

MARC J. RANDAZZA, JENNIFER RANDAZZA, and NATALIA RANDAZZA

DISTRICT OF NEVADA

Defendants.

**PLAINTIFFS' MOTION FOR DEFAULT
JUDGMENT AGAINST DEFENDANT
ELIOT BERNSTEIN AND AN AWARD
OF ATTORNEY'S FEES AND
STATUTORY DAMAGES:
MEMORANDUM OF POINTS AND
AUTHORITIES**

MEMORANDUM OF POINTS AND AUTHORITIES

Plaintiff Marc Randazza is an individual, an attorney, a legal author, and a resident of Las Vegas, Nevada. Plaintiff is the owner and managing partner of Marc J. Randazza PA, d/b/a

1 Randazza Legal Group (“RLG”), a nationally recognized First Amendment and Intellectual
2 Property law firm with offices located in Nevada, Florida, and Arizona. Since 2008, RLG has been
3 doing business using Marc Randazza’s personal name as a source identifier for its services.

4 In addition to owning and operating his own law firm, Plaintiff regularly appears in all
5 forms of news media as an author legal commentator. He has appeared in New York City
6 Magazine, New York Times, Boston Globe, Los Angeles Times, Fox News, and CNN, among
7 others. (See **Exhibit A**). He also regularly publishes under his byline at his blog, The Legal
8 Satyricon, which is one of the most well-known law blogs in the country. (See **Exhibit B**).
9 Plaintiff regularly speaks on panels about the First Amendment and intellectual property at
10 conferences nationwide. (See **Exhibit A**). He was also named one of 2013 Porn’s Most Powerful
11 Players by CNBC. (See **Exhibit C**).

12 In 2011, XBiz World Magazine named Randazza one of the adult entertainment industry’s
13 Top 50 newsmakers and commented on his work in high-profile cases. (See **Exhibit D**). In Nevada,
14 Plaintiff’s name has appeared in high profile Las Vegas media, including the Las Vegas Review-
15 Journal, the Las Vegas Sun, VegasInc, Las Vegas CityLife, and Las Vegas Weekly. (See **Exhibit**
16 **A**).

17 Plaintiff Jennifer Randazza is the wife of Plaintiff Marc Randazza. Plaintiff Natalia
18 Randazza is their four-year-old daughter. Both Jennifer and Natalia Randazza are private people
19 who were only targeted because of their relationship to Plaintiff Randazza.

20 **C. Facts Regarding Defendants**

21 Defendant Eliot Bernstein is an individual who, upon information and belief, resides in
22 Boca Raton, Florida.

23 At issue in this suit are thirty-two Infringing Domain Names containing all or part of
24 Plaintiffs’ personal names. While the majority of the Infringing Domain Names are registered to
25 Defendant Cox, five of the Domain Names were registered to Eliot Bernstein. See WhoIs Records
26 for <marcjohnrandazza.com>, <marcjrandazza.com>, <fuckmarcrandazza.com>,
27 <marcrandazzaisalyingasshole.com>, and <marcrandazzasucks.com>, (“Infringing Domain
28

Names”) attached as composite Exhibit E. These domain names contain the personal name and common law trademark of Plaintiff Marc Randazza. These Defendants registered the Infringing Domain Names with the intent to capitalize on the use of Plaintiff Randazza’s personal name and extort money from Plaintiffs. In fact, the profit in this endeavor flows directly from the extortion scheme.

While the content of these five websites contained was the same as the content of the other Infringing Domain Names, authored by Cox, upon information and belief, Bernstein is a knowing and voluntary participant in this infringement. Plaintiffs explained to him they were willing to believe that he was an unwitting participant in this unlawful conduct. Nevertheless, after having explained so to him, when Plaintiffs’ counsel contacted Bernstein on October 15, 2012, to notify him of the potential filing of this lawsuit, Bernstein did not respond other than to say “Please include me [as a defendant in the lawsuit].” See Exhibit F.

Between December 10, 2011 and September 20, 2012, Defendants registered the Infringing Domain Names through registrar Godaddy.com. Defendants registered the Infringing Domain Names with the intent to capitalize on Plaintiff Randazza’s personal name, of which Plaintiff Randazza has legitimate common law trademark rights.

On December 10, 2011, <marcrandazza.com> was registered to Crystal Cox in the publically available Whois information. (See **Exhibit G**). On January 16, 2012, Cox sent an email to Plaintiff stating that she had purchased his personal name as a domain name. (See **Exhibit H**). She then asked Plaintiff to purchase her “reputation management services” in an attempt to extort money from Plaintiff. (See **Exhibit H**). See *Obsidian Finance Group, LLC v. Cox*, 2012 WL 1065484 (D. Ore 2012).

Defendants continued to register several dozen more domain names and registered dozens of Blogger accounts throughout the next several months, all of which contain Plaintiff’s personal

1 name, the name of his law firm, Randazza Legal Group, or his family members' names. (See
2 **Exhibit E**). Five of the Infringing Domain Names are registered to Defendant Bernstein. (**Exhibit**
3 **E**).

4 **C. Procedural Facts**

5 On November 28, 2012, Plaintiffs filed a Complaint for cybersquatting, state and common
6 law right of publicity, common law right of intrusion upon seclusion, and civil conspiracy.
7 Plaintiffs served Defendant Bernstein on December 15, 2012, with a copy of the Complaint and *Ex*
8 *Parte* Motion for Temporary Restraining Order via personal service to a member of Bernstein's
9 family at his home in Boca Raton, Florida. Bernstein has never filed or served an Answer or
10 responsive pleading to the Complaint in accordance with Rule 12 of the Federal Rules of Civil
11 Procedure.
12

13 On January 11, 2013, this Court entered a Preliminary Injunction on Plaintiffs' cause of
14 action on the Individual Cyberpiracy Protections Claims, finding that Plaintiffs had a likelihood of
15 success on the merits of its 15 U.S.C. § 8131 claims. Pursuant to Plaintiffs' request, on January 9,
16 2013, the Clerk of the Court entered a default against Bernstein. A copy of the Default is attached
17 hereto as Exhibit I and incorporated herein by reference.
18

19 **II. Argument**

20 Concurrent with the default already entered upon the record by the Clerk of the Court, this
21 Court should grant Plaintiffs' request for default judgment against Bernstein for cybersquatting,
22 state and common law right of publicity, common law right of intrusion upon seclusion, and civil
23 conspiracy.
24

25 **A. Defendant Bernstein has violated Plaintiffs' individual cyberpiracy protections** 26 **pursuant to 15 U.S.C. § 8131.**

27 In the interest of brevity and judicial economy, Plaintiffs incorporate by reference their
28 arguments regarding the Violation of Individual Cyberpiracy Protections under 15 U.S.C. § 8131

1 against Defendant Bernstein as presented to this Court in its Motion for Temporary Restraining
 2 Order and Preliminary Injunction. The undisputed facts show that Bernstein registered or
 3 trafficked in <marcjohnrandazza.com>, <marcjrandaZZa.com>, <fuckmarcrandazza.com>,
 4 <marcrandazzaisalyingasshole.com>, and <marcrandazzasucks.com> with the bad faith intent to
 5 profit from registering, trafficking in, or using as a domain name a mark that is either identical or
 6 confusingly similar to the distinctive marks of Plaintiffs' personal names. As Plaintiffs have
 7 previously exhibit to this Court through uncontradicted evidence, Defendant had a specific intent to
 8 profit from these websites under 15 U.S.C. § 8131, and this Court should enter judgment in favor
 9 of Plaintiffs on their claims under this section of the Anti-Cybersquatting Consumer Protection Act.
 10

11 **B. Defendant Bernstein violated the Anti-Cybersquatting Consumer Protection**
 12 **Act.**

13 Based on the evidence included in the record, Plaintiff Randazza succeeds on the merits of
 14 his claim under the ACPA. That Act provides, in pertinent part:

15 [A] person shall be liable in a civil action by the owner of a mark . . . if, without
 16 regard to the goods or services of the parties, that person –

17 (i) has a **bad faith intent** to profit from that mark . . .; and

18 (ii) registers, traffics in, or uses a domain name that –

19 (I) in the case of a mark that is **distinctive** at the time of the registration
 20 of the domain name, is **identical or confusingly similar** to that
 21 mark; [or]

22 (II) in the case of a famous mark that is **famous** at the time of registration
 23 of the domain name, is **identical or confusingly similar** to that
 24 mark...

25 15 U.S.C. § 1125(d)(1)(A) (emphasis added). Thus, Defendants are liable under the ACPA if they
 26 had a bad faith intent to profit from registering, trafficking in, or using as a domain name a mark
 27 that is either identical or confusingly similar to a distinctive mark, such as Plaintiff's personal
 28 name.

Courts consider several factors in assessing whether a defendant has the requisite "bad faith
 intent" to profit from a mark, as defined by the ACPA, including but not limited to:

- (I) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
- (III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
- (IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
- (V) the person's intent to divert consumers from the mark owner's online location to a site assessable under the domain name that could harm the goodwill represented by the mark, either for commercial gain with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the site;
- (VI) the person's offer to transfer, sell or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;
- (VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;
- (VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, without regard to the goods or services of the parties; and
- (IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous. . . .

15 U.S.C. § 1125 (d)(1)(B). A court is “**not limited to considering just the listed factors** when making [its] determination of whether the statutory criterion has been met. The factors are, instead, expressly described as indicia that ‘may’ be considered along with other factors.” *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 498 (2d Cir. 2000) (emphasis added).

In applying these factors, it is abundantly clear that Plaintiffs have demonstrated Defendant Bernstein’s bad faith intent: (1) Defendant has no trademark rights to MARC RANDAZZA or in the Infringing Domain Names; (2) the Infringing Domain Names contain the legal name of

1 Plaintiff, under which he also provides legal services; (3) Defendant has never been known by the
2 name Marc Randazza; (4) Defendant made no use of Plaintiff's name prior to registering the
3 Infringing Domain Names; (5) Defendant has not made any *bona fide* noncommercial or fair use of
4 the Infringing Domain Names; (6) by use of the Infringing Domain Names, Defendant intends to
5 attract Plaintiff's potential clients and profit from his reputation and name; (7) the mark contained
6 in the Infringing Domain Names is identical or confusingly similar to Plaintiff's personal name, as
7 discussed below; (8) Defendant offered to sell one or more of the Infringing Domain Names to
8 Plaintiff or a third party with the intent to profit off of that sale; and (9) several of the Domain
9 Names are registered to Defendant Bernstein, despite the fact that Defendant Cox maintains the
10 sites. Accordingly, at least eight of the nine factors of bad faith defined by the ACPA clearly
11 weigh in favor of finding that Bernstein had the requisite bad faith intent to profit from the
12 registration of the Infringing Domain Names.
13

14
15 Defendants clearly do not have any legitimate purpose in registering Plaintiffs' names and
16 common law marks. Instead, they registered the names in order to extort money from Plaintiff
17 Randazza through an elaborate scheme to first destroy his good name and then offer to "fix up" the
18 reputation they cast in a negative light. As a proxy participant in Cox's various blog posts, offer to
19 sell, and attempts at link spamming, Bernstein contributed to Cox's intent to profit. Defendants'
20 use of the domain names is not a legitimate exercise of their First Amendment rights, but is a cover
21 for an elaborate scheme to obtain money from Plaintiffs.
22

23 Plaintiff Randazza also can prove the second element necessary for satisfying an ACPA
24 claim: Defendants have registered several domain names that are identical to Plaintiff Randazza's
25 common law mark. The Infringing Domain Names are identical to Plaintiff's personal name. In
26 fact, the Infringing Domain Names **contain the entirety of Plaintiff Marc Randazza's personal**
27
28

1 **name.** Additionally, many of the Infringing Domain Names do not contain any unique word or
 2 phrase to indicate that they do not emanate from Plaintiff, but wholly incorporate Plaintiff's name.

3 While Plaintiff Randazza does not possess a *registered* trademark in his personal name,
 4 "MARC J. RANDAZZA" has nonetheless become distinctive and synonymous with the offering of
 5 legal services. Plaintiff Randazza therefore owns common law trademark rights to the mark "Marc
 6 J. Randazza," established by recognition in the relevant channels of trade since at least 2008. Since
 7 then, Plaintiff has been the owner and managing partner of Marc J. Randazza PA, d/b/a Randazza
 8 Legal Group ("RLG"), a nationally recognized First Amendment and Intellectual Property law firm
 9 with offices located in Nevada, Florida, and Arizona. RLG has been doing business using Marc
 10 Randazza's personal name as a source identifier for its services.

11 Randazza regularly appears in all forms of news media as an author and legal commentator,
 12 publishes on his blog, the Legal Satyricon, and speaks worldwide on panels about the First
 13 Amendment and intellectual property matters. The distinctiveness of the Marc Randazza mark, and
 14 its recognition in the legal community, is uncomplicated, incontrovertible, and undeniable. Over
 15 the last five years, Plaintiff Randazza has created a genuine commodity in the Randazza trademark
 16 over the last five years. Defendant Bernstein can produce no evidence to the contrary.

17 Therefore, Defendant Bernstein registered and trafficked in (in bad faith) Plaintiffs'
 18 common law mark for the purpose of his own financial gain.

19 **C. Plaintiffs succeed on their Right of Publicity claims.**

20 In relevant part, the Nevada right of publicity statute reads:

21 There is a right of publicity in the name, voice, signature, photograph or likeness of every
 22 person. The right endures for a term consisting of the life of the person and 50 years after
 23 his or her death, regardless of whether the person commercially exploits the right during his
 24 or her lifetime...

25 ... Any commercial use by another of the name, voice, signature, photograph or likeness of
 26 a person requires the written consent of that person or his or her successor in interest.

1 Nev. R. Stat. 597.790(1)-(2). The United States Court of Appeals for the Ninth Circuit states that
 2 the common law right of publicity is actionable when a plaintiff alleges “(1) the defendant's use of
 3 the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage,
 4 commercially or otherwise; (3) lack of consent; and (4) resulting injury.” *White v. Samsung*
 5 *Electronics Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992). It is not important how the defendant
 6 misappropriates the plaintiff's name or identity; it matters only *whether* the plaintiff's identity was
 7 misappropriated. *Id.* at 1398.

9 In looking at the facts, Defendant Bernstein clearly violated Plaintiff Randazza's rights of
 10 publicity under both the Nevada statute and common law. Bernstein willingly registered Marc
 11 Randazza's personal name as a domain name, without his consent, for commercial gain, in
 12 violation of Randazza's publicity rights.

13 Defendants registered the Infringing Domain Names incorporating the use of the Plaintiff
 14 Marc Randazza's personal name with the intent to profit from their commercial use. Defendants
 15 attempted to profit from the use of Plaintiff's name through the use of 1) pay-per-click advertising
 16 and 2) the sale of the domains either to Plaintiff or a third party with an interest in Plaintiff's name
 17 and in order to further their extortion scheme. Randazza did not give his consent for either
 18 Defendant to register his personal names as a domain name, by writing or otherwise.

20 As a direct and proximate result of Defendant Bernstein's use of Marc Randazza's name, he
 21 has suffered, and will continue to suffer, monetary loss and irreparable injury to his business,
 22 reputation, and goodwill. Plaintiffs seek only injunctive relief under this claim.

24 **D. Plaintiffs succeed on their common law intrusion upon seclusion claim.**

25 In order to succeed on a claim for intrusion upon seclusion, a plaintiff in Nevada must show
 26 1) an intentional intrusion (physical or otherwise); 2) on the solitude or seclusion of another; 3) that
 27 would be highly offensive to a reasonable person. *Kuhn v. Account Control Technology, Inc.*, 865
 28

1 F.Supp. 1443, 1448 (D. Nev. 1994). Specifically to the third element, what is highly offensive to a
2 reasonable person is a matter of social conventions and expectations. *Id.* at 1449. The court
3 considers other factors, such as “the degree of intrusion, the context, conduct and circumstances
4 surrounding the intrusion as well as the intruder's motives and objectives, the setting into which he
5 intrudes, and the expectations of those whose privacy is invaded.” *Id.*

6
7 As a willing participant in Cox’s scheme, Bernstein is liable for the intrusion upon
8 Plaintiffs’ seclusion. The use of Mr. Randazza’s name, identity, and likeness, as well as the use of
9 the names of Jennifer Randazza and their four-year-old daughter Natalia Randazza, is highly
10 offensive to a reasonable person. While Mr. Randazza has established an online identity,
11 Defendants still may not use his name in an effort to intrude upon Mr. Randazza’s privacy in an
12 effort to attempt to harass and intimidate his family. Furthermore, Plaintiff Jennifer Randazza and
13 Plaintiff Natalia Randazza are private citizens who have a reasonable expectation that their names,
14 photos, and personal information will not be displayed in a public forum without their consent.

15
16 The use of private citizen Plaintiff Jennifer Randazza’s name and likeness, particularly in
17 making sexually inappropriate comments about her, is highly offensive to a reasonable person.
18 (ECF #1 ¶9) Plaintiff Jennifer Randazza did nothing to instigate Defendants’ use of her name and
19 likeness for their own purposes.

20
21 The use of then-three-year-old Plaintiff Natalia Randazza’s name to harass his family is
22 highly offensive to a reasonable person. Natalia Randazza is a toddler whose only reason for being
23 the subject of Defendants’ ire is because she is Mr. Randazza’s daughter. Plaintiff Natalia
24 Randazza is an innocent child whose name should not be associated with Defendants’ crusade to
25 extort and harm Plaintiffs’ reputation and business. Therefore, Plaintiffs are entitled to relief for
26 intrusion upon their seclusion.

27
28 **E. Plaintiffs succeed on their civil conspiracy claims.**

1 In order to allege a claim for civil conspiracy, the plaintiff must plead that two or more
2 people acted in a concerted action with the intention to accomplish an unlawful objective for the
3 purpose of harming another, resulting in damages to the plaintiff. *Flowers v. Carville*, 266 F. Supp.
4 2d 1245, 1249 (D. Nev. 2003), *quoting Collins v. Union Fed. Sav. & Loan Ass'n*, 9 Nev. 284, 662
5 P. 2d 610, 622 (1983). Civil conspiracy must include damages from an underlying tort. *Id.*

6
7 Courts in the Ninth Circuit determine the damages for the tort of civil conspiracy through
8 the “overt acts doctrine.” *Gibson v. U.S.*, 781 F.2d 1334, 1340 (9th Cir. 1986). Under this doctrine,
9 courts determine injury and damages to the plaintiff through overt acts, not from the continuance of
10 the conspiracy. *Id.*, *quoting Kadar Corp v. Milbury*, 549 F. 2d 230, 234 (1st Cir. 1977).

11 By their own admission, Defendants Bernstein and Cox conspired in order to commit all of
12 the acts referenced herein, and are therefore jointly and severally liable for the results of their co-
13 conspirator’s wrongs. Defendant Cox refers to Bernstein as her “business partner” and even argues
14 in her filings on his behalf, despite the fact that Bernstein has not yet made an appearance in this
15 case. In her Motion Requesting Plaintiff Inform Insurance Providers of Lawsuit, Cox states,
16 “These blogs and connected posts took years to build, these domain names and connected blogs,
17 this online media network took over \$750,000 and 10 years to build, built by Pro Se Defendant /
18 Pro Se Counter Plaintiff Crystal L. Cox and her Business Partner.” (ECF #53 at 6).

19
20 Moreover, Bernstein has done nothing to deny his liability or to explain why five of the
21 Infringing Domain Names were registered in his name. (See Exhibit F,G). When Plaintiffs
22 contacted Bernstein to warn him of the filing of the instant suit and to extend to him the
23 opportunity to explain his involvement, Bernstein responded only “Please include me.” (See
24 Exhibit F).

25
26 The overt acts that led to Plaintiffs’ damages were the concerted action on the part of both
27 Defendants to register the personal names of Plaintiffs as domain names (Exhibit E) with the
28

objective to destroy Plaintiffs' reputations and harass and intimidate Plaintiffs and other family members in an effort to earn money from the registration of these domain names. Defendants sought to earn money from this registration, either from pay-per-click advertising and the sale of supplements resulting from the publicity rights associated with Plaintiffs' names (Exhibit J); from Plaintiffs paying Defendants a monthly fee to maintain these websites (Exhibit H); or from the sale of the domain names to Plaintiffs or a third party (Exhibit K). As a result of these overt, concerted acts, Plaintiffs have suffered irreparable injury to their business, reputation and goodwill. Therefore, Plaintiffs are entitled to relief on their civil conspiracy claims.

F. Plaintiffs are entitled to Attorneys' Fees, Damages, and Permanent Injunctive Relief.

1. Attorneys' Fees Should Be Awarded When Infringement is Willful

In Lanham Act claims, including cybersquatting cases, attorneys' fees may be awarded where infringement is malicious, fraudulent, deliberate, or willful. *See* 15 U.S.C. § 1117(a); *Lindy Pen Co., Inc v. Bic Pen Corp.*, 982 F.2d 1400 (9th Cir. 1993). In 1975, Congress amended the Lanham Act for the "express purpose of permitting the recovery of attorneys' fees 'in exceptional cases.'" *Lindy Pen Co., Inc. v. Bic Pen Corp.*, 982 F.2d 1400 (9th Cir. 1993), citing 15 U.S.C. § 1117; *see also* Senate Report No. 93-1400 93rd Congree, Second Session (1974).

An "exceptional case" occurs where the infringement can be characterized as malicious, fraudulent, deliberate, or willful. *Id. See also Gracie v. Gracie*, 217 F.3d 1060, 1068 (9th Cir. 2000). If a court finds an infringer's actions to have been willful, district courts do not abuse their discretion in awarding attorney's fees. *Id.* Furthermore, it is an abuse of discretion for the trial court to fail to award attorneys' fees when the infringer's conduct is willful. *See Playboy Enterprises, Inc. v. Baccarat Clothing Co., Inc.*, 692 F.2d 1272, 1276 (9th Cir. 1982) ("In light of PEI's well supported arguments and the trial court's finding that the defendants deliberately

1 [infringed], it is our opinion that the lower court abused its discretion by not considering such
2 actions ‘exceptional.’”)

3 In this case, Defendant Bernstein deliberately chose to adopt Plaintiff Randazza’s common
4 law mark. Randazza is a well-known attorney managing a nationally recognized First Amendment
5 law firm. Defendant did not choose to register the domains <marcjohnrandazza.com>,
6 <marcjranda.com>, <fuckmarcandazza.com>, <marcandazzaisalyingasshole.com>, and
7 <marcandazzasucks.com> by mere accident. Defendant’s conduct was a willful and deliberate
8 attempt to capitalize on Plaintiffs’ well-known services, reognizability, and to earn money as a
9 result.
10

11 2. Information Required for Attorneys’ Fees Pursuant to Local Rule 54-16

12 Pursuant to Local Rule 54-16, Plaintiffs provide the following information:

13 a. *Itemization and description of the work performed*

14 The itemization and description of the work performed accompanies the Declaration of
15 Ronald D. Green (attorney) (“Green Decl.”) attached hereto as Exhibit L and incorporated herein
16 by reference.
17

18 b. *Itemization of non-taxable costs sought as part of fee award:*

19 None.

20 c. *Nature of the case:*

21 This was an action for violation of individual cyberpiracy protections under 15 U.S.C. §
22 8131; cybersquatting under 15 U.S.C. § 1125(d); right of publicity under Nev. R. Stat. 597.790(1)-
23 (2); common law right of publicity; common law right of intrusion upon seclusion; and civil
24 conspiracy.
25

26 //

27 //

d. *Difficulty of this case:*

This case was moderately difficult. The primary claims asserted were violation of individual cyberpiracy protections and cybersquatting. Trademark law is considered a specialized area of law, and claims asserted under the ACPA are particularly difficult as this is a fairly new area of law. Furthermore, the voluminous and vexatious filings by Bernstein's co-conspirator, Cox, have unnecessarily multiplied the work required in the case.

e. *Results obtained and amount involved:*

Plaintiffs obtained an entry of default that was favorable to Plaintiffs. The ACPA provides for damages of up to \$100,000.00 per domain name. *See* U.S.C. § 1117(d).

f. *Time and Labor Required*

This case involved a considerable amount of time and labor. Plaintiffs filed their Complaint. They applied for and obtained a Temporary Restraining Order and Preliminary Injunction. In the interim, Defendant Cox filed a number of extraneous motions to which Plaintiffs' counsel had to respond, and through which Defendant Cox claimed to be filing on Bernstein's behalf. Finally, after Plaintiffs obtained an entry of Default against Defendant Bernstein, they prepared and filed the instant Motion.

g. *Novelty and Difficulty of the Questions Involved:*

This case involved two claims under the ACPA: violation of individual cyberpiracy protections and cybersquatting. As the statute is relatively new, it raised novel questions of law, particularly with regard to Section 8131.

h. *Skill Requisite to Perform the Legal Services Properly:*

A moderate degree of skill was required to perform the legal services properly. As stated above, trademark law, and in particular cybersquatting, is considered a specialized area of law requiring considerable knowledge and experience.

i. *Preclusion of Other Employment by the Attorneys Due to Acceptance of the Case:*

During the pendency of this action, Plaintiffs' counsel's firm was working at full capacity, which precluded its attorneys from performing other work. Specifically, this case precluded Mr. Green from taking cases for which he would have received compensation.

j. *The Customary Fee:*

Plaintiffs' counsel represented Plaintiffs pro bono while working on this case. However, Ronald Green's normal rate is \$400 an hour, and calculations of attorneys' fees should be based on his normal rate. Green Decl. at ¶ 8.

k. *Whether to Fee is Fixed or Contingent*

Plaintiffs' counsel represented Plaintiffs pro bono for the litigation of this matter.

l. *The Time Limitations Imposed by the Client or the Circumstances.*

Plaintiffs did not impose any time limitations. Plaintiffs were being irreparably harmed by Defendants' registration and use of the domain names at issue and, therefore, Plaintiffs' counsel was required to act promptly.

m. *The Experience, Reputation, and Ability of the Attorneys Involved.*

Randazza Legal Group has an excellent reputation within the legal community and the attorneys working on this case are highly skilled. The lead attorney, Ronald D. Green, has worked extensively on cybersquatting and trademark infringement in Nevada's federal courts since June 2003. *See* Green Decl. at ¶ 4. Mr. Green performed all necessary work on this file with the assistance of associate attorney J. Malcolm DeVoy IV, law clerk Laura Tucker, and paralegal Erika Dillon. Mr. DeVoy has worked on cybersquatting litigation since he became a licensed attorney in June 2010. Ms. Tucker has worked on cybersquatting litigation since she joined Randazza Legal Group in November 2011. Ms. Dillon has worked on cybersquatting litigation since August 2011, prior to joining Randazza Legal Group.

n. *The Undesirability of this Case, if Any:*

Several aspects of Defendants' behavior in this case can be characterized as undesirable. Defendants have flooded the Court's docket with multiple impertinent filings and hundreds of exhibits. Moreover, Plaintiffs' counsel has been named in Defendant Cox's Counterclaim (in which Cox makes claims in Defendant Bernstein's name) and also became a target of Defendants' ire on their various websites.

o. *The Nature and Length of the Professional Relationship with the Client:*

Plaintiff Marc Randazza is the managing partner of Randazza Legal Group, where Mr. Green is employed as a partner.

p. *Award in Similar Cases*

Plaintiffs' counsel does not know whether the award would be similar to the awards in other cases. Regarding attorneys' fees, Plaintiffs' counsel is representing Plaintiffs pro bono.

3. The Court should award attorneys' fees in the amount of \$23,610.00.

This Court should enter an award of attorneys' fees in favor of Plaintiffs in the amount of \$23,175.00. See Green Decl. Exhibit 1. Plaintiffs are not asking for an award on the extensive time billed on this case by law clerk Tucker. This Court should also enter an award of \$435.00 for costs incurred by Plaintiffs. Plaintiffs would not have incurred these fees and costs but for the bad faith intent of Defendant Bernstein to profit from Plaintiffs' good will through the use of their common law marks and personal names. Consequently, the Court should award Plaintiffs \$23,610.00 in attorneys' fees and costs.

4. Damages

Defendants' registration and use of domain names containing Plaintiffs' personal names and common law trademark was calculated with the intent to profit from their registration. Defendant Bernstein's intentional and wrongful conduct requires Plaintiffs to incur costs necessary

1 to restore Plaintiffs' reputation. Moreover, the ACPA permits Plaintiffs to elect to receive statutory
2 damages.

3 It is difficult to ascertain the number of clients and members of the legal community who
4 were searching for Plaintiffs' website and who were diverted to Defendants' websites after either
5 typing in any of the Infringing Domain Names or performing a search for Plaintiffs' name on
6 search engine websites. Under the ACPA, this Court may award damages of not less than \$1,000
7 and not more than \$100,000 per domain name for cybersquatting:

9 In a case involving a violation of section 1125(d)(1) of this title, the plaintiff
10 may elect, at any time before the final judgment is rendered by the trial
11 court, to recover, instead of actual damages and profits, an award of statutory
12 damages in an amount of not less than \$1,000 and not more than \$100,000
per domain name, as the court considers just.

13 15 U.S.C. §1117(d).

14 Competent courts in several jurisdictions have awarded statutory damages pursuant to 15
15 U.S.C. §1117(d) to plaintiffs prevailing on ACPA claims. *See E. & J. Gallo Winger v. Spider*
16 *Webs Ltd.*, 286 F.3d 270, 278 (5th Cir. 2002) (upholding statutory damage award of \$25,000);
17 *Shields v. Zuccarini*, 254 F.3d 476 (3d Cir. 2001) (awarding \$50,000 in statutory damages);
18 *International Bancorp, L.L.C. v. Societe Des Baines De Mer Et Du Cercle Des Etrangers A*
19 *Monaco*, 192 F.Supp.2d 467 (E.D.Va. 2002) (awarding \$51,000 in statutory damages); *Victoria's*
20 *Cyber Secret Ltd. Partnership v. V Secret Catalogue, Inc.*, 161 F.Supp.2d 1339, (S.D. Fla. 2001)
21 (awarding \$40,000 in statutory damages); *Aztar Corp. v. MGM Casino*, 2001 WL 939070,
22 (E.D.Va. 2001) (awarding \$100,000 in statutory damages); *Electronics Boutique Holdings Corp. v.*
23 *Zuccarini*, 2000 WL 1622760 (E.D.Pa. 2000) (awarding \$100,000 in statutory damages). But see
24 *Morrison & Foerster LLP v. Wick*, 94 F. Supp.2d 1125 (D. Colo. 2000) (holding plaintiff not
25 entitled to statutory damages because plaintiff did not "elect" for statutory damages). This Court
26 has previously awarded statutory damages and attorneys' fees under the ACPA to resort hotel
27 casinos due to the actions of cybersquatters. *See Mirage Resorts, Inc. v. McClellan*, Case No. CV-

1 S-00-1275-LDG (LRL) (awarding \$100,000 in statutory damages in addition to attorneys' fees and
2 costs).

3 Defendant Bernstein's conduct of intentionally adopting and using Plaintiffs' personal
4 names and common law trademark has been egregious, and this Court should assess the maximum
5 in statutory damages. Plaintiff Marc Randazza has spent several years providing legal services
6 using his personal name through Randazza Legal Group. Exhibit A. By using Plaintiffs' personal
7 names and common law trademarks to harass and intimidate Plaintiffs with the specific intention to
8 profit from that registration, Defendant Bernstein clearly intended to profit from the goodwill of
9 Plaintiffs. Defendant Bernstein ignored Plaintiffs' requests to cease using the domain names and to
10 transfer the registration of the domain names, even after a WIPO decision finding Plaintiffs to be
11 the proper owners, thereby requiring Plaintiffs to obtain judicial relief. This Court has the
12 opportunity to send a clear message that this type of extortionate behavior will not be tolerated and
13 will be enforced to the maximum extent provided by law. "[T]he court has wide discretion in
14 determining the amount of statutory damages to be awarded, constrained only by the specified
15 maxima and minima." Harris v. Emus Records Corp., 734 F.2d 1329, 1335 (9th Cir. 1984).
16 Further, the trial court's award of statutory damages will be overturned only for abuse of discretion.
17 See Russell v. Price, 612 F.2d 1123, 1131-32 (9th Cir. 1979). Accordingly, Plaintiffs request that
18 the Court award statutory damages in the amount of \$100,000 per domain name, which would have
19 the effect of deterring Defendant Bernstein from his unlawful conduct.

20 5. Plaintiffs are entitled to Permanent Injunctive Relief

21 The ACPA authorizes the Court to order the transfer of the domain name to the owner of
22 the mark. 15 U.S.C. § 1125(d)(1)(C). Furthermore, if the Court finds a defendant violated a
23 plaintiff's individual cyberpiracy protections, the Court may order the transfer of the domain name
24 to the plaintiff. Accordingly, as the common law trademark owner of the mark in dispute, and as
25 the personal name "Marc Randazza" refers to Plaintiff Marc Randazza, Plaintiffs request transfer of
26 the domain names to them. The specific relief is set forth in Section III below.

28 //

III. Conclusion

Plaintiffs pray for the following relief:

1. The Court permanently enjoin Defendant Bernstein from using the Infringing Domain Names, that he be enjoined from registering personal names or common law marks of Plaintiffs, and that Bernstein be ordered to file with the Court and serve on Plaintiffs within thirty (30) days after the service on Defendants of such injunction, or such extended period as the Court may direct, a report in writing under oath setting forth in detail the manner and form in which he has complied with the injunction;

2. That the Registrars of the Infringing Domain Names, GoDaddy.com, be ordered to permanently transfer the domain names <fuckmarcrandazza.com>, <marcrandazzaisalyingasshole.com>, and <marcrandazzasucks.com> to Plaintiffs pursuant to the Plaintiffs in order to cease the continued harassment and to cease the continued violation of Randazza's rights of publicity, right to privacy, and other rights enumerated herein which may not specifically be remedied by 15 USC 8131(2); or 15 USC § 1175(d)(1)(c);

3. That Defendant Bernstein release to Plaintiffs information on any and all domain names that incorporate the Plaintiffs' name;

4. That Plaintiffs receive and recover from Defendant Bernstein all damages sustained;

5. That Plaintiffs receive and recover from Defendant Bernstein statutory damages in the amount of \$100,000 per domain name, for a total of \$500,000, which is the maximum allowed by 15 U.S.C. § 1117(d); this maximum amount is supported by Defendant Bernstein's extreme bad faith and conspiratorial and fraudulent activities.

6. That the Court order Defendant Bernstein to pay Plaintiffs reasonable costs, expenses, and attorneys' fees incurred in prosecuting this action, pursuant to 15 U.S.C. § 1116; 15 U.S.C. 8131(2); and 15 U.S.C. § 1117(a);

7. That Plaintiffs be awarded pre- and post-judgment interest to the maximum extent allowed by law; and

8. That Plaintiffs be awarded such and other further relief to which they may be justly entitled.

1 9. Injunctive relief that Defendant Bernstein be enjoined from owning, registering, or
2 operating any domains incorporating the “Randazza” name, whether they be direct domain
3 registration or through the use of any blogging platform, and that such injunctive relief contemplate
4 the Defendant using proxies, agents, or third parties to evade this relief, and specifically enjoins the
5 Defendant from using third parties to do that which the injunction prevents them from doing
6 directly.

7
8 Dated: January 29, 2013

Respectfully submitted,

9 /s/Ronald D. Green

10 Ronald D. Green, NV Bar #7360

Randazza Legal Group

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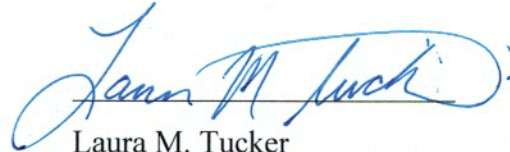
13 ecf@randazza.com
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CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure 5(b), I hereby certify that the foregoing document was filed using this Court's CM/ECF system on January 29, 2013.

Dated: January 29, 2013

Respectfully Submitted,



Laura M. Tucker
Law Clerk

ecf@randazza.com

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