

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

CURTIS J. NEELEY, Jr.

PLAINTIFF

VS.

CASE NO. 5:09-cv-05151-JLH

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

DEFENDANTS

**NAMEMEDIA'S RESPONSE TO PLAINTIFF'S MOTION FOR SUMMARY  
JUDGMENT AS TO NAMEMEDIA'S COUNTERCLAIM**

At issue is whether Plaintiff can be awarded summary judgment based upon a conclusory allegation that his conduct is protected by the First Amendment. The case law is clear that he cannot.

**FACTS**

1. *Plaintiff registered a domain name that is confusingly similar to NameMedia's distinctive, federally registered trademark.*

NameMedia, Inc. ("NameMedia") on April 12, 2006 applied for, and on January 27, 2009 obtained a federal registration for its distinctive trademark. *See* Ex. A. NameMedia also operates the website [www.<NAMEMEDIA.com>](http://www.<NAMEMEDIA.com>). On October 15, 2009, Plaintiff registered the domain [<NAMEMEDIAs.com>](http://<NAMEMEDIAs.com>). *See* Ex. B. The only difference between the two domain names is the letter "s."

2. *Plaintiff had no existing rights to register the domain <NAMEMEDIAs.com> and makes improper commercial use of the domain.*

Plaintiff has no trademark or other intellectual property rights in the mark "NAMEMEDIA." The domain name [<NAMEMEDIAs.com>](http://<NAMEMEDIAs.com>) does not consist of Plaintiff's legal

name or a name commonly used to identify Plaintiff. Plaintiff has no prior use of <NAMEMEDIAS.com> in connection with the bona fide offering of any goods or services. Plaintiff directly solicits donations at <NAMEMEDIAS.com>. *See* Ex. C. Plaintiff also advertises a link to his other website, www.curtisneeley.com. *See id.* At www.curtisneeley.com, Plaintiff offers his photographs for sale. *See* Ex. D.

3. *Plaintiff has intended to cause confusion through use of the domain <NAMEMEDIAS.com>.*

The addition of the letter “s” to NameMedia’s distinctive NAMEMEDIA trademark is itself evidence of Plaintiff’s intent to cause confusion. The first sentence at <NAMEMEDIAS.com> shows that Plaintiff anticipates customer confusion. *See* Ex. C. Plaintiff includes numerous references and links to NameMedia at <NAMEMEDIAS.com>. *See id.* As a result, a Google search for “NAMEMEDIA” produces <NAMEMEDIAS.com> as the fifth highest result. *See* Ex. E. Plaintiff boasts of his ability to manipulate search engines to produce the high ranking of <NAMEMEDIAS.com> in the results of search engines. *See* Ex. F.

4. *Plaintiff has demanded between \$30 million and \$100 million to transfer the domain name and “silence his outrage.”*

Plaintiff made this demand in writing: “This could be over for something between thirty million and 100 million. I would even give you <NAMEMEDIAS.COM>. . . I would agree to never discuss domain names again.” *See* Ex. F. In the same communication, Plaintiff stated that \$100 million will allow NameMedia to silence his outrage. *See id.*

5. *Plaintiff will not obey any Court order regarding <NAMEMEDIA.com>, and intends to destroy NameMedia's business.*

Plaintiff states he will not obey any order of this Court that will require him to cease use of <NAMEMEDIA.com>. *See* Ex. F. Plaintiff also states his intent is to destroy NameMedia's business and put NameMedia employees in jail. *See id.*

### **STANDARD**

Summary judgment is not appropriate unless the record, viewed in the light most favorable to the nonmoving party, and giving that party the benefit of all reasonable inferences, shows that there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law. The burden is on Plaintiff to demonstrate the non-existence of a genuine factual dispute. *Blair v. World Tropics Prods.*, 502 F.Supp.2d 828, 830 (W.D. Ark. 2007). All facts must be considered in the light most favorable to NameMedia, and all reasonable inferences must be drawn in NameMedia's favor. *Gregory v. Dillard's, Inc.*, 565 F.3d 464, 481 (8th Cir. 2009).

### **ARGUMENT**

NameMedia's counterclaim brings a single claim under the Anticybersquatting Consumer Protection Act (the "ACPA"). The ACPA prohibits Plaintiff from registering a domain name that is confusingly similar to NameMedia's distinctive trademark with a bad faith intent to profit. *See* 15 U.S.C. § 1125(d). To determine bad faith intent to profit, the statute provides a nonexhaustive list of factors that the Court may consider. *See* 15 U.S.C. § 1125(d)(1)(B)(i). There is no formula for applying these factors; courts do not simply add up how many factors weight to one side.<sup>1</sup> *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214, 234 (4th Cir. 2002). Because the

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<sup>1</sup> This is the same non-mechanical analysis the Eighth Circuit applies in trademark infringement cases. *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 1054 (8th Cir. 2005).

list of factors is permissive rather than mandatory, the Court is not required to analyze each factor. *Virtual Works, Inc. v. Wolkswagen of America, Inc.*, 238 F.3d 264, 269 (4th Cir. 2001). Additionally, the Court is not limited to these factors and may consider other factors that are applicable to the particular case. *Id.* at 268; *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 786 (8th Cir. 2004).

**I. Substantial Evidence Exists that Plaintiff Acted at Least Partially in Bad Faith, Which Precludes Summary Judgment.**

Plaintiff's entire argument is based upon the proposition that his conduct is protected by the cybersquatting law's safe harbor provision. The safe harbor provision only applies when the person both (1) believed and (2) had reasonable grounds to believe, that the use of the domain name was lawful. *See* 15 U.S.C. § 1125(d)(1)(B)(ii). This safe harbor provision does not sweep as broadly as Plaintiff hopes. Anyone accused of cybersquatting can set forth at least some lawful motives for their behavior. *Virtual Works*, 238 F.3d at 270. In that case, the Fourth Circuit set forth the seminal language regarding the safe harbor provision: "A defendant who acts even partially in bad faith in registering a domain name is not, as a matter of law, entitled to benefit from the Act's safe harbor provision." *Id.*; *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 369 (4th Cir. 2001).

The Eighth Circuit adopted the Fourth Circuit's analysis that a defendant who acts even partially in bad faith is not entitled to benefit from the safe harbor provision. *Coca-Cola*, 382 F.3d at 788. In that case, the defendant registered domain names that incorporated various distinctive marks. *Id.* at 779. The defendant linked these domains to websites with antiabortion commentary. *Id.* These websites contained links to other websites where consumers could

purchase goods or make donations. *Id.* The defendant argued the First Amendment protected his conduct under the safe harbor provision. *Id.* at 787-88. The Eighth Circuit held that the First Amendment analysis is intertwined with the bad faith analysis under 15 U.S.C. § 1125(d)(1)(B)(i). *See id.* at 788. The court rejected Purdy's First Amendment argument because of his bad faith as indicated by analyzing the factors under 15 U.S.C. § 1125(d)(1)(B)(i). *See id.* While Purdy had a First Amendment right to express his message, he had no such right to express that message through domain names that inappropriately used distinctive trademarks. *Id.* at 787-88.

The question of whether Plaintiff's conduct falls within the purview of the safe harbor provision is a question of fact that is inappropriate for summary judgment. Domain names are not automatically entitled to First Amendment protection. *Sunlight Saunas, Inc. v. Sundance Sauna, Inc.*, 427 F.Supp.2d 1032, 1057 (D. Kan. 2006). Instead, the analysis demands a "particularistic, context-sensitive analysis . . . including analyses of the domain name itself, the way the domain name is being used, the motivations of the author of the website in question, [and] the contents of the website." *Id.* This is a factual determination making summary judgment inappropriate. *Id.* at 1057, 1066; *see also Shields v. Zuccarini*, 254 F.3d 476, n. 2 (3rd Cir. 2001) (defendant's claim of fair use under the safe harbor provision creates a genuine issue of material fact).

Plaintiff bases his First Amendment argument solely upon a naked assertion that his conduct is constitutionally protected. *See* Docket # 52 at ¶ 29; Docket # 51 at ¶ 5. However, several of the factors listed in 15 U.S.C. § 1125(d)(1)(B)(i) show Plaintiff acted at least partially in bad faith:

(1) Plaintiff has no trademark or other intellectual property rights in the mark NAMEMEDIA, which is wholly incorporated in the domain name <NAMEMEDIAs.com>. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(I); *Coca-Cola*, 382 F.3d at 785. Plaintiff's first use of the mark NAMEMEDIA occurred when he purchased the domain <NAMEMEDIAs.com> on October 15, 2009. *See* Ex. B.

(2) The domain name <NAMEMEDIAs.com> does not consist of Plaintiff's legal name or a name commonly used to identify Plaintiff. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(II); *Coca-Cola*, 382 F.3d at 785.

(3) Plaintiff has no prior use of the domain name <NAMEMEDIAs.com> in connection with the bona fide offering of any goods or services. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(III); *Coca-Cola*, 382 F.3d at 785.

(4) Plaintiff is not making a bona fide noncommercial or fair use of the domain <NAMEMEDIAs.com>. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(IV); *Coca-Cola*, 382 F.3d at 786. Directly soliciting monetary contributions is a commercial use, as is linking to other sites that solicit monetary contributions. *Coca-Cola*, 382 F.3d at 786. Plaintiff directly solicits donations at <NAMEMEDIAs.com>. *See* Ex. C. He also provides links to his main website that offers his products for sale. *See id.* and Ex. D.

(5) Plaintiff intends to divert consumers and harm the goodwill of NameMedia's NAMEMEDIA trademark for commercial gain and with the intent to dilute NameMedia's NAMEMEDIA trademark by creating likelihood of confusion. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(V); *Coca-Cola*, 382 F.3d at 786. Plaintiff's intent to cause confusion is clear, as the first sentence on his website anticipates consumer confusion. *See* Ex. C. He also

demonstrates his intent to create confusion through search engines. *See* Ex. F. Plaintiff has been successful, as a Google search for NAMEMEDIA lists <NAMEMEDIAS.com> as the fifth result. *See* Ex. E.

(6) Plaintiff has offered to transfer the domain name for financial gain. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(V); *Coca-Cola*, 382 F.3d at 786. Profit includes any attempt to procure an advantageous gain or return. *Coca-Cola*, 382 F.3d at 786. Plaintiff makes his demand clear: “This could be over for something between thirty million and 100 million. I would even give you <NAMEMEDIAS.COM> . . . I would agree to never discuss domain names again.” *See* Ex. F. In the same communication, he stated that \$100 million will allow Name Media to silence his outrage. *See id.*

Other additional factors are particularly important in this case. Plaintiff has stated he will not obey any order of this Court regarding his use of the domain <NAMEMEDIAS.com>. *See* Ex. F. Plaintiff has stated that his intended purpose: “I want your company to be unable to exist. PERIOD!” *See id.* This is much more than just criticism; Plaintiff has no First Amendment right to destroy NameMedia’s business. Plaintiff also makes repeated demands for NameMedia employees to serve prison terms. *See* Ex. C and Ex. F.

Considering all facts in the light most favorable to NameMedia, and drawing all reasonable inferences in NameMedia’s favor, a genuine issue of material fact exists as to whether Plaintiff acted at least partially in bad faith. Plaintiff is not entitled to summary judgment on NameMedia’s counterclaim.

**CONCLUSION**

For the foregoing reasons, Plaintiff's motion for summary judgment, Docket # 50, should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Kevin Lemley, hereby certify that on this 16th day of February, 2010, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following attorneys of record:

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I hereby certify that, on this 16th day of February, 2010, I mailed a copy of the foregoing to the following *pro se* plaintiff:

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/s/ Kevin M. Lemley  
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