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25 UNITED STATES DISTRICT COURT

26 CENTRAL DISTRICT OF CALIFORNIA

27 ACADEMY OF MOTION PICTURE
28 ARTS AND SCIENCES, a California
nonprofit corporation,

Plaintiff,

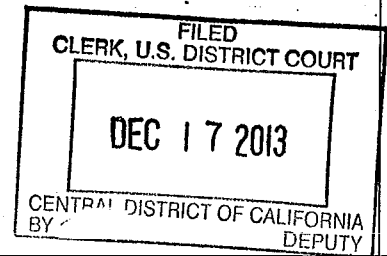
v.

GODADDY.COM, INC., a Delaware
corporation, and GODADDY.COM,
LLC, a Delaware limited liability
company,

Defendants.

Case No: CV-13-08458-ABC (CWx)

FIRST AMENDED COMPLAINT



1 Plaintiff, Academy of Motion Picture Arts and Sciences (“the Academy”
 2 or “Plaintiff”), a California nonprofit corporation brings this Complaint against
 3 Defendants GoDaddy.com, Inc. and GoDaddy.com, LLC (collectively
 4 “GoDaddy” or “Defendants”), and in so doing allege, upon information and
 5 belief, except as to allegations specifically pertaining to themselves, which are
 6 based on personal knowledge, as follows against Defendants:

7 8 SUMMARY OF CLAIMS

9 1. This action is brought by Plaintiff seeking redress for GoDaddy’s
 10 violations of the Anticybersquatting Consumer Protection Act (“ACPA”) 15
 11 U.S.C.A. § 1125(d), and California Business Professions Code Sections 17200.
 12 Said violations arise from Defendants’ actions to generate revenue from the
 13 unauthorized taking, use, and monetization of Plaintiff’s distinctive, famous
 14 and valuable marks. Plaintiff seeks redress for damages caused to it as a direct
 15 and proximate result of Defendants’ unauthorized monetization, registration,
 16 trafficking in, licensing and/or other such use of domain names belonging to
 17 and/or that are confusingly similar to Plaintiff’s valuable, protected, distinctive
 18 and famous marks. The instant action is related to and supplements a currently
 19 pending action between the same parties asserting the same theories of
 20 infringement under the ACPA and related state theories that was filed in May
 21 2010, Case No. 2:20-cv-03738-ABC-CW. In the pending action, Judge Collins
 22 has already made several summary judgment rulings, including on June 24,
 23 2013 and November 4, 2013. The instant action asserts claims related to
 24 parked pages on additional domain names not part of the pending action.

25 2. GoDaddy has deliberately taken, infringed, diluted and/or
 26 otherwise used, without authorization, the Academy’s rights in the OSCAR®,
 27 OSCARS® and OSCAR NIGHT®, ACADEMY AWARD®, ACADEMY
 28 AWARDS® marks (the “Academy’s Distinctive & Valuable Marks”). They

1 have done so through the registration, license, use, trafficking in, conversion,
2 and monetization of Internet domain names that are identical to and/or
3 confusingly similar to the Academy's Distinctive & Valuable Marks.

4 3. GoDaddy achieves monetary gain by using the Academy's
5 Distinctive & Valuable Marks to knowingly divert internet traffic away from
6 Plaintiff's legitimate websites, to infringing parked domains ("Deceptive
7 Domains"). The infringing domains are "parked pages" that have no
8 legitimate business purpose, display no substantive content, and are used
9 exclusively for the display of revenue generating advertisements. Defendants
10 derive revenue each time an internet user is directed to an infringing parked
11 domain and an advertisement is "clicked." GoDaddy has been, or attempted
12 to, derive revenue from hundreds of such infringing parked domains which
13 demonstrates its bad faith intent to profit from advertising on domain names
14 that are identical to, or confusingly similar to, the Academy's Distinctive &
15 Valuable Marks.

16 4. Defendants' violations and misconduct have caused damage and
17 losses to the Plaintiff. Plaintiff has expended significant time and expense in
18 identifying infringing parked pages. Plaintiff has incurred the additional
19 expense of consulting with attorneys and reimbursing them for the costs
20 associated with numerous cease-and-desist letters to holders of infringing sites,
21 which were rendered infringing by Defendants' services. Thereafter, Plaintiff
22 incurred the expense of determining whether their cease-and-desist letters had
23 been complied with. Finally, Plaintiff has suffered loss in the form of dilution
24 of legally-protected trademarks as a result of Defendants' conduct in placing
25 advertisements related to the Academy's marks on parked pages. This has
26 occurred, and continues to occur, on numerous parked pages as set forth below.

1 **SUBJECT MATTER JURISDICTION AND VENUE**

2 5. This is an action for cybersquatting under 15 U.S.C. § 1125(d) and
3 for violations of California statutory and common law. This Court has subject
4 matter jurisdiction over this claim pursuant to 28 U.S.C. § 1331. This Court
5 has supplemental jurisdiction pursuant to 28 U.S.C. § 1367.

6 6. Venue is proper in this Judicial District pursuant to 28 U.S.C. §
7 1391(b) as a substantial part of the events or omissions giving rise to the claim
8 and the actual harm to Plaintiff occurred in this District by reason of the
9 Defendants' conduct as alleged below. No other forum would be more
10 convenient for the parties and witnesses to litigate this action. California law
11 applies to all state law claims or controversies arising between the parties.

12
13 **PARTIES**

14 **A. PLAINTIFF: THE ACADEMY**

15 7. The Academy is a nonprofit corporation organized and existing
16 under the laws of the State of California, with its principal place of business in
17 Los Angeles County.

18 8. The Academy was founded in 1927 by a group of 36 film industry
19 leaders, who numbered among them Cecil B. Deville, Mary Pickford, Jack
20 Warner and Douglas Fairbanks, for the purpose of advancing the motion
21 picture arts and sciences by promoting cultural, educational and technological
22 achievements. As an incentive for members of the industry to strive toward
23 this goal and as a means of recognizing persons who make outstanding
24 contributions in their respective creative fields, the Academy presents annual
25 "Awards of Merit," known to the public as "Oscars." The Academy's Awards
26 of Merit are alternatively referred to in the singular as "Academy Award" or
27 "Oscar." The Oscars are presented during a nationally and internationally
28 televised "Academy Awards" program.

1 9. The Academy owns the ACADEMY AWARD® and ACADEMY
2 AWARDS® marks, which it has registered with the United States Patent and
3 Trademark Office (“USPTO”) pursuant to Certificate of Registration No.
4 2,245,965 for its ACADEMY AWARD mark and Certificate of Registration
5 Nos. 1,103,859, 1,880,473 and 1,956,313 for its ACADEMY AWARDS mark.
6 These marks are valid, subsisting, and incontestable, and, as the owner of these
7 registered marks, the Academy has the rights to their exclusive use.

8 10. The Academy owns the OSCAR®, OSCARS® and OSCAR
9 NIGHT® marks, which it has registered with the United States Patent and
10 Trademark Office pursuant to Certificates of Registration Nos. 1,096,990,
11 1,118,751, 1,996,585 and 2,021,582, for its OSCAR mark, Certificate of
12 Registration No. 1,528,890 for its OSCARS mark, and Certificate of
13 Registration No. 2,029,445 for its OSCAR NIGHT mark. These marks are
14 valid, subsisting, and incontestable, and, as the owner of these registered
15 marks, the Academy has the rights to their exclusive use.

16 11. With respect to Registration Nos. 1,103,859 and 1,880,473 for the
17 ACADEMY AWARDS® mark, Registration No. 1,096,990 for the OSCAR®
18 mark, and Registration No. 1,528,890 for the OSCARS® mark, the Academy
19 has complied with the requirements set forth in Sections 8 and 15 of the
20 Trademark Act of 1946. The Academy’s exclusive right to use those marks
21 and its registrations thereof have become incontestable within the meaning of
22 15 U.S.C. § 1065 and said certificates of registration constitute conclusive
23 evidence of, inter alia, the Academy’s ownership of, and exclusive right to use,
24 those marks.

25 12. The Academy is a venerable and important organization within the
26 motion picture industry, responsible for encouraging the industry’s cultural,
27 educational and technological advances. The Academy’s esteem is based on
28 its reputation for conferring its Academy Award of Merit on only those

1 individuals who have shown outstanding achievement in their creative fields.
2 Said award would not be a credible, highly prized award if the public and trade
3 believed that the Academy sold or gave the award to persons other than its
4 Academy Award of Merit winners. Indeed, the Academy does not license the
5 Academy's Distinctive and Valuable Marks except to promote its annual
6 Academy Awards® telecast or in connection with films that have been honored
7 by the Academy. Specifically, the Academy does not otherwise allow the
8 Academy's Distinctive and Valuable Marks to be used to advertise or promote
9 any other product or service.

10 13. As a result of the Academy's long leadership of the film industry,
11 extensive advertising, and media attention, the Academy's ACADEMY
12 AWARD®, ACADEMY AWARDS®, OSCAR®, OSCARS®, and OSCAR
13 NIGHT® marks have achieved widespread and favorable public acceptance
14 and recognition, and have become assets of substantial value throughout this
15 district, the United States, and the world.

16 14. The Academy's marks are recognized nationally and
17 internationally as signifying the Academy's Award of Merit and annual
18 Academy Awards® ceremony. The marks ACADEMY AWARD®,
19 ACADEMY AWARDS®, OSCAR®, OSCARS®, and OSCAR NIGHT® have
20 achieved a strong secondary meaning. The public universally associates the
21 terms and marks "Academy Award", "Academy Awards", "Oscars" and
22 "Oscar Night" with the Oscar® presentation by the Academy. The public also
23 universally associates the terms and marks "Academy Award", "Oscar", and
24 "Oscars" with the Oscar® statuette presented to the winners of the Academy's
25 annual Awards of Merit. ACADEMY AWARD®, ACADEMY AWARDS®,
26 OSCAR®, OSCARS®, and OSCAR NIGHT® are unquestionably linked in
27 the public mind with the Academy and its Award of Merit. Indeed, referring to
28 the Oscar® statuette, the Ninth Circuit has stated that "[t]he [OSCAR] mark

1 should be given the strongest possible protection against infringement.”
2 Academy of Motion Picture Arts and Sciences v. Creative House Promotions,
3 944 F.2d 1446, 1455 (9th Cir. 1991).

4 **B. DEFENDANTS**

5 15. Defendant GoDaddy.com, Inc. is the “flagship company” of
6 GoDaddy Group, Inc., an Arizona corporation with its principal place of
7 business located at 14455 N. Hayden Rd., Suite 219, Scottsdale, AZ 85260.
8 GoDaddy purports to be the world’s leading ICANN-accredited domain name
9 registrar for .COM, .NET, .ORG, .INFO, .BIZ and .US domain extensions. It
10 claims to have over forty (40) million domain names under its management,
11 and boasts that “(a)s an ICANN-accredited domain registrar, GoDaddy has
12 more names under management than any other registrar and has an array of
13 internet based services.”

14 16. Defendant GoDaddy.com, LLC is a Delaware limited liability
15 company with its principal place of business located at 14455 N. Hayden Rd.,
16 Suite 219, Scottsdale, AZ 85260. GoDaddy.com, LLC was incorporated on
17 December 5, 2011 and is the successor in interest to GoDaddy.com, Inc.

18 17. GoDaddy offers its services in interstate commerce, including, but
19 not limited to such services as registration, certification, hosting, parking,
20 redirection, transfer, and monetization through its “parking” program that
21 monetizes participating domain names. GoDaddy has a number of other
22 subsidiary companies, including: Wild West Domains, Inc., Starfield
23 Technologies, and Blue Razor Domains.

24 18. This Court has personal jurisdiction over GoDaddy because it
25 conducts substantial business within this district, has engaged in acts or
26 omissions within this district causing injury, has engaged in acts outside this
27 district causing injury within this district, and has engaged in conduct related
28 to the unlawful activities at issue in this action causing injury and harm in this

1 district, and/or has otherwise made or established contacts with this district
2 sufficient to permit the exercise of personal jurisdiction.

3 19. GoDaddy has intentionally used domains that it knew or should
4 have known infringed on the Academy's Distinctive & Valuable Marks.

5 20. GoDaddy has registered domains, monetized domains,
6 intentionally displayed advertisements on parked domains, and otherwise
7 utilized the Academy's Distinctive & Valuable Marks without Plaintiff's
8 consent or authorization.

9 21. GoDaddy has profited from its unlawful and unauthorized conduct
10 alleged herein.

11 22. As described above, and in more detail below, Defendants'
12 unlawful conduct has also caused Plaintiff to expend time and money in
13 policing Defendants' activities, issuing cease-and-desist letters, and monitoring
14 Defendants' activities for compliance. Moreover, Plaintiff has suffered a loss
15 in the value of its trademarks.

16
17 **GODADDY'S BUSINESS**

18 23. GoDaddy advertises and procures customers by offering "free
19 parking" of a registrant's domain name.

20 24. Under GoDaddy's "Parked Page Service", GoDaddy will park the
21 registrant's page and place advertisements on the web page while GoDaddy is
22 granted the right to collect and retain all revenue generated by the advertising.
23 GoDaddy's registrant-customers do not share the revenue GoDaddy generates
24 from parking their domain names.

25 25. Conservatively, GoDaddy has more than 500,000 customers in the
26 State of California and earns revenue in excess of \$35 million per year from
27 those customers.

28 26. GoDaddy also utilizes a Cash Parking Program, to monetize

1 parked domain names that are confusingly similar to distinctive, famous and
2 valuable marks. The Cash Parking Program is a service GoDaddy offers to its
3 customers that permits domain registrants to pay a fee to allow GoDaddy,
4 through its advertising partner, to place ads on the registrant's web page. The
5 revenue generated through this advertising is then split between the registrant,
6 GoDaddy, and GoDaddy's advertising partner.

7 27. GoDaddy has submitted a United States Patent Application for
8 "Systems and Methods for Filtering Online Advertising Trademarks". The
9 patent application recognizes the need for systems and methods to filter online
10 advertisements containing third-party trademarks because an unscrupulous
11 domain name registrant could attempt to gain financially by signing up for
12 domain parking advertising using a trademarked domain name notwithstanding
13 that the rightful trademark owners would not want their trademarks used by
14 others to profit from their trademarks. *Id.*, at [0007] and [0033]. The patent
15 application reflects both GoDaddy's recognition of the need—and its ability—
16 to protect against the very illegitimate activity and injury that it promotes and
17 profits from.

18 28. GoDaddy knew it was harming trademark holders, such as the
19 Academy, by monetizing domains utilizing their marks. In fact, GoDaddy
20 provided an example of such harmful activity in its Patent Application. Its
21 example is virtually identical to the activities the Academy complains of here
22 and details precisely why advertisements should not be placed on Deceptive
23 Domains:

24
25 [0033] In such situations, an unscrupulous domain name
26 registrant may attempt to financially gain from using the
27 trademarked domain name. For example, he may sign up for
28 one of the domain parking advertising methods discussed
above. If the trademark owner is one of the advertisers
partaking in the advertising program (many major products

and services providers are), the trademark owner's advertisements and links may appear when an Internet user accesses the domain name registrant's parked webpage. Using the hypothetical example in the previous paragraph, if an Internet user accesses a parked webpage resolving from a domain name that includes a trademark (but is not owned or controlled by the trademark owner--such as www.mygodaddy.com), the trademark owner and legitimate business entity's (GODADDY.COM) advertisements and links may appear. Legitimate trademark owners may not want their trademarks, advertisements, links, and websites used in such a manner because it allows others to profit from their trademarks. Such practices also may add credence or an air of legitimacy to any products or services offered on the domain name registrant's webpage.

[0034] For these reasons, systems and methods for filtering online advertisements containing third-party trademarks are needed.

Despite the foregoing, GoDaddy is committing the unscrupulous behavior described above to profit from The Academy's Distinctive & Valuable Marks.

29. Pursuant to the agreements GoDaddy requires its registrant-customers to agree to, GoDaddy is the authorized licensee of the registrants for the purpose of placing advertisements for commercial gain on the registrants' webpages in both the Parked Page Service and the Cash Parking Program.

30. GoDaddy, as the authorized licensee of the registrants, has licensed, monetized, used and/or trafficked in at least the following domain names in its Parked Page Service, with bad faith intent to profit from the Distinctive & Valuable Marks of the Academy:

- 2011THEOSCARS.COM
- 24HOURSATOSCARS.COM
- 24HOURSATTHEOSCARS.COM
- 2OSCARS.COM

- 1 • ALLOSCARWINNERS.COM
- 2 • BILLYCRYSTAL2012ACADEMYAWARDS.COM
- 3 • BILLYCRYSTAL2012OSCARS.COM
- 4 • NIGHTATOSCARS.COM
- 5 • OSCARGOODIEBAGS.COM
- 6 • OSCARIMAGES.COM
- 7 • OSCARMOMINEE.COM
- 8 • OSCARMOMINEES.COM
- 9 • OSCARONLINE.COM
- 10 • OSCARREDCARPET.COM
- 11 • OSCARWINNERS2009.COM
- 12 • OSCARWINNERS2012.COM
- 13 • THEOSCARS2011.COM
- 14 • TWOOSCARS.COM
- 15 • 100OSCAR.COM
- 16 • 100THOSCAR.COM
- 17 • 100OSCARS.COM
- 18 • ACADEMYAWARD100.COM
- 19 • BESTPICTUREOSCARNOMINATIONS.COM
- 20 • BESTOSCARPARTYINTOWN.COM
- 21 • COMEDYOSCARS.COM
- 22 • IAMANOSCARWINNER.COM
- 23 • LETSTALKOSCARS.COM
- 24 • OSCAR2014LIVE.COM
- 25 • OSCAR2013LIVE.COM
- 26 • OSCAR2013LIVESTREAM.COM
- 27 • OSCARARTPRODUCTION.COM
- 28 • OSCARAWARD2013LIVE.COM
- OSCARAWARDS2013.COM
- OSCARHOSTS.COM
- OSCARLIVE2013.COM
- OSCARNOMINATEDMOVIES.COM

- 1 • OSCARPICTURES.COM
- 2 • OSCARS2013LIVE.COM
- 3 • OSCARSFILM.COM
- 4 • OSCARSNOMINATIONS.COM
- 5 • OSCARSWINNER.COM
- 6 • OSCARWEEK.COM
- 7 • OSCARWINNERS2009.COM
- 8 • OSCARWINNINGACTORS.COM
- 9 • OSCARWINNERS2012.COM
- 10 • WATCHOSCAR2013ONLINE.COM
- 11 • YOUTUBEOSCARS.COM
- 12 • ZBIGATTIACADEMYAWARDS.COM
- 13 • ACADEMYAWARDSWINNERSLIST.COM
- 14 • WATCHOSCARAWARDS2012ONLINE.COM
- 15 • WATCHACADEMYAWARDS2012ONLINE.COM
- 16 • OSCARNOMINATIONS2013.COM
- 17 • ONLINEOSCARS.COM
- 18 • OSCARACTRESS.COM
- 19 • OSCARACTRESS.COM
- 20 • NOMINATEDBYOSCAR.COM
- 21 • NOMINATEDBYOSCAR.NET
- 22 • NOMINATEDBYOSCAR.ORG
- 23 • OSCARMOVIES.COM
- 24 • OSCARFILMSITESI.COM
- 25 • ONACADEMYAWARDS.COM
- 26 • ACADEMYAWARDEE.COM
- 27 • ACADEMYAWARDER.COM
- 28 • INDIEACADEMYAWARDS.COM
- MUSICACADEMYAWARD.COM
- ACADEMYAWARDS2015.COM
- OSCAR-MOVIE.COM
- OSCAR-MOVIE.INFO

- OSCAR-THEMOVIE.INFO
- OSCAR-O.COM
- OSCAR-O.INFO
- OSCAR-W.COM
- TOGETHERACADEMYAWARDS.COM
- ACADEMYAWARDSNOMINATION.COM
- AFRICANACADEMYAWARDS.COM
- OSCAR-PG.COM
- SAPPHIREACADEMYAWARDS.COM
- MILLIONAIREACADEMYAWARDS.COM
- MILLIONAIRESACADEMYAWARDS.COM
- ACADEMY-AWARDS.ORG
- ACADEMYAWARDSMOVIES.COM
- OSCAR-MOVIES.INFO
- WILDABOUTTHEACADEMYAWARDS.COM
- 2012ACADEMYAWARDS.COM
- 2013ACADEMYAWARDS.COM
- ACADEMYAWARDS2011WINNERS.COM
- ACADEMYAWARDS2012WINNERS.COM
- ALLOSCAR.COM
- LISTOFACADEMYAWARDWINNERS.COM
- OSCARBUZ.COM
- OSCARCAP.COM
- OSCARWINNINGMOVIES.COM
- ACADEMY-AWARDS-POOL.COM
- OSCAR-AWARDS-POOL.COM

Because there are so many infringing domain names, attached as Exhibits A-J are true and correct copies or screenshot exemplars from the list in paragraph 30.

31. GoDaddy, as the authorized licensee of the registrants in the Cash Parking Program, has licensed, monetized, used and/or trafficked at least the

1 following domain names, with bad intent to profit from the famous, Distinctive
2 & Valuable Marks of the Academy:

- 3 • 2012ACADEMYAWARDS.COM
- 4 • 2013ACADEMYAWARDS.COM
- 5 • ACADEMYAWARDS2011WINNERS.COM
- 6 • ACADEMYAWARDS2012WINNERS.COM
- 7 • ALLOSCAR.COM
- 8 • LISTOFACADEMYAWARDWINNERS.COM
- 9 • MYOSCARORNOT.COM
- 10 • MYOSCARSORNOT.COM
- 11 • OSCARBUZ.COM
- 12 • OSCARCAP.COM
- 13 • OSCARWINNINGMOVIES.COM
- 14 • ACADEMY-AWARDS-POOL.COM
- 15 • OSCAR-AWARDS-POOL.COM

16 Attached as Exhibits K-N are a few screenshots of examples from the list in
17 paragraph 31.

18 32. As a direct and proximate result of Defendants' conduct alleged in
19 this Complaint, the Academy has suffered injury to its business and property,
20 suffered financial loss, been deprived of property, and has otherwise been
21 damaged by Defendants' misconduct. Plaintiff's losses include the time and
22 expense of locating infringing pages parked with the Defendants, and the fees
23 for legal actions taken with respect to those pages. Plaintiff has also suffered
24 lost value in its trademarks.

25 33. Through its Cash Parking program, GoDaddy and the Registrants
26 of the domains have conspired to make money through their concerted action
27 in registering, monetizing and sharing revenue from parked domains that
28 infringe the Academy's Distinctive & Valuable Marks.

1 34. GoDaddy has engaged in acts in furtherance of their conspiracy,
2 including but not limited to:

3 a. Registering the domains listed in paragraph 29 and 30:

4 b. Parking said domains and utilizing the parked domain to
5 display revenue generating advertisements (monetized parked domain);

6 and

7 c. Sharing revenue generated from parked domains.

8 35. GoDaddy has continued to permit the domain names listed in
9 paragraphs 30 and 31 to be registered and parked, even though the Academy
10 previously filed a virtually identical lawsuit against GoDaddy for this same
11 conduct and has sent numerous cease-and-desist letters to GoDaddy,
12 demanding that it stop “registering or using the Academy’s trademarks, or any
13 colorable imitations thereof, as domain names”. The Academy sent the
14 numerous cease-and-desist letters to GoDaddy, and its registrants between
15 August 1, 2007, and February 5, 2010 and filed a lawsuit on May 14, 2010.
16 Despite the foregoing, many of the domain names that were the subject of
17 these cease-and-desist letters are strikingly similar or identical to the domain
18 names that GoDaddy permitted to be registered and parked several years
19 later. For example:

20 • On July 6, 2009, the Academy sent GoDaddy.com, Inc. a cease-
21 and-desist letter for ACADEMYAWARDSDVD.COM. Despite
22 that letter, GoDaddy later permitted OSCARDVD.COM to be
23 registered and parked; and

24 • On February 21, 2008, October 10, 2008, July 6, 2009, July 22,
25 2009, and August 6, 2009, the Academy sent and GoDaddy.com,
26 Inc. cease-and-desist letters for domain names that incorporated
27 variations of Academy Awards with the term “winners.” Despite

28 those letters, GoDaddy later permitted

1 ACADEMYAWARDS2011WINNERS to be registered and
2 parked.

3 36. Plaintiff has expended significant time and expense, including in
4 connection with the retention of counsel and third party domain monitoring
5 services, in identifying these infringing pages and sending the cease-and-desist
6 letters. In addition, Defendants' illegal activities result in advertising related
7 to the Academy's marks being placed on numerous parked pages that have no
8 actual relationship to the Academy, thereby causing dilution of Plaintiff's
9 interest in legally protected trademarks.

10 11 **FIRST CLAIM FOR RELIEF**

12 **(Violation of the Anticybersquatting Consumer Protection Act)**

13 37. Plaintiff hereby repeats and re-alleges all of the preceding
14 paragraphs as though fully set forth herein.

15 38. Plaintiff has standing to pursue this claim as Plaintiff has suffered
16 injury in fact and has lost money or property as a result of Defendants' actions
17 as set forth above.

18 39. In 1999, Congress passed the Anticybersquatting Consumer
19 Protection Act ("ACPA" or "Act"), 15 U.S.C.A. § 1125(d), to protect
20 consumers and American businesses, to promote the growth of online
21 commerce, and to provide clarity in the law for trademark owners.

22 40. 15 U.S.C. 1125(d) provides:

23 (d) **Cyberpiracy prevention**

24 (1)(A) A person shall be liable in a civil action by the owner
25 of a mark, including a personal name which is protected as a
26 mark under this section, if, without regard to the goods or
services of the parties, that person—

27 (i) has a bad faith intent to profit from that mark,
28 including a personal name which is protected as a mark
under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

15 U.S.C. 1125 (d)(E) provides:

As used in this paragraph, the term “traffics in” refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

41. The ACPA applies not only to individuals and companies who register domain names, but also to: (1) registrants of the Deceptive Domains; (2) anyone who “uses” the domain name which is defined as the registrant or the “authorized licensee” of the registrants of the Deceptive Domains; and (3) anyone who “traffics in” Deceptive Domains, which refers to anyone involved in any transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration, whether or not the person is the registrant of the Deceptive Domain.

42. The ACPA makes unlawful the use, licensing, pledging, ~~trafficking in, or any other exchange of consideration for the use of the~~ Deceptive Domain Names. Defendants’ conduct in monetizing the infringing

1 Deceptive Domains violates the Act.

2 43. As alleged herein, GoDaddy has acted as the authorized licensee
3 of the registrants and used the infringing Deceptive Domains in violation of the
4 ACPA, with bad faith intent to profit from the Academy's Distinctive &
5 Valuable Marks.

6 44. GoDaddy's acts as alleged herein constitute the use of and
7 trafficking in infringing Deceptive Domains, in violation of the ACPA with
8 bad faith intent to profit from the Academy's Distinctive & Valuable Marks.

9 45. GoDaddy's acts as alleged herein constitute cyberpiracy,
10 cybersquatting, and/or typosquatting (a form of cybersquatting based on
11 typographical errors users may make in entering domain names into a web
12 browser), in violation of the ACPA.

13 46. The Academy's Distinctive & Valuable Marks were distinctive,
14 famous, venerable, valuable, and federally-registered before GoDaddy
15 registered, trafficked in or acted as the authorized licensee of various
16 registrants and used the Deceptive Domains.

17 47. The infringing Deceptive Domains, including without limitation
18 those identified in paragraphs 32 and 33 are identical or confusingly similar to
19 the Academy's Distinctive & Valuable Marks.

20 48. GoDaddy does not have any intellectual property rights or any
21 other rights in the Academy's Distinctive & Valuable Marks.

22 49. None of the infringing Deceptive Domains consist of the legal
23 name of GoDaddy, or a name that is otherwise commonly used to identify
24 GoDaddy.

25 50. GoDaddy has never made any prior use of any of the infringing
26 Deceptive Domains in connection with the bona fide offering of any goods or
27 services.

28 51. GoDaddy trafficked in and used the infringing Deceptive Domains

1 to divert consumers from Plaintiff's websites to websites accessible from the
 2 infringing Deceptive Domains. GoDaddy thereby created a likelihood of
 3 confusion as to the source, sponsorship, affiliation, or endorsement of the
 4 infringing Deceptive Domain websites.

5 52. GoDaddy has used, trafficked in, and acted as registrant's
 6 authorized licensee in the infringing Deceptive Domains which it knew were
 7 identical or confusingly similar to the protected and Distinctive & Valuable
 8 Marks of Plaintiff, which were distinctive at the time of the registration and
 9 continue to be distinctive.

10 53. GoDaddy's trafficking in, and/or use, as the authorized licensee of
 11 the registrant, of the infringing Deceptive Domains constitutes cybersquatting
 12 in violation of 15 U.S.C. § 1125(d).

13 54. By reason of GoDaddy's acts alleged herein, a remedy at law is
 14 not adequate to compensate plaintiff for the injuries inflicted by Defendants.
 15 Accordingly, Plaintiff is entitled to preliminary and permanent injunctive relief
 16 pursuant to 15 U.S.C. § 1116.

17 55. By reason of Defendants' acts alleged herein, Plaintiff is entitled
 18 to recover GoDaddy's profits, actual damages and the costs of the action, or,
 19 on Plaintiff's election, statutory damages under 15 U.S.C. § 1117, in an
 20 amount up to \$100,000 per domain name infringement.

21 22 **SECOND CLAIM FOR RELIEF**

23 **(Violation of California Business & Professions Code**

24 **Section 17200 et seq. -Unfair Conduct)**

25 56. Plaintiff realleges the preceding paragraphs as if fully set forth
 26 herein and, to the extent necessary, pleads this cause of action in the
 27 alternative.

28 57. Plaintiff has standing to pursue this claim as Plaintiff has suffered

1 injury in fact and has lost money or property as a result of Defendants' actions
2 as set forth above. Those losses include the expense of locating infringing web
3 pages and legal fees for issuing cease-and-desist letters. Those losses also
4 include dilution of Plaintiff's trademarks.

5 58. GoDaddy's actions as alleged in this complaint constitute "unfair"
6 conduct within the meaning of California Business and Professions Code
7 sections 17200 et seq.

8 59. GoDaddy's business practices, as alleged herein, are "unfair"
9 because they offend established public policy and/or are immoral, unethical,
10 oppressive, unscrupulous and/or substantially injurious to business owners and
11 commerce within the State of California. GoDaddy's conduct is "unfair"
12 because GoDaddy uses valuable property that does not belong to it, without the
13 owners' permission or consent, for its own commercial/economic gain.

14 60. As a result of GoDaddy's "unfair" conduct, Plaintiff has been
15 deprived of its property, had its property and goodwill diluted and diminished,
16 suffered economic/financial loss, and was otherwise injured and damaged. As
17 indicated above, those losses include costs associated with identifying
18 infringing sites promulgated as a result of GoDaddy's illegal conduct, as well
19 as dilution and diminution in value of Plaintiff's valuable and legally protected
20 trademarks.

21 61. The general public has been damaged by GoDaddy's unfair
22 conduct by being confused and misdirected on the internet.

23 62. GoDaddy's wrongful business practices alleged herein constituted,
24 and continue to constitute, a continuing course of unfair competition since
25 GoDaddy continues to generate revenue in a manner that offends public policy
26 and/or in a fashion that is immoral, unethical, oppressive, unscrupulous and/or
27 substantially injurious to its California businesses, commerce, competition and
28 general public.

1 63. Pursuant to Cal. Bus. & Prof. Code §17203, Plaintiff seeks an
2 Order enjoining GoDaddy from continuing to engage in unlawful, unfair,
3 and/or deceptive business practices and any other act prohibited by law,
4 including those acts set forth in this complaint.

5 64. Plaintiff also seeks an order requiring GoDaddy to make full
6 restitution of all monies it has wrongfully obtained from Plaintiff, along with
7 all other relief allowable under Cal. Bus. & Prof. Code §17200 et seq.

8
9 **THIRD CLAIM FOR RELIEF**
10 **(Violation of California Business & Professions**
11 **Code § 17200 et seq.-Unlawful Conduct)**

12 65. Plaintiff realleges the preceding paragraphs as if fully set forth
13 herein and, to the extent necessary, pleads this cause of action in the
14 alternative.

15 66. Plaintiff has standing to pursue this claim as Plaintiff has suffered
16 injury in fact and has lost money or property as a result of Defendants' actions
17 as set forth in detail above.

18 67. GoDaddy's actions as alleged in this complaint constitute an
19 "unlawful" practice within the meaning of California Business and Professions
20 Code §17200 et seq. because GoDaddy's actions are "unfair" and violate both
21 federal statutory law and California statutory and common law.

22 68. Pursuant to Cal. Bus. & Prof. Code § 17203, Plaintiff seeks an
23 Order enjoining GoDaddy from continuing to engage in unlawful business
24 practices, including those acts set forth in this complaint.

25 69. Plaintiff seeks an order requiring GoDaddy to make full restitution
26 of all moneys it has wrongfully obtained from Plaintiff, along with all other
27 relief allowable under Cal. Bus. & Prof. Code §17200 et seq.

PRAYER FOR RELIEF

WHEREFORE, the Academy prays for relief as follows:

a. The Court enter a judgment that Defendants have violated the rights of the Academy in the Academy's Distinctive & Valuable Marks.

b. The Court adjudge and decree that GoDaddy, its agents, representatives, employees, assigns and suppliers, and all persons acting in concert or privity with GoDaddy, be preliminarily and permanently enjoined from the following activities:

1. Registering, using, or trafficking in any manner, in any domain name that incorporates, in whole or in part, the Academy's Distinctive & Valuable Marks or any name, mark or designation confusingly similar thereto ("Deceptive Domains");
2. Using the Academy's Distinctive & Valuable Marks, or any other name, mark, designation or depiction in a manner that is likely to cause confusion regarding whether GoDaddy is affiliated or associated with or sponsored by Plaintiff;
3. Registering any domain name using an automated process that is intended to create (or which could result in the creation of) Deceptive Domains;
4. Engaging in typosquatting;
5. Engaging in cybersquatting;
6. Engaging in cyberpiracy;
7. Assisting, conspiring with, aiding or abetting any other person or business entity in engaging in or performing any of the activities referred to above.

c. The Court award statutory damages under 15 U.S.C. § 1117(d), on

election of Plaintiff, in an amount of One Hundred Thousand Dollars (\$100,000.00) per domain name infringement;

d. The Court adjudge and decree that GoDaddy be ordered to pay the Academy's reasonable attorney fees, prejudgment interest, and costs of this action;

e. That, with respect to state statutory law claim,

1. That GoDaddy be permanently enjoined and restrained from, in any manner, directly or indirectly, continuing, maintaining, or engaging in the unfair, unlawful, and/or deceptive practices alleged herein;

2. That Plaintiff be awarded full restitution of money Defendants have unlawfully obtained, as well as compensatory damages and/or all other available monetary and equitable remedies;

3. That Plaintiff be awarded both pre-and post-judgment interest at the maximum allowable rate on any amounts awarded;

4. That Plaintiff recover its costs of suit, including reasonable attorneys' fees as provided by law; and

f. That Plaintiff be awarded such other and further relief as may be necessary and appropriate.

Dated: December 17, 2013



BOIES, SCHILLER & FLEXNER LLP

FOOTE MIELKE CHAVEZ & O'NEIL
LLC

LEE TRAN LIANG & WANG LLP

Counsel for Plaintiff ACADEMY OF
MOTION PICTURE ARTS AND
SCIENCES