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8 UNITED STATES DISTRICT COURT FOR
 9 THE DISTRICT OF ARIZONA

10 Yoyo.Email, LLC

11 Plaintiff,

13 v.

14 Playinnovation, LTD.

16 Defendant.

CV-14-01922-PHX-PGR

Case No. _____

**COMPLAINT FOR
 DECLARATORY JUDGMENT**

COMPLAINT FOR DECLARATORY JUDGMENT

19 THERE IS NO OTHER CIVIL ACTION ARISING
 20 OUT OF THE SAME TRANSACTIONS OR
 21 OCCURRENCES AS ALLEGED IN THIS
 22 COMPLAINT PENDING IN THIS COURT, NOR HAS
 23 ANY SUCH ACTION BEEN PREVIOUSLY FILED
 AND DISMISSED AFTER HAVING BEEN
 24 ASSIGNED TO A JUDGE

25 Plaintiff, through counsel, hereby brings its Complaint for Declaratory
 26 Judgment against Playinnovation, Ltd. ("Playinnovation") and alleges as follows:
 27

INTRODUCTION

1
2 1. This is a declaratory judgment action seeking a declaration of rights
3 in the domain name <playinnovation.email> purchased, registered and owned by
4 Plaintiff on or about July 8, 2014 and deleted from Plaintiff's account with
5 Registrar GoDaddy.com, LLC ("GoDaddy") at the request of Defendant on
6 allegations of cybersquatting under the Uniform Rapid Suspension System
7 ("URS"), as well as Plaintiff's rights in the further domains suspended, deleted
8 and/or transferred away from Plaintiff as included in **Exhibit 7** and the domain
9 name assets registered by Plaintiff at risk of being suspended, deleted or
10 transferred as included on **Exhibit 4**.
11
12
13

THE PARTIES

14
15
16 2. Plaintiff YOYO.EMAIL, LLC is a limited liability company having
17 its principal place of business at 38 Market Square Toddington, Dunsatble,
18 Dedfordhsire LU5 6BS, United Kingdom.
19

20 3. Defendant Playinnovation Ltd., is a limited company having its
21 principal place of business at 26 Chase Road, Park Royal, NW10 6BB, United
22 Kingdom.
23

JURISDICTION AND VENUE

24
25 4. This case involves questions of federal trademark law under Section
26 43 the Lanham Act, 15 USC §1125 et seq.
27
28

1 5. This matter is brought under the Declaratory Judgment Act, 28
2 U.S.C. § 2201(a), which provides that "any court of the United States, upon the
3 filing of an appropriate pleading, may declare the rights and other legal relations
4 of any interested party seeking such declaration, whether or not further relief is or
5 could be sought. Any such declaration shall have the force and effect of a final
6 judgment or decree and shall be reviewable as such."
7

8
9 6. This matter is further brought under the Declaratory Judgment Act,
10 28 U.S.C. §2202 which provides: "Further necessary or proper relief based on a
11 declaratory judgment or decree may be granted, after reasonable notice and
12 hearing, against any adverse party whose rights have been determined by such
13 judgment." As such, the Court has jurisdiction over the subject matter of this
14 action pursuant to 28 U.S.C. §1331.
15

16
17 7. Playinnovation stipulated to personal jurisdiction in this Court when
18 it filed a URS Complaint against Plaintiff wherein Defendant agreed: "Mutual
19 Jurisdiction- Complainant submits, with respect to any challenges to the
20 determination in this proceeding, to the jurisdiction of the Registrar." The
21 Registrar in this case for the domain name <playinnovation.email> is GoDaddy,
22 with its corporate headquarters at 4455 N. Hayden Rd., Suite. 226, Scottsdale,
23 Arizona 85260-6947. (**Exhibit 2; Defendant's URS Complaint**); *see also*,
24 UDRP, definition of Mutual Jurisdiction and Para 3(b)(xiii)(requiring
25
26
27
28

1 Complainant to “ submit, with respect to any challenges to a decision in the
2 administrative proceeding canceling or transferring the domain name, to the
3 jurisdiction of the courts in at least one specified Mutual Jurisdiction”).
4

5 **BACKGROUND**

6 8. The Uniform Rapid Suspension System (URS) is a rights protection
7 mechanism that compliments the existing Uniform Domain Name Dispute
8 Resolution Policy (UDRP) by offering a low cost, fast track for relief to alleged
9 trademark right holders experiencing the most clear-cut cases of trademark
10 infringement. For more information on the URS, see
11 <http://newgtlds.icann.org/en/applicants/urs>.
12
13

14 9. On or about July 8, 2014, the Plaintiff Yoyo.email registered
15 <playinnovation.email> at GoDaddy a domain name registrar. (**Exhibit 1**).
16

17 10. On or about July 8, 2014, the same day Plaintiff registered the subject
18 domain and without any information about Plaintiff or its business model
19 including its intended use, Defendant Playinnovation Ltd filed a URS complaint
20 against Plaintiff asking that the domain name registration be suspended for the
21 remaining period of registration. (*See Exhibit 2*).
22
23

24 11. On or about July 8, 2014, Plaintiff Yoyo.email responded to the URS
25 Complaint denying trademark infringement, bad faith cybersquatting and
26 explaining its intentions for a new business model for certified e-mail delivery
27
28

1 (See **Exhibit 3**).

2 12. Yoyo.email's CEO, Giovanni Laporta, explained in response to the
3 URS that he had registered the subject domain, and many other domains on the
4 new <.email> gTLD registry, "in good faith, following ICANN with respect to the
5 new generic Top Level Domains and consistently with the principles
6 progressively established since the introduction of the domain name system ...".
7
8 (See **Exhibit 3**, p.1). For more information on the .email gTLD registry and
9 launch see <<http://icannwiki.com/index.php/.email>>.
10

11
12 13. Plaintiff further explained that its intention was to create a "domain
13 name directory and a new system based on that directory to record the sending and
14 receipt of emails." (See **Exhibit 3**, p.1).
15

16 14. Plaintiff further described the general business and use of the domain
17 as follows: "To sum up, YOYO is effectively an email courier service, like a
18 courier operates in the real world, YOYO operates online. e.g. <.email> is the
19 "carrier" acting as the 'courier'." (See **Exhibit 3**, p.2).
20

21 15. Also on **July 8, 2014**, within hours after the Plaintiff registered the
22 domain name, and the URS Complaint being served on the Plaintiff, URS panelist
23 Carol Stoner issued a Final Determination that Plaintiff had a violation of the URS
24 <http://newgtlds.icann.org/en/applicants/urs> and ordered the SUSPENSION of
25 Plaintiff's domain name <playinnovation.email>. (**Exhibit 5**).
26
27
28

1 16. The basis of Panelist Stoner's determination is purely conclusory and
2 unclear, without citing to specific evidence. However, it appears that the decision
3 was driven by arguments made in Defendant's Complaint that Plaintiff's CEO
4 Giovanni Laporta had stated: "We do intend to make money by; the value of
5 having large numbers of active users, people linked to the service. Social media
6 engagement through web flow; "a charge could be levied here". Advertising, a
7 "charge could be levied here". Personalised (sic) email addresses (common
8 names), much like private number plates on motor cars; "a charge could be levied
9 here."
10
11

12
13 17. Panelist Stoner determined that "the Defendant had submitted
14 reliable evidence showing the Plaintiff Yoyo.Email had offered the domain name
15 for sale, and that the Defendant had submitted reliable evidence showing the
16 Plaintiff had intentionally attempted to attract for commercial gain, internet users
17 to its website or other online location, by creating a likelihood of confusion with
18 the Defendant's mark as to the source, sponsorship, affiliation, or endorsement of
19 Plaintiff's website.
20
21

22
23 18. In fact, there has never been any communication between the parties,
24 no offer to sell the domain to Defendant or anyone else, or evidence submitted
25 supporting any of these findings.
26

27 19. Mr. Laporta's statement has been severely misrepresented and taken
28

1 out of context. The subject statement did not state that any trademark-protected
2 domain would be visible to any consumer, or that <playinnovation.email> would
3 be used in any way which violates trademark law. In fact, Mr. Laporta made it
4 clear that his anticipated email services which includes common surnames and
5 generic domain names (not <playinnovation.email>) “may’ be used in various
6 ways. Mr. Laporta was working with trademark attorneys to ensure that none of
7 the branded domain names would be used in any way that violated law.
8
9

10 20. Plaintiff’s possible <.email> services, as it related to domain names
11 which include company names such as <playinnovation.email>, and as argued to
12 various URS and UDRP panelists is set forth below.
13

14 21. When a person sends an email to a company, such as Playinnovation,
15 the email normally goes through a series of email servers, which are often
16 controlled by third parties such as employers or email providers (Gmail, Yahoo,
17 etc).
18
19

20 22. Certain data, such as time stamps and routing of email (“Email Meta
21 Data”), is stored on email servers but often times not within the control of either
22 the sender of the email or the recipient of the email. Even when certain Email
23 Meta Data is displayed to an email sender or recipient, that data is not, and often
24 can not be certified, similar to when paper-based certified mail is sent through a
25 carrier service such as the United States Postal Service. *See e.g.*
26
27
28

1 http://en.wikipedia.org/wiki/Certified_Mail.

2 23. In order to provide certification of delivery, and potentially receipt,
3 of an email as well as the Email Meta Data, Plaintiff needed to route, capture and
4 store Email Meta Data on its own email servers. (See **Exhibit 6**, p.1-3).

5 24. Plaintiff's intention at the time of the domain name registration and
6 today is to use the subject domain name <playinnovation.email> as an
7 independent, back-end email server controlled by Plaintiff and invisible to
8 consumers to route, capture and store Email Meta Data so that Plaintiff can certify
9 that the email was sent, and potentially, received.
10

11 25. Plaintiff has not displayed, and does not intend to display, the subject
12 domain name in commerce as part of the sale of advertising of YOYO's services
13 as defined in 15 USC §1127.
14

15 26. If a person were to send an email to Playinnovation through YOYO's
16 certification service, that email would route through the <playinnovation.email>
17 back-end server in order to capture metadata about the email such as the date sent,
18 time sent, location, IP information, routing information and other data. Since
19 Plaintiff would control the email server, Plaintiff would be able to 'certify' and
20 'verify' the metadata, that the email was in fact sent, and potentially certify that it
21 was received.
22

23 27. Plaintiff's business model, currently in development, would use the
24
25
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28

1 domain name <playinnovation.email> only as a data storage server, which
2 identifies the server and meta data, for all email sent to the company
3 Playinnovation.
4

5 28. At the time of the URS response, Plaintiff was still developing its
6 business model and working with trademark attorneys including the Honorable
7 Neil Brown QC, a highly regarded and experienced UDRP domain name expert in
8 order to ensure that Plaintiff complied with all laws, including, but not limited to,
9 the URS, UDRP and the Lanham Act. <http://www.neilbrownqc.com/>
10

11 29. Despite the fact that the ICANN URS system “was designed to help
12 tackle clear cut cases of trademark and domain name misuse” and that the URS
13 was “not intended for use in proceedings with open questions of fact, contestable
14 issues or more involved legal scenarios,” URS panelists such as Carol Stoner, are
15 erroneously determining that there has been a violation of the policy and
16 trademark law.
17

18 30. Its noted, the majority of URS and UDRP decisions have gone
19 against Plaintiff resulting in either the suspension, deletion or transfer of domain
20 name assets from Plaintiff to various trademark owners despite the fact that:
21

- 22
- 23 a. Plaintiff has not used the domain name at all.
 - 24 b. Plaintiff does not intend to use the subject domain names as a URL /
25 web address or to host a website.
26
27
28

1 c. Plaintiff has not made the subject domain names visible to the
2 general public.

3 d. Plaintiff has not used any trademark protected domain name itself to
4 monetize its service to consumers or trademark owners.
5

6 31. Plaintiff has not solicited any payment to sell, transfer or offer
7 services related to any trademark protected domain name to any trademark owner.
8

9 32. Plaintiff registered a large number of brands as '[brand].email'
10 domain names when the <.email> Registry launched in or about March, 2014 for
11 use as non-public, non-consumer facing, back-end email servers. As each brand
12 would be its own server, identification and verification of data, as necessary, by
13 recipient would be easy and straightforward.
14

15 33. Plaintiff has other aspects to its contemplated business model around
16 generic non-branded <.email> domain names such as on the purely generic
17 domain name also included on their list (see e.g., **Exhibit 4**).
18

19 34. Plaintiff has incurred approximately \$82,000 in registration fees in
20 registering the domain names included on **Exhibit 4**, and approximately \$170,000
21 Dollars overall in the development of its email services. (See **Exhibits 8-12**).
22

23 35. To date approximately 34 URS and UDRP actions have been filed by
24 various alleged trademark owners concerning Plaintiff's registration of domain
25 names which include a company's brand or trademark as part of the <.email>
26
27
28

1 domain name. (See, **Exhibit 7**, list of URS and UDRP proceedings against
2 Plaintiff).

3 36. The simple registration of a trademark domain name which is all of
4 the undisputed evidence to date is not a per se violation of trademark law under
5 the UDRP, Lanham Act or any other law.
6

7 37. Speculation about what Plaintiff might do in the future with the
8 particular domain name as contained in the URS and UDRP Determinations is not
9 a basis to suspend his domain assets or transfer his domain assets to third party
10 trademark owners.
11

12 38. By way of example only, a UDRP panelist found cybersquatting
13 based on the use of the subject domain name as a website 'parking page' which
14 the panelist said was showing third party advertisements despite the fact that: (a)
15 the domain name had never hosted any website (b) no one, including Complainant
16 in that case, had even alleged that the domain had ever been used for such purpose
17 and, (c) the domain name had never been used to display third party
18 advertisements or for any other commercial purpose. It appears the UDRP panelist
19 simply cut and paste inapplicable and erroneous information from prior decisions
20 in ruling against Plaintiff, without even reading the materials submitted. *See Arla*
21 *Foods amba vs Yoyo.email Ltd*
22 www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0724
23
24
25
26
27
28

1 39. Objectively false findings, conjecture, misinterpretation,
2 misinformation, unsupported speculation and erroneous statements by previous
3 UDRP and URS panelists have now prejudiced all future proceedings as panelists
4 often rely on prior findings in new and future URS and UDRP proceedings. It is
5 making it impracticable to defend successfully against further URS and UDRP
6 proceedings.
7

8
9 40. The adverse URS and UDRP decisions, and the prospect of further
10 adverse decisions based on prior panelist rulings, are limiting, and potentially
11 eliminating, Plaintiff's right to develop and eventually launch a lawful, non-
12 infringing business model on <.email> gTLDs.
13

14 41. The adverse URS and UDRP decisions, and the prospect of further
15 adverse decisions based on prior panelist rulings, are dispossessing Plaintiff of its
16 domain assets and denying Plaintiff's ability to use lawfully paid for and
17 registered domain assets.
18

19
20 42. URS and UDRP proceedings are purely administrative, are not
21 considered precedent and are not binding on any federal courts, nor are any
22 decisions binding or even instructive precedent for US courts.
23

24 43. The UDRP explicitly provides that a UDRP proceeding does not bar
25 a subsequent court proceeding. UDRP 4(k) states in part: "Availability of court
26 proceedings. The mandatory administrative proceeding requirements set forth in
27

1 Paragraph 4 shall not prevent either you [the domain name registrant] or the
2 complainant from submitting the dispute to a court of competent jurisdiction for
3 independent resolution before such mandatory administrative proceeding is
4 commenced or after such proceeding is concluded." *See*
5 <https://www.icann.org/resources/pages/policy-2012-02-25-en>.
6
7
8

9 **COUNT I**

10 **DECLARATORY JUDGMENT**

11
12 44. Plaintiff restates and reincorporates its prior allegations as though
13 fully stated herein.

14 45. Plaintiff's domain assets such as;

15 eharmony.email	garnier.email	statoil.email
16 theo2.email	kiehls.email	shearton.email
17 maplin.email	sanofi.email	sheartonparklane.email
18 theaa.email	groupama.email	thehartford.email
19 rbsbank.email	lockheed.email	beiersdorf.email
20 rbs.email	lockheedmartin.email	nivea.email
21 natwest.email	lufthansa.email	budlight.email
22 coutts.email	footlocker.email	playinnovation.email
23 cravendale.email	geico.email	mwe.email
24 nvidia.email	dunkindonuts.email	stuartweitzman.email
25 arla.email	baskinrobbins.email	
26 arlafoods.email	lurpak.email	

27 and others including in **Exhibits 4 and 7** are being suspended, deleted and/or
28 transferred to third-parties as a result of URS and UDRP determinations
29
30

1 finding that Plaintiff is violating trademark rights of parties such as

2 Defendant, despite the facts that:

3 e. Plaintiff has repeatedly stated a clear intention and due diligence to
4 comply with all trademark laws;

6 f. None of the domain names have yet been used by Plaintiff in any
7 way;

9 g. The intended use of the domain name is merely as a back-end
10 technical server to record the sending and receipt of emails to various
11 third parties;

13 h. No consumer shopping for goods and services, including certified
14 email, would be shown the <playinnovation.email>, or other
15 <.email> domain name incorporating a trademark or brand, as part of
16 the contemplated service offering;

18 i. Plaintiff's intended use of the domain name is not a "trademark use"
19 under trademark law; and

21 j. Plaintiff's intended use of the domain name under the business model
22 described is not a violation of the AntiCybersquatting Consumer
23 Protection Act (ACPA).

25 k. Other matters as set forth herein.

27 46. Without court action, Plaintiff's domain assets are expected to

1 continue being frozen and/or transferred to third parties in URS, UDRP or court
2 proceedings and plaintiff will lose its substantial investment in registering and
3 eventually using these domain names.

4
5 47. With regard to the <playinnovation.email> domain name, and others,
6 Plaintiff will be denied use of the domain names and ultimately be unable to use
7 the domain consistent with its intended purpose.

8
9 48. Plaintiff understands that once it implements its business model, the
10 “proof will be in the pudding.” However, Plaintiff is being unfairly denied the
11 right to implement its business model as a result of domain name suspensions,
12 deletions and transfers under the URS and UDRP.

13
14 49. Plaintiff, pursuant to the Declaratory Judgment Act, asks that this
15 Court declare Plaintiff has not acted unlawfully in violation of the Lanham Act.
16

17
18 **PRAYER FOR RELIEF**

19
20 WHEREFORE, Plaintiff respectfully requests the court enter judgment as
21 follows:

22
23 A. Declaring that the registration and use of the domain name
24 <playinnovation.email> as a non-public, back-end email server to track and store
25 delivery and receipt data is not a “trademark use” under trademark law.

26
27 B. Declaring that the use of the domain names, which incorporate
28

1 alleged trademarks as set forth in various domain names listed in **Exhibit 4**, as a
2 non-public, back-end email server to track and store delivery and potentially
3 receipt data is not a “trademark use” under trademark law.
4

5 C. Declaring that Plaintiff’s registration, (non)-use and anticipated use
6 of the domain name <playinnovation.email> is not a violation of the Lanham Act
7 or Anticybersquatting Consumer Protection Act, or the UDRP or URS;
8

9 D. Declaring that Plaintiff’s registration, (non)-use and anticipated use
10 of the domain names included in **Exhibits 4 and 7** are not a violation of the
11 Lanham Act or Anticybersquatting Consumer Protection Act, or the UDRP or
12 URS;
13

14 E. Declaring that the domain name <playinnovation.email> be removed
15 from suspension at the registrar GoDaddy and restored to Plaintiff so that Plaintiff
16 may continue to develop its business model and use the subject domain name
17 consistent with its intended use as a non-public, back-end email server as set forth
18 herein.
19


20
21 F. Declaring that the domain names included on **Exhibit 4 and 7** which
22 have been suspended or transferred under the UDRP and URS, and others as of
23 the date of judgment, be removed from suspension or returned to Plaintiff so that
24 Plaintiff may continue to develop its business model and use the subject domain
25 name consistent with its intended use as a non-public, back-end email server as set
26
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28

1 forth herein; and

2 G. Declaring that Plaintiff's business model as set forth herein is a
3 legitimate and lawful business;
4

5
6 Respectfully submitted this 28th day of August, 2014.

7
8
9 By:


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