

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
(ALEXANDRIA DIVISION)**

**FILED**

2008 SEP 15 P 12:13

COURT REPORTER  
ALEXANDRIA, VIRGINIA

MARC RASMUSSEN, an individual,

Plaintiff,

v.

Sarasota Association of Realtors, Inc.  
A Nonprofit Corporation

Defendant.

Civil Action No.: 1:08cv954  
LO/TRJ

**COMPLAINT**

Marc Rasmussen ("Plaintiff"), by his attorneys, hereby files this Complaint pursuant to 15 U.S.C. § 1125(d) complaining of Sarasota Association of Realtors, Inc. ("Defendant"), and states as follows:

**THE PARTIES**

1. Plaintiff is a real estate agent who, since at least 2002, has offered and provided various real estate related services. He resides in Sarasota, Florida.

2. Defendant is a Florida nonprofit corporation which describes itself as an association of realtors. The Defendant's principal place of business is located at 3590 South Tuttle Avenue, Sarasota, Florida 34239.

**JURISDICTION AND VENUE**

3. Plaintiff is a citizen and resident of Sarasota, Florida.

4. Defendant is a nonprofit corporation organized and existing under the laws of Florida with its corporate headquarters and principal place of business in Sarasota, Florida.

5. This court has *in personem* jurisdiction over Defendant. Defendant (a) has numerous members of its association who reside, are domiciled and conduct business within this Court's district (b) actively conducts business and provides services on a regular and continuing basis to members, individuals and businesses residing, located and domiciled within this Court's district.

6. Because this is a federal question arising under the Lanham Act, this court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. § 1331 because Plaintiff seeks a declaratory judgment pursuant to 15 U.S.C. 1114(2)(D)(v), 15 U.S.C. § 1121, 15 U.S.C. § 1125(d) and 28 U.S.C. § 1338(a) (Trademark Disputes), 28 U.S.C. § 1332, 15 U.S.C. § 1116 (Injunctive Relief Under the Trademark Act), and 28 U.S.C. § 2201-02 (Federal Declaratory Judgment Act) that Plaintiff's registration and use of the domain name THESARASOTAMLS.COM does not violate Defendant's claimed rights in the term "The Sarasota MLS" under the ACPA or otherwise under the Lanham Act.

7. This Court has *in rem* jurisdiction over the domain name property in this matter pursuant to 15 U.S.C. § 1125(d)(2)(C).

8. Venue is proper in this district under 28 U.S.C. § 1391. The subject matter of this dispute, the domain name, is maintained, domiciled, protected, managed and utilized in this Court's district by the registrar, Network Solutions, LLC and/or its subsidiaries and/or related entities ("Network Solutions"), which are domiciled, reside and conduct business in this district and by the central database registry for the domain name which is located in this Court's district. The action of transferring the ownership of the domain name, if effectuated (or prohibited from being effectuated by a ruling of this Court) will be implemented by Network Solutions and/or its related entities which are domiciled and located in this Court's district. Furthermore, since *in rem* jurisdiction is appropriate in this proceeding and the subject of the *in rem* action is located in this Court's district, the venue of this Court's district is appropriate.

## NATURE OF THE CONTROVERSY

9. This is an action for a declaratory judgment and certain other remedies under the trademark laws of the United States and under the Anticybersquatting and Consumer Protection Act ("ACPA"). 15 U.S.C. § 1125(d). The Plaintiff is the registrant of the Internet domain name THESARASOTAMLS.COM. The domain name has been disabled and suspended by the registrar, Network Solutions, LLC. and is at immediate risk of being transferred away from Plaintiff by, and as a result of, the actions of Defendant, which claims trademark rights and certain other rights with respect to the term and the domain name THESARASOTAMLS.COM. The Plaintiff seeks a determination by this Court that Plaintiff's registration and/or use of the THESARASOTAMLS.COM Internet domain name is not (and has not been) in violation of ACPA and that Plaintiff's use of the THESARASOTAMLS.COM Internet domain name constitutes neither an infringement, a threat of dilution of Defendant's trademark nor a violation of the ACPA. Plaintiff also seeks an injunction prohibiting Defendant from further interference with Plaintiff's use of the domain name.

## FACTS

1. This case involves "reverse domain name hijacking," which occurs when an individual or an entity may allege that it is the owner of a trademark and assert spurious claims of trademark infringement and trademark dilution against the owner of a domain name whose chosen domain name is similar or identical to the registered trademark. Defendant is attempting to wrest control of Plaintiff's domain name by asserting baseless allegations of trademark infringement, trademark dilution and cybersquatting.

2. Plaintiff registered the domain name THESARASOTAMLS.COM on or about August 20, 2003 in good faith at which time (and at all times subsequent to which time) he believed and has had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

3. On or about July 3, 2008 Defendant filed a complaint thereby initiating an arbitration proceeding against Plaintiff with the National Arbitration Forum in accordance with the Uniform Domain Name Dispute Resolution Policy (“UDRP”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”). On or about the date of July 3, 2008, the registrar of the domain name, Network Solutions, LLC disabled, suspended and “locked” the domain name, thereby prohibiting Plaintiff from utilizing the domain name in accordance with the uses typically enjoyed by a registrant of a domain name. The action to disable, suspend and “lock” the domain name was in accordance with the UDRP and associated procedures. On or about August 27, 2008, the arbitration panel for the dispute ruled that the domain name should be transferred to Defendant. (NAF Case No. FA0806001213084). As of the date of the filing of this complaint, the domain name continues to be disabled, suspended and “locked” pending the transfer of the registration of the domain name to the defendant pursuant to the UDRP decision.

4. The reasons stated in the ruling of the arbitrator represent a significant departure from the written standards contained in the UDRP in that Defendant did not prove that (1) Plaintiff had bona fide trademark rights in the domain name or in terms included in the domain name (for purposes of the federal trademark laws that are applicable to the proceeding), (2) Plaintiff had no legitimate interest in the domain, or (3) that Plaintiff had registered and/or used the domain name in bad faith.

5. Plaintiff's use of the term as a domain name has not traded upon any goodwill or reputation enjoyed by Defendant as it relates to the services that Defendant offers, nor is there any possibility of confusion between the services offered by Defendant (1) to its members and/or (2) to the general public.

6. Plaintiff's use of THESARASOTAMLS.COM as his chosen domain name is a fair or otherwise lawful use of the term.

7. Because of the actions of Defendant, and its claims of trademark infringement, dilution and violation of the ACPA Plaintiff faces losing valuable rights in his Internet domain name.

8. Because the National Arbitration Forum has directed that the THESARASOTAMLS.COM domain name be transferred to Defendant, this Court has jurisdiction under 15 U.S.C. § 1114(2)(D)(v) to determine whether Plaintiff's registration and use of THESARASOTAMLS.COM is unlawful under the ACPA and the Lanham Act.

9. Based on the facts set forth herein, an actual controversy has arisen and now exists between Plaintiff and Defendant regarding whether or not Plaintiff's use of the term THESARASOTAMLS.COM as his domain name infringes Defendant's trademarks and/or constitutes trademark dilution and/or can serve as the basis for any relief under any federal or state law.

10. Defendant has alleged that it has acquired common law trademark rights to the term Sarasota MLS.

11. In spite of the Defendant's allegation that it has acquired common law trademark rights to the term Sarasota MLS, the Defendant did not have the intention (and did not) utilize the term in a trademark sense.

12. Exhibits which Defendant has proffered during prior proceedings with respect to the domain name do not show a specific intention of using the term in a trademark sense. Instead, the exhibits demonstrate that the term was used interchangeably as both a noun and an adjective and never included any trademark symbol.

13. Any use of the term Sarasota MLS by the Defendant was only as a descriptive name of its database.

14. Defendant has not had (and does not have) trademark rights to the term Sarasota MLS for purposes of the federal trademark laws pursuant to which this action has been initiated.

15. Defendant did not have any rights to a trademark with respect to the term Sarasota MLS that had become famous or distinctive at the time of Plaintiff's registration of the domain name.

16. Plaintiff did not have (and did not exhibit) any bad faith intent to profit from any alleged mark owned by Defendant.

17. A number of knowledgeable, well-informed individuals who have reviewed the facts in this situation have made the determinations (which determinations have been documented in writing) that (1) the Plaintiff had chosen the name and constructed the site in good faith and (2) that there was insufficient evidence that the public was being misled.

18. Plaintiff structured and prepared websites on the domain name in a manner, with wording and with structure that was intended to avoid confusion and did, in fact, not cause confusion.

19. Any use of the domain name by Plaintiff did not cause confusion.

20. Plaintiff has never sold, transferred, trafficked in or offered to sell the domain name.

21. At all times Plaintiff utilized the domain name in a bona fide manner for bona fide purposes.

22. Plaintiff did not have any intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site.

23. Plaintiff did not provide material and misleading false contact information when applying for the registration of the domain name. Plaintiff did not fail to maintain accurate contact information with respect to the domain name in question or with respect to any other domain name.

24. Plaintiff has never registered or acquired multiple domain names which the Plaintiff knew

were identical or confusingly similar to marks of others that were distinctive at the time of registration of such domain names, or dilutive of famous marks of others that were famous at the time of registration of such domain names, without regard to the goods or services of the parties.

25. The alleged mark incorporated in the domain name registration was not (and is not) distinctive and/or famous within the meaning of subsection (c)(1) of section 43.

26. Plaintiff's use of THESARASOTAMLS.COM as his chosen domain name is a fair or otherwise lawful use of the term.

27. Because of the actions of Defendant, and its claims of trademark infringement and dilution, Plaintiff faces losing valuable rights in his Internet domain name.

28. Because the National Arbitration Forum has directed that the THESARASOTAMLS.COM domain name be transferred to Defendant, this Court has jurisdiction under 15 U.S.C. § 1114(2)(D)(v) to determine whether Plaintiff's registration and use of THESARASOTAMLS.COM is unlawful under the ACPA and the Lanham Act.

## COUNT I

29. Plaintiff incorporates by reference the allegations set forth in paragraphs 1 through 28 above.

30. The ACPA, provides a cause of action for a registrant whose domain name has been suspended, disabled, or transferred by which the registrant may sue for a declaration that the registrant is not in violation of the Act and for an injunctive relief to the domain name registrant, including the reactivation of the domain name. 15 U.S.C. § 1114(2)(D)(v).

31. Section 1114(2)(D)(v) provides a registrant who is threatened with the loss of his domain name under the UDRP with a cause of action for an injunction returning the domain name if the

registrant can show that the registrant is in compliance with the ACPA.

32. An *in rem* cause of action is allowed and may be brought where the registrar Network Solutions, LLC (located in this Court's district) or registry database ("located in this Court's district) is located. Anticybersquatting Act 15 U.S.C. § 1125(d)(2)(C)

33. Defendant does not have any exclusive use of the alleged mark nor did it have such a right at the time Plaintiff registered the domain name.

34. Plaintiff did not register the domain name THESARASOTAMLS.COM with the bad faith intent to profit from the goodwill of defendant's alleged trademark.

35. Plaintiff has, at all times, been in compliance with the ACPA and has not violated the ACPA (or engaged in Cybersquatting activity) pursuant to the ACPA.

36. As such, Plaintiff is entitled to have the unencumbered use of the domain name THESARASOTAMLS.COM and to have the domain name reactivated and to have any and all suspensions or transfers terminated and prohibited.

### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiff prays for relief from this Court as follows:

- A. Order Network Solutions LLC. to take all action necessary to enable the domain name THESARASOTAMLS.COM, to reactivate the domain name, to discontinue any suspension of the domain name, and to refrain from transferring the domain name from Plaintiff.
- B. For a declaration from this Court that Plaintiff's registration, use and possession of the domain name THESARASOTAMLS.COM neither infringes defendant's trademarks nor

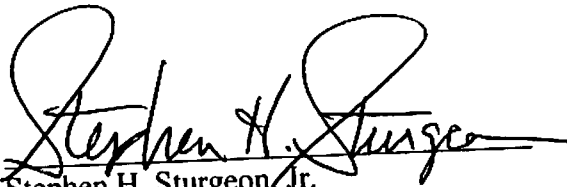


dilutes the trademarks in any manner nor constitutes a violation of any federal or state law;

- C. For a declaration from this Court that Plaintiff may continue to use and enjoy his chosen domain name without interference of any type by the defendant;
- D. For injunctive relief prohibiting defendant from interfering with or challenging Plaintiff's registration, possession or use of the subject domain name;
- E. For attorneys' fees incurred by the Plaintiff;
- F. For costs incurred by Plaintiff; and
- G. For such other relief as this Court may deem just and proper.

This 15th day of September, 2008.

By:



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