

1 ANTHONY H. SON (CA Bar No. 190478)
WILEY REIN LLP
2 1776 K Street, NW
Washington, DC 20006
3 Telephone: 202-719-7416
Fax: 202-719-7049
4 ason@wileyrein.com

5 *Attorneys for Plaintiff Electronic Creations*
Corporation

6
7 **UNITED STATES DISTRICT COURT**
8 **NORTHERN DISTRICT OF CALIFORNIA**

9 ELECTRONIC CREATIONS CORPORATION,
10 Plaintiff,
11 v.
12 ASCENT REAL ESTATE, INC.,
13 Defendant.

Case No. _____

**COMPLAINT FOR DECLARATORY
RELIEF**

14
15 Plaintiff Electronic Creations Corporation (“ECC” or “Plaintiff”), for its Complaint
16 against Defendant Ascent Real Estate, Inc. (“Ascent” or “Defendant”), alleges:

17 **NATURE OF THE SUIT**

18 1. This action seeks a court declaration that ECC’s use of the ascentrealestate.com
19 domain name does not infringe on or dilute any valid and protectable trademark owned by
20 Ascent, including the marks A ASCENT REAL ESTATE (and design) and ASCENT REAL
21 ESTATE.

22 **JURISDICTION AND VENUE**

23 2. This is an action for declaratory relief brought under 28 U.S.C. §§ 2201 and 2202,
24 and under the Lanham Act, 15 U.S.C. §§ 1114(1)(a), 1125(a) and 1125(c). This Court has federal
25 question jurisdiction over this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and
26 1338(a).

27 3. Venue is proper in this Court pursuant to 28 U.S.C. § 1391 because ECC does
28 business in this district and a substantial part of the events giving rise to this litigation occurred in

1 this district, including the marketing and sales of services associated with the accused infringing
2 domain name and website.

3 4. This Court has personal jurisdiction over Ascent because, on information and
4 belief, it does business in and throughout the State of California and therefore has purposefully
5 availed itself of the laws of the State in which this judicial district sits.

6 **PARTIES**

7 5. Plaintiff ECC is a corporation organized and existing under the laws of the state of
8 Colorado, having a principal business address of 1275 Fourth Street, Suite 276, Santa Rosa, CA
9 95404. ECC is registered to do business in California under the name ELCR.

10 6. On information and belief, Defendant Ascent is a corporation organized and
11 existing under the laws of the State of California, having a principal place of business at Bankers
12 Hill, 410 Kalmia, San Diego, California 92101. On information and belief, Ascent does business
13 throughout the State of California. On information and belief, Ascent was established in 2005.

14 **BACKGROUND**

15 **ECC and Its Business**

16 7. Established in 1996, ECC is an Internet development company that provides
17 unique electronic services tailored for the web including building, leasing, and managing
18 websites.

19 8. ECC manages websites, e-mail accounts, and Internet domain names (web
20 addresses) for clients across the globe.

21 9. ECC's websites are solid and reliable, with user interfaces that speak of utter
22 simplicity while allowing the highest functionality and the most complex interaction with a
23 database. ECC's websites provide valuable information, tools, and services to consumers.

24 10. ECC's websites include, for example, ascentrealestate.com,
25 PropertyAppraisal.com, GoAuto.com, Pup.com, ElectronicCreations.com, VH.com, Cobb.com,
26 SonomaProperty.com, CommercialProperties.com, ElectronicAppraisal.com, CyberRealty.com,
27 DuckPond.com, MT.org, Petaluma.org, We.org, IllinoisTrader.com, IowaTrader.com,
28 MichiganTrader.com, MinnesotaTrader.com, OhioTrader.com, and WisconsinTrader.com.

1 11. Internet domain names, or “web addresses,” such as the domain name at the center
2 of this dispute, have an exceedingly high value because domain names are needed to locate and
3 access Internet websites and there are a limited number of available domain names.

4 **ECC’S Registration and Use of the Ascentrealestate.com Domain Name**

5 12. ECC is the owner of the ascentrealestate.com domain name and acquired the
6 domain name because the Ascent brand is positive and uplifting, and has religious connotations
7 for one of the principals of ECC. ECC’s portfolio of Ascent formative domain names includes
8 the following: AscentRealEstate.com, AscendRealEstate.com, AscensionHomes.com,
9 AscensionProperties.com, AscensionProperty.com, AscensionRealEstate.com, and
10 AscensionRealty.com.

11 13. ECC has used the ascentrealestate.com domain name to display webpages
12 containing information about various services related to real estate.

13 14. ECC has used and/or licensed the ascentrealestate.com domain name continuously
14 since acquiring the domain name.

15 15. ECC has displayed a website through the ascentrealestate.com domain name that
16 includes a search function for real estate which is provided by ZipRealty, Inc. (“ZipRealty”).
17 Upon information and belief, ZipRealty is a corporation organized under the laws of the State of
18 California with its principal place of business at 2000 Powell Street, Suite 300, Emeryville,
19 California 94608.

20 **Ascent’s Accusation of Trademark Infringement and Lanham Act Violations**

21 16. On information and belief, Ascent was formed as a corporation with the state of
22 California on April 4, 2005.

23 17. On information and belief, Ascent or its principal registered the domain name
24 ascentrealestate.net on or about March 30, 2005 after learning that ascentrealestate.com had
25 already been registered.

26 18. Ascent claims ownership of two U.S. registered trademarks: A ASCENT REAL
27 ESTATE (and Design), Registration No. 3,195,161; and ASCENT REAL ESTATE, Registration
28 No. 4,230,114 (referred to herein collectively as “the Ascent Marks”).

1 19. The mark A ASCENT REAL ESTATE (and Design), Registration No. 3,195,161,
2 was issued by the U.S. Patent and Trademark Office on January 2, 2007. The application for the
3 mark A ASCENT REAL ESTATE (and Design), Registration No. 3,195,161, was filed on June 2,
4 2005.

5 20. Registration No. 3,195,161 claims a sworn date of first use of the trademark in
6 U.S. interstate commerce of April 4, 2005—the same day that Ascent was incorporated.

7 21. Registration No. 3,195,161 includes a sworn affidavit by Ascent that “to the best
8 of his/her knowledge and belief no other person, firm, corporation, or association has the right to
9 use the mark in commerce, either in the identical form thereof or in such near resemblance thereto
10 as to be likely, when used on or in connection with the goods/services of such other person, to
11 cause confusion, or to cause mistake, or to deceive.”

12 22. The mark ASCENT REAL ESTATE, Registration No. 4,230,114, was issued by
13 the U.S. Patent and Trademark Office on October 23, 2012. The application for the mark
14 ASCENT REAL ESTATE, Registration No. 4,230,114, was filed on March 21, 2012.

15 23. Registration No. 4,230,114 claims a sworn date of first use of the trademark in
16 U.S. interstate commerce of April 1, 2005—three days before Ascent was incorporated.

17 24. Registration No. 4,230,114 includes a sworn affidavit by Ascent that “to the best
18 of his/her knowledge and belief no other person, firm, corporation, or association has the right to
19 use the mark in commerce, either in the identical form thereof or in such near resemblance thereto
20 as to be likely, when used on or in connection with the goods/services of such other person, to
21 cause confusion, or to cause mistake, or to deceive.”

22 25. On April 8, 2013, Ascent sent a letter (“Ascent April 2013 Letter”) to ECC’s
23 business partner ZipRealty, asserting Ascent’s purported rights associated with the Ascent Marks.
24 *See Exhibit A.*

25 26. A copy of the Ascent April 2013 Letter was sent by Ascent to ECC.

26 27. The Ascent April 2013 Letter asserted that ZipRealty’s use of the term “Ascent
27 Real Estate” in the ascentrealestate.com domain name infringes Ascent’s trademarks, is
28 actionable under the Lanham Act, and that such conduct is actionable under California state law

1 as trademark infringement, unfair competition, injury to business reputation, and trademark
2 dilution.

3 28. The Ascent April 2013 Letter further demanded that ZipRealty, Inc. cease and
4 desist from all further use of “Ascent Real Estate.”

5 29. ECC, via a letter dated April 30, 2013 (“ECC April 2013 Letter”), responded to
6 Ascent’s threat of trademark infringement and the other purported legal violations. *See* Exhibit
7 B.

8 30. In the ECC April 2013 Letter, ECC also requested that Ascent retract its claim of
9 trademark infringement and other purported violations. ECC further warned that, if Ascent did
10 not retract its claims, ECC would consider pursuing: (1) the cancellation of Ascent’s trademark
11 registrations on grounds of priority; (2) a claim of tortious interference; and (3) a declaration of
12 the lawfulness of ECC’s actions under the Lanham Act and the Anticybersquatting Consumer
13 Protection Act (“ACPA”).

14 31. Ascent responded in writing via a letter dated June 14, 2013 (“Ascent June 2013
15 Letter”). *See* Exhibit C.

16 32. In the Ascent June 2013 Letter, Ascent did not withdraw its accusations of
17 trademark and other violations set forth in its April 2013 Letter. In the Ascent June 2013 Letter,
18 Ascent reiterated its belief that “ECC and ZipRealty are in violation of the Lanham Act.”

19 **COUNT I**

20 **CLAIM FOR DECLARATORY RELIEF**

21 **(Declaration of No Trademark Infringement)**

22 33. ECC incorporates herein by reference each and every allegation contained in
23 Paragraphs 1-32 above, as though fully set forth herein.

24 34. By virtue of the Ascent April 2013 Letter and the Ascent June 2013 Letter, there is
25 an actual and existing controversy between ECC and Ascent in that Ascent has demanded that
26 ECC and its business partner cease using the ascentrealestate.com domain name and transfer the
27 ascentrealestate.com domain name to Ascent. Ascent has not renounced the threatened claims
28 against ECC under the Lanham Act and common law.

1 43. The actions described above evidence reasonable grounds for belief by ECC that
2 the use of the domain name was a fair use or otherwise lawful.

3 44. ECC is entitled to a judgment of no bad faith intent in the registration or use of the
4 domain name.

5 45. In light of such controversy between the parties, ECC seeks a declaration from this
6 Court that ECC's registration and use of the ascentrealestate.com domain name does not violate
7 the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d).

8 46. Such a declaration is necessary and proper at this time in that, among other things,
9 such a declaration will establish whether ECC and its business partner ZipRealty, Inc. may
10 continue using the ascentrealestate.com domain name.

11 **PRAYER FOR RELIEF**

12 WHEREFORE, ECC respectfully requests of this Court:

13 1. For a declaration that the ECC's use of the ascentrealestate.com domain name does
14 not:

15 a. Infringe or dilute any of Ascent's registered trademarks or any common
16 law rights it might have accrued;

17 b. Violate Section 32 of the Lanham Act, 15 U.S.C. § 1114(1)(a);

18 c. Violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);

19 d. Violate Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c);

20 e. Violate Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d); or

21 f. Violate any applicable common law or statutory unfair competition law;

22 2. That the Court order an award of costs and reasonable attorneys' fees, pursuant to
23 the Lanham Act, or as otherwise permitted by law, incurred by ECC in connection with this
24 action; and

25 ///

26 ///

27 ///

28 ///

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

3. That ECC be awarded such other and further relief as the Court may deem just and proper.

Dated: October 7, 2013

Respectfully submitted,

/s/ Anthony H. Son
By: Anthony H. Son

WILEY REIN LLP
Anthony H. Son

Attorneys for Plaintiff
ELECTRONIC CREATIONS CORPORATION