

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

Ronald D. Coleman (RC 3875)
GOETZ FITZPATRICK LLP
One Penn Plaza—Suite 4401
New York, NY 10119
(212) 695-8100
rcoleman@goetzfitz.com
Attorneys for Defendant / Counterclaim Plaintiff

MONSTER WORLDWIDE, INC., and)	
AFFINITY LABS, INC.,)	Case No.
<i>Plaintiffs,</i>)	10:CV:2272 (DLC)
-vs. -)	
HR Guru.BIZ CORPORATION,)	AMENDED ANSWER,
<i>Defendant.</i>)	COUNTERCLAIMS
)	AND
HR Guru.BIZ CORPORATION,)	JURY DEMAND
<i>Counterclaim Plaintiff,</i>)	
-vs. -)	
MONSTER WORLDWIDE, INC., and)	
AFFINITY LABS, INC,)	
<i>Counterclaim Defendants.</i>)	

ANSWER

HR Guru.Biz Corporation, by and for its Answer to the Complaint in this matter, through its undersigned attorneys, answers and defends as follows:

1. Defendant neither admits nor denies the allegations of this paragraph of the Complaint, which as a summary description of plaintiff's characterization of "the nature of the action" is not an allegation amenable to such response.

2. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

3. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

4. Admitted.

5. Admitted.

6. Denied, except admitted that defendant's activities are national and from time to time may incidentally involve activities affecting persons in the State of New York.

7. Admitted.

8. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

9. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint, except denies the allegation that the purpose of Plaintiff Affinity Labs in undertaking its activities is "to improve the lives, careers, and education of its members."

10. Denied, except admitted that plaintiff Affinity Labs launched "the Site" in September 20, 2009.

11. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

12. Admitted, except defendant states that the allegation in this paragraph of the Complaint is materially misleading insofar as it does not disclose that on October 15, 2009, the PTO issued an Office Action advising plaintiff that the applied-for mark was refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2879578 and 2997002 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*, such marks being registered to defendant.

13. Admitted, except defendant states that the allegation in this paragraph of the Complaint is materially misleading insofar as it does not disclose that on October 15, 2009, the PTO issued an Office Action advising plaintiff that the applied-for mark was refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2879578 and 2997002 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*, such marks being registered to defendant.

14. Admitted.

15. Admitted.

16. Admitted.

17. Admitted.

18. Denied.

19. Denied, except admitted that defendant has no intention of resuming use of the design component of the mark.

20. Denied.

21. Admitted.

22. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

23. Denied.

24. Denied.

25. Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint.

26. Admitted.

27. Admitted.

28. Admitted, except Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint relating to the beliefs of Plaintiffs.

29. Admitted.

30. Admitted, except Defendant lacks knowledge or information sufficient to admit or deny the allegations of this paragraph of the Complaint as to what was “feasible” for Plaintiffs and “the substantial time, effort, and resources to transition to a new name.”

31. Admitted.

32. Defendant incorporates by reference its responses to the corresponding allegations of the Complaint.

33. Denied, except admitted that Defendant has asserted and continued to assert that Plaintiffs have infringed and do infringe Defendant’s trademarks.

34. Admitted.

35. Denied.

36. Denied.

37. Denied.

38. Defendant incorporates by reference its responses to the corresponding allegations of the Complaint.

- 39. Denied.
- 40. Denied.
- 41. Denied.
- 42. Denied.
- 43. Denied.
- 44. Admitted.
- 45. Denied.
- 46. Denied.

AFFIRMATIVE DEFENSES

FAILURE TO STATE A CLAIM

Plaintiffs have failed to state a claim for which relief can be granted for the following reasons, *inter alia*:

1. Defendant is the senior user of the HR GURU common law trademark, having made us of and established good will in the same since 2002; and
2. The Defendant's Registrations issued in 2004 and 2005 respectively, at which time defendant became entitled to nationwide ownership of those marks, which included and incorporated the HR GURU word mark, which dates were according to the Complaint far prior to any alleged first use by Affinity Labs of the HR GURU mark or any mark that is confusingly similar to the Defendant's Registrations; and
3. Notwithstanding the allegations of the Complaint that Affinity Labs "has used" the HR GURU trademark or a confusingly similar form of it, the Complaint does not allege that Affinity Labs has built up any goodwill in the HR GURU mark

arising from such use such that it would be entitled to any trademark rights even irrespective of defendant's superior rights at law.

UNCLEAN HANDS

Plaintiffs' claims are barred by the doctrine of unclean hands, based on their filing of this meritless action and their willful infringement of the Defendant's Registrations and the HR GURU marks of defendant, *inter alia*.

CONFUSION

To the extent plaintiffs rely on their allegation that "Plaintiffs are not aware of a single instance of actual confusion arising from their use of the HRGURU word/design mark" as tending to negate the existence of a likelihood of confusion, such "awareness" is neither legally nor factually significant in light of evidence of actual confusion in defendant's possession.

WHEREFORE, defendant demands that plaintiff's Complaint be dismissed, with prejudice, in its entirety, and that defendant be granted its attorneys' fees and costs of suit.

COUNTERCLAIMS

Defendant / counterclaim plaintiff, HR Guru.biz Corporation ("HR Guru"), by and through its undersigned attorneys, for its counterclaim against counterclaim defendant Affinity Labs, Inc. ("Affinity Labs") alleges and says as follows:

THE PARTIES

1. HR Guru incorporates and reiterates the allegations of ¶¶ 2-4 of the Complaint and its responses thereto.

JURISDICTION AND VENUE

2. HR Guru incorporates and reiterates the allegations of ¶¶ 2-4 of the Complaint and its responses thereto.

FACTS

3. HR Guru incorporates and reiterates its responses of the allegations of the Complaint and its responses thereto as if set fully set forth herein.

4. HR Guru was founded by Cynthia Herrera. It evolved from her experiences as a social worker for a non-profit organization called The Family Place, the largest family violence service provider in the Dallas area.

5. At The Family Place, Ms. Herrera managed volunteer programs, worked the crisis hotline, acted as an assistant to the Executive Program Director and served as Safe Home Outreach Program Recruiter.

6. Building on the skills she developed in that role as well as her demonstrated passion for and success at “finding better places for people,” Herrera joined Robert Half International, a major recruiting firm, where she recruited and placed accounting, finance, tax and audit professionals.

7. Herrera founded HR Guru in 2002 to leverage her social worker roots to build a new type of highly personal, dynamic and grass-roots-oriented “headhunter” experience.

8. In early 2002, HR Guru adopted and began using the trademark HR GURU for personnel consulting and recruiting services.

9. The origin of the mark was that “HR” was a known abbreviation for “human resources,” a term used to describe what personnel recruiters such as HR Guru provide to their clients, coupled with “guru,” meaning a transcendently wise expert or sage.

10. At or around that time, HR Guru launched at www.hrguru.biz, the home page of which utilized the HR GURU mark as set out in Figure 1 below:



11. HR Guru chose the HRGuru.biz domain name because HRGuru.com was not available, although it was not, upon information and belief, in active use as a domain name for a website.

12. Making necessity a virtue, HR Guru opted to utilize both the HR GURU and HRGURU.BIZ trademarks in its business, both incorporating as HRGURU.BIZ and obtaining the Defendant's Registrations of which HRGURU.BIZ is the main component, as set out in the Complaint.

13. HR Guru continued, however, to use the HR GURU trademark as an alternative name for its business, as demonstrated in the above illustration.

14. HR Guru's business grew substantially over the ensuing years. As a result of its success, as well as its investments in marketing, networking and promotion, the HRGURU and HRGURU.BIZ trademarks, as well as the registered marks identified in the Complaint as are inherently distinctive to the public, and serve primarily as a designator of origin of recruiting and related services emanating from or sponsored by HR Guru.

15. As a result of the widespread use and display of the HR GURU trademark, (a) the public and the trade use it and the Defendant's Registrations to identify and refer to HR Guru's recruiting services; (b) the public and the trade recognize that such designations refer to a high quality of recruiting and human resources services emanating from a single source; and (c) said trademark and has built up secondary meaning and extensive goodwill in HR Guru only.

16. HR Guru's use of both the HR GURU and HRGURU.BIZ word trademarks and the Defendant's Registrations for the purposes set forth in the Defendant's Registrations has been continuous and ongoing since no later than 2002.

17. The Defendant's Registrations were issued in August, 2004 and September 20, 2005, respectively.

18. Specifically, HR Guru owns U.S. Trademark Registration 2997002 for the word mark HRGURU.BIZ used in connection with "Employment hiring, recruiting, placement, staffing, and career networking services; consulting services in the field of human resources; administration, management, implementation and coordination of human resources, human resources outsourcing" as well as "Educational and training services, namely conducting classes, seminars, conferences, and workshops for employees and others on employment and human

resources issues.” A true copy of the registration certificate for Registration 2997002 is attached hereto as Exhibit A.

19. Additionally, HR Guru owns U.S. Trademark Registration 2879578 for the word mark HRGURU.BIZ used in connection “Employment hiring, recruiting, placement, staffing, and career networking services; consulting services in the field of human resources; administration, management, implementation and coordination of human resources, human resources outsourcing” as well as “Educational and training services, namely conducting classes, seminars, conferences, and workshops for employees and others on employment and human resources issues.” A true copy of the registration certificate for Registration 2879578 is attached hereto as Exhibit B.

20. As set out in the Complaint, plaintiff Affinity Labs adopted and began using HR Guru’s HR GURU trademark, or a mark that incorporated the HR GURU trademark or which was confusingly similar to the Defendant’s Registrations or trademarks, no earlier than November, 2006.

21. The use by Affinity Labs of HR Guru’s marks, and of marks that are confusingly similar to them, was a use in competition with HR Guru and in the same channels of trade as those in which HR Guru uses its mark or in markets regarding which HR Guru is likely to developing one or more services for sale in the market of Affinity Labs’ services.

22. The HRGURU marks used by Affinity Labs are likely to be confused with HR Guru’s marks, including the Defendant’s Registrations.

23. On October 15, 2009, the PTO issued an Office Action advising Affinity Labs that its application to register the word mark HRGURU and a logo incorporating that word was refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2879578

and 2997002 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

24. The trademark registrations that formed the basis of the PTO's Section 2(d) refusal, based on a likelihood of confusion, are the Defendant's Registrations.

25. On October 15, 2009, the PTO issued an Office Action advising Affinity Labs that its application to register the trademark HRGURU was refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2879578 and 2997002 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

26. The trademark registrations that formed the basis of the PTO's Section 2(d) refusal, based on a likelihood of confusion, are the Defendant's Registrations.

27. The abandonment by Affinity Labs of, as set forth in the Complaint, "all use of the HRGURU name" and its claimed intent to "withdraw Affinity Labs' Applications" are, notwithstanding its self-serving denial of the same, a tacit acknowledgment of the superior rights of HR Guru in its trademarks as compared to those claimed by Affinity Labs.

28. Affinity Labs subsequently brought this action in bad faith as an attempt to prevent HR Guru's assertion of its right to appropriate compensation for the wrongful infringement by Affinity Labs of HR Guru's trademark rights, premised on the threat that HR Guru would be overwhelmed by the cost of litigation and would gladly accept a "walkaway."

29. The acts of Affinity Labs set forth above were willful.

30. The acts of Affinity Labs set forth above were malicious.

31. Furthermore, Affinity Labs has, notwithstanding the averments in the Complaint, continued to compete unfairly with HR Guru by exploiting its dominant position and its wrongful possession of the HRGuru.com domain name.

32. As of the date hereof, Affinity Labs has not withdrawn its trademark applications.

33. Affinity Labs continues to utilize the HR Guru’s HR GURU mark to drive Internet traffic to its proprietary websites.

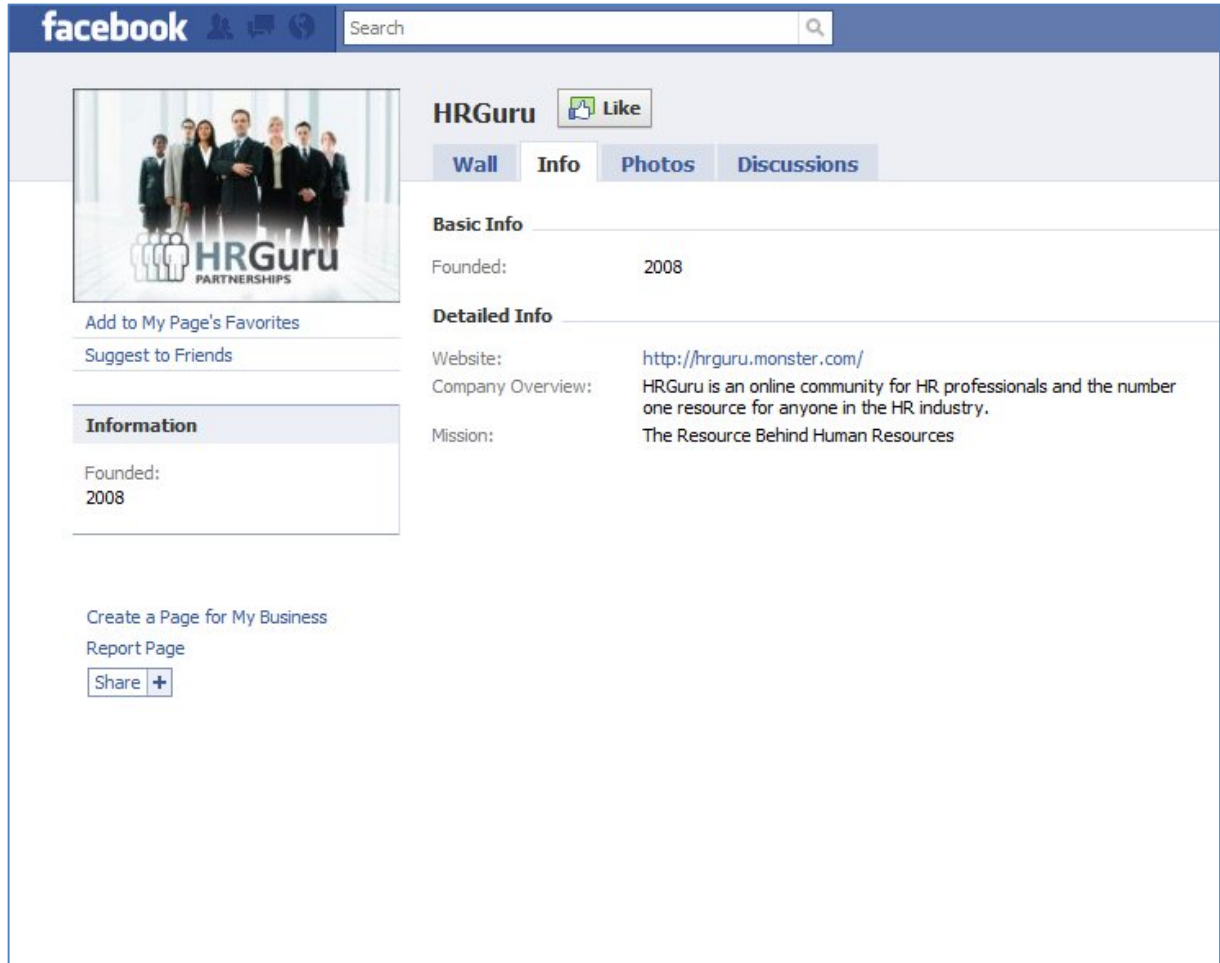
34. Affinity Labs still maintains benefits from its infringement of the HRGuru.com domain name.

35. As of the date hereof, Internet browser attempting to reach the URL www.hruguru.com are redirected to the Affinity Labs “HR People” website, indicating another URL but capturing traffic of all users inputting www.hruguru.com to their browsers.

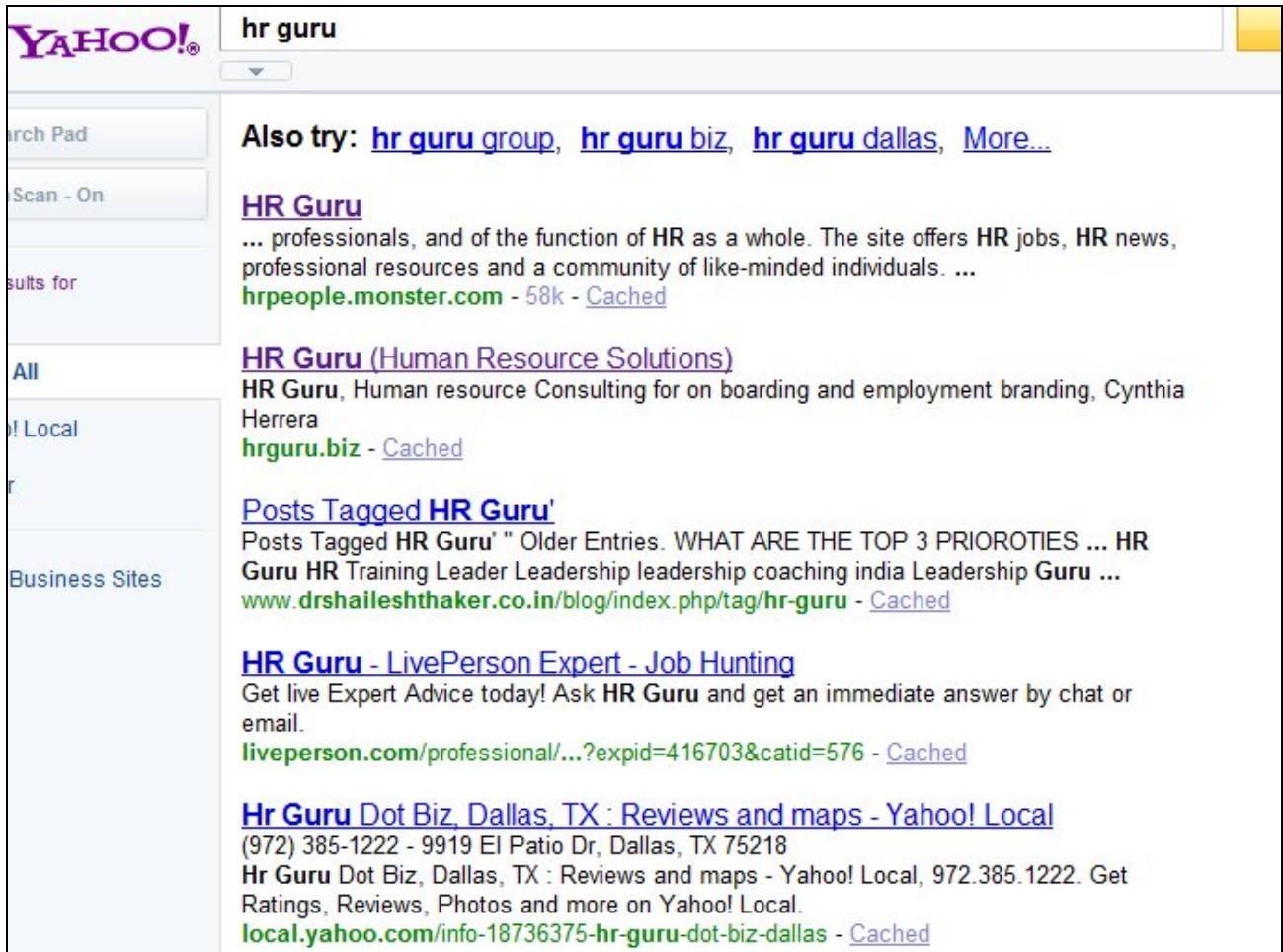
36. As of the date hereof, Affinity Labs still maintains a Facebook “Group” called HRGURU which utilizes the HR GURU trademark, as illustrated below:



37. As of the date hereof, Affinity Labs still maintains a Facebook “Page” called HRGURU which utilizes the HR GURU trademark, as illustrated below:



38. As of the date hereof, a Yahoo! Internet search utilizing the HR GURU trademark as the search term returns, as the top results, websites directing users to Affinity Labs, and utilizing the title “HR GURU,” as illustrated below:



39. As of the date hereof, a Google Internet search utilizing the HR GURU trademark as the search term returns, as the top results, websites directing users to Affinity Labs, and utilizing the title “HR GURU,” as illustrated below:

hr guru - Google Search

Web [Images](#) [Videos](#) [Maps](#) [News](#) [Shopping](#) [Gmail](#) [more](#) ▼

Google [Advanced Search](#)

Web [+ Show options...](#)

[HRPeople : The Resource Behind Human Resources](#)
HRPeople is an online community dedicated to the advancement of current and prospective HR professionals, and of the function of HR as a whole.
[hrpeople.monster.com/](#) - [Cached](#)

Careers	News
Get into HR	Forum
Employment Law Guide	Specialties
Salary & KSA Guide	About Us

[More results from monster.com »](#)

[Careers - HRPeople](#)
HRPeople's job and career section include career tips, employer tips and job listings for HR positions across the country.
[hrpeople.monster.com/careers](#) - [Cached](#)

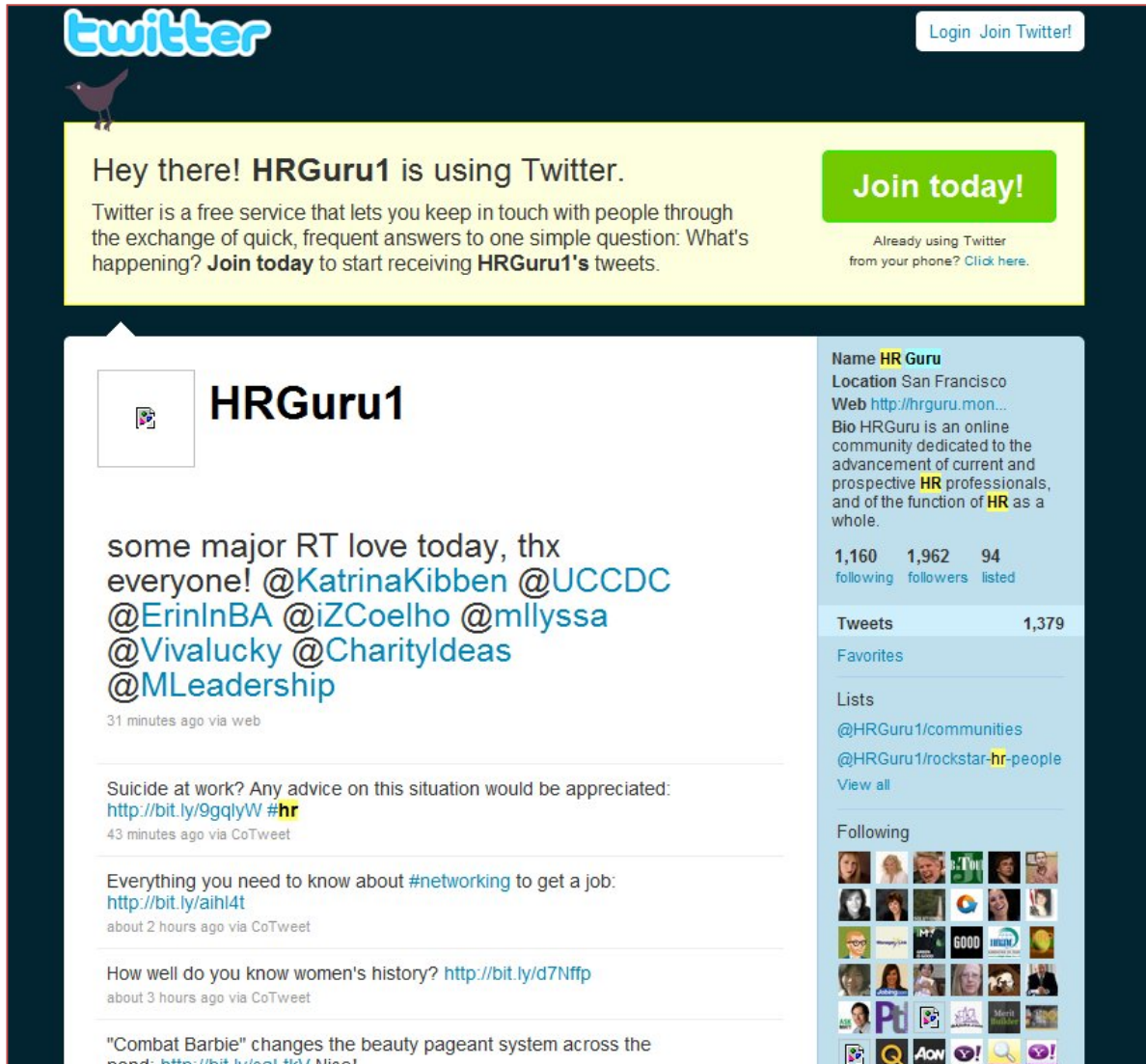
[MEET HR GURU'S - Prof. Dave Ulrich ; Lynda Gratton & many more ...](#)
See who's attending MEET HR GURU'S - Prof. Dave Ulrich ; Lynda Gratton & many more @ WORLD HRD CONGRESS 2010 - Mumbai on LinkedIn Events.
[events.linkedin.com/MEET-HR-GURUS-Prof-Dave.../90877](#) - [Cached](#) - [Similar](#)

[HR Guru Notes | Facebook](#)
Welcome to the official Facebook Page of HR Guru. Get exclusive content and interact with HR Guru right from Facebook. Join Facebook to create your own Page ...
[www.facebook.com/pages/HR-Guru/272597834850?v=app...](#) - [Cached](#)

[HR Guru: Up in the Air Has Heartless 'Transition Consultants' All ...](#)
Jan 13, 2010 ... So far, Up in the Air has coasted through awards season with its timely tale of selfish human-resources mavens who gradually learn there are ...
[www.movieline.com/.../hr-guru-insists-up-in-the-air-has-heartless-transition-consultants-all-wrong.php](#) - [Cached](#) - [Similar](#)

[HR Guru - Dallas, TX \(Texas\) | \(214\) 766-5254](#)
HR Guru specializes in designing Employment Brands for Fortune Companies. Our sister division, Guru Recruits provides niche direct hire and staffing.
[www.manta.com/coms2/dnbcompany_gt4zd8](#) - [Cached](#)

40. As of the date hereof, a Twitter page utilizing a user name incorporating the HR GURU mark was maintained, on information and belief, by Affinity Labs, as illustrated below:



41. The foregoing illustration is of a “cached” search engine page showing that the Twitter user profile page was active as of “31 minutes ago” as of early in the morning of April 27, 2010.

42. Prior to the time of the filing of this Amended Answer, Counterclaims and Jury Demand, but after the Electronic Case Filing submission of the original Answer, Counterclaims

and Jury Demand late on April 26, 2010, the referenced Twitter user profile page was deleted by the user which is, on information and belief, Affinity Labs or one of its employees acting with the knowledge or approval of Affinity Labs.

43. On information and belief, this deletion was an attempt to destroy evidence of the extent, nature and recency of the continued use of the HR GURU trademarks notwithstanding, or more likely as a result of, the pendency of this litigation.

44. As demonstrated by the foregoing, even as of the date of this filing Affinity Labs continues to infringe the HR GURU trademarks; maintain its applications to register trademarks that the PTO has already deemed infringing of those belong to HR Guru; compete unfairly with HR Guru on the Internet and, presumably, elsewhere despite its claims to the contrary; and conduct itself dishonestly and unethically with respect to its candor about the extent of its activities.

FIRST CAUSE OF ACTION
Trademark Infringement

45. HR Guru repeats and realleges each and every allegation of the foregoing as though fully set forth herein.

46. The acts of Affinity Labs as alleged constitute trademark infringement in violation of the Lanham Act, Section 32, 15 U.S.C. § 1114, all to the substantial and irreparable injury of the public and of HR Guru's business reputation and goodwill.

47. HR Guru has been damaged by the acts of Affinity Labs.

48. HR Guru has no adequate remedy at law.

SECOND CAUSE OF ACTION

False Designation of Origin

49. HR Guru repeats and realleges each and every allegation of the foregoing as though fully set forth herein.

50. The acts of Affinity Labs as alleged constitute trademark infringement in violation of the Lanham Act, Section 43(a), 15 U.S.C. § 1125(a), all to the substantial and irreparable injury of the public and of HR Guru's business reputation and goodwill.

51. HR Guru has been damaged by the acts of Affinity Labs.

52. HR Guru has no adequate remedy at law.

THIRD CAUSE OF ACTION

Common Law Unfair Competition

53. HR Guru repeats and realleges each and every allegation of the foregoing as though fully set forth herein.

54. The aforementioned acts of Affinity Labs constitute unfair competition and in violation of the common law of New York State.

55. HR Guru has been damaged by the acts of Affinity Labs.

56. HR Guru has no adequate remedy at law.

FOURTH CAUSE OF ACTION

Statutory Unfair Competition

57. HR Guru repeats and realleges each and every allegation of the foregoing as though fully set forth herein.

58. The aforementioned acts of Affinity Labs constitute unfair competition and unfair deceptive acts or practices in violation of New York General Business Law § 349.

- 59. HR Guru has been damaged by the acts of Affinity Labs.
- 60. HR Guru has no adequate remedy at law.

FIFTH CAUSE OF ACTION
Cybersquatting

61. HR Guru repeats and realleges each and every allegation of the foregoing as though fully set forth herein.

62. The aforementioned acts of Affinity Labs constitute a violation of the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d).

- 63. HR Guru has been damaged by the acts of Affinity Labs.
- 64. HR Guru has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, HR Guru.biz Corporation prays for judgment against plaintiff / counterclaim defendant Affinity Labs, Inc. as follows:

I. That the Court enter an injunction enjoining the Affinity Labs, its agents, servants, employees, and all other persons in privity or acting in concert with it from:

- a) using any reproduction, counterfeit, copy, or colorable imitation of the HR GURU trademark or the Defendant's Registrations to identify any services not authorized by HR Guru;
- b) engaging in any course of conduct likely to cause confusion, deception or mistake, or injure HR Guru's business reputation or dilute the distinctive quality of HR Guru's name and marks; and
- c) using a false description or representation including words or other symbols tending to falsely describe or represent Affinity Labs'

Int. Cls.: 35 and 41

Prior U.S. Cls.: 100, 101, 102 and 107

United States Patent and Trademark Office

Reg. No. 2,879,578

Registered Aug. 31, 2004

**SERVICE MARK
PRINCIPAL REGISTER**

HRGURU.BIZ

HRGURU.BIZ CORPORATION (TEXAS CORPORATION)
ONE GALLERIA TOWER
13355 NOEL ROAD, SUITE 1802
DALLAS, TX 75240

FOR: EMPLOYMENT HIRING, RECRUITING, PLACEMENT, STAFFING, AND CAREER NETWORKING SERVICES; CONSULTING SERVICES IN THE FIELD OF HUMAN RESOURCES; ADMINISTRATION, MANAGEMENT, IMPLEMENTATION AND COORDINATION OF HUMAN RESOURCES, HUMAN RESOURCES OUTSOURCING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-7-2002; IN COMMERCE 10-7-2002.

FOR: EDUCATIONAL AND TRAINING SERVICES, NAMELY CONDUCTING CLASSES, SEMINARS, CONFERENCES, AND WORKSHIPS FOR EMPLOYEES AND OTHERS ON EMPLOYMENT AND HUMAN RESOURCES ISSUES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-7-2002; IN COMMERCE 10-7-2002.

SER. NO. 78-297,423, FILED 9-8-2003.

PRISCILLA MILTON, EXAMINING ATTORNEY

Int. Cls.: 35 and 41

Prior U.S. Cls.: 100, 101, 102 and 107

United States Patent and Trademark Office

Reg. No. 2,997,002

Registered Sep. 20, 2005

**SERVICE MARK
PRINCIPAL REGISTER**



HRGURU.BIZ CORPORATION (TEXAS CORPORATION)
ONE GALLERIA TOWER
13355 NOEL ROAD, SUITE 1802
DALLAS, TX 75240

FOR: EMPLOYMENT HIRING, RECRUITING, PLACEMENT, STAFFING, AND CAREER NETWORKING SERVICES; CONSULTING SERVICES IN THE FIELD OF HUMAN RESOURCES; ADMINISTRATION, MANAGEMENT, IMPLEMENTATION AND COORDINATION OF HUMAN RESOURCES, HUMAN RESOURCES OUTSOURCING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-7-2002; IN COMMERCE 10-7-2002.

FOR: EDUCATIONAL AND TRAINING SERVICES, NAMELY CONDUCTING CLASSES, SEMINARS, CONFERENCES, AND WORKSHOPS FOR EMPLOYEES AND OTHERS ON EMPLOYMENT AND HUMAN RESOURCES ISSUES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-7-2002; IN COMMERCE 10-7-2002.

SER. NO. 78-297,668, FILED 9-9-2003.

PRISCILLA MILTON, EXAMINING ATTORNEY