

No. _____

IN THE
Supreme Court of the United States

JFXD TRX ACQ LLC, D/B/A TRX,
Petitioner,

v.

LOO TZE MING, ET AL.,
Respondents.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Ninth Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The Anticybersquatting Consumer Protection Act (ACPA) creates a cause of action against a person who in bad faith “registers, traffics in, or uses” an internet domain name that is identical or confusingly similar to a protected trademark that was famous or distinctive “at the time of registration of the domain name.” 15 U.S.C. § 1125(d)(1)(A)(ii)(I)-(II). The concept of registration of a domain name is thus central to ACPA liability.

Three circuits hold that the *re-registration* of a domain name counts as registration for ACPA purposes. The Ninth Circuit, however, alone holds that only the *initial* registration of a domain name is a “registration.” One implication of this rule is that if a domain name was first registered before the mark its name bears became famous or distinctive, the domain name can be transferred, sold, and used in bad faith in perpetuity, and this activity is forever beyond the reach of the ACPA.

The question presented is:

Whether registration of a domain name for purposes of the ACPA includes re-registrations, or if it is instead limited to the initial registration.

PARTIES TO THE PROCEEDING

Petitioner JFXD TRX ACQ LLC is a Florida-based limited liability company doing business as TRX. Petitioner was plaintiff-appellant in the court of appeals and plaintiff in the district court.

Respondents are Loo Tze Ming, an individual residing in Malaysia, and *trx.com*, a domain name included as a defendant under the lower courts' *in rem* jurisdiction. Respondents were defendants-appellees in the court of appeals and defendants in the district court.

CORPORATE DISCLOSURE STATEMENT

The parent corporation of petitioner JFXD TRX ACQ LLC is JFXD Capital LLC, a Florida-based limited liability company. JFXD Capital LLC is not publicly traded.

RELATED PROCEEDINGS

United States District Court for the Eastern District of Virginia:

JFXD TRX ACQ LLC v. trx.com, et al., No. 1:23-cv-00217-CMH-LRV (Nov. 6, 2023)

United States District Court for the District of Arizona:

JFXD TRX ACQ LLC v. trx.com, et al., No. 2:23-cv-02330-ROS (Feb. 26, 2024)

United States Court of Appeals for the Ninth Circuit:

JFXD TRX ACQ LLC v. trx.com, et al., No. 24-1661 (Apr. 4, 2025)

JFXD TRX ACQ LLC v. trx.com, et al., No. 24-3391 (Apr. 4, 2025)

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PETITION FOR A WRIT OF CERTIORARI

Petitioner JFXD TRX ACQ LLC (TRX) respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit.

INTRODUCTION

This case is about “cybersquatting,” which refers to “the bad faith, abusive registration and use of the distinctive trademarks of others as Internet domain names, with the intent to profit from the goodwill associated with those trademarks.” *Shields v. Zuccarini*, 254 F.3d 476, 481 (3d Cir. 2001). “Cybersquatting is the Internet version of a land grab.” *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 946 (9th Cir. 2002). By registering the domain names of well-known brands, cybersquatters can “force the rightful owners of the marks to pay for the right to engage in electronic commerce under their own name.” *Id.* Put simply, cybersquatting “is essentially extortion.” *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015).

As far back as 1999, Congress recognized that cybersquatting “threaten[ed] the continued growth and vitality of the Internet as a platform.” S. Rep. No. 106-140, at 8 (1999). That concern led to the enactment of the Anticybersquatting Consumer Protection Act (ACPA), Pub. L. No. 106-113, § 1000(a)(9) [app. I, tit. III], 113 Stat. 1536 [1501A-545] (1999).

The ACPA amended the Lanham Act to add a new cause of action against abusers of internet domain names that resembled protected trademarks. As relevant here, the statute allows mark owners to sue any person who,

with “a bad faith intent to profit from” a protected mark, 15 U.S.C. § 1125(d)(1)(A)(i), either “*registers*, traffics in, or uses a domain name,” *id.* § 1125(d)(1)(A)(ii) (emphasis added), that “is identical or confusingly similar to that mark,” *id.* § 1125(d)(1)(A)(ii)(I), so long as the mark was “distinctive at the time of *registration* of the domain name,” *id.* (emphasis added). Both as a prerequisite to liability and as a potential conduct element, the concept of “registration” is central to the ACPA’s scheme.

This case presents a straightforward but fundamental question: what does it mean to register a domain name? The Ninth Circuit, standing alone, holds that this concept refers only to the *initial* registration of a domain name. Three circuits, as well as numerous district courts, have rejected that view and held that subsequent registrations count as well. This Court should grant certiorari and hold that “registration” means any “registration,” not “initial registration.”

The Ninth Circuit adopted its extraordinarily narrow understanding of “registration” in *GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011). *GoPets* held that the ACPA’s references to registration cover only an *initial* registration—not any subsequent registrations (*i.e.*, *re-registrations*) of the domain name. The court identified no textual basis for this limitation; instead, it fretted that the statute would otherwise make it too difficult for owners of domain names to alienate them, contrary to the “general rule” in property law. *Id.* at 1031.

The practical effect of the Ninth Circuit’s cramped interpretation of the ACPA is that if the initial registration of a domain name was not a statutory violation, subsequent owners of that domain name are permanently

immunized from ACPA liability. Suppose a domain name (say, <kiwi.com>) was registered in the early days of the internet—perhaps by a speculating cyberpirate planting a flag on as many four-letter words he could think of. If a company called Kiwi later comes along and its marks become distinctive, it has no recourse under the ACPA against even a cybersquatter who in bad faith acquires and re-registers <kiwi.com> for the sole purpose of extorting money from Kiwi. In the Ninth Circuit’s view, since <kiwi.com> was *first* registered before Kiwi’s marks became distinctive, there can never be an ACPA claim against even the most nefarious cyberpirate.

That is what happened in this case. Petitioner TRX owns distinctive marks related to its successful brand of weight-training equipment. The domain name <trx.com>, however, was first registered by another entity in 1999, before TRX existed. So under the Ninth Circuit’s precedent, any cybersquatter is free to come along, unhampered by the ACPA, and acquire <trx.com> in bad faith for the sole purpose of holding it for profit rather than operating a web page. Respondent Loo Tse Ming did just that in 2022—at least a decade and a half after TRX’s marks became distinctive—but *GoPets* doomed TRX’s ACPA claim against him.

In the Third, Fourth, or Eleventh Circuits, TRX’s ACPA claim would be viable. Those courts of appeals have each rejected the Ninth Circuit’s analysis in *GoPets* and have held that the ACPA treats re-registrations of domain names no differently from initial registrations. These circuits have focused on the statutory text, noting that the Ninth Circuit’s contrary conclusion requires the

insertion of absent modifiers. And these courts—as well as every other district court to address the issue—have recognized that the Ninth Circuit’s view, which puts swaths of egregious cybersquatting behavior out of the ACPA’s reach, is irreconcilable with the statute’s purpose.

This Court should resolve the circuit split in this case. The Ninth Circuit held that *GoPets* foreclosed TRX’s ACPA claim. TRX pressed the Ninth Circuit to reconsider its view of the ACPA in light of the Third, Fourth, and Eleventh Circuit’s contrary conclusions, but the Ninth Circuit refused. Thus, the circuit split will persist unless resolved by this Court—leading to uncertainty nationwide over the scope of digital trademark rights. The Ninth Circuit’s position is unjustifiable, and it continues to extinguish meritorious cybersquatting claims like the one TRX asserts here. This Court should grant review to set things right.

OPINIONS BELOW

The memorandum disposition of the court of appeals (Pet. App. 1a-4a) is unreported but is available at 2025 WL 1009557. The order of the district court dismissing the second amended complaint (Pet. App. 19a-25a) is unreported but is available at 2024 WL 1221906. A separate order of the district court related to attorney’s fees (Pet. App. 5a-18a) is unreported but is available at 2024 WL 2844420.

JURISDICTIONAL STATEMENT

The judgment of the court of appeals was entered on April 4, 2025. A petition for rehearing was denied on

May 16, 2025. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

RELEVANT STATUTORY PROVISIONS

The pertinent sections of the U.S. Code, 15 U.S.C. §§ 1125 and 8131, are reproduced in the appendix to this petition. Pet. App. 38a-51a.

STATEMENT

A. Technical and Legal Background

1. A web page is identified by computers by its specific numerical address—its “IP address.” *See Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 774 (11th Cir. 2015); Karl M. Manheim & Lawrence B. Solum, *An Economic Analysis of Domain Name Policy*, 25 Hastings Commc’ns & Ent. L.J. 359, 364-65 (2003). It would be cumbersome, of course, if internet users had to keep track of and enter these numerical addresses. Instead, a web page is accessed through the use of its “domain name,” which is a unique “alpha-numeric mnemonic device that can be mapped onto an [IP] address.” *Jysk*, 810 F.3d at 774 (alteration in original) (quoting Jacqueline D. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 Wake Forest L. Rev. 1361, 1365 (2005)). An individual looking for information about this Court can thus type the easy-to-remember <supremecourt.gov> into her browser, without any need to memorize or type the less practicable “96.17.180.43” or “2600:1413:5000:34::173d:ca70.”¹ This

¹ *See DNS Records for www.supremecourt.gov*, NsLookup.io, <https://www.nslookup.io/domains/www.supremecourt.gov/dns-records> (last visited Aug. 12, 2025).

system—with alphanumeric shorthands for lengthy numerical addresses—is known as the “domain name system,” or “DNS.” Manheim & Solum, *supra*, at 361-62. Registration of domain names is overseen by an international nonprofit organization called the Internet Corporation for Assigned Names and Numbers, or “ICANN.” *See Jysk*, 810 F.3d at 775.

The process of domain-name registration involves three parties: the registry, the registrar, and the registrant. Returning to the <supremecourt.gov> example, the portion of this domain name to the right of the period (“.gov”) is called the “top-level domain.” *See Off. Depot Inc. v. Zuccarini*, 596 F.3d 696, 698 (9th Cir. 2010). Top-level domains are managed and controlled by *registries*; for instance, the “.com” top-level domain (used by most commercial web pages in the United States) is managed by the registry Verisign. *See id.* The domain name consists of the top-level domain and a second- (or further-) level domain—“supremecourt” in the example. *See id.*

The role of the *registrar* is to accept registrations from the public (*i.e.*, applicants) for domain names, connect to the relevant registry to check for availability, and to register the applicant’s IP address to the chosen domain name in the registry’s database on the applicant’s behalf. *Off. Depot*, 596 F.3d at 698-99. The applicant becomes the *registrant* once registration is complete. *Jysk*, 810 F.3d at 775. Registrars “maintain an ownership record for each domain name they have registered with a registry,” and “[a]ction by a registrar is needed to transfer ownership of a domain name from one registrant to another.” *Off. Depot*, 596 F.3d at 699. In particular, registrars “keep track of . . . domain names

and ensure that only one party controls a specific domain name during any given period.” *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3d Cir. 2003). As consideration “for the right to use the domain name for a fixed period of time, the registrant pays a certain sum of money and agrees to certain other conditions.” *Id.* Thus, when this process is complete, the registrant owns the domain name, and the details of that ownership are officially recorded by the registrar, which interacts with the registry to make the registrant’s web page accessible through the registered domain name. *Off. Depot*, 596 F.3d at 699.

Because the registration of a domain name is associated with a particular registrant (*i.e.*, owner) for a limited period, *Schmidheiny*, 319 F.3d at 582, the owner of a domain name must ensure that registration is timely renewed, or it can lose control over the name if someone else registers it following its lapse.² If ownership and control over a domain name changes hands, that change will generally be reflected by updating the information with the registrar. *See Off. Depot*, 596 F.3d at 699. And because domain names are unique, many brands may find themselves unable to register their preferred domain names if someone has already registered it. Indeed, modern brands with three- or four-letter trademarks often find that their preferred domain name

² *See, e.g.*, Darren Rovell, *Dallas Cowboys Forget to Renew Team Web Site*, CNBC (updated Nov. 9, 2010, 5:26 PM EST), <https://www.cnbc.com/2010/11/09/dallas-cowboys-forget-to-renew-team-web-site.html>; Lance Whitney, *Google Paid This Much to the Guy Who Briefly Owned google.com*, CNET (Jan. 29, 2016, 9:01 AM PT), <https://www.cnet.com/tech/services-and-software/what-did-google-pay-the-guy-who-briefly-owned-google-com>.

(say, <kiwi.com>) was captured in the early days of the internet, meaning that not only can they not use the domain name bearing their own business's mark, but their customers who attempt to access that domain name will inevitably be victims of confusion.

2. As noted above, Congress enacted the ACPA in 1999 to make it easier for brands to control domain names associated with their products and services. *See Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 808-09 (6th Cir. 2004). The ACPA created a cyber-squatting cause of action as Section 43(d) of the Lanham Act, ch. 540, 60 Stat. 427 (1946). ACPA § 3002(a), 113 Stat. at 1501A-545 to -548; *see* 15 U.S.C. § 1125(d).

As relevant here, the ACPA provides a cause of action to the owner of a trademark against a person who, with “a bad faith intent to profit from that mark,” 15 U.S.C. § 1125(d)(1)(A)(i), either “registers, traffics in, or uses a domain name” that “is identical or confusingly similar to th[e] mark,” *id.* § 1125(d)(1)(A)(ii)(I). A critical caveat is that the cause of action exists only if the mark “is distinctive at the time of registration of the domain name.” *Id.*³

As to the bad-faith element of the ACPA's cyber-squatting cause-of-action, the statute sets forth a nonexhaustive list of nine factors bearing on the question. 15 U.S.C. § 1125(d)(1)(B)(i)(I)-(IX). For instance, the defendant's “prior use . . . of the domain name in connection

³ The neighboring ACPA provision prohibits registering, trafficking in, or using a domain name that “is identical or confusingly similar to or dilutive of” a “famous mark that is famous at the time of registration of the domain name.” 15 U.S.C. § 1125(d)(1)(A)(ii)(II).

with the bona fide offering of any goods or services” is suggestive of no bad faith, *id.* § 1125(d)(1)(B)(i)(III), whereas 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” is suggestive of bad faith, *id.* § 1125(d)(1)(B)(i)(VIII). The statute also contains a safe-harbor provision, under which bad faith “shall not be found” if the defendant “believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.” *Id.* § 1125(d)(1)(B)(ii).

In addition to adding protections for trademarks, the ACPA also added “cyberpiracy protections for individuals.” ACPA § 3002(b), 113 Stat. at 1501A-548 (capitalization altered). It created a cause of action against “[a]ny person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent,” intending to profit by selling the domain name to the named person or to a third party. *Id.* § 3002(b)(1)(A), 113 Stat. at 1501A-548. (This provision was initially codified at 15 U.S.C. § 1129 (2000 ed.), but is now codified at 15 U.S.C. § 8131.)

B. Factual Background

1. The domain <trx.com> was first registered in 1999 by a legitimate U.S.-based business called TRX Inc., a technology company unrelated to petitioner. Pet. App. 6a; *see* C.A. SER 5. Petitioner’s TRX brand was founded in 2003 by Randy Hetrick, a former Navy SEAL. Pet. App. 6a, 30a; C.A. ER 48. TRX operations and intellectual-property ownership were originally

under the umbrella of an entity called Fitness Anywhere LLC; petitioner is the successor owner of the TRX business following Fitness Anywhere’s bankruptcy. Pet. App. 30a.

TRX is a fitness company that manufactures and sells training equipment enabling individuals to use their own body weight as resistance. D. Ct. Doc. 86, ¶ 10 (Feb. 21, 2024) (SAC). TRX owns the “TRX” mark and has used it continuously since 2005 in connection with fitness-related goods and services throughout the world. *Id.* ¶¶ 11-12. It also owns numerous other marks that are derivative of “TRX.” *See id.* ¶ 13 (listing trademarks). TRX’s marks are highly distinctive. *Id.* ¶ 16. And its satisfied users include no less than the late Justice Ruth Bader Ginsburg herself. *See* TRX® (@TRX-training), X (Aug. 27, 2018, 7:30 PM EDT), <https://x.com/trxtraining/status/1034221559903281152> (showing a video of Justice Ginsburg using TRX equipment).⁴

2. By 2013, the TRX Inc. that once owned the <trx.com> domain name was defunct. C.A. ER 63-64. Beyond this point, <trx.com> did not lead to any live web page. *Id.*

In April 2022, respondent Ming purchased <trx.com> as part of a strategy of investing in domain names. SAC

⁴ No surprise, the single-character domain name <x.com> was first purchased all the way back in the early 1990s. *See* Jimmy Soni, *The Colorful History of X.com (Aka the Website Formerly Known as Twitter)*, Medium (July 28, 2023), <https://medium.com/@jimmysoni/the-colorful-history-of-x-com-aka-the-website-formerly-known-as-twitter-53b3dfec0069>.

¶ 30. Ming had learned that short domain names potentially have large value, and he developed a portfolio of such domain names. C.A. ER 64. After learning that <trx.com> was available for purchase, Ming bought it—he has claimed the purchase price was \$138,000. SAC ¶ 30. He then arranged to have <trx.com> display a “for sale” page where anyone wishing to acquire the domain name could express interest in a purchase. *Id.* ¶ 31.

Ming then registered <trx.com> with GoDaddy (the registrar) using a fictitious name and contact information. SAC ¶¶ 8, 32, 39. He has never used the TRX mark or the <trx.com> domain name to offer any bona fide goods or services. *Id.* ¶¶ 35-36. Consistent with his intent when purchasing the domain name, Ming has since attempted to sell it for a profit. *Id.* ¶¶ 37-38.

C. Procedural History

TRX sued respondents in the Eastern District of Virginia, asserting a single count under the ACPA. D. Ct. Doc. 1 (Feb. 16, 2023).⁵ Amid concerns over whether respondent Ming was subject to personal jurisdiction in Virginia, and because there was ongoing litigation concerning ownership of <trx.com> in the District

⁵ The ACPA permits the owner of a mark to file an *in rem* action against the contested domain name itself if the domain’s owner cannot be located or would not be subject to personal jurisdiction in U.S. courts. *See* 15 U.S.C. § 1125(d)(2)(A)(ii). Pursuant to this provision, TRX initially named <trx.com> as an *in rem* defendant in the district where the registry is located. *See id.* § 1125(d)(2)(C)(i). There is no longer any live dispute over whether respondent Ming owns the domain name or is subject to personal jurisdiction in the United States.

of Arizona, the case was transferred to that district. D. Ct. Doc. 59 (Nov. 6, 2023).

TRX moved for a preliminary injunction. D. Ct. Doc. 68 (Nov. 20, 2023). The district court denied the motion on the ground that TRX’s cybersquatting claim under the ACPA had no likelihood of success. Pet. App. 29a-35a. The court noted the undisputed fact that <trx.com> was first registered in 1999, before TRX or its trademarks were in existence. *Id.* at 29a-30a. It observed that under *GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011), there could be no ACPA claim if the domain name was “initially registered” before the marks at issue existed. Pet. App. 33a. The court ordered TRX “to file a statement setting forth why its claim is viable in light of Ninth Circuit authority.” *Id.*

Finding TRX’s subsequently filed statement inadequate to overcome the governing precedent, the district court *sua sponte* dismissed the complaint. Pet. App. 26a-28a. The court again reiterated that, under the governing Ninth Circuit precedent, the ACPA claim could not go forward if the domain name had been registered since 1999, even if the ACPA defendant had himself acquired the domain name decades later. *Id.* at 27a.

The district court gave TRX leave to amend to try to plead around *GoPets*. Pet. App. 27a-28a. TRX filed a second amended complaint. D. Ct. Doc. 86. But the court once again *sua sponte* dismissed the complaint, this time with prejudice. Pet. App. 19a-25a. The court found that TRX had not plausibly alleged anything other than a *re*-registration of <trx.com> after the TRX marks became distinctive, and thus “Ninth Circuit authority preclude[d] [TRX’s] cybersquatting claim.” *Id.* at 22a.

Under *GoPets*, the court explained, “subsequent owners of [a] domain name have all [the] rights enjoyed by original registrants.” *Id.* (citing *GoPets*, 657 F.3d at 1024). That is, the court held that because the initial 1999 registrant of <trx.com> would not have had ACPA liability, neither could Ming, even though he purchased the domain name in 2022. *See id.* at 19a-22a.⁶

2. TRX appealed the district court’s judgment, arguing, as relevant here, that it had adequately pleaded facts that would render *GoPets* inapplicable and that *GoPets*, in any event, was wrongly decided and should be rejected or narrowed. C.A. Appellant’s Br. 12-14, 18-26. TRX also pointed out that there was a circuit split as to the key issue decided by *GoPets* and that, under the law of the Fourth Circuit (where TRX had initially filed), TRX would have stated an ACPA claim. *Id.* at 10-12.

The Ninth Circuit affirmed. Pet. App. 1a-4a. As relevant here, the court observed that under its precedent, “‘a re-registration of a currently registered domain name by a new registrant’ is not a ‘registration’ of that domain name,” and thus does not give rise to liability under the ACPA. *Id.* at 3a (quoting *GoPets*, 657 F.3d at 1026). Thus, the only way for TRX to state an ACPA claim was to allege “that it possessed rights in the mark ‘TRX’ before the initial registration of <trx.com>.” *Id.* The court of appeals agreed with the district court that

⁶ The district court later awarded attorney’s fees and expenses to Ming. Pet. App. 5a-18a; *see* 15 U.S.C. § 1117(a).

the operative complaint did not properly include such an allegation. *Id.*⁷

3. In its petition for rehearing, TRX urged the court of appeals to reconsider *GoPets*' interpretation of the ACPA, observing that it placed the Ninth Circuit on the wrong end of a 3-to-1 circuit split and effectively nullified the ACPA's protections for modern brands. C.A. Appellant's Reh'g Pet. 1; *see id.* at 3-5. The court of appeals denied the petition. Pet. App. 36a-37a.

REASONS FOR GRANTING THE PETITION

TRX's ACPA claim failed because of Ninth Circuit authority holding that "registration" of a domain name for purposes of the ACPA does not cover re-registrations. That holding conflicts with the positions of three other circuits and every other district court to consider the question. It is also wrong—deeming re-registrations not to be registrations rewrites the statutory text and provides a windfall to cyberpirates. This case presents a clean vehicle for resolving this important and recurring question of federal trademark law. This Court should grant review.

I. THE CIRCUITS ARE SHARPLY DIVIDED ON WHETHER RE-REGISTRATION OF A DOMAIN NAME IS REGISTRATION UNDER THE ACPA.

The ACPA grants a mark owner a cause of action against a person who, in bad faith, "registers, traffics in, or uses a domain name" that is "identical or confusingly

⁷ The court of appeals also affirmed the award of attorney's fees and expenses. Pet. App. 4a.

similar to” the protected mark, but only if the mark was “distinctive at the time of registration of the domain name.” 15 U.S.C. § 1125(d)(1)(A)(ii)(I). This case presents a straightforward question: does “registration” means the *initial* registration of a domain name, as the Ninth Circuit holds, or does that term include re-registrations, as three circuits and numerous district courts hold?

A. The Ninth Circuit Alone Holds That Re-Registration of a Domain Name Is Not Registration for Purposes of the ACPA.

1. In *GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011), the Ninth Circuit held that “the term ‘registration’” in the ACPA’s cause of action “applies only to the initial registration of the domain name.” *Id.* at 1026. There, Edward Hise (a defendant) had registered the contested domain name (<gopets.com>) in 1999, several years before the plaintiff company (GoPets Ltd.) was founded and registered trademarks bearing its name. *Id.* at 1026-27. The defendant registered the domain in good faith as part of a project in a marketing class and had initially intended to develop it into a pets-related resource, but that plan never came to fruition. *See id.* What ended up being a more lucrative use of the domain name was an attempt to sell it to the plaintiff for \$5 million. *Id.* at 1028. In 2006, during the course of these attempts to extort the plaintiff, ownership of <gopets.com> was transferred from Hise to his corporation. *Id.* It was subsequently re-registered by the corporation. *Id.* at 1030.

The plaintiff asserted, *inter alia*, an ACPA claim. *GoPets*, 657 F.3d at 1029. Analyzing that claim, the

Ninth Circuit explained that “[a]t issue in this case is what counts as ‘registration.’” *Id.* at 1030.

The court of appeals observed that “the gopets.com domain name was not ‘identical or confusingly similar to’ a protected mark when Edward Hise registered it in 1999.” *GoPets*, 657 F.3d at 1030 (quoting 15 U.S.C. § 1125(d)(1)(A)(ii)(I)). The plaintiff argued that it nonetheless had a viable cybersquatting claim because “the term ‘registration’ in ACPA includes re-registrations as well as initial registrations,” and the domain name had been re-registered by the corporation in 2006—after the plaintiff’s mark had become distinctive. *Id.* The court rejected that argument and “h[e]ld that [the] re-registration of gopets.com was not a registration within the meaning of” the ACPA. *Id.* at 1032; *see id.* at 1030-32.

The court of appeals first noted that the ACPA’s text “considered in isolation does not answer the question whether ‘registration’ includes re-registration.” *GoPets*, 657 F.3d at 1031. It therefore “[l]ook[ed] at ACPA in light of traditional property law.” *Id.* The court explained that “Edward Hise could have retained all of his rights to gopets.com indefinitely if he had maintained the registration of the domain name in his own name,” and it “[s]aw] no basis in ACPA to conclude that a right that belongs to an initial registrant of a currently registered domain name is lost when that name is transferred to another owner.” *Id.* After all, in the court’s view, “[t]he general rule is that a property owner may sell all of the rights he holds in property,” and reading “registration” to include re-registrations “would make rights to many domain names effectively inalienable, whether the alienation is by gift, inheritance, sale, or other form

of transfer.” *Id.* at 1031-32. And “[n]othing in the text or structure of the statute” convinced the court “that Congress intended that rights in domain names should be inalienable.” *Id.* at 1032.

The court acknowledged that it was departing from the Third Circuit’s decision in *Schmidheiny v. Weber*, 319 F.3d 581 (3d Cir. 2003). *GoPets*, 657 F.3d at 1031. *Schmidheiny* is discussed just below. *See* pp. 17-19, *infra*.

B. The Third, Fourth, and Eleventh Circuits Hold to the Contrary.

In conflict with the Ninth Circuit’s decision in *GoPets*, three other circuits have held that subsequently registering a domain name counts as registering it for ACPA purposes. In those circuits, when a domain name is re-registered in bad faith by a cybersquatter, the mark owner has an ACPA claim available, even if no claim could arise from the initial registration of the domain name.

1. The Third Circuit was first to address the question presented in *Schmidheiny*, 319 F.3d 581. That case involved the domain name <schmidheiny.com>, named for Stephan Schmidheiny, then one of the wealthiest individuals in the world (but later held responsible for hundreds of asbestos-related deaths and sentenced to twelve years’ imprisonment on manslaughter charges in Italy). *Id.* at 581-82; *see* Angela Giuffrida, *Swiss Billionaire Jailed over Asbestos-Related Deaths in Italian Town*, *Guardian* (June 8, 2023, 11:35 AM EDT), <https://www.theguardian.com/world/2023/jun/08/stephan-schmidheiny-swiss-billionaire-jailed-over-asbestos->

related-deaths-piedmont-italy. The domain name had been registered by the defendant (for pure cybersquatting purposes) prior to the enactment of the ACPA; following the statute’s enactment, the domain name was re-registered with a new registrar under the name of a new registrant, and the defendant subsequently tried to sell it to Schmidheiny (the person). *Schmidheiny*, 319 F.3d at 581, 583. Schmidheiny sued under the ACPA’s provision governing cybersquatters’ abuse of domain names bearing the names of individuals. *Id.* at 582; see 15 U.S.C. § 8131(1)(A); p. 9, *supra*.⁸

ACPA liability turned on whether the re-registration after the statute’s enactment counted as a registration. See *Schmidheiny*, 319 F.3d at 582. The district court had held that “the plain meaning of the word ‘registration’ as used by Congress imparts . . . no other meaning but the initial registration of the domain name.” *Id.* (internal quotation marks omitted). The Third Circuit reversed, holding that a domain name’s initial registration date does not “control whether a registration is subject to the [ACPA].” *Id.* The court observed that “[t]he words ‘initial’ and ‘creation’ appear nowhere” in the ACPA. *Id.* And because the plain meaning of “registration” encompassed subsequent registrations, the court explained that the narrower construction would add a limitation to the text that Congress had not included. *Id.* at 582-83. The court further noted that the apparent policy behind the ACPA also supported its interpretation: “[t]o conclude otherwise would permit the domain names of living persons to be sold and purchased

⁸ As noted above, at the time this provision was codified at 15 U.S.C. § 1129 (2000 ed.). See *Schmidheiny*, 319 F.3d at 582.

without the living persons’ consent, ad infinitum, so long as the name was first registered” at a time the ACPA imposed no liability. *Id.* at 583.

2. Four years after the Ninth Circuit created a circuit split in *GoPets*, the Eleventh Circuit took the Third Circuit’s side. See *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767 (11th Cir. 2015). *Jysk* involved a web designer who created a website for the plaintiff (a furniture company) but registered the domain name to himself. *Id.* at 771-72. When the registration lapsed years later, the defendant re-registered it in his own name and attempted to leverage his ownership to extract financial concessions from the plaintiff. *Id.* at 772. Facing an ACPA suit, the defendant argued that it was irrelevant whether his re-registration of the domain name was done in bad faith because the ACPA only prohibits bad-faith *initial* registrations of a domain name. *Id.* at 774.

The Eleventh Circuit observed that the Third and Ninth Circuits “ha[d] provided divergent answers to this question.” *Jysk*, 810 F.3d at 777. It “agree[d] with the Third Circuit” that the ACPA does not distinguish between initial registrations and re-registrations. *Id.* The court explained that the ACPA “nowhere contains the qualifications of *initial* or *creation* when it refers to the act of registering.” *Id.* Instead, “[i]t refers simply to a registration, and a re-registration is, by definition, a registration.” *Id.*; see *id.* (citing dictionary definition of “re-register” as “[t]o register again” (alteration in original) (internal quotation marks omitted)).

Beyond the textual support for its conclusion, the court of appeals also noted that “[i]ncluding re-registrations under the registration hook comports with the

purpose of Congress in enacting the ACPA—to prevent cybersquatting.” *Jysk*, 810 F.3d at 777. After all, the court explained, “[i]t would be nonsensical to exempt the bad-faith re-registration of a domain name simply because the bad-faith behavior occurred during a noninitial registration, thereby allowing the exact behavior that Congress sought to prevent.” *Id.* at 778.

3. Two years ago, the Fourth Circuit “join[ed] the Third and Eleventh Circuits in holding that the term ‘registers’ and its derivatives extend to each registration of a domain name, including . . . any subsequent re-registrations.” *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023). The case involved <pru.com>, a domain name that infringed on Prudential’s marks and that was purchased by a foreign company in 2017 from a third party, long after the marks became distinctive. *Id.* at 789. The foreign-company defendant argued that its 2017 re-registration of the domain name “[wa]s not a qualifying ‘registration’ within the meaning of the ACPA because an unaffiliated . . . company initially registered the PRU.COM domain name before Prudential trademarked the term PRU in the United States.” *Id.* at 794. The court of appeals noted that “the Third, Ninth, and Eleventh Circuits” had “considered the issue and split on the meaning of the term ‘registers’ and its derivatives” in the ACPA. *Id.*

The Fourth Circuit sided with the Third and Eleventh Circuits. Beginning with the text, the court explained that “[t]o ‘re-register’ simply means ‘to register again.’” *Prudential Ins.*, 58 F.4th at 796 (quoting dictionary). Accordingly, the court held that “the ordinary

meaning of the word ‘registers’ necessarily includes both the first registration and any subsequent re-registrations.” *Id.* “And because the ACPA does not expressly limit the term registers to only the initial or creation registration,” the court “conclude[d] that the re-registration of a domain name is a registration for purposes of the ACPA.” *Id.*

The court of appeals rejected *GoPets*’ opposite conclusion as “contrary to the statutory purpose of the ACPA, which is to curtail cyberpirates and cybersquatting.” *Prudential Ins.*, 58 F.4th at 796. The court acknowledged that its interpretation of the ACPA interfered with the alienability of domain names, the primary concern motivating the Ninth Circuit’s position, but it was unmoved, agreeing with the Eleventh Circuit that it “would be ‘nonsensical’ to *not* include re-registrations within the purview of the ACPA.” *Id.* (quoting *Jysk*, 810 F.3d at 778).⁹

The Fourth Circuit also acknowledged the Ninth Circuit’s “public policy concern” that if re-registrations were covered by the ACPA, “minor, periodic re-registrations of domain names” could lead to liability. *Prudential Ins.*, 58 F.4th at 797 (internal quotation marks omitted). But the court explained that the ACPA’s

⁹ As just one illogical consequence of *GoPets*, the Fourth Circuit observed that “if the ACPA were limited to initial registrations, a mark owner would not have a cause of action where, following the withdrawal of a partner who was the initial registrant of a domain name, the departing partner is instructed by the remaining partners to re-register the domain name in the partnership’s name but, in an attempt to extort the partnership, does not.” *Prudential Ins.*, 58 F.4th at 797.

cause of action requires the defendant to act with a bad-faith intent to profit. *Id.*; see 15 U.S.C. § 1125(d)(1)(A)(i). The court believed that the ACPA’s bad-faith requirement alleviated any concerns about good-faith adjustments to registration leading to unintended liability for innocent domain-name owners. *Prudential Ins.*, 58 F.4th at 797.

C. Each District Court to Address the Question Presented Has Likewise Rejected the Ninth Circuit’s View.

The question presented has also arisen in a number of district courts. Each recognized the clear circuit split. And each sided with the majority view.

For instance, the defendant in *We the Protestors, Inc. v. Sinyangwe*, 724 F. Supp. 3d 281 (S.D.N.Y. 2024), argued that the ACPA claim at issue failed because “[t]he ACPA looks to whether the claimant’s mark is distinctive at the time the allegedly infringing domain was registered, not when the registration is later renewed.” *Id.* at 298 (alteration in original) (internal quotation marks omitted). The court noted that this argument “implicate[d] a circuit split over the meaning of registration under the ACPA and more specifically over whether a re-registration falls within the meaning of that term.” *Id.* at 298-99. And it concluded that the Third, Fourth, and Eleventh Circuits “have the better of the argument.” *Id.* at 299; see *id.* at 299-300.

Likewise, in *WorkForce Software, LLC v. Workforce.com, Inc.*, No. 20-cv-7365, 2021 WL 4963608 (N.D. Ill. Oct. 26, 2021), “[t]he question before the Court [wa]s whether the term ‘registration’ [in the ACPA] extends

to re-registration events after the creation and initial registration of a domain.” *Id.* at *8. After canvassing the then-2-to-1 circuit split, the court “ultimately agree[d] with the approach taken by the Third and Eleventh Circuits.” *Id.* at *9. Other district courts have similarly acknowledged the split of authority and rejected the outlier view of the Ninth Circuit, instead concluding that “the best interpretation of the word registration in the ACPA is that it includes re-registrations.” *Instructure, Inc. v. Canvas Techs., Inc.*, No. 21-cv-454, 2022 WL 43829, at *17 (D. Utah Jan. 5, 2022); *see also Xereas v. Heiss*, 933 F. Supp. 2d 1, 16 & n.10 (D.D.C. 2013) (“*GoPets* is not persuasive . . .”).

* * *

In short, the Ninth Circuit stands alone in holding that the concept of “registration” in the ACPA contains a hidden modifier limiting it to *initial* registrations. Every other court of appeals and district court to consider the issue has rejected that view.

And the consequences of the split are nowhere more stark than in this very case. TRX initially brought this suit in the Eastern District of Virginia, where—under *Prudential Insurance*—its ACPA claim could have gone forward. Pet. App. 5a; *see Prudential Ins.*, 58 F.4th at 794-97. But the case was transferred to the District of Arizona, Pet. App. 5a, making *GoPets* the governing precedent, and dooming TRX’s claim. This Court should not abide the status quo in trademark law, under which the viability of a federal claim rises and falls with circuit lines.

II. THE NINTH CIRCUIT’S OUTLIER POSITION IS WRONG.

The Ninth Circuit’s *GoPets* decision is not just on an island—it is wrong. The text and purpose of the ACPA point to a commonsense result: re-registering a domain name is registering it.

The question presented arises when the owner of a domain-name takes steps to “register” a domain name that has previously been registered in the past. That is, the question is whether such “re-registration” is also “registration.” It plainly is. To “re-register” something is simply “to register [it] again.” *Reregister*, Merriam-Webster, <https://www.merriam-webster.com/dictionary/re-register> (last visited Aug. 12, 2025); *accord Prudential Ins.*, 58 F.4th at 796; *Jysk*, 810 F.3d at 777. That should be the end of the case.

That a “re-registration” is a “registration” all the same is consistent with how “re-XX” words work throughout the English language. A “remarriage” is no less a “marriage” just because one of the participants was previously married. Similarly, one who “repaints” his house also “paints” it; that it is a “repaint” job simply reflects that the house was once before painted but has little bearing on whether the task at hand is “painting.” Likewise, ask anyone who has been subject to “reimprisonment,” *Esteras v. United States*, 145 S. Ct. 2031, 2036 (2025), and he will make clear that it is no less “imprisonment” than the first go-around.

The same goes for the ACPA. As the courts in the majority have observed, the ACPA’s references to “register[ing],” 15 U.S.C. § 1125(d)(1)(A)(ii), and

“registration,” *id.* § 1125(d)(1)(A)(ii)(I), are not qualified by the word “initial.” See *Schmidheiny*, 319 F.3d at 582-83; *Jysk*, 810 F.3d at 777; *Prudential Ins.*, 58 F.4th at 796. Instead, Congress spoke just of a “registration” *simpliciter*—re-registrations included.

The ACPA’s purpose also supports the majority view. The ACPA was enacted to stop bad actors from obtaining and sitting on domain names similar to protected trademarks for the sole purpose of profiting off the ownership. See *S. Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009) (“The practice of holding domain names for ransom with an intent to profit directly from selling the domain name itself is the paradigmatic harm targeted by the [ACPA].” (internal quotation marks omitted)); *Ford Motor Co. v. Catalanotte*, 342 F.3d 543, 549 (6th Cir. 2003) (“Registering a famous trademark as a domain name and then offering it for sale to the trademark owner is exactly the wrong Congress intended to remedy when it passed the ACPA.”). Under the *GoPets* rule, however, the ACPA is enfeebled. So long as a domain name was *long ago* registered before a trademark became distinctive, the Ninth Circuit holds that cyberpirates can have at that domain name with impunity forever. As several courts of appeals have recognized, “it would be ‘nonsensical’ to *not* include re-registrations within the purview of the ACPA as it would allow for ‘the exact behavior that Congress sought to prevent.’” *Prudential Ins.*, 58 F.4th at 796-97 (quoting *Jysk*, 810 F.3d at 778).

The Ninth Circuit’s contrary conclusion in *GoPets* rested almost entirely on the theory that, under “traditional property law” principles, “[t]he general rule is

that a property owner may sell all of the rights he holds in property.” 657 F.3d at 1031. Based on that observation, the court saw “no basis in ACPA to conclude that a right that belongs to an initial registrant of a currently registered domain name is lost when that name is transferred to another owner.” *Id.* And the court worried that, if “registration” included re-registrations, that “would make rights to many domain names effectively inalienable.” *Id.* at 1031-32.

That logic is not persuasive. The entire premise of the ACPA is to disrupt the ordinary operation of “traditional” property rights—under which anyone would be free to scoop up an unregistered domain name, even if it were similar to a distinctive mark, and then try to sell the domain name to the mark owner for an extortionate sum. *See Storey v. Cello Holdings*, 347 F.3d 370, 372-73 (2d Cir. 2003) (Sotomayor, J.) (noting that domain names are assigned “through a first-come, first-serve process that does not consider trademark rights”). Congress enacted the ACPA because it identified that the operation of ordinary property-law principles facilitated harmful cybersquatting activity and hampered development of the internet. Given that the core purpose of the ACPA was to *divest* certain property rights in order to protect mark owners’ rights, the Ninth Circuit should not have looked to traditional property rights as the basis for giving the ACPA a narrow construction.

III. THE QUESTION PRESENTED IS WORTHY OF THIS COURT’S REVIEW.

This Court’s review is warranted. As this case illustrates, cybersquatting has not abated as a serious problem in digital commerce since Congress addressed it in

the late 1990s, and the ACPA continues to be a frequent font of litigation—note the recent decisions discussed above from the Fourth Circuit and multiple district courts. *See* pp. 20-23, *supra*. And given the nationwide reach of the internet, it is particularly unsettling to abide a circuit split that creates uncertainty about the scope of mark owners’ online rights. Further, as time goes on, and the time since the initial registration of a domain name increases, it becomes more and more difficult for plaintiffs within the Ninth Circuit to establish bad faith in connection with the initial registration—further deepening the practical significance of the circuit split.

In fact, review of the question presented is especially ripe now that the Fourth and Ninth Circuits have staked out opposing positions. Because of the operation of the ACPA scheme, litigation as to domain-name ownership is focused in those two circuits. The most important registry for U.S. commerce—Verisign, which maintains all “.com” domain names—is headquartered in the Eastern District of Virginia. *See Prudential Ins.*, 58 F.4th at 789. And the key registrar—GoDaddy—is headquartered in the District of Arizona. *Id.* ACPA disputes often proceed as *in rem* cases against the domain name because cyberpirates either operate from abroad (and are not subject to personal jurisdiction in the United States) or use fictitious information when registering the domain name, making it impossible to locate the registrant. *See* H.R. Rep. No. 106-464, at 114 (1999). In these circumstances, the ACPA permits actions to be brought where either the registry or registrar is located, 15 U.S.C. § 1125(d)(2)(A), *see* p. 11 n.5, *supra*, so cases are often brought in Virginia or Arizona. And because GoDaddy

requires registrants to submit to personal jurisdiction in Arizona, *Prudential Ins.*, 58 F.4th at 789, cases (like this one) against foreign cyberpirates will often end up in that district even when the domain-name owner can be identified and the action proceeds as an *in personam* case.

Nor is further percolation necessary. The arguments on both sides have been fully aired in the four precedential opinions addressing the question presented. Moreover, there is no reason to think that the Ninth Circuit will bring itself into alignment with the majority view. In this very case, TRX preserved and forcefully asserted its view that *GoPets* was wrongly decided and should be reconsidered, including in its petition for rehearing en banc. Appellant’s C.A. Br. 18-26; Appellant’s C.A. Reh’g Pet. 2-5. The court of appeals showed no interest, consistent with its approach for the last 14 years. Pet. App. 36a-37a; see *Dent v. Lotto Sport It. SpA*, No. 17-cv-651, 2021 WL 242100, at *9 (D. Ariz. Jan. 25, 2021) (“[T]he Ninth Circuit has not altered its analysis of re-registration since it published *GoPets*.”). *GoPets* created a split on the day it was decided, that split has only deepened, and it will continue to deepen absent this Court’s intervention.

IV. THIS CASE IS AN EXCELLENT VEHICLE FOR RESOLVING THE QUESTION PRESENTED.

This case presents an excellent opportunity to resolve the question presented. Application of *GoPets* was the sole basis for dismissal of TRX’s complaint. See Pet. App. 3a, 22a, 32a-33a. The district court *sua sponte* flagged TRX’s complaint for dismissal based on the fact

that a nonparty had registered the domain name <trx.com> in 1999, prior to TRX’s marks becoming distinctive. *Id.* at 33a, 35a. Under *GoPets*, therefore, TRX’s marks were not “distinctive at the time of registration of the domain name,” 15 U.S.C. § 1125(d)(1)(A)(ii)(I), and so TRX’s ACPA claim failed even though respondent Ming re-registered the domain name in 2022, *after* the marks became distinctive.

This case would have come out differently in the Third, Fourth, and Eleventh Circuits. In those courts of appeals, re-registering a domain name—as Ming did in 2022—counts as a registration under the ACPA. *See* pp. 17-22, *supra*. Under the law of those circuits, therefore, Ming “register[ed]” the domain name <trx.com> with a bad-faith intent to profit from TRX’s marks, and did so where the marks were “distinctive at the time of registration of the domain name”—*i.e.*, in 2022. 15 U.S.C. § 1125(d)(1)(A)(ii)(I). TRX would therefore have stated a claim under the ACPA.

Further, this case raises the question presented without any difficult ancillary questions about whether the defendant’s conduct truly counts as a “registration” of the domain name. In *GoPets*, the Ninth Circuit articulated concern about whether minor updates with a registrar relating to billing might be deemed “re-registrations,” and hence “registrations,” under the ACPA. 657 F.3d at 1030-31. But here there is no serious question that respondent Ming “registered” the <trx.com> domain name in 2022; he purchased the domain name from a third party and newly registered it with his own (albeit fictitious) name and contact information. SAC ¶¶ 32, 39.

Indeed, this case presents exactly the sort of facts that Congress was trying to address in the ACPA. An American company owns distinctive trademarks related to its legitimate business, TRX. SAC ¶¶ 10-22. A foreign pirate acquired the domain name <trx.com> with no intent to operate a business using the name “TRX” or even to operate the webpage for any purpose; instead, he purchased it solely to try to obtain money from the American business (or others), who he hoped would be willing to pay exorbitant sums for an asset that only had value to TRX. *Id.* ¶¶ 23-43. That is precisely the sort of behavior the ACPA attempted to eradicate, and only in the Ninth Circuit is it inexplicably beyond the ACPA’s reach. Granting certiorari and resolving the circuit split in TRX’s favor would restore the “the ACPA’s purpose,” as reflected in its clear text, “of eliminating cybersquatting and protecting American businesses, consumers, and online commerce.” *Prudential Ins.*, 58 F.4th at 797.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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APPENDIX

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APPENDIX A

FILED

APR 4 2025

Molly C. Dwyer, Clerk
U.S. Court of Appeals

NOT FOR PUBLICATION

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

JFXD TRX ACQ LLC, a
Florida limited liability com-
pany,

Plaintiff - Appellant,

v.

TRX.COM, a domain name;
LOO TZE MING, an individ-
ual from Malaysia,

Defendants - Appellees.

No. 24-1661

D.C. No.

2:23-cv-02330-ROS

MEMORANDUM*

* This disposition is not appropriate for publication and is not precedent except as provided by Ninth Circuit Rule 36-3.

JFXD TRX ACQ LLC, Plaintiff - Appellant, v. TRX.COM; LOO TZE MING, Defendants - Appellees.
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No. 24-3391
D.C. No.
2:23-cv-02330-ROS

Appeal from the United States District Court
for the District of Arizona

Roslyn O. Silver, District Judge, Presiding

Submitted April 2, 2025**
Phoenix, Arizona

Before: HAWKINS, W. FLETCHER, and R. NELSON, Circuit Judges.

In these two appeals, Appellant, JFXD TRX ACQ LLC (“JFXD”), challenges both the dismissal of its complaint for failure to state a claim and the award of attorneys’ fees under the Lanham Act.

We review de novo the district court’s dismissal of a complaint for failure to state a claim. *Benavidez v. Cty. Of San Diego*, 993 F.3d 1134, 1141 (9th Cir. 2021). We review de novo the district court’s decision concerning the appropriate choice of law. *Stromberg v. Qualcomm Inc.*, 14 F.4th 1059, 1066 (9th Cir. 2021). We review an attorneys’ fee award under the Lanham Act for an abuse

** The panel unanimously concludes this case is suitable for decision without oral argument. *See* Fed. R. App. P. 34(a)(2).

of discretion. *SunEarth, Inc. v. Sun Earth Solar Power Co., Ltd.*, 839 F.3d 1179, 1181 (9th Cir. 2016) (en banc).

JFXD owns the popular fitness brand TRX and its associated intellectual property. Appellee, Loo Tze Ming, owns the domain name <trx.com>.

First, JFXD contends that the district court erred by applying Ninth Circuit law instead of Fourth Circuit law. JFXD filed its complaint under the Anticybersquatting Consumer Protection Act (“ACPA”) seeking, in the Eastern District of Virginia, a determination that it owned <trx.com>. Lacking personal jurisdiction over Ming, the Virginia district court transferred the case to the District of Arizona. The Arizona district court applied Ninth Circuit law. On questions of federal law, “a transferee court in this circuit is bound only by our circuit’s precedent.” *Newton v. Thomason*, 22 F.3d 1455, 1460 (9th Cir. 1994). Thus the district court correctly applied Ninth Circuit law.

Next, JFXD argues that the district court erred in dismissing its complaint for failure to state a claim. In *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1026 (9th Cir. 2011), we held that under the ACPA, “a re-registration of a currently registered domain name by a new registrant” is not a “registration” of that domain name. *Id.* Therefore, JFXD was required to plead that it possessed rights in the mark “TRX” before the initial registration of <trx.com>. Because it did not do so, its ACPA claim fails. *See id.* The district court reasonably rejected JFXD’s Second Amended Complaint because JFXD had already pleaded facts that made contradictory allegations in its newest complaint implausible.

Finally, JFXD challenges the award of attorneys' fees under the Lanham Act's provision authorizing fees in "exceptional cases." 15 U.S.C. § 1117(a). The district court did not abuse its discretion in finding that this case was "exceptional." *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 554 (2014). JFXD filed suit in the Virginia district court even though its attorney knew that Ming was already litigating in Arizona. Further, as the Arizona district court explained, "JFXD and its counsel were unable to present intelligible factual or legal arguments, leaving Ming and the [Arizona district court] to guess as to why JFXD believed its cybersquatting claim was viable." Finally, JFXD ignored court orders, communicated with the court *ex parte*, and inexplicably shifted its position multiple times throughout the course of litigation. Because the district court properly granted Ming attorneys' fees below, Appellees are entitled to attorneys' fees on appeal. *See Jason Scott Collection, Inc. v. Trendily Furniture*, 68 F.4th 1203, 1224 (9th Cir. 2023).

We **AFFIRM** the district court in both appeals.

APPENDIX B

[Date Filed: 05/08/2024]

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONAJFXD TRX ACQ LLC,
Plaintiff,
v.
trx.com, et al.,
Defendants.No. CV-23-02330-PHX-
ROS
ORDER

Hoping to obtain ownership of the domain name <trx.com>, Plaintiff JFXD TRX ACQ LLC filed this case in the Eastern District of Virginia. That court concluded it lacked personal jurisdiction over Defendant Loo Tze Ming and transferred the case to Arizona. Once in Arizona, the Court gave Plaintiff multiple opportunities to plead a viable claim. Plaintiff was unable to do so, and the Court dismissed Plaintiff's complaint with prejudice. Ming now seeks an award of attorneys' fees and non-taxable expenses. Ming is entitled to such an award.

I. Standard for Awarding Fees and Costs

JFXD sued Ming under 15 U.S.C. § 1125(d) hoping to obtain ownership of <trx.com>. The type of claim JFXD brought meant the court could "award reasonable

attorney fees to the prevailing party” after concluding the case was “exceptional.” 15 U.S.C. § 1117(a). Determining whether a case qualifies as “exceptional” requires looking “to the totality of the circumstances” and assessing whether the case “stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.” *SunEarth, Inc. v. Sun Earth Solar Power Co.*, 839 F.3d 1179, 1180 (9th Cir. 2016). In making this assessment a court should consider factors such as “frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence.” *Id.*

Understanding why the present case qualifies as “exceptional” requires looking to events that occurred long before this suit was filed as well as the proceedings in a separate case. Those background facts, combined with the weakness of JFXD’s arguments and positions asserted in this case, render this case exceptional.

II. Events Before Present Suit

The domain name <trx.com> was first registered in 1999 by an unknown third party. Approximately four years after that registration, nonparty Randal Hetrick invented “the famous gym product called TRX.” (Doc. 68 at 3). Mr. Hetrick began selling that gym product through a company known as Fitness Anywhere LLC. Over the following years, Fitness Anywhere obtained and used numerous trademarks involving the letters “TRX.” (Doc. 68 at 3). In 2018, attorney Alain

Villeneuve began providing “IP legal services” to Fitness Anywhere. (Doc. 95-7 at 5). In June 2022, Fitness Anywhere filed for Chapter 11 reorganization. (CV-22-2042, Doc. 11-1).

On June 16, 2022, Fitness Anywhere and a related company filed an application with the bankruptcy court for permission to employ Mr. Villeneuve as special intellectual property counsel while the bankruptcy proceeded. (Doc. 95-7). According to that application, Mr. Villeneuve would provide Fitness Anywhere with “general IP advice, patent and trademark prosecution, brand enforcement, IP litigation, management of foreign IP counsel, and maintenance of IP assets.” (Doc. 95-7 at 5). Mr. Villeneuve submitted a declaration in support of that application where he explained his appointment was appropriate because of his “deep understanding and familiarity with [Fitness Anywhere], [its] IP and the issues that arise concerning [Fitness Anywhere’s] IP.” (Doc. 95-7 at 11). The application was granted, and Mr. Villeneuve provided legal services to Fitness Anywhere beginning on June 8, 2022. The record does not disclose when Mr. Villeneuve stopped providing services, but it is undisputed Mr. Villeneuve was still providing services as of late August 2022. (Doc. 95-8 at 4 n.1).

On August 26, 2022, JFXD purchased all of Fitness Anywhere’s assets, including its intellectual property such as trademarks. (Doc. 23-2330 Doc. 74-3). Mr. Villeneuve’s name does not appear on the asset purchase agreement, but it is difficult to believe Fitness Anywhere’s “special intellectual property counsel” would have been unaware that his client had agreed to sell all its intellectual property. Despite Fitness

Anywhere no longer owning any intellectual property, Mr. Villeneuve continued to work for Fitness Anywhere in some capacity.

In the fall of 2022, Fitness Anywhere asked Mr. Villeneuve to file a domain name dispute regarding ownership of <trx.com>.¹ (Doc. 68-2). Mr. Villeneuve prepared the necessary paperwork and on October 19, 2022, filed the dispute with a nongovernmental entity. In that dispute Mr. Villeneuve stated, “Fitness Anywhere LLC is the owner of the famous trademark TRX.” (Doc. 68-2 at 4). That was false. As of October 2022, JFXD, not Fitness Anywhere, owned “the famous trademark TRX.”

As of 2022, Defendant Ming had owned <trx.com> for approximately four years. Ming had purchased the domain name from a nonparty for \$138,000. Despite owning <trx.com>, Ming claims he did not receive notice of the domain name dispute proceeding initiated by Mr. Villeneuve. Thus, Ming did not respond in that proceeding. In November 2022, a decision was issued by the nongovernmental entity concluding <trx.com> should be transferred to Fitness Anywhere unless Ming filed suit in Arizona. (CV-22-2042 Doc. 1). Ming received notice of that decision and on November 30, 2022, filed suit in Arizona.

Ming’s complaint sought a determination he was entitled to remain the owner of <trx.com>. That case

¹ Mr. Villeneuve has not identified who at Fitness Anywhere asked him to file that dispute and, again, it is difficult to believe Fitness Anywhere would have made such a request given that Fitness Anywhere did not own the intellectual property.

was assigned to Judge Logan. After filing his complaint, Ming obtained a waiver of service from Fitness Anywhere, signed by Mr. Villeneuve. (CV-22-2042 Doc. 8). Despite waiving service, Fitness Anywhere did not respond to the complaint. Instead, on February 3, 2023, Mr. Villeneuve emailed Judge Logan's chambers stating Fitness Anywhere had declared bankruptcy in June 2022. Mr. Villeneuve's email also stated he was "the general counsel of JFXD ... the purchaser of the Chapter 11 assets" and he was unable to determine "the optimal way" to file notice of Fitness Anywhere's bankruptcy. (CV-22-2042 Doc. 11-1). Given that Mr. Villeneuve was general counsel for JFXD, it is not clear why he waived service on behalf of Fitness Anywhere. Nor is it clear why Mr. Villeneuve believed he was responsible for filing notice regarding Fitness Anywhere's bankruptcy. At any rate, Judge Logan stayed the case against Fitness Anywhere pending resolution of the bankruptcy.

III. Activities in Present Suit

Shortly after Mr. Villeneuve emailed Judge Logan's chambers, JFXD filed the present suit in the Eastern District of Virginia. Mr. Villeneuve was involved as counsel for JFXD from the beginning. (Doc. 6-1). JFXD's complaint asserted a cybersquatting claim against <trx.com> and Ming. According to JFXD, <trx.com> is "identical to or confusingly similar to or dilutive of the TRX marks." (Doc. 1 at 12). As for Ming, he was identified as "the registrant of <trx.com>" and allegedly had a "bad faith intent to profit from" misusing <trx.com>. (Doc. 1 at 2, 12). JFXD's complaint sought transfer of <trx.com> to JFXD as well as an award of

statutory damages. When the Virginia court asked JFXD why it believed the Virginia court had personal jurisdiction over Ming, JFXD responded by arguing Ming was not a proper party because Ming did not own <trx.com>. Of course, it had been JFXD's own decision to identify Ming as the owner of <trx.com> and to name him as a defendant. JFXD did not offer any explanation to the Virginia court why it had sued Ming if JFXD believed Ming was not the owner of <trx.com>.

Ming appeared in Virginia to contest personal jurisdiction. Ming conceded he was subject to personal jurisdiction in Arizona, and he requested the case be transferred to Arizona. (Doc. 42 at 8). JFXD opposed transfer by arguing, again despite its own allegations that Ming was the owner of <trx.com>, that there was no "evidence of ownership of the domain by [Ming]." (Doc. 39 at 6).

The Eastern District of Virginia did not address JFXD's shifting positions regarding Ming. Instead, that court concluded personal jurisdiction over Ming was lacking and transferred the case to Arizona. (Doc. 59). After the case arrived in Arizona, Mr. Villeneuve, as counsel for JFXD, filed a motion for preliminary injunction. (Doc. 68). The motion sought an order requiring the immediate transfer of <trx.com> to JFXD. That motion did not discuss or cite *GoPets Ltd. v. Hise*, the Ninth Circuit authority most pertinent to JFXD's cybersquatting claim. 657 F.3d 1024, 1032 (9th Cir. 2011). Ming filed an opposition, discussing the applicability of *GoPets* and why, under that precedent, JFXD's cybersquatting claim was doomed. According to Ming, <trx.com> was first registered years before the

TRX gym product was invented and, therefore, *GoPets* established JFXD's cybersquatting claim had no chance of success. JFXD's reply acknowledged *GoPets* but argued, for indecipherable reasons, the Court should not follow *GoPets*. It was unreasonable for JFXD to file a reply that did not contain any plausible argument that *GoPets* did not bar the cybersquatting claim.

The Court denied the request for preliminary injunction by pointing out it was undisputed "<trx.com> was initially registered in 1999 and the TRX-related marks did not exist until years later." (Doc. 82 at 4). Based on that sequence of events and the rule set forth in *GoPets*, the Court concluded JFXD had "no likelihood of success." (Doc. 82 at 3). Instead of requiring Ming file a motion to dismiss making the same arguments he had made in opposing the motion for preliminary injunction, the Court ordered JFXD to file a document explaining how *GoPets* did not require dismissal of the complaint. JFXD was also ordered to explain Mr. Villeneuve's contradictory statements regarding ownership of the TRX-related marks. (Doc. 82 at 5). That is, the Court instructed Mr. Villeneuve to explain why he had stated Fitness Anywhere owned the TRX-related marks in filing the domain name dispute despite Fitness Anywhere having sold those marks months earlier.

JFXD's response addressing the viability of its claim in light of *GoPets* was exceptionally difficult to understand. It appeared JFXD misunderstood basic aspects of litigating a cybersquatting claim. For example, JFXD titled one section of its response "Further Evidence a Registrar Owns this URL." (Doc. 83 at 8). A "registrar" is a company that registers

“domain names with registries on behalf of those who own the names.” *Off. Depot Inc. v. Zuccarini*, 596 F.3d 696, 699 (9th Cir. 2010). It was undisputed <trx.com> was not currently owned by a “registrar.” Thus, JFXD’s statement that <trx.com> was owned by a “registrar” was inexplicable.

JFXD’s response also recounted a sequence of events it described as “worthy of a fiction book.” (Doc. 83 at 8). JFXD allegedly attempted to buy <trx.com> through GoDaddy, a nonparty brokerage that connects buyers with sellers of domain names. JFXD claims it was contacted by a GoDaddy agent and “[t]here was the smell of money in the air, the same vibe as entering a used car showroom.” The agent “was forceful . . . and tried to bully [JFXD] in giving an initial seven number initial offer” to purchase <trx.com>.” (Doc. 83 at 8). JFXD refused to do so. These events had no relevance to the current dispute. GoDaddy is not a party nor is there any connection between GoDaddy and Ming. The fact that JFXD believed it had been mistreated by GoDaddy was irrelevant to the claim JFXD was pursuing in this case.

On the merits, and as best as the Court could determine, JFXD’s response was attempting to argue *GoPets* did not preclude its cybersquatting claim because <trx.com> had been “re-registered” after the TRX-related marks came into existence. While unsure whether that was the position JFXD wished to pursue, the Court granted JFXD leave to amend its complaint to allege facts supporting that argument. (Doc. 85).

For unknown reasons, JFXD and Mr. Villeneuve ignored the Court’s Order requiring an explanation of

Mr. Villeneuve’s contradictory statements regarding ownership of the TRX-related marks. Identifying the proper owner of the TRX-related marks was crucial for this case to continue. If Mr. Villeneuve’s statement in October 2022 that Fitness Anywhere still owned the TRX-related mark was accurate, JFXD would not have standing to bring the current case. The decision to ignore the Court’s Order requiring an explanation addressing ownership was unreasonable.

JFXD filed an amended complaint but, as the Court later observed, those “allegations appear[ed] to be based on a misunderstanding of how the domain name system operates.” (Doc. 88 at 2). JFXD’s amended complaint alleged the registration of <trx.com> had lapsed and Ming had purchased the domain name from “the public domain.” It was not clear what JFXD meant by “public domain.” More importantly, JFXD’s position had always been that Ming purchased <trx.com> for \$138,000 through an “internet brokerage.” (Doc. 74 at 3). JFXD appeared to believe registration with a registrar was the same as purchasing a domain name through an “internet brokerage.” Those are very different events. Because JFXD had not alleged any facts establishing the registration of <trx.com> had lapsed and Ming had “re-registered” it, the complaint was dismissed without leave to amend.

At the same time JFXD filed its amended complaint, Mr. Villeneuve submitted a statement addressing his contradictory statements. That statement was submitted *ex parte* via email to the Court. (Doc. 87). The Court noted it was improper to submit such *ex parte* statements and instructed Mr. Villeneuve not to send

future communications via email. As for the contents, the email was “largely indecipherable.” (Doc. 88 at 4). The Court could not determine why Mr. Villeneuve had made conflicting statements and submitting an indecipherable statement attempting to explain his behavior was unreasonable.

A few weeks after judgment was entered against JFXD, Ming filed a motion for attorneys’ fees. The governing statute allows for awards of attorney’s fees to prevailing parties in “exceptional cases.” 15 U.S.C. § 1117(a). Ming argues that requirement is met here because JFXD “had no chance of success” and engaged in inappropriate behavior throughout this case, such as presenting baseless legal arguments and attempting *ex parte* communications with the Court. Ming seeks an award of \$39,746.50 in attorneys’ fees and \$1,352.27 in non-taxable expenses. JFXD filed an opposition but, as with many of its previous filings, that document is very hard to understand. JFXD’s opposition does not contain any objections to the hourly rates of Ming’s counsel or the number of hours that counsel spent on this case.

JFXD’s improper behavior continued in opposing the request for attorneys’ fees. The following is a partial list of JFXD’s misstatements or unreasonable arguments made in that opposition:

- JFXD argues a plaintiff is entitled to fees only upon showing the defendant “engaged in malicious, fraudulent, deliberate or willful infringement.” (Doc. 99 at 2). That test was overruled in *SunEarth, Inc. v. Sun Earth Solar Power, Co.*, 839 F.3d 1179 (9th Cir. 2016). JFXD cites *SunEarth* but fails to apply its holding.

- JFXD argues Ming “cites a bizarre lower standard” regarding entitlement to fees. (Doc. 99 at 3). However, JFXD is the party that cites the incorrect standard.
- JFXD repeatedly argues the Court should have applied “2nd Circuit law” because the case was transferred from Virginia. (Doc. 99 at 3, 4). Virginia is in the Fourth Circuit, not the Second Circuit.
- JFXD argues the Court should not have applied Ninth Circuit law. JFXD did not make this argument while the case was pending.
- JFXD argues “extreme poor lawyering in *GoPets* misled the 9th Circuit to ignore the relevant portion of the ACPA.” (Doc. 99 at 3). JFXD appears to believe “poor lawyering” is a basis to ignore binding precedent. It is not.
- JFXD argues it will request *GoPets* be overruled and that argument “is not frivolous litigation but a public service.” (Doc. 99 at 5). Before judgment, JFXD never argued *GoPets* was incorrect. Rather, JFXD consistently maintained, without explanation, that *GoPets* did not apply in this case because of factual differences.
- JFXD argues *GoPets* should not apply because “[t]he 9th Circuit’s own jury instructions no [sic] not include *GoPets*.” (Doc. 99 at 6). The contention that model jury instructions should control over a published opinion is frivolous.

- JFXD argues the Court required he file an amended complaint by February 21, 2024, despite the fact that Mr. Villeneuve was “leaving on February 14, 2024 to return on February 27, 2024 for a romantic anniversary.” (Doc. 99 at 7). JFXD did not seek an extension of the February 21 deadline and it is unreasonable to argue the Court should have considered Mr. Villeneuve’s undisclosed “romantic anniversary” plans in setting a briefing schedule.
- JFXD presents a strange argument that, despite naming Ming as a defendant, JFXD continues to believe Ming is a “fraud.” (Doc. 99 at 1). JFXD allegedly attempted to investigate Ming and what it found was “chilling.” (Doc. 99 at 9). JFXD cites postings on an Internet message board allegedly discussing fraud committed by Ming. The Court cannot understand what JFXD is attempting to establish through this argument because it was JFXD’s decision to sue Ming. Any argument from JFXD that Ming is not a proper party is frivolous.

That partial list of arguments in a single filing is representative of JFXD’s behavior throughout this case. JFXD and its counsel were unable to present intelligible factual or legal arguments, leaving Ming and the Court to guess as to why JFXD believed its cybersquatting claim was viable. Many cases involve one or two bad arguments or positions, but this case was unique in the

number of unintelligible assertions made by JFXD and its counsel.

IV. Award and Amount

Given the behavior outlined above, this case is “exceptional.” This case stands out from others in both the frivolousness and objective unreasonableness of JFXD’s behavior. It would be unjust to require Ming bear the cost of litigating against unintelligible factual and legal positions. Moreover, awarding fees might dissuade JFXD from pursuing such tactics in the future.

Having determined this is an exceptional case such that Ming should be awarded costs and fees, the final issue is determining the amount to award. Local Rule 54.2(f) required JFXD “identify with specificity all disputed issues of material fact and . . . separately identify each and every disputed time entry or expense item.” JFXD chose not to comply with this rule. In fact, JFXD did not make any objection to the hourly rate or the number of hours set forth in Ming’s motion for fees. The Ninth Circuit has instructed that when an opposing party “cannot come up with specific reasons for reducing the fee request that the district court finds persuasive, [the district court] should normally grant the award in full, or with no more than a haircut.” *Moreno v. City of Sacramento*, 534 F.3d 1106, 1116 (9th Cir. 2008). Defense counsel’s hourly rates are reasonable, the number of hours expended in defending this case was reasonable, and the non-taxable expenses were reasonable. Therefore, not even a “haircut” would be appropriate. *Id.* The Court will award the full amount requested.

Accordingly,

IT IS ORDERED the Motion for Attorney Fees and Non-Taxable Expenses (Doc. 95) is **GRANTED**. Defendant is awarded \$39,746.50 in attorneys' fees and \$1,352.27 in non-taxable expenses. The Clerk of Court shall enter a judgment in favor of Defendant Loo Tze Ming in the amount of \$41,098.77.

Dated this 8th day of May, 2024.

[/s/ *Roslyn O. Silver*]
Honorable Roslyn O. Silver
Senior United States District Judge

APPENDIX C

[Date Filed: 02/26/2024]

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

JFXD TRX ACQ LLC,
Plaintiff,

v.

trx.com, et al.,
Defendants.

No. CV-23-02330-PHX-
ROS
ORDER

Over the past two months, the Court has been attempting to determine whether Plaintiff's cybersquatting claim involving <trx.com> is viable. In analyzing Plaintiff's request for a preliminary injunction, the Court noted the record at that time established Plaintiff's cybersquatting claim was not viable. Based on that, the Court ordered Plaintiff to explain the legal and factual basis for its cybersquatting claim. (Doc. 82). The Court also ordered Plaintiff's counsel, Alain Villeneuve, to explain his contradictory statements regarding ownership of the TRX-related trademarks. (Doc. 82).

On January 18, 2024, Plaintiff filed a brief setting forth its theory how its cybersquatting claim was viable. (Doc. 83). Mr. Villeneuve, however, ignored the Order directing him to explain his contradictory statements. On February 12, 2024, the Court addressed Plaintiff's

brief regarding the cybersquatting claim. Despite significant difficulty in understanding Plaintiff's filing, the Court concluded Plaintiff believed "the registration of <trx.com> expired, <trx.com> became available to the public, and <trx.com> was registered again." (Doc. 85 at 2). The Court noted Plaintiff's complaint did not allege facts supporting this sequence of events. The Court allowed Plaintiff to amend its complaint but specifically instructed Plaintiff the amended complaint would need to "allege facts establishing when three crucial events occurred: 1) when <trx.com> was first registered; 2) when the registration of <trx.com> expired and the domain name became available to the public; and 3) when <trx.com> was registered again." (Doc. 85 at 2). The Court also noted Mr. Villeneuve had ignored the previous Order requiring an explanation of his contradictory statements. The Court ordered Mr. Villeneuve to file an explanation at the same time the amended complaint was filed. (Doc. 85 at 2).

On February 21, 2024, Plaintiff filed its amended complaint. The only new allegations relevant to the viability of Plaintiff's cybersquatting claim are "[u]pon information and belief, in the period of 2018 to 2022, the URL <trx.com> would have expired and returned to the public domain, and in 2022, it was purchased by [Defendant Loo Tze Ming] from the public domain subsequent to

the senior rights of TRX.”¹ (Doc. 86 at 16). These allegations do not remedy the flaws previously identified by the Court.

Plaintiff’s allegations appear to be based on a misunderstanding of how the domain name system operates. As explained by the Ninth Circuit,

there are three primary actors in the domain name system. First, companies called “registries” operate a database (or “registry”) for all domain names within the scope of their authority. Second, companies called “registrars” register domain names with registries on behalf of those who own the names. Registrars maintain an ownership record for each domain name they have registered with a registry. Action by a registrar is needed to transfer ownership of a domain name from one registrant to another. Third, individuals and companies called “registrants” own the domain names. Registrants interact with the

¹ Plaintiff continues to use the term “public domain” when referring to the registration of a domain name. That is not a correct usage of the term “public domain.” “Public domain” refers to “the status of an invention, creative work, commercial symbol, or any other creation that is not protected by any form of intellectual property.” *McCarthy on Trademarks and Unfair Competition* § 1:23. Plaintiff is not using “public domain” to refer to any type of intellectual property protection. Instead, Plaintiff appears to be describing domain names as in the “public domain” if the domain names are not currently registered such that any member of the public may choose to register them for a nominal amount.

registrars, who in turn interact with the registries.

Off. Depot Inc. v. Zuccarini, 596 F.3d 696, 699 (9th Cir. 2010).

The amended complaint alleges the registration of <trx.com> lapsed and it was “purchased by Defendant from the public domain” in 2022. Plaintiff appears to be alleging the domain name <trx.com> was available for anyone to register when Defendant registered the domain name with a registrar. But Plaintiff has already argued that registering a publicly available domain name with a registrar costs \$19.99 per year. (Doc. 83 at 5). Plaintiff has also argued Defendant purchased <trx.com> for \$138,000. (Doc. 68 at 5; Doc. 83 at 7). Thus, the amount paid by Defendant for <trx.com> establishes Defendant did not register <trx.com> in 2022 with a registrar. Instead, as Defendant has repeatedly claimed, the purchase price shows Defendant bought the domain name on the secondary market.

Given Plaintiff’s allegations and arguments, the amended complaint does not contain allegations making it plausible the registration of <trx.com> lapsed and the domain name became available to any member of the public. Without plausible allegations establishing the registration of <trx.com> lapsed, Ninth Circuit authority precludes Plaintiff’s cybersquatting claim. *GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011) (holding subsequent owners of domain name have all rights enjoyed by original registrants). Plaintiff was given the opportunity to allege additional facts but was unable to do so. Thus, dismissal without leave to amend is appropriate.

Mr. Villeneuve has not yet explained his contradictory statements regarding ownership of the crucial TRX-related property. As explained in a previous Order, Mr. Villeneuve previously stated the company Fitness Anywhere owned all TRX-related property, including the TRX trademarks, until August 2022. That month Fitness Anywhere allegedly sold all its property to current Plaintiff JFXD. Despite that sale, in October 2022 Mr. Villeneuve initiated a domain name dispute proceeding on behalf of Fitness Anywhere. During those proceedings Mr. Villeneuve stated Fitness Anywhere was “the owner of the famous trademark TRX.” (Doc. 68-2 at 4). That proceeding ended with an order requiring <trx.com> be transferred to Fitness Anywhere.

If Fitness Anywhere did not own “the famous trademark TRX” as of October 2022, Mr. Villeneuve’s statement in the dispute resolution proceeding was false. Alternatively, if that statement was accurate and Fitness Anywhere continues to own “the famous trademark TRX,” Mr. Villeneuve’s statements in this case that Plaintiff JFXD owns the domain name have been false.

On February 21, 2024, Mr. Villeneuve emailed a letter to the chambers’ inbox attempting to explain his contradictory statements. Submitting the letter via email was improper. As explained in the Electronic Case Filing Administrative Policies and Procedures Manual, the chambers’ email “addresses are to be used only for sending proposed orders,” and not for any other purpose.² In addition, if Mr. Villeneuve sent the letter only to the

² <https://www.azd.uscourts.gov/sites/azd/files/adm%20manual.pdf>, page 10.

Court, the letter was an improper ex parte communication. Mr. Villeneuve must not send any communications other than proposed orders to the chambers' email address. All communications with the Court must be filed on the docket.

As for the contents of Mr. Villeneuve's letter, it is largely indecipherable. The letter appears to state that as of October 2022, Mr. Villeneuve was not aware that his client, Fitness Anywhere, had declared bankruptcy and sold its assets. Thus, Mr. Villeneuve appears to be stating he initiated the domain name dispute proceeding on behalf of a client that no longer owned the relevant property. There is no explanation how an attorney might be unaware that his client had declared bankruptcy and sold off all the property relevant to the attorney's work. The letter contains a variety of additional statements, but the Court is unable to understand what Mr. Villeneuve is attempting to convey. All that can be determined is that Mr. Villeneuve still has not explained why he stated Fitness Anywhere owned the TRX trademark months after Fitness Anywhere sold all its assets. But this issue is now moot because the case will be dismissed.

Accordingly,

IT IS ORDERED the Amended Complaint (Doc. 86) is **DISMISSED WITHOUT LEAVE TO AMEND**. The Clerk of Court shall close this case.

IT IS FURTHER ORDERED the Clerk of Court shall file the letter received from Mr. Villeneuve.

25a

Dated this 26th day of February, 2024.

[/s/ *Roslyn O. Silver*]
Honorable Roslyn O. Silver
Senior United States District Judge

APPENDIX D

[Date Filed: 02/12/2024]

WO

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

JFXD TRX ACQ LLC,
Plaintiff,

v.

trx.com, et al.,
Defendants.

No. CV-23-02330-PHX-
ROS
ORDER

On January 9, 2024, the Court issued an Order explaining that Plaintiff's cybersquatting claim involving <trx.com> appeared to be foreclosed by Ninth Circuit authority. (Doc. 82). That authority provides, at least under some circumstances, when "a domain name is registered before a particular trademark exists, the trademark owner cannot assert a viable cybersquatting claim against the domain name owner." (Doc. 82 at 4). Here, Plaintiff has admitted <trx.com> was first registered years prior to when Plaintiff's TRX trademark came into existence. Based on that, the Court ordered Plaintiff to explain its basis for pursuing a cybersquatting claim. (Doc. 82). The Court also ordered Plaintiff to explain why its counsel has made contradictory statements regarding the current owner of all TRX-related property.

(Doc. 82 at 5). Plaintiff responded by presenting arguments addressing the viability of its cybersquatting claim, but Plaintiff did not address its counsel's contradictory statements.

Plaintiff now admits its cybersquatting claim would not be viable if <trx.com> had remained registered the entire time after it was first registered in 1999. (Doc. 83 at 2-3). However, Plaintiff believes that at some point in time the registration of <trx.com> expired such that it was returned to the “common depository.” (Doc. 83 at 9). Presumably Plaintiff is referring to the fact that domain names may become available to the public if they are not renewed.¹ According to Plaintiff, once the registration of <trx.com> expired, the subsequent registration of <trx.com> could not take advantage of the Ninth Circuit authority.² Assuming Plaintiff is correct on that point, the current complaint does not allege facts showing the registration of <trx.com> expired, <trx.com> became available to the public, and <trx.com> was registered again. Thus, the current complaint will be dismissed with leave to amend.

¹ See *FAQs for Registrants: Domain Name Renewals and Expiration*, <https://www.icann.org/resources/pages/domain-name-renewal-expiration-faqs-2018-12-07-en> (“If you do not timely renew your domain name registration, it may be transferred or released and made available for registration on a first-come first-serve basis.”).

² The Court cannot understand large portions of Plaintiffs' response and it is not clear whether this is, in fact, Plaintiff's argument. Liberally construed, however, Plaintiff is arguing the registration of <trx.com> expired on some date after the TRX trademark purportedly owned by Plaintiff came into existence.

Should Plaintiff choose to amend, it must allege facts establishing when three crucial events occurred: 1) when <trx.com> was first registered; 2) when the registration of <trx.com> expired and the domain name became available to the public; and 3) when <trx.com> was registered again. The Court expresses no opinion on whether this sequence of events would state a claim under Ninth Circuit authority.

Finally, if Plaintiff chooses to amend, Plaintiff will be required to file a separate statement explaining the conflicting positions adopted by its counsel regarding ownership of the TRX-related property. As set forth in the previous Order, that statement “must explain whether Fitness Anywhere owned any TRX-related property at the time Mr. Villeneuve stated Fitness Anywhere ‘is the owner of the famous trademark TRX.’” (Doc. 82 at 5).

Accordingly,

IT IS ORDERED the Amended Complaint (Doc. 4) is **DISMISSED WITH LEAVE TO AMEND**. No later than **February 21, 2024**, Plaintiff shall file an amended complaint. If an amended complaint is filed, no later than **February 21, 2024**, Plaintiff shall file a statement explaining the contradictory statements regarding the owner of TRX-related property.

Dated this 12th day of February, 2024.

[/s/ Roslyn O. Silver]
Honorable Roslyn O. Silver
Senior United States District Judge

APPENDIX E**[Date Filed: 01/09/2024]****WO****IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA**

JFXD TRX ACQ LLC,
Plaintiff,

v.

trx.com, et al.,
Defendants.

No. CV-23-02330-PHX-
ROS
ORDER

Plaintiff JFXD TRX ACQ LLC (“JFXD”) seeks a preliminary injunction ordering transfer of the domain name <trx.com> to JFXD pending resolution of this suit. (Doc. 68). Defendant Loo Tze Ming, the current owner of <trx.com>, opposes that request. (Doc. 72). JFXD has not established a likelihood of success on the merits and the request for a preliminary injunction will be denied.

BACKGROUND

Understanding the current case requires reference to filings made in this case as well as an earlier-filed case involving a party related to JFXD. CV-22-2042-SPL. Based on those filings, it is undisputed the domain name <trx.com> was first registered in 1999 by an unknown third party. Neither case identifies the owner of <trx.com> after that date until April 2022 when Ming

purchased <trx.com> from an online brokerage. The most crucial events for purposes of the present suit occurred long before Ming purchased <trx.com>.

In 2003, approximately four years after <trx.com> was first registered, nonparty Randal Hetrick invented “the famous gym product called TRX.” (Doc. 68 at 3). Mr. Hetrick began selling that gym product through a company known as Fitness Anywhere LLC. Over the following years, Fitness Anywhere obtained and used numerous trademarks involving the letters “TRX.” (Doc. 68 at 3). In June 2022, Fitness Anywhere filed for Chapter 11 reorganization. (CV-22-2042, Doc. 11-1). In August 2022, JFXD purchased all of Fitness Anywhere’s assets, including its intellectual property such as trademarks. (Doc. 23-2330 Doc. 74-3). Despite ostensibly selling all its assets, in October 2022, Fitness Anywhere filed a domain name dispute with a nongovernmental entity. (Doc. 68-2). That dispute was filed by attorney Alain Villeneuve on behalf of Fitness Anywhere. As the owner of <trx.com>, Ming should have received notice of that dispute. Ming alleges he did not receive notice and, therefore, he did not participate in that dispute. In November 2022, a decision was issued by the nongovernmental entity concluding <trx.com> should be transferred to Fitness Anywhere unless Ming filed suit in Arizona. (CV-22-2042 Doc. 1). Ming received notice of that decision and on November 30, 2022, Ming filed suit in Arizona against Fitness Anywhere.

Ming’s complaint sought a determination he was entitled to remain the owner of <trx.com>. That case was assigned to Judge Logan. After filing his complaint,

Ming obtained a waiver of service from Fitness Anywhere, signed by Mr. Villeneuve. (CV-22-2042 Doc. 8). Despite waiving service, Fitness Anywhere did not respond to the complaint. Instead, on February 3, 2023, Mr. Villeneuve emailed Judge Logan's chambers stating Fitness Anywhere had declared bankruptcy in June 2022. Mr. Villeneuve's email also stated he was "the general counsel of JFXD . . . the purchaser of the Chapter 11 assets" and he was unable to determine "the optimal way" to file notice of Fitness Anywhere's bankruptcy. (CV-22-2042 Doc. 11-1). Given that Mr. Villeneuve was general counsel for JFXD, it is not clear why he was responsible for filing notice regarding Fitness Anywhere's bankruptcy. At any rate, Judge Logan stayed the case against Fitness Anywhere pending resolution of the bankruptcy.

Shortly after Mr. Villeneuve emailed Judge Logan's chambers, JFXD filed the present suit in the Eastern District of Virginia. JFXD's complaint asserted a cybersquatting claim against <trx.com> and Ming. According to JFXD, <trx.com> is "identical to or confusingly similar to or dilutive of the TRX marks." (Doc. 1 at 12). In addition, Ming allegedly has a "bad faith intent to profit from" misusing <trx.com>. (Doc. 1 at 12). The complaint sought transfer of <trx.com> to JFXD as well as an award of statutory damages. Ming requested a change of venue, and the case was transferred to Arizona. (Doc. 41, 59).

After the case arrived in Arizona, JFXD filed a motion for preliminary injunction. JFXD is represented by Mr. Villeneuve. The motion seeks an order requiring the immediate transfer of <trx.com> to JFXD. Ming filed an

opposition, primarily arguing <trx.com> was first registered years before the TRX gym product was invented. Based on that, Ming argues JFXD's cybersquatting claim has no chance of success and no preliminary injunction should be issued.

ANALYSIS

There are two slightly different tests for determining whether to grant a preliminary injunction. Under the first test, a plaintiff "must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest." *Winter v. Natural Resources Defense Council, Inc.*, 555 U.S. 7, 20 (2008). Under the second test, a plaintiff must show there are "serious questions going to the merits," the balance of hardships tip sharply in his favor, there is a likelihood of irreparable injury, and the injunction is in the public interest. *All. for the Wild Rockies v. Cottrell*, 632 F.3d 1127, 1135 (9th Cir. 2011). This second "sliding scale" test allows a plaintiff to make a lesser showing of likelihood of success provided he will suffer substantial harm in the absence of relief. *Id.* at 1133. While these two tests differ on how much likelihood of success must be shown, neither test allows a court to issue a preliminary injunction when the papers establish there is no likelihood of success. That is the situation here.

JFXD's claim for cybersquatting under 18 U.S.C. § 1125(d) depends on when <trx.com> was first registered and when the TRX-related trademarks came into existence. As the Court explained in a recent unrelated case, liability for cybersquatting is possible "only when

a person other than the trademark owner registers a domain name that is confusingly similar to a trademark that is distinctive at the time of the domain name's registration." *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *2 (D. Ariz. July 14, 2023). In other words, if a domain name is registered before a particular trademark exists, the trademark owner cannot assert a viable cybersquatting claim against the domain name owner.

Here, it is undisputed <trx.com> was first registered in 1999 and JFXD's main gym product was not invented until four years later. JFXD does not argue its various TRX-related trademarks predate the product's invention. Therefore, based on the present record, JFXD's cybersquatting claim cannot succeed. Because JFXD has not established a likelihood of success on the merits, the motion for preliminary injunction must be denied.

The docket does not reflect a response to the complaint either in the form of an answer or a motion to dismiss. Given the seemingly undisputed facts that <trx.com> was initially registered in 1999 and the TRX-related marks did not exist until years later, JFXD's cybersquatting claim does not appear to state a claim on which relief might be granted. JFXD will be required to file a statement setting forth why its claim is viable in light of Ninth Circuit authority. *See GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011) ("Because Edward Hise registered gopets.com in 1999, long before GoPets Ltd. registered its service mark, Digital Overture's re-registration and continued ownership of gopets.com does not violate § 1125(d)(1)."). In its response, JFXD must also address the following.

The filings in this case, as well as the filings in the case pending before Judge Logan, show some confusion regarding the current owner of the TRX-related property and the proper defendant for Ming’s challenge to the order transferring <trx.com>. According to statements made by Mr. Villeneuve, Fitness Anywhere owned all TRX-related property, including the TRX trademarks, until it sold that property to JFXD in August 2022. Despite no longer owning any TRX-related property, in October 2022 Mr. Villeneuve initiated a domain name dispute proceeding on behalf of Fitness Anywhere. During those proceedings Mr. Villeneuve stated Fitness Anywhere was “the owner of the famous trademark TRX.” (Doc. 68-2 at 4). That administrative proceeding resulted in an order that <trx.com> be transferred to Fitness Anywhere. If Fitness Anywhere no longer owned the TRX-related property prior to the administrative proceeding, it would appear the transfer order was improper. If, however, Fitness Anywhere did own the property and continued to own the property, Ming’s claims against Fitness Anywhere pending before Judge Logan are the proper avenue for resolving ownership of <trx.com>. In that situation, however, JFXD’s current complaint is improper because JFXD does not own the TRX-related property. In explaining why its complaint does not state a claim for relief, JFXD must explain the conflicting positions adopted by Mr. Villeneuve. In particular, JFXD must explain whether Fitness Anywhere owned any TRX-related property at the time Mr. Villeneuve stated Fitness Anywhere “is the owner of the famous trademark TRX.” (Doc. 68-2 at 4).

Accordingly,

IT IS ORDERED the Motion for Preliminary Injunction (Doc. 68) is **DENIED**.

IT IS FURTHER ORDERED no later than **January 18, 2024**, Plaintiff shall file a statement explaining how its cybersquatting claim is viable. No later than **January 25, 2024**, Defendant shall file a response. Defendant need not file any response to the complaint pending further Order by the Court.

IT IS FURTHER ORDERED the case management conference set for **January 12, 2024**, is **VACATED** to be reset if necessary.

IT IS FURTHER ORDERED the Stipulation (Doc. 81) is **DENIED AS MOOT**.

Dated this 8th day of January, 2024.

[/s/ *Roslyn O. Silver*]
Honorable Roslyn O. Silver
Senior United States District Judge

APPENDIX F

FILED

MAY 16 2025

Molly C. Dwyer, Clerk
U.S. Court of Appeals

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

JFXD TRX ACQ LLC, a
Florida limited liability com-
pany,

Plaintiff - Appellant,

v.

TRX.COM, a domain name
and LOO TZE MING, an indi-
vidual from Malaysia,

Defendants - Appellees.

No. 24-1661

D.C. No.2:23-cv-02330-
ROS

District of Arizona,
Phoenix

ORDER

JFXD TRX ACQ LLC,

Plaintiff - Appellant,

v.

TRX.COM; LOO TZE MING,

Defendants - Appellees.

No. 24-3391

D.C. No.
2:23-cv-02330-ROS

District of Arizona,
Phoenix

ORDER

Before: HAWKINS, W. FLETCHER, and R. NELSON, Circuit Judges.

Appellant filed a petition for rehearing en banc on April 17, 2025 in the above-captioned cases. Judge R. Nelson has voted to deny the petition for rehearing en banc, and Judge Hawkins and Judge W. Fletcher have so recommended.

The full court has been advised of the petition for rehearing en banc, and no judge of the court has requested a vote on whether to rehear the matter en banc. Fed. R. App. P. 40.

The petition for rehearing en banc (Dkt. No. 46 in Case No. 24-1661; and Dkt. No. 37 in Case No. 24-3391) is DENIED.

APPENDIX G

1. Section 43 of the Lanham Act, ch. 540, 60 Stat. 427 (1946), as amended, 15 U.S.C. § 1125, provides:

§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be

subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

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- (i) The degree of similarity between the mark or trade name and the famous mark.
 - (ii) The degree of inherent or acquired distinctiveness of the famous mark.
 - (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
 - (iv) The degree of recognition of the famous mark.
 - (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
 - (vi) Any actual association between the mark or trade name and the famous mark.
- (C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

- (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

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- (i) advertising or promotion that permits consumers to compare goods or services; or
 - (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.
- (B) All forms of news reporting and news commentary.
- (C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

- (A) the claimed trade dress, taken as a whole, is not functional and is famous; and
- (B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

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(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)

(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention**(1)**

(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

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

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

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)

(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, 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 accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or 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, or dilutive of famous marks of others that are famous 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 within the meaning of subsection (c).

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(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)

(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and

Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

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(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)

(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

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(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

2. Section 3002(b) of the Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, div. B, § 1000(a)(9) [app. I, tit. III], 113 Stat. 1536 [1501A-545] (1999), 15 U.S.C. § 8131, provides

§ 8131. Cyberpiracy protections for individuals

(1) In general

(A) Civil liability

Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

(B) Exception

A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name

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is used in, affiliated with, or related to a work of authorship protected under title 17, including a work made for hire as defined in section 101 of title 17, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946 (15 U.S.C. 1051 et seq.) or other provision of Federal or State law.

(2) Remedies

In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

(3) Definition

In this section, the term “domain name” has the meaning given that term in section 45 of the Trademark Act of 1946 (15 U.S.C. 1127).

(4) Effective date

This section shall apply to domain names registered on or after November 29, 1999.