

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

DECKERS OUTDOOR CORPORATION,)	
)	
)	Case No. 11-cv-7970
Plaintiff,)	
)	Honorable Ronald A. Guzman
v.)	
)	Magistrate Martin C. Ashman
LIYANGHUA et al.,)	
)	
Defendants.)	
)	
)	
)	
)	
)	

**MEMORANDUM IN SUPPORT OF PLAINTIFF DECKERS OUTDOOR
CORPORATION'S MOTION FOR SERVICE OF PROCESS
BY EMAIL AND ELECTRONIC PUBLICATION ORDER**

Plaintiff submits this Memorandum in support of its Motion for Service of Process by
Email and Electronic Publication.

MEMORANDUM OF LAW

I. INTRODUCTION

Plaintiff Deckers Outdoor Corporation (“Deckers”) brings the present action against all Defendants identified in “Schedule A” attached to the First Amended Complaint (collectively the “Defendants”), for federal trademark infringement and counterfeiting (Count I), false designation of origin (Count II), cyberpiracy (Count III) and violation of the Illinois Uniform Trade Practices Act (Count IV). As alleged in Deckers’ First Amended Complaint, the Defendants are promoting, advertising, distributing, offering for sale and selling products bearing counterfeits of Deckers’ UGG® Trademark, through various fully interactive commercial Internet websites operating under at least the domain names listed in Schedule A attached to the First Amended Complaint (collectively the “Defendant Domain Names”).

II. STATEMENT OF FACTS

On November 15, 2011, this Court granted Deckers’ Motion for a Temporary Restraining Order (“the TRO” - Docket Entry 18) which was extended and converted into a preliminary injunction on December 15, 2011. (Docket Entry 42). The TRO authorized, among other things, that Deckers may provide notice of these proceedings and the preliminary injunction hearing to Defendants by electronic mail at the e-mail addresses identified in Schedule A to Deckers’ Complaint and electronic publication at the Defendant Domain Names which have been transferred to Deckers’ control. *Id.* at ¶ 6. Since and pursuant to entry of the TRO, dozens of PayPal accounts associated with Defendants’ websites have been frozen and each of the Defendant Domain Names has been transferred to Deckers control to disable. *See* Declaration of Justin R. Gaudio (hereinafter “Gaudio Declaration” at ¶ 2). Each of the Defendant Domain Names was redirected to a website providing notice of these proceedings between entry of the TRO and January 11, 2012. *Id.* None of the Defendants has provided any indication that they

intend to defend these proceedings. *Id.* Deckers respectfully submits that an order allowing service of process solely via email and electronic publication in this case will benefit all parties and the Court by ensuring the registrants of the Defendant Domain Names receive notice of the pendency of this action and allowing this action to move forward expeditiously. Absent the ability to serve the Defendants in this manner, Deckers will almost certainly be left without the ability to pursue a remedy.

III. ARGUMENT

In Paragraph 6 of the TRO, this Court allowed Deckers to provide notice of these proceedings and the preliminary injunction hearing via email and electronic Publication. A screenshot of the website at <http://gbclaw.net/caseno-11-cv-7970>, which provides notice to Defendants, is attached as Exhibit 1 to the Gaudio Declaration. For example, when the Defendant Domain Name buttonbaileyuggboots.com is typed into a web browser URL bar, it will take the visitor to <http://gbclaw.net/caseno-11-cv-7970> instead of a counterfeit website. Each of the Defendant Domain Names has been redirected to this website since at least January 11, 2012. Pursuant to Federal Rule of Civil Procedure 4(f)(3), Deckers now requests an order allowing service of process on Defendants using this same previously approved method. Electronic service is appropriate and necessary in this case because the Defendants on information and belief have provided false or inaccurate physical address information in their registrations for the Defendant Domain Names in order to conceal their locations and avoid liability for their unlawful conduct. Examples of addresses provided by Defendants include “Fuzhou Gulou Fuzhou, 350002” and “Johnsonjohnson, Johnson Johnson 111111, gb.” *See* Gaudio Declaration at ¶¶ 4-5.

In addition, Defendants rely primarily on electronic communications to communicate with their registrars and customers, demonstrating the reliability of this method of communication by which the registrants of the Defendant Domain Names may be apprised of the pendency of this action. Deckers respectfully submits that an order allowing service of process solely via email and electronic publication in this case will benefit all parties and the Court by ensuring the registrants of the Defendant Domain Names receive immediate notice of the pendency of this action and allowing this action to move forward expeditiously. Absent the ability to serve the Defendants in this manner, Deckers will almost certainly be left without the ability to pursue a remedy.

According to regulations established by the Internet Corporation for Assigned Names and Numbers (“ICANN”), an individual or entity that registers a domain name is required to provide accurate contact information for the domain name. *See* Gaudio Declaration at ¶ 6. As demonstrated, the registrants for the Defendant Domain Names have ignored the applicable ICANN regulations and provided false physical address information to the domain name registrars in order to avoid liability for their criminal conduct. However, as a practical matter, the registrants of the Defendant Domain Names generally must maintain an accurate email address where their registrars may communicate with them regarding issues related to the purchase, transfer, and maintenance of the various accounts. Moreover, it is necessary for merchants, such as the registrants of the Defendant Domain Names, who operate entirely online, to provide customers with accurate email addresses by which the customer can contact the merchant to ask questions about the merchant’s products, place orders from the merchant’s Internet websites, and receive information from the merchant regarding the shipment of an order.

Deckers conducted searches of the public WhoIs information regarding the Defendant Domain Names identifying the e-mail addresses the registrants provided the Registrars. *See* Declaration of Justin R. Gaudio in Support of Deckers' Motion for a TRO at ¶ 3 (Docket No. 23). Many of Defendants' names and addresses used to register the Defendant Domain Names are incomplete, randomly typed letters, contain street addresses with no cities or states listed or use a privacy service. *Id.* Overlapping contact information also suggests that many of the aliases used to register the Defendant Domain Names are used by the same individual or entity. Thus, based on the provision of invalid postal addresses and likely fictitious name(s), Deckers is preventing from serving the Defendants by traditional means.

Federal Rule of Civil Procedure 4(f)(3) allows this Court to authorize service of process by any means not prohibited by international agreement as the Court directs. *Rio Props, Inc. v. Rio Int'l Interlink*, 284 F.3d 1007, 1014 (9th Cir. 2002). Rule 4 does not require that a party attempt service of process by those methods enumerated in Rule 4(f)(2), including by diplomatic channels and letters rogatory, before petitioning the court for alternative relief under Rule 4(f)(3). *Id.* at 1114-15. The Ninth Circuit in *Rio Properties* held, "without hesitation," that email service of an online business defendant "was constitutionally acceptable." *Rio Props.*, 284 F.3d at 1017. The Court reached this conclusion in part because the defendant conducted its business over the Internet, used email regularly in its business, and encouraged parties to contact it via email.

Similarly, a number of Courts, including the Northern District of Illinois, have held that alternate forms of service pursuant to Rule 4(f)(3), including email service, are appropriate and may be the only means of effecting service of process "when faced with an international e-business scofflaw." *See, e.g., Deckers Outdoor Corporation v. Does 1-55*, No. 11 Civ. 10,

Docket No. 26 (N.D. Ill. February 3, 2011) (allowing service of process by email); *MacLean-Fogg Co. v. Ningbo Fastlink Equip. Co. Ltd.*, 2008 WL 5100414, *2 (N.D. Ill. Dec. 1, 2008) (holding email and facsimile service appropriate); *Farouk Systems, Inc. v. Eyou Int'l Trading Co., Ltd., et al.*, No. 4:10 CV 2672 (S.D. Tex. Aug. 2, 2010); *The North Face Apparel Corp., et al. v. Fujian Sharing Import & Export Ltd. Co., et al.*, No. 10 CIV 1630 (S.D.N.Y. Mar. 16, 2010); *Popular Enter., LLC v. Webcom Media Group, Inc.*, 225 F.R.D. 560, 563 (E.D. Tenn. 2004) (quoting *Rio Properties*, 284 F.3d at 1018) (allowing email service); *see also Williams-Sonoma, Inc. v. FriendFinder, Inc.*, 2007 WL 4973848, *4 (N.D. Cal. Dec. 6, 2007) (allowing email service); *Philip Morris USA, Inc. v. Veles Ltd.*, 2007 WL 725412, *1, (S.D.N.Y. Mar. 12, 2007) (same); *Williams v. Advertising Sex LLC*, 231 F.R.D. 483, 488 (N.D. West Va. 2005) (same); *Juniper Networks, Inc. v. Bahattab*, 2008 WL 250584, *1-2 (D.D.C. Jan. 30, 2008) (citing *Rio* and other cases in holding that “in certain circumstances ...service of process via electronic mail ... is appropriate and may be authorized by the Court under Rule 4(f)(3) of the Federal Rules of Civil Procedure”). Deckers submits that allowing service solely by email and electronic publication in the present case is appropriate and comports with constitutional notions of due process, particularly given the decision by the registrants of the Defendant Domain Names to conduct their illegal Internet-based activities anonymously.

Deckers is unable to determine the exact physical whereabouts or identity of the registrants of the Defendant Domain Names. However, Deckers has good cause to suspect the registrants of the respective Defendant Domain Names are all residents of China. The United States and the People’s Republic of China are both signatories to the Hague Convention on the Service Abroad of Judicial and Extra-Judicial Documents in Civil and Commercial Matters (the “Hague Convention”). *See* Gaudio Declaration at ¶ 7.

