

JURISDICTION SUBGROUP ICANN LITIGATION SUMMARY v2

Reviewed by:	Raphael Beauregard-Lacroix
Name of Case:	Schreiber v Dunabin et al
Parties: ¹	Graham Schreiber (Plaintiff) Defendants: A: Lorraine Dunabin (main defendant) B: CentralNIC (registry .uk.com) C: Verisign (registry .com) D: ICANN E: eNOM/Demand Media (registrar) F: Network Solutions (registrar)
Citizenship of Parties:	Plaintiff: Canada Def. A, B: UK Def. C-F: US
Court/Venue:	US District Court (Eastern District of Virginia)
Choice of Law provision in contract; if so, which jurisdiction?:	Unknown/not relevant in this case
Law used to determine conflict of laws issues (i.e., which law applies)	Not relevant in this case
Substantive Law Governing the Dispute:	US Law
Date Case Began:	31 July 2012
Date Case Ended:	5 October 2015 (writ of mandamus denied following refusal by the Court of Appeal to hear the appeal, as the notice of appeal was filed too late.)
Causes of Action:	Primary and contributory trademark infringement of <i>Landcruise Ltd.</i> , a Canadian company. However these claims are moot, since what Schreiber actually asserts is trademark infringement by a UK company. All the US defendants are contributory defendants. Neither him nor Lorraine Dunabin have recognized trademarks in the US at the time of the complaint, hence the dismissal of the complaint for failure to state a claim and lack of subject matter jurisdiction (extraterritorial application of the <i>Lanham Act</i> is denied)

¹ Indicate whether each party is Plaintiff (P) or Defendant (D), or other status. Please also list non-party participants, such as Amicus Curiae (AC).

Issues Presented:	Extraterritorial application of the <i>Lanham Act</i> . US Trademark law may be applied extraterritorially. However, the following test must be satisfied: “(1) the defendant’s conduct has a significant effect on United States commerce; (2) the defendant is a citizen of the United States; and (3) issuance of an injunction would interfere with trademark rights under the relevant foreign law, making issuance of the injunction inappropriate in light of international comity concerns.” Neither of these are satisfied in this case.
Preliminary Relief?:	None
Relief Requested by Plaintiff	Unclear; injunction against Dunabin and the other defendants.
Outcome/Relief Granted:	Dismissal of all claims (including “remaining state law claims,”) for lack of subject matter jurisdiction and failure to state a claim. -“The Court grants Defendants’ Motions to Dismiss Plaintiffs Complaint for lack of subject matter jurisdiction against Dunabin because Dunabin’s alleged infringing acts occurred outside of the United States and concern marks that have not been used or registered in the United States.” (p.7) -the Court grants Defendants’ Motions to Dismiss Plaintiffs Complaint for failure to state a claim because Plaintiff fails to plead facts that plausibly establish he has recognized trademark rights in the United States that can be infringed, either directly or contributorily. (p.7)
Was Jurisdiction Contested? ²	Yes (subject matter)
Relevance to WG mandate	None, to the extent that the petition was borderline frivolous
Impact on ICANN accountability/operations: ³	None
Impact if case were decided for the other party?	It is hard to imagine it would ever have been, as there are many legal hoops one must go through before managing to make ICANN liable for contributory trademark infringement in domain name matters, including clear statutory provisions in favour of ICANN (including the “Safe Harbour” of the Lanham Act)
Did the Court comment on the merit, lack of merit and/or frivolity of the plaintiff’s claim?	Yes (see above)
Key Documents:	District Court decision, 24 March 2013 (Case No. 1:12-cv-852 (GBL-JFA), not on ICANN’s website but available online)

² For example, challenge to venue, challenge to change of venue, challenge to governing law, challenge to application of “choice of law” provision. Please describe the outcome as well as the challenge.

³ Indicate whether the case had or will have an effect on ICANN’s accountability mechanisms or the operation of ICANN’s policies..

