle's trademark.

20 Freecycle filed this action against Defendant claiming that he had made remarks
21 that infringed upon their trademark. In accordance with this, Plaintiff moved for a
22 temporary restraining order which was granted by this court. Now, Plaintiffs are asking
23 for a preliminary injunction as well as an order to show cause as to why Defendant should
24 not be held in contempt of court for not removing previously posted comments on the
25 internet that infringe upon Freecycle's trademark.

26 Defendant claims that the term "freecycle" is a generic term and thus not able to be
27 trademarked. Defendant points to the fact that the trademark is still pending with the
28 USPTO and that there is an objection to the pending trademark that must be resolved by

1 the USPTO. With regard to the motion for contempt filed by Freecycle, Defendant
2 asserts that it did not relate to past comments made by Defendant before the Complaint in
3 this case was even filed.

4 5 **II. DISCUSSION**

6 The moving party carries the burden for demonstrating the need for injunctive
7 relief. *Huang v. Holiday Inns, Inc.*, 594 F.Supp. 352, 355 (C.D.Cal. 1984).

8 Factors to consider in determining whether to grant a preliminary injunction are:

9 (1) the likelihood of plaintiff's success on the merits; (2) the possibility of
10 plaintiff's suffering irreparable injury if relief is not granted; (3) the extent
11 to which the balance of hardships favors the respective parties; and (4) in
certain cases, whether the public interest will be advanced by the provision
of preliminary relief.

12 *Dollar Rent A Car of Wash., Inc. v. Travelers Indemnity Co.*, 774 F.2d 1371, 1374 (9th
13 Cir. 1985).

14 In a trademark infringement case, a plaintiff is entitled to a preliminary injunction
15 if it can show "either (1) a combination of 'probable success on the merits' and 'the
16 possibility of irreparable injury' or (2) the existence of 'serious question going to the
17 merits' and that 'the balance of hardships tips sharply in [its] favor.'" *GoTo.com, Inc. v.*
18 *Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000) (quoting *Sardi's Rest. Corp. v.*
19 *Sardie*, 755 F.2d 719, 723 (9th Cir. 1985)).

20 *1. Likelihood of Success on the Merits*

21 Freecycle argues that it is likely to succeed on the merits. The Lanham Act
22 prohibits the unauthorized use of a "registered mark in connection with the sale . . . or
23 advertising of any goods . . . [where] such use is likely to cause confusion, or to cause
24 mistake, or to deceive." 15 U.S.C. § 1114. Section 43 of the act makes any person who,
25 in connection with the sale of goods, uses any term, name, or symbol in a way that is
26 likely to cause confusion, mistake or to deceive, liable in a civil action to any person
27 damaged by the act. 15 U.S.C. § 1125. In order to establish trademark infringement or
28 unfair competition under the Lanham Act, a plaintiff must show that the defendant "is

1 using a mark similar to a valid, protectable trademark of [plaintiffs]." *Brookfield*
2 *Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999).
3 Freecycle argues that even though its trademark is still pending, it has established a
4 recognizable logo and name that is protectable through over three years of use as well as
5 the USPTO's approval of publication in its Principal Register.

6 Additionally, Freecycle argues that its legitimate trademark rights have been
7 recognized by Defendant when he was associated with The Freecycle Network. This is
8 born out by the record. While Defendant was associated with The Freecycle Network, he
9 actively undertook to protect its trademark and logo. *See* Complaint, Exh. A-C; *see also*
10 Beal Decl. ¶ 8. Then, after his separation from the organization, he began to publicly
11 encourage the disparagement of the Freecycle trademark. *See* Complaint, Exh. D-G; *see*
12 *also* Beal Decl. ¶ 9.

13 All of these factors lead to the conclusion that Plaintiff has a significant chance to
14 succeed on the merits of the case.

15 2. Irreparable Injury

16 Irreparable injury may be presumed by a showing of likelihood of success on the
17 merits of a trademark infringement claim. *El Pollo Loco, Inc. v. Hashim*, 316 F.3d 1032,
18 1038 (9th Cir. 2003). Because The Freecycle Network has shown a likelihood of success
19 on the merits, a preliminary injunction is appropriate as to the trademark claims.

20 3. Balance of Hardships

21 The balance of hardships falls in Freecycle's favor. If a preliminary injunction is
22 granted, then Defendant is merely prohibited from making public comments that could
23 disparage Freecycle's trademark during the pendency of this case. There would be no or
24 very little cost to Defendant of not being able to do this. If the preliminary injunction is
25 not granted then The Freecycle Network could very well suffer loss of goodwill and
26 confusion with respect to its trademark rights (assuming it does in fact have those
27 trademark rights). It is clear though that currently, the balance of hardships clearly falls
28 within Freecycle's favor.

1 **III. CONCLUSION**

2 Accordingly IT IS HEREBY ORDERED that the motion for Preliminary
3 Injunction is GRANTED in Freecycle's Favor. Defendant is prohibited from making any
4 comments that could be construed as to disparage upon Freecycle's possible trademark
5 and logo. Additionally, Defendant IS FURTHER ORDERED to remove all postings
6 from the internet and any other public forums that he has previously made that disparage
7 Freecycle's possible trademark and logo. This Order specifically refers to, but is not
8 limited to, the exhibits used by Freecycle in this case.

9 Finally, IT IS ORDERED that Plaintiff The Freecycle Network, Inc.'s Notice of *Ex*
10 *Parte* Motion and *Ex Parte* Motion for Order to Show Cause Against Defendant Tim Oey
11 Regarding Contempt Due to Failure to Comply with Temporary Restraining Order
12 (Docket # 20) is DENIED. However, Defendant is forewarned that if he refused to
13 comply with the terms of this preliminary injunction and continues to publicly disparage
14 Freecycle's trademark rights and logo then he could be found to be held in contempt of
15 court.

16
17 DATED this 11th day of May, 2006.
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27 

28
Raner C. Collins
United States District Judge

The Freecycle Network, Inc. v. Tim Oey
U.S. District Court
District of Arizona
Exhibit D

Paula
pdspencer@earthlink.com
Be kind to each other.

No virus found in this incoming message.
Checked by AVG Anti-Virus.
Version: 7.0.344 / Virus Database: 267.11.1/104 - Release Date: 9/16/2005

****Step down letter from Paula, the GOA, to Tim.**

----- Original Message -----

From: "Paula" <california@freecycle.org>
To: <oev@post.harvard.edu>
Cc: <deron@freecycle.org>
Sent: Friday, September 16, 2005 12:04 PM
Subject: Trademark Issues

Tim,

>

> As a volunteer representative of The FreecycleT Network you have publicly
> requested that members actively campaign against the organization
> obtaining the Trademark it has filed for. The following are quotes from
> your post:

>

> "The best way to keep freecycle in the public domain is for as many people
> and groups as possible to continue to use the term generically.

>

> If you feel that the term freecycle is generic, you can let the USPTO know
> by sending a letter to:

> Commissioner Of Trademarks" (address followed)

>

> "Yahoo listens to its customers, so if folks complain about groups being
> deleted for use of the term "freecycling" than members/moderators of those
> groups should complain to Yahoo "(email address followed)

>

> This is contrary to the mission of this organization to keep the trademark
> free from external corporate use and solely open to local members of The
> FreecycleT Network. Therefore, I must ask that you step down as the as
> a moderator of the Freecycle Sunnyvale list. I would appreciate your
> cooperation as soon as possible and confirming that you have done so.

>

> Sincerely,

> Paula

>

> All the best,

> Paula

The Freecycle Network, Inc. v. Tim Oey
U.S. District Court
District of Arizona
Exhibit E

- >
 - > Be kind to each other.
 - > www.freecycle.org
 - >
 - > FreecycleT and the FreecycleT logo are trademarks of The FreecycleT
 - > Network in the United States and/or other countries.
 - >
 - > No virus found in this incoming message.
 - > Checked by AVG Anti-Virus.
 - > Version: 7.0.344 / Virus Database: 267.11.1/104 - Release Date: 9/16/2005
-

----- Original Message -----

From: "Paula" <california@freecycle.org>

To: <timcafc@oeyweb.com>; <petritim123@yahoo.com>; <timoev@yahoo.com>

Sent: Friday, September 16, 2005 1:30 PM

Subject: Trademark Issues

Tim,

- >
- > As a volunteer representative of The FreecycleT Network you have publicly
- > requested that members actively campaign against the organization
- > obtaining the Trademark it has filed for. The following are quotes from
- > your post:
- >
- > "The best way to keep freecycle in the public domain is for as many people
- > and groups as possible to continue to use the term generically.
- >
- > If you feel that the term freecycle is generic, you can let the USPTO know
- > by sending a letter to:
- > Commissioner Of Trademarks" (address followed)
- >
- > "Yahoo listens to its customers, so if folks complain about groups being
- > deleted for use of the term "freecycling" than members/moderators of those
- > groups should complain to Yahoo "(email address followed)
- >
- > This is contrary to the mission of this organization to keep the trademark
- > free from external corporate use and solely open to local members of The
- > FreecycleT Network. Therefore, I must ask that you step down as the as
- > a moderator of the Freecycle Sunnyvale list. I would appreciate your
- > cooperation as soon as possible and confirming that you have done so.
- >
- > Sincerely,
- > Paula
- >

Tim Oey <timoe@gmail.com> to Freedomcycle

More options 4:40 am (3 hours ago) Good news -- it is legal for everyone to use the term freecycle, freecycling, freecycler, freecycled, etc -- there are no current viable registered trademark applications that cover the word -- so have fun with it!

1) The trademark application 78415420

(New Media Worlds, Inc.-- International Class: 042 An online service where users are able to give items away for free that they no longer need) Their claim was for just the plain word "freecycle" but it is about to be denied based on abandonment as of a notice sent to this applicant on 8/22/2005.

Read it at: <http://portal.uspto.gov/external/portal/tow>
Serial Number: 78415420

2) The trademark application 78475113

(THE FREECYCLE NETWORK-- International Class: 042 DESIGN, CREATION, HOSTING AND MAINTENANCE OF A FREE WEBSITE THAT PROVIDES OTHERS WITH A GLOBAL INTERNET BASED SYSTEM OF GIVING AND RECEIVING PERSONAL PROPERTY FOR FREE)

This claim was for the freecycle graphic logo only and does not cover the word in standard characters (plain text).

Read all about it at: <http://portal.uspto.gov/external/portal/tow>
Serial Number: 78475113

In particular read the application itself.

Please note that the original application includes a copy of the then current freecycle.org site which uses the word freecycle as freecycling, freecycles, etc.

Plus continued use of the word freecycle as a generic term by everyone will insure that it can never be trademarked by any corporation ever. So I hope you all will do your part to make this so. If you don't trust me, just read up on trademark law yourself or consult your own attorney.

Keep on freecycling!

Cheers,

Tim Oey

Good news -- it is legal for everyone to use the term freecycle, freecycling, freecycler, freecycled, etc -- there are no current viable registered trademark applications that cover the word -- so have fun with

----- Original Message -----

From: Tim Oey
To: freecyclenext@yahoogroups.com
Sent: Wednesday, September 14, 2005 2:03 AM
Subject: [freecyclenext] Gifting "freecycle" to the public

The best way to keep freecycle in the public domain is for as many people and groups as possible to continue to use the term generically.

If you feel that the term freecycle is generic, you can let the USPTO know by sending a letter to:
Commissioner Of Trademarks
P.O. Box 1451
Alexandria, Va. 22313-1451

In your letter, reference registered trademark application 78475113.

Yahoo listens to its customers, so if folks complain about groups being deleted for use of the term "freecycling" than members/moderators of those groups should complain to Yahoo at:
http://add.yahoo.com/fast/help/us/groups/cgi_abuse
or
copyright@yahoo-inc.com

Basically, if you all want something to happen you have to do something about it.

Power to the people...

Cheers,
Tim

- Visit your group "freecyclenext" on the web.
- To unsubscribe from this group, send an email to:
freecyclenext-unsubscribe@yahoogroups.com
- Your use of Yahoo! Groups is subject to the Yahoo! Terms of Service.

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District of Arizona
Exhibit F

We have already successfully defended it from a company in Canada and a company in Florida. We are fortunate to have a great deal of pro bono legal support as an organization from those who believe in us.

However, I was surprised to learn that you are actively not only encouraging moderators to misuse our trademark but also to write the US Patent & Trademark Office to contest our right to the trademark. You went so far as to provide the address and our case number. You have made your position a clear. This position is clearly in stark contrast to the goals of this organization.

I'm sorry that you have chosen this path and hope that you will reconsider. I wish you the best. No doubt you have good intentions in your heart which hopefully will not prove costly for The Freecycle Network as an organization overall down the road.

Sincerely yours,
Deron

Deron Beal
The Freecycle Network

No virus found in this incoming message.

Checked by AVG Anti-Virus.

Version: 7.0.344 / Virus Database: 267.11.3/106 - Release Date: 9/19/2005

----- Original Message -----

From: "Tim Oey" <oeey@post.harvard.edu>

To: "chandan mishra" <chandan@hotmail.com>; "Deron Beal" <deron@freecycle.org>; <freecyclesunnyvale-owner@yahogroups.com>

Cc: <california@freecycle.org>

Sent: Tuesday, September 20, 2005 11:08 AM

Subject: RE: Goodbye

- > Actually on this point, I have encouraged people to
- > use the term freecycle as a generic term which would
- > block The Freecycle Network (TFN), and all others,
- > from holding a trademark on the term in the area of
- > freecycling services offered on the web.
- >
- > This would mean that everyone could use the term
- > freecycle and no one could stop anyone else from using
- > it. There are also lots of other consequences.
- >
- > In consultation with some trademark attorneys, I'm in
- > the process of writing up a more thorough analysis of
- > the pro's and con's of freecycle as a trademark vs
- > freecycle as a generic term.
- >

> The decision to pursue a trademark was made by Deron.
> Most of the network does not know what the
> consequences are of getting a trademark nor the
> consequences of having freecycle be a generic term.
> Deron did not want to allow discussion or voting in
> this space which lead us to the current situation.
>
> Cheers,
> Tim
>
> --- chandan mishra <chandan@hotmail.com> wrote:
>> 4. Also according to Tim, he never encouraged anyone
>> to misuse Freecycle
>> trademark. Could you please point us to instances
>> where he did that?
>
> --
> No virus found in this incoming message.
> Checked by AVG Anti-Virus.
> Version: 7.0.344 / Virus Database: 267.11.3/107 - Release Date: 9/20/2005

The Freecycle Network, Inc. v. Tim Oey
U.S. District Court
District of Arizona
Exhibit G

Yahoo! My Yahoo! Mail Make Yahoo! your home page



Search the Web Search


Groups Home - Help

EXPRESS GOLD
The Power of Debt

\$7500 CREDIT CARD
Free Enrollment

NO CREDIT CHECKS
NO ANNUAL FEES
FREE GREAT LIMIT INCREASE
NO EMPLOYMENT VERIFICATION

SIGNUP TODAY
CLICK HERE



Group Member - Edit Membership

Start a Group | My Groups

fcnext - Free Recycling - The Next Generation

- Home
- Messages
- Post
- Chat
- Files
- Photos
- Links
- Database
- Polls
- Calendar
- Promote

Messages Help

Go

Message #

Search:

Go

Post Message

Up Thread | Message Index | View Source | Unwrap Lines

Message 3171 of 4099 < Previous Message | Next Message >

From: Tim Oey <timoey@...>
 Date: Thu Feb 23, 2006 9:55 am
 Subject: Let your voices be heard...

- reduce_reuse...
- Offline
- Send Email
- Invite to Yahoo! 360°

Reply

Forward

Many of us know that TFN is already a bit crazy in trying to clamp down on free speech freedoms, but now is a great time to further the cause and keep freecycle free for everyone forever (and drive TFN even crazier).

What you can do on your own:

- Using TFN's directory, please contact all the freecycle groups in your state and surrounding states to let them know that freecycle is a generic term. Ask them to visit <http://greenribbon.us> for more information. There is no need to be that organized about it but if you think you have a state well covered, please post a note to fcnext. You'll need to dribble the mails out a few at a time and by as many people as possible to get around Yahoo's intricate group owner spam catchers. Make all your emails unique -- don't repeat exactly the same contents

Yahoo! Groups Tips

Did you know...
 You can create an FAQ
 for your group?

Yahoo! 360°

Keep connected to your friends and family through blogs, photos and more. Create your own 360° page now.

or subject, etc.

2) If you currently have a group within TFN, either take it out of TFN and tell all your members that freecycling should stay free or do comply initially with TFN's request so that your group is not deleted but then later sprinkle freecycling around your group and other groups so the free grassroots movement continues to be free (this is likely to really drive TFN nuts). Let more people know about <http://greenribbon.us>

3) Do give TFN GOAs a hard time because they are doing bad things by limiting free speech. Free speech is very important. Let everyone know that TFN does not need to control freecycling for TFN to be successful.

4) Get your freecycling is free statements to Eric for posting on <http://greenribbon.us>







5) Let others know that freecycling is a wonderful thing that people can do via Google, Craigslist, Yahoo Groups, any email list, or however they wish -- even just leaving stuff out on the curb with a "Free" or "Freecycle this" note attached.

Spread the word and let the word be free.

Enjoy!

Cheers,
Tim

Replies	Author	Date
3190	If I told ya.... belhaven_jass	Feb 23, 2006 5:18 pm
	Re: Let your voices be heard... I don't think any of that is a good idea. Why not let the courts decide if? By...	

3314	<p>..... Re: Let your voices be heard... Hi Lass, The courts will get to it eventually. How is encouraging others to...</p>	<p>Tim Oey reduce_reuse...  </p>	<p>Feb 26, 2006 11:00 pm</p>
3336	<p>..... Re: Let your voices be heard... i second tim's post...educating others is a necessity in any grassroots ...</p>	<p>xlina (freecycle mode... existentialista  </p>	<p>Feb 27, 2006 5:11 am</p>
3348	<p>..... Re: Let your voices be heard... I think I've made my intent known when it comes to FreeSpeech :-) FreeCyclo</p>	<p>Free cycle Recycle freecycos  </p>	<p>Feb 27, 2006 6:47 am</p>

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