

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

WAWA, INC.	:	CIVIL ACTION
	:	
v.	:	
	:	
TOM CHRISTENSEN, d/b/a	:	
VIRTUAL DOMAIN BUYERS	:	NO. 99-1454

MEMORANDUM AND ORDER

Norma L. Shapiro, S.J.

July 27, 1999

Plaintiff, WAWA, Inc., filing a complaint on March 23, 1999, alleged trademark dilution under the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c), § 43(c) of the Lanham Act, and violation of state law under 54 Pa. C.S.A. § 1124. Plaintiff requested an injunction against any use of the name WAWAWA.COM, actual damages sustained by the plaintiff, any profits realized by the defendant with the use of the WAWAWA.COM domain name, punitive damages, costs and attorneys fees. On May 10, 1999, a default was entered by the Clerk because defendant did not plead, answer or otherwise respond to the complaint. On May 14, 1999, Plaintiff filed a Motion for Default Judgment.

On June 16, 1999, plaintiff's motion for default judgment was denied, the entry of default was vacated and a hearing to show cause why service was proper was ordered. At the hearing, only the plaintiff was present. Upon consideration of the plaintiff's evidence and argument, a declaratory judgment will issue that the use of the name WAWAWA.COM by Tom Christensen, d/b/a Virtual Domain Buyers, is a violation of the Federal Trademark Dilution Act of

1995, 15 U.S.C. § 1125(c), § 43(c) of the Lanham Act, and 54 Pa. C.S.A. § 1124.

Discussion

"Before a default can be entered, the court must have jurisdiction over the party against whom the judgment is sought, which also means that the party must have been effectively served with process." 10 A Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure § 2682 (3d ed. 1998). The court must consider subject matter jurisdiction sua sponte. This court has original jurisdiction over this action under 15 U.S.C. § 1121 and 28 U.S.C. § 1338(a). This court also has jurisdiction over the state law claim under 28 U.S.C. § 1338(b), because those claims are joined with a substantial and related claim under the Trademark Laws of the United States.

After determining that the court has subject matter jurisdiction,¹ the court must consider whether there was valid service of process. Service of process must comply with the statute under which service is effectuated and constitutional due process. See Ackerman v. Levine, 788 F.2d 830, 838 (2d Cir. 1986). Constitutional due process requires that service of process be "reasonably calculated, under all circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections." Mullane v. Central Hanover Bank & Trust Co., 339 U.S. 306, 314 (1950).

¹ At the hearing on July 1, 1999, the court inquired about personal jurisdiction. The defendant is a Danish resident with no known direct contact with the Eastern District of Pennsylvania. Plaintiff's counsel argued that minimum contacts have been established because the web site in question is "interactive" with persons in Pennsylvania. Lack of personal jurisdiction, Fed. R. Civ. P. 12(b)(2), is waivable and the defendant did not appear to raise this issue.

Service of process was attempted against defendant, a Danish citizen, by electronic transmission and a direct mailing. Electronic mail ("email") is not an approved method of service under Federal Rule of Civil Procedure 4. The Judicial Conference Rules Committee has discussed and recommended a change in Fed. R. Civ. P. 4 to permit service by electronic transmission. But at this time, email is not a valid means for delivering a summons and complaint to a defendant. Plaintiff's attempted service by electronic transmission of the summons and complaint on March 24 and March 26, 1999 was invalid.

Plaintiff also mailed a copy of the complaint and summons to Mr. Christensen in Denmark on April 6, 1999 and a receipt of service was signed by defendant and returned to plaintiff. A certified direct mailing meets the constitutional requirement of service "reasonably calculated" to give notice.

Federal Rule of Civil Procedure. Fed. R. Civ. P. 4(f) provides for service on an individual in a foreign country, "by any internationally agreed upon means ... such as those authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents ...". Fed. R. Civ. P. 4(f)(1).

The Hague Convention, Article 10(a), states, "[p]rovided the State of destination does not object, the present Convention shall not interfere with the freedom to send judicial documents, by postal channels, directly to persons abroad." Under Fed. R. Civ. P. 4(f) and Hague Convention Article 10(a), direct mailing of service of process to a Danish citizen in Denmark was valid service.

The necessary prerequisites for a default judgment were established. "[I]t is well settled ... that the granting of a declaratory judgment rests in the sound discretion of the trial court exercised in the public interest." 10 B Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure § 2759 (3d ed. 1998). The court will grant a declaratory judgment that the use of WAWAWA.COM by Tom Christensen, d/b/a Virtual Domain Buyers, violates the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c), §

43(c) of the Lanham Act, and 54 Pa. C.S.A. § 1124.

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CIVIL ACTION

**TOM CHRISTENSEN, d/b/a
VIRTUAL DOMAIN BUYERS**

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NO. 99-1454

JUDGMENT AND ORDER

AND NOW, this 27th day of July, 1999, upon consideration of Plaintiff's motion for a declaratory judgment that defendant's use of WAWAWA.COM violates 15 U.S.C. § 1125 (c) and 54 Pa. C.S.A. § 1124, there being no response thereto, it is hereby

ORDERED that Plaintiff's Motion is **GRANTED**.

The use of the name and mark WAWAWA.COM by defendant Tom Christensen d/b/a Virtual Domain Buyers, violates the Federal Trademark Dilution Act of 1995, § 43 (c) of the Lanham Act, 15 U.S.C. § 1125 (c), and 54 Pa. C.S.A. § 1124.

Norma L. Shapiro, S.J.