

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 TUCKER ELLIS LLP
David J. Steele - SBN 209797
2 david.steele@tuckerellis.com
Howard A. Kroll - SBN 100981
3 howard.kroll@tuckerellis.com
Steven E. Lauridsen - SBN 246364
4 steven.lauridsen@tuckerellis.com
515 South Flower Street
5 Forty-Second Floor
Los Angeles, CA 90071
6 Telephone: 213.430.3400
Facsimile: 213.430.3409
7
8 Attorneys for Plaintiff,
FACEBOOK, INC. and INSTAGRAM, LLC

9
10 **UNITED STATES DISTRICT COURT**
11 **NORTHERN DISTRICT OF CALIFORNIA**

12 FACEBOOK, INC. and INSTAGRAM, LLC

Case No. 3:19-cv-7071

13 Plaintiff,

**COMPLAINT FOR CYBERSQUATTING;
TRADEMARK INFRINGEMENT; FALSE
DESIGNATION OF ORIGIN; AND
DILUTION**

14 v.

15 ONLINENIC INC., DOMAIN ID SHIELD
SERVICE CO., LIMITED, and DOES 1-20

DEMAND FOR JURY TRIAL

16 Defendants.
17
18
19
20
21
22
23
24
25
26
27
28

1 Plaintiffs Facebook, Inc. (“Facebook”) and Instagram, LLC (“Instagram”) (collectively
2 “Plaintiffs”) by and through their attorneys, Tucker Ellis LLP, file their complaint against Defendants
3 OnlineNIC, Inc. (“OnlineNIC”), Domain ID Shield Service Co., Limited (“ID Shield”) (collectively
4 “Defendants”), and John Does 1-20 (“Doe Defendants”) for injunctive relief and damages.

5 INTRODUCTION

6 1. Cybercrime is highly dependent on registered domain names, which are used to send
7 spear phishing emails, operate malware, and engage in other types of online abuse. According to the
8 Internet Corporation of Assigned Names and Numbers (ICANN), as of July 31, 2019, there were over
9 800,000 resolving domain names used for phishing, malware, spam, and botnets.

10 2. Cybercriminals often rely on privacy services to hide their ownership and control of
11 malicious domains from the public. In exchange for a fee, privacy services conceal the domain name
12 registrant’s identity as listed on publicly available domain name registration records. These privacy
13 services, like the services offered by Defendants, are increasingly used by cybercriminals as they cycle
14 through domain names in order to conceal their identity and evade detection.

15 3. Defendant OnlineNIC is an ICANN-accredited domain name registrar and Defendant ID
16 Shield is its privacy protection service. According to one internet security group, domain names
17 registered by OnlineNIC were reported for abuse in approximately 40,000 instances. In 2019, one
18 internet security group reported that OnlineNIC was one of the top 20 domain name registrars used for
19 abuse.

20 4. Although accredited by ICANN, Defendants have repeatedly failed to take appropriate
21 “steps to investigate and respond appropriately to any reports of abuse” as required by the ICANN
22 Registrar Accreditation Agreement (“RAA”) and have failed to provide abusive domain name
23 registrants’ names and contact information to victims of online abuse as required under the RAA.

24 5. For years, the Doe Defendants, OnlineNIC and its alter ego ID Shield, as registrants,
25 registered domain names (such as [hackingfacebook.net](#)) that have been used for malicious activity,
26 including phishing and hosting websites that purported to sell hacking tools. These domain names also
27 have infringed on Plaintiffs’ trademarks. Plaintiffs have sent multiple notices to OnlineNIC providing
28 evidence of domain name abuse and infringement. Defendants did not address any of Plaintiffs’ notices.

1 6. Plaintiffs seek relief from OnlineNIC and its alter ego, ID Shield, who have registered (as
2 the registrant), used, and trafficked in domain names that include Plaintiffs' trademarks. Plaintiffs seek
3 damages and injunctive relief against Defendants to stop their ongoing unlawful and harmful conduct,
4 pursuant to the Lanham Act and the Anti-Cybersquatting Consumer Protection Act (15 U.S.C. § 1125).

5 **I. THE PARTIES**

6 7. Plaintiff Facebook, Inc. is a Delaware corporation with its principal place of business in
7 Menlo Park, California.

8 8. Plaintiff Instagram, LLC is a Delaware limited liability company with its principal place
9 of business in Menlo Park, California.

10 9. Defendant OnlineNIC Inc. is a California corporation with its principal place of business
11 in San Leandro, California. Defendant OnlineNIC is a domain name registrar that sells, registers and
12 transfers domain names for third parties.

13 10. Defendant ID Shield, is a Hong Kong limited company. Defendant ID Shield is
14 OnlineNIC's domain name privacy service, which registered domain names in the name of ID Shield on
15 publicly available domain name registration records.

16 11. At all times material to this action, OnlineNIC and ID Shield are instrumentalities and
17 alter egos of each other. OnlineNIC is also the direct participant in the actions of ID Shield as alleged in
18 this Complaint.

19 12. Plaintiffs have not identified the Defendants referred to as the Doe Defendants. The Doe
20 Defendants are individuals or entities who have registered, or caused to be registered, domain names
21 that infringe on Plaintiffs' trademarks. Plaintiffs reserve the right to amend this complaint to allege such
22 Defendants' true names and capacities when they are ascertained.

23 **II. JURISDICTION AND VENUE**

24 13. The Court has federal question jurisdiction over the federal causes of action alleged in
25 this complaint pursuant to 28 U.S.C. § 1331.

26 14. The Court has personal jurisdiction over Defendant OnlineNIC, and its alter ego ID
27 Shield, because OnlineNIC maintained and operated business in California.

28 15. Each of the Doe Defendants has entered into one or more contracts for domain name

1 registration services used in connection with Defendants’ unlawful scheme; a material term of these
 2 contracts was Defendants’ agreement to submit to the Court’s jurisdiction. A copy of the domain name
 3 registration agreement is attached to this Complaint as Exhibit 1. Accordingly, the Court has personal
 4 jurisdiction over each of the Doe Defendants.

5 16. The Court has personal jurisdiction over the Defendants and the Doe Defendants because
 6 each of them knowingly directed and targeted parts of their unlawful scheme at Plaintiffs, which have
 7 their principal places of business in California. Defendants and the Doe Defendants also transacted
 8 business and engaged in commerce in California.

9 17. Venue is proper with respect to each of the Defendants pursuant to 28 U.S.C. §1391(b)(2)
 10 because a substantial part of the events and omissions giving rise to the claims alleged occurred in this
 11 district.

12 18. Pursuant to Civil L.R. 3-2(c), this case is exempt from the Court’s division-specific venue
 13 rule because it involves intellectual property rights.

14 **III. FACTUAL ALLEGATIONS**

15 **A. Background on Plaintiffs and their Trademarks**

16 19. Facebook offers a social networking website and mobile application that enables its users
 17 to create their own personal profiles and connect with each other on their personal computers and mobile
 18 devices.

19 20. Facebook owns the exclusive rights to several trademarks and service marks to provide
 20 its online services, including the distinctive FACEBOOK word mark and stylized mark, and has used
 21 the marks in connection with its services since 2004.

22 21. In addition to its extensive common law rights, Facebook owns numerous United States
 23 registrations for its FACEBOOK marks, including:

- 24 a. United States Registration Number 3,122,052; and
- 25 b. United States Registration Number 3,881,770.

26 Copies of these registration certificates are attached to this Complaint as Exhibit 2. Facebook’s
 27 common law and registered trademarks are collectively referred to as the “Facebook Trademarks.”

28 22. Facebook’s use of the Facebook Trademarks in interstate commerce has been extensive,

1 continuous, and substantially exclusive. Facebook has made, and continues to make, a substantial
2 investment of time, effort, and expense in the promotion of Facebook and the Facebook Trademarks.
3 As a result of Facebook's efforts and use, the Facebook Trademarks are famous (and have been famous
4 since at least as early as 2011) as they are recognized within the US and around the world as signifying
5 high-quality, authentic goods and services provided by Facebook.

6 23. Instagram offers a photo and video sharing and editing service, mobile application, and
7 social network. Instagram users can choose to share their photos and videos with their followers online.

8 24. Instagram owns the exclusive rights to the distinctive INSTAGRAM word mark and
9 stylized mark, having used the marks in connection with its goods and services as early as 2010.

10 25. In addition to its extensive common law rights, Instagram owns numerous United States
11 registrations for the INSTAGRAM marks, including:

- 12 c. United States Registration Number 4,795,634;
- 13 d. United States Registration Number 4,146,057;
- 14 e. United States Registration Number 4,756,754;
- 15 f. United States Registration Number 5,566,030;
- 16 g. United States Registration Number 4,170,675;
- 17 h. United States Registration Number 4,856,047;
- 18 i. United States Registration Number 4,822,600;
- 19 j. United States Registration Number 4,827,509;
- 20 k. United States Registration Number 4,863,595; and
- 21 l. United States Registration Number 5,019,151.

22 Copies of these registration certificates are attached to this Complaint as Exhibit 3. Instagram's common
23 law and registered trademark rights are collectively referred to as the "Instagram Trademarks."

24 26. Instagram's use of the Instagram Trademarks in interstate commerce has been extensive,
25 continuous, and substantially exclusive. Instagram has made, and continues to make, a substantial
26 investment of time, effort, and expense in the promotion of Instagram and the Instagram Trademarks. As
27 a result of Instagram's efforts and use, the Instagram Trademarks are famous (and have been famous
28

1 since at least as early as 2014) as they are recognized within the US and around the world as signifying
2 high-quality, authentic goods and services provided by Instagram.

3 **B. OnlineNIC is Responsible for the Actions of ID Shield**

4 27. Defendant OnlineNIC is accredited by ICANN and subject to ICANN's RAA. A copy of
5 the RAA is attached to this Complaint as Exhibit 4

6 28. Defendant ID Shield provides a domain name registration privacy service on behalf of
7 Defendant OnlineNIC. ID Shield is the registrant of the domain name, and is listed as the registrant in
8 the WHOIS directory.

9 29. OnlineNIC controls certain business operations of ID Shield. ID Shield registers domain
10 names as the registrant, and licenses these domain names either to OnlineNIC for its use or to
11 OnlineNIC's customers for their use. OnlineNIC's website refers to ID Shield's services as "OnlineNIC
12 ID Shield." A screen capture of OnlineNIC's "Domain Privacy" page from its website is attached to this
13 Complaint as Exhibit 5.

14 30. The ID Shield Service Agreement, found on the OnlineNIC website, is attached to this
15 Complaint as Exhibit 6. According to the ID Shield Service Agreement, "[i]f you subscribe to the IDS
16 Services, each domain name registration which you control and which [uses the ID Shield service] will
17 thereafter be registered in the name of [ID Shield], as registrant."

18 31. According to ID Shield's "About Us" webpage "OnlineNIC, Inc. [sic] is an internet
19 services company that provides . . . internet services, including domain name service and other related
20 services." A copy of ID Shield's "About Us" webpage is attached to this Complaint as Exhibit 7.

21 32. ID Shield and OnlineNIC are managed by the same President and VP of Business
22 Development. A copy of OnlineNIC's "About Us" webpage is attached to this Complaint as Exhibit 8;
23 *compare* Exhibit 7 with Exhibit 8.

24 33. OnlineNIC's customers purchase and pay for the ID Shield services directly from their
25 OnlineNIC user account. ID Shield's "Payment Info" webpage indicates that payments to ID Shield
26 should be processed through the customer's OnlineNIC user account. Customers wishing to close their
27 account should email sales@onlinenic.com ("Please contact our sales at sales@onlinenic.com if you
28 wish to close your account.") *See* Exhibit 9.

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 34. ID Shield and OnlineNIC share the same technical support staff, and technical support
2 services are provided by the same person(s). A copy of ID Shield’s help webpage (listing OnlineNIC
3 and its phone numbers and email addresses) is attached to this Complaint as Exhibit 10.

4 35. The domain names domainidshield.com and onlinenic.com are hosted on the same IP
5 address. Defendants’ websites contain links to each other.

6 36. OnlineNIC and ID Shield are instrumentalities and alter egos of each other. OnlineNIC is
7 also the direct participant in the actions of ID Shield as alleged in this Complaint.

8 **C. Defendants Registered, Used, or Trafficked In the Infringing Domain Names**

9 37. OnlineNIC and ID Shield registered, used, or trafficked in, at least the following 20
10 domain names that are identical or confusingly similar to the Facebook Trademarks and the Instagram
11 Trademarks (the “Infringing Domain Names”):

- | | |
|----------------------------------|------------------------------|
| 12 i. facebook-fans-buy.com | xi. trollfacebook.com |
| 13 ii. facebook-mails.com | xii. www-facebook-login.com |
| 14 iii. facebook-pass.com | xiii. www-facebook-pages.com |
| 15 iv. facebook-pw.com | xiv. buyinstagramfans.com |
| 16 v. facebookphysician.com | xv. instaface.org |
| 17 vi. facebookvideodownload.net | xvi. instagram01.com |
| 18 vii. findfacebookid.com | xvii. iiinstagram.com |
| 19 viii. hackingfacebook.net | xviii. login-lnstagram.com |
| 20 ix. hacksomeonesfacebook.com | xix. m-facebook-login.com |
| 21 x. lamsocialfacebook.net | xx. singin-lnstagram.com |

22 38. ID Shield is the registrant for each of the Infringing Domain Names. A copy of WHOIS
23 entries for each of the Infringing Domain Names is attached to this Complaint as Exhibit 11.

24 39. Upon information and belief, each of the Infringing Domain Names was registered on
25 behalf of the Doe Defendants or OnlineNIC using Defendants’ registration services and privacy
26 services.

27 40. ID Shield trafficked in the Infringing Domain Names by licensing these domain names
28 either to OnlineNIC for its use or to OnlineNIC’s customers for their use.

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 **D. Defendants’ Bad Faith Intent to Profit**

2 41. OnlineNIC has a history of cybersquatting on famous and distinctive trademarks.

3 42. On or about December 19, 2008, OnlineNIC was found liable for registering over 600
4 domain names that were confusingly similar to the VERIZON mark. In the *Verizon* case, the Court
5 awarded \$33.15 million in damages and denied OnlineNIC’s motion to set aside or reduce the judgment.

6 43. On or about December 19, 2008, Yahoo! Inc. alleged in a separate action that OnlineNIC
7 registered at least 554 domain names that were identical or confusingly similar to its trademarks.

8 44. On or about October 7, 2008, Microsoft Corporation alleged in a separate action that
9 OnlineNIC registered at least 97 domain names that were identical or confusingly similar to its
10 trademarks.

11 45. OnlineNIC has been named in administrative complaints filed under the Uniform
12 Domain-Name Dispute-Resolution Policy (“UDRP”). In many of these UDRP cases, OnlineNIC has
13 verified to the dispute providers that OnlineNIC itself was the registrant of the domain name at issue in
14 the complaint.

15 46. OnlineNIC has operated under one or more aliases, including “Junlong Zhen,”
16 “lenawoo,” and “China-Channel,” to hide its involvement in registering as a registrant, using, and
17 trafficking in infringing domain names.

18 47. OnlineNIC and ID Shield profit from the sale of the ID Shield service, including
19 providing the service to the Doe Defendants and to OnlineNIC. OnlineNIC and ID Shield profit from the
20 sale of the ID Shield service by collecting fees from the sale of that service.

21 48. The users of the Infringing Domain Names, which, upon information and belief, included
22 Defendants and the Doe Defendants, intended to divert consumers to websites using domain names that
23 were confusingly similar to the Facebook Trademarks and the Instagram Trademarks. In some instances,
24 the Infringing Domain Names have been used for malicious activity, including to host websites directing
25 visitors to other commercial sites, phishing, selling purported tools for hacking. Screenshots of several
26 of these websites hosted at the Infringing Domain Names are attached to this Complainant as Exhibit 12.

27 49. Defendants also used some of the Infringing Domain Names in connection with email
28 services, which is usually an indication that the domain name was used for phishing or other scams.

1 Specifically, at least the following domain names had domain name servers configured to facilitate
 2 email: facebook-mails.com, facebook-pass.com, facebook-pw.com, facebookvideodownload.net,
 3 findfacebookid.com, hackingfacebook.net, hacksomeonesfacebook.com, login-Instagram.com, m-
 4 facebook-login.com, singin-Instagram.com, and trollfacebook.com.

5 50. Defendants have registered multiple domain names that they know are identical or
 6 confusingly similar to marks of others that were distinctive at the time of registration of the domain
 7 names, or dilutive of famous marks of others that were famous at the time of registration of the domain
 8 names. A table showing examples of some of Defendants' registered domains is attached as Exhibit 13.

9 51. Plaintiffs' Facebook Trademarks and Instagram Trademarks were distinctive and famous,
 10 when Defendants registered, used or trafficked in the Infringing Domain Names.

11 **E. OnlineNIC's and ID Shield's Failure to Disclose Contact Information**

12 52. Under the RAA, OnlineNIC agreed that ID Shield "shall accept liability for harm caused
 13 by wrongful use of the Registered Name, unless it discloses the current contact information provided by
 14 the licensee and the identity of the licensee within seven (7) days to a party providing [ID Shield]
 15 reasonable evidence of actionable harm." *See* Exhibit 4.

16 53. OnlineNIC and ID Shield's service agreements anticipate that they will be sued for
 17 misuse of domain names, including for trademark infringement and cybersquatting, and require parties
 18 to their respective agreements to indemnify against such claims. *See* Exhibits 1 and 6.

19 54. ID Shield service agreement states (twice) that it will cancel its proxy service if a domain
 20 name is alleged to infringe on a third party's trademark or if it receives valid evidence of trademark
 21 infringement. *See* Exhibit 6.

22 55. Between April 23, 2019 and August 12, 2019, Plaintiffs' authorized representatives sent
 23 at least 5 notices to ID Shield with evidence that each of the Infringing Domain Names caused Plaintiffs
 24 actionable harm and requesting that ID Shield disclose the identities of the registrant(s) ("Plaintiffs'
 25 Notices"). For example:

26 a. On April 23, 2019 Plaintiffs' authorized representatives sent notice regarding www-
 27 facebook-login.com.

28 b. On May 2, 2019, Plaintiffs' authorized representatives sent notice regarding: facebook-

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 fans-buy.com, facebook-pass.com, facebookphysician.com, facebook-pw.com,
2 iamsocialfacebook.net, and iiinstagram.com.

3 c. On May 14, 2019, Plaintiffs’ authorized representatives sent notice regarding: facebook-
4 mails.com, facebookvideodownload.net, findfacebookid.com, instagram01.com, m-
5 facebook-login.com, and www-facebook-pages.com.

6 d. On June 3, 2019, Plaintiffs’ authorized representatives sent notice regarding:
7 buyinstagramfans.com, hackingfacebook.net, hacksomeonesfacebook.com, login-
8 Instagram.com, singin-lnstagram.com, and trollfacebook.com.

9 e. On August 12, 2019, Plaintiffs’ authorized representatives sent notice regarding
10 instaface.org.

11 56. ID Shield failed to disclose the identity or any contact information of the licensee when
12 presented with reasonable evidence of actionable harm by Plaintiffs or their authorized representatives
13 that one or more domain names infringed or cybersquatted on the Facebook Trademarks and Instagram
14 Trademarks.

15 57. ID Shield failed to even respond to Plaintiffs’ Notices.

16 **FIRST CAUSE OF ACTION**

17 **[Cybersquatting on Plaintiffs’ Trademarks Under 15 U.S.C. § 1125(d)]**

18 58. Plaintiffs reallege and incorporate by reference all of the preceding paragraphs.

19 59. The Facebook Trademarks and Instagram Trademarks (collectively, “Plaintiffs’
20 Trademarks”) were distinctive or famous and federally registered at the United States Patent and
21 Trademark Office at the time Defendants registered, used, and trafficked in the Infringing Domain
22 Names.

23 60. One or more of the Infringing Domain Names are confusingly similar to Plaintiffs’
24 Trademarks.

25 61. One or more of the Infringing Domain Names are dilutive of the Facebook Trademarks or
26 Instagram Trademarks.

27 62. Defendants registered (as the registrant), used, or trafficked in one or more of the
28 Infringing Domain Names with a bad faith intent to profit from Plaintiffs’ Trademarks.

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 63. Defendants do not have any trademark or other intellectual property rights in the
2 Infringing Domain Names.

3 64. The Infringing Domain Names do not consist of the legal name of either of the
4 Defendants, nor do they consist of a name that is otherwise commonly used to identify them.

5 65. Defendants have not made any prior use of any of the Infringing Domain Names in
6 connection with the *bona fide* offering of any goods or services.

7 66. Defendants have not made any *bona fide* noncommercial or fair use of Plaintiffs'
8 Trademarks on a website accessible at any of the Infringing Domain Names.

9 67. Defendants registered (as the registrant), used, and trafficked in one or more of the
10 Infringing Domain Names to divert consumers from Plaintiffs' legitimate websites to a website
11 accessible under the Infringing Domain Names for Defendants' commercial gain by creating a
12 likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of their websites.

13 68. Defendants' registration, use, and/or trafficking in the Infringing Domain Names
14 constitutes cybersquatting in violation of 15 U.S.C. § 1125(d), entitling Plaintiffs to relief.

15 69. Plaintiffs' remedy at law is not adequate to compensate it for the injuries Defendants
16 inflicted on Plaintiffs. Accordingly, Plaintiffs are entitled to permanent injunctive relief pursuant to
17 15 U.S.C. § 1116.

18 70. Plaintiffs are entitled to recover Defendants' profits, Plaintiffs' actual damages, and the
19 costs of this action. Instead of actual damages and profits, Plaintiffs may alternatively elect to an award
20 of statutory damages under 15 U.S.C. § 1117(d) in an amount of \$100,000 per domain name.

21 71. This is an exceptional case, entitling Plaintiffs to an award of reasonable attorneys' fees
22 under 15 U.S.C. § 1117.

23 **SECOND CAUSE OF ACTION**

24 **[Trademark and Service Mark Infringement of**
25 **Plaintiffs' Trademarks Under 15 U.S.C. § 1114]**

26 72. Plaintiffs reallege and incorporate by reference all of the preceding paragraphs.

27 73. Defendants have used Plaintiffs' Trademarks in interstate commerce. Defendants' use of
28 Plaintiffs' Trademarks is likely to cause confusion, mistake, or deception as to the origin, sponsorship,

1 or approval by Plaintiffs of Defendants' websites.

2 74. The above-described acts of Defendants constitute trademark and service mark
3 infringement in violation of 15 U.S.C. § 1114(1) and entitle Plaintiffs' to relief.

4 75. Defendants have unfairly profited from the alleged trademark and service mark
5 infringement.

6 76. By reason of Defendants' acts of trademark and service mark infringement, Plaintiffs
7 have suffered damage to the goodwill associated with Plaintiffs' Trademarks.

8 77. Defendants have irreparably harmed Plaintiffs and, if not enjoined, will continue to
9 irreparably harm Plaintiffs and their federally registered trademarks and service marks.

10 78. Defendants have irreparably harmed the general public and, if not enjoined, will continue
11 to irreparably harm the general public, which has an interest in being free from confusion, mistake, and
12 deception.

13 79. Plaintiffs' remedy at law is not adequate to compensate them for the injuries inflicted by
14 Defendants. Accordingly, Plaintiffs are entitled to permanent injunctive relief pursuant to
15 15 U.S.C. § 1116.

16 80. Plaintiffs are entitled to recover Defendants' profits, Plaintiffs', actual damages, and the
17 costs of this action. Plaintiffs' are also entitled to have their damages trebled under 15 U.S.C. § 1117(a).

18 81. This is an exceptional case, making Plaintiffs eligible for an award of reasonable
19 attorneys' fees pursuant to 15 U.S.C. § 1117(a).

20 **THIRD CAUSE OF ACTION**

21 **[Trademark and Service Mark Infringement of Plaintiffs' Trademarks**
22 **and False Designation of Origin Under 15 U.S.C. § 1125(a)]**

23 82. Plaintiffs reallege and incorporate by reference all of the preceding paragraphs.

24 83. Plaintiffs' Trademarks are distinctive marks that are associated with Plaintiffs and
25 exclusively identify their respective businesses, products, and services.

26 84. Defendants' use in commerce of Plaintiffs' Trademarks, and variations thereof, is likely
27 to cause confusion, or to cause mistake, or to deceive the relevant public that Defendants' goods and
28 services are authorized, sponsored, or approved by, or are affiliated with, Plaintiffs.

1 85. Defendants' acts constitute trademark and service mark infringement of Plaintiffs'
2 Trademarks, as well as false designation of origin, in violation of 15 U.S.C. § 1125(a), entitling
3 Plaintiffs to relief.

4 86. Defendants have unfairly profited from their conduct.

5 87. By reason of the above-described acts of Defendants, Plaintiffs have suffered damage to
6 the goodwill associated with Plaintiffs' Trademarks.

7 88. Defendants have irreparably harmed Plaintiffs and, if not enjoined, will continue to
8 irreparably harm Plaintiff and Plaintiffs' Trademarks.

9 89. Defendants have irreparably harmed the general public and, if not enjoined, will continue
10 to irreparably harm the general public, which has an interest in being free from confusion, mistake, and
11 deception.

12 90. Plaintiffs' remedy at law is not adequate to compensate it for the injuries inflicted by
13 Defendants. Accordingly, Plaintiffs are entitled to permanent injunctive relief pursuant to
14 15 U.S.C. § 1117.

15 91. Plaintiffs are entitled to recover Defendants' profits, Plaintiffs', actual damages, and the
16 costs of this action. Plaintiffs' are also entitled to have their damages trebled under 15 U.S.C. § 1117(a).

17 92. This is an exceptional case, making Facebook eligible for an award of reasonable
18 attorneys' fees pursuant to 15 U.S.C. § 1117.

19 **FOURTH CAUSE OF ACTION**

20 **[Dilution of the Facebook Trademarks and Instagram Trademarks Under 15 U.S.C. § 1125(c)]**

21 93. Facebook and Instagram reallege and incorporate by reference all of the preceding
22 paragraphs.

23 94. The Facebook Trademarks and Instagram Trademarks are famous, as that term is used in
24 15 U.S.C. § 1125(c), and they were famous before Defendants' use of them and variations of the
25 trademarks in commerce. This fame is based on, among other things, the inherent distinctiveness and
26 federal registration of each of the Facebook Trademarks and Instagram Trademarks as well as the
27 extensive and exclusive worldwide use, advertising, promotion, and recognition of them.

28 95. Defendants' use of the Facebook Trademarks and Instagram Trademarks, and variations

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 thereof, in commerce is likely to cause dilution by blurring or dilution by tarnishment of these
2 trademarks.

3 96. Defendants' acts constitute dilution by blurring and dilution by tarnishment in violation
4 of 15 U.S.C. § 1125(c), entitling Facebook and Instagram to relief.

5 97. Defendants have unfairly profited from their conduct.

6 98. Defendants damaged the goodwill associated with the Facebook Trademarks and the
7 Instagram Trademarks and they will continue to cause irreparable harm.

8 99. Facebook's and Instagram's remedy at law is not adequate to compensate them for the
9 injuries inflicted by Defendants. Accordingly, Facebook and Instagram are entitled to permanent
10 injunctive relief pursuant to 15 U.S.C. § 1116.

11 100. Because Defendants' acted willfully, Facebook and Instagram are entitled to damages,
12 and those damages should be trebled pursuant to 15 U.S.C. § 1117.

13 101. This is an exceptional case, making Plaintiffs eligible for an award of attorneys' fees
14 pursuant to 15 U.S.C. § 1117.

15 **REQUEST FOR RELIEF**

16 WHEREFORE, Plaintiffs request judgment against Defendants as follows:

17 1. That the Court enter a judgment against Defendants that Defendants have:

18 a. Infringed the rights of Plaintiffs in the federally registered Facebook Trademarks,
19 and Instagram Trademarks, in violation of 15 U.S.C. § 1125(d).

20 b. Infringed the rights of Plaintiffs in the federally registered Facebook Trademarks
21 and Instagram Trademarks, in violation of 15 U.S.C. § 1114(1);

22 c. Infringed the rights of Plaintiffs in the federally registered Facebook Trademarks
23 and Instagram Trademarks, in violation of 15 U.S.C. § 1125(a);

24 d. Infringed the rights of Plaintiffs in the federally registered Facebook Trademarks
25 and Instagram Trademarks, in violation of 15 U.S.C. § 1125(c).

26 2. That each of the above acts was willful.

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 3. That the Court issue a permanent injunction enjoining and restraining Defendants and
2 their agents, employees, successors, and assigns, and all other persons acting in concert with or in
3 conspiracy with or affiliated with Defendants, from:

4 a. Registering, using, or trafficking in any domain name that is identical or
5 confusingly similar to the Facebook Trademarks or the Instagram Trademarks;

6 b. Engaging in any use, including advertising, promoting, marketing, franchising,
7 selling, and offering for sale any goods or services, on or in connection with the Facebook Trademarks
8 or the Instagram Trademarks, or any similar mark or designation, that is likely to cause confusion, or to
9 cause mistake as to the affiliation of that use with Plaintiffs; and

10 c. Engaging in any activity which lessens the distinctiveness or tarnishes the
11 Facebook Trademarks or the Instagram Trademarks.

12 4. That Plaintiffs be awarded damages for Defendants’ trademark infringement and false
13 designation of origin and that these damages be trebled due to Defendants’ willfulness, in accordance
14 with the provisions of 15 U.S.C. § 1117.

15 5. That Defendants be ordered to account for and disgorge to Plaintiffs all amounts by
16 which Defendants have been unjustly enriched by reason of the unlawful acts complained of.

17 6. That Plaintiffs be awarded \$100,000 in statutory damages per infringing domain name by
18 reason of Defendants’ cybersquatting in accordance with the provisions of 15 U.S.C. § 1117.

19 7. That Plaintiffs be awarded an amount sufficient to reimburse Plaintiffs for the costs of
20 corrective advertising.

21 8. That Plaintiffs be awarded prejudgment interest on all infringement damages.

22 9. That the Court award Plaintiffs their reasonable attorneys’ fees pursuant to
23 15 U.S.C. § 1117 and any other applicable provision of law.

24 10. That the Court award Plaintiffs their costs of suit incurred herein.

25 11. That the Court award such other or further relief as the Court may deem just and proper.

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

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

DATED: October 28, 2019

Tucker Ellis LLP

By: /s/David J. Steele
David J. Steele
Howard A. Kroll
Steven E. Lauridsen

Attorneys for Plaintiffs,
FACEBOOK, INC. and INSTAGRAM, LLC

Platform Enforcement and Litigation
Facebook, Inc.
Jessica Romero
Nikya Williams
Olivia Gonzalez

DEMAND FOR TRIAL BY JURY

Plaintiffs Facebook, Inc. and Instagram, LLC, hereby demand a trial by jury to decide all issues so triable in this case.

DATED: October 28, 2019

Tucker Ellis LLP

By: /s/David J. Steele
David J. Steele
Howard A. Kroll
Steven E. Lauridsen

Attorneys for Plaintiffs,
FACEBOOK, INC. and INSTAGRAM, LLC,

Platform Enforcement and Litigation
Facebook, Inc.
Jessica Romero
Nikky Williams
Olivia Gonzalez

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

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