

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No. 07-22674-Civ-JORDAN/Torres

DELL INC.; AND ALIENWARE CORPORATION,

Plaintiffs,

vs.

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.

PLAINTIFFS' MEMORANDUM IN OPPOSITION TO MOTION TO DISMISS

I. INTRODUCTION

In their Complaint, Plaintiffs Dell Inc. and its subsidiary Alienware Corporation (collectively "Dell") allege that Defendants¹ are both the registrar **and** the registrant of over 1,100 domain names that infringe and dilute, and are counterfeits of, Dell's service marks and trademarks. (Complaint, ¶¶70, 71, 122 and 123). Not only do Defendants work "together as a single entity" (Complaint, ¶15) and are alter egos of each other (Complaint, ¶16), but Defendants conceal their true identities by "using numerous shell-entities, fictitious business and personal names." (Complaint, ¶77). Dell identifies at least 23 different shell-entities, fictitious businesses and personal names (the "Unasi Identities") through which Defendants conduct or have conducted their business of registering domain names as a registrant

¹ BelgiumDomains, LLC, CapitolDomains, LLC, DomainDoorman, LLC, Netrian Ventures Ltd., and iHoldings.com, Inc. are collectively referred to as Defendants.

(Complaint, ¶¶78-110, 113) and further alleges that the Unasi Identities are the alter egos of Defendants. (Complaint, ¶112). Based on these (and other) allegations, Dell brought this action for cybersquatting, trademark infringement, dilution, counterfeiting, unfair competition, and related claims.

Despite the fact that Dell's Complaint sets forth a "short and plain statement" of its claims showing that it is entitled to relief, (Fed. R Civ. P. 8(a)(2)), Defendants move to dismiss the Complaint on four grounds. Defendants' Motion to Dismiss, however, is contrary to the facts, law and allegations of the Complaint, and must be denied for the following reasons:

First, Defendants claim that they are immune from liability because they only are the registrars of the infringing domain names, not the registrants. (Defendants Motion to Dismiss and Incorporated Memorandum of Law ("Motion"), pp. 9-10). Defendants are mistaken. The allegations of the Complaint, as well as the facts established through discovery,² reflect that Defendants are both the registrars and the registrants of the infringing domain names and that Defendants control, and are alter egos of, the shell entities, fictitious businesses and personal names that are listed as the registrants. (Complaint, ¶¶70-71, 77-113).

Second, Defendants claim that the domain names were not used in commerce because the Defendants "only displayed Internet search results" on their websites. (Motion, p. 2). Defendants' view regarding what constitutes a use in commerce is misguided, at best, and the Complaint properly alleges that Defendants' use was a use in commerce.

² Mindful of the limited scope of a Motion to Dismiss, Dell limits this Opposition to the allegations of fact and supporting exhibits presented in the Complaint. It should be noted, however, that documents produced under this Court's Expedited Discovery Order show that the registrants of the infringing domain names are in fact alter egos of, or shell-entities controlled by, Defendants as the Complaint alleges.

Third, Defendants argue that Dell's counterfeiting claim must fail because "there is no credible authority for extending [a counterfeiting claim] to the registration of domain names." (Motion, p. 9). Again, Defendants are mistaken. Courts hold that domain names can be counterfeit marks likely to cause confusion, including this Court. *See, e.g., Petmed Express, Inc. v. Medpets.com, Inc.*, 336 F. Supp. 2d 1213 (S.D. Fla. 2004); *MPS IP Servs. Corp. v. Modis Commc'ns, Inc.*, 2007 U.S. Dist. LEXIS 15637, at *8-9 (M.D. Fla. Mar. 6, 2007); *Aztar Corp. v. MGM Casino*, 59 U.S.P.Q.2d 1460, 1463 (E.D. Va. 2001). Defendants fail to acknowledge, let alone address or attempt to distinguish these cases, all of which Dell previously cited in its Motion for *Ex Parte* Temporary Restraining Order and Preliminary Injunction. Further, Defendants do not cite any cases to the contrary.

Finally, Defendants contend that service of process against Netrian Ventures Ltd was insufficient requiring dismissal of that particular defendant because it was not served on an officer, a managing agent or a designated registered agent. Defendants do not inform the Court, however, that Netrian did not comply with Florida Law and appoint a registered agent. In those situations, Florida law permits service on any employee at Netrian's principal place of business. § 48.081(3)(a), Fla. Stat. (2006). Since Netrian was served at the address it reported to the Florida Secretary of State, service was appropriate. Moreover, any objection that service was deficient is now moot as Netrian was also served via the Florida Secretary of State in accord with § 48.181(1), Fla. Stat. (2006).

II. ARGUMENT

A. Standard of Review

Under Rule 8(a) of the Federal Rules of Civil Procedure, a complaint need only "contain a short and plain statement of the claim showing that the pleader is entitled to relief." This remains the standard, even after the Supreme Court's recent decision in *Bell Atlantic Corp. v.*

Twombly, ___ U. S. ___, 127 S. Ct. 1955 (2007). As the Supreme Court made clear just two weeks later (in a case ignored by Defendants), “[s]pecific facts are not necessary; the [complaint] need only give the defendant fair notice of what the . . . claim is and grounds upon which its rests.” *Erickson v. Pardus*, ___ U.S. ___, 127 S.Ct. 2197, 2200 (2007).

The *Erickson* court also reinforced that, “when ruling on a defendant’s motion to dismiss, a judge must accept as true all of the factual allegations contained in the complaint.” *Id.* (citing *Bell Atlantic* (slip op., at 7-8)). See also *Watts v. Fla. Int’l Univ*, 495 F. 3d 1289, 1295 (11th Cir. 2007) (“the pleadings are construed broadly” in a Rule 12(b)(6) motion to dismiss and “the allegations in the complaint are viewed in the light most favorable to the plaintiff”). Motions to dismiss under Rule 12(b)(6) are rarely granted and are generally viewed with disfavor. *Brooks v. Blue Cross & Blue Shield*, 116 F. 3d 1364, 1369 (11th Cir. 1997). Indeed, the Supreme Court has stated that “[l]iberal discovery rules and summary judgment motions, not motions to dismiss, should be used to define disputed facts and issues” *Swierkiewicz v. Sorema N. A.*, 534 U. S. 506, 122 S. Ct. 992, 998 (2002).

Not surprisingly, Defendants attempt to restate the standard of review by conflating the new law under *Bell Atlantic* with the heightened pleading requirements under Fed. R. Civ. P. 9(b) for pleading special matters such as fraud. Even though Dell’s claims arise under the Lanham Trademark Act and related Florida State law, and do not require heightened pleading under Rule 9(b)³, Defendants improperly cite cases that consider the pleading requirements for claims of Federal Securities Fraud and RICO violations.⁴ Dell’s Complaint properly sets

³ See *Motmanco v. McDonald's Corp.*, 2005 WL 1027261, *8 (M.D.Fla.2005) (“While fraud may be actionable under the FDUTPA, proof of misrepresentation or deceit sufficient to constitute fraud is not a necessary element in all causes of action brought under the FDUTPA”).

⁴ *Garcia v. SantaMaria Resort, Inc.*, No. 07-10017-CIV, 2007WL 4127628, *3 (S.D. Fla. Nov.15, 2007) (King, J.)(“[the Amended Complaint] alleges violations of § 10 of the Securities

forth sufficient facts that give Defendants full and fair notice of what Dell's claims are and the grounds upon which those claims rest. As such, Defendants' Motion to Dismiss should be denied.

B. Dell Alleges That Defendants Are Both The Registrars And The Registrants Of The Infringing Domain Names

Dell's Complaint alleges that "Defendants registered Defendants' Domain Names for their own use, i. e. Defendants are *both the registrar and the registrant* of Defendants' Domain Names." (Complaint, ¶71) (Emphasis added); "[o]ne or more of Defendants is or was the registrant or the registrant's authorized licensee or user of each of the Infringing Domain Names." (Complaint, ¶143). Even though the whois data in the Complaint identifies registrants with different names than Defendants, the Complaint alleges that each of these registrants are shell entities, fictitious businesses and personal names controlled by Defendants (Complaint, ¶¶77-112. 113) and the alter ego of the Defendants (Complaint, ¶112). The Complaint additionally describes Defendants' scheme of transferring the Infringing Domain Names among the three registrar defendants, and that for each registration one of the shell identities was listed as the registrant. (Complaint, ¶¶126-132).

For example, some of the whois data in Exhibit 8 to the Complaint identifies Keyword Marketing, Inc. (with an address at P.O. Box, 556, Main Street, Charlestown, West Indies KN) as the registrant, and DomainDoorman, LLC as the registrar of the domain name dellcustomer care.com on May 22, 2007. Yet, Dell alleges that "[o]ne or more Defendants conduct business as Keyword Marketing, Inc., P.O. Box 556, Main Street, Charlestown, West Indies, Saint Kitts and Nevis." (Complaint, ¶82).

Exchange Act of 1934)."

On May 28, 2007, that same domain name, dellcdustomermercure.com, was registered by Marketing Total S.A. (with an address at P.O. Box, 556, Main Street, Charlestown, West Indies KN) as the registrant and BelgiumDomains as the registrar.⁵ Again, Dell alleges that “[o]ne or more Defendants conduct business as Marketing Total S.A., P.O. Box 556, Main Street, Charlestown, West Indies, Saint Kitts and Nevis.” (Complaint, ¶86). It is significant that Keyword Marketing, Inc. and Marketing Total S.A. have the same address.

Despite these (and many other) allegations, Defendants have the audacity to claim that they are not the registrants of the infringing domain names. *See* Motion, pp. 9-10 (“The Registrar Defendants are not the registrant of any of the Domain Names, as indicated by Plaintiff’s own evidence”). Defendants repeat this mantra in an obvious attempt to mislead the Court: “Plaintiffs allege the Domain Names are all registered to entities and individuals other than the Registrar Defendants, such as Carribean Online International Ltd. and Domain Drop S.A.” (Motion, p. 3). Defendants fail to inform the Court, however, that Dell specifically alleges that “[o]ne or more Defendants conduct business as” Carribean Online International Ltd. (Complaint, ¶78) and Domain Drop S.A. (Complaint, ¶80).

Defendants ignore Dell’s allegations that *Defendants themselves* registered and used the Infringing Domain Names because Defendants *are* the “Unasi Identities” (as that term is defined in paragraph 111 of the Complaint). Even though the Unasi Identities are listed as the registrants of the Infringing Domain Names, the Complaint clearly and directly alleges that Defendants and the Unasi Identities are one and the same. *See Flentye v. Kathrein*, 485 F. Supp. 2d 903, 914-15 (N.D. Ill. 2007) (even if the Defendant did not actually register the domain name, an alter ego

⁵ Dell’s allegation of the kiting of dellcdustomermercure.com can be found in paragraph 131 of the Complaint.

allegation was sufficient to deem that Defendant is a domain name registrant). As such, the Complaint properly alleges that Defendants themselves committed the wrongdoing at issue.⁶

C. Defendants Are Not Immune From Liability Under The ACPA Because They Are Both Registrars And Registrants, And Because They Registered The Infringing Domain Names With A Bad-Faith Intent To Profit From Dell's Marks

Defendants claim that they are immune from liability under the Anticybersquatting Consumer Protection Act (“ACPA”) simply because they are domain name registrars. Defendants’ argument fails for two reasons. First, as discussed above, Dell alleges that Defendants, as *registrants*, have registered, used, and trafficked in the Infringing Domain Names for their own benefit. Second, Defendants’ claim that, “[a]s a matter of law, domain name registrars like the Registrar Defendants are immune from liability for allegedly infringing domain names registered by third parties” (Complaint, pg. 12.) broadly misstates the law.

While Defendants assert immunity, pointing to the fact that Defendants are the registrars for the Infringing Domain Names, this assertion is nothing more than Defendants’ oft-repeated claim (which is contradicted by the allegations of the Complaint) that they are not the registrants

⁶ Apparently, Defendants’ real quarrel is not that Dell’s Complaint lacks factual allegations of wrongful conduct by Defendants, but that it lacks *proof* of those allegations. *See* Motion, p. 10 (“Plaintiffs do not allege any facts which warrant the conclusion that the Registrar Defendants were the registrant of any of the Domain Names”); *see also* Motion, p. 3 (“Plaintiffs make the conclusory allegation that the Domain Name registrants are employed by the Registrar Defendants ‘to conceal their true identities’ but they do not allege any facts which warrant that conclusion”); *see also* Motion, p. 15 (“Additionally, Plaintiffs’ failure to demonstrate likelihood of confusion as to their Lanham Act claims is fatal to its FDUTPA claims”). Rule 8, however, does not require that a complaint contain proof or demonstrate the *prima facie* elements of the claims. Indeed, the Supreme Court recognized the distinction between “facts” and “proof” in *Bell Atlantic*: “a well-pleaded complaint may proceed even if it strikes a savvy judge that actual *proof* of those *facts* is improbable, and ‘that a recovery is very remote and unlikely.’ ” *Bell Atlantic Corp.*, 550 U. S. at ___, 127 S. Ct. at 1965 (emphasis added). Nevertheless, Dell has alleged the *fact* that Defendants are the actual registrants of the domain names and has provided ample evidence in support of its allegations.

of the Infringing Domain Names. Taking Dell's allegations as true--that Defendants are *also the registrants* of the Infringing Domain Names--which is appropriate in deciding a motion to dismiss, Defendants' claim of immunity fail.

Moreover, even if Defendants were just the registrars for the Infringing Domain Names, they would still not qualify for the ACPA's exception from liability for registrars. The ACPA immunizes a domain name registrar from liability "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 (emphasis added). Here, Dell properly alleges that the Defendants had a bad-faith intent to profit from Dell's Marks. Specifically, Dell's Complaint alleges that, "Defendants registered, trafficked in, or used the Infringing Domain Names with a bad-faith intent to profit from Plaintiffs' Marks." (Complaint, ¶141). Accordingly, the Complaint properly asserts that Defendants do not qualify for this exemption.

The Defendants cite one case, *Hawes v. Network Solutions, Inc.*, 337 F.3d 377, 380 (4th Cir. 2003), supporting their claim of immunity. However, this case involved a registrar being sued by its customer after the registrar transferred the customer's domain name to 3rd party in accord with a court's order. The registrar in *Hawes* was not accused of also being the registrant of the infringing domain names at issue in the case, nor was it accused of using or trafficking in domain names for its own benefit. On the other hand, in at least two cases with virtually identical facts, courts have denied registrar defendants' motions to dismiss where the complaint alleges that the registrar is also the registrant of the domain names, or has used or trafficked in the domain names.

In *Verizon Cal. et al. v. Maltuzi LLC*, a registrar moved to dismiss the Complaint against it claiming it was not the "domain name registrant or that registrant's authorized licensee." *Verizon Cal. et al. v. Maltuzi LLC*, CV 07-1732 PA (JCx) (C.D. Cal.). The Court denied this motion reasoning that "[t]he First Amended Complaint also alleges that 'each Defendant was acting as the agent or on behalf or at the direction of the other Defendants.' At least at this state, and given the apparent disputes concerning the relationship between the Defendants and the role

each plays, the Court concludes that the First Amended Complaint's allegations are sufficient to state a claim under the ACPA against Defendants." *Id.*, Min. Order at pg. 4, Nov. 5, 2007). A copy of the Court's Minute Order is attached to this memorandum as Exhibit 1.

In *Dell Inc v. Intercosmos Media Grp., Inc. et al.* the Plaintiff Dell Inc. alleged that the defendant registrar had, as registrants, registered, used, and trafficked in infringing domain names for their own benefit. *Dell Inc v. Intercosmos Media Grp., Inc. et al.*, 2:07-cv-02668-GTP-SS (E.D. LA.). The registrar defendant moved to dismiss the complaint against it, for among other reasons, because it claimed that as a registrar it was immune under the ACPA. *Id.*, Motion to Dismiss. The court denied the registrar defendant's motion without comment. *Id.*, Min. Order at pg. 1, Aug. 29, 2007). A copy of the Court's Order is attached to this memorandum as Exhibit 2.

Here, just as in the cases discussed above, dismissal of a claim in a well-pleaded Complaint that asserts a registrar is also the registrant of infringing domain names is unwarranted.

D. Dell Alleges That Defendants Use The Trademarks In Commerce By Registering Domain Names And Providing Websites At The Domain Names That Generate Revenue For Defendants

Dell's Complaint alleges that Defendants used the Dell Marks in commerce when Defendants registered and used the Infringing Domain Names, and used the Dell Marks in operating websites accessible at the Infringing Domain Names that generated revenue for Defendants at Dell's cost. For example, Dell's Complaint alleges that "Defendants use or used the Infringing Domain Names to divert for commercial gain Internet users searching for Plaintiffs' Marks or Plaintiffs' websites." (Complaint, ¶133). More specifically, Dell alleges that Defendants "used each of the Infringing Domain Names for 'pay-per-click' websites that display or displayed advertising links to various commercial websites, many of which offer goods or services identical, directly competitive or related to those sold or provided in

connection with Plaintiffs' Marks," (Complaint, ¶134) and that Defendants "caused pop-up and pop-under advertisements to be displayed when Internet users accessed or access the websites at some of the Infringing Domain Names." (Complaint, ¶135). In addition, Dell has provided selected screenshots of the websites accessible at the Infringing Domain Names that show that "pay-per-click" advertisements are provided on those websites. (Exhibits 9 and 10 to the Complaint).

Despite these allegations, Defendants contend that the Complaint must be dismissed because "the Complaint shows that [Defendants] never used the Alleged Marks in a commercial, trademark sense." (Motion, p. 6). Again, Defendants are wrong.

First, Defendants mischaracterize the law regarding what constitutes a "use in commerce" for the purposes of infringement by citing a case that discusses the "use in commerce" requirement applicable to registration of a trademark and not infringement. (Motion, p. 5). *See Qualitex C. v. Jacobson Products Co.*, 514 U.S. 159 (1995); Prof. J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition* § 23:11.50 (4th ed. 2007) ("The Lanham Act § 45 definition of 'use in commerce' . . . was clearly drafted to define the types of 'use' that are needed to qualify a mark for federal registration - not as a candidate for infringement.")

Second, even though Dell does not allege that Defendants "used" the Dell Trademarks by operating a search engine and offering a Dell mark for sale as an advertisement keyword, Defendants improperly rely on a case related to the provision of search engine advertisements on the search engine's own webpage. (Motion, p. 6). Defendants rely on *Rescuecom Corp. v. Google Inc.*, 456 F. Supp. 2d 393 (N.D. N.Y. 2006) where the Court found that Google, a defendant that did not register infringing domain names, did not use trademarks "in commerce" by selling keyword advertisements keyed on the entry of the trademarks as search queries. The

Rescuecom case and fact pattern is inapposite to the facts presented in this case. Moreover, Defendants fail to inform the Court that the law upon which the *Rescuecom* case is based has been rejected in this circuit. See *Rescuecom Corp. v. Computer Troubleshooters USA, Inc.*, 464 F.Supp.2d 1263, 1266-67 (N.D. Ga 2005) (rejecting the 2nd Circuit's approach to this question in favor of the 9th Circuit's view that selling trademarks as keywords is probably a "use"). Further, Defendants fail to cite *Lahoti v. Vericheck*,⁷ where the domain name registrant "directed consumers to another website that earned him income from sponsored search results." *Lahoti v. Vericheck*, 2007 U.S. Dist. LEXIS 64666 at *25 (W.D. Wash. Aug. 30, 2007) The *Lahoti* court held that the domain name registrant's conduct constitutes a commercial use. *Id.*

Third, Defendants repeatedly rely on cases that state "mere registration" of a domain name is not actionable use of a trademark in commerce, without more, when Defendants have done far more than merely register domain names. (Motion, pp. 6, 7, 13). Given Dell's allegations of considerably more than "mere registration," namely, registering the infringing domain names *and* offering "pay-per-click" websites at those domain names, Defendants arguments fail.⁸ Furthermore, Courts hold that registering numerous infringing domain names and providing websites accessible at those domain names that contain revenue-generating advertisements, some of which are for products that compete with the trademark owner's products, is clearly "use" of the trademark "in commerce." See, e. g., *Lennar Pacific Properties Management, Inc. v. Dauben, Inc.*, 2007 U.S. Dist. LEXIS 60414 (N.D. Tex. Aug. 16, 2007) (finding that defendant's use of the plaintiff's trademark in a domain name that connected to a

⁷ Defendants' counsel also represented the domain name registrant in *Lahoti*.

⁸ It is questionable, however, whether more than "mere registration" is required under the law after the ACPA was enacted. The ACPA makes actionable such registration, without more, as long as the defendant registered the domain name with a bad-faith intent to profit from the name. 15 U.S.C. §1125(d)(1)(A).

website resembling a search page (i.e., a pay-per-click website like Defendants') was a clear violation of 15 U.S.C. § 1114(1) and thus constituted an actionable trademark use); *Planned Parenthood Fed'n of Am. v. Bucci*, 1997 U. S. Dist. LEXIS 3338 (S.D. N. Y. 1997) ("Defendant simply ignores the fact that he has done more than merely register a domain name; he has created a home page that uses plaintiff's mark as its address, conveying the impression to Internet users that plaintiff is the sponsor of defendant's web site."); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F. 3d 1002 (9th Cir. 2004) (finding commercial use and infringement where Defendant Uzi Nissan placed links to auto-related websites on his nissan.com website).

It is noteworthy that Defendants attempt to recast their actions as "redirecting" Internet users to "results which appear to have been provided by an Internet search engine." (Motion, pp. 3, 6, 8). An examination of the screenshots of Exhibits 9 and 10 reveals, however, that the users visiting these Infringing Domain Names are not "redirected;" rather, the website they view at the Infringing Domain Name contains numerous links to websites offering products and services identical or related to those sold or provided in connection with Dell's Marks, many of which are directly competitive with Dell's goods and services.

Here, just as in the cases discussed above, Dell alleges that Defendants provide websites at the Infringing Domain Names that host pay-per-click advertisements. (Complaint, ¶134). Therefore, dismissal of Dell's well-pleaded Complaint that alleges that Defendants used the Dell Marks in commerce is unwarranted.

E. Dell's Counterfeiting Claim Meets Rule 12(b)(6) Requirements

Courts hold that a domain name can constitute a counterfeit mark, including this Court. For example, in *Petmed Express, Inc. v. Medpets.com, Inc.*, plaintiff PetMed Express owned federal trademark registrations for the marks PETMED EXPRESS, INC. and 1888PETMEDS, and marketed pet-care medicines and products over the Internet using the domain names 1888petmeds.com, petmeds.com, 1800petmeds.com, and petmedexpress.com. 336 F. Supp. 2d

1213, 1216 (S.D. Fla. 2004). The defendants began selling pet-care products via a website using the domain names medpets.com and 1888medpets.com. The court found that “Defendants’ domain names are counterfeit marks likely to confuse consumers into [mistakenly] thinking that [defendants’ websites] www.medpets.com and www.1888medpets.com are associated with PetMed.” Id. at 1220. The court awarded, *inter alia*, statutory damages under the Trademark Counterfeiting Act. Id. at 1220-21.⁹

Dell’s Complaint alleges that Defendants, similar to the Petmed defendants, registered numerous domain names without Plaintiffs’ consent that are identical to, or substantially indistinguishable from, Dell’s Marks and provides a detailed list of those domain names. (Complaint, ¶123).¹⁰ Dells Complaint also alleges facts which support each element of a trademark counterfeiting claim. (Complaint, ¶¶187-192). For example, Dell alleges that “Defendants’ use in commerce of Plaintiffs’ Marks and substantially indistinguishable variations thereof is likely to cause confusion, mistake, or to deceive.” (Complaint. ¶ 187). Dell also

⁹ Other courts have also held that domain names can constitute counterfeit marks. *See, e.g., MPS IP Servs. Corp. v. Modis Commc’ns, Inc.*, 2007 U.S. Dist. LEXIS 15637, at *8-9 (M.D. Fla. Mar. 6, 2007) (citing *Petmed Express*) (holding defendant’s website using the domain name modis.com offering IT consulting services counterfeited plaintiff’s federally registered MODIS mark for IT consulting services); *see also Aztar Corp v. MGM Casino*, 59 U.S.P.Q.2d 1460, 1463 (E.D. Va. 2001), *adopted by*, 2001 U.S. Dist. LEXIS 13110 (E.D. Va. Apr. 9, 2001 (finding domain name tropicanacasino.com counterfeited registered TROPICANA mark); *Playboy Enters. v. Asiafocus Int’l, Inc.*, 1998 U.S. Dist. LEXIS 10359, at *23 (E.D. Va. 1998) (cited by *Petmed Express*) (holding content of websites at domain names asian-playmates.com and playmates-asian.com counterfeited registered PLAYBOY and PLAYMATE marks). In *Microsoft Corp. v. Evans* the court characterized the damages granted in *Playboy v. AsiaFocus* as “1,000,000 for willful infringement of two counterfeit domain names”. *Microsoft Corp. v. Evans*, 2007 U. S. Dist. LEXIS 77088 (E.D. Cal. 2007).

¹⁰ These domain names are counterfeits of Dell’s Marks because they either contain the DELL Marks (e.g., *dell-computers-help.com*), or differ from the ALIENWARE Marks by only one character (e.g., *al9ienware.com*). In some cases, such as *dellinkprinter.com*, Defendants add a generic or descriptive term associated with Dell’s goods or services. These domain names are “counterfeits” because they are identical to, or substantially indistinguishable from, Dell’s Marks, and the advertising services offered by Defendants under such “counterfeit” domain names are identical to those covered by Dell’s federal registrations.

provides evidence of Defendants' use of the domain names to support its claim of counterfeiting. Exhibits 9 and 10 to Complaint.

Defendants' central argument for dismissing Dell's counterfeiting claim is that "Plaintiffs seek to stretch the law of counterfeiting out of all reasonable proportion by claiming it applies to" Defendants' conduct. (Motion, p. 8). Characterizing the law of trademark counterfeiting only as "related to knockoffs of designer goods," Defendants contend that "there is no credible authority for extending it to the registration of domain names" (Motion, p. 9). Defendant are mistaken. In fact, Defendants arguments are disingenuous given the fact that Dell's Memorandum Of Law In Support Of Plaintiffs' Motion For *Ex Parte* Temporary Restraining Order And A Preliminary Injunction [D.E. #8], which was served on Defendants on November 9, 2007, contains ample authority to support Dell's counterfeiting claims. It is telling that Defendants do not even acknowledge, let alone address or attempt to distinguish any of these cases in their Motion. Nor do Defendants cite any cases to the contrary.

F. Dell Properly Effected Service At The Business Address Provided By Netrian To Florida's Secretary Of State

In a final attempt to avoid answering for its wrongful conduct, Defendant Netrian Ventures, Ltd. ("Netrian"), contests the sufficiency of service of process. Netrian's contention is not only misleading, it is simply wrong.

Plaintiffs effected service on Netrian by serving an employee at Netrian's place of business. Netrian does not argue that the individual served was not an employee. Instead, it alleges that service was ineffective because Plaintiffs failed to serve "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)." (Motion, p. 16).

Netrian ignores the fact that Fed. R. Civ. P. 4(h) designates at least one additional method

for proper, effective service. Federal Rule of Civil Procedure 4(h) expressly permits service upon domestic or foreign corporations and other entities “in the manner prescribed for individuals by subdivision (e)(1)...” which authorizes service “**pursuant to the law of the state in which the district court is located.**” Fed. R. Civ. P. 4.(e)(1) (emphasis added). As demonstrated below, Dell properly served Netrian under Fed. R. Civ. P. 4(e)(1). Consequently, Netrian’s assertion of inadequate service of process should be rejected by the Court.

Each Registrar Defendant¹¹ is a Florida limited liability company organized under Chapter 608, Florida Statutes (2007). As a result, the Registrar Defendants are required to be member-managed companies whose affairs are “designated to be managed by one or more managing members.” §§ 608.402(19) and (20) and 608.422, Fla. Stat. (2007).

Netrian has been the statutorily-required managing member for each Registrar Defendant since May 8, 2007. As the sole managing member, Netrian was the only entity responsible for managing the business affairs of the Registrar Defendants and directing the filing of annual reports with the Secretary of State for the State of Florida.¹² In fact, on May 8, 2007, Netrian caused the filing of the Registrar Defendants’ 2007 Limit Liability Company Annual Reports, and provided the following information to the Secretary of State:

¹¹ BelgiumDomains, LLC, CapitolDomains, LLC, DomainDoorman, LLC, are the Registrar Defendants.

¹² Netrian attempts to preserve its ability to argue that “there is no personal jurisdiction over it in the State of Florida.” (Motion, p. 1 at fn. 1). The fact that Netrian is the managing member of three **Florida** limited liability companies is more than adequate to establish that (a) Netrian has sufficient contacts with Florida to be subject to personal jurisdiction, and (b) exercising jurisdiction over Netrian comports with traditional notions of fair play and substantial justice. *Sloss Industries Corp. v. Eurisol*, 488 F.3d 992, 925 (11th Cir. 2007). Consequently, any attack on an alleged lack of personal jurisdiction would be disingenuous, at best.

MANAGING MEMBERS/MANAGERS:

Title: MGRM () Delete
 Name: IHOLDINGS.COM, INC.,
 Address: 501 NE 1ST AVE SUITE # 201
 City-St-Zip: MIAMI, FL 33132 US

ADDITIONS/CHANGES:

Title: MGRM (X) Change () Addition
 Name: NETRIAN VENTURES LTD, .
 Address: 501 NE 1ST AVE SUITE # 201
 City-St-Zip: MIAMI, FL 33132 US

Copies of the Certified 2007 Limited Liability Company Annual Reports for each of the three Registrar Defendants are attached to this memorandum as Composite Exhibit 3.¹³ By a separate Notice of Filing the original certified copies are being submitted to the Court.

As the designated managing member of three Florida limited liability companies, Netrian should have qualified with the Secretary of State to transact business in Florida and should have designated a registered agent pursuant to 607.050(1)(a), Florida Statutes (2006).¹⁴ Netrian failed to do either. As a result, **“pursuant to the law of the state in which the district court is located,”**¹⁵ Plaintiffs effected service on Netrian under Section 48.081(3)(a), Florida Statutes:

As an alternative to all of the foregoing [methods for service on private corporations, domestic or foreign] process may be served on the agent designated by the corporation under s. 48.091. However, if service cannot be made on a registered agent because of failure to comply with s. 48.091, **service of process shall be permitted on any employee** at the corporation’s principal place of business ...

§ 48.081(3)(a), Fla. Stat. (2006) (emphasis added).¹⁶

In an abundance of caution, however, Dell also has served Netrian pursuant to Section

¹³ The address for Netrian, as well as for iHoldings.com, Inc., the Registrar Defendants’ former managing member, is the offices of Richard Baron, Esquire, the attorney for Defendant Vazquez and the former President of iHoldings.com, Inc.

¹⁴ Each corporation, foreign corporation, or alien business organization that . . . that transacts business in this state **shall have and continuously maintain** in this state a registered office and a registered agent and shall file with the Department of State notice of the registered office and registered agent. § 607.0505(1)(a), Fla. Stat. (2006) (emphasis added).

¹⁵ Fed. R. Civ. P. 4(e)(1).

¹⁶ Florida corporations and foreign corporations now qualifying or hereafter qualifying to transact business in Florida shall designate a registered agent and registered agent office. § 48.091(1).

48.181(1), Florida Statutes, which provides:

The acceptance by any person or persons, individually or associated together as a copartnership or any other form or type of association, who are residents of any other state or country, and all foreign corporations, and any person who is a resident of the state and who subsequently becomes a nonresident of the state or conceals his or her whereabouts, of the privilege extended by law to nonresidents and others to operate, conduct, engage in, or carry on a business or business venture in the state, or to have an office or agency in the state, **constitutes an appointment by the persons and foreign corporations of the Secretary of State of the state as their agent on whom all process in any action or proceeding against them, or any of them, arising out of any transaction or operation connected with or incidental to the business or business venture may be served.** The acceptance of the privilege is signification of the agreement of the persons and foreign corporations that **the process against them which is so served is of the same validity as if served personally on the persons or foreign corporations.**

§ 48.181(1), Fla. Stat. (2006) (emphasis added). The Return of Service is attached to this memorandum as Exhibit 4.¹⁷

For the reasons set forth herein, and as a matter of law and fact, Netrian was properly served on November 9, 2007. Consequently, Netrian's request to quash service should be denied.

III. CONCLUSION

For the above reasons, Plaintiffs request that the Court deny Defendants' Motion to Dismiss.

Dated: December 26, 2007

Respectfully submitted,

/s/ Mimi L. Sall

Mimi L. Sall (Fla. Bar No. 436704)

E-mail: msall@swmwas.com

STEARNS WEAVER MILLER WEISSLER

ALHADEFF & SITTERSON, P.A.

200 East Las Olas Boulevard, Suite 2100

Fort Lauderdale, Florida 33301

Tel: 954-462-9575

Fax: 954-462-9567

David J. Steele

¹⁷ Service through the Secretary of State occurred within the 120-day period in which to affect service of process. Fed. R. Civ. P. 4(m).

Email: david.steele@cph.com
CHRISTIE, PARKER & HALE, LLP
3501 Jamboree Road
Suite 6000 - North Tower
Newport Beach, CA 92660
Tel.: 949-476-0757
Fax: 949-476-8640

Howard A. Kroll
Email: howard.kroll@cph.com
CHRISTIE, PARKER & HALE, LLP
350 West Colorado Boulevard, Suite 500
Pasadena, CA 91105
Tel.: 626-795-9900
Fax: 626-577-8800

CERTIFICATE OF SERVICE

I hereby certify that on December 26, 2007, I electronically filed the foregoing document 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/ Mimi L. Sall

Dell Inc. and Alienware Corporation vs. Belgiumdomain, LLC, et al.
Case No. 07-22674-Civ-JORDAN/Torres
United States District Court, Southern District of Florida

Lawrence P. Rochefort, Esquire
E-mail: lawrence.rochefort@akerman.com
Christopher S. Carver, Esquire
E-mail: christopher.carver@akerman.com
AKERMAN SENTERFITT
SunTrust International Center
Suite 2500
One S.E. Third Avenue
Miami, Florida 33131
Tel.: 305-374-5600
Fax: 305-374-5095
Attorneys for BelgiumDomains, LLC,
CapitolDomains, LLC, DomainDoorman,
LLC, Netrian Ventures, Ltd., and
iHoldings.com, Inc.
Service by CM/ECF

Richard Baron, Esquire
Email: rbaron@bellsouth.net
Richard Baron & Associates
501 NE 1st Avenue
Suite 201
Miami, FL 33132
Tel. 305-577-4626
Fax: 305-577-4630
Attorneys for Defendant Juan Pablo Vazquez
Service by CM/ECF

Joel R. Dichter, Esquire
E-mail: jdichter@NewmanDichter.com
Derek Newman, Esquire
E-mail: derek@NewmanDichter.com
Newman Dichter
505 Fifth Avenue South, Suite 610
Seattle, WA 98104
Tel.: 206-274-2800
Fax: 206-274-2801
(*Moving for Admission Pro Hac Vice*)
Service by CM/ECF