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10 **UNITED STATES DISTRICT COURT**
11 **DISTRICT OF ARIZONA**

12 David Dent, an individual,

Case No. CV-17-651-PHX-DMF

13 Plaintiff,

14 vs.

15 Lotto Sport Italia, S.p.A.,
16 an Italian Corporation,

17 Defendant.

18 **DEFENDANT LOTTO SPORT ITALIA, S.P.A.'S**
19 **MOTION FOR SUMMARY JUDGMENT**

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DEFENDANT LOTTO SPORT ITALIA, S.P.A.’S
MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Defendant Lotto Sport Italia, S.p.A. (“Lotto”) moves for summary judgment as to each surviving claim for relief contained in Plaintiff’s Complaint.

MEMORANDUM OF POINTS AND AUTHORITIES

1.0 INTRODUCTION

Dent is a cybersquatter and cannot show that his registration and use of <lottoworks.com> and <lottostore.com> (the “Infringing Domain Names”) did not violate the Lanham Act or the Anti-cybersquatting Consumer Protection Act (the “ACPA”). With regard to the Lanham Act, Dent’s registration and use of the Infringing Domain Names created a likelihood of confusion. After all, both Infringing Domain Names contained the entirety of Lotto’s distinctive marks, and one of them offered links to Lotto’s competitors.

With respect to the ACPA, Dent argues that he did not act in bad faith when he registered, used, or trafficked in the Infringing Domain Names. However, he admits that he performed no due diligence and that he **never** performs due diligence prior to registering domain names. He registered and used distinctive domains with no knowledge regarding whether he was violating anyone’s intellectual property rights. This constitutes bad faith.

Finally, Dent demands damages and reimbursement of his attorneys’ fees. None of the remedies for his asserted claims for relief allow for an award of damages or attorneys’ fees. In the unlikely event that he does prevail, he is requesting relief that is unavailable to him. Given that Dent is not entitled to the relief requested in his Complaint, Lotto respectfully requests that the instant Motion be granted.

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1 **2.0 LEGAL ARGUMENT**

2 **2.1 Standard of Review**

3 Summary judgment is appropriate if “there is no genuine issue as to any **material** fact
4 and the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c); *Jesinger*
5 *v. Nev. Fed. Credit Union*, 24 F.3d 1127, 1130 (9th Cir. 1994) (emphasis added). Once a
6 defendant has identified parts of the record showing an absence of an issue of material fact,
7 “the nonmoving party must ‘designate specific facts showing that there is a genuine issue for
8 trial.’” *Brinson v. Linda Rose Joint Venture*, 53 F.3d 1044, 1048 (9th Cir. 1995).

9 **2.2 Declaratory Relief (28 U.S.C. § 2201)**

10 Dent asks for a declaration pursuant to 28 U.S.C. § 2201 that he did not violate the
11 Lanham Act. The language of the claim asks the Court to hold that he did not violate the
12 Lanham Act but only contains language regarding whether Dent registered the Infringing
13 Domain Names in bad faith, contrary to the provisions of 15 U.S.C. § 1125(d)(1)(B)(ii).
14 Section 1125 is the ACPA, one tiny sliver of the Lanham Act. Even if he did not violate this
15 sliver, Dent violated the Lanham Act and infringed upon Lotto’s intellectual property rights.
16 He is not entitled to the relief he requests.

17 **3.2.1 Dent Violated the Lanham Act**

18 Dent is liable for trademark infringement under Section 43(a) of the Lanham Act if he:
19 uses in commerce any ... name ... or any false designation of
20 origin, false or misleading description of fact, which (A) is likely
21 to cause confusion, or to cause mistake, or to deceive as to the
22 affiliation, connection, or association of such person with
23 another person, or as to the origin, sponsorship, or approval of
24 his or her goods, services, or commercial activities by another
25 person.

15 U.S.C. § 1114(1)(a) forbids using any “reproduction” or “colorable imitation of a registered
24 mark in conjunction with the sale, offering for sale, distribution, or advertising of any goods
25

1 or services in connection with which such use is likely to cause confusion, or to cause mistake,
2 or to deceive.”

3 Here, as Plaintiff, the burden of proof is on Mr. Dent to show that his use of Lotto’s
4 marks “is [not] likely to cause confusion or mistake among the general public.” *Perfect 10, Inc.*
5 *v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146, 1187 (C.D. Cal. 2002). He cannot do so.

6 Courts determine likelihood of confusion as a matter of law at summary judgment. *See*
7 *Murray v. Cable Nat’l Broad Co.*, 86 F.3d 858, 859 (9th Cir. 1996). In cases involving domain
8 names, confusion may occur when Mr. Dent’s sole action was the registering of an infringing
9 domain name. *See Green Prods. Co. v. Independence Corn By-Prods. Co.*, 992 F. Supp. 1070, 1080
10 (N.D. Iowa 1997).

11 To show that there is no likelihood of confusion, Mr. Dent must provide some
12 evidence that the similarity of his domain names to Lotto’s marks is unlikely to “confuse
13 customers about the source of the products.” *Abercrombie & Finch Co. v. Moose Creek, Inc.*, 486
14 F.3d 629, 633 (9th Cir. 2007). Mr. Dent must be able to prove that, even though his domains
15 are identical to Lotto’s marks, consumers would **not** be likely to assume that his domain names
16 are related to Lotto’s marks. *Acad. Of Motion Picture Arts & Scis. v. Creative House Promotions,*
17 *Inc.*, 944 F.2d 1446, 1455-56 (9th Cir. 1991).

18 The record is void of any evidence for Dent to meet his burden. No surveys. No
19 evidence. No expert testimony. He simply has taken domain names that correspond precisely
20 to Lotto’s marks, where there were ads on those domains for Lotto’s competitors,¹ and expects
21 this Court to hold that he did not violate the Lanham Act. The U.S. Court of Appeals for the
22 Ninth Circuit uses a non-exhaustive eight-factor test enumerated in *AMF, Inc. v. Sleekcraft Boats,*

23
24
25 ¹ While Lotto is aware of multiple Dent domains that contain infringing links, it cannot show that one of them, <lottostore.com>, ever displayed infringing links.

1 599 F.2d 341 (9th Cir. 1979) to determine whether a defendant’s use of a mark is confusingly
2 similar, which will be analyzed below.

3 3.2.1.1 Lotto’s Rights to Its Marks

4 First, Lotto’s marks are famous or, at the very least, distinctive and entitled to
5 protection. As noted in the Statement of Undisputed Facts, the LOTTO mark originated
6 when the *Caberlotto* family truncated their name as LOTTO for their sportswear and footwear
7 company. (*See* Statement of Undisputed Facts (“SUF”), at ¶ 1.) The company was formed in
8 1973 and concentrates its sales on athletic footwear, sportswear, and sports accessories. (*See*
9 *id.*, at ¶ 2.) The LOTTO mark is used by Lotto in over 110 countries, including the United
10 States. (*See id.*, at ¶ 3.) Lotto possesses registrations for LOTTO and variations thereof in
11 over 110 countries, including the United States. (*See id.*) Many of Lotto’s registered marks in
12 the United States have been deemed incontestable. (*See id.*, at ¶ 8.) It conducts extensive
13 business on the World Wide Web, using <lottosport.com> and other domain names,
14 including <lottoworks.net>, which it registered in 2004. (*See id.*, at ¶ 6.)

15 The LOTTO marks are *arbitrary trademarks*² because the LOTTO marks do not suggest
16 that Lotto uses them to offer sporting equipment, sportswear, and related items. *See*
17 *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 n.2 (9th Cir. 2002). Alternatively, at the
18 very least, Lotto’s LOTTO marks are *suggestive trademarks*³ because they “require imagination,
19 thought, or perception to link the trademark with the goods offered.” *Interstellar Starship*
20 *Services*, 304 F.3d at 943 n.6.

23 _____
24 ² For example, using “Amazon” as an online bookstore is an arbitrary trademark. *Interstellar Starship Services, Ltd. v. Epix, Inc.*, 304 F.3d 936, 943 n.6 (9th Cir. 2002).

25 ³ For example, using “Roach Motel” for insect traps is a suggestive trademark. *See Interstellar Starship Services*, 304 F.3d at 943 n.6.

3.2.1.2 The *Sleekcraft* Factors

The Ninth Circuit uses an eight-factor test to determine whether there is a likelihood of confusion. Seven of these factors weigh heavily in Lotto's favor:

1. *Strength of the mark*: Lotto's marks are strong and either arbitrary or suggestive and thus automatically entitled to federal trademark protection. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

2. *Proximity of the goods*: Mr. Dent claims that he registered the Infringing Domain Names to offer lottery services, but neither Infringing Domain has ever been used for that purpose. In fact, <lottoworks.com> was used to display links to Lotto's competitors, offering identical goods to Lotto's.⁴ (*See* SUF, at ¶ 16.) Similarly, Dent's campaign to disrupt Lotto's business includes at least 9 other domains used the same way. (*See id.*, at ¶ 24.) Lotto sells its goods on the Internet on online stores, and consumers would visit <lottostore.com> and expect to see Lotto's goods for sale. At the least, consumers would suffer initial interest confusion. "Initial interest confusion is customer confusion that creates initial interest in a competitor's product. Although dispelled before an actual sale occurs, initial interest confusion impermissibly capitalizes on the goodwill associated with a mark and is therefore actionable trademark infringement." *Playboy Enters. v. Netscape Commc'ns. Corp.*, 354 F.3d 1020, 1025 (9th Cir. 2004); *see also*; *Brookfield Communs., Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999).

3. *Similarity of the marks*: <lottoworks.com> contains the entirety of Lotto's registered LOTTO WORKS mark, and <lottostore.com> contains the entirety of Lotto's

⁴ In fact, Dent continues to maintain and register domain names containing Lotto's marks, and the associated websites display advertisements for Lotto's competitors and for Lotto itself. (*See* SUF, at ¶ 24.)

1 LOTTO mark, along with the descriptive word “store.” The Infringing Domain Names are
2 identical to Lotto’s registered, famous marks.

3 4. *Evidence of actual confusion:* Actual confusion is unnecessary to find a likelihood of
4 confusion. *See Acad. of Motion Picture Arts & Scis.*, 944 F.2d at 1456. Rather, “[l]ikelihood of
5 confusion will be found whenever consumers are likely to assume that a mark is associated
6 with another source or sponsor because of the similarities between the two marks.” *Id.* Here,
7 the Infringing Domain Names are not only similar to Lotto’s marks; they are identical.

8 5. *Marketing channels used:* “Convergent marketing channels increase the likelihood
9 of confusion.” *Sleekcraft*, 599 F.2d at 353. Here, the marketing channels are identical – the
10 internet.

11 6. *Type of goods and purchaser care:* Here, the Court should consider the buyer to be
12 an online shopper who may be easily distracted by competing links or a website bearing Lotto’s
13 trademarks. Lotto’s goods are footwear, which is not terribly expensive or specialized, leaving
14 shoppers unlikely to exercise great care. *See, e.g., K-Swiss, Inc. v. USA Aisiqui Shoes, Inc.*, 291 F.
15 Supp. 2d 1116, 1125 (C. D. Cal. 2003); *Asics Corp. v. Payless Shoe Source, Inc.*, 2006 U.S. Dist.
16 LEXIS 103078, at *20 (Aug. 23, 2006). It is very likely that a consumer would see links for
17 products similar to Lotto’s on one of Mr. Dent’s websites and be confused as to the origin or
18 sponsorship of his goods or services. *See Brookfield*, 174 F.3d at 1066. Dent cannot
19 demonstrate otherwise, and it is his burden.

20 7. *Likelihood of expansion:* <lottoworks.com> already offers goods competitive with
21 Lotto’s. Mr. Dent continues to maintain and register domain names containing Lotto’s marks.
22 (*See* SUF, at ¶ 24.) Mr. Dent has claimed that he could not control whether these competitive
23 ads were displayed because there was a pending dispute, and thus GoDaddy blocked him from
24 modifying the sites associated with the Infringing Domain Names. (*See* SUF, at ¶ 17.)

25

1 However, with the <lottoworks.com> Infringing Domain Name, he removed the
2 competitive ads on or about March 21, 2017 in order to make himself look better during this
3 litigation. (*See* SUF, at ¶ 18.) This case was filed mere weeks earlier, and Dent desired to get
4 the infringing links off of the website associated with the <lottoworks.com> Infringing
5 Domain Name prior to Lotto’s entry into the case and the commencement of discovery. (*See*
6 Doc. # 9). Moreover, Dent possesses registrations for at least nine additional domain names
7 containing Lotto’s marks. (*See* SUF, at ¶ 24.) Those domain names are not subject to any
8 dispute and still contain advertisements for Lotto and its competitors. (*See id.*)

9 Under a Lanham Act analysis, Plaintiff Dent cannot prevail on his claim pursuant to
10 15 U.S.C. § 1114(2)(D)(v). The Infringing Domain Names should be transferred to Lotto,
11 and this Court should enter judgment on Lotto’s behalf.

12 **3.2.2 Dent Violated The ACPA**

13 Dent demands that this Court declare that his registration and use of the Infringing
14 Domain Names “does not violate Defendant’s rights under the Lanham Act.” (Complaint, at
15 ¶ 34.) He asserts that he “reasonably believes its [sic] registration and use of the [Infringing]
16 Domain Names was and is lawful under the Lanham Act” but does not explain how links to
17 Lotto’s competitors is lawful under the Act. (*Id.*, at ¶ 37.) This Court should examine whether
18 Mr. Dent’s conduct was unlawful under the entire Lanham Act. Nevertheless, his actions still
19 violated the ACPA. Mr. Dent’s actions violate the ACPA if he (1) registered, trafficked, or
20 used a domain name that (2) is identical or confusingly similar to a distinctive mark, or is
21 identical, confusingly similar to, or dilutive of a famous mark (3) with a bad faith intent to
22 profit. *See* 15 U.S.C. § 1125(d)(1).

23 Here, Mr. Dent registered <lottoworks.com> and <lottostore.com>. (*See* SUF, at
24 ¶¶ 11-12.) <lottoworks.com> is identical to Lotto’s registered LOTTO WORKS mark, which
25

1 has been in continuous use by Lotto for over twelve years. (*See* SUF, at ¶¶ 8(h), 10.
2 <lottostore.com> contains the entirety of Lotto’s famous LOTTO marks along with “store,”
3 a descriptive term for an online or brick-and-mortar location where consumers would expect
4 to buy Lotto’s products. *See Perfumebay, Inc. v. eBay, Inc.*, 506 F.3d 1165, 1174 (9th Cir. 2007)
5 (finding the “requisite similarity between PERFUMEBAY and EBAY because the
6 PERFUMEBAY mark incorporates the entirety of the EBAY mark”); SUF, at ¶ 8. Both
7 Infringing Domain Names are identical, or confusingly similar to, Defendant’s marks.

8 To determine bad faith, the most important factors to consider are the unique
9 circumstances of the particular case. *See Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190,
10 1220 (9th Cir. 2012). In addition, the ACPA contains nine non-exclusive factors to assist the
11 Court in a determination of bad faith. *See* 15 U.S.C. § 1125(d)(1)(B)(i).

12 With regard to the unique circumstances of this case, a domain registrant can exhibit a
13 bad faith intent to profit when he registers a domain name “without first conducting a
14 reasonable investigation, let alone any investigation, as to whether [the domains] infringed on
15 any other party’s rights” and “by having a practice and custom of registering domain names
16 without first conducting reasonable investigations as to whether the domain names infringed
17 upon any other party’s rights.” *NextEngine Ventures, LLC v. Lestar, Inc.*, 2015 U.S. Dist. LEXIS
18 169672, at *9 (C.D. Cal. Dec. 8, 2014) (holding that the registrant acted in bad faith by
19 performing no investigation prior to registering <gocables.com>). Failure to perform a
20 reasonable investigation precludes Mr. Dent from seeking shelter under the ACPA’s bad faith
21 safe harbor. *See id.* at *10. After all, it is unreasonable for the registrant to believe that use of
22 the domain was lawful “without first conducting a reasonable investigation as to whether [the
23 Infringing Domain Names] infringed on any other party’s rights.” *Id.*

1 Here, Mr. Dent admits that he performed no due diligence or investigation prior to
2 registering the <lottoworks.com> and <lottostore.com> Infringing Domain Names. (*See*
3 *SUF*, at ¶ 14.) In an interview with his designated rebuttal expert witness, Jefford Englander,
4 Mr. Dent admitted that he never performs any investigation prior to registering domain names.
5 (*See id.*, at ¶ 15.) This is presumably why Mr. Dent had his rebuttal expert opine that no due
6 diligence or best practices were required prior to registration of a domain name. (*See id.*) Of
7 course, on this subject, Mr. Englander’s opinion is not a legal opinion worthy of any weight.

8 Mr. Dent acted in bad faith by registering the Infringing Domain Names. Looking at
9 the non-exclusive factors enumerated in the ACPA, most weigh strongly in favor of a finding
10 of bad faith against Mr. Dent, as follows:

11 I. *The trademark or other intellectual property rights of the person, if any, in the domain name:*
12 Mr. Dent admittedly has no trademark rights in either domain name (*SUF*, at ¶ 14).

13 II. *The extent to which the domain name consists of the legal name of the person or a name that*
14 *is commonly used to identify that person:* Mr. Dent does not claim, and there is no evidence to
15 suggest, that Mr. Dent is commonly known as “lotto works” or “lotto store.”

16 III. *The person’s prior use, if any of the domain name in connection with the bona fide offering of*
17 *any goods or services:* The Infringing Domain Names have never been used to offer any bona fide
18 goods or services. The only goods that have ever been offered on either Infringing Domain
19 were ads for Lotto’s competitors and ads offering the domains for sale. (*SUF*, at ¶¶ 16, 19).

20 IV. *The person’s bona fide noncommercial or fair use in a site accessible under the domain name:*
21 Mr. Dent has never used the Infringing Domain Names in a noncommercial or fair manner.

22 VIII. *The person’s registration or acquisition of multiple domain names which the person knows are*
23 *identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain*
24 *names, or dilutive of the famous marks of others that are famous at the time of registration of such domain*
25

1 *names, without regard to the goods or services of the parties:* As demonstrated in the Statement of Facts,
2 Mr. Dent registered <arialasvegas.co>, <minecraftxxx.com>, <vallartaremax.com>,
3 <remaxvallarta.com>, and <remaxvallartarealty.com>. Each of these domains contains the
4 distinctive marks of others, meaning Dent is a cybersquatter. (SUF, at ¶¶ 25-26).

5 In conjunction with the eighth factor, above, Mr. Dent continues to register domain
6 names containing Lotto's marks, and those domain names continue to offer links to Lotto's
7 goods and to the goods and services of Lotto's competitors. (*See* SUF, at ¶ 24.) It would be
8 easy for Mr. Dent to remove these links if he intended not to infringe Lotto's intellectual
9 property, but he has not done so. His intent is clear.

10 Mr. Dent cannot show that his registration and use of <lottoworks.com> and
11 <lottostore.com> was not unlawful under the Lanham Act or the ACPA. His claim for relief
12 pursuant to 15 U.S.C. § 1114(2)(D)(v) must fail.

13 **2.3 Reverse Domain Name Hijacking (15 U.S.C. § 1114(2)(D)(v))**

14 **3.3.1 Elements of Claim**

15 15 U.S.C. § 1114(2)(D)(v) provides that a domain name registrant "whose domain
16 name has been suspended, disabled, or transferred" may "file a civil action to establish that
17 the registration or use of the domain name by such registrant is not unlawful under this
18 chapter." If the registrant demonstrates that his use was not unlawful, the "court may grant
19 injunctive relief to the domain name registrant, including the reactivation of the domain name
20 or transfer of the domain name to the domain name registrant." 15 U.S.C. § 1114(2)(D)(v).
21 Dent has not sought injunctive relief. He has only sought damages and is not entitled to any.

22 Few courts have analyzed this statute. However, to prevail upon a claim asserted under
23 subsection (v), Plaintiff Dent must demonstrate that: (1) he was a domain name registrant;
24 (2) his domain names were suspended, disabled, or transferred as a result of Lotto's complaint;

25

1 and (3) Dent’s registration and use was not unlawful. *Black v. Irving Materials, Inc.*, 2019 U.S.
2 Dist. LEXIS 135882, at *29 (N.D. Cal. Aug. 10, 2019).

3 Here, Defendant Lotto concedes the first two prongs. Dent registered the
4 <lottoworks.com> and <lottostore.com> Infringing Domain Names. Moreover, Lotto filed
5 an arbitration and the arbitrator found for Lotto and ordered the Infringing Domain Names
6 transferred. However, Mr. Dent cannot prove that his registration and use of the Infringing
7 Domain Names was not unlawful, necessitating that this Court issue summary judgment on
8 this claim in Lotto’s favor.

9 With regard to the requirement that Mr. Dent demonstrate that his registration and use
10 of the Infringing Domain Names was not unlawful “under this chapter,” courts are split
11 regarding whether “this chapter” refers to the Lanham Act as a whole or the Anti-
12 cybersquatting Consumer Protection Act (the “ACPA”). *See Barcelona.com v. Excelentisimo*
13 *Ayuntamiento de Barcelona*, 330 F.3d 617, 627 n.2 (4th Cir. 2003) (concluding that subsection (v)
14 refers to the Lanham Act); *but see Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 18 (1st
15 Cir. 2001) (holding that subsection (v) refers to the ACPA). Defendant asserts that subsection
16 (v) was intended to refer to the Lanham Act as a whole. “[T]his chapter” can only refer to the
17 Lanham Act as a whole and not the ACPA individually. However, regardless of this Court’s
18 interpretation of “this chapter,” judgment should be entered in Lotto’s favor.

19 Logically, Congress meant for subsection (v) to refer to the Lanham Act as a whole
20 when it passed 15 U.S.C. § 1114(2)(D)(v). The subsection specifically states that the registrant
21 must demonstrate that his registration and use was not unlawful “under this chapter.” “[T]his
22 chapter” must refer to Chapter 22 of the United States Code, entitled “Trademarks.” If
23 Congress intended to limit “this chapter” to the ACPA, it would not have used such expansive
24
25

1 language. The Court’s analysis of whether Mr. Dent’s actions were lawful should not be
2 restricted to the ACPA but to the Lanham Act as a whole.

3 Consider the effect of the statute if this is not the correct interpretation: Since there
4 are hefty statutory damages if a registrant violates the ACPA, its standard is higher than the
5 rest of the Lanham Act. Therefore, proving that one did not violate the narrower provisions
6 of the ACPA is easier than proving that one did not violate the much broader Lanham Act.

7 Dent will take the position that the statute only requires Dent to prove that he did not
8 violate the ACPA. However, that interpretation leaves him free to violate the remainder of
9 the Lanham Act without consequence. If his eventual interpretation is used, a cybersquatter
10 with a claim for Reverse Domain Name Hijacking could do the following:

11 (1) The cybersquatter could register, use, or traffic in a domain name that violates
12 a trademark owner’s rights under the Lanham Act, but that just barely escapes the higher
13 standard of the ACPA.

14 (2) The cybersquatter loses a UDRP arbitration because of his bad faith conduct.

15 (3) The cybersquatter could then sue the trademark owner under the Reverse
16 Domain Name Hijacking statute.

17 (4) Then, if the “only the ACPA” standard is employed, the cybersquatter would
18 regain control of the infringing domain name – despite his violation of the Lanham Act.

19 Dent would have this Court codify the availability of relief to a cybersquatter who
20 violated the law, and would deny control of a domain name to an honest business. That simply
21 does not make sense. That could require a court to grant equitable relief, in a case under a
22 sub-chapter of the Lanham Act, to a party who violated the Lanham Act, as long as that party
23 was careful enough to avoid violating one smaller sub-section of the Lanham Act.

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1 With all due respect to the courts that suggested otherwise, that would require an
2 absurd result. Courts should always begin the analysis of a statute with an examination of its
3 plain language. *See Jimenez v. Quarterman*, 555 U.S. 113, 118 (2009). If the plain language of the
4 statute “is clear and consistent with the statutory scheme at issue, the statute’s plain language
5 is conclusive and [the court] need not inquire beyond the plain language of the statute.” *In re*
6 *Jackson*, 184 F.3d 1046, 1051 (9th Cir. 1999). As demonstrated above, the plain language of
7 subsection (v) is clear. It applies to Chapter 22 as a whole and not to the ACPA.

8 **3.3.2 Dent’s Registration Was Unlawful**

9 Here, Dent needs to prove that his registration was lawful pursuant to the Lanham Act.
10 Lotto’s arguments with regard to whether Dent is entitled to a declaratory judgment that he
11 did not violate the Lanham Act are applicable here and incorporated herein. Moreover, in the
12 unlikely event that the Court determines that 15 U.S.C. § 1114(2)(D)(v) applies only to the
13 ACPA, the Court can additionally refer to Lotto’s arguments above demonstrating that Dent
14 registered, used, or trafficked in the Infringing Domain Names in bad faith. To hold that it is
15 “not unlawful” to register a registration of a domain name that 100% corresponds to a
16 registered trademark, without doing any due diligence, would license an avalanche of bad
17 behavior by cybersquatters.

18 **3.3.3 Available Remedies Under Subsection (v)**

19 With respect to this claim, Mr. Dent asks the Court solely for “costs and expenses ...
20 and reasonable attorneys’ fees.” (Complaint, at Prayer For Relief ¶ 3.) He additionally asks
21 for statutory damages pursuant to the ACPA, even though he has not made a claim for
22 cybersquatting. (*See id.* at ¶ 4.) He is entitled to nothing.

23 Claims made pursuant to 15 U.S.C. § 1114(2)(D)(v) are declaratory relief claims and are
24 not affirmative claims. *See Black*, 2019 U.S. Dist. LEXIS 135882, at *38-39. By its plain
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1 language, the subsection only authorizes a court to “grant injunctive relief to the domain name
2 registrant, including the reactivation of the domain name or transfer of the domain name to
3 the domain name registrant.” Here, Mr. Dent’s Prayer for Relief does not ask this Court for
4 injunctive relief or to prevent transfer of the Infringing Domain Names to Defendant Lotto.

5 Mr. Dent demands that this Court award him statutory damages pursuant to 15 U.S.C.
6 § 1125(d)(1). However, he did not assert a claim for relief pursuant to Section 1125.
7 Therefore, damages under that section are not available to him. *See MailPlanet.com, Inc. v. Lo*
8 *Monaco Hogar, S.L.*, 2007 U.S. Dist. LEXIS 105076, at *14-15 (S.D. Fl. Dec. 17, 2007) (holding
9 that statutory damages under 15 U.S.C. § 1125(d)(1) are not available when a party asserts a
10 claim pursuant to 15 U.S.C. § 1114(2)(D)(v)).

11 Regarding attorneys’ fees and costs, while certain provisions of the Lanham Act and
12 the ACPA provide for an attorneys’ fee and costs award to the prevailing party, subsection (v)
13 is silent regarding reimbursement of fees and costs. It is accepted that where “Congress
14 includes particular language in one section of a statute but omits it in another section of the
15 same Act, it is generally presumed that that Congress acts intentionally and purposely in the
16 disparate inclusion or exclusion.” *Wang v. Societe du Figaro*, -- F.3d --, 2018 U.S. Dist. LEXIS
17 13119, at *47-48 (S.D. N.Y. Jan. 26, 2018).

18 Based upon Lotto’s research, two courts have opined upon whether attorneys’ fees and
19 costs may be awarded on successful claims asserted under subsection (v). Both concluded
20 that they may not. *See Wang*, 2018 U.S. Dist. LEXIS 13119, at *40, 49 (holding that subsection
21 (v) “provides only for injunctive relief to the domain name registrant” and does not authorize
22 an award of fees and costs); *MailPlanet.com*, 2007 U.S. Dist. LEXIS 105076, at *14-15.

23 Subsection (v) only authorizes this Court to provide Dent with injunctive relief, **which**
24 **he does not request**. This claim fails on its merits. Even if Dent had succeeded in asserting
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1 a valid claim for relief pursuant to subsection (v), he has failed to ask the Court for any relief
2 permitted under the subsection and should take nothing by way of this claim for relief.

3 Moreover, Dent has unclean hands, rendering him ineligible for an injunction. Because
4 unclean hands is an equitable remedy, traditional equitable considerations like unclean hands
5 may militate against issuing an injunction even if the requesting party would otherwise be
6 entitled to one. *See Inst. Of Cetacean Research v. Sea Shepherd Conservation Soc’y*, 725 F.3d 940, 947
7 (9th Cir. 2013). Here, Dent admittedly did not exercise any diligence before registering the
8 Infringing Domain Names. (*See* SUF, at ¶ 14.) The website located at <lottoworks.com>
9 displayed advertisements for Lotto’s competitors while it was registered by Dent. (*See id.*, at
10 ¶ 16.) He currently possesses registrations for numerous other domain names that display
11 advertisements for Lotto and its competitors and has taken no attempts to remove those
12 advertisements. (*See id.*, at ¶ 24.) The arbitrator additionally held that Dent conveniently
13 omitted that he registered the <lottoworks.com> Infringing Domain Name in 2016, and not
14 1998, to make it appear as though his rights in the Domain predated Lotto’s rights in its marks.
15 (*See* SUF, at ¶ 23(a).) Even if Dent was otherwise entitled to an injunction (he is not), his own
16 bad acts would prevent the court from using its equitable powers to grant him one.

17 Lotto has already provided its analysis regarding Mr. Dent’s violations of the ACPA
18 and the larger Lanham Act above. It incorporates those arguments as if set forth fully herein.

19 3.2.3 Exceptionality of the Case

20 Section 35(a) of the Lanham Act provides that courts may award a reasonable
21 attorneys’ fee to the prevailing party in “exceptional cases.” 15 U.S.C. § 1117(a). Plaintiff
22 Dent does not argue that this case is exceptional and appears to only request attorneys’ fees
23 pursuant to 15 U.S.C. § 1114(2)(D)(v). However, subsection (v) does not permit an award of
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1 attorneys' fees. Moreover, if Mr. Dent does request fees pursuant to Section 1117(a), they are
2 not available to him. On the other hand, Lotto *should* be granted its fees.

3 Courts should determine whether a case is “exceptional” through an examination of
4 the “totality of the circumstances.” *Sunearth, Inc. v. SunEarth Solar Power Co.*, 839 F.3d 1179,
5 1180 (9th Cir. 2016), *citing Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749,
6 1756 (U.S. 2016). An exceptional case “is simply one that stands out from others with respect
7 to the substantive strength of a party’s litigating position ... or the unreasonable manner in
8 which the case was litigated.” *Id.* Among other things, the trial court should consider
9 “frivolousness, motivation, objective unreasonableness (both in the factual and legal
10 components of the case), and the need in particular circumstances to advance considerations
11 of compensation and deterrence.” *Id.*

12 Here, Mr. Dent registered <lottostore.com> and <lottoworks.com>. (*See* SUF, at
13 ¶¶ 11-12.) He registered the <lottoworks.com> Infringing Domain about one month after
14 Lotto filed an application with the USPTO and about a decade after it started using the mark
15 in commerce. (*See id.*, at ¶¶ 8(h), 10.) The <lottostore.com> website immediately forwarded
16 it to a page offering it for sale, while the <lottoworks.com> resolved to a page offering links
17 to Lotto’s competitors. (*See id.*, at ¶¶ 16, 19.)

18 By all appearances, Mr. Dent was a cybersquatter, and Lotto contends that he remains
19 a cybersquatter. Lotto filed an arbitration before WIPO, and the arbitrator agreed that
20 Mr. Dent engaged in cybersquatting when he registered and used the Infringing Domain
21 Names. (*See* SUF, at ¶¶ 20-23.) The arbitrator held that Dent conveniently omitted that he
22 registered the <lottoworks.com> domain name in 2016, and not 1998, so that it would appear
23 that his rights predated Lotto’s (SUF, at ¶ 23(a)); that one of the sites associated with the
24 Infringing Domain Names offered links to Lotto’s competitors (SUF, at ¶ 16); and that Dent
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1 had not used either of the Infringing Domain Names for any *bona fide* good or service. (SUF,
2 at ¶ 22.) Given all of that, Lotto not only initiated the UDRP against Mr. Dent in good faith,
3 it was rewarded with a resounding win.

4 Dent cannot argue that Lotto entered this dispute in bad faith or with meritless claims.
5 *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 525 (1994). Dent had registered domain names
6 containing the totality of Lotto's distinctive marks, ten of which contained advertisements for
7 Lotto's competitors, and Lotto won the arbitration it filed against Dent.

8 This case is exceptional in Lotto's favor. After all, Dent registered multiple domain
9 names that contained the entirety of its marks. He obtained the registration for
10 <lottoworks.com> almost immediately after Lotto applied for registration of LOTTO
11 WORKS with the USPTO. The website associated with that Infringing Domain contained
12 links to Lotto's competitors. Dent made misrepresentations to the arbitrator, and Lotto
13 prevailed in the arbitration.

14 Throughout this litigation, Lotto has proceeded in good faith. Lotto engaged in
15 discovery in good faith and filed no motions to compel. Meanwhile, Dent admitted that he
16 performed no due diligence before registering the Infringing Domain Names and acted
17 insulted when it was suggested that he should have. Dent misrepresented his ability to remove
18 content from the Infringing Domain Names. And, in the meantime, he continued to register
19 domain names containing Lotto's marks that display advertisements for Lotto's competitors.
20 Lotto should prevail in this action, and it should be awarded its fees.

21 **3.0 CONCLUSION**

22 Based upon the arguments contained herein and the relevant excerpts of the record
23 in the Statement of Undisputed Facts, Defendant Lotto Sport Italia, S.p.A respectfully
24 requests that the Court grant the instant Motion for Summary Judgment.

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Dated: October 9, 2019.

Respectfully submitted,

/s/ Ronald D. Green

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Case No. CV-17-651-PHX-DMF

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on October 9, 2019, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I further certify that a true and correct copy of the foregoing document being served via transmission of Notices of Electronic Filing generated by CM/ECF.

/s/ Crystal Sabala

Employee,
Randazza Legal Group, PLLC

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