

**United States District Court
District of Minnesota**

Lawyerist Media, LLC,

Plaintiff,

v.

PeerViews, Inc.,

Defendant.

Court file no. _____

Complaint

JURY TRIAL DEMANDED

Introduction

Lawyerist seeks a declaration of non-infringement and cancellation of the trademarks “SmallLaw” and “BigLaw” registered by PeerViews, which are registered in violation of the Lanham Act, 15 U.S.C. §§ 1051–1127. These marks are generic and descriptive.

Jurisdiction and Venue

1. This Court has jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 2201.
2. Minnesota is the appropriate venue and jurisdiction because Lawyerist is located in Minnesota, because any potentially infringing use of the SmallLaw or BigLaw trademarks has or will occur in Minnesota, and because the Defendant mailed a letter threatening legal action to Minnesota, directed at a Minnesota entity, with the successful intent of causing an action (or reaction) in Minnesota. Therefore, under the Minnesota Long-Arm Statute, Minn. Stat. § 543.19, and under the Due

Process Clause of the United States Constitution, Minnesota is the proper jurisdiction and venue for the resolution of this dispute.

3. PeerViews has sufficient contacts with the state of Minnesota that the exercise of jurisdiction over it by this Court is proper and does not offend any traditional notions of fair play or substantial justice.

Parties

4. Lawyerist is a Minnesota limited-liability company with its principal place of business in Minneapolis, Minnesota.

5. PeerViews, Inc., is a Delaware corporation with its principal place of business in New York, New York.

Factual Allegations

Origin and registration of the terms SmallLaw and BigLaw

6. Two opposite ends of the law firm size spectrum—big law firms and small law firms (including solo practitioners)—have long been identified by the terms “big law” or “BigLaw” and “small law” or “SmallLaw,” with various capitalizations.

7. There are numerous examples of the use of these terms, both online and offline, extending back for years. These terms are generic terms referring to small and large law firms, and therefore may not be monopolized by any particular legal commentator as a source identifier.

8. Despite the lengthy history of third-party use of BigLaw and SmallLaw, PeerViews filed trademark applications for those terms in October 2008 with the actual or constructive knowledge that it had no right to monopolize these terms in the relevant marketplace.

9. PeerViews filed a trademark application for SmallLaw on October 23, 2008, which resulted in a federal registration on August 10, 2010. *See* U.S. Trademark Reg. No. 3,832,551.

10. PeerViews filed a trademark application for BigLaw on October 28, 2008, which resulted in a federal registration on February 9, 2010. *See* U.S. Trademark Reg. No. 3,747,924.

*Use of SmallLaw and BigLaw on Lawyerist,
and allegation of infringement by PeerViews*

11. Lawyerist operates a website, lawyerist.com, through which it offers information and related products and services to attorneys at both small and large law firms.

12. In the course of its business, Lawyerist must use the phrase “small law” and the term SmallLaw to describe small law firms and solo practitioners, which are a substantial part of its market, subscribers, and customers. Lawyerist must also use the phrase “big law” and the term BigLaw to refer to another substantial part of its market, subscribers, and customers.

13. Lawyerist has published numerous articles with the terms [SmallLaw](#) and [BigLaw](#).

14. On February 15, 2011, Lawyerist published an article entitled [Above the Law Goes Small Law](#), by Gyi Tsakalakis, about a new column with a focus on small law firms, published by the blog [Above the Law](#), written by [Jay Shepherd](#).

15. On February 24, 2011, Fish & Richardson (a BigLaw intellectual property firm) sent a letter to Lawyerist demanding that it delete the *Above the Law Goes Small Law* article within 7 days because it was “nearly identical” to its client’s alleged trademark, SmallLaw.

16. Fish & Richardson further demanded that Lawyerist stop using the phrase “small law” in the future.

*The use of “small law” does not
infringe on PeerViews’s trademark*

17. The words *small* and *law*, when used next to one another as a descriptive identifier of small law firms and solo practices, do not constitute an infringement of PeerViews’s alleged rights in the term SmallLaw, if it has any.

18. To the extent the SmallLaw and BigLaw trademarks are valid (which plaintiff claims is not at all), Lawyerist’s use is non-infringing. BigLaw and

SmallLaw are not valid trademarks, but even if they were, Lawyerist's use could not possibly be deemed as an infringement, as a matter of law.

*SmallLaw and BigLaw are
generic or descriptive terms*

19. Under the Lanham Act, the terms SmallLaw and BigLaw are descriptive to the point of being generic, and therefore may not be registered as enforceable trademarks.

20. The fact is, SmallLaw and BigLaw are common terms, used by many writers—and bloggers—to describe small and large law firms and the collective universe of small firms and small firm practice and big firms and big firm practice, respectively.

21. Past uses of SmallLaw and BigLaw include the following, which are just a sampling:

- a. Since 2000, the New York Times: [*I Am Lawyer, Hear Me Whine*](#) (“If BIGLAW DC does not react with major raises, I guarantee you that BIGLAW DC will face a brain drain.”).
- b. Since 2004, Crime and Federalism: [*Dollars and deals*](#) (“A [sic] ex-law professor of mine said that his large Los Angeles law firm allowed its associates to work, for 6-weeks at full BigLaw pay, for the LA County DA's office.”).

- c. Since 2006, Above the Law: [SmallLaw Reversed Perk Watch: Don't cry over the Kleenex](#); [Another Judge Leaves for Greener Pastures](#) (“Sounds like the transition to Biglaw partner will be pretty easy for Mukasey.”).
 - d. Also since 2006, Legal Blog Watch: [Triumph of the Competent Masochists?](#) (“The problem is that most of us simply don't view BigLaw partnership as worth the price.”) quoting [Adam Smith, Esq.](#)
 - e. Since 2007, [BigLawBoard.com](#).
 - f. Also since 2007, Simple Justice: [Take a \(Salary\) Hike!](#) (“[F]irst year associates at “biglaw” are paid more than judges.”).
 - g. Since 2008, the Wall Street Journal: [Law School Rankings Reviewed to Deter ‘Gaming’](#) (“[A] higher U.S. News rank doesn't always translate into better “BigLaw” job prospects.”); [Fen-Phen Lawyer Trial: Gallion’s Former Associate Testifies](#) (“For working on the Fen-Phen settlement, David Helmers — a Kentucky SmallLaw associate fresh out of law school — received a \$3 million bonus, and a new car.”).
22. Nobody “owns” these terms any more than any one company can claim a monopoly on a phrase like “Big Business.”

23. PeerView's registration of the two trademarks was illegitimate *ab initio*. This was an attempt by one company to grab a common term and to attempt to appropriate it under the apparent mistaken impression that trademarks are "word patents" and not designators of the source or origin of goods.

24. PeerViews's use of the purported trademarks SmallLaw and BigLaw is an attempt to silence the competition and force them and their products out of the marketplace.

25. PeerViews is attempting to impoverish the English language by laying proprietary claim to common, ordinary words and assert that others cannot use those words in their normal context.

26. Senator Patrick Leahy has commented on such uses of trademarks in the past and identified them as abusive:

I am concerned that large corporations are at times abusing the substantial rights Congress has granted them in their intellectual property to the detriment of small businesses [. . .] We saw a high-profile case like this in Vermont last year involving a spurious claim against Rock Art Brewery. When a corporation exaggerates the scope of its rights far beyond a reasonable

interpretation in an attempt to bully a small business out of the market, that is wrong.¹

27. There can be no clearer example of trademark abuse than this one, in which a business is attempting to assert trademark rights over a commonly-used term, especially because that term was used in its commonly-understood sense.

Summary

28. In the face of PeerViews's abusive use of its purported trademarks, Lawyerist seeks declaratory relief and a cancellation of PeerViews's SmallLaw and BigLaw trademark registrations.

Trial by Jury

29. Plaintiff is entitled to and hereby respectfully demands a trial by jury.

Count 1: Declaratory Relief

30. Lawyerist incorporates and re-alleges the preceding paragraphs.

¹ Leahy, Patrick, U.S. Senator for Vermont, [*Leahy to Introduce Bill to Ease Burdens on Trademark Owners*](#) (1.26.2010).

31. PeerViews claims Lawyerist's use of the phrase "small law" constitutes trademark infringement, and has threatened to bring a lawsuit against Lawyerist on this basis.

32. Lawyerist's ongoing use of the terms SmallLaw and BigLaw in its capacity as a media outlet commenting on the legal industry are likely to result in further claims of trademark infringement by PeerViews.

33. An actual, present, and justiciable controversy has arisen between Lawyerist and PeerViews concerning Lawyerist's right to use the phrase "small law" and the terms SmallLaw and BigLaw in commerce or otherwise.

34. Lawyerist seeks a declaration from this Court that its use (and similar use by others) of the phrase "small law" and the terms SmallLaw and BigLaw does not constitute trademark infringement of any kind.

**Count 2:
Cancellation of SmallLaw Trademark**

35. Lawyerist incorporates and re-alleges the preceding paragraphs.

36. PeerViews's purported trademark SmallLaw is the generic name of the goods and services for which it is registered, and is not protectable as a registered trademark.

37. In the alternative, PeerViews's purported trademark SmallLaw is merely descriptive, without the adequate secondary meaning required to support a valid trademark registration.

38. The phrase "small law" and its variants, including SmallLaw, are so widely used in sources of information and other products in the relevant marketplace that any claim PeerViews has to SmallLaw as a unique trademark, particular to its goods or services, cannot be supported.

39. The phrase "small law" and its variants are so widely used to describe the ingredients, qualities, characteristics, functions, features, purposes, or uses of the goods and services claimed by PeerViews in connection with its purported trademark SmallLaw, and PeerViews has developed so little (if any) secondary meaning or acquired distinctiveness in the term, that any claim PeerViews has to SmallLaw as a unique trademark, particular to its goods or services, cannot be supported.

40. SmallLaw was always or has become generic or merely descriptive, and cancellation of PeerViews's registration is warranted pursuant to 15 U.S.C. § 1064.

**Count 3:
Cancellation of BigLaw Trademark**

41. Lawyerist incorporates and re-alleges the preceding paragraphs.

42. PeerViews's purported trademark BigLaw is the generic name of the goods and services for which it is registered, and is not protectable as a registered trademark.

43. In the alternative, PeerViews's purported trademark BigLaw is merely descriptive, without the adequate secondary meaning required to support a valid trademark registration.

44. The phrase "big law" and its variants, including BigLaw, are so widely used in sources of information and other products in the relevant marketplace that any claim PeerViews has to BigLaw as a unique trademark, particular to its goods or services, cannot be supported.

45. The phrase "big law" and its variants are so widely used to describe the ingredients, qualities, characteristics, functions, features, purposes, or uses of the goods and services claimed by PeerViews in connection with its purported trademark BigLaw, and PeerViews has developed so little (if any) secondary meaning or acquired distinctiveness in the term, that any claim PeerViews has to SmallLaw as a unique trademark, particular to its goods or services, cannot be supported.

46. BigLaw was always or has become generic or merely descriptive, and cancellation of PeerViews's registration is warranted pursuant to 15 U.S.C. § 1064.

Prayer for Relief

Lawyerist seeks the following relief:

- a. A declaration that Lawyerist's use of the phrase "small law" and the terms SmallLaw and BigLaw does not infringe on PeerViews's trademarks;
- b. Cancellation of the trademarks SmallLaw and BigLaw;
- c. Costs of litigation and reasonable attorney fees; and
- d. Such other and further relief as this Court deems just and proper.

The Glover Law Firm, LLC

March 16, 2011

Date

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