

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO. 23-62077-CIV-COHN

STEPHEN M. GAFFIGAN, an individual, and
STEPHEN M. GAFFIGAN, P.A., a Florida
corporation

Plaintiffs,

vs.

THE INDIVIDUAL, BUSINESS ENTITY,
OR UNINCORPORATED ASSOCIATION
OPERATING THE DOMAIN NAMES,
STEPHENMGAFFIGANPA.COM and
ATTORNEYSTEPHENMGAFFIGANPA.COM,
and THE INDIVIDUAL, BUSINESS ENTITY,
OR UNINCORPORATED ASSOCIATION
OPERATING UNDER THE FACEBOOK
SOCIAL MEDIA IDENTITY, STEPHEN M.
GAFFIGAN PA,

Defendants.

**ORDER GRANTING APPLICATION FOR
ENTRY OF TEMPORARY RESTRAINING ORDER AND SETTING
HEARING ON MOTION FOR PRELIMINARY INJUNCTION**

THIS CAUSE is before the Court upon Plaintiffs' Application for Entry of Temporary Restraining Order and Preliminary Injunction [DE 5] ("Application"). The Court has considered the Application and is otherwise fully advised in the premises. For the reasons discussed herein, the Court will grant the Application and adopt Plaintiffs' Proposed Temporary Restraining Order.

Plaintiffs, Stephen M. Gaffigan ("Gaffigan"), an individual, and Stephen M. Gaffigan, P.A., a Florida corporation ("SMGPA") (collectively, "Plaintiffs") move, pursuant to 15 U.S.C. § 1116, Fed. R. Civ. P. 65, The All Writs Act, 28 U.S.C. § 1651(a), Florida

Statutes §§ 540.08, 501.211(1), and this Court's inherent authority, for entry of a temporary restraining order against Defendants,¹ and upon expiration of that order, a preliminary injunction against Defendants, for alleged violations of 15 U.S.C. § 1125(a), Florida Statutes §§ 540.08, 501.204, common law unfair competition, and common law right of publicity and unauthorized publication of name or likeness.

I. FACTUAL BACKGROUND

The Court bases this Order on the following facts from Plaintiffs' Complaint, Application, and supporting evidentiary submissions:

1. Gaffigan is a successful and well-regarded attorney, whose entire legal practice is devoted to anticounterfeiting litigation. See DE 5-1 ¶ 4. As a result of his reputation, Gaffigan's name, image, likeness, and persona (collectively "Gaffigan's Name") hold significant commercial value. See id. Gaffigan is the exclusive owner of the rights to his name, image, likeness, and persona. See id.

2. Gaffigan's firm, SMGPA, provides intellectual property related services and is also well-regarded in the field of anti-counterfeiting. See id. ¶ 5. SMGPA uses "Stephen M. Gaffigan, P.A." and "SMGPA" (collectively, the "SMGPA Marks") in connection with its provision of legal services and owns common law trademark rights in the SMGPA Marks. See id. ¶ 6.

3. Defendants control the websites under the domain names stephenmgaffiganpa.com and attorneystephenmgaffiganpa.com (the "Subject Domain

¹ Defendants are the Individual, Business Entity, or Unincorporated Association operating under the domain names, stephenmgaffiganpa.com and attorneystephenmgaffiganpa.com, and the Individual, Business Entity, or Unincorporated Association operating under the Facebook social media identity, Stephen M. Gaffigan PA, both identified on Schedule "A" attached to the Application. All references to Schedule "A" in this Order shall refer to docket entry 5, page 22.

Names”) and associated e-mail addresses (the “E-mail Accounts”), and the social media identity operating under the Facebook Account “Stephen M. Gaffigan PA” (the “Social Media Account”), as identified on Schedule “A.” See DE 5-1 ¶ 8.

4. Defendants misappropriate Gaffigan’s Name and the related firm names by promoting, marketing, advertising, offering to sell and/or selling fictitious intellectual property related legal services (“Impersonated Legal Services”) and by falsely suggesting Gaffigan is associated with such services. See DE 1 ¶ 12. Moreover, Defendants are using Gaffigan’s Name and the associated firm names to fraudulently assert lawsuits and claims against third parties. See id.

5. Defendants are not now, nor have they ever been authorized or licensed to use the SMGPA Marks or Gaffigan’s name, image, likeness, and/or persona for any purpose. See DE 5-1 ¶¶ 14-15.

6. Defendants are using Gaffigan’s Name and the SMGPA Marks to create the false impression that Plaintiffs are affiliated with Defendants and involved in the provision of the Impersonated Legal Services. See id. ¶¶ 8-15. Defendants achieve this by prominently displaying the SMGPA Marks and Gaffigan’s Name within the Subject Domain Name, E-mail Accounts, and Social Media Account. See id. ¶ 9.

7. Defendants have fabricated fake legal documents and sent them to various brand owners via email. See id. ¶ 10. These fake legal documents used the SMGPA Marks and Gaffigan’s Name and forged signature to persuade recipients that Plaintiffs either prepared and sent or are associated with the fake legal documents. See id.

II. LEGAL STANDARD

To obtain a temporary restraining order, a party must demonstrate “(1) a substantial likelihood of success on the merits; (2) that irreparable injury will be suffered if the relief is not granted; (3) that the threatened injury outweighs the harm the relief would inflict on the non-movant; and (4) that the entry of the relief would serve the public interest.” Schiavo ex. rel Schindler v. Schiavo, 403 F.3d 1223, 1225–26 (11th Cir. 2005); see also Levi Strauss & Co. v. Sunrise Int’l. Trading Inc., 51 F. 3d 982, 985 (11th Cir. 1995) (applying the test to a preliminary injunction in a Lanham Act case).

III. ANALYSIS

The declaration Plaintiffs have submitted in support of their Application support the following conclusions of law:

A. Plaintiffs have a strong probability of proving at trial that Defendants are engaged in a false endorsement advertising campaign that deliberately and intentionally misappropriates Gaffigan’s Name and the related firm names and that consumers are likely to be confused by Defendants’ online marketing campaign.

B. Because of the false association campaign, Plaintiffs are likely to suffer immediate and irreparable harm if a temporary restraining order is not granted. It clearly appears from the following specific facts, as set forth in Plaintiffs’ Complaint, Application for Temporary Restraining Order, and accompanying declarations on file, that immediate and irreparable loss, damage, and injury will result to Plaintiffs and to consumers if a temporary injunction is not granted:

1. Defendants control and operate the Social Media Account and/or the fully interactive Internet websites operating under the Subject Domain Names without

authorization, misappropriate Gaffigan's Name and related firm names to create the false impression that Plaintiffs are affiliated with and endorse the Impersonated Legal Services; and

2. There is good cause to believe that more false representations bearing Gaffigan's Name and related firm names will appear online; that consumers are likely to be misled, confused, and potentially suffer from the unnecessary expenditure of legal fees; and that Plaintiffs may continue to suffer harm to their reputation.

C. The potential harm to Defendants in granting Plaintiffs' injunction enjoining their unauthorized use of Gaffigan's Name and related firm names is far outweighed by the continuing harm to Plaintiffs, their goodwill and reputation, and the consuming public, if such relief is not issued.

D. The public interest favors issuance of the temporary restraining order to protect Plaintiffs' rights in Gaffigan's Name, the related firm names, the SMGPA Marks, and their reputation, and to protect the consuming public against continued deception.

IV. CONCLUSION

For the foregoing reasons, it is **ORDERED AND ADJUDGED** that pursuant to 15 U.S.C. § 1116, Federal Rule of Civil Procedure 65, 28 U.S.C. § 1651(a), and the Court's inherent authority, Plaintiffs' Application for Temporary Restraining Order [DE 5] is hereby **GRANTED** as follows:

(1) Each Defendant, its officers, directors, employees, agents, subsidiaries, distributors, and all persons in active concert or participation with any Defendant having notice of this Order are temporarily restrained from using Gaffigan's name, image,

likeness, or persona, related firm names, and the SMGPA Marks in any advertising, marketing, promoting, offering to sell, and/or selling, or any services;

(2) Each Defendant, its officers, directors, employees, agents, subsidiaries, distributors, and all persons in active concert or participation with any Defendant having notice of this Order shall immediately discontinue the use of Gaffigan's name, image, likeness, or persona, related firm names, and the SMGPA Marks, on or in connection with all Internet websites and domain names, email addresses, and social media accounts owned and operated, or controlled by them, including Subject Domain Names and associated Internet websites, E-mail Accounts, and Social Media Account identified in Schedule "A";

(3) Each Defendant, its officers, directors, employees, agents, subsidiaries, distributors, and all persons in active concert or participation with any Defendant having notice of this Order shall immediately discontinue the use of Gaffigan's name, image, likeness and/or persona, related firm names, and the SMGPA Marks within domain name extensions, metatags, or other markers within website source code, from use on any webpage (including as the title of any web page), from any advertising links to other websites, from search engines' databases or cache memory, and any other form of use of such terms that are visible to a computer user or serves to direct computer searches to websites and social media accounts registered, owned, or operated by any Defendant, including the websites and social media account operating under the Subject Domain Names and Social Media Account;

(4) Each Defendant shall not transfer ownership of the Internet websites operating under their Subject Domain Names, E-mail Accounts, or the Social Media

Account identified in Schedule "A" during the pendency of this action, or until further order of the Court;

(5) Each Defendant shall preserve copies of all computer files relating to the use of any of the Subject Domain Names and Social Media Account, and shall take all steps necessary to retrieve computer files relating to the use of the Subject Domain Names and Social Media Account that may have been deleted before the entry of this Order;

(6) Upon Plaintiffs' request, the privacy protection service for any of the Subject Domain Names and Social Media Account for which the registrant uses such privacy protection service to conceal the registrant's identity and contact information is ordered to disclose to Plaintiffs the true identities and contact information for those registrants;

(7) Upon entry of this Order, Plaintiffs shall provide a copy of the Order by e-mail to the registrar of record for each of the Subject Domain Names. The registrar of record for each of the Subject Domain Names shall immediately lock each of the Subject Domain Names; shall notify each registrant of record of the Order; and shall provide notice of the locking of the domain name to the registrant of record. Plaintiffs shall also provide a copy of this Order to the registrars and the registries for the Subject Domain Names for the purposes described in Paragraph 8, below;

(8) The domain name registrars for the Subject Domain Names shall immediately assist in changing the registrar of record for the Subject Domain Names to a holding account with a registrar of Plaintiffs' choosing (the "New Registrar"), excepting any such domain names which such registrars have been notified in writing by Plaintiffs have been or will be dismissed from this action, or as to which Plaintiffs have withdrawn

their request to immediately transfer such domain names. To the extent the registrars do not assist in changing the registrars of record for the domains under their respective control within one business day of receipt of this Order, the top-level domain (TLD) registries, for the Subject Domain Names, or their administrators, including backend registry operators or administrators, within five business days of receipt of this Order, shall change, or assist in changing, the registrar of record for the Subject Domain Names to a holding account with the New Registrar, excepting any such domain names which such registries have been notified in writing by Plaintiffs have been or will be dismissed from this action, or as to which Plaintiffs have withdrawn their request to immediately transfer such domain names. Upon the change of the registrar of record for the Subject Domain Names, the New Registrar will maintain access to the Subject Domain Names in trust for the Court during the pendency of this action. Additionally, the New Registrar shall immediately institute a temporary 302 domain name redirection which will automatically redirect any visitor to the Subject Domain Names to the following Uniform Resource Locator ("URL") <http://servingnotice.com/GX1c0windex.html>, whereon copies of the Complaint, this Order, and all other documents on file in this action shall be displayed. Alternatively, the New Registrar may update the Domain Name System ("DNS") data it maintains for the Subject Domain Names, which link the domain names to the IP addresses where their associated websites are hosted, to NS1.MEDIATEMPLE.NET and NS2.MEDIATEMPLE.NET, which will cause the domain names to resolve to the website where copies of the Complaint, this Order, and all other documents on file in this action shall be displayed. After the New Registrar has effected this change, the Subject Domain

Names shall be placed on lock status by the New Registrar, preventing the modification or deletion of the domains by the New Registrar or Defendants;

(9) Upon Plaintiffs' request, any Internet website operators and/or administrators who are provided with notice of this Order shall remove any and all listings and associated images of services bearing and/or using Plaintiffs' trademarks, name, likeness, and/or persona via the Subject Domain Names and Social Media Account, and upon Plaintiffs' request, any other listings and images of services bearing and/or using Plaintiffs' trademarks, name, likeness, and/or persona associated with or linked to any other domain names, e-mail accounts, and social media accounts being used and/or controlled by Defendants to promote, market, advertise, offer for sale and/or sell services bearing and/or using Plaintiffs' trademarks, name, likeness, and/or persona;

(10) Upon Plaintiffs' request, any Internet website operators and/or administrators who are provided with notice of this Order shall cease hosting, facilitating access to, or providing any supporting service to any and all websites and social media accounts owned and operated by Defendants, including the Subject Domain Names and Social Media Account;

(11) This Order shall apply to the Subject Domain Names and associated websites, E-mail Accounts, and Social Media Account, and any other domain names, websites, e-mail accounts, and social media accounts which are being used by Defendantss for the purpose of misappropriating Gaffigan's name, image, likeness and/or persona and related firm names and the SMGPA Marks;

(12) As a matter of law, this Order shall no longer apply to any Defendant or associated domain name dismissed from this action or as to which Plaintiffs have withdrawn their request for a temporary restraining order;

(13) This Order shall remain in effect until the date for the hearing on the Motion for Preliminary Injunction, or until such later dates as set by the Court or stipulated to by the parties;

(14) Pursuant to 15 U.S.C. § 1116(d)(5)(D) and Federal Rule of Civil Procedure 65(c), Plaintiffs shall post a bond in the amount of \$10,000.00, as payment of damages to which Defendants may be entitled for a wrongful injunction, during the pendency of this action, or until further Order of the Court. In the Court's discretion, the bond may be subject to increase should an application be made in the interest of justice;

(15) Plaintiffs shall serve copy of this Order on each Defendant via their corresponding e-mail address and/or online contact provided on the websites operating under the Subject Domain Names and the Social Media Account, or by providing a copy of this Order by e-mail to the registrar of record for the Subject Domain Names or the social media platform operator for the Social Media Account so that the registrar and social media platform, in turn, notifies each Defendant of the Order, or by other means reasonably calculated to give notice which is permitted by the Court. In addition, Plaintiffs shall post a copy of this Order on the website located at <http://servingnotice.com/GX1c0windex.html> and shall provide the address to the website to Defendants via e-mail/online contact form, and such notice so given shall be deemed good and sufficient service thereof. Plaintiffs shall continue to provide notice of these proceedings and copies of the documents on file in this matter to Defendants by regularly

updating the website located at <http://servingnotice.com/GX1c0windex.html>, or by other means reasonably calculated to give notice which is permitted by the Court;

(16) A hearing before this Court is **SET for Thursday, November 16, 2023, at 10:00 a.m.**, in Courtroom 203E of the United States Courthouse, 299 East Broward Boulevard, Fort Lauderdale, Florida. At the hearing, Defendants and/or any other affected persons may challenge the appropriateness of this Order and move to dissolve the same, and the Court will hear argument on Plaintiffs' Motion for Preliminary Injunction;

(17) Additionally, for the purpose of providing additional notice of this proceeding, and all other pleadings, orders, and documents filed herein, the website operators and/or administrators for the Subject Domain Names and/or Social Media Account, including but not limited to, Facebook.com, and its related companies and affiliates shall, at Plaintiffs' request, provide Plaintiffs' counsel with any e-mail address known to be associated with Defendants' respective Subject Domain Names and/or Social Media Account;

(18) No later than **noon on November 13, 2023**, Defendants or any other affected persons shall file with the Court and serve on Plaintiffs' counsel any Response to Plaintiffs' Motion for Preliminary Injunction. Plaintiffs shall file and serve any Reply no later than **noon on November 15, 2023**. These dates may be revised upon stipulation by all parties and approval of the Court;

(19) No later than **noon on November 14, 2023**, Plaintiffs, Defendants, or any other affected persons shall file Witness Lists identifying any witnesses that the parties expect to call at the preliminary-injunction hearing. At the option of the parties, direct

testimony may be submitted in the form of written affidavit; however, all affiants will be subject to live cross examination at the hearing;

(20) Also no later than **noon on November 14, 2023**, Plaintiffs, Defendants, and/or any other affected persons shall file Exhibit Lists identifying any exhibits that the parties intend to introduce at the preliminary-injunction hearing. All exhibits shall be pre-labeled in accordance with the proposed Exhibit Lists. Exhibit labels must include the case number; and

(21) **Defendants are hereby notified that if they do not timely respond to Plaintiffs' Motion for Preliminary Injunction and do not appear at the scheduled hearing, the Court may enter a preliminary injunction against them by default.**

DONE AND ORDERED in Chambers at Fort Lauderdale, Broward County, Florida, on this 2nd day of November, 2023.



JAMES I. COHN
United States District Judge

Copy Provided:
Counsel of record via CM/ECF