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FILED

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division**

2012 JAN -9 P 3: 31

CLERK US DISTRICT COURT
ALEXANDRIA, VIRGINIA

DOMAIN THE NET TECHNOLOGIES
LTD.,
81 Sokolov St.
Ramat Hasharon
Israel 47238

Plaintiff,

v.

KEY-SYSTEMS GMBH,
Prager Ring 4-12, Zweibrucken, 66482,
Germany

Defendant.

Civil No. 1:12cv25

LO/TCB

COMPLAINT

Plaintiff, Domain The Net Technologies Ltd. ("Plaintiff"), by and through counsel, brings this action against Defendant, Key-Systems GmbH ("Defendant"), prays for declaratory and injunctive relief against Defendant, and alleges as follows:

I. JURISDICTION AND VENUE

1. This is an action for a declaratory judgment of no trademark infringement and/or unfair competition, and of Plaintiff's right to continue to use its mark in connection with goods and services that it has offered in interstate commerce in the United States since at least as early as 2010.
2. This Court has subject matter jurisdiction under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338. The claims alleged in the Complaint arise under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and the Lanham Act, 15 U.S.C. §§ 1051 *et seq.*
3. On information and belief, this Court has personal jurisdiction over Defendant because the Defendant has sufficient contacts with this Judicial District subjecting it to the personal jurisdiction of this Court pursuant to the Lanham Act, and because Defendant has purposefully availed itself of this forum.

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4. Venue is proper in this Judicial District under 28 U.S.C §§ 1391 (b),(c) and.(d).

II. PARTIES

5. Plaintiff Domain The Net Technologies Ltd. is a company organized and existing under the laws of Israel with a place of business at 81 Sokolov St., Ramat-Hasharon, Israel 47238.

6. Upon information and belief, Defendant Key-Systems GmbH is a limited liability company organized and existing under the laws of Germany with a place of business at Prager Ring 4-12, Zweibrucken, 66482, Germany.

III. BACKGROUND

A. Plaintiff's products, services and marks

7. Plaintiff is a domain management, brand security and software development company specializing in providing domain registration, hosting services, domain management solutions and digital brand security software-as-a-service solutions to corporations and other premium customers.

8. Plaintiff established its company in the year 2000 and began offering its domain name related technologies in 2004.

9. Plaintiff markets and promotes its brand protection services under the BRANDSHIELD mark, including on its website at www.brandshield.com.

10. Plaintiff's BRANDSHIELD mark serves to identify and indicate the source of Plaintiff's products and services to consumers.

11. Plaintiff owns U.S. Trademark Application Serial No. 85311650 for the mark BRANDSHIELD for use in International Class 35 for "Business consultation in the field of domain name and intellectual property management and protection; Consulting regarding intellectual property business risk mitigation processes; Consulting services in the field of managing intellectual properties; Negotiation and settlement of commercial transactions for third parties; Trademark monitoring"; in International Class 42 for "Computer service, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of

1 intellectual property protection and monitoring and domain name security; Providing on-
2 line non-downloadable software for domain name security and intellectual property
3 monitoring”; and in International Class 45 for “Domain name registration services;
4 Domain name registration services, namely, conducting domain name searches for the
5 purpose of providing legal advice on domain name registration; Electronic monitoring
6 services for security purposes in the field of domain name services and domain name
7 protection; Intellectual property consultation; Intellectual property watch services;
8 Providing information in the field of intellectual property legal services; Providing
9 information in the field of intellectual property; Providing on-line information in the field
10 of intellectual property; Providing on-line information in the field of intellectual property
11 legal services; Trademark watch services.”

12 12. The application has been reviewed by an Examining Attorney in the U.S. Trademark
13 Office, who searched the register and has not found any confusingly similar marks that
14 would preclude Plaintiff’s registration in all three International Classes, stating that “no
15 conflicting marks would bar registration.” On October 4, 2011 the mark was allowed for
16 publication in the *Official Gazette* of the USPTO, and for registration on the Principal
17 Register if no opposition by any interested third party.

18 **B. Defendant’s Weak Mark**

19 13. Upon information and belief Defendant is the owner of U.S. Trademark Registration Nos.
20 3770352 and 3770353 for the word mark and design mark for BRANDSHELTER for
21 domain name monitoring and registration services for brand development purposes.

22 14. The term “Brand” as used in Defendant’s mark is the only similar component to
23 Plaintiff’s mark and is a generic and/or merely descriptive term commonly used as a part
24 of many companies’ trademarks that offer brand protection services

25 15. There are many active US trademark registrations and applications, not owned by
26 Defendant, that use the terms “Brand” followed by another term in connection with
27 domain services, advertising, brand consulting, management and protection services,
28 including but not limited to: BrandSafe, BrandStock, BrandSecure, BrandScore, Brand

1 Protectors, BrandDimensions, Brand Advocates, BrandCoach, BrandStock, BrandStack,
2 BrandBucket, Brands2Last, Brand Synthesis, Brands Realized, BrandDelivery, Brand
3 Habit, BrandWizard, BrandChannel, BrandStock, BrandPlanning, BrandULift,
4 BrandUSell, BrandUWorld, BrandiNar, Brandamentals, BrandPortrait, BrandCaster,
5 BrandEx, BrandCafe, BrandRituals, Brand Knew, Brandvironment,
6 BrandExchanger.com, BrandUWin, BrandCloud, BrandAds, BrandConnect,
7 BrandFluence, BrandPoint, BrandLaunch, BrandSherpa, Brand Groove, BrandSlam,
8 Brand Rjvntr, BrandWhale, BrandMobilization, BrandAwake, BrandTruth, BrandWare,
9 BrandRank, BrandRight, BrandSeeking, BrandReact, BrandEquation, BrandStart,
10 BrandJunkie, BrandCameo, BrandGarten, BrandZone, BrandLab and Brand Edge.

11 16. There are some 3,528 [three thousand five hundred twenty eight] live trademark records
12 in the US Patent and Trademark Office, covering marksthat contain the word BRAND,
13 all but two of which are not owned by Defendants.

14 17. During the application process for Defendant`s own marks, the examining attorney
15 assigned to its applications found no similar conflicting marks that would bar its
16 registration despite the prior registration of at least the following marks: Brand Armor,
17 BrandSafe, BrandSecure, BrandScore, Brand Protectors, BrandDefense,
18 BrandDimensions, Brand Advocates, BrandCoach, Brand Edge, BrandBucket,
19 BrandChannel, BrandCrawler, and BrandStock..

20 18. Plaintiff and Defendant use entirely different logos, typefaces, designs, graphics and
21 other trade dress, such that there can be no likelihood of confusion in the brand protection
22 services marketplace.

23 19. There are many BRAND+word marks in the relevant brand protection industry.
24 Consumers of brand protection services are highly sophisticated brand management
25 professionals who exercise an extremely high degree of care in selecting their brand
26 protection service providers. Such service contracts generally cost in the tens of
27 thousands of U.S. dollars per year, and are highly customized and negotiated agreements.
28 Defendant does not own and cannot rightfully claim exclusive rights to use of the word

1 BRAND, as used in a trademark or otherwise, in the brand protection services industry.

2 **C. Activities That Create a Justiciable Controversy**

3 20. On October 17, 2011, Defendant filed an Opposition proceeding with the USPTO
4 Trademark Trial and Appeal Board (“TTAB”) (Opp. No. 91202113), complaining that
5 Plaintiff’s trademark application should be rejected.

6 21. Defendant’s opposition before the TTAB alleges a prima facie case of trademark
7 infringement against Plaintiff by stating that Plaintiff’s mark “is likely to be confused
8 with Opposer’s existing registered marks” and “Applicant’s mark should not be
9 registered if it is likely to be confused with existing registered marks.” citing Lanham
10 Trademark Act, § 2(d), 15 U.S.C.A. § 1052(d).

11 22. Defendants have commenced this opposition action in the TTAB, where any issues
12 resolved could then be litigated anew in this Court. That could effectively duplicate costs
13 and process of both parties, and significantly extend the amount of time that damages
14 hypothetically would accrue in the extremely unlikely event that a judgment for
15 infringement was entered against Plaintiff.

16 23. Based upon the statements contained in the Opposition, and the fact that both parties have
17 used their marks in U.S. commerce since 2010, Plaintiff has a real and reasonable
18 apprehension that Defendant will sue Plaintiff for trademark infringement, despite the
19 fact that Defendant’s marks are weak and not likely to be confused with Plaintiff’s mark.

20 **IV. COUNT I**

21 **Declaration of *no* Trademark Infringement**

22 24. Plaintiff restates and re-alleges paragraphs 1-23 of this Complaint as though fully set
23 forth herein.

24 25. Plaintiff has a real and reasonable apprehension that it will be sued and/or subject to
25 substantial liability for trademark infringement under Section 32(1) of the Lanham Act,
26 15 U.S.C. § 1114(1), if Plaintiff continues its activities, including marketing and sales of
27 its products and services bearing the BRANDSHIELD mark without obtaining a
28 declaration of its rights.

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26. An actual and substantial controversy exists between Defendant and Plaintiff, which have adverse legal interests of sufficient immediacy and reality to warrant the issuance of a declaratory judgment pursuant to 28 U.S.C. §§ 2201-02.

27. There is no likelihood of confusion between Plaintiff's BRANDSHIELD mark and the BRANDSHELTER marks of the Defendant.

28. Plaintiff's use of its BRANDSHIELD trademark does not infringe Defendant's purported trademark rights.

29. Defendant is not entitled to injunctive relief or to any of the monetary remedies set forth in the Lanham Act.

V. COUNT II

Declaration of *no* Unfair Competition

30. Plaintiff restates and re-alleges paragraphs 1-29 of this Complaint as though fully set forth herein.

31. Plaintiff has a real and reasonable apprehension that it will be sued and/or subject to substantial liability for unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), if Plaintiff continues its activities, including marketing and sale of its products and services bearing the BRANDSHIELD mark without obtaining a declaration of its rights.

32. An actual and substantial controversy exists between Defendant and Plaintiff, which have adverse legal interests of sufficient immediacy and reality to warrant the issuance of a declaratory judgment pursuant to 28 U.S.C. §§ 2201-02.

33. Plaintiff's activities, including its use of its BRANDSHIELD mark, do not constitute unfair competition or infringement of Defendant's purported rights under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

34. Defendant is not entitled to injunctive relief or to any of the monetary remedies set forth in the Lanham Act.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Domain The Net Technologies Ltd. prays for judgment against

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Defendant as follows:

1. For a declaration from this Court that Plaintiff's BRANDSHIELD mark does not infringe the trademark rights or any purported rights of Defendant;
2. For a declaration from this Court that Plaintiff's activities, including its marketing and sale of its products and services bearing its BRANDSHIELD mark, does not constitute unfair competition under Lanham Act § 43(a), 15 U.S.C. § 1125(a);
3. For a declaration from this Court that Plaintiff's activities, including its marketing and sale of its products and services bearing its BRANDSHIELD mark, have not caused any harm to Defendant.
4. For a declaration from this Court that Plaintiff is entitled to use and register the BRANDSHIELD mark as set forth in its aforementioned application, and that Defendant is not entitled to enjoin or otherwise impair such use or registration;
5. For an injunction from this court precluding Defendant from interfering with Plaintiff's use of its BRANDSHIELD mark, including prohibiting Defendant from prosecuting any alleged trademark rights against Plaintiff, or otherwise interfering with the U.S. Patent and Trademark Office registration of the BRANDSHIELD mark;
6. For Plaintiff's costs of suit incurred, including, but not limited to reasonable attorneys' fees;
7. For such other relief to Plaintiff as this Court may deem just and proper.

DEMAND FOR JURY TRIAL

Plaintiff demands a trial by jury on all issues raised by this Complaint.

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Respectfully submitted,

Dated: January 9, 2012

By: 
Bruce Rheinstein (VSB No. 31578)
rheinstein@gmail.com
4125 Hampstead Lane
Woodbridge, VA 22192
Telephone: (253) 642-7823
Facsimile: (202) 944-3306

James L. Bikoff (D.C. Bar No. 209023)
jbikoff@sgbdc.com
Silverberg, Goldman & Bikoff LLP

David K. Heasley (D.C. Bar No. 375636)
dheasley@sgbdc.com
Silverberg, Goldman & Bikoff LLP
1101 30th Street NW
Washington, D.C. 20007
Telephone: (202) 944-3300
Facsimile: (202) 944-3306

Michael L. Rodenbaugh
(California Bar No. 179059)
mike@rodenbaugh.com
548 Market Street, #55819
San Francisco, CA 94104
(415) 738-8087 phone/fax

Attorneys for Plaintiff

DOMAIN THE NET TECHNOLOGIES LTD..

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

DOMAIN THE NET TECHNOLOGIES, LTD

(b) County of Residence of First Listed Plaintiff (EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number) (See attachment)

DEFENDANTS

KEY-SYSTEMS GMBH

County of Residence of First Listed Defendant (IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

Attorneys (If Known)

Peter N. Lobasso, Esq., Berenson LLP, 1146 Walker Road, Great Falls, VA 22066

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- 1 U.S. Government Plaintiff
2 U.S. Government Defendant
3 Federal Question (U.S. Government Not a Party)
4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- Citizen of This State
Citizen of Another State
Citizen or Subject of a Foreign Country
PTF DEF
1 1 Incorporated or Principal Place of Business in This State
2 2 Incorporated and Principal Place of Business in Another State
3 3 Foreign Nation
4 4
5 5
6 6

IV. NATURE OF SUIT (Place an "X" in One Box Only)

Table with columns: CONTRACT, REAL PROPERTY, CIVIL RIGHTS, TORTS, PRISONER PETITIONS, FORFEITURE/PENALTY, LABOR, IMMIGRATION, BANKRUPTCY, SOCIAL SECURITY, FEDERAL TAX SUITS, OTHER STATUTES. Includes various legal categories like Insurance, Personal Injury, Labor, etc.

V. ORIGIN (Place an "X" in One Box Only)

- 1 Original Proceeding
2 Removed from State Court
3 Remanded from Appellate Court
4 Reinstated or Reopened
5 Transferred from another district (specify)
6 Multidistrict litigation
7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing. (Do not cite jurisdictional statutes unless diversity): 15 USC 1051 et seq.; 28 USC 2201-2202

Brief description of cause: Declaratory judgment action in trademark case; injunctive relief sought, as well.

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23 DEMAND \$ CHECK YES only if demanded in complaint: JURY DEMAND: Yes No

VIII. RELATED CASE(S) IF ANY

(See instructions): JUDGE DOCKET NUMBER

DATE

01/09/2012

SIGNATURE OF ATTORNEY OF RECORD

Handwritten signature of Bruce Plewate

FOR OFFICE USE ONLY

RECEIPT # AMOUNT APPLYING IFP JUDGE MAG. JUDGE

Court Name: United States District Court
Division: 1
Receipt Number: 14683026410
Cashier ID: sbrown
Transaction Date: 01/09/2012
Payer Name: BRUCE RHEINSTEIN

CIVIL FILING FEE
For: BRUCE RHEINSTEIN
Amount: \$350.00

CHECK
Remitter: BRUCE RHEINSTEIN
Check/Honey Order Num: 3042
Amt Tendered: \$350.00

Total Due: \$350.00
Total Tendered: \$350.00
Change Amt: \$0.00

FILING FEE
112CV25