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16 (*Pro Hac Vice Application to be filed*)

17 Attorneys for Plaintiff  
18 Vanity.com, Inc.

19  
20 **IN THE UNITED STATES DISTRICT COURT**  
21 **FOR THE DISTRICT OF ARIZONA**

22 VANITY.COM, INC., a Nevada  
23 corporation,

24 Plaintiff,

25 v.

26 VANITY SHOP OF GRAND FORKS,  
27 INC., a North Dakota corporation,

28 Defendant.

Case No.

**COMPLAINT FOR DECLARATORY  
JUDGMENT**

**DEMAND FOR JURY TRIAL**

**COMPLAINT AND DEMAND FOR JURY TRIAL**

Vanity.com, Inc. (“Plaintiff”), by its attorneys, for its Complaint, alleges:

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3200 NORTH CENTRAL AVENUE  
SUITE 2000  
PHOENIX, ARIZONA 85012

**NATURE OF ACTION**

This action seeks a declaratory judgment that Plaintiff’s registration and use of the domain name <vanity.com> (hereinafter “the Domain Name”) does not constitute trademark infringement, unfair competition, or a violation of the Anti-cybersquatting Consumer Protection Act (“ACPA”), and that Plaintiff is the rightful registered name holder or registrant of the Domain Name. Plaintiff seeks to bar the transfer of the Domain Name to Defendant Vanity Shop of Grand Fork, Inc. (“Defendant”). This action also seeks relief for Defendant’s bad faith actions constituting common law unfair competition.

**JURISDICTION AND VENUE**

1. Pursuant to 28 U.S.C. §§ 2201(a) and 2202, Plaintiff seeks a declaration and judgment regarding its rights and obligations in an actual controversy within this Court’s jurisdiction concerning Plaintiff’s rights in and to the Domain Name. Subject matter jurisdiction exists in this case pursuant to 28 U.S.C. § 1331, giving this Court original jurisdiction in a civil action raising a federal question under 28 U.S.C. § 1338(a), the Lanham Act, 15 U.S.C. § 1051, *et seq.*, and the ACPA, 15 U.S.C. § 1125(d), giving this Court original and exclusive jurisdiction in a civil action arising under the trademark and cybersquatting laws of the United States. Pendent jurisdiction exists over the state law claim.

2. This Court has personal jurisdiction over Defendant because Defendant specifically consented to jurisdiction in this Court by choosing it as the forum for a dispute arising from the UDRP decision, as this forum is the home to GoDaddy, Inc., the registrar of the Domain Name.

3. Venue is proper in this Judicial District under 28 U.S.C §§ 1391, because the Court has personal jurisdiction over the Defendant.

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**THE PARTIES**

1  
2 4. Plaintiff Vanity.com, Inc. is a Nevada corporation formed in 2006, with its  
3 principal place of business in Los Altos, California.

4 5. Plaintiff and/or its principal have owned the vanity.com Domain Name  
5 since 1995.

6 6. Plaintiff owns a U.S. federal trademark registration, Registration number  
7 3720766 for the Vanity.com trademark, filed on August 28, 2008 in connection with “On-  
8 line journals, namely, blogs featuring cosmetic procedures and surgery related content.”

9 7. Plaintiff has a legitimate interest in the inherently valuable Domain Name,  
10 and has used the Vanity.com trademark and Domain Name in various non-infringing  
11 manners *for over seventeen years*, without any bad faith towards Defendant.

12 8. Upon information and belief, Defendant Vanity Shop of Grand Fork, Inc. is  
13 a North Dakota Corporation with its principal place of business in North Dakota.

14 9. Upon information and belief, Defendant manufactures and sells various  
15 goods under the trademark “Vanity,” and variations thereof, and has procured U.S.  
16 federal trademark registrations in connection with such goods and in connection with  
17 retail services selling such goods.

18 10. On this basis, Defendant has asserted a meritless legal claim against  
19 Plaintiff’s rightful property, the Domain Name. This has created a case of actual  
20 controversy for adjudication by the federal courts.

21 11. Plaintiff has filed a similar action in the Northern District of California on  
22 June 5, 2012, styled *Vanity.com, Inc. v. Vanity Shop of Grand Fork, Inc.*, CV-12-02912  
23 (SI), seeking the same relief on essentially the same claims as asserted herein.

24 12. Plaintiff is required to file also in this jurisdiction in order to preserve  
25 ownership of its rightful property, the Domain Name, as this jurisdiction was chosen by  
26 the Defendant pursuant to the UDRP. If Plaintiff did not file this action, then the Domain  
27 Name registrar would transfer the Domain Name to Defendant pursuant to the terms of the  
28 UDRP.



1 or legitimate interests in the Domain Name and has registered and used it in bad faith, in a  
2 manner likely to confuse consumers as to the source of Defendant’s services.

3 20. Plaintiff responded to the UDRP complaint by filing a Declaratory  
4 Judgment action in the Northern District of California, described above. Plaintiff notified  
5 the National Arbitration Forum of such civil action and requested a dismissal or stay of  
6 the UDRP proceeding. Plaintiff presented evidence of its ownership of the domain name  
7 for 17 years, and of its US trademark registration, and argued that this dispute is between  
8 two legitimate trademark owners and therefore is not appropriate for the UDRP.  
9 Moreover, since the UDRP decision is reviewed *de novo* by any federal court, Plaintiff  
10 sought to avoid duplicative and potentially inconsistent litigation. Alternatively, Plaintiff  
11 argued that it should be given ten more days to respond to the Complaint, if the Forum  
12 would not stay or dismiss the proceedings in lieu of the civil action in California.

13 21. The Forum’s panelist ignored the latter request completely, and refused to  
14 stay or dismiss the proceedings without any reasoning whatsoever for such refusal.

15 22. The panelist, in incorrectly determining that Plaintiff lacks legitimate  
16 interest in the Domain Name and registered it in bad faith, stated:

17 a. “[E]ven though the Panel finds that the WHOIS information appears to  
18 indicate that Respondent is commonly known by the disputed domain name, the Panel  
19 concludes that Respondent is not commonly known by the <vanity.com> domain name  
20 under Policy ¶ 4(c)(ii).”

21 b. “Complainant states that Respondent resolves the <vanity.com> domain  
22 name to a commercial website offering information, blogs, chat groups, and social media  
23 links on beauty, fashion, health, and self topics. Nonetheless, the Panel finds that  
24 Respondent is not engaging in a bona fide offering of goods or services under Policy ¶  
25 4(c)(i) or a legitimate noncommercial or fair use of the <vanity.com> domain name under  
26 Policy ¶ 4(c)(iii).”

27 23. As a result of this panelist’s incorrect determination, the Defendant has  
28 obtained an order from the National Arbitration Forum, directing the transfer of the

1 Domain Name to Defendant, thus mandating the taking from Plaintiff of its rightful  
2 property.

3 24. Under the provisions of the UDRP, the Domain Name would be transferred  
4 to Defendant ten business days from notification of the decision to Plaintiff, unless  
5 Plaintiff files an action in this Court to overturn the arbitration decision.

6 25. Vanity Shop had the right, pursuant to the ACPA, to sue Plaintiff for  
7 trademark infringement in federal court.

8 26. Indeed, Vanity Shop's counsel specifically suggested in a phone call with  
9 Plaintiff's counsel on June 1, 2012 that they might do so, which precipitated Plaintiff's  
10 filing of the civil action in California.

11 The Registration

12 27. Plaintiff registered the Domain Name in good faith in 1995, long before the  
13 UDRP arbitration process was envisioned or enacted.

14 28. Vanity is a common English word, and has obvious inherent, valuable  
15 meaning as a trademark for almost any business. There are some 114 active USPTO  
16 trademark records for Vanity-formative marks in various industries, including Plaintiff's  
17 trademark registration for Vanity.com, filed in 2008.

18 29. Moreover, the Domain Name is the quintessential vanity domain name for  
19 any corporation or individual engaged in the multi-billion dollar domain name industry,  
20 giving it even greater inherent and non-infringing market value. Indeed, at one time,  
21 Plaintiff provided more than 50,000 "[user@vanity.com](mailto:user@vanity.com)" email addresses to different  
22 internet users.

23 30. After registering the Domain Name, Plaintiff and its principal have made  
24 demonstrable efforts to create a business under the Domain Name, and otherwise have  
25 ensured to maintain control of this valuable property asset.

26 31. The registration and use of domain names comprised of generic, geographic,  
27 descriptive, keyword and/or dictionary terms is widely recognized as a good faith use.  
28



1 39. Nevertheless, an NAF panelist ordered that the Domain Name be transferred  
2 from Plaintiff to Defendant.

3 40. In order to protect its valuable property, Plaintiff is forced to bring this  
4 action so that the Domain Name registrar will not transfer the name, as it otherwise is  
5 required to do under its contract with ICANN, per the terms of the UDRP.

6 41. Plaintiff seeks to maintain the status quo, and in particular its ownership of  
7 the valuable Domain Name, until the appropriate federal court in Northern California can  
8 adjudicate the rights of the parties, as each party is a federal trademark registrant.

9 42. Plaintiff further seeks damages and the recovery of its attorneys' fees that  
10 have resulted from Defendant's unfair competition for the Domain Name, and from  
11 Defendant's otherwise abusive and illegal behavior.

12 Defendants' Activities that Create a Claim for Unfair Competition

13 43. Plaintiff realleges all of the foregoing paragraphs of this Complaint.

14 44. Defendant's activities towards Plaintiff constitute unfair competition under  
15 common law and under Cal. Bus. & Prof. Code § 17200, et seq.

16 45. Defendant's activities are unlawful, unfair and fraudulent; they constitute an  
17 illegitimate attempt to obtain Plaintiff's property without just compensation, and an  
18 illegitimate attempt to enforce trademark rights far beyond any reasonable interpretation  
19 of same.

20 46. These activities are unlawful, unfair and fraudulent insofar as third parties  
21 may believe Defendant's assertions, and Plaintiff's reputation and business is likely to  
22 suffer accordingly.

23 47. Moreover, these activities cast a legal cloud on Plaintiff's title to its valuable  
24 Domain Name property, rendering such property more difficult if not impossible to sell  
25 for its full market value, and thus effectively disabling such property. This obviously  
26 causes economic harm to Plaintiff.



**COUNT I**

**(DECLARATORY RELIEF)**

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2  
3 48. Plaintiff realleges all the foregoing paragraphs of this Complaint.

4 49. Plaintiff rightfully registered and has used the Domain Name in good faith,  
5 and with neither knowledge of Defendant’s mark, nor intent to sell the Domain Name  
6 specifically to Defendant. Plaintiff had no intention of diverting any traffic from  
7 Defendant’s website, and avers that there is no evidence that such has occurred.

8 50. In registering the Domain Name, Plaintiff had a legitimate interest in the  
9 inherent, generic value of the Domain Name and has used the Domain Name consistently  
10 with such purpose.

11 51. VANITY is a common, generic word. Defendant’s putative rights in the  
12 VANITY mark are far from exclusive; they are weak and narrowly confined to various  
13 goods and retail services. Defendant has no exclusive right to the use of the term  
14 “Vanity” as a trademark or otherwise.

15 52. Plaintiff believed and had reasonable grounds to believe, based on the  
16 market for generic domain names, as well as prior legal decisions and decisions under the  
17 UDRP and the ACPA (and their predecessor case law, to the extent any existed in 1995),  
18 that the registration and use of the Domain Name as a generic word and in connection  
19 with non-infringing business endeavors was lawful.

20 53. For more than seventeen years, Plaintiff has had quiet enjoyment of her  
21 property in good faith, never hearing any complaint from Defendant or anyone else about  
22 her ownership of the Domain Name.

23 54. Now Defendant’s counsel has filed and prevailed in an administrative  
24 action, contending essentially that Plaintiff used the Domain Name in violation of anti-  
25 cybersquatting and unfair competition laws. Defendant’s counsel has further suggested  
26 that a ‘cease and desist’ notice and federal lawsuit are imminent.

27 55. Defendant’s agent filed the UDRP complaint, contending that Plaintiff  
28 registered and used the Domain Name in bad faith.

1 56. The UDRP provides that administrative panel decisions may be stayed, and  
2 that subject domain name disputes may be resolved in a court of competent jurisdiction –  
3 regardless of the UDRP panelists’ findings. The federal courts have held that such review  
4 is to be made *de novo*.

5 57. A justiciable controversy exists between Plaintiff and Defendant.

6 58. To resolve this actual controversy, Plaintiff seeks a declaration and  
7 judgment that its registration and use of the Domain Name is with the legitimate interest  
8 of exploiting its inherent value as a generic term, and/or is consistent with documented  
9 legitimate business efforts, and constitutes good faith use. Plaintiff seeks to remove the  
10 legal cloud over title to Plaintiff’s valuable property, which has been created by  
11 Defendant’s actions.

12  
13 **COUNT II**

14 **(COMMON LAW UNFAIR COMPETITION)**

15 59. Plaintiff realleges all paragraphs of this Complaint.

16 60. Defendant has filed and prevailed in a UDRP complaint and has suggested  
17 legal proceedings, contending that Plaintiff used the Domain Name in violation of anti-  
18 cybersquatting, trademark and unfair competition laws.

19 61. Defendant’s wrongful and baseless accusations of infringement have created  
20 a cloud on Plaintiff’s title to the Domain Name.

21 62. As a result of Defendant’s past and continued wrongful acts, Plaintiff has  
22 incurred damages in an amount to be proved at trial, including compensation for  
23 Plaintiff’s time, effort and attorneys’ fees in defending against Defendant’s baseless  
24 claims.

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28 ///

1 **COUNT III**

2 **(UNFAIR COMPETITION)**

3 Cal. Bus. & Prof. Code § 17200, et seq

4 63. Plaintiff realleges all paragraphs of this Complaint.

5 64. Defendant has filed and prevailed in a UDRP complaint and has suggested  
6 legal proceedings, contending that Plaintiff used the Domain Name in violation of anti-  
7 cybersquatting, trademark and unfair competition laws.

8 65. Defendant's wrongful acts, as described in this Complaint, are unlawful,  
9 unfair and fraudulent, and cause damage to Plaintiff and injure its business, in violation of  
10 Cal. Bus. & Prof. Code § 17200, et seq.

11 66. As a result of Defendant's past and continued wrongful acts, Plaintiff has  
12 incurred damages in an amount to be proved at trial, including compensation for  
13 Plaintiff's time, effort and attorneys' fees in defending against Defendant's baseless  
14 claims.

15 **COUNT III**

16 **(INJUNCTIVE RELIEF 15 U.S.C. s 1114(2)(D)(v))**

17 67. Plaintiff realleges all paragraphs of this Complaint.

18 68. 15 U.S.C. s 1114(2)(D)(v) provides that a domain name registrant whose  
19 domain name has been suspended, disabled, or transferred under a policy described under  
20 clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the  
21 registration or use of the domain name by such registrant is not unlawful under this  
22 chapter.

23 69. 15 U.S.C. s 1114(2)(D)(v) provides that the court may grant injunctive relief  
24 to the domain name registrant, including the reactivation of the domain name or transfer  
25 of the domain name to the domain name registrant.

26 70. Injunctive relief is appropriate in this action to prevent the reverse domain  
27 name hijacking engaged in by Vanity Shops.  
28



**DEMAND FOR JURY TRIAL**

Plaintiff respectfully requests that all issues in this case be decided by a jury.

Dated: July 3, 2012

**JABURG & WILK, P.C.**

s/Maria Crimi Speth  
Maria Crimi Speth

**RODENBAUGH LAW**

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