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15 **UNITED STATES DISTRICT COURT**
16 **DISTRICT OF NEVADA**

17 GREGORY RICKS,
18 Plaintiff,

19 v.

20 BMEzine.COM, LLC,

21 Defendant.

Case No. 2:08-cv-01174-PMP-GWF

**ANSWER TO COMPLAINT and
COUNTERCLAIM FOR DAMAGES,
INJUNCTIVE, AND DECLARATORY
RELIEF**

23 BMEzine.COM, LLC,
24 Counterclaim Plaintiff,

25 v.

26 GREGORY RICKS,

27 Counterclaim Defendant.

- (1) Cybersquatting under 15 U.S.C. § 1125(d)
- (2) Trademark Infringement under 15 U.S.C. § 1125(a)
- (3) Willful Trademark Infringement under 15 U.S.C. § 1114(1)
- (4) False Designation of Origin under 15 U.S.C. § 1125(a)
- (5) Unfair Competition under 15 U.S.C. §

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- 1125(a)
- (6) Nevada Common Law Trademark Infringement
- (7) Deceptive Trade Practices under N.R.S. 598.0903, *et seq.*
- (8) Intentional Interference with Prospective Economic Advantage
- (9) Trademark Infringement under Fla. Stat. § 495.131
- (10) Dilution under Fla. Stat. § 495.151

Defendant/Counterplaintiff, BMEzine.COM, LLC (“Defendant”) by and through its attorney of record, the law firm of GREENBERG TRAUERIG, LLP, hereby responds to the Complaint filed by Plaintiff/Counterdefendant, GREGORY RICKS (“Plaintiff”) and alleges as follows:

FIRST CAUSE OF ACTION

SUMMARY OF ACTION

1. Defendant maintains that the allegations contained in paragraph 1 of the Complaint constitute a legal conclusion to which no response is required. To the extent a response is required, Defendant admits only to those duties as are imposed by law.

2. Defendant maintains that the allegations contained in paragraph 2 of the Complaint constitute a legal conclusion to which no response is required. To the extent a response is required, Defendant admits only to those duties as are imposed by law.

THE PARTIES

3. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 3 of the Complaint and therefore specifically and generally denies the same.

4. Defendant admits the allegation in paragraph 4 of the Complaint that Defendant Bmezine.com, LLC is a Nevada limited liability company. Defendant denies the remaining allegations in this paragraph of the Complaint.

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JURISDICTION OVER THE SUBJECT MATTER

5. Defendant maintains that the allegations contained in paragraph 5 of the Complaint constitute a legal conclusion to which no response is required. To the extent a response is deemed required, Defendant specifically and generally denies each and every allegation.

6. Defendant maintains that the allegations contained in paragraph 6 of the Complaint constitute a legal conclusion to which no response is required. To the extent a response is deemed required, Defendant specifically and generally denies each and every allegation.

7. Defendant maintains that the allegations contained in paragraph 7 of the Complaint constitute a legal conclusion to which no response is required. To the extent a response is deemed required, Defendant specifically and generally denies each and every allegation.

STATEMENT OF FACTS

8. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 8 of the Complaint and therefore specifically and generally denies the same.

9. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 9 of the Complaint and therefore specifically and generally denies the same.

10. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 10 of the Complaint and therefore specifically and generally denies the same.

11. Defendant denies the allegations contained within paragraph 11 of the Complaint.

12. Defendant denies the allegations contained within paragraph 12 of the Complaint.

13. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 13 of the Complaint and therefore specifically and generally denies the same.

14. Defendant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 14 of the Complaint and therefore specifically and generally denies the same.

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1 15. Defendant denies the allegations contained within paragraph 15 of the Complaint.

2 16. Defendant maintains that the language of the federal trademark application speaks
3 for itself. Defendant admits the remaining allegations contained in paragraph 16 of the Complaint.

4 17. Defendant denies the allegations contained within paragraph 17 of the Complaint.

5 18. Defendant denies the allegations contained in paragraph 18 of the Complaint.

6 19. Defendant denies the allegations contained within paragraph 19 of the Complaint.

7 20. Defendant admits the allegations contained within paragraph 20 of the Complaint.

8 21. Defendant admits the allegations contained within paragraph 21 of the Complaint.

9 22. Defendant denies the allegations contained within paragraph 22 of the Complaint.

10 23. Defendant denies the allegations contained within paragraph 23 of the Complaint.

11 24. Defendant denies the allegations contained within paragraph 24 of the Complaint.

12 **DECLARATORY JUDGMENT**

13 25. Defendant repeats and reaffirms each and every preceding paragraph of this answer
14 to Plaintiffs' Complaint as fully set forth herein.

15 26. Defendant admits that a justiciable issue exists and denies the allegations contained
16 within paragraph 26 of the Complaint.

17 27. Defendant denies the allegations contained within paragraph 27 of the Complaint.

18 28. Defendant denies the allegations contained within paragraph 28 of the Complaint.

19 29. Defendant denies the allegations contained within paragraph 29 of the Complaint.

20 **COUNT I**

21 30. Defendant maintains that the allegations contained in paragraph 30 of the Complaint
22 constitute a legal conclusion to which no response is required. To the extent a response is deemed
23 required, Defendant specifically and generally denies each and every allegation. Defendant repeats
24 and reaffirms each and every preceding paragraph of this answer to Plaintiffs' Complaint as fully
25 set forth herein.

26 31. Defendant is without knowledge or information sufficient to form a belief as to the
27 truth or falsity of the allegation when Ricks registered the domain name BME.COM. Defendant
28 denies the allegations as to Defendant falsely accusing Ricks of capitalizing on the alleged goodwill

1 associated with Bmezine’s business by driving traffic to its BME.COM site, and demanding that
2 the domain BME.COM be transferred to Bmezine. Defendant admits the remaining allegations
3 contained in paragraph 31 of the Complaint.

4 32. Defendant admits the allegations contained within paragraph 32 of the Complaint.

5 33. Defendant denies the allegations contained within paragraph 33 of the Complaint.

6 34. Defendant denies the allegations contained within paragraph 34 of the Complaint.

7 35. Defendant denies the allegations contained within paragraph 35 of the Complaint.

8 36. Defendant maintains that the allegations contained in paragraph 36 of the Complaint
9 constitute a conclusory statement to which no response is required. To the extent a response is
10 deemed required, Defendant specifically and generally denies each and every allegation.

11 **COUNT II**

12 37. Defendant maintains that the allegations contained in paragraph 30 of the Complaint
13 constitute a legal conclusion to which no response is required. To the extent a response is deemed
14 required, Defendant specifically and generally denies each and every allegation. Defendant repeats
15 and reaffirms each and every preceding paragraph of this answer to Plaintiffs’ Complaint as fully
16 set forth herein.

17 38. Defendant denies the allegations contained within paragraph 38 of the Complaint.

18 39. Defendant denies the allegations contained within paragraph 39 of the Complaint.

19 40. Defendant denies the allegations as to Bmezine providing an online interactive
20 database of pornographic photos and videos. Defendants admits the remaining allegations
21 contained in paragraph 40 of the Complaint.

22 41. Defendant denies the allegations contained within paragraph 41 of the Complaint.

23 42. Defendant denies the allegations contained within paragraph 42 of the Complaint.

24 **AFFIRMATIVE DEFENSES**

25 Defendant, without altering the burdens of proof the parties must bear, assert the following
26 affirmative defenses to the Complaint, and the claims asserted therein. Defendant specifically
27 incorporates into its affirmative defenses its answers to the preceding paragraphs of Plaintiff’s
28 Complaint as if fully set forth herein.

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FIRST AFFIRMATIVE DEFENSE

1
2 Plaintiff's Complaint, and all the claims for relief alleged therein, fails to state a claim
3 against Defendant upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

4
5 Plaintiff has not been damaged directly, indirectly, proximately or in any manner
6 whatsoever by any conduct of Defendant.

THIRD AFFIRMATIVE DEFENSE

7
8 Any injuries or damages sustained by Plaintiff as alleged in the Complaint are the result of
9 the conduct of a third-party over which Defendant had no control.

FOURTH AFFIRMATIVE DEFENSE

10
11 The allegations contained in the Complaint, and the resulting damage, if any, to Plaintiff,
12 was proximately caused or contributed to by Plaintiff's own conduct.

FIFTH AFFIRMATIVE DEFENSE

13
14 Any harm or injury or claim of damage of Plaintiff, or cause of action of Plaintiff, as alleged
15 or stated in the Complaint, is barred by the doctrine of laches, estoppel, waiver, unclean hands,
16 assumption of the risk and the applicable statute of limitations, as to all or part of the claims of
17 Plaintiff.

SIXTH AFFIRMATIVE DEFENSE

18
19 Plaintiff's alleged damages are the direct and proximate result of their own negligent or
20 intentional conduct or malfeasance.

SEVENTH AFFIRMATIVE DEFENSE

21
22 Plaintiff's claims are barred because Plaintiff has no rights to the marks in question.

EIGHTH AFFIRMATIVE DEFENSE

23
24 Plaintiff's claims are barred because Defendant has superior rights to the marks in question.

NINTH AFFIRMATIVE DEFENSE

25
26 Pursuant to Nevada Rules of Civil Procedure, all possible affirmative defenses may not
27 have been alleged herein insofar as sufficient facts were not available after reasonable inquiry upon
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1 the filing of this Answer and, therefore, Defendant reserves the right to amend this Answer to
2 allege additional Affirmative Defenses if subsequent investigation warrants.

3 **COUNTERCLAIM**

4 **I. INTRODUCTION**

5 1. This action seeks declaratory relief, injunctive relief, and damages against Ricks'
6 willful infringement and dilution of BME's famous trademark "BME" (hereinafter the "BME mark")
7 resulting from Ricks' use of the BME tradename, service mark, and <bme.com> Internet Domain
8 Name in violation of 15 U.S.C. §§ 1051 *et seq.* (the "Lanham Act"), the Anti-cybersquatting
9 Consumer Protection Act ("ACPA") (15 U.S.C. § 1125(d)), N.R.S. 598.0903 *et. seq.*, the Florida
10 Dilution Act, *Fla. Stat.* § 495.151, Florida trademark infringement as under *Fla. Stat.* § 495.131,
11 Florida's Unfair and Deceptive Trade Practices Act, and the common law doctrines of unfair
12 competition, trademark infringement and intentional interference with prospective economic
13 advantage.

14 **II. JURISDICTION AND VENUE**

15 2. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C.
16 §§ 1331, 1338(a), 2201 and 2202, and supplemental jurisdiction over the state law claims pursuant to
17 28 U.S.C. §§ 1338(b) and 1367.

18 3. Venue currently lies in this district, by virtue of the fact that Ricks has filed an
19 original action in this district and this Complaint is brought as a compulsory Counterclaim.

20 **III. THE PARTIES**

21 4. BME is a Nevada limited liability company with its principal place of business in
22 Toronto, Canada.

23 5. BME is the most well-known body art specialty publisher in the world. BME
24 operates a network of websites, all of which provide services of interest to the body art community
25 and marketplace.

26 6. Ricks is the owner and registrant of the <bme.com> Internet domain name (the
27 "Infringing Domain Name"), and upon information and belief owns several other infringing domain
28 names.

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1 7. Ricks, upon information and belief, is in the business of cybersquatting on famous
2 trademarks in order to earn pay-per-click fees or other advertising revenue from trading on the fame
3 of the marks.

4 8. Upon information and belief, Ricks is either the principal or alter ego of Gee Whiz
5 Domains, which is additionally in the business of cybersquatting on famous trademarks. In fact, Gee
6 Whiz Domains is the registrant of the following domains which infringe upon the intellectual
7 property rights of third parties: <machtcom.com>, <yahooemail.com>, <msnbc.com>,
8 <billgates.com>, <newyorktimesbestseller.com>, <microsoft.com>, <microsoft.com>,
9 <xmasradio.com>, <lufthansa.com>, <microsoftclipart.com>, <ultimatesurrenderpassword.com>,
10 <epinione.com>, <exxonmobil.com>, <barbizon.com>, <googlepagescreator.com>,
11 <cnnmoney.com>, <toysru.com>, <yahoo.com>, <htpgmail.com>, <officedepo.com>,
12 <cartmax.com>, <snoopdog.com>, and <napsterlite.com>.

13 9. Moniker.com, a Florida corporation, is the registrar of the domain name <bme.com>.

14 10. Pursuant to 15 U.S.C. § 1125(d)(1)(c), this Court is empowered to order the Registrar
15 to transfer the domain name to a prevailing Plaintiff.

16 **IV. BACKGROUND**

17 **A. BMEzine's Valuable Common-Law Trademark Rights**

18 11. BME has been using the BME mark in international commerce in connection with
19 tattooing and piercing journalism since as early as 1994, when it was used regularly on an Internet
20 newsgroup, and as such, its use pre-dates the World Wide Web. See Exhibit A, and Composite
21 Exhibit B.

22 12. BME owns overwhelming common law trademark rights in the BME mark
23 established by fourteen (14) years of continuous and widespread use on the Internet, millions of
24 daily visitors to the BME network of websites, as well as near ubiquitous recognition in the relevant
25 channels of trade.

26 13. BME has been using "BME" as a source identifier for its services since 1994. The
27 use of "BME" ("Body Modification 'Ezine") has spanned across the Internet; the website has been
28 viewed in all countries, "BME" has been featured in numerous tattoo, body modification and

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1 mainstream print articles; and is clearly recognizable to anyone in the relevant marketplace and well
2 beyond. See Exhibits A, B, and C.

3 14. The BME mark has achieved strong secondary meaning in both the mainstream press
4 and in the relevant marketplace. “BME” is a famous mark, especially within the body art, tattooing,
5 and piercing communities. See Declarations of Kevin Wimberly, Exhibit D, Elayne Angel, Exhibit
6 E, and Allen Falkner, Exhibit F. See also Exhibits A, B, and C.

7 15. Additionally, acquired distinctiveness of this mark is apparent from the evidence
8 attached in Composite Exhibit G to this Complaint. See also Exhibits A and B. This evidence
9 consists of a representative sampling of unsolicited media attention bestowed upon BME. As shown
10 in these Exhibits, BME is frequently mentioned in the mainstream media on a regular basis.

11 16. Further evidence of the BME common law rights exists on Wikipedia.com. See
12 http://en.wikipedia.org/wiki/BME_%28website%29 and Exhibit H. While “facts” reported on
13 Wikipedia are hardly conclusive evidence, as it may be edited by anyone at any time, the Wikipedia
14 history shows that there has been a Wiki on BME since April of 2004, and that it has been edited
15 many times by many users. See Exhibit I.

16 17. In 1995, “BME” won a Lydia Award for best World Wide Web site and Best Body
17 Art Magazine (any medium) See Exhibit J.

18 18. BME is frequently mentioned in other sources of Body Art media. See Exhibits A, B,
19 and G, which detail unsolicited media attention focused on BME from 1994 to 1998.

20 19. In July of 1998, Playgirl Magazine noted that BME is “a good place to learn about
21 genital piercing!” See Playgirl Magazine, July 1998 at p. 42.

22 20. BME’s flagship website, BMEZine.com, is linked to by 1,216 other websites. See
23 Exhibit K.

24 21. The BME mark (in connection with the body art, tattooing, and piercing industry) can
25 only identify BME, and Internet users who navigate their browsers to the Infringing Domain Name
26 would be misled to believe that the Infringing Domain Name (a true and correct copy of the website
27 BME.com as of the date the UDRP Complaint was filed appears at Exhibit L) is in some way
28 connected to or affiliated with BME.

1 22. This misuse of the BME mark created confusion between BME's and Ricks'
2 domains, as shown in Exhibit M. See also Expert Witness Declarations, Exhibits D-F. Given the
3 fact that BME only does business online, this could create a crisis in the marketplace.

4 23. In 1994, BME's publication was launched on Usenet, and later on BME.freeq.com.
5 See Composite Exhibit N, which consists of historical printouts of bme.freeq.com. Thereafter, BME
6 has done business on a collection of websites on the World Wide Web, as discussed below. BME
7 operates, among others, the following websites, printouts of which are attached hereto as Composite
8 Exhibit O:

9 a. BMEfest.com a website that promotes the annual gathering for
10 members of the community of the BME family of websites;

11 b. BMEvideo.com, an adult site displaying online videos of
12 extreme and erotic body modification (graphic portions redacted);

13 c. BMEhard.com, a site that allows users to post content on bonus
14 galleries;

15 d. BMEboys.com, a blog-type site that allows user posted pictures
16 and text;

17 e. TeamBME.com, a mailserver site which provides email
18 accounts for members of "Team BME" (people with BME tattoos);

19 f. AskBME.com, a question and answer site for members of the
20 body art, tattooing, and piercing community;

21 g. BMEworld.com, a site offering free homepages and
22 anonymous e-mail for members of the body modification community;

23 h. BMEink.com, a site designed to give the tattoo-specific
24 members of the BME community a separate forum;

25 i. BMEzine.com, BME's flagship site;

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j. BMEjapan.com, a site designed for Japanese-speaking members of the body modification community;

k. BMEscholarship.com, a website that accepts donations to provide academic scholarships to members of the body modification community;

l. BMEshop.com, a website that sells merchandise specific to the body art, tattooing, and piercing community;

24. BME has created a genuine commodity in the BME mark.

25. Allen Falkner and Elayne Angel are experts in the fields of Body Piercing and Body Art. They confirm the obvious – that the mark BME can only identify BME, and any other use of the mark will result in a strong likelihood of confusion in the relevant marketplace. See Declarations of Angel and Falkner, attached as Exhibits E, and F. See also, Declaration of Kevin Wimberly, at Exhibit D.

C. Ricks' Wrongful Conduct

26. On or about March 6, 2000, Ricks registered the Infringing Domain Name, <bme.com>, with Moniker Online Services, Inc., a registrar for domain names. The Infringing Domain Name contains the entirety of BME's distinctive mark.

27. Upon information and belief, Ricks purchased the Infringing Domain Name as a direct result of the popularity of BMEzine's online services offered in connection with the BME mark.

28. Even if Ricks purchased the <bme.com> domain name without bad faith, Ricks later used <bme.com> in a bad faith intent to profit from confusion with BME's marks.

29. Upon information and belief, Ricks chose to register and/or use <bme.com> and commenced use of the BME mark in connection with its website solely for the purpose of improperly trading upon BME's trademark rights, or for the purpose of attempting to re-sell the domain to BME.

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- 1 **D. The Infringing Domain Name <bme.com>**
- 2 30. The Infringing Domain Name incorporates the entirety of the BME mark.
- 3 31. BME is informed and believes, and on that basis alleges that Ricks was aware of
- 4 BME’s rights in the BME mark and willfully infringed upon it by registering the Infringing Domain
- 5 Name.
- 6 32. BME is informed and believes, and on that basis alleges that Ricks was aware of
- 7 BME’s rights in the BME mark and willfully infringed upon it by using the Infringing Domain
- 8 Name in a bad faith attempt to capitalize on the BME mark by launching a web page that dealt solely
- 9 with tattooing, piercing, and body art.
- 10 33. Ricks provides no *bona fide* services at <bme.com>, but rather sends visitors into a
- 11 rabbit hole of links that eventually leads to other websites. Ricks then receives payment for each of
- 12 these clicks.
- 13 34. Upon information and belief, Ricks receives financial consideration for this mis-
- 14 directed traffic.
- 15 35. Upon information and belief, Ricks intended to misdirect valuable Internet traffic that
- 16 otherwise would have gone to the BME Websites.
- 17 36. Upon information and belief, Ricks willfully created a likelihood of confusion
- 18 between BME’s services and Ricks’ services offered in connection with the Infringing Domain
- 19 Name.
- 20 37. BME has not consented to Ricks’ use of the BME tradename, service mark, and/or
- 21 domain name, nor has BME sponsored, endorsed, nor approved of the services offered and promoted
- 22 by Ricks.
- 23 38. Ricks’ services consist of nothing more than a misleading webpage containing links
- 24 to other webpages where goods and services pertaining to body piercing and tattooing are located,
- 25 along with images that lead the consumer to believe that the webpage is sponsored by or provided by
- 26 BME.
- 27 39. Ricks has done nothing to market or promote the BME mark independently of the
- 28 infringing services offered at <bme.com>.

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1 40. Upon information and belief, Ricks adopted and used the BME mark and the
2 Infringing Domain Name for the purpose of misleading and confusing the public about its
3 association with BME, and trading on the goodwill, reputation, and fame of BME and its BME
4 mark.

5 41. After learning of Ricks' use of the Infringing Domain Name, and the BME trade
6 name and service mark, BME communicated with Ricks through its registrar, Moniker.com, to
7 inquire as to Ricks' intentions.

8 42. Ricks demanded an exorbitant amount in exchange for the domain name. However,
9 BME agreed to pay it. Upon acceptance of the offer, Ricks revoked the offer and increased the price
10 twice as ransom for the Infringing Domain Name and the steady flow of stolen traffic and customers.
11 This amount is well in excess of Ricks' reasonable expenses incurred in connection with the domain
12 name.

13 43. Ricks' infringing conduct and refusal to respect BME's trademark rights indicates
14 that Ricks deliberately and willfully selected and is using a mark and a domain name similar to
15 BME's famous trademark to mislead and confuse consumers into believing that Ricks' website is
16 provided by, sponsored by, or approved of by BME. Ricks is trading on BME's reputation and
17 goodwill, and its enormous investment in the promotion of the BME service mark, thus diluting the
18 distinctive quality of the famous BME mark.

19 44. Upon information and belief, Ricks knew about BME, the BME mark, and BME's
20 business at the time he adopted the BME tradename, service mark, and domain name, and began
21 offering his closely-related services under the BME mark.

22 45. Ricks' first commercial use of the BME mark and BME.com domain name occurred
23 many years after BME's first use of the BME mark in connection with its services, and years after
24 BME's common law rights had been established.

25 46. Ricks' first commercial use of the BME mark and the <bme.com> domain name
26 occurred after BME's BME mark had become famous.

27 47. Ricks' <bme.com> domain name incorporates BME's trademark in its entirety.

28 ...

1 48. Ricks uses the Infringing Domain Name in connection with services that are closely
2 related to services offered in connection with BME’s BME mark.

3 49. Ricks’ promotion of his services under the <bme.com> domain name is directed at
4 consumers of BME’s services and is conducted through the same channels of trade as are used by
5 BME to promote its services under the BME mark.

6 50. Ricks’ use of the Infringing Domain Name, and Ricks’ actions described herein are
7 certain or likely to cause confusion, deception, and/or mistake as to: (a) the source or origin of
8 Ricks’ services; and (b) whether BME sponsors, endorses, or approves of Ricks or his services or is
9 otherwise affiliated with Ricks.

10 51. Ricks’ use of the Infringing Domain Name and Ricks’ actions described herein dilute
11 the distinctive quality of BME’s famous BME mark.

12 52. Ricks’ use of the Infringing Domain Name and Ricks’ actions described herein have
13 been, and continue to be deliberate, willful, and with disregard of BME’s rights.

14 53. Ricks’ continuing conduct constitutes an ongoing risk that the public will be confused
15 as to the source or origin of the services provided at <bme.com>.

16 54. BME has sustained, and will continue to sustain, irreparable injury as a result of
17 Ricks’ conduct. This injury is not compensable solely by the award of monetary damages. Unless
18 Ricks is immediately restrained and enjoined from engaging in its infringing and diluting conduct,
19 BME will continue to suffer irreparable injury.

20 **FIRST CLAIM FOR RELIEF**

21 **Cybersquatting – 15 U.S.C. § 1125(d)**

22 55. BME incorporates by reference and realleges the allegations set forth in paragraphs
23 1-53, inclusive, as though set forth in their entirety herein.

24 56. This is an action under the ACPA, 15 U.S.C. § 1125(d).

25 57. Ricks’ Infringing Domain Name is confusingly similar to and/or dilutive of BME’s
26 famous BME mark.

27 58. Ricks has registered, has used, and/or is using the Infringing Domain Name with the
28 bad faith intent to profit from BME’s famous BME mark.

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1 59. Ricks' actions constitute a violation of the Lanham Act and the ACPA as codified at
2 15 U.S.C. § 1125(d).

3 60. BME has been, is now, and will continue to be irreparably harmed by Ricks'
4 aforementioned acts, and unless enjoined by the Court, Ricks' unauthorized use of the <bme.com>
5 domain name will continue, and there is no adequate remedy at law for the harm caused by the acts
6 alleged herein.

7 **SECOND CLAIM FOR RELIEF**

8 **Trademark Infringement under 15 U.S.C. § 1125(a)**

9 61. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
10 53, inclusive, as though set forth in their entirety herein.

11 62. This is an action for trademark infringement, pursuant to 15 U.S.C. § 1125(a).

12 63. BME alleges and believes that Ricks chose the <bme.com> domain name, adopted
13 the BME mark, and took the other actions alleged above, in order to cause confusion or mistake, to
14 deceive the public as to the origin, sponsorship, or approval of his services, and/or to deliberately
15 pass off his services as those of BME.

16 64. Ricks' conduct constitutes trademark infringement in violation of 15 U.S.C. §
17 1125(a).

18 65. Unless enjoined, Ricks will continue its infringing conduct.

19 66. As a direct and proximate result of Ricks' infringing conduct, BME has suffered and
20 will continue to suffer irreparable injury to its business reputation and goodwill for which no
21 adequate remedy exists at law, and BME has lost sales, visitors and profits in an amount not yet fully
22 ascertained.

23 67. Ricks conduct complained-of herein is malicious, fraudulent, knowing, willful, and
24 deliberate, entitling BME to an accounting of Ricks' profits, increased damages, and an award of it's
25 attorneys fees and costs incurred in prosecuting this action under 15 U.S.C. § 1117.

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THIRD CLAIM FOR RELIEF

Willful Trademark Infringement under 15 U.S.C. § 1114(1)

68. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-53, inclusive, as though set forth in their entirety herein.

69. This is an action for declaratory and injunctive relief and damages pursuant to 15 U.S.C. § 1114(1).

70. In the course of its conduct of business, BME's BME mark has been continuously used in association with the BME Websites. During this period, the BME mark and the BME reputation have continuously grown throughout the United States and worldwide as a source of origin for BME's services.

71. BME's mark has become associated in the minds of consumers with one of the most reputable tattoo and body piercing-related websites on the Internet, and BME enjoys the benefit of the ever-increasing fame and goodwill associated with the BME mark, as a result of its efforts and industry.

72. Ricks' aforementioned acts constitute willful infringement of BME's BME mark in violation of the Lanham Act, Section 32(1), 15 U.S.C. § 1114(1).

73. Consumers are likely to be confused by Ricks' use and display of the BME mark as a component of his URL.

74. Consumers who navigate to <bme.com> are likely to believe that they are navigating to a site owned or endorsed by BME, thereby falsely designating the origin of the goods and services offered via the infringing site.

75. Consumers, once so misled, are likely to purchase goods and services at the site <bme.com>, believing they are BME's or somehow affiliated with BME, thereby resulting in a loss of sales to BME, blurring of the source of origin of products and services, and diluting the value of BME's marks.

76. The use by Ricks of the BME mark in connection with the Infringing Domain Name is likely to cause confusion, mistake, and deception in the relevant marketplace as to the source of

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1 origin of online services delivered to the end user who accesses <bme.com>, and will continue to do
2 so unless enjoined by this Court.

3 77. By such wrongful acts Ricks has caused, and unless restrained by the Court, will
4 continue to cause serious irreparable injury and damage to BME and to the goodwill associated with
5 the BME mark, including diversion of customers, lost sales, and lost profits, blurring tarnishment
6 and dilution of the BME mark.

7 **FOURTH CLAIM FOR RELIEF**

8 **False Designation of Origin**

9 78. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
10 53, inclusive, as though set forth in their entirety herein.

11 79. This is an action for damages and injunctive and declaratory relief pursuant to 15
12 U.S.C. § 1125(a).

13 80. Ricks' aforementioned acts constitute false designation of origin, false representation
14 and false description in violation of the Lanham Act, Section 43(a), 15 U.S.C. § 1125(a).

15 81. By such wrongful acts, Ricks has caused, and unless restrained by the Court, will
16 continue to cause serious irreparable injury and damage to BME and to the goodwill associated with
17 BME's BME mark, including diversion of customers, lost sales and lost profits.

18 82. By such wrongful acts, Ricks has caused, and unless restrained by the Court, will
19 continue to cause injury to BME's trademark rights, and to cause serious irreparable injury and
20 damage to BME and to the goodwill associated with the BME mark, including diversion of
21 customers, lost sales, and lost profits.

22 **FIFTH CLAIM FOR RELIEF**

23 **Unfair Competition**

24 83. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
25 53, inclusive, as though set forth in their entirety herein.

26 84. Ricks' aforementioned acts constitute unfair competition under the common law and
27 under 15 U.S.C. § 1125(a).

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1 85. On information and belief, beginning on or about March 6, 2000, and continuing
2 thereafter, Ricks, without the consent of BME, registered an Internet Domain Name that infringed on
3 BME's trademark rights and diverted traffic from BME's online business by forwarding unwitting
4 customers to other websites that are in direct competition with BME.

5 86. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
6 the mistaken belief that Ricks' website <bme.com> is associated with BME.

7 87. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
8 the mistaken belief that Ricks' website is endorsed or sponsored by BME.

9 88. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
10 the mistaken belief that Ricks' website is in some way connected with BME.

11 89. This confusion is likely to influence the decision of members of the public as to
12 whether to use the services found at the sites to which <bme.com> resolves.

13 90. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
14 the mistaken belief that <bme.com> and/or the websites that it resolves to is associated with BME.

15 91. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
16 the mistaken belief that these websites are endorsed or sponsored by BME.

17 92. Ricks' use of the BME mark is likely to confuse and mislead the public and to induce
18 the mistaken belief that these websites are in some way connected with BME.

19 93. This confusion is likely to influence the decision of members of the public as to
20 whether to use the services provided at <bme.com>.

21 94. The aforesaid acts of Ricks constitutes false designation of origin and false
22 description and representation tending falsely to describe Ricks' website and services, all in violation
23 of § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

24 95. With knowledge of the falsity of such designation of origin, such description, and
25 such representation, Ricks has utilized the aforesaid domain name <bme.com> in interstate
26 commerce.

27 96. By reason of such false designation of origin and false description and representation
28 tending falsely to describe the aforesaid goods and services, BME has suffered and will continue to

1 suffer substantial damage to its business in the form of diversion of trade, loss of profits, loss of
2 goodwill, and damage to reputation.

3 97. By reason of the aforesaid false designation of origin and false description and
4 representation as alleged above, Ricks is liable to BME for the actual damages suffered by BME as a
5 result of Ricks' acts and any additional profits earned by Ricks as a result of said acts.

6 98. BME has been damaged by Ricks' aforementioned acts.

7 99. Unless restrained and enjoined, the aforesaid false designation of origin and false
8 description and representation tending to mislead consumers will cause BME irreparable injury.

9 **SIXTH CLAIM FOR RELIEF**

10 **Nevada Common Law Trademark Infringement**

11 100. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
12 53, inclusive, as though set forth in their entirety herein.

13 101. By virtue of having used and continuing to use its trademark, BME has acquired
14 common law rights in the BME mark.

15 102. Ricks' use of a mark identical and/or confusingly similar to BME's trademark
16 infringes BME's common law rights in its BME mark, and this use is likely to cause confusion,
17 mistake, or deception among consumers, who will believe that Ricks' web site and/or Internet
18 domain name originates from, or is affiliated with, or endorsed by BME when, in fact, it is not.

19 103. As a direct and proximate result of Ricks' infringement of BME's common law
20 trademark rights under Nevada and other common law, Plaintiff has suffered, and will continue to
21 suffer, monetary damages and irreparable injury to its business, reputation, and goodwill.

22 **SEVENTH CLAIM FOR RELIEF**

23 **Deceptive Trade Practices under N.R.S. § 598.0915**

24 104. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
25 53, inclusive, as though set forth in their entirety herein.

26 105. Upon information and belief, in the course of operating his website, Ricks knowingly
27 made false representations as to affiliation, connection and/or association with BME by using a mark
28 confusingly similar to BME's trademark and otherwise engaged in deceptive trade practices.

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1 106. As the direct and proximate result of Ricks' conduct, BME has suffered, and will
2 continue to suffer, monetary damages and irreparable injury to its business, reputation, and goodwill.

3 **EIGHTH CLAIM FOR RELIEF**

4 **Intentional Interference with Prospective Economic Advantage**

5 107. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
6 53, inclusive, as though set forth in their entirety herein.

7 108. Upon information and belief, at the time Ricks adopted and began using BME's name
8 and mark and since that time, Ricks knew and has known that BME is in the business of providing
9 various products, services, information and publications related to the body piercing and tattoo
10 industry.

11 109. Upon information and belief, Ricks committed acts intended or designed to disrupt
12 BME's prospective economic advantage arising from advertising and/or providing these products
13 and services.

14 110. Ricks' actions have disrupted or are intended to disrupt BME's business by, among
15 other things, diverting web users away from BME's various web sites.

16 111. Ricks has no legal right, privilege or justification for his conduct.

17 112. As a direct and proximate result of Ricks' intentional interference with BME's
18 prospective economic advantage, BME has suffered, and will continue to suffer, monetary damages
19 and irreparable injury.

20 113. Based on the intentional, willful and malicious nature of Ricks' actions, BME is
21 entitled to recover exemplary damages and reasonable attorneys' fees and costs incurred in
22 connection with this action.

23 **NINTH CLAIM FOR RELIEF**

24 **Trademark Infringement under the Fla. Stat. § 495.131**

25 114. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
26 53, inclusive, as though set forth in their entirety herein.

27 115. This is an action for damages and injunctive relief under the Florida Trademark Act,
28 § 495.131, *Fla. Stat.* (2007).

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1 116. Ricks' aforementioned acts constitute trademark infringement under the Florida
2 Trademark Act, § 495.131, *Fla. Stat.* (2007).

3 117. Consumers are likely to be confused by Ricks' use and display of the BME mark as a
4 component of Ricks' URL.

5 118. Consumers who navigate to <bme.com> are likely to believe that they are navigating
6 to a site owned or endorsed by BME, thereby falsely designating the origin of the goods and services
7 offered via the infringing site.

8 **TENTH CLAIM FOR RELIEF**

9 **Dilution Under the Fla. Stat. § 495.151**

10 119. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-
11 53, inclusive, as though set forth in their entirety herein.

12 120. This is an action for trademark dilution, pursuant to the Florida Trademark Act, §
13 495.151.

14 121. BME owns and has used the term "BME" as a distinctive trade name, trademark, and
15 service mark throughout the United States and the world. By reason of BME's longstanding and
16 exclusive use of its distinctive BME mark in connection with online journalism pertaining to body
17 piercing and tattooing, the widespread public identification of that mark with BME's products and
18 services, and the commercial success of the BME branded services, the BME mark is exceedingly
19 well-known and famous around the world, as well as within the state of Florida.

20 122. Ricks' unauthorized use of the BME mark in the <bme.com> domain name in the
21 state of Florida began after the BME mark had become famous in this state.

22 123. Ricks' unauthorized use of the BME mark, as a component of the <bme.com>
23 domain name is likely to dilute the distinctiveness and identity-evoking quality of the BME mark
24 and tradename in violation of *Fla. Stat.* § 495.151.

25 124. Ricks' wrongful acts of dilution are likely to cause, and/or have caused, and are
26 causing irreparable harm to BME for which there is no adequate remedy at law.

27 Pursuant to *Fla. Stat.* § 495.151, BME is entitled to injunctive relief enjoining and restraining Ricks
28 from engaging in any further acts of dilution.

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PRAYER FOR RELIEF

WHEREFORE, DEFENDANT PRAYS FOR JUDGMENT AS FOLLOWS:

1. That Plaintiff take nothing by virtue of this action and that same be dismissed with prejudice.
2. That Defendant be awarded it's attorney's fees and costs incurred in the defense of this action;
3. Such other and further relief as the Court may deem just and proper;
4. A preliminary and permanent injunction prohibiting Ricks, his respective officers, agents, servants, employees and/or all persons acting in concert or participation with them, or any of them, from: (1) using BME's trademark or confusingly similar variations thereof, alone or in combination with any other letters, words, letter strings, phrases or designs, in commerce or in connection with any business or for any other purpose (including, but not limited to, on web sites and in domain names); and (2) registering, owning, leasing, selling, or trafficking in any domain names containing BME's trademark or confusingly similar variations thereof, alone or in combination with any other letters, words, phrases or designs;
5. A preliminary and permanent injunction requiring the current domain name registrar to transfer the <bme.com> internet domain name to BME;
6. An award of compensatory, consequential, statutory, and punitive damages to BME in an amount to be determined at trial;

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1 D. An award of interest, costs and attorneys' fees incurred by BME in prosecuting this
2 action; and

3 E. All other relief to which BME is entitled.

4 DATED: November 7, 2008

5 **WESTON, GARROU, WALTERS &**
6 **MOONEY**

GREENBERG TRAUERIG, LLP

7
8 /s/ Lawrence G. Walters

/s/ Ronald D. Green

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CERTIFICATE OF SERVICE

I hereby certify that on November 7, 2008, I served the foregoing ANSWER TO COMPLAINT AND COUNTERCLAIM on:

Clarke Douglas Walton
Walton Law Firm, P.C.
8275 S. Eastern Ave., Suite 200
Las Vegas, NV 89123

Stevan Lieberman
Greenberg & Lieberman
2141 Wisconsin Ave., NW, Suite C2
Washington, D.C. 20007

by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

- by mailing in a sealed, first-class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.
- by hand delivery.
- by sending via overnight courier in a sealed envelope.
- by faxing to the attorney at the last-known fax number.
- by electronic mail to the last known e-mail address.

/s/ Rae Ann Chavez

An employee of Greenberg Traurig

CERTIFICATE OF SERVICE

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