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11 Attorneys for Plaintiff
NAME.SPACE, INC.

12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA
14 WESTERN DIVISION
15

16 NAME.SPACE, INC.,
17 Plaintiff,
18 v.
19 INTERNET CORPORATION FOR
20 ASSIGNED NAMES AND NUMBERS,
21 Defendant.

Case No. CV12- 8676 (PA)

Assigned for all purposes to the
Honorable Percy Anderson

**PLAINTIFF NAME.SPACE'S
RESPONSE TO ICANN'S
CITATION TO
SUPPLEMENTAL AUTHORITY**

Hearing Date: February 25, 2013
Hearing Time: 1:30 p.m.
Judge: Honorable Percy Anderson
Hearing Location: 312 N. Spring St.

1 Pursuant to the Court’s February 14, 2013 Order, Plaintiff name.space, Inc.
2 (“name.space”) respectfully submits this response to Defendant ICANN’s citation
3 of *Image Online Design v. ICANN*, No. 2:12-cv-08968 (DJP) (C.D. Cal. Feb. 7,
4 2013) (“*Image Online*”).¹

5 ARUGMENT

6 ICANN’s attempt to rely on the recent decision in *Image Online* is without
7 merit. In finding that plaintiff’s trademark claims were not ripe in *Image Online*,
8 Judge Pregerson relied on plaintiff’s admission that its claims were based on future
9 conduct, which is not the case here. In addition, ICANN is not challenging the
10 validity of name.space’s trademark rights in this case, and thus Judge Pregerson’s
11 decision on the validity of plaintiff’s mark is irrelevant to this motion.

12 **I. IMAGE ONLINE INVOLVED DIFFERENT TRADEMARK CLAIMS.**

13 IOD’s trademark infringement claims differ materially from name.space’s
14 claims. IOD acknowledged that its trademark claims were based on ICANN’s
15 future intention to delegate the .WEB registry to someone other than IOD, stating
16 that “it is ‘plausible’ that ICANN’s intent will be realized.” (*Id.* at 14.) It was on
17 this basis that Judge Pregerson ruled that “IOD has not alleged use of the trademark
18 or ‘immediate capability and intent’ to infringe, and therefore [IOD’s] trademark
19 infringement claim is not ripe for adjudication.” (*Id.*) In other words, IOD alleged
20 that its trademark would be infringed only when the .WEB registry was delegated
21 to someone other than IOD, and sued based on ICANN’s purported intent to
22 accomplish that delegation in the future. By contrast, name.space’s claims *do not*
23 *require or depend on any future conduct.* name.space’s trademark claims are based
24 on ICANN’s acceptance of substantial application fees in exchange for its

25
26 ¹ The decision was issued after name.space filed its summary judgment opposition on February 4,
27 2013. The full text of the decision was attached as Exhibit A to the Declaration of Jeffrey A.
28 LeVee in Support of ICANN’s Motion for Summary Judgment, ECF No. 42-2 (“LeVee Decl.”).

1 “willingness to allow competing TLD registries to use the identical gTLDs in
2 commerce on the ICANN-controlled DNS.” (Compl. ¶ 123.) Whether ICANN
3 ultimately grants a TLD application is irrelevant to name.space’s claims because
4 name.space has alleged that the likelihood of confusion already exists right now.
5 Nothing more needs to happen. As a result, name.space’s claims are clearly ripe.²

6 **II. ICANN DOES NOT CHALLENGE THE VALIDITY OF**
7 **NAME.SPACE’S MARKS.**

8 Finally, ICANN notes in its reply that Judge Pregerson found that IOD’s
9 mark “cannot enjoy trademark protection.” (Reply at 12; LeVee Decl., Ex. A at
10 19.) The validity of IOD’s mark is irrelevant to ICANN’s motion here, however,
11 because, unlike in *Image Online*, ICANN has not challenged the validity of
12 name.space’s marks. ICANN has moved only for dismissal of name.space’s
13 trademark claims for lack of subject matter jurisdiction under Rule 12(b)(1).
14 (Reply at 1.) name.space nevertheless has valid trademark rights in its TLDs,
15 which name.space will demonstrate when that issue is properly before the Court,
16 which it presently is not.

17 Dated: February 15, 2013

MORRISON & FOERSTER LLP

19 By: /s/ Craig B. Whitney
20 Craig B. Whitney

21 Attorneys for Plaintiff
22 NAME.SPACE, INC.

23
24 _____
25 ² ICANN also advanced the same incorrect legal argument in *Image Online* that it does here, that
26 a trademark infringement claim requires the marks at issue to be “used or displayed in the sale or
27 advertising of the services and the services are rendered in commerce.” (LeVee Decl., Ex. A. at
28 13-14.) ICANN nevertheless neglected —both here and in *Image Online*—to cite controlling
Ninth Circuit precedent holding that this quoted language applies only to a plaintiff’s *registration*
of the mark, not for *infringement*. (See name.space’s Opp’n, ECF. No. 37, at 24.)