

IN THE UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF ARKANSAS
FAYETTEVILLE DIVISION

CURTIS J. NEELEY, JR.

PLAINTIFF

v.

Civil No. 09-5151

NAMEMEDIA, INC., NETWORK
SOLUTIONS, INC.; and
GOOGLE, INC.

DEFENDANTS

O R D E R

Now on this 20th day of May, 2010, comes on for consideration the **Motion To Dismiss** of defendant Network Solutions, Inc. (document #104), and from said motion, and the response thereto, the Court finds and orders as follows:

1. In this case, plaintiff Curtis J. Neeley, Jr. ("Neeley") alleges that Network Solutions, Inc. ("Network") violated his trademark rights by advertising the domain registration expiration dates for two domain names once owned by him. He also contends that NameMedia, Inc. ("NameMedia") registered these domain names in bad faith, and licensed them to Google, Inc. ("Google"). All these actions are said to violate the anti-cybersquatting provisions of **15 U.S.C. § 1125(d)**.

Neely further alleges that the defendants "conspired to cybersquat" his domains, and that Network violated his copyright and trademark rights by advertising domain expiration dates.

Neeley also seeks injunctive relief preventing Network from advertising the expiration dates of domain names, and directing Google to "stop licensing trademark infringing domains when made

aware of the claims."

2. Network makes the following arguments for dismissal:

- * that Neeley's claim it advertised the expiration dates of the domain names at issue herein is barred by the statute of limitations;

- * that Neeley's copyright claims against it are subject to dismissal by reason of Neeley's failure to register his copyright;

- * that punitive damages are not available for Neeley's trademark or copyright claims;

- * that Neeley's claims under Title 5 must fail because Network is not a government agency;

- * that Neeley lacks standing to object to Network's business practices except to the extent those practices affect the two domain names here in issue;

- * that Neeley's trademark claims lack factual or legal basis; and

- * that as a mere registrar of domain names, Network is not liable for trademark violations.

3. In response, Neeley contends that he is entitled to the benefit of equitable tolling of the statute of limitations, in that he did not know, nor could he have known -- before October 18, 2009 -- who the domain registrar in this case was.

4. Federal trademark law, embodied in the Lanham Act, does not prescribe a statute of limitations, so courts look to the

local statute which bears the closest resemblance to the Lanham Act and apply the statute of limitations contained in that statute. **Axcan Scandipharm Inc. v. Ethex Corp.**, 585 F.Supp.2d 1067, 1077 (D. Minn., 2007).

Arkansas has a body of statutory trademark law (see **A.C.A. § 4-71-201 et seq.**), but like the Lanham Act it does not contain a statute of limitations. The Court, thus, turns to the general statute of limitations under Arkansas law, which places a three-year statute of limitations on actions involving the taking of goods or chattels. **A.C.A. § 16-56-105.**

Neeley does not dispute that a three-year statute of limitations applies, but contends that the statute of limitations should be equitably tolled as against Network. As explained by the Eighth Circuit,

[t]he doctrine of equitable tolling permits a plaintiff to sue after the statutory time period has expired if he has been prevented from doing so due to inequitable circumstances. Because statutes of limitations protect important interests of certainty, accuracy, and repose, equitable tolling is an exception to the rule, and should therefore be used only in exceptional circumstances.

Firstcom, Inc. v. Qwest Corp., 555 F.3d 669, 675 (8th Cir. 2009)

(internal citations and quotation marks omitted).

Under Eighth Circuit precedent "'a litigant seeking equitable tolling bears the burden of establishing two elements: (1) that he has been pursuing his rights diligently, and (2) that some

extraordinary circumstance stood in his way'." **Burns v. Prudden**, 588 F.3d 1148, 1150 (8th Cir. 2009). Equitable tolling requires that the plaintiff have acted reasonably and in good faith, and that despite due diligence he was "unable to obtain vital information bearing on the existence of [the] claim." **Sandoval v. American Bldg. Maintenance Industries, Inc.**, 578 F.3d 787, 792 (8th Cir. 2009).

The factual showing of Neeley on this issue is that he made inquiry of an internet group he had joined in July, 2009, for information about the registrar of the domain names. By a post dated October 18, 2009, he asked for help in determining "when I first registered eartheye.com and who was the registrar I once used?" Neeley indicated that he wanted the information because "[t]he judge asked,"¹ and that if it was publicly accessible information, "I know this is the group that would know."

Neeley received a response the same day, informing him that Network was the registrar he had used, and that the registration expired on April 18, 2003. This prompt response, from a group of which Neeley was a member and which he knew would have the information, indicates that he could have obtained the information about Network in a more timely manner. In addition, the Court

¹It appears Neeley made this inquiry in response to the Order of Magistrate Judge James Marschewski that Neeley complete an Addendum and return it to assist in the determination of whether the Complaint should be served, a common procedure with Complaints filed *in forma pauperis*.

notes that Arkansas law provides for filing a complaint against an unknown tortfeasor as a "John Doe" defendant, thereby tolling the statute of limitations. **A.C.A. § 16-56-125.** Neeley could have availed himself of this statute to sue an unknown domain registrar in a timely fashion.

Under these circumstances, the Court is not persuaded that equitable tolling should apply to Neeley's claims against Network. Neeley's claim of trademark infringement against Network arose on April 18, 2003, and was not asserted until his Amended Complaint was filed on November 24, 2009. The Court has already determined, for reasons set forth in its Order dated March 1, 2010, that Neeley's mental competency -- which he lost temporarily due to an accident -- was restored on January 25, 2006, giving him until January 26, 2009, to file suit. He did not file his trademark infringement claim against Network in that period of time, and it is now time-barred. It will be dismissed with prejudice for that reason.

5. Network also contends that Neeley's copyright claims against him are subject to dismissal by reason of Neeley's failure to register his copyright. For reasons set forth in the Court's March 1, 2010, Order, this argument has merit, and Neeley's copyright infringement claim against Network will be dismissed without prejudice.

6. Network contends that punitive damages are not available

for Neeley's trademark or copyright claims. Because those claims are subject to dismissal, the Court need not address this argument.

7. Network contends that Neeley's claim under Title 5 fails because Network is not a government agency. Neeley makes no response to this contention, and the Court finds it has merit. This claim will be dismissed with prejudice.

8. Network contends that Neeley lacks standing to object to its business practices except to the extent those practices affect the two domain names here in issue. This contention goes to Neeley's prayer for injunctive relief preventing Network from advertising expiration dates of domain names.

The Supreme Court has outlined the requirements of standing as follows:

the irreducible constitutional minimum of standing contains three elements. First, the plaintiff must have suffered an "injury in fact" - an invasion of a legally protected interest which is (a) concrete and particularized, and (b) "actual or imminent, not 'conjectural' or 'hypothetical'." Second, there must be a causal connection between the injury and the conduct complained of - the injury has to be "fairly . . . trace[able] to the challenged action of the defendant, and not . . . th[e] result [of] the independent action of some third party not before the court." Third, it must be "likely," as opposed to merely "speculative," that the injury will be "redressed by a favorable decision."

Lujan v. Defenders of Wildlife, 504 U.S. 555, 560-61 (1992)

(internal citations omitted).

Even when Neeley's Complaint, with all amendments, is read

broadly,² it contains no sufficient allegation of an actual or imminent invasion of his rights. The gravamen of his Complaint against Network is the advertising of the expiration dates of the two domain names, an act which is past and completed. Given the unusual circumstances that led to Neeley being unaware of the expiration of the registrations for his domain names, it is exceedingly unlikely that it will ever recur, and thus any benefit to Neeley by the injunctive relief he seeks could be nothing more than speculative. He thus lacks standing to pursue this type of relief, and his claim for injunctive relief will be dismissed without prejudice.

9. Finally, Network contends that Neeley's trademark claims lack factual or legal basis, and that as a mere registrar of domain names, Network is not liable for trademark violations. Given that the trademark infringement claim is barred by the statute of limitations, the Court need not address this argument.

IT IS THEREFORE ORDERED that the **Motion To Dismiss** of defendant Network Solutions, Inc. (document #104) is **granted**.

IT IS FURTHER ORDERED that Neeley's claim of trademark infringement and any claim asserted under Title 5 against Network Solutions, Inc., are hereby **dismissed with prejudice**.

²In evaluating a motion to dismiss, the Court views the complaint in the light most favorable to the plaintiff, Krentz v. Robertson Fire Protection District, 228 F.3d 897, 905 (8th Cir. 2000), dismissing only if the plaintiff fails to assert facts that affirmatively and plausibly suggest that he has the right he claims, as opposed to asserting facts that are merely consistent with such right, Gregory v. Dillard's, Inc., 565 F.3d 464, 473 (8th Cir. 2009).

IT IS FURTHER ORDERED that Neeley's claim of copyright infringement and his claim for injunctive relief against Network Solutions, Inc., are hereby **dismissed without prejudice**.

IT IS SO ORDERED.

/s/ Jimm Larry Hendren
JIMM LARRY HENDREN
UNITED STATES DISTRICT JUDGE