

1 WO

2  
3  
4  
5  
6 **IN THE UNITED STATES DISTRICT COURT**  
7 **FOR THE DISTRICT OF ARIZONA**  
8

9 David Dent,

10 Plaintiff,

11 v.

12 Lotto Sport Italia SpA,

13 Defendant.

No. CV-17-00651-PHX-DMF

**ORDER**

14  
15  
16 Plaintiff filed his Complaint on March 3, 2017. (Doc. 1)<sup>1</sup> Count One requests a  
17 finding that Plaintiff's registration and/or use of domain names <lottostore.com> and  
18 <lottoworks.com> is not unlawful pursuant to a claim of reverse domain name hijacking  
19 under the Anticybersquatting Consumer Protection Act ("ACPA") provisions of the  
20 Lanham Act in 15 U.S.C. §§ 1114(2)(D)(v)<sup>2</sup>. (*Id.* at 9-10) Count Two requests declaratory  
21 relief that Plaintiff's registration and/or use of the domain names <lottostore.com> and

22  
23 <sup>1</sup> Citations to the record indicate documents as displayed in the official electronic document  
24 filing system maintained by the District of Arizona under Case Number CV-17-00651-  
PHX-DMF.

25 <sup>2</sup> Count One originally alleged violation of both § 1114(2)(D)(iv) and § 1142(2)(D)(v).  
26 (Doc. 1 at 9-10) On February 12, 2018, District Judge Silver found that § 1114(2)(D)(iv)  
27 and § 1114(2)(D)(v) define separate violations, and that only § 1114(2)(D)(v) addresses  
28 reverse domain name hijacking. (Doc. 17 at 4) Judge Silver concluded that Plaintiff had  
failed to state a claim under § 1114(2)(D)(iv) for fraud in a domain dispute proceeding and  
dismissed any claim under that subsection. (*Id.*)

1 <lottoworks.com> does not violate Defendant’s rights under the Lanham Act. (*Id.* at 10-  
2 12 (citing 15 U.S.C. § 1125(d)(1))) Count Three alleged tortious interference and was  
3 dismissed in February 2018, with leave to amend if deficiencies in the claim were cured.  
4 (Docs. 1, 17) Plaintiff did not file an amended complaint. Plaintiff and Defendant each  
5 move for summary judgment on the remaining claims in Counts One and Two. (Docs. 83,  
6 86)

7 The remaining claims in Plaintiff’s Complaint request: (1) a declaration “that  
8 [P]laintiff’s registration, ownership and use of the Domain Names <lottostore.com> and  
9 <lottoworks.com> is lawful and proper and does not infringe on any right the Defendant  
10 may claim in the United States”; (2) his “costs and expenses, including costs under 15  
11 U.S.C. § 1114(2)(D)(v) and reasonable attorneys’ fees”; and (3) “an award of statutory  
12 damages in the amount of not less than \$1,000 and not more than \$100,000 per domain  
13 name, as the court considers just” pursuant to 15 U.S.C. § 1117(d). (Doc. 1 at 13) In  
14 Plaintiff’s briefing associated with the parties’ cross-motions for summary judgment,  
15 Plaintiff argues he is entitled to attorneys’ fees (Doc. 86 at 20, Doc. 91 at 18-19, Doc. 96  
16 at 13), but does not urge entitlement to statutory damages under 15 U.S.C. § 1117(d).

17 Plaintiff David Dent’s and Defendant Lotto Sport Italia’s cross-motions for  
18 summary judgment are fully briefed. (Docs. 83, 91, 95, 86, 89, 96) For the reasons that  
19 follow, Plaintiff’s motion for summary judgment (Doc. 86) will be granted and  
20 Defendant’s motion for summary judgment (Doc. 83) will be denied.

## 21 I. BACKGROUND

22 Plaintiff has been engaged in the gaming industry for approximately twenty years.  
23 (Doc. 87, Plaintiff’s Statement of Facts “PSOF” ¶¶ 3-16) Plaintiff’s experience includes  
24 ownership, development, and management of online gaming companies based in Canada,  
25 the Isle of Man, and Gibraltar. (*Id.* at ¶¶ 3-11) In 2015 and 2016, Plaintiff discussed with  
26 associates a business model for entry into the secondary lottery industry. (*Id.* at ¶¶ 19-23)  
27 In June 2016, Plaintiff began negotiations to purchase the domain name <lottostore.com>,  
28 which Plaintiff avers was in support of his planned entry into the secondary lottery

1 industry. (*Id.* at ¶ 24) The original owner registered this domain name in January 2011.  
2 (Docs. 87 at ¶ 100, 90 at ¶ 100) In September 2016, Plaintiff purchased the domain name  
3 <lottostore.com>, which was transferred to his account with GoDaddy, an internet domain  
4 name registrar. (Doc. 87 at ¶¶ 28-29) Plaintiff declares he planned to establish a holding  
5 company, an online consumer lottery store using the domain name <lottostore.com> as its  
6 website, and a business to act as a bookmaking entity which would “hold the license and  
7 jackpot insurance, set odds/prices, and develop and manage the lottery products and  
8 services offered at lottostore.com.” (*Id.* at ¶ 32)

9 In October 2016, Plaintiff began negotiations to acquire the additional domain name  
10 <lottoworks.com> to be used by the bookmaking company he planned. (*Id.* at ¶¶ 33-34)  
11 The original owner had registered this domain name in July 1998. (Docs. 87 at ¶ 99, 90 at  
12 ¶ 99) Plaintiff purchased the <lottoworks.com> domain name in December 2016. (Doc.  
13 87 at ¶ 43) Shortly thereafter, Defendant filed a World Intellectual Property Organization  
14 (“WIPO”) complaint against the use of domain name <lottoworks.com> causing GoDaddy  
15 to lock this domain name. (*Id.* at ¶¶ 48-49)

16 Defendant Lotto currently manufactures, markets, and distributes athletic footwear,  
17 sportswear, and sports accessories to over 110 countries, including the United States.  
18 (Doc. 84, Defendant’s Statement of Facts “DSOF” at ¶¶ 2-3) Defendant was founded in  
19 1973 and took its name from the final five letters of Caberlotto, the last name of the  
20 company’s founder. (*Id.* at ¶ 1) Defendant asserts it has been world famous for decades,  
21 having been endorsed by famous athletes in the 1980s and having sponsored teams and  
22 athletes in professional tennis and national soccer clubs since the 1990s. (*Id.* at ¶ 4)  
23 Defendant offers its products on the internet as well as in retail stores, and says it uses  
24 <lottosport.com> as its primary domain name, which was registered in 1996. (*Id.* at ¶ 6)  
25 Defendant has been using the LOTTO WORKS mark internationally for more than ten  
26 years after it received registration for that mark in the European Union in August 2009.  
27 (*Id.* at ¶¶ 7, 10) On March 6, 2018, Defendant obtained registration of the trademark  
28 LOTTO WORKS with the United States Patent and Trademark Office (“USPTO”) for

1 materials related to eyeglasses and clothing (shoes are included in the clothing category).  
2 (*Id.* at ¶ 9, Doc. 84-9 at 2)<sup>3</sup> Defendant does not have trademark rights in the term “lotto”  
3 for gambling or lottery. (Docs. 87 at ¶ 82, 90 at ¶ 82)

4 Shortly after Plaintiff purchased the disputed domain names in September and  
5 December 2016, Defendant initiated arbitration with WIPO. (Doc. 84 at ¶¶ 11, 12, 20) In  
6 a decision dated February 13, 2017, a WIPO sole panelist concluded that: (1) the  
7 <lottoworks.com> domain name included the entire LOTTO WORKS mark so that the  
8 domain name was confusingly similar to that mark; (2) the <lottostore.com> domain name  
9 was also confusingly similar to Defendant’s LOTTO trademark because the domain name  
10 incorporates “lotto” and only adds the generic<sup>4</sup> word “store,” which “adds no distinctive  
11 element”; (3) Plaintiff registered the disputed domain names “to trade off the goodwill of  
12 [Defendant’s] mark, which does not provide [Plaintiff] with any rights or legitimate  
13 interests”; and (4) the domain names were registered and used in bad faith. (Doc. 85-1 at  
14 5-8) The WIPO panelist’s finding of bad faith was premised on the understanding that  
15 Plaintiff had neglected to indicate he registered the domain names in 2016, not 1998,<sup>5</sup> the  
16 webpage for <lottoworks.com> displayed many references to shoes as well as links both  
17 to Defendant’s and Defendant’s competitors’ websites, and because it was likely that  
18 internet users would visit the <lottostore.com> website intending to find Defendant’s  
19 online store. (*Id.* at 9) The WIPO panelist did not find that Defendant’s complaint was  
20

---

21 <sup>3</sup> The DSOF incorrectly states that Defendant’s application for the trademark of LOTTO  
22 WORKS was filed on October 26, 2018. (Doc. 84 at ¶ 9) In fact, Defendant applied for  
23 registration on October 27, 2016, and the trademark was registered by the USPTO on  
24 March 6, 2018. (Doc. 84-9 at 2-3)

24 <sup>4</sup> A term is “generic” when consumers understand the word to refer to a good itself rather  
25 than to a particular producer’s goods, that is, when the term “is identified with all such  
26 goods or services, regardless of their suppliers.” *KP Permanent Make-Up, Inc. v. Lasting  
27 Impression I, Inc.*, 408 F.3d 596, 604 (9th Cir. 2005).

27 <sup>5</sup> However, as is discussed below, the Ninth Circuit in *GoPets Ltd. v. Hise*, 657 F.3d 1024,  
28 1032 (9th Cir. 2011) held that a re-registration of an existing domain name is not a  
“registration” for the purposes of the ACPA.

1 brought in bad faith or was primarily intended to harass the domain name holder and,  
2 therefore, declined to grant Plaintiff's request that WIPO find that Defendant committed  
3 reverse domain name hijacking. (*Id.* at 9-10)

4 The parties now each cross move for summary judgment regarding Count One, in  
5 which Plaintiff requests the Court to find Plaintiff's registration and use of the disputed  
6 domain names are not unlawful pursuant to a claim of reverse domain name hijacking  
7 under the ACPA provisions of the Lanham Act in 15 U.S.C. §§ 1114(2)(D)(v); and Count  
8 Two, in which Plaintiff requests a declaration that Plaintiff's registration and use of the  
9 disputed domains are not unlawful under the Lanham Act pursuant to 15 U.S.C. §  
10 1125(d)(1). (Docs. 83, 91, 95, 86, 89, 96)

## 11 **II. STANDARD OF REVIEW**

12 "The court shall grant summary judgment if the movant shows that there is no  
13 genuine dispute as to any material fact and the movant is entitled to judgment as a matter  
14 of law." Fed. R. Civ. P. 56(a). "One of the principal purposes of the summary judgment  
15 rule is to isolate and dispose of factually unsupported claims or defenses." *Celotex Corp.*  
16 *v. Catrett*, 477 U.S. 317, 323-24 (1986). "[S]ubstantive law will identify which facts are  
17 material. . . . Only disputes over facts that might affect the outcome of the suit under the  
18 governing law will properly preclude the entry of summary judgment." *Anderson v.*  
19 *Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

20 "The proper question . . . is whether, viewing the facts in the non-moving party's  
21 favor, summary judgment for the moving party is appropriate." *Zetwick v. Cty. of Yolo*,  
22 850 F.3d 436, 441 (9th Cir. 2017) (*citing Arizona ex rel. Horne v. Geo Group, Inc.*, 816  
23 F.3d 1189, 1207 (9th Cir. 2016)). "[W]here evidence is genuinely disputed on a particular  
24 issue—such as by conflicting testimony—that 'issue is inappropriate for resolution on  
25 summary judgment.'" *Id.* (*quoting Direct Techs., LLC v. Elec. Arts, Inc.*, 836 F.3d 1059,  
26 1067 (9th Cir. 2016)).

27 The movant bears the initial burden of proving the absence of a genuine issue of  
28 material fact. *Celotex*, 477 U.S. at 323. For issues on which the movant would bear the

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.