

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

CASE NO. 07-22674-CIV-JORDAN/TORRES

DELL INC.; AND ALIENWARE
CORPORATION,

Plaintiffs,

v.

BELGIUMDOMAINS, LLC;
CAPITOLDOMAINS, LLC;
DOMAINDOORMAN, LLC; NETRIAN
VENTURES LTD.; IHOLDINGS.COM,
INC.; JUAN PABLO VAZQUEZ a/k/a JP
VAZQUEZ, an individual; and DOES 1-10;

Defendants.

**DEFENDANTS BELGIUMDOMAINS, LLC, CAPITOLDOMAINS, LLC,
DOMAINDOORMAN, LLC, NETRIAN VENTURES LTD.,
AND IHOLDINGS.COM, INC.'S MOTION TO DISMISS AND
INCORPORATED MEMORANDUM OF LAW**

Pursuant to Fed.R.Civ.P. 12(b)(6), defendants BelgiumDomains, LLC (“BelgiumDomains”), CapitolDomains, LLC (“CapitolDomains”), DomainDoorman, LLC (“DomainDoorman”), Netrian Ventures Ltd. (“Netrian”), and iHoldings.com, Inc. (“iHoldings”)¹ (collectively, “Registrar Defendants”), by and through their undersigned trial counsel, hereby move for dismissal of the eight causes of action alleged in the Complaint for Cybersquatting, Trademark Infringement, Counterfeiting, Dilution, and Unfair Competition (“Complaint”; [DE 1]) of Plaintiffs Dell Inc. (“Dell”) and Alienware Corporation (“Alienware”) (together, “Plaintiffs”), on the following grounds:

¹ Netrian also moves to dismiss proceedings against it pursuant to Fed.R.Civ.P. 12(b)(5) for insufficient service of process. Further, Netrian believes there is no personal jurisdiction over it in the State of Florida (or anywhere in the U.S.), and does not waive that contention by specially appearing and filing this motion.

1. All of Plaintiffs' causes of action (the "Claims") are based on the argument that the Registrar Defendants are the registrants of the domain names referred to in the Complaint (the "Domain Names"), which purportedly infringe various trademarks owned by Plaintiffs (the "Alleged Marks"; see Complaint ¶¶ 18, 47, 62). However, Plaintiffs' Complaint indicates the Registrar Defendants only provided services for other entities and individuals who were the actual Domain Name registrants. For this reason, Plaintiffs' Claims should be dismissed.

2. Plaintiffs' Claims are all based on the argument that the registrants of the Domain Names used them in commerce – *i.e.*, that the registrants used the Domain Names as unique indicators of the source of related goods or services. However, Plaintiffs' own evidence attached to the Complaint as Exhibits 1 through 10 show not that the Domain Name registrants promoted any goods or services in connection with the Alleged Marks, but only displayed Internet search results upon entry of one of the Domain Names. Consequently, Plaintiffs' Claims should be dismissed.

3. Plaintiffs' Complaint does not provide a sufficient factual basis to allege their fourth Claim for counterfeiting, since the Domain Names are not indistinguishable from the Alleged Marks and were not used in connection with goods or services.

4. Plaintiffs' service of process against Netrian was insufficient, requiring dismissal of these proceedings against Netrian pursuant to Fed.R.Civ.P. 12(b)(5).

MEMORANDUM OF LAW

I. INTRODUCTION AND BACKGROUND

A. Allegations Concerning Registrar Defendants' Purported Use of Domain Names

1. Alleged Domain Name Registrations

Plaintiffs' Claims are all based on the Registrar Defendants' alleged "registration, use, or trafficking" of the Domain Names, which Plaintiffs claim infringe their Alleged Marks. (*See, e.g.*,

Complaint ¶¶ 77, 114, 122, 141, 165, 176, 188, 200, 211, 219, 228.) Plaintiffs aver that three of the Registrar Defendants are domain name registrars while the fourth, Netrian, is their “Corporate Manager.” (*Id.* ¶¶ 63-65, 67.) Further, Plaintiffs allege the Domain Names are all registered to entities and individuals other than the Registrar Defendants, such as Caribbean Online International Ltd. and Domain Drop S.A. (*Id.* ¶¶ 77-113.) However, Plaintiffs blur the distinction between domain name registrars – which merely serve as an interface between their customers and the relevant domain name registries – and domain name registrants, who actually own and control the registered domain names. Plaintiffs make the conclusory allegation that the Domain Name registrants are employed by the Registrar Defendants “to conceal their true identities” (*id.* ¶ 77), but they do not allege any facts which warrant that conclusion.

2. Alleged Commercial Use of Domain Names

Plaintiffs’ Claims are also based on the allegation that the registrants of the Domain Names used them in connection with the promotion of “goods or services identical, directly competitive or related to those sold or provided in connection with Plaintiffs’ [Alleged] Marks.” (*See, e.g.*, Complaint ¶ 134; *see also id.* at ¶¶ 135-36, 137, 150, 166, 176, 189, 200-01, 210-11, 219, 229). However, the attachments to the Complaint indicate the Domain Names only redirected Internet users to results which appear to have been provided by an Internet search engine. (*See id.*, Ex. 9.) Some of those search results included links to Plaintiffs’ own websites. (*See id.*) Critically, none of the search results attached to the Complaint indicates use of Plaintiffs’ Alleged Marks in connection with another party’s goods or services. (*See id.*)

B. Allegations Concerning Plaintiffs’ Counterfeiting Claim

Plaintiffs base their counterfeiting claim on alleged use of “Counterfeit Domain Names”, a term Plaintiffs never define. (*See* Complaint ¶¶ 124, 188-89.) Their alleged “counterfeiting” relates

to the purported use of “websites and pop-up and pop-under advertisements.” (*See id.* ¶ 189.) However, Plaintiffs do not allege the Registrar Defendants ever used any of the Alleged Marks in connection with goods and services which are similar to those offered by Plaintiffs, which allegation is mandatory to support a claim of counterfeiting.

C. Alleged Service of Process on Netrian

Plaintiffs purport to have effectively served process on Defendant Netrian. In the Return of Service Plaintiffs filed for Defendant Netrian (Notice of Returns of Service [DE 44], 21-22), they claim to have served a copy of the Summons, Complaint and the other listed documents on an individual named Belkenia Candelario in Miami, Florida. Plaintiffs identify Ms. Candelario as a “EMPLOYEE/BUSINESS AGENT” of Netrian. Plaintiffs’ Return of Service refers to that address as Defendant Netrian’s “principal place of business.” (*Id.*) However, Netrian is a foreign entity and Plaintiffs have made no showing that its principal place of business is at that address, in Miami, or in Florida at all.

II. ARGUMENT

A. Standard of Review

In *Bell Atlantic Corp. v. Twombly*, ___ U.S. ___, 127 S. Ct. 1955 (2007), the Supreme Court held that in order to survive a motion to dismiss, a complaint must contain factual allegations that are “enough to raise a right to relief above the speculative level, on the assumption that all the allegations in the complaint are true.” *Id.* at 1965. “While a complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed factual allegations, a plaintiff’s obligation to provide the ‘grounds’ of his ‘entitle[ment] to relief’ requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.” *Id.* at 1964-65. This Court has recognized the new enunciation of the standard in a number of recent decisions granting motions to dismiss. *See,*

e.g., *Garcia v. Santa Maria Resort, Inc.*, No. 07-10017-CIV, 2007 WL 4127628, *3 (S.D. Fla. Nov. 15, 2007) (King, J.); *MRI Scan Ctr., Inc. v. Allstate Ins. Co.*, No. 07-60771-CIV, 2007 WL 2288149, *1 (S.D. Fla. Aug. 7, 2007) (Cohn, J.); *Bays v. Vistas HEalthcare Corp.*, Case No. 04-21431-CIV, 2007 WL 2050994, *1 (S.D. Fla. July 25, 2007) (Jordan, J.).

The Complaint similarly fails to meet this heightened standard; indeed, Plaintiffs' Complete with the type of "formulaic recitation of the elements of . . . cause[s] of action," 127 S. Ct. at 1965, condemned by the Supreme Court in *Twombly*. Moreover, even under the prior *Conley v. Gibson* standard, "[u]nsupported conclusions of law or of mixed fact and law have long been recognized not to prevent a Rule 12(b)(6) dismissal." *Marsh v. Butler County, Ala.*, 268 F.3d 1014, 1036 n. 16 (11th Cir. 2001).

Finally, "where the plaintiff refers to certain documents in the complaint and those documents are central to the plaintiff's claim, then the Court may consider the documents part of the pleadings for purposes of Rule 12(b)(6) dismissal." *Brooks v. Blue Cross & Blue Shield*, 116 F.3d 1364, 1368 (11th Cir. 1997). Accordingly, not only the allegations of Plaintiffs' Complaint, but also the Exhibits must be evaluated in determining whether Plaintiffs' Claims meet the *Twombly* standard.

B. All of Plaintiffs' Claims Should Be Dismissed Because the Registrar Defendants Did Not Use the Alleged Marks in Commerce

The Lanham Act requires that an allegedly infringing mark be "use[d] in commerce" before an infringement can occur. 15 U.S.C. § 1125(a)(1). A mark is not used in commerce unless the alleged infringer uses it as a unique indicator of the source of the related goods or services. *See Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163-164, 115 S. Ct. 1300, 1303-04, 131 L. Ed. 2d 248 (1995) (federal trademark law prevents competitors from copying "a source-identifying

mark”, thus ensuring the owner will “reap the financial, reputation-related rewards associated with a desirable product”).

All of Plaintiffs’ Claims, including their Lanham Act claims, are based on commercial use. Specifically, Plaintiffs allege that the registrants of the Domain Names used them in connection with the promotion of “goods or services identical, directly competitive or related to those sold or provided in connection with Plaintiffs’ [Alleged] Marks.” (Complaint ¶ 134; *see also* Complaint ¶¶ 135-36, 137, 150, 166, 176, 189, 200-01, 210-11, 219, 229).

Even assuming *arguendo* that the Registrar Defendants were actual Domain Name registrants, the Complaint shows that they never used the Alleged Marks in a commercial, trademark sense. The Domain Name registrants did not promote their unique goods or services in connection with the Alleged Marks. To the contrary, the exhibits to the Complaint show that the registrants merely used the Domain Names to redirect users to search engine results, of the sort commonly provided by Google or Yahoo. This type of use is not a trademark use because there is no use of the Alleged Marks to identify the source or quality of goods or services, aside from some links to Plaintiffs’ own services. *See Rescuecom Corp. v. Google, Inc.*, 456 F. Supp. 2d 393, 403 (N.D.N.Y. 2006) (holding there was no “trademark use as a matter of law” when defendant’s web page displayed search results but “an internet user who enters [plaintiff’s trademark] into Google as a search term, may still go to plaintiff’s website(s) by clicking on the appropriate link on the search results page – even though he or she may have other choices”).

Nor did the registration of the Domain Names by itself amount to trademark use. The mere registration of a domain name cannot constitute “use” as a matter of law. *See, e.g., Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 961 (C.D. Cal. 1997) (“The registration of a domain name, without more, does not amount to infringement of a mark similar to the name.”);

Panavision Int'l, L.P. v. Toeppen, 945 F. Supp. 1296, 1303 (C.D. Cal. 1996) (same); *Cline v. 1-888-Plumbing Group, Inc.*, 146 F. Supp. 2d 351, 369 (S.D.N.Y. 2001) (“In the context of Internet domain names, parties encroach on a registrant’s rights under § 32(1) of the Lanham Act not when they reserve a domain name likely to be confused with the registered mark, but when they use it.”); *HQM, Ltd. v. Hatfield*, 71 F. Supp. 2d 500, 507 (D. Md. 1999) (“[N]early every Court to have decided whether mere registration or activation of a domain name constitutes ‘commercial use’ has rejected such arguments.”); *Jews For Jesus v. Brodsky*, 993 F. Supp. 282, 307 (D.N.J. 1998) (“[T]he mere registration of a domain name, without more, is not a ‘commercial use’ of a trademark.”); *Juno Online Services v. Juno Lighting, Inc.*, 979 F. Supp. 684, 691 (N.D. Ill. 1997) (“The mere ‘warehousing’ of the domain name is not enough to find that defendant placed the mark on goods or ‘used or displayed the mark in the sale or advertising of services’ as required” under 15 U.S.C. § 1127.).

Accordingly, Plaintiffs cannot prevail on any of their Claims because the Domain Name registrants did not use the Alleged Marks in a trademark sense. All of Plaintiffs’ Claims are based on alleged use in commerce of the Alleged Marks. Therefore, Plaintiffs’ failure to allege facts sufficient to show commercial use provides another basis for dismissing the Complaint in its entirety.

C. Plaintiffs’ Counterfeiting Claim Should Be Dismissed Because the Domain Names Are Not Indistinguishable from the Alleged Marks, and Were Not Used in Connection with Goods or Services

Plaintiff’s “counterfeiting” claim should be dismissed for the above reasons. In addition, it should be dismissed because the Complaint does not allege facts sufficient to show that the Registrar Defendants engaged in counterfeiting. Plaintiffs do not even define the “Counterfeit Domain Names” on which this Claim is allegedly based. (*See* Complaint ¶¶ 124, 188-89.)

The Lanham Act, at 15 U.S.C. § 1127, provides as follows:

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

Id. Even a brief comparison of the Alleged Marks (*see* Complaint ¶ 62) and the Domain Names (*see* Complaint ¶¶ 21-33) reveals that Plaintiffs do not allege facts showing that the Domain Names are “identical with, or substantially indistinguishable from” Plaintiffs’ claimed marks. For example, Plaintiffs have not identified any Alleged Marks “indistinguishable from” <coupons-coupon-dell.com>, the very first Domain Name listed. (*See* Complaint ¶ 21.) Notably, the Lanham Act’s requirement for “counterfeit” marks is much more stringent than the “confusingly similar” test set forth in 15 U.S.C. §§ 1114 and 1125. Plaintiffs must allege facts sufficient to indicate the Domain Names are “substantially indistinguishable” from their Alleged Marks, and they fail completely.

Moreover, Plaintiffs do not allege the Registrar Defendants used the Domain Names in connection with “counterfeit” goods or services. Their alleged “counterfeiting” relates to the purported use of “websites and pop-up and pop-under advertisements.” (*See* Complaint ¶ 189.) This is insufficient. Relevant statutes, case law, and treatises all concur that “counterfeiting” refers to the use of one party’s trademark on another party’s goods or in connection with another party’s services, in a manner that deceives consumers as to the source of the goods or services. For example, producing handbags with the Chanel logo which are not actually Chanel’s goods, would be counterfeiting. *See Chanel, Inc. v. Italian Activewear of Florida, Inc.*, 931 F.2d 1472, 1474 (11th Cir. 1991) (“The Chanel-labeled goods purchased from Sola were counterfeit”). However, nothing of the sort is even hinted at in the complaint. As such, Plaintiffs seek to stretch the law of counterfeiting out of all reasonable proportion by claiming it applies to domain name registration services provided to third party registrants which link their domain names to Internet search results.

The law of trademark counterfeiting relates to knockoffs of designer goods, branded pharmaceuticals, and other similar infringements. There is no credible authority for extending it to the registration of domain names used to provide Internet search results. “Counterfeiting is the act of producing or selling a product with a sham trademark that is an intentional and calculated reproduction of the genuine trademark.” 3 J. Thomas McCarthy, *McCarthy on Trademarks* § 25:10 (3d ed. 1997). A “counterfeit mark” means:

a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered.

15 U.S.C. § 1116(d)(1)(B)(I); *see also Babbit Electronics, Inc. v. Dynascan Corporation*, 38 F.3d 1161, 1181 (11th Cir. 1994) (“Babbit had knowledge that the telephones to which they affixed Dynascan's marks were not Dynascan's telephones... Consequently, it is clear that Babbit used Dynascan's trademarks knowing that they were counterfeit. Babbit is therefore liable for trademark counterfeiting.”).

Plaintiffs do not allege the Registrar Defendants used any marks identical or “substantially indistinguishable” from their Alleged Marks in connection with goods or services which are confusingly similar to Plaintiffs’. Accordingly, their meritless “counterfeiting” claim should be dismissed as a matter of law.

D. All of Plaintiffs’ Claims Relating to the Domain Names Fail Because the Registrar Defendants Never Registered or Used Them

Plaintiffs’ Claims relating to the Domain Names blur the distinction between domain name registrars and domain name registrants. Registrars, like the Registrar Defendants, merely serve as an interface between their customers and the relevant domain name registries. Registrants actually own and control the registered domain names. The Registrar Defendants are not the registrant of any of

the Domain Names, as indicated by Plaintiff's own evidence. Nor does the Complaint allege facts sufficient to indicate the Registrar Defendants used or trafficked in the Domain Names. Since all Claims are based on the registration (as registrant) or use of the Domain Names, or on alleged trafficking in them, Plaintiffs' Claims must be dismissed.

1. Plaintiffs' First Claim for Cybersquatting Fails.

Plaintiffs' first Claim is for violation of the Anticybersquatting Consumer Protection Act ("ACPA"). However, domain name registrars such as the Registrar Defendants are immune from liability pursuant to the ACPA:

A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under [the Anticybersquatting Consumer Protection Act] for the registration or maintenance of a domain name for another absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

15 U.S.C. § 1114. "Congress intended expressly to limit the liability of domain name registrars under the [ACPA]." *Hawes v. Network Solutions, Inc.*, 337 F.3d 377, 384 (4th Cir. 2003). "Without such limitation of liability, all registrars would potentially have been exposed to the offense of cybersquatting because they register and traffic in domain names that could be infringing or diluting trademarks protected by the Lanham Act." *Id.*; *see also*, 47 U.S.C. §230(c)(1) ("[n]o provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider."). Plaintiffs do not allege any facts which warrant the conclusion that the Registrar Defendants were the registrant of any of the Domain Names. In fact, Plaintiffs' own evidence attached to the Complaint, as well as their allegations in the Complaint, show that individuals and entities other than the Registrar Defendants are the registrants of the Domain Names.

Moreover, the facts alleged in the Complaint do not support the conclusion that any of the Registrar Defendants “used” the Domain Names as that term is defined in the ACPA. 15 U.S.C. §1125(d)(1)(D) provides that “[a] person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant’s authorized licensee.” The Complaint indicates parties other than the Registrar Defendants are the registrants of the Domain Names. Further, Plaintiffs do not specifically allege that any of the Registrar Defendants are authorized licensees of any Domain Names – they merely insert the conclusory allegation that “[o]ne or more of Defendants” may have been authorized licensees. (*See, e.g.*, Complaint ¶ 143.) The Complaint does not provide any factual basis for this assertion – clearly contrary to the requirements of *Twombly* – which, in any event, is not directed specifically to the Registrar Defendants.

Since Plaintiffs do not allege facts sufficient to prove use or registration under the ACPA, the only argument remaining to them is “trafficking.” (*See* 15 U.S.C. § 1125(d)(1)(A)(ii) (ACPA liability attaches when a defendant “registers, traffics in, or uses a domain name”). Pursuant to 15 U.S.C. § 1125(d)(1)(E), trafficking involves the following kinds of transactions:

transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

Id. The Complaint does not allege any specific transactions of this kind. To the contrary, Plaintiffs allege the Domain Names were registered “to avoid paying” registration costs – in other words, that they were transferred without consideration. (Complaint ¶¶ 125-26.)² Accordingly, the Complaint

² Moreover, even were Plaintiffs to make such an allegation, the party injured would not be Plaintiffs, but ICANN. However, ICANN is well aware of the practice, is evaluating it, and has not taken any action to address it as of yet. *See* Motion to Unseal by Defendants BelguimDomains, LLC, CapitolDomains, LLC, and DomainDoorman, LLC, and Incorporated Memorandum of Law [DE 65] at 1-2.

does not provide a sufficient basis for holding the Registrar Defendants liable pursuant to the ACPA, and Plaintiffs' first Claim must be dismissed.

2. Plaintiffs' Second, Third, and Fourth Claims for Trademark Infringement, Unfair Competition, and Counterfeiting Fail.

Plaintiffs' second, third, and fourth Claims are based on the Registrar Defendants' alleged trademark infringement, unfair competition, and "counterfeiting" resulting from their alleged use of the Domain Names. However, a registrar who merely performs services on behalf of a registrant – the party which actually owns and uses the domain name – cannot be liable under these causes of action. The Complaint does not allege facts sufficient to show that the Registrar Defendants ever used or registered (for themselves or any related parties) the Domain Names.

As a matter of law, domain name registrars like the Registrar Defendants are immune from liability for allegedly infringing domain names registered by third parties. In *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949 (C.D.Cal. 1997), the court granted summary judgment to domain name registrar Network Solutions, Inc. ("NSI") holding that NSI was not liable for direct or contributory trademark infringement or dilution, based on NSI's acceptance of registrations for domain names that were identical or similar to Lockheed's trademarks. In directly applicable language, the *Lockheed* court held:

The Court finds that NSI's use of domain names is connected with their technical function to designate computers on the Internet, not with their trademark function to identify the source of goods and services. Because Lockheed cannot establish that NSI has used its service mark in connection with goods or services or with the sale, offer for sale, distribution or advertising of goods and services, the Court grants summary judgment for NSI on the direct infringement and unfair competition claims . . .

Id. at 967. This case is virtually identical. Like NSI, the Registrar Defendants are domain name registrars, not registrants, and, therefore, cannot be held liable for infringement or unfair competition.

Plaintiffs' Claims are founded upon the premise that the Registrar Defendants are the registrants of the Domain Names – *i.e.*, that the Registrar Defendants own and control the Domain Names. However, Plaintiff's evidence and allegations contradict this premise. The factual allegations in the Complaint provide no link between the Domain Names and the Registrar Defendants, other than to confirm Defendants served as registrars (not registrants). Consequently, Plaintiffs' Claims for trademark infringement, unfair competition, and counterfeiting must be dismissed.

3. Plaintiffs' Fifth Claim for Dilution Fails.

Plaintiffs cite the Federal Anti-Dilution Act, 15 U.S.C. §1125(c), as the basis for their fifth Claim. As Plaintiffs admit, however, that this argument is based on the Registrar Defendants' alleged "use of the Plaintiffs' Marks and variations thereof and the Infringing Domain Names in commerce." (Complaint ¶ 201.) As demonstrated above, however, Plaintiffs' exhibits contradict their allegations and fail to provide a factual basis for the claim that the Registrar Defendants are making, or ever have made, any use whatsoever of the Domain Names.

The mere registration or control of a domain name, even if it is similar or identical to a trademark, does not constitute trademark use. *Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998) (registration of a trademark as a domain name, without more, is not a commercial use of the trademark and therefore is not within the prohibitions of the Federal Anti-Dilution Act); *see also*, *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 133 (D. Mass. 1999) (holders of a trademark, even a famous mark, are not automatically entitled to use that mark as their domain name, nor prohibit others from registering and using the mark as part of a domain name.) In fact, Internet users often have free speech interests in non-infringing uses of domain names which are similar or even identical to trademarks. *American Civil Liberties Union of Georgia v. Miller*, 977 F. Supp.

1228 (N.D.Ga. 1997) (invalidating as an overbroad violation of the First Amendment a statute that prohibited the use of trademarks on the Internet by persons other than trademark owners).

Accordingly, the dilution Claim must be dismissed because Plaintiffs' Complaint does not provide facts sufficient to allege the Registrar Defendants are responsible for any dilution of Plaintiffs' trademarks, which dilution has not even sufficiently been alleged. Moreover, the Complaint completely fails to allege that the Registrar Defendants' uses of the Domain Names are infringing; to the contrary, the Complaint's exhibits show that these uses are not prohibited by the Federal Anti-Dilution Act.

4. Plaintiffs' Sixth through Eighth Claims for Florida State Law Violations Fail.

Plaintiffs' sixth, seventh, and eighth Claims are also based on the Registrar Defendants' purported dilution of the Alleged Marks, as well as state law unfair competition and alleged violation of the Florida Deceptive and Unfair Trade Practices Act ("FDUTPA"), Fla. Stat. § 501.201, *et seq.* Plaintiffs' Complaint provides no more basis for their state law claims than for their federal claims.

The sixth Claim is brought under Florida's dilution statute, Fla. Stat. §495.151, which requires "commercial use of a mark or trade name," and based on the Registrar Defendants' alleged "use of the Infringing Domain Names in connection with Defendants' goods and services." (Complaint ¶ 211.) However, Plaintiffs do not allege facts sufficient to indicate the Registrar Defendants are registrants of the Domain Names, nor that the registrants used the Domain Names in connection with their own goods and services (as opposed to search results). Consequently, Plaintiffs fail to state a claim for dilution under Florida law.

Plaintiffs also fail to state claims under FDUTPA and state law unfair competition. Pursuant to Fla. State 501.204(1), FDUTPA requires an "[u]nfair method[] of competition, unconscionable

act[] or practice, or an “unfair or deceptive” act or practice.” Plaintiffs base their FDUTPA Claim, like all their other Claims, on the Registrar Defendant’s alleged use of the Domain Names to deceive consumers. (Complaint ¶ 219.) Additionally, Plaintiffs’ failure to demonstrate likelihood of confusion as to their Lanham Act claims is fatal to its FDUTPA claims. *Custom Mfg. & Eng’g, Inc. v. Midway Servs.*, No. 05-12906, 2007 WL 4165634, *7 (11th Cir. Nov. 21, 2007). Since the Complaint provides insufficient facts to allege the Registrar Defendants used the Domain Names at all, let alone in commerce, and Plaintiffs cannot demonstrate likelihood of confusion, Plaintiffs’ seventh Claim under FDUTPA must also be dismissed. Likewise, Plaintiffs’ eighth Claim for state law unfair competition must similarly be dismissed:

Even giving the phrase “unfair competition” its broadest ordinary meaning, the offense must include at least two elements, “unfairness” and “competition.” This requirement that the offense include an element of rivalry is consistent with the plain meaning of the words and with recognized definitions.

Practice Mgmt. Assoc., Inc. v. Old Dominion Ins. Co., 601 So. 2d 587, 588 (Fla. 1st DCA 1992). Plaintiffs’ Complaint does not provide facts sufficient to allege unfairness – the Registrar Defendants only provided domain name registration services to others, which is not unfair to Plaintiffs. Further, there is no “competition” since the alleged facts do not support Plaintiffs’ claim that the Registrar Defendants used the Domain Names to compete with Plaintiffs.

Accordingly, all of Plaintiffs’ state-law claims fail, and should be dismissed.

E. The Purported Service on Netrian Should Be Quashed Because Plaintiffs’ Service of Process Was Insufficient

In addition to the bases for dismissal of Plaintiffs’ Claims set forth above, Plaintiffs’ attempted service of process on Netrian fails to satisfy the rules for service of process and deprives Netrian of its due process. Service of process on a domestic or foreign corporation, partnership or other unincorporated association in a judicial district of the United States requires “delivering a copy

of the summons and complaint to an officer, a managing or general agent, or to any other agent authorized by appointment or by law to receive service of process.” Fed. R. Civ. P. 4(h). Here, Plaintiffs’ purported service of process on Defendant Netrian fails to satisfy those criteria.

Plaintiffs served a summons and complaint not on a “officer, a managing or general agent, or to any other agent authorized by appointment or by law to receive service of process” but rather on an individual Plaintiffs describe merely as an “EMPLOYEE/BUSINESS AGENT” of Netrian. Courts require that the representative of a defendant company actually be an officer or agent or otherwise authorized to accept service of process. *See Thomas v. Furness (Pacific), Ltd.*, 171 F.2d 434, 435 (9th Cir. 1948) (dismissing defendant from action where person upon whom process was served was not an agent of defendant); *see also Estate of Klieman v. Palestinian Auth.*, 467 F. Supp. 2d 107, 114 (D.D.C. 2006) (holding service insufficient where “plaintiffs have filed no affidavits, declarations or other evidence to establish that Mr. Takash was an authorized agent for service of process or that he represented that he was”). Plaintiffs’ service of process on Defendant Netrian is insufficient and Plaintiffs’ claims against Netrian should be dismissed for this additional reason.

III. CONCLUSION

Plaintiffs’ Complaint does not allege facts sufficient to support their implicit contention that the Registrar Defendants were the registrants of the Domain Names, which is fatal to their Claims. Nor have Plaintiffs provided allegations which support their conclusory assertions regarding alleged use of the Domain Names in commerce. In addition, there is no basis for Plaintiffs’ meritless counterfeiting claim. The Domain Names are not “substantially indistinguishable” from the Alleged Marks, and there are no credible allegations that anyone provided “counterfeit” goods or services in connection with the “Counterfeit” Domain Names. Finally, the purported service of process on

Netrian must be quashed as insufficient. For these reasons, the Registrar Defendants respectfully request that this Court dismiss Plaintiffs' Complaint in its entirety.

WHEREFORE, defendants BelgiumDomains, LLC, CapitolDomains, LLC, DomainDoorman, LLC, Netrian Ventures Ltd., and iHoldings.com, Inc., respectfully request that the Court dismiss the Complaint for Cybersquatting, Trademark Infringement, Counterfeiting, Dilution, and Unfair Competition in its entirety and provide the Registrar Defendants with such other and further relief as the Court deems just and proper.

Respectfully submitted,

Date: December 7, 2007

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*Attorneys for BelgiumDomains, LLC,
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CERTIFICATE OF SERVICE

I hereby certify that on December 7, 2007, I electronically filed *Defendants BelgiumDomains, LLC, CapitolDomains, LLC, DomainDoorman, LLC, Netrian Ventures Ltd., and iHoldings.com, Inc.'s Motion to Dismiss and Incorporated Memorandum of Law* with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

s/Christopher S. Carver
Christopher S. Carver

SERVICE LIST
Dell, Inc. v. BelgiumDomains, LLC

U.S. District Court, Southern District of Florida Case No. 07-22674-CIV-JORDAN:

**Counsel for Plaintiffs Dell, Inc., and
Alienware Corporation**

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