

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION**

KEITH LIONEL URBAN,)	
)	
Plaintiff/Counter-Defendant,)	
)	
v.)	No.: 3:07-cv-00152
)	JUDGE TRAUGER
KEITH D. URBAN,)	
)	
Defendant/Counter-Plaintiff.)	JURY DEMAND

**ANSWER AND COUNTERCLAIM OF
DEFENDANT/COUNTER-PLAINTIFF KEITH D. URBAN**

For his Answer to the Complaint, Defendant Keith D. Urban (“Painter”) files this Answer and Counterclaim in response to the Complaint filed by Plaintiff Keith Lionel Urban (“Musician”), and states as follows:

FIRST AFFIRMATIVE DEFENSE

The Musician is misusing the judicial process to improperly intimidate the Painter. The Complaint is baseless. The Painter’s given birth name is Keith Urban. (A copy of his birth certificate attached as Exhibit A.) He has used the name Keith Urban in business and personal dealings since his birth in 1970.

SECOND AFFIRMATIVE DEFENSE

The Painter obtained the domain name keithurban.com on May 10, 1999, which is prior to the date the Musician registered the domain name keithurban.net. Through this lawsuit, the Musician is using his celebrity to threaten the Painter to give up intellectual property in which he has legitimate interests.

THIRD AFFIRMATIVE DEFENSE

The Painter registered the domain name keithurban.com in good faith on May 10, 1999. The Painter offers his goods and services from website accessed at keithurban.com, and has done so in good faith since it was first launched.

FOURTH AFFIRMATIVE DEFENSE

The Musician's asserted trademarks are not famous.

FIFTH AFFIRMATIVE DEFENSE

The Painter's use of the name KEITH URBAN is a fair use.

SIXTH AFFIRMATIVE DEFENSE

The Painter's registration of the domain name keithurban.com and his operation of the related website does not produce confusion, nor does it produce deception or mistake as to the source, affiliation or sponsorship of the website and goods and services advertised thereon.

SEVENTH AFFIRMATIVE DEFENSE

The fact that the Musician may have achieved fame after the Painter's registration of the domain name keithurban.com (and the Painter's use of the related website) does not create a cause of action for the Musician against the Painter, and does not give the Musician grounds to claim trademark infringement or any of the other claims asserted in the Complaint.

EIGHTH AFFIRMATIVE DEFENSE

The Complaint must be dismissed because the Musician's claims, either in whole or in part, fail to state a claim upon which relief can be granted.

NINTH AFFIRMATIVE DEFENSE

Some or all of the claims made in the Complaint may be barred by the equitable doctrines of estoppel, waiver, acquiescence and laches, and under the applicable statute of limitations.

TENTH AFFIRMATIVE DEFENSE

The Painter reserves the right to file such additional defenses as may be appropriate upon completion of its investigation and discovery.

ELEVENTH DEFENSE

The Painter answers the numbered averments of the Complaint as follows:

1. Upon information and belief, the Painter admits the averments of paragraph 1.
2. The Painter admits the averments of paragraph 2.
3. The Painter admits that the Musician seeks relief under the laws identified in paragraph 3, but denies that he caused any tortious injury to the Musician, or that the Musician is entitled to such relief.
4. The Painter admits that the Musician seeks relief under the laws identified in paragraph 4, but denies that he caused any tortious injury to the Musician, or that the Musician is entitled to such relief.
5. The Painter admits he operates a website that is accessible at keithurban.com, and that he has solicited sales over the website, wherever it may be accessed, including Tennessee. The Painter consents to this Court's personal jurisdiction and venue. The Painter denies all remaining averments of paragraph 5.
6. The Painter lacks knowledge or information sufficient to form a belief as to the truth of the averments in paragraph 6, and therefore denies the same.
7. The Painter admits that the Musician seeks relief under the laws identified in paragraph 7, but denies that he caused any tortious injury to the Musician, or that the Musician is entitled to such relief.

8. The Painter admits that he has registered the domain name keithurban.com, that he operates the related website and that he uses such for commercial purposes. The Painter denies all remaining averments of paragraph 8.

9. The Painter denies the averments of paragraph 9.

10. The Painter admits that he offers his own art for sale on his website, and that the Musician attached a copy of a page of the website to the Complaint. The Painter denies all remaining averments of paragraph 10.

11. The Painter admits that the quoted language of paragraph 11 is accurate. The Painter denies all remaining averments of paragraph 11.

12. The Painter admits the averments of paragraph 12, but denies that the law requires he obtain permission or endorsement by the Musician.

13. The Painter denies the averments of paragraph 13.

14. The Painter adopts and reasserts his responses in paragraphs 1-13, above.

15. The Painter lacks knowledge or information sufficient to form a belief as to the truth of the averments in paragraph 15, and therefore denies the same.

16. The Painter denies the averments of paragraph 16.

17. The Painter denies the averments of paragraph 17.

18. The Painter denies the averments of paragraph 18.

19. The Painter denies the averments of paragraph 19.

20. The Painter denies the averments of paragraph 20.

21. The Painter denies the averments of paragraph 21.

22. The Painter adopts and reasserts his responses in paragraphs 1-21, above.

23. The Painter lacks knowledge or information sufficient to form a belief as to the truth of the averments in paragraph 23, and therefore denies the same.

24. The Painter denies the averments of paragraph 24.

25. The Painter denies the averments of paragraph 25.

26. The Painter denies the averments of paragraph 26.

27. The Painter adopts and reasserts his responses in paragraphs 1-26, above.

28. The Painter denies the averments of paragraph 28.

29. The Painter denies the averments of paragraph 29.

30. The Painter denies the averments of paragraph 30.

31. The Painter denies the averments of paragraph 31.

32. The Painter adopts and reasserts his responses in paragraphs 1-31, above.

33. The Painter denies the averments of paragraph 33.

34. The Painter admits he has registered the domain name keithurban.com. The Painter denies all remaining averments of paragraph 34.

35. The Painter denies the averments of paragraph 35.

36. The Painter denies the averments of paragraph 36.

37. The Painter adopts and reasserts his responses in paragraphs 1-36, above.

38. The Painter denies the averments of paragraph 38.

39. The Painter denies the averments of paragraph 39.

40. The Painter adopts and reasserts his responses in paragraphs 1-39, above.

41. The Painter denies the averments of paragraph 41.

42. The Painter denies the averments of paragraph 42.

43. The Painter denies any averments of the Complaint which he has not specifically admitted or denied.

WHEREFORE, having fully answered the averments of the Musician's Complaint, the Painter demands that the Complaint be dismissed with prejudice, that costs be taxed to the Musician, and that the Painter recover its reasonable fees and costs incurred in defending same. The Painter further demands a jury trial.

COUNTERCLAIM

Keith D. Urban (the "Painter") hereby assumes the role of Counter-Plaintiff, and for its Counterclaim against Keith Lionel Urban (the "Musician"), states as follows:

PARTIES, JURISDICTION AND VENUE

1. The Painter is a citizen of New Jersey. The Musician is a citizen of Nashville, Tennessee.

2. This Court has subject matter jurisdiction over this action, pursuant to 28 U.S.C. § 1331, as it presents federal questions under the Lanham Act, 15 U.S.C. § 1501 *et seq.* and under 28 U.S.C. §§ 1338(a) and (b). This Court also has diversity jurisdiction over this action, pursuant to 28 U.S.C. § 1332, as the parties are citizens of different states, and as the amount in controversy exceeds \$75,000.

3. This Court has both general and specific personal jurisdiction over the Musician.

4. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) because the Musician resides in this district, and a substantial part of the events giving rise to the claims have occurred in this district.

5. These counterclaims arise from an actual and justiciable controversy between the

parties regarding the Musician's trademarks, personal right to privacy, domain name and other intellectual property. The Musician has brought suit against the Painter for alleged infringement of the Musician's alleged intellectual property rights.

FACTS

6. The Painter was born in 1970, and given the name Keith Daniel Urban. A copy of his birth certificate is attached hereto as Exhibit A.

7. Since he was born more than three decades ago, the Painter has gone by the name Keith Urban.

8. The Painter is a trained visual artist and computer graphics designer. He studied fine arts.

9. The Painter registered keithurban.com on May 10, 1999, a date long before any actual or constructive trademark use of KEITH URBAN by the Musician first began. Related WHOIS information for keithurban.com is attached as Exhibit B.

10. The Painter has maintained his registration with the domain name registry from the date of his first registration to the present date; it does not expire until May 10, 2011; and it is renewable.

11. The Painter offers both paintings for sale and design services from his website, keithurban.com, which website has value to him in excess of the jurisdictional threshold.

12. The Painter has a right and legitimate interest in keithurban.com.

13. As keithurban.com was no longer available, the Musician registered the domain name keithurban.net on September 7, 1999 – almost four months after the Painter registered keithurban.com. Related WHOIS information for keithurban.net is attached as Exhibit C.

14. The Musician is an overreaching trademark owner who is trying to reverse domain name hijack keithurban.com.

COUNT I – DECLARATORY JUDGMENT

15. The Painter incorporates the factual allegations set forth in the preceding paragraphs as if the same were fully written herein.

16. Resolution of the following issues would settle the entire controversy between the parties.

17. Pursuant to 28 U.S.C. § 2201 et seq., and Fed. R. Civ. P. 57, the Painter has presented a case of actual controversy in this Court’s jurisdiction, and seeks the following declarations, that:

A. The Painter has Priority over the Musician regarding the Domain Name keithurban.com

18. The Painter has priority over the Musician, and the exclusive right to register, use and operate the domain name keithurban.com and the related website, so long as the Painter maintains his registration.

19. The Painter registered keithurban.com on May 10, 1999, a date long before any actual or constructive trademark use of KEITH URBAN by the Musician first began.

20. As keithurban.com was no longer available, the Musician registered the domain name keithurban.net on September 7, 1999 – almost four months after the Painter registered keithurban.com.

B. The Painter has not Created a Likelihood of Confusion

21. The Painter seeks a declaration that the Painter has not conducted any act that would create a likelihood of confusion with regard to any of the Musician’s asserted trademarks.

22. The goods and services offered by the Painter and the Musician are not closely related

23. The conditions surrounding the marketing of the goods and services offered by the Painter and the Musician are not such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that they come from a common source.

24. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

**C. The Musician's Asserted Trademarks are not Famous,
and the Painter has not Conducted any Activities that Constitute
Trademark Dilution or False Designation of Origin**

25. The Painter seeks a declaration that the Musician's asserted trademarks are not famous and that, in any event, the Painter has not conducted any activities that would constitute trademark dilution under 15 U.S.C. § 1125(c)(1), or false designation under 15 U.S.C. §1125(a)(1).

26. The Musician's asserted trademarks are not famous.

27. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

**D. The Painter has not Conducted any act of False Designation of Origin
or Unfair Competition**

28. The Painter seeks a declaration that the Painter has not conducted any act of false designation of origin or unfair competition.

29. The Painter has not sold or offered for sale his own goods and services as those of the Musician.

30. The Painter has not sold or offered for sale the Musician's goods and services as his own.

31. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

E. The Painter has not Violated the Anti-Cybersquatting Consumer Protection Act

32. The Painter seeks a declaration that he has not conducted any act in violation of the Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. §1125.

33. The Musician's asserted trademarks are not famous.

34. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

F. The Painter has not Violated the Tennessee Consumer Protection Act

35. The Painter seeks a declaration that the Painter has not conducted any act in violation of the Tennessee Consumer Protection Act, Tenn. Code Ann. § 47-18-104.

36. The Painter has not sold or offered for sale his own goods and services as those of the Musician.

37. The Painter has not sold or offered for sale the Musician's goods and services as his own.

38. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

G. The Painter has not Violated the Tennessee Personal Rights Privacy Act

39. The Painter seeks a declaration that the Painter has not conducted any act in violation of the Tennessee Personal Rights Privacy Act, §47-25-1106.

40. The Painter has used his own given name and not the Musician's name in connection with the website accessed at keithurban.com.

41. The Painter has not infringed or diluted any of the Musician's alleged intellectual property rights or committed any acts of false designation of origin or unfair competition.

H. The Musician is Precluded from Asserting the Claims in the Complaint

42. The Painter seeks a declaration that the Musician is precluded or prohibited from bringing any causes of action for infringement or dilution against the Painter under the equitable doctrines of estoppel, waiver, acquiescence, and laches and under the applicable statute of limitations.

43. The Musician knew or should have known about the Painter's right and legitimate interest in his given name as well as keithurban.com which have been in the open commercial market for a number of years, yet the Musician failed to take any action against the Painter with respect thereto for such a prolonged and unreasonable length of time that the Painter had no notice and no reason to conclude that the Musician was construing its rights in such a broad fashion as asserted in the present Complaint.

44. The Musician knew or should have known of the Painter's alleged infringement and dilution since at least as early as May 10, 1999, when the Painter first registered keithurban.com.

45. On information and belief, the Musician had actual notice of the Painter's activity with respect to keithurban.com since at least as early as May 10, 1999.

46. Since at least as early as May 10, 1999, the Painter has invested considerable time and expense in developing, marketing and promoting his goods and services at keithurban.com.

47. The Musician's long delay in challenging the Painter's alleged infringement and dilution, despite the fact that he has known of the alleged infringement and dilution for several years, is inexcusable and unreasonable.

48. Through its inexcusable and unreasonable delay, the Musician intentionally relinquished his right to challenge the alleged infringement and dilution by the Painter.

49. The Musician's claims, brought more than seven years after the Musician knew or should have known of the Painter's alleged infringement and dilution, are barred by the statute of limitations.

COUNT II – INJUNCTIVE RELIEF

50. The Painter incorporates the factual allegations set forth in the preceding paragraphs of both the Counterclaim and the Painter's Answer as if the same were fully written herein.

51. Pursuant to Fed. R. Civ. P. 65, the Painter seeks a permanent injunction consistent with the Declaratory Judgment, prohibiting the Musician and anyone in concert with him from attempting to cancel the registration of the Painter's domain name, keithurban.com; from interfering with the Painter's business relationship with the domain name registrar; and from using, operating or in any way interfering with the Painter's domain name, keithurban.com, and related website, so long as the Painter maintains his registration.

52. Without such injunction, the Painter will be irreparably harmed.

53. The Painter has no adequate remedy at law.

54. The injury that the Painter will receive absent an injunction is greater than any foreseeable harm to others.

PRAYER FOR RELIEF

WHEREFORE, the above premises considered, the Painter Keith D. Urban prays for the following relief:

1. That proper process issue and be served upon the Musician, Keith Lionel Urban;
2. That the Musician be required to answer;
3. That the Court order a speedy hearing, pursuant to Fed. R. Civ. P. 57, and advance it on the calendar, and declare that:
 - a. The Painter has priority over the Musician, and the exclusive right to register, use and operate the domain name keithurban.com and the related website, so long as the Painter maintains his registration;
 - b. The Painter has not created a likelihood of confusion;
 - c. The Musician's asserted trademarks are not famous, and the Painter has not conducted any activities that constitute trademark dilution or false designation of origin;
 - d. The Painter has not conducted any act of false designation of origin or unfair competition;
 - e. The Painter has not violated the Anti-Cybersquatting Consumer Protection Act;
 - f. The Painter has not violated the Tennessee Consumer Protection Act;
 - g. The Painter has not violated the Tennessee Personal Rights Privacy Act; and,
 - h. The Musician is precluded from asserting the claims in the Complaint.

4. That upon the conclusion of trial the Court issue a permanent injunction, enjoining the Musician and all persons acting in concert with him, from attempting to cancel the registration of the Painter's domain name, keithurban.com; from interfering with the Painter's business relationship with the domain name registrar; and from using, operating or in any way interfering with the Painter's domain name, keithurban.com, and related website, so long as the Painter maintains his registration;

5. That the Musician be ordered to pay the Painter such damages as the trier of fact determines the Painter has sustained as a result of the Musician's unlawful and wrongful acts;

6. That the Musician be ordered to pay the Painter such exemplary and punitive damages as this Court finds proper;

7. That the Musician be ordered to pay the full costs and reasonable attorneys' fees, plus pre- and post-judgment interest, that the Painter incurs in this action;

8. That a jury be empanelled; and

9. That this Court grant the Painter such other and additional relief as it deems just and equitable.

Respectfully submitted,

BONE McALLESTER NORTON PLLC

/s/ Stephen J. Zralek
Stephen J. Zralek, BPR #18971
Paul W. Kruse, BPR #13858
BONE MCALLESTER NORTON PLLC
511 Union Street, Suite 1600
Nashville, TN 37219
615.238.6300 – telephone
615.238.6301 – telefax
szralek@bonelaw.com
pkruse@bonelaw.com
Counsel for Defendant/Counter-Plaintif

CERTIFICATE OF SERVICE

I certify that on March 28, 2007, I served a copy of this document, via ECF, on:

William T. Ramsey, Esq.
Lisa B. Taplinger, Esq.
Cynthia S. Parson, Esq.
NEAL & HARWELL, PLC
150 Fourth Avenue, North, Suite 2000
Nashville, TN 37219
615.244.1713 – telephone
615.726.0573 – telefax
ramseywt@nealharwell.com
ltaplinger@nealharwell.com
cparson@nealharwell.com

Counsel for Plaintiff/Counter-Defendant

/s/ Stephen J. Zralek _____