

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

Case #09-82448-CIV-RYSKAMP/VITUNAC

Robert C. Lewin & Broward Rehab
Center, Inc.,

Plaintiff,

vs.

Rafael Foss, et al.,

Defendant.

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PRELIMINARY INJUNCTION

THIS CAUSE came before the Court on the Plaintiffs', Robert C. Lewin ("Lewin" or "Mr. Lewin") and Broward Rehab Center Inc., ("BRC") (Lewin and BRC, collectively "Plaintiffs") Motion for Preliminary Injunction [DE 4] (the "Motion") against Defendants Rafael Foss, 888-444-PAIN, Inc. and Accident and Wellness Centers, LLC (collectively, "Defendants"), Plaintiffs' Memorandum of Law [DE 5] in Support of Plaintiff's Motion for Preliminary Injunction, the Declaration [DE 6] of Dr. Robert Lewin, the Declaration [DE 7] of Dr .Barry Raxenberg, Plaintiffs' Response [DE 21] in opposition to the motion for preliminary injunction, Plaintiffs' Reply [DE 28] in support of the Motion, and the oral argument, evidence, and testimony presented before this Court at the hearing on the motion held on March 11, 2010. The Court having reviewed the record, and being duly advised in the premises, makes the following Findings of Fact and Conclusions of Law:

Mr. Lewin is the current owner of United States Service Mark 411PAIN, Registration No. 2,621,497, for "advertising agency services and providing medical information in the field of

pain and general health care services” with a date of first use of July 1, 1996 and a registration date of September 17, 2002. This registration is valid and subsisting and in full force and effect and has been promoted throughout the United States.

As early as November 1997, Mr. Lewin obtained a license for the toll free number 800-411-7246 and began advertising this number along with the mark 800-411PAIN, an open and visible use of the registered 411PAIN mark in the telephone number.

411PAIN and 800-411PAIN were promoted as the brand identifiers for advertising agency services, health care services, medical information services and general accident recovery information services in various advertising media in the South Florida area and currently, throughout the United States.

In 1998, Mr. Lewin obtained the domain 411PAIN.COM, an open and visible use of the 411PAIN mark in a domain name, to advertise the hotline and the other services being offered by Mr. Lewin and Broward Rehab.

Broward Rehab has used the federally registered and incontestable mark 411PAIN for advertising agency services and providing medical information in the field of pain and general health care services since 1996, the 800-411PAIN mark, which incorporates the registered 411PAIN mark, for medical information services, general health care services and accident recovery information services since 1997, and the 411PAIN.COM mark and domain name for advertising agency services, medical information services, general health care services and accident recovery information since 1998.

Plaintiffs have invested a substantial sum to promote good will in the 411PAIN trademark. From 1998 through October 2009, over \$13,200,000 has been spent in advertising

the mark 411PAIN, the mark 800-411PAIN with its associated phone number 800-411-7246 and the domain 411PAIN.COM (hereinafter, referred to collectively as the “411PAIN marks”).

Television advertisements featured a vehicle crash and then an authority figure (such as a police officer with a police cruiser, an EMT with ambulance, a firefighter with a fire truck, etc.) conveying to the viewers that if they called the phone number associated with the mark 800-411PAIN or went to the web pages located at 411PAIN.COM they could get help after being injured in vehicular accident, or any other type of accident, and receive information as to what to do next to protect themselves.

These advertisements have become well known and exclusively associated with Mr. Lewin through his company Broward Rehab Center Inc. (hereinafter, collectively referred to as “Broward Rehab”) for advertising agency services, medical information services, general health care services and accident recovery information services.

As a result of the supervision and control exercised by Broward Rehab over the nature and quality of the services offered in connection with the 411PAIN marks, and the extensive advertising, sale and public acceptance of the marks, these distinctive marks have acquired celebrity symbolizing the extensive goodwill that Broward Rehab had created throughout the United States. Therefore, the distinctive 411PAIN marks have acquired significant secondary meaning in the minds of the relevant public and have become famous.

Broward Rehab has used the federally registered and incontestable mark 411PAIN for advertising agency services and providing medical information in the field of pain and general health care services since 1996, the 800-411PAIN mark, which incorporates the registered 411PAIN mark, for medical information services, general health care services and accident

recovery information services since 1997, and the 411PAIN.COM mark and domain name for advertising agency services, medical information services, general health care services and accident recovery information since 1998. There is over 10 years of use in commerce of the 411PAIN marks and coupled with the extensive advertising, there is substantial goodwill built up in the 411PAIN marks and Broward Rehab's business reputation.

In mid-2008, Defendants Rafael Foss, 888-444-PAIN INC. and Accident and Wellness Centers LLC began using the confusingly similar mark 888-444-PAIN and the associated phone number 888-444-7246, the trade name 888-444-PAIN INC. and the domain name 888444PAIN.COM (hereinafter, collectively the 888-444-PAIN marks and trade name) in various media advertisements in the South Florida.

Rafael Foss is the Officer/Director of 888-444-PAIN, INC. and the Manager/Member of Accident and Wellness Centers LLC. Rafael Foss paid Channel 39 for the commercial advertising of 888-444-PAIN and is the registrant of the domain name 888444PAIN.COM. The television advertisements copy many elements of the Plaintiffs television advertisements.

Defendants offer the same services as Broward Rehab through its advertisements. Defendants' advertisements request that consumer call the 888-444-PAIN number (888-444-7246), or go to the web pages located at <www.888444PAIN.com> to receive health care information and general information about getting help after they have been in an accident. In essence, Defendants are offering medical information services, general health care information services and accident recovery information services via the same media channels in the same geographical area and to the same consumers as Broward Rehab.

Whether to award a preliminary injunction depends on the following factors: The

plaintiff's likelihood of success on the merits, whether the plaintiff will suffer irreparable harm if a preliminary injunction were denied, the injury to the defendant in the event that a preliminary injunction were granted, and whether the grant of a preliminary injunction would serve the public interest. *Warren Pub. Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1516 (11th Cir. 1997).

Plaintiffs' mark is federally-registered (Registration No. 2,621,497), and, as of February 2009, deemed incontestable. The registration is *prima facie* evidence of the validity of the mark. 15 U.S.C. § 1057(c); 15 U.S.C. § 1115; *Marco's Franchising, LLC v. Marco's Italian Express, Inc.*, No. 8:06-cv-00670-T-17-TGW, 2007 WL 2028845, at *4 (M.D.Fla., July 9, 2007).

The 411PAIN mark has been in open and visible use in Plaintiff's telephone number, domain name 411PAIN.COM, and in Plaintiff's advertising. Plaintiffs therefore have also demonstrated continuous common law trademark rights in the 411PAIN mark and related marks. The principles of trademark/service mark infringement are the same under either common law or statutory law. *Gift of Learning Found., Inc. v. TGC, Inc.*, 329 F.3d 792, 802 (11th Cir. 2003) (citing *Investacorp, Inc. v. Arabian Inv. Banking Corp. (Investacorp) E.C.*, 931 F.2d 1519, 1521 (11th Cir. 1991)).

Plaintiff's marks are strong marks entitled to trademark/service mark protection. They are inherently distinctive because they require "an effort of the imagination" by consumers in order for the mark to relate to advertising agency services, health care services, medical information services and general accident recovery information services. *Gift of Learning*, 329 F.3d at 798.

Plaintiff's marks also enjoy secondary meaning. In order to establish secondary meaning, one must show that "the primary significance of the term in the minds of the consuming public is

not the product but the producer.” *Vision Ctr v. Opticks, Inc.*, 596 F.2d 111, 118 (5th Cir.1979) (quotation omitted).

Plaintiff’s marks have acquired strong secondary meaning among the relevant consumers as a result of their long and widespread use, the extensive, nearly ubiquitous advertising and promotion using the marks, Plaintiff’s successful efforts to create a conscious connection in the public mind between the marks and Plaintiff’s services, and the extent to which the public actually identifies the marks with the Plaintiff’s services. *Investacorp*, 931 F.2d at 1525 (citing *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984)).

In addition, five years of continuous use gives rise to a presumption of secondary meaning under the Lanham Act. 15 U.S.C. § 1052(f). Plaintiff has used its 411PAIN mark for over twice that period.

It is undisputed that Broward Rehab is the senior user based on the registration of the mark 411PAIN, Reg. No. 2,621,497, with a date of first use as of July 1996 and the fact that Plaintiffs has established common law rights to 800-411PAIN as early as 1997 and 411PAIN.COM as early as 1998.

The central inquiry in trademark /service mark infringement is whether there exists a ‘likelihood of confusion’ between the parties’ names and symbols. The inquiry into the likelihood of confusion focuses on seven factors: (1) the distinctiveness of the mark at issue; (2) the similarity of the marks; (3) the similarity of the service; (4) the similarity of service outlets and customers; (5) the similarity of advertising media utilized; (6) the defendant’s intent and (7) any actual confusion. *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1561 (11th 1991).

Defendants' marks 888-444-PAIN and 888444PAIN.COM and trade name 888- 444-PAIN INC. are essentially the same as the dominant portions of Plaintiffs' marks 411PAIN, 800-411PAIN and 411PAIN.COM. Both marks begin with a "4" and include the term "PAIN." Therefore, if a consumer saw the marks in a television commercial, or, worse still, heard them in a radio commercial, because of the similarities of the marks, the consumer would believe that the "444PAIN" emanates from the same source as "411PAIN." Even if Defendants use the hyphen within its marks, the hyphen is not sufficient to distinguish the two marks in the minds of the public. Moreover, the sound of the marks "411PAIN" AND "444PAIN" are sufficiently similar that consumers would be confused. 444PAIN only differs from 411PAIN by two digits. The first impression either mark makes, the leading numeral four, is identical. Instead of following this with two 1s, and Plaintiffs do, Defendants follow the leading 4 with two more fours. This slight difference between the marks does virtually nothing to avoid confusion.

It is well settled that vanity telephone numbers are entitled to protection under the Lanham Act. *Bird v. Parsons*, 289 F.3d 865, 878 (Ohio 2002), *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F.Supp. 949, 958 (C.D. Cal., 1997). *Petmed Express, Inc. v. Medpets.Com, Inc.*, 336 F.Supp.2d 1213 (S.D. Fla. 2004) ("1888MedPets" and "www.1888.MedPets.com" confusingly similar to "1888PetMeds"); *American Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp.*, 622 F.Supp. 673 (N.D.Ill.1985) (granting American Airlines an injunction against travel agency's use of telephone number 1-800-263-7422, which defendant promoted as 1-800-AMERICAN).

Plaintiffs and Defendants offer essentially identical services. Plaintiffs target the same South Florida population as Defendants by the same media advertising. "The greater the

similarity between the products and services, the greater the likelihood of confusion.” *John H. Harland Co. v. Clarke Checks, Inc.* 711 F.2d 966, 976 (11th Cir. 1983).

In addition, the advertising media used by Defendants is virtually identical to those used by Plaintiffs. Defendants have advertised on the same television channel using commercials that are significantly the same as those produced by Plaintiffs. Plaintiffs have used the visual, as well as the sound of, a vehicle engaged in an accident, an authority figure talking to the camera, and many times showing the victim at the scene, all using 800-411PAIN and 411PAIN.COM.

The overall “look and feel” of the commercials are strikingly similar to those being broadcast by Defendants which use 888-444-PAIN and 888444PAIN.COM. Based on the similarity of Plaintiffs’ and Defendants’ marketing campaigns in the same media outlets, and the confusingly similarity of the marks, there is a heightened likelihood of consumer confusion.

The Court finds that Defendants have acted in bad faith and intentionally advertised nearly identical services with an nearly identical ad campaign. “A finding that the defendant has acted in bad faith is sufficient to justify an inference of confusing similarity.” *Popular Bank of Florida v. Banco Popular de Puerto Rico*, 9 F.Supp.2d 1347, 1362 (S.D. Fla. 1998) (citing *Babbit Elec., Inc. v. Dynascan Corp.*, 38 F.3d 1161, 1179 (11th Cir. 1994)).

Based on Defendants strikingly similar media campaigns targeted to the same South Florida population for the same services as Plaintiffs, it is not believable that Defendants’ use of the confusingly similar 888-444-PAIN marks as Plaintiffs’ 411PAIN marks were not deliberate and in bad faith to capitalize on Plaintiffs’ long established reputation. Plaintiffs have demonstrated that Defendants deliberately sought to capitalize on the Plaintiffs’ reputation by choosing a confusingly similar mark and trade name.

Defendants' use of 444-PAIN is likely to cause confusion with Plaintiffs' marks. Plaintiffs have demonstrated a substantial likelihood of success on the merits of their claims. Plaintiffs have made a strong showing of likelihood of confusion and therefore there is a presumption of irreparable harm. *E. Remy Martin & Co. v. Shaw-Ross Inter'l Imports, Inc.*, 756 F.2d 1525, 1530 (11th Cir. 1985) (“[A] sufficiently strong showing of likelihood of confusion may by itself constitute a showing of substantial likelihood of prevailing on the merits and/or a substantial threat of irreparable harm.”).

In addition, Plaintiffs have demonstrated that the injury to their reputation and goodwill posed by the confusion between themselves and Defendants in the absence of an injunction would be incalculable and irreversible.

Defendants have demonstrated no harm to them beyond not being able to use a mark confusingly similar to Plaintiffs' marks.

The balance of hardships also dictates in favor of the granting on an injunction.

Finally, the public interest will be served if the injunction is granted because by doing so, the confusion in the marketplace will be minimized. *Kason Indus., Inc. v. Component Hardware Group, Inc.*, 120 F.3d 1199, 1207 (11th Cir. 1997)(noting a strong public interest in preventing deception of consumers in the marketplace).

NOW, THEREFORE, IT IS HEREBY ORDERED AND ADJUDGED that:

A. Plaintiffs' Motion for Preliminary Injunction is **GRANTED**;

B. Defendants Rafael Foss, 888-444-PAIN, Inc. and Accident and Wellness Centers, LLC (collectively, “Defendants”), their respective agents, licensees, servants, employees, successors and assigns, and all corporations in which any of them has an ownership

interest or controls, and all others in concert and privity with any of them are preliminarily enjoined, until final resolution of this action, or until this Court issues a subsequent order modifying or dissolving the injunction, from directly or indirectly:

- (i) using the word PAIN in combination with any combination of numbers as a mark, a domain name, or as a trade name;
- (ii) using a mark, a domain name, or as a trade name similar to 411PAIN or 444PAIN;
- (iii) using any confusingly similar variations of “411” and “PAIN,” alone or in combination with any other letters, words, letter strings, phrases, or designs in commerce or in connection with any business or for any other purpose (including, but not limited to, on web sites, in domain names, and as names for business entities);
- (iv) using the telephone number 888-444-7246, including answering calls placed to this number or the inclusion of the number in materials available to the public;
- (v) engaging in any course of conduct likely to cause confusion, deception or mistake, or injure Plaintiffs’ business reputation, or weaken the distinctive quality of Plaintiffs’ marks;
- (vi) infringing any of Plaintiffs’ trademarks or trade dress;
- (vii) engaging in unfair competition against Plaintiffs;
- (viii) claiming any connection or affiliation with Plaintiffs, or endorsement from Plaintiffs; and

(ix) disparaging Plaintiffs goods or services.

C. There having been no request from the Defendants for Plaintiffs to provide security, nor any proffer of evidence from Defendants as to potential costs or damages that might be sustained by them if wrongfully enjoined, this injunction shall be effective upon Plaintiffs' posting of a nominal security bond in the amount of \$10,000.00.

DONE AND ORDERED this 18th day of March, 2010.

S/Kenneth L. Ryskamp
KENNETH L. RYSKAMP
UNITED STATES DISTRICT JUDGE