

BOIES, SCHILLER & FLEXNER LLP
 Stuart Singer (*pro hac vice*)
 David Nelson (*pro hac vice*)
 401 East Las Olas Blvd, Suite 1200
 Fort Lauderdale, FL 33301
 Tel: 954-356-0011
 Fax: 954-356-0022
 Email: ssinger@bsfllp.com; dnelson@bsfllp.com

FOOTE MIELKE CHAVEZ & O'NEIL, LLC
 Robert M. Foote (*pro hac vice*)
 Kathleen Chavez (*pro hac vice*)
 Matthew Herman (*pro hac vice*)
 10 West State Street, Suite 200
 Geneva, IL 60134
 Tel: 630-232-7450
 Fax: 630-232-7452
 Email: rmf@fmcolaw.com; kcc@fmcolaw.com; mjh@fmcolaw.com

LEE, TRAN & LIANG LLP
 James M. Lee (CA Bar No. 192301)
 Enoch H. Liang (CA Bar No. 212324)
 601 South Figueroa Street, Suite 3900
 Los Angeles, CA 90017
 Tel: 213-612-8900
 Fax: 213-612-3773
 Email: james.lee@ltlattorneys.com; enoch.liang@ltlattorneys.com

UNITED STATES DISTRICT COURT
 CENTRAL DISTRICT OF CALIFORNIA

| | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| ACADEMY OF MOTION PICTURE ARTS AND SCIENCES, a California nonprofit corporation, Plaintiff, v. GODADDY.COM, INC., a Delaware corporation; GODADDY.COM, LLC, a Delaware limited liability company, Defendants. |) Case No. CV13-08458-ABC (CW))) PLAINTIFF ACADEMY OF) MOTION PICTURE ARTS AND) SCIENCES' OPPOSITION) TO DEFENDANT) GODADDY.COM, LLC'S) MOTION TO DISMISS AND) MOTION TO STRIKE)) Hearing) Date: February 24, 2014) Time: 10:00 a.m.) Location: Courtroom 680 |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

TABLE OF CONTENTS

| | <u>Page</u> |
|----------------------------------------------------------------------------------------------------|-------------|
| I. INTRODUCTION | 1 |
| II. BACKGROUND | 2 |
| A. The Academy | 2 |
| B. GoDaddy And Its' Page Parking Program..... | 3 |
| C. The 2010 Lawsuit And GoDaddy's Similar, Unsuccessful Motions To Dismiss | 4 |
| D. The Instant Lawsuit And GoDaddy's Similarly Unpersuasive Motion To Dismiss And Strike | 5 |
| III. LEGAL STANDARD | 5 |
| A. Rule 12(b)(6) Standard | 5 |
| B. Rule 12(f) Standard | 5 |
| IV. DISCUSSION | 6 |
| A. GoDaddy's 12(b)(6) Motion To Dismiss Should Be Denied. | 6 |
| 1. The Domain Names' Similarity in Sight and Sound Meet the "Confusingly Similar" Standard..... | 6 |
| 2. The Twelve Domain Names do not Contain "Proper Names" | 7 |
| 3. The Domain Names are Similar in Sight, Sound, and Meaning to the Academy's Marks | 8 |
| B. Defendants' Motion To Strike The Academy's Request For Restitution Should Be Denied..... | 11 |
| 1. Plaintiff Asserts a Cognizable Claim for Restitution Under Section 17200 | 11 |
| 2. Attorney Fees are Available Under the UCL | 14 |
| V. CONCLUSION | 15 |

TABLE OF AUTHORITIES

Cases

| | |
|-----------------------------------------------------------------------------------------------------------------------|-------|
| <i>Academy of Motion Pictures Arts and Sciences v. Creative House Promotions</i> , 944 F.2d 1446 (9th Cir. 1991)..... | 3 |
| <i>Buick v. World Savings Bank</i> , 565 F. Supp. 2d 1152 (E.D. Cal. 2008)..... | 13 |
| <i>Coca-Cola Co. v. Purdy</i> , 382 F.3d 774 (8th Cir. 2004)..... | 9 |
| <i>Corrarrubias v. Allstate Ins. Co.</i> , 1998 WL 656571 (C.D. Cal. July 10,1998)..... | 13 |
| <i>Ford Motor Co. v. Greatdomains.com, Inc.</i> , 177 F. Supp. 2d 635 (E.D. Mich. 2001)..... | 9, 10 |
| <i>Harrods Ltd. v. Sixty Internet Domain Names</i> , 157 F. Supp. 2d 658 (E.D. Va. 2001)..... | 8, 10 |
| <i>In re 2TheMart.com. Inc. Sec. Lit.</i> , 114 F. Supp. 2d 955 (C.D. Cal. 2000) | 6, 13 |
| <i>Korea Supply Co. v. Lockheed Martin Corp.</i> , 29 Cal. 4th 1134 (2003) | 13 |
| <i>Mattel, Inc. v. Internet Dimensions</i> , 2000 WL 973745 (S.D.N.Y July 13, 2000) | 8, 10 |
| <i>MGA Entertainment, Inc. v. Mattel, Inc.</i> , 2005 WL 5894689 (C.D. Cal. Aug. 26, 2005)..... | 12 |
| <i>Omega S.A. v. Omega Eng’g, Inc.</i> , 228 F. Supp. 2d 112 (D. Conn. 2002) | 8 |
| <i>Osei v. Countrywide Home Loans</i> , 692 F. Supp. 2d 1240 (E.D. Cal. 2010)..... | 12 |
| <i>RDF Media Ltd. v. Fox Broadcasting Co.</i> , 372 F. Supp. 2d 556 (C.D. Cal. 2005) | 6 |

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

| | |
|-----------------------------------------------------------------------------------------------|-----------|
| <i>Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.</i> , 202 F.3d 489 (2d Cir. 2000)..... | 8 |
| <i>Super-Krete Intern., Inc. v. Sadler</i> , 712 F. Supp. 2d 1023 (C.D. Cal. 2010) | 8, 10, 11 |
| <i>Telesaurus VPC, LLC v. Power</i> , 623 F.3d 998 (9th Cir. 2010)..... | 5 |
| <u>Statutes</u> | |
| Cal. Code. Civ. P. § 1021.5 | 14, 15 |
| Fed. R. Civ. P. 12(f)..... | 5, 13 |
| Fed. R. Civ. P. 12(b)(6) | 5 |

I. INTRODUCTION

This action brought in November 2013 (“GoDaddy II”) against GoDaddy is, in substance, identical to the litigation filed in 2010 against GoDaddy, Case No. 2:10-cv-03738-ABC-CW (“GoDaddy I”). The only difference is that the Academy has added to this action the additional domain names identified *after* Sept. 14, 2011, which were excluded from the GoDaddy I litigation by Judge Collins on June 21, 2013 (GoDaddy I, Dkt No. 491). GoDaddy’s Motion to Dismiss and Strike the claims brought in GoDaddy II raises two main arguments—both are misguided.

First, GoDaddy argues that the Court should dismiss twelve domain names because they are not confusingly similar to the Academy’s Marks “as a matter of law.” But, GoDaddy’s Motion should be denied because Plaintiff’s First Amended Complaint (FAC) alleges facts which, taken as true (as they must be, in a 12(b)(6) motion), are sufficient to show that the twelve domain names at issue *are* confusingly similar to the Academy’s Marks. GoDaddy’s argument that the domain names constitute “proper names” is clearly unfounded, as one could tell by a cursory glance at the domain names at issue (i.e., alloscar.com, oscarcap.com, oscar-o.com, oscar-o.info, oscar-w.com, nominatedbyoscar.com, nominatedbyoscar.net, nominatedbyoscar.org, oscarsfilm.com, twooscars.com, oscaronline.com, and nightatoscars.com).

Further, GoDaddy’s arguments that the addition of minor or generic words, or the removal of punctuation, is sufficient to render the domain names dissimilar in sight, sound, or meaning to the Academy’s Marks is in direct contradiction to well-settled authority on the issue. Again, even a cursory glance at the domain names next to the Academy’s Marks shows that they are *substantially* similar in sight, sound *and* meaning.

1 recognition. *See id.* at ¶ 13. Accordingly, the marks have become assets of
 2 substantial value. *See id.* As the Ninth Circuit has explained, “the
 3 [OSCAR] mark should be given the strongest possible protection against
 4 infringement.” *Academy of Motion Pictures Arts and Sciences v. Creative*
 5 *House Promotions*, 944 F.2d 1446, 1455 (9th Cir. 1991).

6 **B. GoDaddy And Its Page Parking Program**

7 Defendants GoDaddy.com, Inc., and GoDaddy.com, LLC
 8 (collectively, “GoDaddy” or “Defendants”) offer a “parking” service by
 9 which they register website domain names which are provided to customers
 10 in exchange for a cut of the revenue received from advertisements posted on
 11 the sites. FAC at ¶¶ 23–39. Defendants have accumulated a litany of
 12 website domain names that unlawfully use the Academy’s mark, such as:

- 13 • www.nominatedbyoscar.com,
- 14 • www.alloscar.com,
- 15 • www.oscarsfilm.com,
- 16 • www.nightatoscars.com,
- 17 • www.oscarwinners2012.com,
- 18 • www.oscarhosts.com,
- 19 • www.oscarlive2013, and
- 20 • www.2011theoscars.com.

21 *See id.* at ¶ 35-36.

22 Rather than sit by idly while its marks are abused in this way, the
 23 Academy has undertaken efforts – culminating in this litigation – to stop
 24 Defendants’ conduct. For instance, the Academy has retained counsel to
 25 identify infringing websites and to send Defendants cease-and-desist letters.
 26 *See id.* at ¶¶ 32, 35-36. Unfortunately, despite sending dozens of letters,
 27 Defendants continued to misuse the Academy’s marks, thus making this
 28 lawsuit necessary. *See id.* at ¶ 35.

**C. The GoDaddy I Lawsuit And GoDaddy's Similar,
Unsuccessful Motions to Dismiss**

The Academy filed its first lawsuit against GoDaddy on May 18, 2010, asserting claims under the ACPA and UCL ("GoDaddy I"). Plaintiff's Request for Judicial Notice ("Plf's RFJN"), Exh. A. On July 14, 2010, Defendants moved to dismiss the Academy's complaint. Plf's RFJN, Exh. B. This Court, *inter alia*, denied the First Motion to Dismiss with respect to the Academy's claim under the ACPA, but granted the Motion with respect to the Academy's UCL claim. Plf's RFJN, Exh. C. The Court concluded that the Academy had stated a UCL claim for conduct that was both "unlawful" and "unfair." *See id.* at 21–22. Nonetheless, the Court found that the Academy's UCL claims would be dismissed for lack of standing because the Academy had not alleged that Defendants' unlawful and unfair conduct caused the Academy economic loss. *Id.* at 21. However, "because the defect could be remedied, the Court . . . grant[ed] the Academy leave to amend to attempt to satisfy its burden to plead that it 'lost money or property' sufficient to satisfy the UCL standing requirement." *Id.*

On August 24, 2010, the Academy filed its FAC in GoDaddy I, which cured the defect identified in the Court's Order. Plf's RFJN, Exh. D.

GoDaddy then brought a *second* motion to dismiss or strike on November 6, 2010, arguing for dismissal on the grounds that AMPAS' FAC failed to plead facts sufficient to maintain a UCL claim and arguing that the motion be stricken based on the grounds that AMPAS failed to allege an entitlement to restitution under the UCL. Plf's RFJN, Exh. E. Similar to this Motion, GoDaddy urged this Court to strike AMPAS' prayer for restitution, arguing that it was insufficiently plead. *Id.* at 9-10.

This Court denied GoDaddy's Motion in its entirety. Def's RFJN, Exh. B. Notably, in ruling against GoDaddy on the issue of restitution, this

1 Court stated “The removal of inadequately pled material is *not a proper*
 2 *purpose* for a motion to strike.” (emphasis added). *Id.* at 7. The Court
 3 further stated “Plaintiff’s prayer for restitution cannot be considered
 4 “redundant, immaterial, impertinent, or scandalous matter.” *Id.* at 8.

5 **D. The Instant Lawsuit And GoDaddy’s Similarly Unpersuasive**
 6 **Motion to Dismiss And Strike**

7 Plaintiff filed the instant lawsuit on November 15, 2013, Complaint
 8 (Dkt. No. 1), followed by its First Amended Complaint on December 17,
 9 2013 (“GoDaddy II”). *See* FAC.

10 GoDaddy now files its motion to dismiss and motion to strike
 11 Plaintiff’s FAC, based on substantially similar arguments to those this Court
 12 overruled in GoDaddy’s first *two* Motions to Dismiss. *See* Defendants’
 13 Motion to Dismiss, Dkt. No. 27(“Motion” or “MTD”).

14
 15 **III. LEGAL STANDARD**

16 Defendants bring their motion under Federal Rules of Civil Procedure
 17 12(b)(6) and 12(f).

18 **A. Rule 12(b)(6) Standard**

19 “‘To survive a motion to dismiss [under Rule 12(b)(6)], a complaint
 20 must contain sufficient factual matter, accepted as true, to state a claim to
 21 relief that is plausible on its face;’ that is, plaintiff must ‘plead[] factual
 22 content that allows the court to draw the reasonable inference that the
 23 defendant is liable for the misconduct alleged.’” *Telesaurus VPC, LLC v.*
 24 *Power*, 623 F.3d 998, 1003 (9th Cir. 2010) (quoting *Ashcroft v. Iqbal*, 129
 25 S.Ct. 1937, 1949 (2009)).

26 **B. Rule 12(f) Standard**

27 Meanwhile, a motion to strike under Rule 12(f) should be granted
 28 only if the pleading contains an “insufficient defense or any redundant,

1 immaterial, impertinent, or scandalous matter.” Fed. R. Civ. P. 12(f). “Rule
 2 12(f) motions are generally disfavored, and will be granted only if it is clear
 3 that the matter will have no bearing on the controversy before the Court.”
 4 *RDF Media Ltd. v. Fox Broadcasting Co.*, 372 F. Supp. 2d 556, 566 (C.D.
 5 Cal. 2005) (internal quotation marks omitted). Moreover, a court must deny
 6 the motion to strike if any doubt exists whether the allegations in the
 7 pleadings might be relevant in the action. *In re 2TheMart.com. Inc. Sec.*
 8 *Lit*, 114 F. Supp. 2d 955, 965 (C.D. Cal. 2000).

10 **IV. DISCUSSION**

11 **A. GoDaddy’s 12(b)(6) Motion to Dismiss Should Be Denied.**

12 GoDaddy’s Motion should be denied because Plaintiff’s First
 13 Amended Complaint alleges facts which, taken as true (as they must be, in
 14 a 12(b)(6) motion), are sufficient to show that the twelve domain names at
 15 issue *are* confusingly similar to the Academy’s Marks.

16 **1. The Domain Names’ Similarity in Sight And Sound Meet** 17 **the “Confusingly Similar” Standard.**

18 Because the overwhelming majority of case law on this issue is
 19 contrary to GoDaddy’s position, GoDaddy takes to intentionally mis-
 20 quoting authority to make that authority fit its arguments.

21 For example, on Page 2 of its Motion, GoDaddy offers the following
 22 quotation from Exhibit A of its RFJN, quoting J. Thomas McCarthy: “In
 23 the cybersquatting context, ‘confusing similarity’ must simply mean that
 24 the plaintiff’s mark and the defendant’s domain name are so similar in
 25 sight, sound **and** meaning” MTD at 2. This is blatantly inaccurate.
 26 The correct quotation reads as follows: “In the cybersquatting context,
 27 ‘confusing similarity’ must simply mean that the plaintiff’s mark and the
 28 defendant’s domain name are so similar in sight, sound **or** meaning”

1 Defs' RFJN, Exh. A at 19:17-19. The distinction is critical, as "and"
 2 would require the domain names to share a similar meaning regardless of
 3 sight and sound, while "or" would find confusing similarity where only
 4 sight and sound were similar, regardless of meaning. That the distinction
 5 is critical was obviously not lost on GoDaddy.

6 In any event, even if the Court does consider meaning in its
 7 determination of whether the domain names are confusingly similar to the
 8 Academy's Marks, it will do so "to a more limited extent" than with sight
 9 or sound. *See* Defs' RFJN, Exh. A at 22:16-20. Further, it will consider
 10 meaning only where it "can be ascertained without regard to the parties'
 11 actual goods or services." *Id.* at 22:11-15. Thus, where the domain names
 12 are confusingly similar only in sight or sound to the Academy's Marks,
 13 this will suffice to establish confusing similarity, regardless of their
 14 meaning.

15 2. The Twelve Domain Names Do Not Contain "Proper 16 Names"

17 GoDaddy first argues that that all twelve of the domain names at
 18 issue contain "proper names" and are therefore not confusingly similar to
 19 the Academy's Marks. GoDaddy bases this argument on the Court's June
 20 21, 2013 Order, wherein the Court stated "Nevertheless, a domain name
 21 that is *clearly* a person's *proper name* is not confusingly similar to the
 22 Academy's marks. For example, on its face, the domain name
 23 'oscarramirez.com' is significantly different from the Academy's OSCAR
 24 marks because it includes *not only* the letters 'oscar,' but also the *clearly*
 25 *recognizable last name*, 'ramirez.'" Defs' RFJN, Exh. A at 23:27-28;
 26 24:1-4 (emphasis added).

27 Not a single one of the twelve domain names at issue meet the
 28 Court's standard of a "proper name." GoDaddy is moving to dismiss the

1 following domain names: alloscar.com, oscarcap.com, oscar-o.com, oscar-
 2 o.info, oscar-w.com, nominatedbyoscar.com, nominatedbyoscar.net,
 3 nominatedbyoscar.org, oscarsfilm.com, twooscars.com, oscaronline.com,
 4 and nightatoscars.com. Of the twelve disputed domain names, not a single
 5 one consists of the letters “oscar” followed by a “clearly recognizable last
 6 name.” Thus, none of these domain names meets the standard for a
 7 “proper name” that this Court set out in its June 21, 2013 Order, which
 8 GoDaddy bases its argument on. *See* Defs’ RFJN, Exh. A at 23:27-28;
 9 24:1-4. GoDaddy’s argument should be dismissed.

10 **3. The Domain Names Are Similar in Sight, Sound, or**
 11 **Meaning to the Academy’s Marks**

12 “Slight differences between domain names and registered marks,
 13 such as the *addition of minor or generic words* to the disputed domain
 14 names are irrelevant.” *See* Defs’ RFJN, Exh. A at 20:1-4 (quoting *Omega*
 15 *S.A. v. Omega Eng’g, Inc.*, 228 F. Supp. 2d 112, 127 (D. Conn. 2002)).
 16 “Similarly, the *addition or removal of punctuation* do not render a domain
 17 name dissimilar from a mark. *See id.* at 20:4-6 (quoting *Super-Krete*
 18 *Intern., Inc. v. Sadler*, 712 F. Supp. 2d 1023, 1032 (C.D. Cal. 2010)); *see*
 19 *also*:

- 20 • *Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, 202 F.3d 489,
 21 498 (2d Cir. 2000) (holding that “sportys.com” is confusingly
 22 similar to “sporty’s” under the ACPA);
- 23 • *Mattel, Inc. v. Internet Dimensions*, 2000 WL 973745, at *3
 24 (S.D.N.Y. July 13, 2000) (holding the domain name
 25 ‘barbiesplaypen’ confusingly similar to the Barbie mark, as both are
 26 inextricably associated with the term ‘play’);
- 27 • *Harrods Ltd. v. Sixty Internet Domain Names*, 157 F. Supp. 2d 658,
 28 677-78 (E.D. Va. 2001) (holding domain names “harrodsbank,”

“harrodsstore,” and “harrodsshopping” are confusingly similar to the “Harrods” mark because they bore a visual resemblance);

- *Ford Motor Co. v. Greatdomains.com, Inc.*, 177 F. Supp. 2d 635, 641 (E.D. Mich. 2001) (holding that the allegation that “4fordparts.com” and “4fordtrucks.com” are confusingly similar to the “Ford” mark was sufficient to overcome Rule 12(b)(6) motion to dismiss); and
- *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 784 (8th Cir. 2004) (holding that domain names “my-washingtonpost,” “mymcdonalds,” and “drinkcoke” with various top-level domain suffixes are confusingly similar to the “Washington Post,” “McDonald’s,” and “Coke” marks).

Notably, GoDaddy relies exclusively on these very differences, the addition of minor or generic words and the removal of punctuation, to support its argument that the domain names are not confusingly similar in sight, sound or meaning to the Academy’s Marks.

GoDaddy claims the following domain names are not similar in sight sound, or meaning to the Academy’s Marks, based on the addition of minor or generic words.

| <u>Trademark</u> | <u>Domain Name</u> | <u>Minor or Generic Addition</u> | <u>Similar Case</u> |
|------------------|----------------------|----------------------------------|---------------------------------------------------------|
| OSCAR | ALLOSCAR.com | “all” | See <i>Harrods</i> ; <i>Super-Krete</i> |
| OSCAR | NIGHTATOSCARS.com | “night at”; no apostrophe | See <i>Harrods</i> ; <i>Super-Krete</i> ; <i>Mattel</i> |
| OSCAR | NOMINATEDBYOSCAR.com | “nominated by” | See <i>Harrods</i> ; <i>Super-Krete</i> ; <i>Mattel</i> |
| OSCAR | NOMINATEDBYOSCAR.net | “nominated | See <i>Harrods</i> ; |

| <u>Trademark</u> | <u>Domain Name</u> | <u>Minor or Generic Addition</u> | <u>Similar Case</u> |
|------------------|----------------------|----------------------------------|-----------------------------------------|
| | | by” | <i>Super-Krete: Mattel</i> |
| OSCAR | NOMINATEDBYOSCAR.org | “nominated by” | <i>See Harrods; Super-Krete: Mattel</i> |
| OSCAR | OSCARCAP.com | “cap” | <i>See Harrods; Super-Krete</i> |
| OSCAR | OSCARMONLINE.com | “m” and “online” | <i>See Harrods; Super-Krete</i> |
| OSCAR | OSCARSFILM.com | “film”; no apostrophe | <i>See Harrods; Super-Krete: Mattel</i> |
| OSCAR | TWOOSCARS.com | “two” | <i>See Ford</i> |
| OSCAR | OSCAR-O.com | “-o” | <i>See Super-Krete; Harrods; Ford</i> |
| OSCAR | OSCAR-O.info | “-o” | <i>See Super-Krete; Harrods; Ford</i> |
| OSCAR | OSCAR-W.com | “-w” | <i>See Super-Krete; Harrods; Ford</i> |

As was the case in *Harrods*, *Super-Krete*, *Ford*, and *Mattel*, the foregoing domain names add only minor or generic terms to the registered mark. These additions are irrelevant and do nothing to change the indisputable fact that the domain names bear a visual and audible resemblance to the Academy’s Marks, as well as hold a similar meaning.

In addition, as in *Mattel*, the domain names “nightatoscars.com, nominatedbyoscars.com, nominatedbyoscars.net, nominatedbyoscars.org, and oscarsfilm.com, incorporate terms that are broadly associated with the Academy and its famous Marks. Thus, if anything the addition of these

1 terms actually *substantiates* the similarity between the domain name and
2 the mark, rather than contrasting it, as GoDaddy argues.

3 As to the domain names “oscarsfilm.com,” “nightatoscars.com,” and
4 “oscarcap,” GoDaddy argues that a reasonable consumer would read an
5 apostrophe into these domain names in order to make the term possessive.
6 However, as noted above, the addition or removal of punctuation do not
7 render a domain name dissimilar from a mark. *See Super-Krete Intern.,*
8 *Inc.*, 712 F. Supp. 2d at 1032. Overall, these domain names are still
9 similar in sight sound and meaning to the Academy’s marks.

10 The twelve domain names at issue here are clearly similar in sight
11 and sound to the Academy’s marks, based on well-established federal case
12 law. This is enough, on its own, to find the domain names confusingly
13 similar to the Academy’s Marks. While this Court has noted that the
14 meaning associated with a domain name *may* be considered, if it is
15 considered at all it will be to a more limited extent than sight or sound.
16 Here, to the extent the meaning of the domain names is considered, the
17 similarity becomes even more, not less, clear. These domain names
18 incorporate terms that are broadly associated with the Academy’s Marks,
19 such as “film”, “nominated” and “night at.” Thus, Plaintiff’s Complaint
20 has set forth sufficient factual allegations to allow this Court to draw the
21 reasonable inference that the domain names at issue are confusingly similar
22 to the Academy’s Marks, and GoDaddy’s 12(b)(6) motion to dismiss
23 should be denied in its entirety.

24
25 **B. Defendants’ Motion To Strike The Academy’s Request For**
26 **Restitution Should Be Denied.**

27 **1. Plaintiff Asserts a Cognizable Claim for Restitution Under**
28 **Section 17200**

1 As part of the prayer for relief contained in the FAC, which is nearly
 2 identical to the Complaint in GoDaddy I, the Academy requests, *inter alia*,
 3 “full restitution of all monies wrongfully obtained from Plaintiff”
 4 FAC ¶¶ 64-69. Defendants move to strike this request, arguing that
 5 restitution is not available under the Academy’s UCL claim. MTD at 6-9.

6 GoDaddy’s Motion is improper. As the Court noted in its *two*
 7 previous orders denying Defendants’ Motions to Dismiss on this same issue,
 8 “restitution is beside the point at this stage” (Plf’s RFJN, Exh. C at 21);
 9 “[t]he removal of inadequately pled material is ***not a proper purpose*** for a
 10 motion to strike” (Defs’ RFJN, Exh. B at 7:24-25); and “Plaintiff’s prayer
 11 for restitution cannot be considered “redundant, immaterial, impertinent, or
 12 scandalous matter” (*id.* at 8:3-4). Whether the Academy is entitled to
 13 restitution on its UCL claims is a question of remedy more properly
 14 addressed after the merits of the Academy’s complaint have been resolved.
 15 *See MGA Entertainment, Inc. v. Mattel, Inc.*, 2005 WL 5894689, at *9 (C.D.
 16 Cal. Aug. 26, 2005) (“Here, MGA’s UCL claim survives, and it is too early
 17 in these proceedings to determine definitively whether MGA might be
 18 entitled to restitution and disgorgement based upon its UCL-related
 19 allegations. Accordingly, the court denies Mattel’s motion to strike MGA’s
 20 request for restitution and disgorgement.”).

21 GoDaddy ignores this Court’s prior rulings and brings *another* motion
 22 to strike material it alleges is improperly plead, the very thing this Court has
 23 already stated it will not do. Defs’ RFJN, Exh. B at 7:24-25, 8:1-3.
 24 GoDaddy argues that the remedy pleaded in a complaint must be one that is
 25 available based on both the claim asserted and the facts alleged. However,
 26 both of the cases GoDaddy cites in support of this argument granted motions
 27 to strike based on the fact that the relief requested was *unavailable* under the
 28 asserted legal theories.

1 For example, in *Osei v. Countrywide Home Loans*, 692 F. Supp. 2d
 2 1240, 1255 (E.D. Cal. 2010), the Court granted the defendant's motion to
 3 strike as to attorney fees, stating, "At this point, the *only* fees that the court is
 4 prepared to say are not recoverable as a matter of law are plaintiff's specific
 5 request for attorney fees under the UCL . . . Attorney fees are not
 6 recoverable under the UCL." (internal quotations omitted) (emphasis added).
 7 In *Corrarrubias v. Allstate Ins. Co.*, 1998 WL 656571 (C.D. Cal. July 10,
 8 1998), the court granted the defendant's motion to strike triple punitive
 9 damages because they did "not apply to claims for common law bad faith."
 10 The Court also struck the plaintiff's request for emotional distress damages
 11 because they "are not recoverable as an element of damages for fraud."

12 GoDaddy's Motion is distinguishable. Unlike the motions in the
 13 foregoing cases, GoDaddy's Motion seeks to strike a remedy that *is*
 14 available under the legal theories asserted in the FAC. *See Buick v. World*
 15 *Savings Bank*, 565 F. Supp. 2d 1152, 1157 (E.D. Cal. 2008) (restitution is a
 16 proper remedy for violations of California's UCL); *Korea Supply Co. v.*
 17 *Lockheed Martin Corp.*, 29 Cal. 4th 1134, 1152 (2003) (actual direct victims
 18 of unfair competition may obtain restitution). Here, by pleading facts
 19 sufficient to show a plausible cause of action under Section 17200, Plaintiff
 20 has asserted a cognizable claim for restitution under Section 17200. Thus,
 21 Plaintiff's request for restitution cannot be considered "redundant,
 22 immaterial, impertinent, or scandalous" under Fed. R. Civ. P. 12(f) and
 23 cannot meet the high standard required to strike pleadings. Because doubt
 24 clearly exists as to whether the allegations of restitution in the pleadings
 25 might be relevant in the action, GoDaddy's Motion to Strike must be denied.
 26 *See In re 2TheMart.com. Inc. Sec. Lit.*, 114 F. Supp. 2d at 965.

27 Whether the Academy is entitled to restitution is a question properly
 28 left for trial. Because Plaintiff has asserted a cognizable claim for restitution

1 under Section 17200, GoDaddy's Motion to Strike is improper and must be
2 denied.

3 **2. Attorney Fees are Available Under the UCL**

4 While Section 17200 does not expressly provide for attorneys' fees,
5 under California Code of Civil Procedure § 1021.5, a court may award
6 attorneys' fees to a successful plaintiff in any action which has resulted in
7 the enforcement of an important right affecting the public interest if: "(a) a
8 significant benefit . . . has been conferred on the general public or a large
9 class of persons, (b) the necessity and financial burden of private
10 enforcement . . . are such as to make the award appropriate," Cal.
11 Code. Civ. P. § 1021.5.

12 The instant action, if successful, will certainly result in the
13 enforcement of an important right affect the public interest. GoDaddy
14 purports to be the world's leading ICANN-accredited domain name
15 registrar for .COM, .NET, .ORG, .INFO, .BIZ and .US domain extensions,
16 with **over 40 million** domain names under its management – "more names
17 than any other registrar." FAC ¶ 15. Further, GoDaddy and its affiliates
18 offer their services in interstate commerce (*id.* at ¶ 17), affecting people all
19 over the United States. In turn, GoDaddy is harming trademark holders
20 nationwide by monetizing domains utilizing their marks. *Id.* at ¶ 28. If
21 Plaintiff is successful, this action will establish enforceable trademark
22 rights of trademark owners nationwide as it related to GoDaddy's parked
23 page programs.

24 Moreover, the necessity and financial burden of private enforcement
25 of trademark rights are such as to make the attorneys' fees award
26 appropriate. Specifically, the Academy, and all other trademark users, are
27 required to sacrifice substantial time and resources to police the Internet
28

1 for infringing pages parked with GoDaddy, and to expend significant legal
2 fees to enforce their trademark rights against GoDaddy.

3 Based on the foregoing, an award of attorneys' fees is warranted if
4 this action is successful, under Cal. Code Civ. P. § 1021.5.

5
6 **V. CONCLUSION**

7 For the foregoing reasons, Defendants' Motion to Dismiss and Motion
8 to Strike should be denied in its entirety.

9
10 DATED: February 3, 2013

LEE TRAN & LIANG LLP

11
12 By: /s/ Enoch H. Liang _____

13 Enoch H. Liang

14 James M. Lee

15 BOIES, SCHILLER & FLEXNER,
16 LLP

17 Stuart Singer (*pro hac vice*)

18 David Nelson (*pro hac vice*)

19 FOOTE, MEYERS, MIELKE
20 FLOWERS LLC

21 Robert M. Foote (*pro hac vice*)

22 Kathleen Chavez (*pro hac vice*)

23 Matthew Herman (*pro hac vice*)

24 Attorneys for Plaintiff

25 ACADEMY OF MOTION PICTURE
26 ARTS AND SCIENCES
27
28