

THE HONORABLE RONALD B. LEIGHTON

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT TACOMA

THE NEIMAN MARCUS GROUP, INC.;  
BERGDORF GOODMAN, INC.;  
AND NM NEVADA TRUST,

Plaintiffs,

vs.

DOTSTER, INC. A/K/A REVENUEDIRECT;  
REGISTRARADS, INC.; AND SCOTT FISH,

Defendants.

NO. C06-5292RBL

PLAINTIFFS' MOTION FOR  
PRELIMINARY INJUNCTION

NOTE FOR MOTION CALENDAR:  
JANUARY 12, 2007

ORAL ARGUMENT REQUESTED

**I. INTRODUCTION**

Plaintiffs NM Nevada Trust, The Neiman Marcus Group, Inc. and Bergdorf Goodman, Inc. (collectively "Plaintiffs") move this Court pursuant to Federal Rule of Civil Procedure 65 for entry of an order enjoining Defendants Dotster, Inc., RegistrarAds, Inc., and Scott Fish. This Motion is supported by authorities set forth below and the declaration of Nelson A. Bangs, Benjamin G. Edelman, and David J. Steele, filed concurrently herewith. A proposed form of order also accompanies this Motion.

1 Plaintiffs are the owners or licensees of the famous trade names, trademarks and service  
2 marks NEIMAN-MARCUS, NEIMAN MARCUS and BERGDORF GOODMAN (collectively,  
3 “Plaintiffs’ Famous Marks”). Defendants Dotster, Inc., Dotster’s employee, Scott Fish, and  
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Plaintiffs are the owners or licensees of the famous trade names, trademarks and service marks NEIMAN-MARCUS, NEIMAN MARCUS and BERGDORF GOODMAN (collectively, “Plaintiffs’ Famous Marks”). Defendants Dotster, Inc., Dotster’s employee, Scott Fish, and Dotster’s affiliate, RegistrarAds, Inc. (collectively, “Defendants”), operate one of the largest and most nefarious cybersquatting operations the Internet has ever seen, having registered and used thousands of domain names that are confusingly similar to famous marks.<sup>1</sup> Defendants’ portfolio of domain names reads like a who’s who of corporate America, including obvious misspellings of many famous marks, including Plaintiffs’ Famous Marks. Defendants also employ a number of devices to cloak their unlawful activities and the true scope of their efforts, and have gone to great lengths to conceal their true identities.

Plaintiffs require immediate injunctive relief because Defendants continue to unlawfully register and use domain names that are confusingly similar to Plaintiffs’ Famous Marks even *after* notice of Plaintiffs’ rights, and even *after* service of Plaintiffs’ Original Complaint. Some examples of domain names Defendants registered after notice of Plaintiffs’ rights in its famous marks include: neamannmarcus.com, neimanmaracus.com, neimanmarcuse.com, neimanmarcuslastchance.com, neimanmarisu.com, neimanns.com, neimansjewelry.com, nemammarcus.com, nemninmarcus.com, neumanmarcos.com, neumenmarcos.com, newmenmarcus.com, ninemmarcus.com, emanmarcus.com, neimanscatalog.com and niemanstores.com.

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<sup>1</sup> Dotster, Inc. is a registrar of Internet domain names and is accredited by the Internet Corporation for Assigned Names and Numbers (“ICANN”). However, the domain names at issue in this case were registered by Dotster, Inc. or its affiliate company, RegistrarAds, Inc., for Defendants’ own direct use and benefit. Dotster Inc.’s

1 Defendants are serial cybersquatters who, even after notice of their unlawful acts, refuse  
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 3 to yield.<sup>2</sup> Accordingly, an injunction from this Court is the only way to prevent Plaintiffs from  
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 5 suffering irreparable harm as a result of Defendants' further unlawful registrations of confusingly  
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 7 similar domain names to Plaintiffs' Famous Marks.  
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 10 **II. STATEMENT OF FACTS**

11 **A. Plaintiffs' Business and its Famous Marks**

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 13 Over the past century, the Neiman Marcus and Bergdorf Goodman retail businesses have  
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 15 grown into two of the nation's best-known retail stores and each operates a worldwide mail order  
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 17 catalog retail business. For nearly a century, Plaintiffs and their predecessors have worked  
 18  
 19 tirelessly to build and maintain the goodwill associated with Plaintiffs' Famous Marks.  
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 21 (Declaration of Nelson A. Bangs ("Bangs Decl.") at ¶¶4, 21).  
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 25 Hundreds of thousands of consumers hold Neiman Marcus charge accounts and sales  
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 27 revenues from the Neiman Marcus stores, catalogs, and its interactive e-commerce website  
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 29 totaled in the billions of dollars in the past fiscal year. (Bangs Decl. at ¶¶7-8). Sales revenues  
 30  
 31 from the Bergdorf Goodman stores, catalogs, and its interactive e-commerce website totaled in  
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 33 the hundreds of millions of dollars in the past fiscal year. (Bangs Decl. at ¶24). Neiman Marcus,  
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 35 in 1999, and Bergdorf Goodman, in 2001, expanded their retailing strategy by launching e-  
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 37 commerce websites at [www.neimanmarcus.com](http://www.neimanmarcus.com) and [www.bergdorfgoodman.com](http://www.bergdorfgoodman.com), respectively.  
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45 role as an ICANN registrar is not at issue in this case, except that Dotster, Inc. has used this position of trust to  
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 47 conceal its unlawful activities.

48  
 49 <sup>2</sup> Similarly, Defendants continue to cybersquat on numerous other famous trademarks even **after** notice of  
 50  
 51 these other famous marks. Examples include: [aberconbiandfict.com](http://aberconbiandfict.com), [ballyhealthspa.com](http://ballyhealthspa.com), [disneychammle.com](http://disneychammle.com),  
[expediance.com](http://expediance.com), [google-satellite.com](http://google-satellite.com), [jcp-photo.com](http://jcp-photo.com), [marriotcourtyard.com](http://marriotcourtyard.com), [playboymanshen.com](http://playboymanshen.com),  
[randmcannly.com](http://randmcannly.com), [searsphotography.com](http://searsphotography.com), [toyotaofnorthampton.com](http://toyotaofnorthampton.com), and [unitediar.com](http://unitediar.com), to list just a few.

1 (Bangs Decl. at ¶¶9, 26). A substantial portion of Neiman Marcus's and Bergdorf Goodman's  
2 sales are conducted on these websites. (Bangs Decl. at ¶¶10, 27).

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5 Plaintiff NM Nevada Trust owns the Neiman Marcus trade name, and the NEIMAN-  
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Plaintiff NM Nevada Trust also owns the Bergdorf Goodman trade name, and the BERGDORF  
GOODMAN trade and service marks (collectively, the "Bergdorf Goodman Marks"), which it  
licenses to Plaintiff Bergdorf Goodman, Inc. (Bangs Decl. at ¶¶19-20).

The Neiman Marcus Marks and the Bergdorf Goodman Marks are highly distinctive and  
valid marks. (Bangs Decl. at ¶¶2, 19). Plaintiffs own numerous United States trademark  
registrations for the Neiman Marcus Marks and for the Bergdorf Goodman Marks. (Bangs Decl.  
at ¶¶2, 19). A table summarizing these registrations and copies of the Registration Certificates  
for each mark is attached as Exhibits 1 and 2 to the Bangs Declaration. Many of these  
registrations are incontestable under the provisions of 15 U.S.C. section 1065. (Bangs Decl. at  
¶¶2, 19).

Plaintiffs diligently police and vigorously protect their rights in the Neiman Marcus  
Marks and Bergdorf Goodman Marks, and strictly control any use by licensees of these marks.  
(Bangs Decl. at ¶¶17, 33).

#### **B. Defendants Unlawful Cybersquatting Operations**

Defendants operate a massive cybersquatting operation and have registered and use  
hundreds of thousands of domain names. (Declaration of Benjamin Edelman ("Edelman Decl.")  
at ¶¶21, 32). Many of these domain names are confusingly similar to famous or distinctive  
trademarks owned by others, including Plaintiffs' Famous Marks. (Declaration of David Steele

1 (“Steele Decl.”) at ¶4, Ex. 2). In fact, Defendants’ portfolio of domain names is so infested with  
2 domain names, which infringe famous trademarks that the representative list filed in support of  
3 Plaintiffs’ Original Complaint was ten pages long—and this representative list only included the  
4 infringing domain names for one famous mark for each letter of the alphabet (i.e., Abercrombie  
5 and Fitch, Bally’s Total Fitness, Cingular Wireless, Disney, Expedia, etc.). (Steele Decl. at ¶4,  
6 Ex. 2). This representative list contains nearly one thousand domain names. (Steele Decl. at ¶4,  
7 Ex. 2).  
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9  
10 Defendants use these domain names, which are confusingly similar to famous marks, to  
11 lure Internet users searching for those famous or distinctive trademarks. Defendants host  
12 websites at each domain name that (1) display links featuring goods or services directly  
13 competitive with those sold or provided in connection with the famous or distinctive trademarks,  
14 and (2) display pop-up advertisements. (Steele Decl. at ¶5, Ex. 3-4); (Edleman Decl. at ¶34, Ex.  
15 5-6). Defendants receive payment from advertisers, search engines, and affiliate programs each  
16 time an advertisement is displayed or a link is clicked. (Edleman Decl. at ¶26).  
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18  
19 Defendants use and operate an automated process in order to identify available domain  
20 names that Defendants believe will be profitable because of anticipated Internet traffic. As a  
21 result of this automated process, Defendants register thousands of domain names each day, many  
22 of which are confusingly similar to famous marks because they involve misspellings or mis-  
23 typings of famous marks. Defendants are unable or unwilling to operate their automated process  
24 such that famous marks are not being infringed.  
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27 At the time the Original Complaint was filed on May 30, 2006, each domain name  
28 featured a link that read “Offer to Buy This Domain.” (Steele Decl. at ¶5, Ex. 3; Edleman Decl.  
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1 at ¶24, Ex. 5). Defendants also sold domain names to Plaintiffs' investigator, among them,  
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3 bergmangoodman.com. (Steele Decl. at ¶6, Ex. 5-6.).  
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5 Defendants also employ a number of devices to hide their unlawful activities and to  
6 conceal their true identities. Defendants failed to list any contact information in the whois data<sup>3</sup>  
7  
8 for many of the domain names they registered and used, and do not list the name of the registrant  
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10 for any of the domain names they have registered. (Steele Decl. at ¶3, Ex. 1). An analysis of a  
11  
12 representative sample of domain names owned by Defendants found that not a single one had  
13  
14 any whois data. (Edleman Decl. at ¶23). Defendants used a non-identifying email service  
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16 provider, gmail.com, to hide any association with Dotster. (Steele Decl. at ¶5). Defendants also  
17  
18 held themselves out as "Revenue Direct" and used the email address  
19  
20 domains@revenuedirect.com to hide any association with Dotster. (Steele Decl. at ¶6, Ex. 6).  
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22 Defendants requested that checks for sales of domain names be made payable to "DOMAIN  
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24 REGISTRATION." (Steele Decl. at ¶7, Ex. 5). In addition, Defendants' legal counsel made  
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26 materially misleading statements to Plaintiffs' counsel that Dotster was not the registrant of the  
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28 domain names and that Dotster did not know the identity of the registrant. (Steele Decl. at ¶10,  
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30 Ex. 10).  
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43 <sup>3</sup> Whois data provides, among other information, the full name of the registrant of the domain name and  
44 the registrant's contact information. Defendants are required to provide accurate and reliable contact details,  
45 including the full name of the registrant, in the whois data. *See* Registrar's Accreditation Agreement, paragraph  
46 3.7.7.1, attached as Exhibit 14 to the Steele Decl. *See also*, 15 USC §1117(e) (providing a rebuttable presumption  
47 that a Lanham Act violation is willful if the violator knowingly provided or knowingly caused to be provided  
48 materially false contact information to a domain name registrar); 15 USC §1125(d)(1)(B)(i)(VII) (one factor in  
49 determining bad faith cybersquatting is the registrant's "provision of material and misleading false contact  
50 information when applying for the registration of the domain name, the person's intentional failure to maintain  
51 accurate contact information, or the person's prior conduct indicating a pattern of such conduct").

**C. Defendants Continued Unlawful Cybersquatting Operations After Notice**

On January 21, 2006, Defendants’ counsel was advised of Plaintiffs’ rights in its famous Neiman Marcus Marks and that Defendants’ registration of neimanmarqus.com infringed Plaintiffs’ rights. (Steele Decl. at ¶8, Ex. 8). On January 22, 2006, Defendants’ counsel acknowledged Plaintiffs’ rights and agreed to delete or transfer the neimanmarqus.com domain name to Plaintiffs.<sup>4</sup> (Steele Decl. at ¶9, Ex. 9). Yet, even after this notice, Defendants did not stop their cybersquatting behavior. Instead, after January 22, 2006, Defendants registered or renewed at least<sup>5</sup> the following domain names which are confusingly similar to the Neiman Marcus Marks:<sup>6</sup>

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|----------------------------|------------------|
| neamannmarcus.com          | nemammarcus.com  |
| neimanmaracus.com          | nemninnarcus.com |
| neimanmarcuse.com          | neumanmarcos.com |
| neimanmarcuslastchance.com | neumenmarcos.com |
| neimanmarisu.com           | newmenmarcus.com |
| neimanns.com               | ninemmarcus.com  |
| neimansjewelry.com         | emanmarcus.com   |

(Steele Decl. at ¶11, Ex. 1)

Even after being served with the Original Complaint on June 1, 2006, Defendants’ cybersquatting activities continued unabated. For example, on October, 13, 2006, more than four

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<sup>4</sup> Defendants admitted in their Original Answer that this email correspondence provided notice of the Neiman Marcus Marks to them. (Original Answer, ¶ 69).

<sup>5</sup> Plaintiffs have had to utilize experts and forensic tools to unearth Defendants’ unlawful cybersquatting because of Defendants efforts to hide the scope of their operation and their true identities. (Edelman Decl. at ¶24). Accordingly, Plaintiffs expect that an accurate count of infringing domain names, and the full measure of Defendants’ unlawful activities will remain unknown until after discovery.

<sup>6</sup> Prior to Plaintiffs’ January 22, 2006 notice, Defendants already had registered at least the following domain names that are confusingly similar to the Neiman Marcus Marks: neimanmarqus.com; nehmanmarcus.com; neimanmarcurs.com; neimenmarus.com; neimumarcus.com; nelmanmarcus.com; nemimarcus.com; and miumanmarcus.com. Defendants also registered the following domain names that are confusingly similar to the Bergdorf Goodman Marks: bergdorfgoddman.com; begrdorfgoodmon.com; bergdorfgoogman.com; bergerdorfgoodman.com; bergmangoodman.com; and borgdorfgoodman.com.

1 months after they were served with the Original Complaint, Defendants registered  
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3 neimanscatalog.com and niemanstores.com, which are confusingly similar domain names to the  
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5 Neiman Marcus Marks. (Steele Decl. at ¶12, Ex. 1 at p. 11-12).  
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8 In addition, even though the Original Complaint identified numerous other famous marks  
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10 on which Defendants were cybersquatting, Defendants, after June 1, 2006, continued registering,  
11  
12 renewing and using domain names that are confusingly similar to those famous marks, including:  
13

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| 14 | aberconbiandfith.com               | expedee.com                    |
| 15 | abercrumbieandfinch.com            | expediance.com                 |
| 16 | ballyhealthspa.com                 | google-satellite.com           |
| 17 | ballynutrient.com                  | googlesexoffender.com          |
| 18 | disneyblockoutdates.com            | googletrace.com                |
| 19 | disneycampground.com               | jcp-photo.com                  |
| 20 | disneychammle.com                  | marriop.com                    |
| 21 | disneychanelchanel.com             | marriotcourtyard.com           |
| 22 | disneychanelsohotsummer.com        | neimanscatalog.com             |
| 23 | disneychannelauditions.com         | niemanstores.com               |
| 24 | disneychannelauditions.com         | playboymanshen.com             |
| 25 | disneychannelathersday.com         | randmcannly.com                |
| 26 | disneychannelhotsummer.com         | searsesential.com              |
| 27 | disneychannelnel.com               | searsphot.com                  |
| 28 | disneychannelsohotsummer.com       | searsphotography.com           |
| 29 | disneychannelsohotsummer.com       | searspicturestudio.com         |
| 30 | disneychannelsohotsummer.com       | searsscratchanddent.com        |
| 31 | disneychannelsohotsummer.com       | toyotaofnorthampton.com        |
| 32 | disneyfireworks.com                | toyotarentals.com              |
| 33 | disneylandcaliforniaadventures.com | toyotasoutheast.com            |
| 34 | disneylandcruises.com              | unitediar.com                  |
| 35 | disneylandland.com                 | walmartdistributioncenters.com |
| 36 | disneylandcollection.com           | walmartexpress.com             |
| 37 | disneyprincess.com                 | xmdelphi.com                   |
| 38 | disneysgrandcaliforniahotel.com    | xmsatliteradio.com             |
| 39 | disneysohotsummer.com              |                                |
| 40 | disneyworldcampgrounds.com         |                                |

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44 (Steele Decl. at ¶13, Ex. 11).

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46 Any claims that Defendants have ceased their unlawful cybersquatting activity are simply  
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48 not supported by the facts. Some of the domain names listed above were registered or renewed  
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50 by Defendants within the past few weeks. Specifically:  
51



- 1 • aberconbiandfict.com which was registered on 05-Oct-2006;
- 2 • abercrumbeandfinch.com which was renewed on 18-Oct-2006;
- 3 • ballyhealthspa.com which was renewed on 22-Oct-2006;
- 4 • ballynutrient.com which was renewed on 01-Nov-2006;
- 5 • jcp-photo.com which was registered on 31-Oct-2006;
- 6 • marriop.com which was registered on 19-Oct-2006;
- 7 • playboymanshen.com which was renewed on 28-Oct-2006;
- 8 • searsphot.com which was renewed on 28-Oct-2006;
- 9 • toyotasoutheast.com which was renewed on 13-Oct-2006;
- 10 • unitediar.com which was renewed on 18-Oct-2006; and
- 11 • xmsatliteradio.com which was renewed on 13-Oct-2006.

12 (Steele Decl. at ¶13, Ex. 11).

13  
14 Finally, even after being served with the Original Complaint, Defendants continued their  
15 failure to list any contact information in the whois data for many of the domain names they have  
16 registered. Some examples of domain names with no contact information include:

17 abercronbiandfict.com, disneychammle.com, google-satellite.com, marriotcourtyard.com,  
18 toyotaofnorthampton.com, and walmartdistributioncenters.com. (Steele Decl. at 14, Ex.12). For  
19 the domain names that do contain contact information, the information is inaccurate and  
20 misleading. Instead of listing themselves as the actual registrant of the domain names,  
21 Defendants hide their identity by identifying the registrant as “c/o the domain name.” For  
22 example, the whois data for the domain name ballyhealthspa.com lists the registrant as “c/o  
23 ballyhealthspa.com.” (Steele Decl. at 15, Ex. 13).

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37 **III. PLAINTIFFS ARE ENTITLED TO A PRELIMINARY INJUNCTION**

38 **A. Standard For Granting Injunctive Relief**

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40 Plaintiffs are entitled to preliminary injunctive relief because Plaintiffs are likely to  
41 succeed on the merits of their claim that Defendants have violated the Anticybersquatting  
42 Consumer Protection Act, 15 U.S.C § 1125(d) (the “ACPA”). In addition, Plaintiffs are entitled  
43 to preliminary injunctive relief because Plaintiffs face irreparable harm if Defendants are  
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1 permitted to continue registering confusingly similar domain names to Plaintiffs' Famous Marks.  
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 3 *See Senate of State of California v. Mosbacher*, 968 F.2d 974, 977 (9th Cir. 1992) (citations  
 4 omitted) (a plaintiff seeking preliminary injunctive relief must prove either: "(1) a combination  
 5 of probable success on the merits and the possibility of irreparable harm, or (2) the existence of  
 6 serious questions going to the merits, the balance of hardships tipping sharply in [plaintiff's]  
 7 favor, and at least a fair chance of success on the merits"). The alternative standards represent a  
 8 sliding scale under which "a lesser showing of probability of success requires a greater showing  
 9 of harm, and vice versa." *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., Inc.*, 900  
 10 F. Supp. 1287, 1292 (C.D. Cal. 1995) (citation omitted).

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 22 **B. Plaintiffs Are Likely To Succeed On The Merits Of Their Claim Against**  
 23 **Defendants For Cybersquatting**

24 Pursuant to the ACPA, cybersquatting involves the (1) registration, use, or trafficking in,  
 25 a domain name (2) that is identical or confusingly similar to a distinctive or famous trademark,  
 26 (3) with a bad faith intent to profit from the mark. *See* 15 U.S.C § 1125(d). As will be shown  
 27 below, Defendants have violated the ACPA and must be enjoined from continuing  
 28 cybersquatting.

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 37 **1. Defendants' Registration, Use, And Trafficking In Domain Names**

38 Defendants have registered at least 34 domain names which are confusingly similar to  
 39 Plaintiffs' Famous Marks. (Steele Decl. at ¶2, Ex. 1). *See also* Answer to Original Complaint,  
 40 ¶ 70 ("It is admitted that Dotster registered the domain names identified in Paragraph 70 for an  
 41 affiliate, which was the registrant"). Dotster identified the affiliate as defendant RegistrarAds,  
 42 Inc. (Steele Decl. at ¶16).

1 Defendants also used these confusingly similar domain names to host websites that  
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 3 displayed links featuring goods or services that are directly competitive with Plaintiffs' goods  
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 5 and displayed pop-up advertisements. (Steele Decl. at ¶5, Ex. 3-4; Edleman Decl. at ¶34, Ex. 5-  
 6  
 7 6). *See also* Answer to Original Complaint, ¶90 (admitting that "a Dotster affiliate *used* certain  
 8  
 9 of the domain names identified in paragraph 70 of the Complaint") (emphasis added).  
 10  
 11 Programming code used within the displayed advertisements, "client=ca dp dotster," identifies  
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 13 Dotster as the client to the advertisers, search engines, or affiliate programs. (Edelman Decl. at  
 14  
 15 ¶26).  
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18  
 19 In addition, Defendants trafficked in these confusingly similar domain names by selling  
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 21 or offering to sell these confusingly similar domain names. (Steele Decl. at ¶6, Ex. 5-6). Emails  
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 23 regarding the purchase of the domain names were sent to, received by, and responded to by  
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 25 Dotster employee and Defendant Scott Fish. (Steele Decl. at ¶6, Ex. 5-6). Dotster employees  
 26  
 27 offered to sell the domain names. (Steele Decl. at ¶6, Ex. 5-6). Dotster employees instructed that  
 28  
 29 payments be sent to Dotster's paypal account, and to Dotster's office to the attention of the  
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 31 Dotster employees. (Steele Decl. at ¶7, Ex. 5-6). Finally, checks for the purchase of domain  
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 33 names were stamped with Dotster's company banking stamp (complete with Dotster's bank  
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 35 account number) and deposited into Dotster's account. (Steele Decl. at ¶7, Ex. 7).  
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40 **2. The Infringing Domain Names are Confusingly Similar to Plaintiffs'**  
 41 **Distinctive and Famous Marks**  
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43 **a) Plaintiffs' Famous Marks are distinctive and famous.**  
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45 The Neiman Marcus Marks and Bergdorf Goodman Marks are very distinctive trade and  
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 47 services marks. (Bangs Decl. at ¶¶2, 19). Both marks continuously have been used in interstate  
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 49 commerce for almost a century to designate Plaintiffs' goods and services. Plaintiffs own  
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1 numerous United States trademark registrations for the Neiman Marcus Marks and for the  
2  
3 Bergdorf Goodman Marks. (Bangs Decl. at ¶¶16, 32, Ex. 1-2). Many of these registrations are  
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5 incontestable under the provisions of 15 U.S.C. § 1065. (Bangs Decl. at ¶¶2, 19).  
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8 The Neiman Marcus Marks and the Bergdorf Goodman Marks are also famous marks.  
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10 The newly enacted dilution statutes provides, “a mark is famous if it is widely recognized by the  
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12 general consuming public of the United States as a designation of source of the goods or services  
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14 of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). In determining whether a mark possesses the  
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16 requisite degree of recognition, courts may consider all relevant factors, including: (1) the  
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18 duration, extent, and geographic reach of advertising and publicity of the mark; (2) the amount,  
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20 volume, and geographic extent of sales of goods or services offered under the mark; (3) the  
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22 extent of actual recognition of the mark; and (4) whether the mark was registered. *Id.*  
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26 Not only are most of the registrations of Plaintiffs’ Famous Marks incontestable, but  
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28 Plaintiffs operate two of the nation’s best-known retail stores in the country. *See Yarmuth-Dion,*  
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30 *Inc., et al. v. D’ion Furs, Inc.*, 835 F.2d 990, 991 (2nd Cir. 1987) (referring to Bergdorf  
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32 Goodman and Neiman Marcus as “the country’s best known department stores”). These stores  
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34 have been in operation for almost a century. Neiman Marcus operates thirty-six stores located in  
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36 premier retail locations in major markets nationwide, while Bergdorf Goodman operates its  
37  
38 world famous main retail store in Manhattan, New York. (Bangs Decl. at ¶¶6, 21). In addition,  
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40 Plaintiffs operate a nationwide mail order catalog retail business under both marks. (Bangs Decl.  
41  
42 at ¶¶5, 22).  
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47 Neiman Marcus, in 1999, and Bergdorf Goodman, in 2001, expanded their retailing  
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49 strategy by launching e-commerce websites at [www.neimanmarcus.com](http://www.neimanmarcus.com) and  
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1 www.bergdorfgoodman.com, respectively. (Bangs Decl. at ¶¶9, 26). Plaintiffs’ Famous Marks  
 2  
 3 are also promoted by Plaintiffs with extensive advertising in the print, radio and television  
 4  
 5 markets. (Bangs Decl. at ¶¶15, 31). Hundreds of thousands of consumers hold Neiman Marcus  
 6  
 7 charge accounts and sales revenues for Neiman Marcus and Bergdorf Goodman stores and  
 8  
 9 catalogs totaled in the billions of dollars and hundreds of millions of dollars, respectively, during  
 10  
 11 the past year. (Bangs Decl. at ¶¶8, 24).  
 12

13  
 14  
 15 **b) Defendants have registered at least 34 domain names that are**  
 16 **confusingly similar to Plaintiffs’ Famous Marks.**  
 17

18 Defendants have registered at least 34 domain names each of which is confusingly  
 19  
 20 similar to Plaintiffs’ Famous Marks. These confusingly similar domain names are:  
 21

- |                                   |                        |
|-----------------------------------|------------------------|
| 22 1. bergdorfgoddman.com         | 18. neimanns.com       |
| 23 2. bergdorfgoodmon.com         | 19. neimanscatalog.com |
| 24 3. bergdorfgoogman.com         | 20. neimansjewelry.com |
| 25 4. bergerdorfgoodman.com       | 21. neimenmarus.com    |
| 26 5. bergmangoodman.com          | 22. neimumarcus.com    |
| 27 6. borgdorfgoodman.com         | 23. nelmanmarcus.com   |
| 28 7. emanmarcus.com              | 24. nemammarcus.com    |
| 29 8. marcusneimen.com            | 25. nemimarcus.com     |
| 30 9. neamannmarcus.com           | 26. neminnmarcus.com   |
| 31 10. nehmanmarcus.com           | 27. nemninmarcus.com   |
| 32 11. nehminmarcus.com           | 28. neumanmarcos.com   |
| 33 12. neimanmaracus.com          | 29. neumenmarcus.com   |
| 34 13. neimanmarcurs.com          | 30. newmenmarcus.com   |
| 35 14. neimanmarcuse.com          | 31. nhminmarcus.com    |
| 36 15. neimanmarcuslastchance.com | 32. niemanstores.com   |
| 37 16. neimanmarisu.com           | 33. ninemmarcus.com    |
| 38 17. neimanmarqus.com           | 34. niumanmarcus.com   |

39 Each domain name is confusingly similar to Plaintiffs’ Famous Marks because it contains  
 40  
 41 misspellings of Plaintiffs’ Famous Marks intended to catch an Internet user who makes a slight  
 42  
 43 spelling or typing error. For example, bergdorfgoddman.com merely replaced the letter “o” in the  
 44  
 45 “goodman” portion of the mark with the letter “d.” “A reasonable interpretation of conduct  
 46  
 47 covered by the phrase ‘confusingly similar’ is the intentional registration of domain names that  
 48  
 49 are misspellings of distinctive or famous names, causing an Internet user who makes a slight  
 50  
 51

1 spelling or typing error to reach an unintended site.” *Shields v. Zuccarini*, 254 F.3d 476, 484 (3rd  
2  
3 Cir. 2001). *See also N. Light Tech., Inc. v. N. Lights Club*, 236 F.3d 57, 66 n.14 (1st Cir. 2001)  
4  
5 (the identical or confusingly similar requirement of ACPA looks to the facial similarity of the  
6  
7 domain name with the mark).  
8

9  
10 Some of the infringing domain names merely append a generic word associated with  
11  
12 Plaintiffs’ Famous Marks to the mark or a portion of the mark. For example, the  
13  
14 neimanscatalog.com domain name merely appends the word “catalog” to the distinctive  
15  
16 “neimans” portion of the Neiman Marcus Marks.<sup>7</sup> Domain names which merely append a generic  
17  
18 word to a distinctive or famous mark are also confusingly similar to the mark upon which they  
19  
20 prey. Senator Hatch, in support of the passage of the ACPA, cited “attphonecard.com” and  
21  
22 “attcallingcard.com” as examples of confusingly similar domain names the bill would protect  
23  
24 against. 145 Cong. Rec. S10513, S10515 (daily ed. August 5, 1999) (statement of Sen. Hatch).  
25  
26

27  
28 Defendants host websites on many of these 34 infringing domain names, which display  
29  
30 links to goods and services that are directly competitive to Plaintiffs’ goods and services. (Steele  
31  
32 Decl. at ¶5, Ex. 3-4) Defendants’ efforts to capitalize of the misspellings or mis-typings of  
33  
34 Internet users looking for Plaintiffs’ websites at neimanmarcus.com and bergdorfgoodman.com  
35  
36 is further evidence that each of the domain names is confusingly similar to the Neiman Marcus  
37  
38 Marks or Bergdorf Goodman Marks.  
39  
40

### 41 42 **3. Defendants’ Bad Faith Intent To Profit From The Marks**

43  
44 In determining whether Defendants possessed the required bad faith intent to profit from  
45  
46 the marks, the ACPA identifies nine separate factors for the courts to examine. 15 U.S.C. §  
47  
48  
49  
50  
51

1 1125(d)(1)(B)(i). Each of the nine factors supports or strongly supports a finding that  
2  
3 Defendants' registration and use of the 34 confusingly similar domain names were with a bad  
4  
5 faith intent to profit from Plaintiffs' Famous Marks.  
6

7  
8 **a) The trademark or other intellectual property rights of the**  
9 **person, if any, in the domain name (15 U.S.C. §**  
10 **1125(d)(1)(B)(i)(I))**  
11

12 Defendants have no intellectual property rights in any of the 34 confusingly similar  
13 domain names that they registered, used and/or trafficked in. Nor have Plaintiffs authorized  
14 Defendants to use Plaintiffs' Famous Marks. (Bangs Decl. at ¶¶18, 34). As such, the first bad  
15 faith intent factor under the ACPA supports a finding that Defendants registered the confusingly  
16  
17 similar domain names with a bad faith intent to profit.  
18  
19  
20  
21  
22

23  
24 **b) The extent to which the domain name consists of the legal name**  
25 **of the person or a name that is otherwise commonly used to**  
26 **identify that person (15 U.S.C. § 1125(d)(1)(B)(i)(II))**  
27

28 Similarly, none of the 34 confusingly similar domain names consists of the legal name of  
29  
30 any Defendant. Nor is any Defendant commonly known by any of these 34 confusingly similar  
31 domain names. Defendants admit this in their Answer to the Original Complaint. *See Answer to*  
32  
33 Original Complaint, ¶¶ 97, 122. Therefore, the second bad faith intent factor under the ACPA  
34  
35 supports a finding that Defendants registered the confusingly similar domain names with a bad  
36  
37 faith intent to profit.  
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<sup>7</sup> Neiman Marcus is widely known for publishing a catalog. (Bangs Decl. at ¶5).

1                                    **c) The person's prior use, if any, of the domain name in connection**  
 2                                    **with the bona fide offering of any goods or services (15 U.S.C. §**  
 3                                    **1125(d)(1)(B)(i)(III))**  
 4

5                                    The third bad faith factor under the ACPA asks the Court to analyze whether Defendants'  
 6 prior use of the 34 confusingly similar domain names was in connection with a *bona fide*  
 7 offering of any goods or services. Defendants, however, used the 34 confusingly similar domain  
 8 names to lure Internet users trying to reach Plaintiffs' websites at neimanmarcus.com and  
 9 bergdorfgoodman.com to a website, which featured advertising and links to goods or services  
 10 directly competitive with Plaintiffs' goods and services, and which displays pop-up  
 11 advertisements. It is well settled that misdirecting Internet traffic by using another party's mark  
 12 is unlawful. *Brookfield Communs., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1059 (9th Cir.  
 13 1999). Because this unlawful use cannot be a *bona fide* offering of goods or services, the third  
 14 bad faith intent factor supports a finding of Defendants' bad faith intent to profit.  
 15  
 16  
 17  
 18  
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 27

28                                    **d) The person's bona fide noncommercial or fair use of the mark in**  
 29                                    **a site accessible under the domain name (15 U.S.C. §**  
 30                                    **1125(d)(1)(B)(i)(IV))**  
 31

32                                    Defendants' use of the 34 confusingly similar domain names was purely commercial.  
 33 Defendants selected the domain names that would generate revenue from advertisers, search  
 34 engines, and affiliate programs, and engineered their systems to maximize Defendants' returns.  
 35 Because none of the websites contained any commentary about, or comparisons of, Plaintiffs  
 36 goods or services, Defendants' use was not a *bona fide* noncommercial or fair use. Further,  
 37 because Defendants' use of each of the domain names is purely commercial, it cannot be a  
 38 noncommercial use. Therefore, the fourth bad faith factor supports a finding that Defendants  
 39 registered the confusingly similar domain names with a bad faith intent to profit.  
 40  
 41  
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 51

**e) The person's intent to divert consumers from the mark owner's**



1 **online location to a site accessible under the domain name that**  
2 **could harm the goodwill represented by the mark, either for**  
3 **commercial gain or with the intent to tarnish or disparage the**  
4 **mark, by creating a likelihood of confusion as to the source,**  
5 **sponsorship, affiliation, or endorsement of the site (15 U.S.C. §**  
6 **1125(d)(1)(B)(i)(V))**  
7

8  
9 In view of the similarity between the 34 confusingly similar domain names and Plaintiffs'  
10 Famous Marks, it is obvious that Defendants' intent was to divert consumers searching for  
11 Plaintiffs' neimanmarcus.com and bergdorfgoodman.com websites. "Cybersquatters often  
12 register well-known marks to prey on consumer confusion by misusing the domain name to  
13 divert customers from the mark owner's site to the cybersquatter's own site, many of which are  
14 pornography sites that derive advertising revenue based on the number of visits, or 'hits,' the site  
15 receives." *Shields v. Zuccarini*, 254 F.3d 476, 484 (3rd Cir. 2001). Although Defendants' sites  
16 did not involve pornography, their intent was the same as the defendant in *Zuccarini*: "to register  
17 a domain name in anticipation that consumers would make a mistake, thereby increasing the  
18 number of hits his site would receive, and consequently, the number of advertising dollars he  
19 would gain." *Id.*  
20  
21  
22  
23  
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32

33  
34 The only reason that consumers would access the websites at any of the 34 confusingly  
35 similar domain names is because these domain names are misspellings or mis-typings of  
36 Plaintiffs' Famous Marks. Defendants thus intended to create a likelihood of confusion in order  
37 to capitalize, for their own commercial gain, on the mistakes of consumers looking for Plaintiffs'  
38 websites. Defendants' desire to profit from the misspellings or mis-typings of consumers seeking  
39 Plaintiffs' famous marks is further evidenced by the fact that websites at each of these  
40 confusingly similar domain names featured links to goods and services directly competitive to  
41 Plaintiffs' goods and services. (Steele Decl. at ¶5, Ex. 3-4).  
42  
43  
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51

1 In addition, Plaintiffs are harmed by the likelihood that consumers will mistakenly access  
2  
3 Defendants' 34 confusingly similar domain names. "Prospective users of plaintiff's services who  
4  
5 mistakenly access defendant's web site may fail to continue to search for plaintiff's own home  
6  
7 page . . . ." *Panavision International, L.P. v. Toeppen, et al.*, 141 F.3d 1316, 1327 (9th Cir. 1998)  
8  
9 (citations omitted).  
10

11  
12 Finally, Defendants intended to divert consumers from Plaintiffs' websites to their own  
13  
14 websites because they continued to register and use confusingly similar domain names **even**  
15  
16 **after explicit notice** of Plaintiffs' rights in their famous mark, and after Plaintiffs filed and  
17  
18 served its Original Complaint. *See Fitzgerald Pub. Co., Inc. v. Baylor Pub. Co., Inc.*, 807 F.2d  
19  
20 1110, 1115 (2nd Cir. 1986) (actual or constructive knowledge on infringing acts proves  
21  
22 willfulness); *Louis Vuitton Malletier & Oakley, Inc. v. Veit*, 211 F. Supp. 2d 567, 583 (E.D. Pa.  
23  
24 2002) ("Willfulness can be inferred by the fact that a defendant continued infringing behavior  
25  
26 after being given notice"). Specifically, in January 2006, Defendants explicitly knew that it  
27  
28 improperly registered *neimanmarcus.com* and that Plaintiffs' owned the famous Neiman Marcus  
29  
30 mark. Yet, despite this explicit knowledge, Defendants registered at least fourteen additional  
31  
32 confusingly similar domain names. Further, even after Defendants were served with the Original  
33  
34 Complaint on June 1, 2006, Defendants continued cybersquatting on Plaintiffs' Famous Marks,  
35  
36 registering *neimanscatalog.com* and *niemanstores.com* on October, 13, 2006.<sup>8</sup>  
37  
38  
39  
40  
41  
42  
43

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44  
45 <sup>8</sup> It defies logic to believe that Defendants did not know what they were doing. Defendants used an  
46  
47 automated process to identify domain names and only kept those domain names that had sufficient traffic to ensure  
48  
49 that Defendants would make a profit on those domain names. *See Answer to Original Complaint*, ¶ 33 (admitting  
50  
51 that many domain names were deleted because of lack of traffic). In employing this automated process, Defendants  
knew or should have known that many of the domain names it registered were receiving traffic solely because they  
were misspellings or mis-typings of famous or distinctive marks. Despite this knowledge, Defendants continued  
using its automated process and continued to register confusingly similar domain names.

1 Accordingly, this fifth bad faith factor strongly supports that Defendants willfully  
2  
3 registered the confusingly similar domain names with a bad faith intent to profit from Plaintiffs'  
4  
5 Famous Marks.  
6

- 7  
8 **f) The person's offer to transfer, sell, or otherwise assign the**  
9 **domain name to the mark owner or any third party for financial**  
10 **gain without having used, or having an intent to use, the domain**  
11 **name in the bona fide offering of any goods or services, or the**  
12 **person's prior conduct indicating a pattern of such conduct**  
13 **(15 U.S.C. § 1125(d)(1)(B)(i)(VI))**  
14

15  
16 At the time the Original Complaint was filed, each confusingly similar domain name  
17  
18 registered by the Defendants featured a link that read "Offer to Buy This Domain." (Edleman  
19  
20 Decl. at ¶24, Ex. 5; Steele Decl. at ¶5, Ex.). Defendants, in fact, did sell bergmangoodman.com  
21  
22 to Plaintiffs' investigator for \$800. (Steele Decl. at ¶6, Ex. 6). Because Defendants not only offer  
23  
24 to sell, but also do sell confusingly similar domain names for financial gain, the sixth bad faith  
25  
26 factor strongly supports a finding that Defendants registered the 34 confusingly similar domain  
27  
28 names with a bad faith intent to profit.  
29  
30

- 31  
32 **g) The person's provision of material and misleading false contact**  
33 **information when applying for the registration of the domain**  
34 **name, the person's intentional failure to maintain accurate**  
35 **contact information, or the person's prior conduct indicating a**  
36 **pattern of such conduct (15 U.S.C. § 1125(d)(1)(B)(i)(VII))**  
37

38  
39 Dotster, as an accredited ICANN registrar, is contractually required to provide  
40  
41 information to the public as to the name, postal and email address, and telephone and fax number  
42  
43 of the registrant for each domain name registered by Dotster. *See* Registrar Accreditation  
44  
45 Agreement, sections 3.3.1.6 and 3.3.1.7, (May 17, 2001), attached as Exhibit 14 to the Steele  
46  
47 Decl. (and available at <<http://www.icann.org/registrars/ra-agreement-17may01.htm>>). This  
48  
49  
50  
51

1 whois data is to be freely provided to the public via Dotster's whois server and updated daily. *Id.*,  
2  
3 Section 3.3.1.  
4

5 Yet when Defendants registered the 34 confusingly similar domain names with Dotster,  
6  
7 this contact information was either non-existent or inaccurate. For example, when Defendants  
8  
9 registered neimanmarqus.com no whois data was provided which identified the registrant of that  
10  
11 domain name. (Steele Decl. at ¶8, Ex. 8). Defendants continue not to provide any whois data for  
12  
13 some of their domain names. (Steele Decl. at ¶14, Ex. 12). For other domain names, Defendants  
14  
15 fail to maintain accurate contact information, listing "c/o the domain name" rather than listing  
16  
17 the true and correct legal name of the registrant. (Steele Decl. at ¶13, Ex. 13). In addition,  
18  
19 Defendants' legal counsel made materially misleading statements to Plaintiffs' counsel that  
20  
21 Dotster was not the registrant of the domain names and that Dotster did not know the identity of  
22  
23 the registrant. (Steele Decl. at ¶10, Ex. 10).  
24  
25  
26  
27

28 Defendants also have exhibited a pattern of conduct of providing false, misleading or  
29  
30 inaccurate contact information. Prior to the filing of the Original Complaint, a representative  
31  
32 sample of some domain names owned by Defendants found that not a single one had any whois  
33  
34 data. (Edleman Decl. at ¶23).  
35  
36

37 This seventh bad faith factor also strongly supports finding that Defendants registered the  
38  
39 34 confusingly similar domain names with a bad faith intent to profit.  
40  
41  
42  
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50  
51

1                                   **h) The person's registration or acquisition of multiple domain**  
 2                                   **names that the person knows are identical or confusingly similar**  
 3                                   **to marks of others that are distinctive at the time of registration**  
 4                                   **of such domain names, or dilutive of famous marks of others**  
 5                                   **that are famous at the time of registration of such domain**  
 6                                   **names, without regard to the goods or services of the parties**  
 7                                   **(15 U.S.C. § 1125(d)(1)(B)(i)(VIII))**  
 8

9  
 10           The eighth bad faith factor, in short, focuses on the number of infringing domain names a  
 11 defendant has registered. Defendants have engaged in one of the largest cybersquatting  
 12 operations ever witnessed. Defendants have registered and use hundreds of thousands of domain  
 13 names. (Edleman Decl. at ¶¶21-32). Many of these domain names are confusingly similar to  
 14 famous or distinctive trademarks owned by others, including Plaintiffs' Famous Marks.  
 15 Defendants have registered so many domain names that infringe famous trademarks that the  
 16 representative list filed in support of Plaintiffs' Original Complaint was ten pages long. This  
 17 representative list only included the infringing domain names for one famous mark for each letter  
 18 of the alphabet (i.e., Abercrombie and Fitch, Bally's Total Fitness, Cingular Wireless, Disney,  
 19 Expedia, etc.) and contained nearly one thousand domain names that were confusingly similar to  
 20 only twenty six famous marks. (Steele Decl. at ¶4, Ex. 2).  
 21  
 22  
 23  
 24  
 25  
 26  
 27  
 28  
 29  
 30  
 31  
 32

33           It is also significant that, even after being served with the Original Complaint, which  
 34 provided notice to Defendants of the numerous famous trademarks on which Defendants had  
 35 cybersquatted, Defendants were not deterred. Defendants have continued to register or renew  
 36 confusingly similar domain names to the famous domain names listed in the Original Complaint.  
 37 (Steele Decl. at ¶13, Ex. 11).  
 38  
 39  
 40  
 41  
 42  
 43  
 44  
 45

46           This eighth bad faith factor strongly supports a finding that Defendants registered the 34  
 47 confusingly similar domain names with a bad faith intent to profit from Plaintiffs' Famous  
 48 Marks.  
 49  
 50  
 51

1                                    **i) The extent to which the mark incorporated in the person’s**  
2                                    **domain name registration is or is not distinctive and famous**  
3                                    **within the meaning of subsection (c) of section 43 (15 U.S.C. §**  
4                                    **1125(d)(1)(B)(i)(IX))**  
5

6                    The final factor also strongly supports Defendants’ bad faith intent to profit. As discussed  
7  
8 above, as result of nearly a century of use, Plaintiffs have created in the Neiman Marcus Marks  
9 and the Bergdorf Goodman Marks two of the most famous and distinctive marks in the world.  
10

11                                    **j) Additional factors to be considered by the Court**  
12

13                    The nine factors listed by the ACPA, however, are not exclusive, and courts often  
14  
15 consider other factors in addition to those recited. *See Sporty’s Farm L.L.C. v. Sportsman’s Mkt.,*  
16  
17 *Inc.*, 202 F.3d 489, 498 (2nd Cir. 2000) (“But we are not limited to considering just the listed  
18  
19 factors when making our determination of whether the statutory criterion has been met.”). In the  
20  
21 present case, Dotster is in a position of trust as an ICANN accredited registrar. Yet Dotster  
22  
23 abused its position to the detriment of Plaintiffs, other trademark owners, and the general public.  
24  
25 For example, as an ICANN accredited registrar, Dotster was able to conceal its unlawful  
26  
27 activities. *See Answer to Original Complaint*, ¶ 34 (“It is admitted that Dotster, as an ICANN  
28  
29 accredited Registrar, was able to facilitate the registration of domain names without immediately  
30  
31 providing WHOIS contact information.”). Dotster’s abuse of trust further supports, and indeed  
32  
33 amplifies, the bad faith intent of Defendants.  
34  
35  
36  
37  
38  
39

40                    Another additional factor to be considered is Defendants’ use of numerous devices to  
41  
42 hide their unlawful activities and to conceal their true identities. In addition to its failure to  
43  
44 provide whois data, discussed above, Defendants used a non-identifying email service provider,  
45  
46 gmail.com, to hide any association with Dotster. (Steele Decl. at ¶5). Defendants also held  
47  
48 themselves out as “Revenue Direct” and used the email address domains@revenuedirect.com to  
49  
50  
51

1 hide any association with Dotster. (Steele Decl. at ¶6, Ex. 6). Defendants requested that checks  
 2  
 3 for sales of domain names be made payable to “DOMAIN REGISTRATION.” (Steele Decl. at  
 4  
 5 ¶7, Ex. 5). Defendants’ legal counsel made materially misleading statements to Plaintiffs’  
 6  
 7 counsel that Dotster was not the registrant of the domain names and that Dotster did not know  
 8  
 9 the identity of the registrant. (Steele Decl. at ¶10, Ex. 10). These statements were made to hide  
 10  
 11 Dotster’s involvement and to quell any further inquiry.  
 12

#### 13 14 15 **4. Irreparable Harm**

16  
 17 Irreparable harm is presumed where the injury befalls a trademark. *Brookfield Communs.,*  
 18  
 19 *Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1066 (9th Cir.1999) (irreparable harm is  
 20  
 21 generally presumed in a trademark infringement action where likelihood of confusion has been  
 22  
 23 shown). Therefore, as a matter of law, Plaintiffs have suffered the “irreparable harm” that, along  
 24  
 25 with likelihood of success on the merits, entitles it to injunctive relief for Defendants’  
 26  
 27 cybersquatting acts.  
 28  
 29

#### 30 31 **C. The Balance Of Hardships Tips Decidedly In Favor Of Granting Preliminary** 32 **Injunctive Relief**

33  
 34 The Court must also weigh the harm which a preliminary injunction might cause the  
 35  
 36 Defendants and weigh it against the threatened injury to Plaintiffs. *Los Angeles Memorial*  
 37  
 38 *Coliseum Com. v. National Football League*, 634 F.2d 1197, 1203 (9th Cir. 1980). Defendants,  
 39  
 40 even after notice, are continuing to register confusingly similar domain names to Plaintiffs’  
 41  
 42 Famous Marks, as well as other famous or distinctive marks. Defendants’ cybersquatting  
 43  
 44 addiction is unrestrained and fueled by Defendants’ continued use of an automated process to  
 45  
 46 “taste” domain names and then discard those domain names with little or no traffic. Unless a  
 47  
 48  
 49  
 50  
 51

1 broad injunction issues, Defendants will continue to register confusingly similar domain names  
2  
3 and harm Plaintiffs and the public.  
4

5 On the other hand, granting an injunction will only prevent Defendants from profiting  
6  
7 from its illegal behavior, which is not a cognizable “hardship” that this Court should consider.  
8  
9 Moreover, nothing in the injunction would prevent Defendants from registering domain names  
10  
11 without an automated system, so long as accurate whois data is provided. Finally, if the Court  
12  
13 issues an injunction, Plaintiffs may be required to post a bond that will compensate Defendants  
14  
15 for any possible monetary harm it might suffer if the injunction later is deemed improper. *See*  
16  
17 Fed. R. Civ. P. 65(c). The Court should not require a bond in this case because we are simply  
18  
19 asking the Court to enjoin Defendants from further infringing on Plaintiffs' Famous Marks.  
20  
21  
22

23  
24 Therefore, Defendants will suffer no actual harm if the injunction issues, while Plaintiffs  
25  
26 (and the public) will be irreparably injured if it does not. The balance of hardships tips strongly  
27  
28 in Plaintiffs' favor.  
29

30  
31 **IV. CONCLUSION**  
32

33 For all of the above reasons, Plaintiffs respectfully request that the Court preliminarily  
34  
35 enjoin Defendants from:  
36

- 37 1. Registering, using, or trafficking in, any domain name that is identical or  
38  
39 confusingly similar to either the Neiman Marcus Marks or the Bergdorf Goodman Marks;  
40  
41  
42 2. Registering any domain name using an automated process;<sup>9</sup> and  
43  
44  
45  
46

47  
48  
49 <sup>9</sup> Defendants' use of an automated process to identify and register thousands of domain names each day is  
50 uncontrolled and ineffective in preventing the registration of domain names which are confusingly similar to  
51 Plaintiffs' Famous Marks and other famous marks.



1 3. Registering any domain name without listing the full and correct legal name of  
2  
3 the registrant in the whois data.<sup>10</sup>  
4

5 Plaintiffs also respectfully request that the Court waive the bond requirement of Federal  
6  
7 Rule of Civil Procedure 65(c), or at a minimum, set a nominal bond amount.  
8

9  
10 DATED: December 12, 2006  
11

12  
13 Respectfully submitted,  
14

15  
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49 <sup>10</sup> In order to verify whether Defendants are complying with the terms of the injunction, Defendants must  
50 be compelled to accurately identify themselves in the whois data as the registrant anytime Defendants register any  
51 domain name.

**CERTIFICATE OF SERVICE**

On December 12, 2006, I caused to be served upon counsel of record, at the address stated below, via the method of service indicated, a true and correct copy of the following documents:

**PLAINTIFFS' MOTION FOR PRELIMINARY INJUNCTION**

Jamie C. Clausen \_\_\_\_\_ Via hand delivery  
**COZEN O'CONNOR** \_\_\_\_\_ Via U.S. Mail, 1st Class, Postage Prepaid  
1201 Third Avenue, Suite 5200 \_\_\_\_\_ Via Overnight Delivery  
Seattle, Washington 98101 \_\_\_\_\_ Via Facsimile  
 X  \_\_\_\_\_ Via E-filing  
Attorneys for Defendants

Robert W. Hayes \_\_\_\_\_ Via hand delivery  
**COZEN O'CONNOR** \_\_\_\_\_ Via U.S. Mail, 1st Class, Postage Prepaid  
1900 Market Street \_\_\_\_\_ Via Overnight Delivery  
Philadelphia, Pennsylvania 19103 \_\_\_\_\_ Via Facsimile  
 X  \_\_\_\_\_ Via E-filing  
Attorneys for Defendants

Vincent V. Carissimi \_\_\_\_\_ Via hand delivery  
Michael J. Leonard \_\_\_\_\_ Via U.S. Mail, 1st Class, Postage Prepaid  
**PEPPER HAMILTON LLP** \_\_\_\_\_ Via Overnight Delivery  
3000 Two Logan Square \_\_\_\_\_ Via Facsimile  
Eighteenth and Arch Streets  X  \_\_\_\_\_ Via E-filing  
Philadelphia, Pennsylvania 19103-2799  
Attorneys for Defendants

I certify under penalty of perjury under the laws of the State of Oregon that the foregoing is true and correct.

DATED at Portland, Oregon, this 12th day of December, 2006.

s/ Sarah J. Crooks  
Sarah J. Crooks, WSBA 35997  
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Inc., Bergdorf Goodman, Inc., NM Nevada Trust  
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