



07-CV-01381-CMP

Hon. John C. Coughenour

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AT SEATTLE  
CLERK U.S. DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
DEPUTY

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT SEATTLE

WHITE CAP CONSTRUCTION SUPPLY, )  
INC., a Delaware corporation; and HD )  
SUPPLY CONSTRUCTION SUPPLY, )  
LTD., a Florida limited partnership, )

Plaintiffs,

v.

The domain name "WHITECAP.COM" in  
rem; and A W REGISTRY, INC., Domain  
Name Registrar,

Defendants.

No. C07-1381C

PLAINTIFFS' FIRST AMENDED  
COMPLAINT AGAINST DOMAIN  
NAME IN REM TO TRANSFER  
DOMAIN NAME UNDER THE  
ANTICYBERSQUATTING  
CONSUMER PROTECTION ACT, 15  
U.S.C. § 1125(d)

S/ISS

Plaintiffs, White Cap Construction Supply, Inc. ("WCCS") and HD  
Supply Construction Supply, Ltd. ("HD Supply") (collectively, "White Cap"), for  
their complaint against the domain name whitecap.com, allege as follows:

FIRST CLAIM FOR RELIEF

(ANTICYBERSQUATTING CONSUMER PROTECTION ACT - 15 U.S.C. § 1125(D))

JURISDICTION

1. This claim for relief arises under the Lanham Trademark Act, 15  
U.S.C. §§ 1051-1127.

2. This court has subject matter jurisdiction over this claim for  
relief under 28 U.S.C. § 1338, 15 U.S.C. § 1121(a) and other federal statutes.

PLAINTIFFS' FIRST AMENDED COMPLAINT  
AGAINST DOMAIN NAME IN REM  
TO TRANSFER DOMAIN NAME - 1

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**THE PARTIES, PERSONAL JURISDICTION AND VENUE**

3. Plaintiff WCCS is a Delaware corporation with its principal place of business at 3120 Airway Avenue, Costa Mesa, California 92626.

4. Plaintiff HD Supply is a Florida limited partnership with its principal place of business at 3120 Airway Avenue, Costa Mesa, California 92626. Plaintiff WCCS is the predecessor-in-interest of Plaintiff HD Supply.

5. Plaintiff WCCS owns the United States trademark registration that is the subject matter of this lawsuit, and plaintiff HD Supply is the user of the trademark that is the subject of the trademark registration with WCCS's permission.

6. AW Registry, Inc. ("AW Registry"), is the registrar of the domain name at issue, *whitecap.com*. AW Registry's principal place of business is 2001 Sixth Avenue, Suite 500, Seattle, Washington 98121. Its email address is support@awregistry.net.

7. According to AW Registry's "Whois" database, *whitecap.com* is registered to oceanographical.com, which allegedly is located at 3453 Ingraham St., Suite B, San Diego, California 92109. However, on information and belief, the 3453 Ingraham Street address is that of a commercial mail receiving agency at which oceanograohical.com has a private mailbox. It is not a physical business address.

8. AW Registry claims to have no information about the owner(s) of oceanographical.com other than its address. No company has registered the fictitious name "oceanographical.com" with the San Diego County (California) County Clerk, although any business operating in San Diego County under the name oceanographical.com is required to register the name with the County Clerk. No company has registered a corporate name oceanographical.com with the California Secretary of State. Consequently, plaintiffs are not able to obtain in

1 *personam* jurisdiction over a person who would have been a defendant in a civil  
2 action under 15 U.S.C. § 1125(d)(1).

3 9. This court has *in rem* jurisdiction under 15 U.S.C. § 1125(d)(2)  
4 over the domain name *whitecap.com* because its domain name registrar resides in this  
5 district.

6 10. Venue is proper in this district under 28 U.S.C. § 1391(b)(3)  
7 because the domain name property is in this district.

8 **PLAINTIFFS' TRADEMARK RIGHTS**

9 11. White Cap's predecessor-in-interest founded a store named  
10 White Cap Construction Supply in 1976 to provide quality tools and services for the  
11 professional contractor community. Today, plaintiff HD Supply operates over 150  
12 "White Cap" stores throughout the United States.

13 12. Over the past 31 years, White Cap and its predecessor-in-  
14 interest have built a strong reputation of being a leader in providing quality  
15 products and quality services to the professional contractor community.

16 13. On or before May 25, 1984, plaintiff HD Supply, through its  
17 predecessor-in-interest, commenced using the trademark WHITE CAP in interstate  
18 commerce for "retail store and distributorship services in the field of construction  
19 tools, equipment and materials" ("the Services"). In this complaint, the term  
20 "WHITE CAP" in all upper case letters refers to plaintiffs' trademarks and service  
21 marks without limitation to the font, capitalization or stylization.

22 14. Since May 25, 1984, plaintiff HD Supply and its predecessor-in-  
23 interest continuously used the trademark WHITE CAP in interstate commerce for  
24 the Services.

25 15. Plaintiff WCCS owns United States Trademark Registration No.  
26 1,478,065 in International Class 42 for the trademark WHITE CAP for the Services

1 (Exhibit A). Registration No. 1,478,065 is incontestable within the meaning of 15  
2 U.S.C. § 1065.

3           16. Plaintiff HD Supply's predecessors also use the trademark  
4 WHITE CAP in interstate commerce on non-metallic building materials, namely,  
5 soffits, sewer and drain pipe of ceramic or earthenware or concrete or sandstone;  
6 deck drains of concrete or ceramic; bituminous waterproofing sheets; non-metal  
7 storm water pollution prevention products used as construction materials, namely  
8 storm water channels, erosion control jute mesh mats, silt fencing, drain filters, sand  
9 bags; non-metal concrete forming products, namely, panels, grout bags, rock texture  
10 mats, non-chemical concrete bond brakers, expansion board, curb and gutter felt,  
11 rebar caps, column forms, and form board ("the Goods").

12           17. White Cap owns considerable goodwill in the WHITE CAP  
13 trademark for the Goods and the Services. The trademark is inherently distinctive  
14 and has acquired secondary meaning.

15           **TODD ESREY'S UNAUTHORIZED USE OF THE WHITE CAP TRADEMARK**

16           18. In or about January 2004, Todd Esrey registered the domain  
17 name *whitecap.com* ("Infringing Domain Name"). Esrey also may have registered  
18 other domain names that are identical or confusingly similar to trademarks owned  
19 by WCCS.

20           19. Esrey's illegally-registered *whitecap.com* domain name  
21 incorporates "White Cap," a term that is identical or confusingly similar to WCCS's  
22 registered trademark.

23           20. WCCS neither licensed nor authorized Esrey to use the WHITE  
24 CAP trademark or to register any domain names that incorporate "White Cap" or  
25 any identical or confusingly similar term.

26

1           21. Esrey knew at all relevant times that the domain names he  
2 registered were identical or confusingly similar to White Cap's trademarks, and  
3 Esrey willfully infringed White Cap's trademarks.

4           22. On numerous occasions, White Cap notified Esrey that White  
5 Cap demanded that Esrey transfer the *whitecap.com* domain name to White Cap and  
6 that White Cap intended to sue Esrey if he refused.

7           23. Esrey admitted that he knew about White Cap, its business and  
8 its ownership of the WHITE CAP trademark. Nevertheless he still refused to  
9 transfer the *whitecap.com* domain name to White Cap.

10          24. Esrey also admitted that he knew that the *whitecap.com* domain  
11 name was valuable to White Cap and that White Cap would seek to obtain the  
12 domain name from him.

13          25. After White Cap complained to Esrey and demanded that Esrey  
14 transfer the *whitecap.com* domain name to White Cap, on information and belief,  
15 Esrey either caused the fictitious oceanographical.com entity to register the domain  
16 name, or he transferred the *whitecap.com* domain name to the fictitious  
17 oceanographical.com entity.

18          26. Persons entering *www.whitecap.com* on a web browser are  
19 redirected to a website of the United States government and a particular webpage  
20 that deals with ocean conditions. That webpage is otherwise available to the public  
21 through a United States Navy website at  
22 [https://www.fnmoc.navy.mil/CGI/ww3\\_loop.cgi?color=w&area=glo&prod=wcap\\_prbl](https://www.fnmoc.navy.mil/CGI/ww3_loop.cgi?color=w&area=glo&prod=wcap_prbl).  
23 Thus, persons who enter *www.whitecap.com* on their Internet browsers first are  
24 redirected to *www.oceanographical.com*. Although the browser continues to show  
25 *www.oceanographical.com* as the web address, the browser displays a single page of  
26 an otherwise publicly available United States government website. The

1 *www.whitecap.com* and *www.oceanographical.com* web sites display no other content  
2 and link to no third-party web sites.

3 27. Esrey and *oceanographical.com* committed their acts with the  
4 intent to deceive and cause confusion and mistake, and were otherwise deliberate,  
5 knowing, willful or in bad faith.

6 28. White Cap has been and will continue to be damaged by the  
7 acts of Esrey and *oceanographical.com*.

8 29. When persons type "*whitecap.com*" into their browsers, they  
9 expect to see content from plaintiffs White Cap. Instead, because of the acts by  
10 *oceanographical.com*, they see a webpage from a government website.

11 30. Esrey registered the domain name *whitecap.com* with bad faith  
12 intent to profit from the plaintiffs' WHITE CAP trademark and their goodwill.  
13 Esrey or *oceanographical.com*'s continued retention of the *whitecap.com* domain  
14 name is in bad faith.

15 31. Plaintiffs' WHITE CAP trademark was distinctive when Esrey's  
16 registered *whitecap.com* as his domain name.

17 32. The Infringing Domain Name *whitecap.com* is identical or  
18 confusingly similar to and dilutive of the WHITE CAP trademark.

19 33. Esrey has a history of cybersquatting. On October 29, 2004,  
20 Simpson Strong-Tie Company Inc. sued Esrey in the United States District Court for  
21 the Northern District of California because of Esrey's registration of the domain  
22 names *simpsonstrongtie.com*, *simpsonstrong-tie.com*, *strong-tie.com* and *strong-wall.com*.  
23 Even after Simpson Strong-Tie filed suit, Esrey would not transfer the domain  
24 names to Simpson Strong-Tie though Esrey knew that his registration of the domain  
25 names was in bad faith and in violation of Simpson Strong-Tie's rights. Esrey failed  
26 to answer the complaint, defaulted and had a default judgment entered against him.

1 The court awarded \$30,468.00 in damages and attorneys' fees and ordered Esrey to  
2 transfer the domain names.

3 34. Esrey's actions violate the Anticybersquatting Consumer  
4 Protection Act, 15 U.S.C. § 1125(d).

5 **REQUEST FOR RELIEF**

6 WHEREFORE, White Cap requests the following relief:

7 1. That this Court order defendant AW Registry to expeditiously  
8 deposit with the Court documents sufficient to establish the Court's control and au-  
9 thority over the disposition of the registration and use of the defendant domain  
10 name *whitecap.com*;

11 2. That this Court thereupon exercise its *in rem* jurisdiction over  
12 the defendant domain name *whitecap.com*;

13 3. That White Cap be awarded a judgment ordering AW Registry,  
14 the domain name registrar, to transfer the domain name registration and ownership  
15 of the domain name *whitecap.com* to White Cap permanently;

16 4. That White Cap be awarded its costs herein; and

17 5. That White Cap be awarded such other and further relief as the  
18 Court may deem just and proper.

19 DATED this 28th day of September, 2007.

20 MUNDT MacGREGOR L.L.P.

21  
22 By           /s/ J. David Stahl            
23 J. David Stahl  
24 WSB No. 14113  
25 Attorneys for Plaintiffs  
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**PLAINTIFFS' FIRST AMENDED COMPLAINT  
AGAINST DOMAIN NAME IN REM  
TO TRANSFER DOMAIN NAME - 8**

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# EXHIBIT A



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Word Mark: WHITE CAP  
 Goods and Services: IC 042, US 401, G & S: RETAIL STORE AND DISTRIBUTORSHIP SERVICES IN THE FIELD OF CONSTRUCTION TOOLS, EQUIPMENT AND MATERIALS. FIRST USE: 19830510. FIRST USE IN COMMERCE: 19840526  
 Mark Drawing Code: (S) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM  
 Design Search Code:  
 Serial Number: 73611720  
 Filing Date: July 28, 1986  
 Current Filing Basis: 1A  
 Original Filing Basis: 1A  
 Published for Opposition: December 1, 1987  
 Registration Number: 1479065  
 Registration Date: February 23, 1988  
 Owner: (REGISTRANT) WHITE CAP INDUSTRIES, INC. CORPORATION CALIFORNIA 1934 EAST EDINGER SANTA ANA CALIFORNIA 92705  
 (LAST LISTED OWNER) WHITE CAP CONSTRUCTION SUPPLY, INC. CORPORATION CALIFORNIA 3120 AIRWAY AVE. COSTA MESA CALIFORNIA 92626  
 Assignment Recorded: ASSIGNMENT RECORDED  
 Attorney of Record: BARUEL B. STONE  
 Type of Mark: SERVICE MARK  
 Register: PRINCIPAL  
 ANIM Text: SECT 15, SECT 8 (6-YR)  
 Live/Dead Indicator: LIVE

Exhibit A