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18 **UNITED STATES DISTRICT COURT**
 19 **CENTRAL DISTRICT OF CALIFORNIA**

20 SITETOOLS, INC., a California
 21 corporation,
 22 Plaintiff,

23 vs.

24 BANSK GROUP LLC, a Delaware
 25 limited liability company,
 26 Defendant.

CIVIL CASE NO.

COMPLAINT

1. **Declaratory Judgment of Non-Cybersquatting Under 15 USC 1125(d);**
2. **Declaratory Judgment of Non-Infringement; and**
3. **Cancellation of Junior Mark Under 15 USC § 1119**

1 Plaintiff SITETOOLS, INC. alleges as follows:
2

3 **Nature of the Case**
4

5 1. This is an action brought by Plaintiff SITETOOLS, INC. (“Sitetools”)
6 against Defendant BANSK GROUP LLC for declaratory relief pursuant to 28
7 U.S.C. § 2201 to establish that Sitetools’ senior registration and use of the
8 internet domain name <bansk.com> since 2013 (the "Domain Names") is not
9 unlawful under the Anticybersquatting Consumer Protection Act (15 U.S.C. §
10 1125(d) ("ACPA"), or otherwise under the Lanham Act (15 U.S.C. §§ 1051 et.
11 seq.); and for cancellation under 15 USC § 1119 of Defendant’s junior US
12 Trademark Reg. No. 6,148,600 issued in 2021.
13

14 **Parties**
15

16 2. Plaintiff, SITETOOLS, INC., is a California corporation having an address
17 of 1101 Lincoln Blvd., Santa Monica, CA 90403, in this judicial district.
18

19 3. Defendant, BANSK GROUP LLC, is a Delaware limited liability company
20 having an address of 65 Radcliffe Rd., Wellesley, MA 02482.
21

22 **Jurisdiction and Venue**
23

24 4. This Court has jurisdiction over the subject matter of this action pursuant to
25 the Declaratory Judgment Act, 28 U.S.C. §§2201-2202; the Lanham Act, 15
26 U.S.C. §1051 et seq.; the Anticybersquatting Consumer Protection Act (ACPA),
27 15 U.S.C. §1125(d); and 28 U.S.C. §1338 (trademarks).

1 5. This Court has jurisdiction over the parties as Plaintiff is located in this
2 judicial district and Defendant has directed threats of litigation into this district
3 against Plaintiff concerning acts performed by Plaintiff in the course of Plaintiff's
4 business conducted in this judicial district.

5

6 6. Venue is proper in this district under 28 U.S.C. § 1391 as a defendant in
7 this action resides in this district and a substantial part of the events or omissions
8 giving rise to the claim occurred in this district.

9

10 7. This action is properly assigned to the Western Division of this Court
11 because a substantial portion of the events giving rise to the dispute occurred in
12 Los Angeles County.

13

14 **General Allegations**

15

16 8. Plaintiff is an internet website developer established as a California
17 corporation in November 2006.

18

19 9. Plaintiff's business has included the acquisition of internet domain names
20 which Plaintiff believes to have commercial monetization potential and
21 developing websites for them or directing traffic from such internet domain
22 names to other websites pertaining to keyword content within such domain
23 names.

24

25 10. Over the course of its operations to date, the Plaintiff has obtained various
26 US registered trademarks relating to websites it operates or has operated, such as:

27

1	US TM Reg. No.	Word Mark
2	4103072	DEOS.COM
3	4099793	POCKETBOOK.COM
4	4375991	FOREVERMORE.COM
	4228704	CAMPUSWORKS.COM
5	4181043	NETPAD
6	4151875	MARKETREACH
	4136418	NETSPACE.COM
7	4038524	IGROOVE.COM
8	3993334	WORDSHOP.COM
	3990160	SELPAGE.COM
9	3985690	SITY.COM
10	3928795	VIDI
	3608178	AVIDA
11	3377223	SITETOOLS
12	4605673	TWEAKED

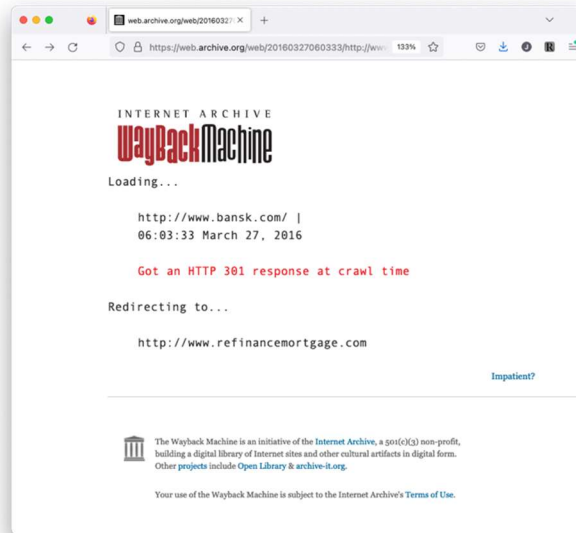
13 11. On or about August 22, 2013, Plaintiff acquired the internet domain name
14 bank.com.

15
16 12. Since having acquired the domain name bank.com, Plaintiff has used it to
17 advertise banking and financial services.

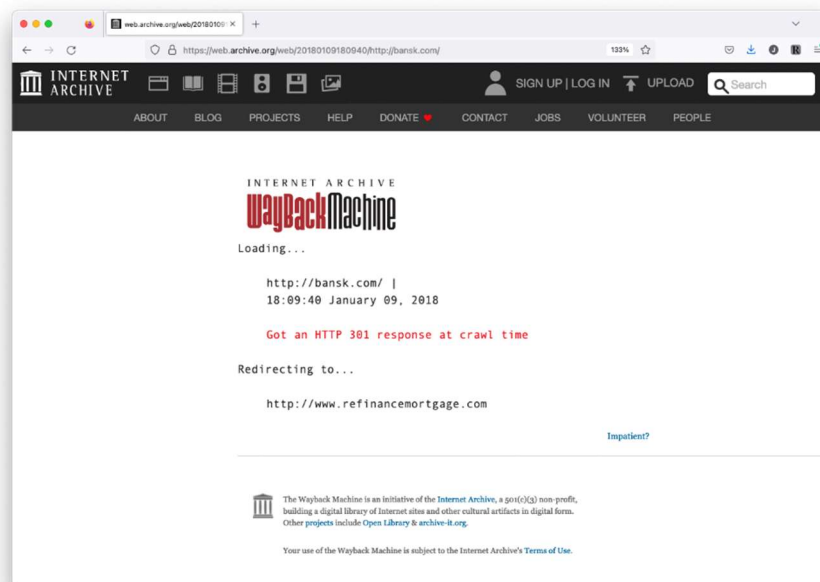
18
19 13. The Plaintiff's acquisition of bank.com is consistent with Plaintiff's
20 acquisition and development of domain names containing generic keywords, as
21 "bank" is a common typographical variant of the generic word "banks".
22

23 14. The Plaintiff's historical use of the domain name is shown, for example,
24 in the Internet Archive "Wayback Machine", which stores occasional visits to
25 internet websites. According to the Internet Archive, the Plaintiff has used the
26 domain name for many years to forward traffic for <bank.com> to a mortgage
27 information and referral website at <refinancemortgage.com>.

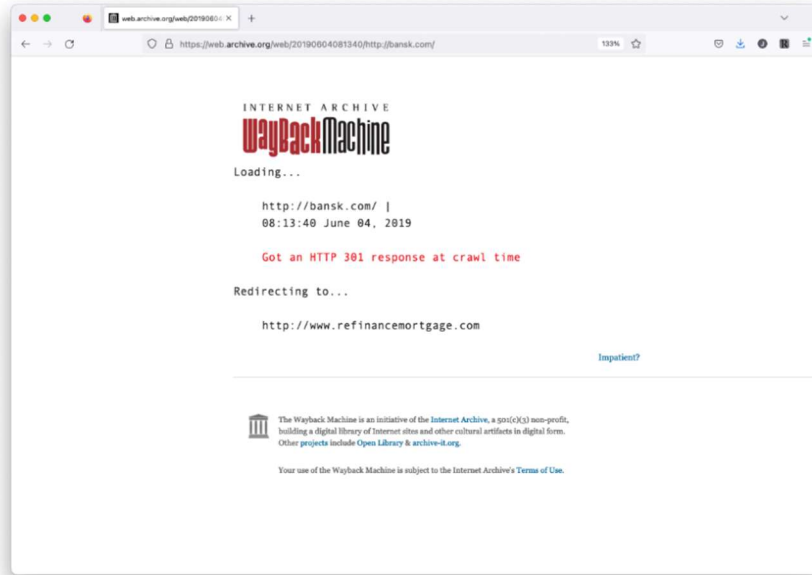
1 15. The Internet Archive entry for <bansk.com> for March 27, 2016, shows
2 that traffic was re-directed to <refinancemortgage.com>:



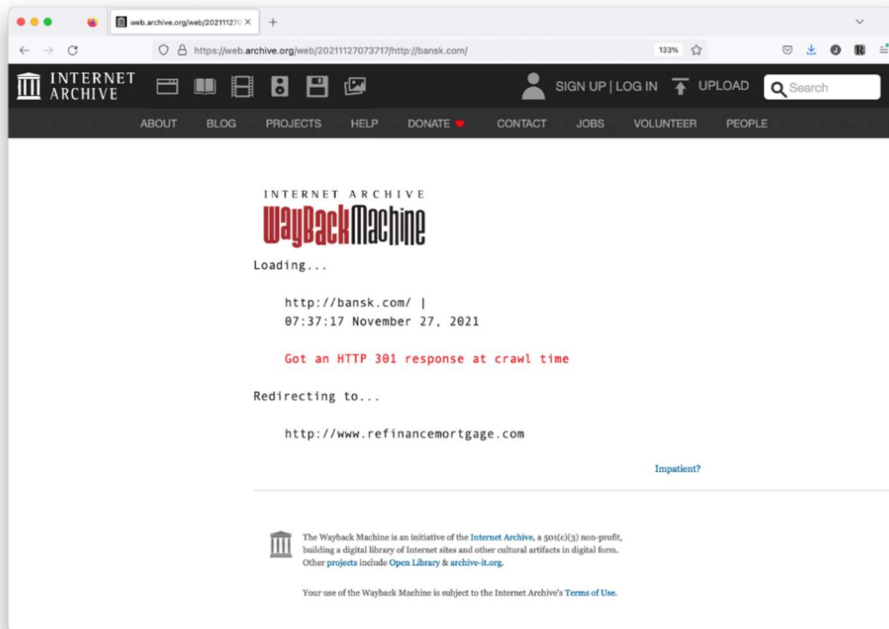
10
11
12
13 16. The Internet Archive entry for <bansk.com> for January 9, 2018, shows
14 that traffic was re-directed to <refinancemortgage.com>:



1 17. The Internet Archive entry for <bansk.com> for June 4, 2019, shows that
2 traffic was re-directed to <refinancemortgage.com>:
3



14
15 18. The Internet Archive entry for <bansk.com> for November 27, 2021,
16 shows that traffic was re-directed to <refinancemortgage.com>:
17



1 19. Plaintiff continues to direct traffic for <bansk.com> to
2 <refinancemortgage.com> in the same manner as Plaintiff has been doing since at
3 least as early as 2016 as shown in the Internet Archive.

4
5 20. Defendant Bansk Group LLC was formed as a Delaware LLC in March
6 2019.

7
8 21. Defendant utilizes the internet domain name <banskgroup.com> which
9 was registered in January 2019.

10
11 22. On information and belief, Defendant is not a successor in interest to any
12 prior user of any name or mark comprising “BANSK”.

13 23. At the time Defendant was formed, Defendant had registered and was
14 using the domain name <bansk.com> for more than five years senior to
15 Defendant.

16
17 24. At the time Defendant acquired the domain name <banskgroup.com>,
18 Plaintiff had registered and was using the domain name <bansk.com> for more
19 than five years senior to Defendant.

20
21 25. On information and belief, Defendant knew Plaintiff was the registrant
22 and user of the domain name <bansk.com> at the time Defendant settled upon
23 using the longer domain name <banskgroup.com>.

24
25 26. On or about April 29, 2019, Defendant filed US trademark registration
26 application no. 88/406,480 for “BANSK” for “Providing venture capital,
27 development capital, private equity and investment funding”.

1 27. Defendant's US trademark application was filed on an intent to use basis,
2 and did not claim use in commerce in the mark as of the time it was filed.

3
4 28. Defendant's application was accompanied by a Declaration under 18 USC
5 1001 signed by Defendant's Managing Member, William Mordan stating:

6
7 "To the best of the signatory's knowledge and belief, no other persons,
8 except, if applicable, concurrent users, have the right to use the mark in
9 commerce, either in the identical form or in such near resemblance as to be
10 likely, when used on or in connection with the goods/services of such other
persons, to cause confusion or mistake, or to deceive.

11 To the best of the signatory's knowledge, information, and belief, formed
12 after an inquiry reasonable under the circumstances, the allegations and
13 other factual contentions made above have evidentiary support.

14 The signatory being warned that willful false statements and the like are
15 punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and
16 that such willful false statements and the like may jeopardize the validity of
17 the application or submission or any registration resulting therefrom,
declares that all statements made of his/her own knowledge are true and all
statements made on information and belief are believed to be true."

18
19 29. At the time Mr. Mordan made the Declaration, Plaintiff had registered and
20 been using the domain name <bansk.com> to re-direct traffic to
21 <refinancemortgage.com> for more than five years.

22
23 30. On information and belief, Mr. Mordan has been licensed to practice law
24 in Ohio, New Jersey and Massachusetts.

25
26 31. On information and belief, Mr. Mordan had reason to know that his
27 Declaration was false, because the Plaintiff was already using the domain name

1 <bansk.com> and Defendant had already settled on the longer and less
2 convenient <banskgroup.com> domain name.

3
4 32. Defendant's application for US trademark registration was filed on an
5 "intent to use" basis. On or about June 26, 2020, Defendant, through its counsel,
6 submitted a "Statement of Use" in order to proceed toward registration of the
7 claimed "BANSK" mark.

8
9 33. Defendant's "Statement of Use" claimed a "date of first use" of December
10 16, 2019 of the claimed "BANSK" mark using an undated business card as its
11 specimen of use.

12
13 34. Plaintiff's registration of <bansk.com> is more than six years senior to
14 Defendant's claimed "date of first use."

15
16 35. Plaintiff's use of <bansk.com> to re-direct traffic to
17 <refinancemortgage.com> is at least more than three years senior to Defendant's
18 claimed date of first use of the claimed "BANSK" mark.

19
20 36. Defendant's "Statement of Use" was signed by a licensed attorney, Linda
21 Graham of Dunlap Bennett & Ludwig, acting on behalf of the Defendant. Ms.
22 Graham personally declared in the Statement of Use on behalf of the Defendant:

23
24 "To the best of the signatory's knowledge and belief, no other persons,
25 except, if applicable, authorized users, members, and/or concurrent users,
26 have the right to use the mark in commerce, either in the identical form or
27 in such near resemblance as to be likely, when used on or in connection
with the goods/services/collective membership organization of such other
persons, to cause confusion or mistake, or to deceive.

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To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”

37. At the time Ms. Graham signed the Declaration, Plaintiff had been using the domain name <bansk.com> for at least five years to re-direct traffic to <refinancemortgage.com>.

38. On information and belief, Ms. Graham’s Declaration was false and Ms. Graham had reason to know it was false by virtue of Plaintiff’s senior use of the domain name.

39. On the basis of representations made by Mr. Morden and Ms. Graham, Defendant procured US TM Reg. No. 6,148,600 on September 8, 2020.

40. On information and belief Defendant’s procurement of US TM Reg. No. 6,148,600 was procured through knowingly false declarations submitted to the United States Patent and Trademark Office during prosecution thereof.

41. At the time Defendant’s US trademark registration issued, Plaintiff had registered the domain name <bansk.com> for more than seven years.

1 42. On January 10, Defendant contacted Plaintiff via email, through counsel,
2 stating:

3

4 “I represent a party that is interested in acquiring the bansk.com domain
5 name. Based on the whois records, I believe SiteTools currently owns this
6 domain. Kindly let me know if your company would be willing to sell this
7 domain, and if so, what your asking price is.”

8

9 43. The January 10 email did not identify Defendant.

10

11 44. The January 10 email did not make any legal claim or raise any dispute
12 with the Plaintiff.

13

14 45. The January 10 email did not offer to settle a disputed legal claim with the
15 Plaintiff.

16

17 46. At the time of the January 10 email, Plaintiff was using the domain name
18 <Bansk.com> in the same manner as it had used the domain name since at least
19 as early as 2016. Plaintiff had no interest in selling the domain name, and
20 replied:

21

22 “The domain Bansk.com is currently not for sale. If your client has a
23 compelling offer we’d love to hear it.”

24

25 47. On January 11, Defendant offered US \$10,000 to purchase the domain
26 name, stating:

27

1 “My client is willing to offer \$10,000 to compensate for your time. Let me
2 know if that works for you.”

3

4 48. Defendant’s January 11 offer was not made to settle a legal claim of any
5 kind, and no legal claim had been raised by Defendant.

6

7 49. Plaintiff refused Defendant’s January 11 offer, and made no counter offer.

8

9 50. On November 2, 2022, Defendant’s counsel returned to Plaintiff with a
10 \$10,000 offer, this time including a threat of legal action if the Defendant refused
11 the offer, stating:

12

13 “My client is preparing a complaint under the Anticybersquatting Consumer
14 Protection Act and related laws regarding your company’s ownership and use
15 of the banks.com domain.”

16

17 51. In the November 2 email, Defendant’s counsel still did not identify
18 Defendant. Accordingly, Plaintiff engaged counsel to obtain further information
19 about the Defendant’s counsel’s threat of litigation. In a further response to
20 Plaintiff’s counsel, on November 10, 2022, Defendant’s counsel declared
21 Defendant’s intention to proceed with an “ACPA claim” against Plaintiff:

22

23 “I have simply stated the fact that my client is preparing a complaint. In terms
24 of the nature of that complaint, I have already informed you that it is an
25 ACPA claim. As you are well aware, ACPA claims are based on trademark
26 rights, so it likely comes as little surprise that my “mystery” client is the
27 owner of a federal trademark registration for BANSK in connection with

1 financial services (RN 6148600). Our claim is further based upon the fact that
2 your client has been using bank.com to forward traffic to its competing
3 financial services website offering mortgage services, which constitutes bad
4 faith use of the domain. Given that your client is located in the United States,
5 if the complaint is filed, we would be filing in personam rather than in rem,
6 which allows my client to seek not only transfer of the domain but also actual
7 damages and attorney’s fees.”

8

9 52. On November 11, 2022, Defendant’s counsel further stated:

10 “I have only communicated (in response to your express request for more
11 information about my client’s claims) my client’s intent to seek the remedies
12 allowed under federal law to compensate my client for the harms and losses
13 that your client has already inflicted on my client through its acts of
14 trademark infringement and cybersquatting.”

15

16

17 **COUNT 1 – Declaratory Judgment of Non-Cybersquatting**
18 **Under 15 USC 1125(d)**

19

20 53. Plaintiff hereby incorporates the allegations of Paragraphs 1 through 52,
21 by this reference as though set forth in full.

22

23 54. On information and belief, Defendant’s reference to an “ACPA claim” is
24 intended to refer to 15 USC 1125(d) which, along with other provisions of 15
25 USC, is commonly referred to as the “Anticybersquatting Consumer Protection
26 Act.”

27

1 55. Defendant has stated through counsel to be “preparing a complaint” and
2 stating that such complaint will “seek not only transfer of the domain but also
3 actual damages and attorney’s fees.”
4

5 56. Defendant has stated through counsel that it has an “intent to seek the
6 remedies allowed under federal law” through alleged “acts of trademark
7 infringement and cybersquatting.”
8

9 57. Based on Defendant’s communications through counsel Plaintiff has a
10 reasonable apprehension that the Defendant intends to act on its stated “intent to
11 seek the remedies allowed” based on claims Plaintiff has engaged in “acts of
12 trademark infringement and cybersquatting”.
13

14 58. Defendant has threatened legal action to deprive the Plaintiff of the
15 domain name and to seek monetary damages against the Plaintiff under the *in*
16 *personam* damages provisions of the ACPA.
17

18 59. Plaintiff’s business and assets threatened by the Defendant are located in
19 this judicial district.
20

21 60. Defendant’s initial contact with the Plaintiff in January 2022, long silence,
22 and renewed contact, including its threat of legal action against Plaintiff in
23 November 2022, causes a substantial and material uncertainty in the continued
24 conduct of Plaintiff’s business in relation to the domain name which the Plaintiff
25 has carried on for years.
26
27

1 61. In relation to cybersquatting against a trademark, the ACPA, 15 USC
2 1125(d), requires:

3 “a mark that is distinctive at the time of registration of the domain name”
4 (15 USC 1125(d)(1)(A)(ii)(I));

5 OR

6 “a mark that is famous at the time of registration of the domain name”
7 (15 USC 1125(d)(1)(A)(ii)(II)).

8

9 62. At the time of Plaintiff’s registration of the domain name in 2013, the
10 Defendant did not have a mark that was distinctive or famous.

11

12 63. At the time of Plaintiff’s registration of the domain name in 2013, the
13 Defendant did not even exist.

14

15 64. There is a bona fide dispute between the parties as to which of them has
16 the legal right to use the domain name <bansk.com>.

17

18 65. Plaintiff asks that the Court issue a Judgment declaring Plaintiff owns the
19 rights in and to the domain name <bansk.com> based on its prior years of usage
20 of <bansk.com> in commerce as set forth above.

21

22 **COUNT 2 – Declaratory Judgment of Non-Infringement**

23

24 66. Plaintiff hereby incorporates the allegations of Paragraphs 1 through 65,
25 by this reference as though set forth in full.

26

27 67. Plaintiff’s use of <bansk.com> to direct internet traffic to
<refinancemortgage.com> began at least as early as 2016. Such registration and

1 use has continued to date and is senior to any claim of rights by Defendant in its
2 claimed “BANSK” trademark.

3

4 68. Defendant’s claim of rights in its alleged “BANSK” mark is junior to the
5 acts of Plaintiff alleged by Defendant to constitute trademark infringement in
6 Defendant’s November 11, 2022 threat of litigation, and thus Defendant cannot
7 allege a necessary element of its claim of trademark infringement.

8

9 69. Plaintiff’s use of the domain name <bansk.com> to forward internet traffic
10 to <refinancemortgage.com> does not constitute use of the alleged “BANSK”
11 mark. The use of <bansk.com> as a forwarding domain name does not cause the
12 display of any “BANSK” mark on or in connection with any goods or services, or
13 is not an infringing use of the term “BANSK”.

14

15 70. Plaintiff’s use of the domain name <bansk.com> is intended to exploit a
16 common typographic variation of the word “banks”, and is thus generic in
17 connection with consumer mortgage information and referral services.

18

19 71. Plaintiff’s use of the domain name <bansk.com> for redirection to
20 consumer home mortgage information and referral services is unlikely to cause
21 confusion or mistake with Defendant’s alleged junior claim in “BANSK” for
22 business venture-oriented services of “Providing venture capital, development
23 capital, private equity and investment funding,” as the services are substantially
24 unrelated and directed to substantially different markets in respective consumer
25 and business services.

26

27

1 72. Plaintiff has periodically been charged automatic maintenance payments
2 for the <bansk.com> domain name. Plaintiff does not believe maintenance of
3 its prior existing domain name constitutes an infringement of Defendant’s
4 “BANSK” mark.

5
6 73. There is a bona fide dispute between the parties as to whether Plaintiff’s
7 use the domain name <bansk.com> infringes Defendants “BANSK” mark.

8
9 74. Plaintiff asks that the Court issue a Judgment declaring Plaintiff’s use of
10 its domain name <bansk.com> in commerce as set forth above does not infringe
11 Defendant’s “BANSK” mark.

12
13 **COUNT 3 - Cancellation of Junior Mark Under 15 USC § 1119**

14
15 75. Plaintiff hereby incorporates the allegations of Paragraphs 1 through 74,
16 by this reference as though set forth in full.

17
18 76. Plaintiff has been using the domain name <bansk.com> in commerce
19 since at least 2013 in conjunction with financial services.

20
21 77. According to its website, Defendant BANSK GROUP LLC is a private
22 investment firm formed in 2019. Defendant obtained a registration for its
23 “BANSK” trademark on September 8, 2020, as Registration Number 6148600.

24
25 78. Existence of Defendant’s “BANSK” mark in commerce for financial
26 investments creates a probability of consumer confusion with Plaintiff’s senior
27 <Bansk.com> domain name used in conjunction with financial services. Plaintiff

1 is harmed by Defendant’s continuing use of its “BANSK” mark. Plaintiff
2 therefore asks that the Court order Defendant’s “BANSK” trademark be
3 transferred to Plaintiff as the senior user, or alternatively cancelled to avoid any
4 risk of consumer confusion.

5

6 79. Plaintiff further asks that the Court award Plaintiff statutory damages
7 under 15 USC 1117(c) for up to \$200,000 to punish and deter Defendant’s willful
8 infringement of Plaintiff’s rights.

9

10

PRAYER FOR RELIEF

11

Wherefore, Plaintiff respectfully requests the Court grant the following
12 relief:

13

14

A. A Declaration that Plaintiff’s registration and use of the domain name
15 <bansk.com> does not violate Defendant’s rights under 15 USC 1125(d);

16

17

B. A Declaration that Plaintiff’s registration and use of the domain name
18 <bansk.com> does not infringe any trademark rights claimed by the Defendant;

19

20

C. (i) Transfer of ownership and control of rights to and including
21 Trademark Registration No. 6,148,600 to Plaintiff; *or alternatively*, (ii)
22 Cancellation of Defendant’s US trademark registration under 15 U.S.C. § 1119;

23

24

D. An injunction against any action by Defendant to interfere with
25 Plaintiff’s lawful use of the domain name <bansk.com>;

26

27

1 E. Transfer of ownership and control of the website domain
2 <banskgroup.com> to Plaintiff;

3

4 F. Statutory damages under 15 USC §1117(c) for up to \$200,000 to punish
5 and deter Defendant's willful infringement;

6

7 G. An award of attorney's fees and costs; and

8

9 H. Such other relief as the Court may deem appropriate.

10

11

Respectfully Submitted,

12

Dated: November 12, 2022

LONG & ASSOCIATES

13

/s/ Michael A. Long

14

Michael A. Long, Esq.

15

Counsel for Plaintiff,

16

SITETOOLS, INC.

17

Dated: November 12, 2022

JOHN B. BERRYHILL LLC

18

/s/ John B. Berryhill

19

John B. Berryhill, Ph.D., Esq.

20

(Pro Hac Vice Application Pending)

21

Counsel for Plaintiff,

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SITETOOLS, INC.

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