

DOMAIN NAME DISPUTES

By: Houston Putnam Lowry¹

- I. The approximately 45,000,000² presently existing domain names are assigned in various ways, depending on the “top level” domain.
- A. Each top level domain is regulated separately and has its own dispute resolution procedures depending on who sponsors the top level domain.
1. You may be able to only get one domain name.
 2. You may be required to have an office or do business “in country.”
- B. Among the most common of the 238 top level domains are (according to Daily Changes³):

.COM	32,984,590
.NET	5,272,539
.ORG	3,275,583
.INFO	2,992,789
.BIZ	1,071,944
.US	891,865
Total	46,651,240

- C. The .com, .net and .org domains are subject to the Uniform Dispute Resolution Policy.
- D. gTLD means Global Top Level Domain.
- E. ccTLD means Country Code Top Level Domain.
- II. Uniform Dispute Resolution Policy (UDRP) (copy attached)
- A. Established by the Internet Corporation for Assigned Names and Numbers (“ICANN”).

¹ Brown & Welsh, P.C., 530 Preston Avenue-2nd Floor, P.O. Box 183, Meriden, CT 06450-0183
(203) 235-1651 Fax: (203) 235-9600 HPLowry@BrownWelsh.com

² It is increasingly difficult to get good statistical information. The following problems have been found with the statistical sources I have used in the past:

<http://domainworldwide.com/>
StateoftheDomain.com

The numbers have not changed since 10/2/2003
Appears to have been taken over by SnapNames.com

³ <http://www.dailychanges.com/>

1. It was approved October 24, 1999.
 2. It became effective for America Online, the NameIT Corp., and Network Solutions on January 3, 2000.
 3. It became effective for all other registrars on December 1, 1999.
- B. The UDRP is implemented by the Rules for Uniform Dispute Resolution Policy (see attached).
- C. Each registrar requires each customer to agree to the rules as a condition of buying a domain name. While no one discusses the issue, this is effectively a specialized form of arbitration, which makes it work in cyberspace.
- D. The registrars with the largest combined market share (70.65%) of the “.com” top level domain are (according to WebHosting.info⁴):

Registrar	Oct-03	Dec-04	# Domains	% Change
Network Solutions	25.89%	15.09%	6,840,786	-41.73%
GoDaddy.com	6.52%	12.08%	5,477,257	+85.26%
Tucows	10.37%	8.85%	4,014,027	-14.64%
eNom.com	5.97%	7.61%	3,448,771	+27.39%
Register.com	9.30%	5.85%	2,654,488	-37.05%
MelbourneIT	5.75%	5.15%	2,336,417	-10.40%
Schlund + partner		3.32%	1,504,185	N.A.
Bulkregister	4.37%	2.78%	1,262,217	-36.32%
DirectNIC.com	2.77%	2.41%	1,094,675	-12.85%
Wild West Domains		2.05%	930,061	N.A.
Sipence		1.95%	884,326	N.A.
Dotster	2.66%	1.85%	837,627	-30.56%
Dotregister	2.39%	1.66%	751,704	-30.63%
Total	75.99%	70.65%	32,036,541	

- E. There are presently four approved dispute resolutions providers (all of whom have their own special supplementary rules):
1. Asian Domain Name Dispute Resolution Center.
 2. CPR Institute for Dispute Resolution.

⁴ <http://www.webhosting.info/registrars/top-registrars/>

3. National Arbitration Forum.
 4. World Intellectual Property Organization.
- F. A large number of cases have been disposed of (as of *May 10, 2004*⁵):
1. 7,790 proceedings involving 13,311 domain names have been decided by decision.
 2. 958 proceedings involving 1,371 domain names have been disposed of without decision.
 3. The backlog is fairly small: 616 proceedings involving 1,014 domain names.
 4. While there are no statistics on how long a case takes, this Panelist's experience suggests it is about 90 days from the time the complaint is complete to issuance of the decision.
 5. Given that ICANN has been very prompt in posting statistics about UDRP proceedings in the past, the author wonders what has happened to change their practice.

III. How does a UDRP proceeding take place?

- A. The procedural details depend on which provider you select.
1. Every provider has their own form to help you comply with their requirements.
- B. The first and foremost factor to remember is there is no hearing, which means this is a DOCUMENTS ONLY proceeding.
1. Documents are filed in both paper format and electronic format.
 2. Certain things **MUST** be in the complaint or it will not be deemed to be administratively compliant (and ultimately rejected if not corrected):
 - a. Request that the complaint be submitted for decision in accordance with the Policy and these Rules.

⁵ <http://www.icann.org/udrp/proceedings-stat.htm>

- b. Provide the name, postal and e-mail addresses, and the telephone and fax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding.
- c. Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy.
- d. Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists).
- e. Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and fax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint.
- f. Specify the domain name(s) that is/are the subject of the complaint.
- g. Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed.
- h. Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.).
- i. Describe, in accordance with the Policy, the grounds on which the complaint is made.
- j. Specify, in accordance with the Policy, the remedies sought.

- k. Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint.
 - l. State that a copy of the complaint, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder).
 - m. State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction.
 - n. Verify the Complaint in accordance with the specific language required (meaning the complaint is essentially under oath).
 - o. Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.
3. If more than one domain name is involved, each domain name must be registered with the same registrar.
- C. The Respondent has only twenty days to respond, which really isn't very much time. The response must be in paper and electronic format. It must include:
- 1. Specific response to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider's Supplemental Rules.).
 - 2. Provide the name, postal and e-mail addresses, and the telephone and fax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding.
 - 3. Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy.

4. If Complainant has elected a single-member panel in the Complaint, state whether Respondent elects instead to have the dispute decided by a three-member panel.
5. If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists).
6. Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint.
7. State that a copy of the response has been sent or transmitted to the Complainant.

D. What does a Complainant need to prove?

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; **and**
2. Respondent has no rights or legitimate interests in respect of the domain name; **and**
3. The domain name has been registered **and** is being used in bad faith. Bad faith can be shown by (and this **not** an exhaustive list):
 - a. Circumstances indicating Respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; **or**
 - b. Respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent as engaged in a pattern of such conduct; **or**
 - c. Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; **or**

- d. by using the domain name, Respondent intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent web site or location.
4. This can be much harder than it looks.
- a. For me, the most common “gap” is tying up the Complainant with the owner of the mark in question.
 - i. I will ask for additional information on this point.
 - ii. Many Panelists will not ask for additional information.
 - (i) They can ignore the problem.
 - (ii) They can dismiss the case.
- E. What does an answer need to show? Respondent wants to show rights or legitimate interests to the domain name by:
- 1. before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; *or*
 - 2. Respondent (as an individual, business, or other organization) have been commonly known by the domain name, even if Respondent has acquired no trademark or service mark rights; *or*
 - 3. Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

IV. What are the powers of the Panel?

- A. The Panel shall conduct the administrative proceeding in such a manner as it considers appropriate in accordance with the Policy and the Rules.
- B. In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

- C. The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, *in exceptional cases*, a period of time fixed by these Rules or by the Panel.
 - D. The Panel shall determine the admissibility, relevance, materiality and weight of the evidence. Note there are normally no evidentiary rules in arbitrations.
 - E. A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.
- V. Some of the principles I have learned doing these types of cases...⁶
- A. The defaulting defendant.
 - 1. This happens a lot; some sources estimate about 35% of the reported cases are not defended.
 - 2. Complainant tends to win more of these cases than contested cases.
 - B. Adding geographical designations does not avoid the problem
example: HPcanada.com and SoyLifeCA.com
 - C. Simply using a domain name that forwards to another web site invites a higher level of scrutiny.
example: Thriftyairportparking.com
 - D. Providing false WHOIS contact information creates a presumption of bad faith.
example: Agent Host v. Host Dot Com Investments
 - 1. Failing to keep your WHOIS information does not create much sympathy, but at least it doesn't create a presumption of bad faith
example: Mattel, Inc. v. KPF, Inc.
 - E. A licensee may generally use a trademarked domain (absent a contractual restriction, which are increasingly common)
example: FunJetVacations.com
 - F. What happens in a trademark proceeding may have an effect on your case.
example: SoyLifeCA.com

⁶ This should not be taken as an official UDRP position nor as anything other than personal observations by the author. The author is not committing himself to any position nor to deciding any particular case in any particular fashion in the future. As always, other Panelists have other positions on these issues.

1. Panelists are loath to second guess whether or not a trademark should have issued.
example: BasicChemicalSolutions.com
2. If you disclaim an interest in special words, that disclaimer may come back from the trademark proceeding to haunt you in the UDRP proceeding.
example: Soylifeca.com

G. Typosquatting.

H. Delay in bringing a proceeding can have significant consequences.

1. There are no hard and fast rules. It seems to be a question of latches based upon the totality of the circumstances (“When does the Respondent gain rights to a domain name it has been using?”)

Case	Docket #	Acquired	Not acquired
Opus Northwest Construction v. Opus Realty	FA0408000318960	10 years	
VideoCall Company v M Koenig c/o Tecton LLC	FA0307000167922	5.3 years	
Target Brands, Inc. v. 4160894 Canada Inc.	FA0401000227648	4 years	
Target Brands, Inc. v. ALDnet Media Group	FA0401000227647	1.75 years	
Global Informational Licensing v. Bankers Online	FA0405000267427		4 months

2. When an active domain name was deleted and the original owner took no action for more than 3 months (allowing the new owner to put up a *bona fide* web site), the new owner had acquired rights and prevented the transfer of the domain name.

Example: Yupi Internet Inc. v. Mercantil Inc.

- I. Don't expect to be able to use a name a web site after your dead pet guinea pig who just happens to be named after a famous trademark.
example: YUM! Brands v. Ether Graphics a/k/a Andrew Gruner

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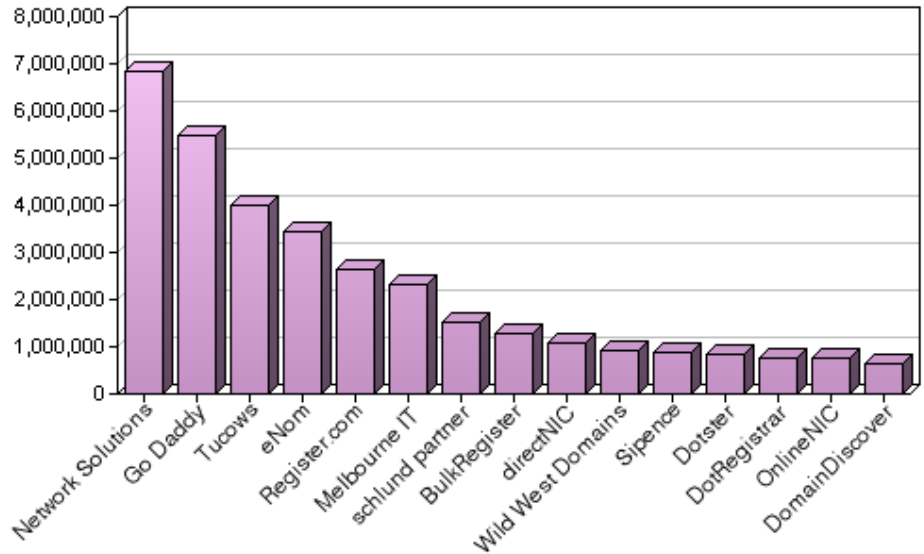
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


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Top Domain Registrars by Total Domains

Rank	Registrar	Country	Market Share	Total Domains
1	Network Solutions		15.085%	6,840,786
2	Go Daddy		12.079%	5,477,257
3	Tucows		8.852%	4,014,027
4	eNom		7.605%	3,448,771
5	Register.com		5.854%	2,654,488
6	Melbourne IT		5.152%	2,336,417
7	schlund+partner		3.317%	1,504,185
8	BulkRegister		2.783%	1,262,217
9	directNIC		2.414%	1,094,675
10	Wild West Domains		2.051%	930,061
11	Sipence		1.950%	884,326
12	Dotster		1.847%	837,627
13	DotRegistrar		1.658%	751,704
14	OnlineNIC		1.656%	750,954
15	DomainDiscover		1.416%	641,938

[<<First](#)
[<<Previous](#)
[1](#)
[2](#)
[3](#)
[4](#)
[5](#)
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[Domain Name Counts](#)

[com/net/org](#)

[biz/info](#)

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[Domain Name](#)

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[International](#)

[United States](#)

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[Top DN Holders](#)

[Secondary Sales](#)

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[Nameservers](#)

[Length of Domains](#)

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History of gTLD domain name growth

This page provides monthly totals on the total number of gTLD domains registered worldwide which provide a useful gauge of the growth of the Internet.

These numbers, however, are the **net total** (number of existing domains + new registrations - expired domains) and thus **do not accurately** represent the the gTLD domain name market. Please see [Zooknic Zaps](#) for up to the minute data on the domain name market.

Although we have up to the minute data this page is only updated quarterly. [Contact us](#) with rec for more recent counts.

	Date	Total	Com	Net	Org	Biz	Info	Edu
	11/14/2004	44,158,128	31,931,475	5,113,766	3,201,915	1,060,193	2,843,330	7,449
	10/14/2004	43,258,259	31,391,071	5,037,129	3,154,596	1,048,067	2,619,966	7,430
	9/16/2004	41,093,507	30,543,695	4,942,154	3,118,657	1,032,216	1,449,363	7,422
	8/15/2004	40,070,695	29,879,736	4,861,811	3,078,857	1,017,985	1,224,901	7,405
	7/17/2004	39,363,493	29,321,771	4,791,592	3,029,358	1,001,991	1,211,384	7,397
	6/17/2004	38,752,988	28,848,515	4,730,183	2,992,438	988,346	1,186,121	7,385
	5/16/2004	38,112,578	28,355,026	4,662,171	2,947,017	979,706	1,161,292	7,366
	4/14/2004	37,398,912	27,796,613	4,580,960	2,898,591	966,113	1,149,293	7,342
	3/15/2004	36,759,814	27,300,968	4,510,958	2,861,626	957,124	1,121,809	7,329
	2/15/2004	36,077,128	26,776,517	4,433,892	2,819,133	936,135	1,104,141	7,310
	1/15/2004	35,340,170	26,207,928	4,349,336	2,775,728	914,761	1,085,133	7,284
	12/17/2003	34,927,328	25,849,965	4,293,719	2,750,696	942,946	1,082,099	7,903
	11/15/2003	34,090,578	25,101,982	4,144,993	2,719,067	1,012,579	1,104,073	7,884
	10/16/2003	33,652,640	24,695,211	4,083,961	2,677,285	1,034,400	1,153,916	7,867
	9/15/2003	33,163,940	24,295,588	4,019,482	2,641,836	1,016,715	1,182,469	7,850
	8/15/2003	32,742,108	23,993,547	3,974,367	2,615,723	993,780	1,156,851	7,840
	7/15/2003	32,259,223	23,633,877	3,922,910	2,586,012	971,174	1,137,425	7,825
	6/15/2003	31,878,784	23,354,574	3,881,571	2,567,060	949,482	1,118,319	7,778
	5/15/2003	31,486,662	23,071,842	3,840,626	2,541,985	926,495	1,098,041	7,673
	4/15/2003	31,150,432	22,832,760	3,807,467	2,523,473	900,758	1,078,555	7,419
	3/16/2003	30,850,629	22,626,562	3,779,100	2,501,273	878,377	1,057,909	7,408
	2/17/2003	30,579,719	22,452,747	3,748,893	2,475,356	857,204	1,038,103	7,416
	1/12/2003	30,143,651	22,147,502	3,702,496	2,442,677	829,096	1,014,473	7,407
	12/15/2002	29,928,518	21,991,795	3,684,679	2,426,220	817,501	1,000,901	7,422
	11/17/2002	29,629,818	21,773,883	3,657,170	2,407,955	800,431	982,949	7,430
	10/13/2002	29,284,654	21,524,698	3,634,504	2,381,538	776,565	959,915	7,434
	9/15/2002	29,043,215	21,358,016	3,616,854	2,366,047	757,547	937,324	7,427
	8/11/2003	28,881,549	21,273,992	3,600,108	2,349,429	735,866	914,733	7,421
	7/15/2002	28,801,916	21,270,830	3,592,057	2,336,914	710,977	883,726	7,412
	6/16/2002	28,710,661	21,243,232	3,590,555	2,325,471	692,707	851,297	7,399
	5/12/2002	28,852,760	21,382,537	3,644,707	2,343,177	656,596	818,373	7,370
	4/14/2002	29,088,673	21,581,810	3,710,409	2,372,801	624,743	791,551	7,359
	3/17/2002	29,925,042	22,284,362	3,861,426	2,435,219	574,304	762,438	7,293
	2/17/2002	29,881,514	22,299,727	3,871,802	2,427,192	543,316	732,245	7,232
	1/13/2002	30,414,510	22,746,754	3,988,975	2,484,886	499,410	687,473	7,012
	12/11/2001	30,969,311	23,198,677	4,320,416	2,796,403	n/a	647,111	6,704

11/12/2001	30,380,724	23,171,002	4,361,359	2,841,663	6,700
10/4/2001	30,675,777	23,291,654	4,467,956	2,909,514	6,653
9/24/2001	30,661,898	23,280,339	4,469,470	2,905,443	6,646
7/14/2001	30,089,731	22,845,079	4,404,308	2,833,781	6,563
6/12/2001	29,881,233	22,702,074	4,369,900	2,802,719	6,540
6/6/2001	29,837,316	22,670,915	4,363,750	2,796,125	6,526
5/31/2001	29,776,489	22,624,608	4,355,713	2,789,643	6,525
5/24/2001	29,741,664	22,606,495	4,347,086	2,781,574	6,509
5/16/2001	29,600,820	22,496,480	4,329,363	2,768,481	6,496
5/9/2001	29,557,743	22,470,923	4,321,013	2,759,321	6,486
5/2/2001	29,553,606	22,475,976	4,317,965	2,753,187	6,478
4/25/2001	29,462,244	22,409,745	4,303,717	2,742,316	6,466
4/18/2001	29,408,919	22,374,229	4,293,519	2,734,719	6,452
4/11/2001	29,385,841	22,366,367	4,286,404	2,726,629	6,441
3/29/2001	29,079,174	22,186,938	4,217,658	2,668,146	6,432
3/22/2001	29,037,496	22,160,178	4,211,612	2,659,287	6,419
3/15/2001	28,973,596	22,123,487	4,197,671	2,646,030	6,408
3/7/2001	28,859,503	22,045,648	4,177,496	2,629,968	6,391
2/23/2001	28,678,351	21,915,624	4,148,705	2,607,653	6,369
2/15/2001	28,462,600	21,756,189	4,114,979	2,585,069	6,363
2/8/2001	28,245,129	21,592,167	4,080,810	2,565,793	6,359
2/1/2001	28,038,864	21,439,059	4,048,985	2,544,469	6,351
1/30/2001	27,969,779	21,387,603	4,038,161	2,537,669	6,346
1/18/2001	27,701,020	21,185,015	3,999,322	2,510,352	6,331
1/9/2001	27,480,324	21,023,720	3,960,363	2,489,924	6,317
12/22/2000	26,993,431	20,652,200	3,888,091	2,446,840	6,300
12/12/2000	26,653,389	20,401,837	3,830,641	2,414,622	6,289
11/27/2000	26,161,187	20,033,920	3,757,776	2,363,233	6,258
7/1/2000	18,648,629	14,680,275	2,512,425	1,449,775	6,154
1/1/2000	10,008,475	8,006,100	1,216,750	779,950	5,675
7/1/1999	7,052,350	5,748,100	768,900	530,950	4,400
1/1/1999	4,038,744	3,425,625	261,375	347,550	4,194
7/1/1998	2,154,634	1,879,501	136,079	134,860	4,194

Earlier data is for both gTLDs and ccTLDs

Date	TOTAL
1/1/98	2,292,000
7/1/97	1,301,000
1/1/97	828,000
7/1/96	488,000
1/1/96	240,000
7/1/95	120,000
1/1/95	71,000
7/1/94	46,000
1/1/94	30,000
7/1/93	26,000
1/1/93	21,000
7/1/92	16,000

Source: 1992 to January 1998 from Hobbes' Internet Timeline; July 1998 data to present from

<http://www.zooknic.com/>

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UDRP POLICY



Uniform Domain Name Dispute Resolution Policy

Policy Adopted: August 26, 1999
Implementation Documents Approved:
October 24, 1999

Notes:

1. This policy is now in effect. See www.icann.org/udrp/udrp-schedule.htm for the implementation schedule.
 2. This policy has been adopted by all accredited domain-name registrars for domain names ending in .com, .net, and .org. It has also been adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).
 3. The policy is between the registrar (or other registration authority in the case of a country-code top-level domain) and its customer (the domain-name holder or registrant). **Thus, the policy uses "we" and "our" to refer to the registrar and it uses "you" and "your" to refer to the domain-name holder.**
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Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

1. Purpose. This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under [Paragraph 4](#) of this Policy will be conducted according

to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and the selected administrative-dispute-resolution service provider's supplemental rules.

2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. Cancellations, Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- a. subject to the provisions of [Paragraph 8](#), our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See [Paragraph 4\(i\)](#) and [\(k\)](#) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a

"Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of [Paragraph 4\(a\)\(iii\)](#), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily

for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.

When you receive a complaint, you should refer to [Paragraph 5](#) of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\)](#):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in [Paragraph 4\(f\)](#).

e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

f. Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

g. Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in [Paragraph 5\(b\)\(iv\)](#) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

h. Our Involvement in Administrative Proceedings. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

i. Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

j. Notification and Publication. The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

k. Availability of Court Proceedings. The mandatory

administrative proceeding requirements set forth in [Paragraph 4](#) shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under [Paragraph 3\(b\)\(xiii\)](#) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See [Paragraphs 1](#) and [3\(b\)\(xiii\)](#) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

5. All Other Disputes and Litigation. All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of [Paragraph 4](#) shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. Our Involvement in Disputes. We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. Maintaining the Status Quo. We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in [Paragraph 3](#) above.

8. Transfers During a Dispute.

a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. Policy Modifications. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name

registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

Comments concerning the layout, construction and functionality of this site should be sent to webmaster@icann.org.

Page Updated 17-May-2002

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UDRP RULES



Rules for Uniform Domain Name Dispute Resolution Policy

Policy Adopted: August 26, 1999
Implementation Documents Approved:
October 24, 1999

Note: These rules are now in effect. See www.icann.org/udrp/udrp-schedule.htm for the implementation schedule.

Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules")

(As Approved by ICANN on October 24, 1999)

Administrative proceedings for the resolution of disputes under the Uniform Dispute Resolution Policy adopted by ICANN shall be governed by these Rules and also the Supplemental Rules of the Provider administering the proceedings, as posted on its web site.

1. Definitions

In these Rules:

Complainant means the party initiating a complaint concerning a domain-name registration.

ICANN refers to the Internet Corporation for Assigned Names and Numbers.

Mutual Jurisdiction means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes

concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.

Panel means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration.

Panelist means an individual appointed by a Provider to be a member of a Panel.

Party means a Complainant or a Respondent.

Policy means the [Uniform Domain Name Dispute Resolution Policy](#) that is incorporated by reference and made a part of the Registration Agreement.

Provider means a dispute-resolution service provider approved by ICANN. A list of such Providers appears at www.icann.org/udrp/approved-providers.htm.

Registrar means the entity with which the Respondent has registered a domain name that is the subject of a complaint.

Registration Agreement means the agreement between a Registrar and a domain-name holder.

Respondent means the holder of a domain-name registration against which a complaint is initiated.

Reverse Domain Name Hijacking means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

Supplemental Rules means the rules adopted by the Provider administering a proceeding to supplement these Rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, the means for communicating with the Provider and the Panel, and the form of cover sheets.

2. Communications

(a) When forwarding a complaint to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:

(i) sending the complaint to all postal-mail and facsimile addresses (A) shown in the domain name's registration data in Registrar's Whois database for the registered domain-name holder, the technical contact, and the administrative contact and (B) supplied by Registrar to the Provider for the registration's billing contact; and

(ii) sending the complaint in electronic form (including annexes to the extent available in that form) by e-mail to:

(A) the e-mail addresses for those technical, administrative, and billing contacts;

(B) `postmaster@<the contested domain name>`; and

(C) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page the Provider concludes is maintained by a registrar or ISP for parking domain-names registered by multiple domain-name holders), any e-mail address shown or e-mail links on that web page; and

(iii) sending the complaint to any address the Respondent has notified the Provider it prefers and, to the extent practicable, to all other addresses provided to the Provider by Complainant under [Paragraph 3\(b\)\(v\)](#).

(b) Except as provided in [Paragraph 2\(a\)](#), any written

communication to Complainant or Respondent provided for under these Rules shall be made by the preferred means stated by the Complainant or Respondent, respectively (see [Paragraphs 3\(b\)\(iii\)](#) and [5\(b\)\(iii\)](#)), or in the absence of such specification

(i) by telecopy or facsimile transmission, with a confirmation of transmission; or

(ii) by postal or courier service, postage pre-paid and return receipt requested; or

(iii) electronically via the Internet, provided a record of its transmission is available.

(c) Any communication to the Provider or the Panel shall be made by the means and in the manner (including number of copies) stated in the Provider's Supplemental Rules.

(d) Communications shall be made in the language prescribed in [Paragraph 11](#). E-mail communications should, if practicable, be sent in plaintext.

(e) Either Party may update its contact details by notifying the Provider and the Registrar.

(f) Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:

(i) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or

(ii) if by postal or courier service, on the date marked on the receipt; or

(iii) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable.

(g) Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is

made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with [Paragraph 2\(f\)](#).

(h) Any communication by

(i) a Panel to any Party shall be copied to the Provider and to the other Party;

(ii) the Provider to any Party shall be copied to the other Party; and

(iii) a Party shall be copied to the other Party, the Panel and the Provider, as the case may be.

(i) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes.

(j) In the event a Party sending a communication receives notification of non-delivery of the communication, the Party shall promptly notify the Panel (or, if no Panel is yet appointed, the Provider) of the circumstances of the notification. Further proceedings concerning the communication and any response shall be as directed by the Panel (or the Provider).

3. The Complaint

(a) Any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules to any Provider approved by ICANN. (Due to capacity constraints or for other reasons, a Provider's ability to accept complaints may be suspended at times. In that event, the Provider shall refuse the submission. The person or entity may submit the complaint to another Provider.)

(b) The complaint shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form and shall:

(i) Request that the complaint be submitted for decision in accordance with the Policy and these Rules;

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(v) Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in [Paragraph 2\(a\)](#);

(vi) Specify the domain name(s) that is/are the subject of the complaint;

(vii) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;

(viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately

describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

(ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,

(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and

(3) why the domain name(s) should be considered as having been registered and being used in bad faith

(The description should, for elements (2) and (3), discuss any aspects of [Paragraphs 4\(b\)](#) and [4\(c\)](#) of the Policy that are applicable. The description shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(x) Specify, in accordance with the Policy, the remedies sought;

(xi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(xii) State that a copy of the complaint, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with [Paragraph 2\(b\)](#);

(xiii) State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction;

(xiv) Conclude with the following statement followed by the signature of the Complainant or its authorized representative:

"Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents."

"Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(xv) Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

(c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

4. Notification of Complaint

(a) The Provider shall review the complaint for administrative compliance with the Policy and these Rules and, if in compliance, shall forward the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the Respondent, in the manner prescribed by [Paragraph 2\(a\)](#), within three (3) calendar days following receipt of the fees to be paid by the Complainant in accordance with [Paragraph 19](#).

(b) If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.

(c) The date of commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under [Paragraph 2\(a\)](#) in connection with forwarding the Complaint to the Respondent.

(d) The Provider shall immediately notify the Complainant, the Respondent, the concerned Registrar(s), and ICANN of the date of commencement of the administrative proceeding.

5. The Response

(a) Within twenty (20) days of the date of commencement of the administrative proceeding the Respondent shall submit a response to the Provider.

(b) The response shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form and shall:

(i) Respond specifically to the statements and

allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) If Complainant has elected a single-member panel in the Complaint (see [Paragraph 3\(b\)\(iv\)](#)), state whether Respondent elects instead to have the dispute decided by a three-member panel;

(v) If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(vi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(vii) State that a copy of the response has been sent or transmitted to the Complainant, in accordance with [Paragraph 2\(b\)](#); and

(viii) Conclude with the following statement followed by the signature of the Respondent or its authorized representative:

"Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(ix) Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.

(c) If Complainant has elected to have the dispute decided by a single-member Panel and Respondent elects a three-member Panel, Respondent shall be required to pay one-half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel.

(d) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.

(e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.

6. Appointment of the Panel and Timing of Decision

(a) Each Provider shall maintain and publish a publicly available list of panelists and their qualifications.

(b) If neither the Complainant nor the Respondent has elected a three-member Panel ([Paragraphs 3\(b\)\(iv\)](#) and [5\(b\)\(iv\)](#)), the Provider shall appoint, within five (5) calendar days following

receipt of the response by the Provider, or the lapse of the time period for the submission thereof, a single Panelist from its list of panelists. The fees for a single-member Panel shall be paid entirely by the Complainant.

(c) If either the Complainant or the Respondent elects to have the dispute decided by a three-member Panel, the Provider shall appoint three Panelists in accordance with the procedures identified in [Paragraph 6\(e\)](#). The fees for a three-member Panel shall be paid in their entirety by the Complainant, except where the election for a three-member Panel was made by the Respondent, in which case the applicable fees shall be shared equally between the Parties.

(d) Unless it has already elected a three-member Panel, the Complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the Respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panelists. These candidates may be drawn from any ICANN-approved Provider's list of panelists.

(e) In the event that either the Complainant or the Respondent elects a three-member Panel, the Provider shall endeavor to appoint one Panelist from the list of candidates provided by each of the Complainant and the Respondent. In the event the Provider is unable within five (5) calendar days to secure the appointment of a Panelist on its customary terms from either Party's list of candidates, the Provider shall make that appointment from its list of panelists. The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider's selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the Parties.

(f) Once the entire Panel is appointed, the Provider shall notify the Parties of the Panelists appointed and the date by which, absent exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider.

7. Impartiality and Independence

A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.

8. Communication Between Parties and the Panel

No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules.

9. Transmission of the File to the Panel

The Provider shall forward the file to the Panel as soon as the Panelist is appointed in the case of a Panel consisting of a single member, or as soon as the last Panelist is appointed in the case of a three-member Panel.

10. General Powers of the Panel

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

(e) A Panel shall decide a request by a Party to consolidate

multiple domain name disputes in accordance with the Policy and these Rules.

11. Language of Proceedings

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

12. Further Statements

In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

13. In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

14. Default

(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

15. Panel Decisions

- (a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.
- (b) In the absence of exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider within fourteen (14) days of its appointment pursuant to [Paragraph 6](#).
- (c) In the case of a three-member Panel, the Panel's decision shall be made by a majority.
- (d) The Panel's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name(s) of the Panelist(s).
- (e) Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of [Paragraph 4\(a\)](#) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

16. Communication of Decision to Parties

- (a) Within three (3) calendar days after receiving the decision from the Panel, the Provider shall communicate the full text of the decision to each Party, the concerned Registrar(s), and ICANN. The concerned Registrar(s) shall immediately communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy.
- (b) Except if the Panel determines otherwise (see [Paragraph 4\(j\)](#) of the Policy), the Provider shall publish the full decision and the date of its implementation on a publicly accessible web site. In any event, the portion of any decision determining a

complaint to have been brought in bad faith (see [Paragraph 15\(e\)](#) of these Rules) shall be published.

17. Settlement or Other Grounds for Termination

(a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding.

(b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

18. Effect of Court Proceedings

(a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

(b) In the event that a Party initiates any legal proceedings during the pendency of an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, it shall promptly notify the Panel and the Provider. See [Paragraph 8](#) above.

19. Fees

(a) The Complainant shall pay to the Provider an initial fixed fee, in accordance with the Provider's Supplemental Rules, within the time and in the amount required. A Respondent electing under [Paragraph 5\(b\)\(iv\)](#) to have the dispute decided by a three-member Panel, rather than the single-member Panel elected by the Complainant, shall pay the Provider one-half the fixed fee for a three-member Panel. See [Paragraph 5\(c\)](#). In all other cases, the Complainant shall bear all of the Provider's fees, except as prescribed under [Paragraph 19\(d\)](#). Upon appointment of the Panel, the Provider shall refund the

appropriate portion, if any, of the initial fee to the Complainant, as specified in the Provider's Supplemental Rules.

(b) No action shall be taken by the Provider on a complaint until it has received from Complainant the initial fee in accordance with [Paragraph 19\(a\)](#).

(c) If the Provider has not received the fee within ten (10) calendar days of receiving the complaint, the complaint shall be deemed withdrawn and the administrative proceeding terminated.

(d) In exceptional circumstances, for example in the event an in-person hearing is held, the Provider shall request the Parties for the payment of additional fees, which shall be established in agreement with the Parties and the Panel.

20. Exclusion of Liability

Except in the case of deliberate wrongdoing, neither the Provider nor a Panelist shall be liable to a Party for any act or omission in connection with any administrative proceeding under these Rules.

21. Amendments

The version of these Rules in effect at the time of the submission of the complaint to the Provider shall apply to the administrative proceeding commenced thereby. These Rules may not be amended without the express written approval of ICANN.

Comments concerning the layout, construction and functionality of this site should be sent to webmaster@icann.org.

Page Updated 05-Feb-2002

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ICANN
UDRP
Statistics



Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy

10 May 2004

Summary of Status of Proceedings

Proceedings	Domain Names	Proceeding Status
566	931	Pending
24	34	Case suspended at complainant's request
26	49	Case suspended, other
616	1014	Total undisposed proceedings
6215	10719	Name transfer
47	60	Registration cancelled
1468	1892	Decision for respondent
60	640	Split decision
7790	13311	Dispositions by decision
8	15	Settlement with transfer
20	20	Settlement, unspecified result
10	13	Dismissal with prejudice
715	1052	Dismissal without prejudice
205	271	Dismissal, unspecified
958	1371	Dispositions without decision
13	14	Proceedings terminated for recommencement

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Page Updated 10 May 2004

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Hewlett-
Packard

v.

Alvaro Collazo

HPcanada.com



DECISION

Hewlett-Packard Company v. Alvaro Collazo
Claim Number: FA0302000144628

PARTIES

Complainant is **Hewlett-Packard Company**, Palo Alto, CA, USA (“Complainant”) represented by **Molly Buck Richard**, of **Thompson & Knight LLP**. Respondent is **Alvaro Collazo**, Tarariras, Colonia, Republic of Uruguay (“Respondent”).

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<hpcanada.com>**, registered with **Iholdings.Com, Inc.** d/b/a **Dotregistrar.Com**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on February 5, 2003; the Forum received a hard copy of the Complaint on February 10, 2003.

On February 7, 2003, Iholdings.Com, Inc. d/b/a Dotregistrar.Com confirmed by e-mail to the Forum that the domain name **<hpcanada.com>** is registered with Iholdings.Com, Inc. d/b/a Dotregistrar.Com and that the Respondent is the current registrant of the name. Iholdings.Com, Inc. d/b/a Dotregistrar.Com has verified that Respondent is bound by the Iholdings.Com, Inc. d/b/a Dotregistrar.Com registration agreement and has thereby agreed to resolve

domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On February 10, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of March 3, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@hpcanada.com by e-mail.

A timely Response was received on February 13, 2003.

Additional material was submitted by the Complainant, which was received by the National Arbitration Forum on February 15, 2003.

On February 19, 2003, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant claims as follows:

A. **CONFUSINGLY SIMILAR DOMAIN NAME (ICANN Rule 3(b)(ix)(1) and ICANN Policy ¶ 4(a)(i)):**

The domain name <**hpcanada.com**> registered by Collazo is confusingly similar to Complainant's famous HP mark, which was registered as a trademark throughout the world long before Collazo registered the domain name on November 3, 2002. The Respondent's domain name contains Complainant's exact mark, "HP," with a non-distinctive geographically descriptive term, "Canada," and the most common URL suffix ".com." "The mere addition of descriptive or generic words to a famous mark, however, does not eliminate the similarity between the domain name and the trademark." *Caterpillar Inc. v. Stephen R. Vine*, FA 97097 (Nat. Arb. Forum June 22, 2001). *See also Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that "neither the addition of an ordinary descriptive word... nor the suffix '.com' detract from the overall impression of the dominant part of the name in each case, namely the trademark SONY"). Complainant's HP Marks were in use almost 60 years prior to Respondent's registration of the domain name <**hpcanada.com**>.

Furthermore, consumers seeking information on Hewlett-Packard products or services available in Canada could easily assume that a site with the domain name <**hpcanada.com**> is associated with Hewlett-Packard, and would be highly surprised to discover that the owner of the domain name has no relationship to Hewlett-Packard. Respondent is not a licensee and is not affiliated with Complainant in any manner. Respondent's continued use of the domain name <**hpcanada.com**> is likely to confuse Complainant's customers and potential customers into believing that there is some affiliation, connection, sponsorship, approval or association between the Respondent and Complainant when in fact none exists.

**B. NO RIGHTS OR LEGITIMATE INTERESTS IN DOMAIN NAME
(ICANN Rule 3(b)(ix)(2) and ICANN Policy ¶4(a)(ii):**

Collazo has no rights or legitimate interests in the <**hpcanada.com**> domain name. He is simply exploiting the fact that Hewlett-Packard's customers and potential customers will, from time to time, include the geographic term "Canada" in a domain address when looking for information on Hewlett-Packard's business in Canada. He is attempting to confuse and to divert such customers to his Internet website for his own commercial gain through a posting of links on his website and the presence of advertising, including "pop-up" advertising. Collazo uses the <**hpcanada.com**> domain name to post links to commercial websites, some of which sell computers and related software and services, which is the same business in which Hewlett-Packard engages. (See printout from <**hpcanada.com**> at Exhibit C.) Certain links lead to websites operated by Dell Computer Corporation and Gateway, Inc., direct competitors of Hewlett-Packard. Collazo's <**hpcanada.com**> website also initiates "pop-up" advertising and contains large advertisements on the website home page itself. (See Exhibit C and additional printouts from <**hpcanada.com**> at Exhibit D.) All of these advertisements are for products or services offered by third-party businesses, not by Collazo himself.

This use is not a bona-fide offering of goods or services pursuant to Policy ¶ 4(c)(i) or noncommercial or fair use of the domain name pursuant to Policy ¶ 4(c)(iii). *See Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 114 (D. Mass. 2002) (finding that, because Respondent's sole purpose in selecting the domain names was to cause confusion with Complainant's website and marks, its use of the names was not in connection with the offering of goods or services or any other fair use); *see also MSNBC Cable, LLC v. Tsys.com*, D2000-1204 (WIPO Dec. 8, 2000) (finding that a respondent who sought profit by redirecting Internet traffic connected with the MSNBC mark had no rights or legitimate interests in the famous mark); *N. Coast Med., Inc. v. Allegro Med.*, FA 95541 (Nat. Arb. Forum Oct. 2, 2000) (finding no bona-fide use where Respondent used the domain name to divert Internet users to its competing website); *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000)

(finding no legitimate use of a mark when a respondent was using another's marks to divert Internet users to its own website).

On information and belief, Respondent is not known by, and is not affiliated with any business known by, the name "hpcanada.com," "hpcanada," or any similar name or mark. Hewlett-Packard has never granted Respondent permission to use the HP mark or any similar name or mark. Respondent is in no way affiliated with Hewlett-Packard. Respondent does not sell any of Complainant's products. Thus, Respondent does not meet the requirements of Policy ¶ 4(c)(ii). *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that when a respondent was not known by a mark it did not have rights in a domain name incorporating that mark); *see also General Mills, Inc. v. Zuccarini*, FA 97050 (Nat. Arb. Forum May 30, 2001) (finding that the respondent had no rights or legitimate interests in a domain name that misspelled a famous mark and that led users to a series of advertisement sites, stating that a "[r]espondent may not utilize close derivations of famous and distinctive trademarks and, thus, profit from Internet users' misspelling the Internet destinations they desire; *Nokia Corp. v. Private*, D2000-1271 (WIPO Nov. 3, 2000) (finding that a respondent was not commonly known by the mark contained in the domain name where the complainant, Nokia Corp., had not permitted the respondent to use the NOKIA mark and no other facts or elements justified prior rights or a legitimate connection to the name "NOKIA" or "wwwnokia"); *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding that a respondent had no rights or legitimate interest in the disputed domain name where it was not commonly known by the mark and never applied for a license or permission to use the mark).

Here, it is clear that Collazo has no rights or legitimate interests in the disputed domain name, <**hpcanada.com**>, thus Policy ¶ 4(c)(ii) has been satisfied.

C. REGISTRATION AND USE IN BAD FAITH (ICANN Rule 3(b)(ix)(3) and ICANN Policy 4(a)(iii)):

Collazo uses the HP mark in the <**hpcanada.com**> domain name to divert Internet users to a website that links to other commercial websites, some of which sell competitive computers and related software and services and that contains pop-up and other advertisements. This is a commercial purpose for which Collazo has no legitimate reason to use the name or mark "HP" or "hpcanada.com." By diverting consumers to sites selling computers and computer-related products and services and by placing third-party advertisements on the site, Collazo is opportunistically attempting to trade on and to profit from the goodwill in and fame of Complainant's mark. Collazo can be presumed to have known of Complainant's famous HP mark – it is not a common word and yet is incorporated in its entirety into Respondent's domain name.

Registration of a domain name, despite knowledge of Complainant's rights, is evidence of bad faith registration pursuant to Policy ¶ 4(a)(iii). See *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. Feb. 11, 2002) (finding that "[w]here an alleged infringer chooses a mark he knows to be similar to another, one can infer an intent to confuse"); see also *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration). In addition, Collazo's behavior constitutes bad faith registration and use under Policy ¶ 4(c)(iv). See *General Mills, supra* (finding bad faith where the respondent linked the disputed domain name, which was a misspelling of a famous mark, to a series of other advertisement websites, and noting that similarity or dissimilarity of products is not a factor under the ICANN Policy or the current law of famous marks); see also *America Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000) (finding a suggestion of opportunistic bad faith where a mark was obviously connected with the complainant and its products and where respondent had no connection with the complainant or its products); *AltaVista v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000) (finding bad faith under Policy ¶ 4(c)(iv) where the respondent linked the domain name to an Internet site that advertised and offered numerous web services); *ESPN, Inc. v. Ballerini*, FA 95410 (Nat. Arb. Forum Sept. 15, 2000) (finding bad faith when the website in dispute was linked by the respondent to a second website, from which second website the respondent presumably received a portion of advertising revenue because of his direction of Internet traffic to that site); *Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with the Complainant's well known marks, thus creating a likelihood of confusion strictly for commercial gain).

Respondent's only possible reason for using the domain name <**hpcanada.com**> is to intentionally attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

B. Respondent

According to the Respondent:

I have registered this domain to create a portal of resources for Canadian expatriates in Uruguay and the rest of South America. HP in my domain stands for "Home Page". Giving Hewlett Packard exclusivity over the two letter combination "HP" is completely irrational and against the spirit of the Internet and the UDRP.

The domain was parked with the registrar while in development and I didn't realize that there were offers for products competing with Hewlett Packard since that advertising is not controlled by me. I have now forwarded the domain to a dedicated parking page with no advertising.

C. Additional Submissions

Complainant submitted additional material contending:

Respondent does not deny in his e-mailed comments that Hewlett-Packard is the owner of the “HP” trademark or any of the many registrations described in the complaint or that sixty years of significant and extensive use of the HP marks have made those marks famous and distinctive. He does voice his dislike of that portion of well-established trademark law that allows Hewlett-Packard to exclude others from using its distinctive, famous “HP” mark in a manner likely to confuse others, but that dislike is, unfortunately for Collazo, irrelevant to the famous and highly-distinctive nature of the HP marks and the effect that status has on the ability of others to use “HP” in commerce.

Respondent’s only attempt to defend his bad-faith infringing activity is to say that “HP” in his domain name stands for “Home Page,” and to claim not to have known what advertising was being placed on his <**hpcanada.com**> site. Hewlett-Packard notes that the advertising at <**hpcanada.com**> was the same advertising that still appears on another of Respondent’s websites, <alvarocollazo.com>. Respondent admits that the advertising contained “offers for products competing with Hewlett Packard.” Respondent claims that he has now forwarded the domain to a page with no advertising.

Hewlett-Packard declines to place any credence in Respondent’s hurried, after-the-fact attempt to justify his bad-faith infringing activity, and respectfully requests that the Panel do the same, deciding this dispute with regard only to the facts and evidence as they existed at the time the complaint was filed. To allow Respondent’s claim that he has made post-filing changes to his website to alter the outcome of this dispute would open the door for all future respondents in domain name disputes to avoid the consequences of their actions and continue to hold domain names containing the famous, distinctive trademarks of others simply by claiming that they had modified their websites after a complaint is filed. This would defy the entire basis of the Uniform Domain Name Dispute Resolution Policy. Borrowing language from Respondent’s e-mail, Hewlett-Packard notes that such an outcome would be “completely irrational and against the spirit of the Internet and the UDRP.”

Respondent did not submit any additional material.

FINDINGS

Complainant has proved each of the three necessary elements for this Panel to order the <**hpcanada.com**> domain name to be transferred:

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution

Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant, Hewlett-Packard Co., is the owner of numerous marks in connection with computer hardware, printers, peripherals, software and other related goods and services. Complainant holds numerous registrations for the HP mark, including, *inter alia*, U.S. Patent and Trademark Office Reg. No. 1,116,835 registered on April 24, 1979. Complainant first used the HP mark in commerce in 1941. The earliest registered trademark provided to the Panel dates from 1955 (still a rather long time for these two letters to be used in commerce). Many decades of extensive promotional efforts have made the HP mark famous and distinct, especially in the computer market where Complainant manufactures printers, *See The Men’s Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16 2002) (“Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning”); *see also Wal-Mart Stores, Inc. v. Stork*, D2000-0628 (WIPO Aug. 11, 2000) (finding Complainant has rights to the name when the mark is registered in a country even if Complainant has never traded in that country).

Respondent’s <**hpcanada.com**> domain name is confusingly similar to Complainant’s HP mark. Respondent’s domain name contains Complainant’s HP mark in its entirety (even though the mark is admittedly short), and only deviates by the addition of a non-distinctive geographic term. *See CMGI, Inc. v. Reyes*, D2000-0572 (WIPO Aug. 8, 2000) (finding that the domain name <cmgiasia.com> is confusingly similar to Complainant’s CMGI mark); *see also Net2phone Inc, v. Netcall SAGL*, D2000-0666 (WIPO Sept. 26, 2000) (finding that Respondent’s registration of the domain name <net2phone-europe.com> is confusingly similar to Complainant’s mark); *see also Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001) (finding confusing similarity where the domain name in dispute contains the identical mark of Complainant combined with a generic word or term).

Rights or Legitimate Interests

Respondent does not have any rights or legitimate interests in the <hpcanada.com> domain name. Respondent is simply exploiting the fact Hewlett-Packard's customers and potential customers might include the geographic term "Canada" in a domain address when looking for information on Complainant's business in Canada. Such use attempts to confuse and divert Internet users based solely on the fame of Complainant's HP mark. Respondent's use of the domain name indicates <hpcanada.com> posts links to commercial websites, some of which sell computers and related software and services that compete with Complainant (even if such information commonly occurs on so-called "parking" pages, Respondent has a responsibility for the content Respondent allows to be posted at its site).

Additionally, Respondent makes use of "pop-up" advertising on its website. Respondent's use of the domain name is not a bona-fide offering of goods or services under Policy ¶ 4(c)(i), or noncommercial or fair use under Policy ¶ 4(c)(iii). *See Vapor Blast Mfg. Co. v. R & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001) (finding that Respondent's commercial use of the domain name to confuse and divert Internet traffic is not a legitimate use of the domain name); *see also Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000) (finding no legitimate use when Respondent was diverting consumers to its own website by using Complainant's trademarks); *see also Chip Merch., Inc. v. Blue Star Elec.*, D2000-0474 (WIPO Aug. 21, 2000) (finding that the disputed domain names were confusingly similar to Complainant's mark and that Respondent's use of the domain names to sell competing goods was illegitimate and not a bona fide offering of goods); *see also Ticketmaster Corp. v. DiscoverNet, Inc.*, D2001-0252 (WIPO Apr. 9, 2001) (finding no rights or legitimate interests where Respondent generated commercial gain by intentionally and misleadingly diverting users away from Complainant's site to a competing website).

Respondent is not commonly known by the domain name pursuant to Policy ¶ 4(c)(ii). Respondent is not authorized to make use of the HP mark, nor is Respondent affiliated in any way with Complainant, *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark); *see also Charles Jourdan Holding AG v. AIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) Respondent is not a licensee of Complainant; (2) Complainant's prior rights in the domain name precede Respondent's registration; (3) Respondent is not commonly known by the domain name in question).

Registration and Use in Bad Faith

Respondent had knowledge of Complainant's rights in the HP mark prior to seeking registration of the <**hpcanada.com**> domain name. Therefore, subsequent registration of the infringing domain name is evidence of bad faith under Policy ¶ 4(a)(iii). See *Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (holding that "there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively"); see also *Exxon Mobil Corp. v. Fisher*, D2000-1412 (WIPO Dec. 18, 2000) (finding that Respondent had actual and constructive knowledge of Complainant's EXXON mark given the worldwide prominence of the mark and thus Respondent registered the domain name in bad faith); see also *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. Feb. 11, 2002) (finding that "[w]here an alleged infringer chooses a mark he knows to be similar to another, one can infer an intent to confuse").

Respondent's only possible reason for using the domain name <**hpcanada.com**> is to intentionally attract, for commercial gain, Internet users to Respondent's website. Respondent's infringing use constitutes bad faith registration and use pursuant to Policy ¶ 4(b)(iv). See *G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that Respondent registered and used the domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because Respondent was using the confusingly similar domain name to attract Internet users to its commercial website); see also *Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where Respondent directed Internet users seeking Complainant's site to its own website for commercial gain); see also *State Farm Mut. Auto. Ins. Co. v. Northway*, FA 95464 (Nat. Arb. Forum Oct. 11, 2000) (finding that Respondent registered the domain name <statefarmnews.com> in bad faith because Respondent intended to use Complainant's marks to attract the public to the website without permission from Complainant).

While Respondent's claim the HP in <**hpcanada.com**> means "home page" may be true, it strikes this Panelist as *not likely to be true*, especially in light of the fact the domain name was registered on November 3, 2002 and nothing was constructed at the site as of the time of this complaint. It doesn't take much to construct a "portal of resources for Canadian expatriates" because such a site would consist primarily of links to other sites.

DECISION

Having established all three elements required under ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**hpcanada.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Houston Putnam Lowry, Panelist
Dated: March 5, 2003

[Click Here](#) to return to the main Domain Decisions Page.

[Click Here](#) to return to our Home Page

Basic Chemical Solutions

v.

BCS California

BASICCHEMICALSOLUTIONS.COM

[List of Decisions](#)[Liste des décisions](#)

ADMINISTRATIVE PANEL DECISION

Under the ICANN Uniform Domain Name Dispute Resolution

Complainant: **Basic Chemical Solutions, LLC**
Respondent: **BCS California Corporation and Jason Singh**
Case Number: **AF-0923**
Contested Domain Name: **BASICCHEMICALSOLUTIONS.COM**
Panel Member: **Houston Putnam Lowry**

1. Parties and Contested Domain Name

The Complainant in this proceeding is BASIC CHEMICAL SOLUTIONS, LLC of 525 Seaport Boulevard, Redwood City, California 940063, U.S.A.

No response has been filed. The registrant of the at-issue domain name and nominal respondents are
BCS CALIFORNIA CORPORATION and JASON SINGH, both of 2915 Gerber Street, Berkeley, California 94705, U.S.A.

The subject domain name is BASICCHEMICALSOLUTIONS.COM and the registrar is Registrar.com (“Registrar”).

2. Procedural history

The electronic version of the Complaint form was filed on-line through eResolution’s Website on July 5, 2001. The hardcopy of the Complaint Form and annexes were received on July 6, 2001. Payment was received on July 6, 2001.

Upon receiving all the required information, eResolution’s clerk proceeded to:

- Confirm the identity of the Registrar for the contested Domain Name;
- Verify the Registrar’s Whois Database and confirm all the essential contact information for Respondent;
- Verify if the contested Domain Name resolved to an active Web page;
- Verify if the Complaint was administratively compliant.

This inquiry lead the Clerk of eResolution to the following conclusions: the Registrar is Register.com, the Whois database contains all the required contact information, the contested Domain Name resolves to an active Web page and the Complaint is administratively compliant.

An email was sent to the Registrar by eResolution Clerk's Office to obtain confirmation and a copy of the Registration Agreement on July 6, 2001. The requested information was received July 6, 2001.

The Clerk then proceeded to send a copy of the Complaint Form and the required Cover Sheet in accordance with paragraph 2 (a) of the ICANN's Rules for Uniform Domain Name Dispute Resolution Policy. The Clerk's Office fulfilled all its responsibilities under Paragraph 2(a) in forwarding the Complaint to the Respondent, notifying the Complainant, the concerned Registrar and ICANN on July 6, 2001. This date is the official commencement date of the administrative proceeding.

No emails were returned 'undeliverable'. All the faxes were successful.

The complaint, official notification and all the annexes were sent via registered mail with proof of service, to the respondent. According to the Canada Post tracking system, all were delivered except for the copy that was sent to the billing contact.

The Respondents did not submit a Response neither via eResolution's website nor a signed version.

On August 1, 2001, the Clerk's Office contacted Houston Putnam Lowry, and requested that he acts as panelist in this case.

On August 1, 2001, Houston Putnam Lowry accepted the appointment to act as panelist in this case and filed the necessary Declaration of Independence and Impartiality.

On August 2, 2001, the Clerk's Office forwarded a user name and a password to Houston Putnam Lowry, allowing him to access the Complaint Form, the Response Form, and the evidence through eResolution's Automated Docket Management System.

On August 2, 2001, the parties were notified that Houston Putnam Lowry had been appointed and that a decision was to be, save exceptional circumstances, handed down on August 16, 2001.

3. Factual Backgrounds

Complainant Basic Chemical Solutions, LLC (a New Jersey limited liability company) is the registered owner of United States trademark #2,315,436 "BASIC CHEMICAL SOLUTIONS". This mark was first used in commerce in March 1996 and the registration was issued on February 8, 2000 by the United States Patent and Trademark office (which predates the registration of the domain name). The registered trademark is essentially identical to the domain name at issue, BASICCHEMICALSOLUTIONS.COM.

The domain name BASICCHEMICALSOLUTIONS.COM was registered with the Registrar on July 6, 2000. The registration listed BCS California Corporation and Jason Singh as the domain name owners. There is no BCS California Corporation on record with the California Secretary of State. While the corporation may be incorporated elsewhere, it would have qualified in as a foreign corporation with the California Secretary of State because it has a California address. The fact BCS California Corporation did not register as required by local law suggests it does not exist.

The contact telephone numbers for the Respondents are the same telephone numbers as for Jas S. Rai. Jas S. Rai answers the telephone at these numbers.[1] Jas S. Rai is listed as Respondents' other contact or representative. The contact email address is jasrai99@yahoo.com. Under circumstances such as these, a Yahoo.com email contact is unusual because bona fide businesses do not tend to use Yahoo mail. Jas S. Rai admitted to Louis Abronson that he owns the BASICCHEMICALSOLUTIONS.COM domain name in spite of how it is registered. All of these facts suggest Jas S. Rai is using the names BCS California Corporation and Jason Singh as a nom de plume. Absent his denial of these facts, they will be assumed.

Jas S. Rai was offered a job at Complainant Basic Chemical Solutions, LLC on July 17, 2000 (see Annex 2). He accepted the position on August 16, 2000 (see Annex 3). On August 24, 2000, he resigned effective the day before (August 23, 2000) (see Annex 4). Jas S. Rai continues to work in the chemicals field for a different (unnamed) employer.

If Complainant Basic Chemical Solutions, LLC did not meet Jas S. Rai's financial demands concerning the transfer of the domain name, Jas S. Rai threatened to transfer the BASICCHEMICALSOLUTIONS.COM to a relation who owns a British chemicals company in direct competition with Complainant Basic Chemical Solutions, LLC. It should be noted the present registered owner of the BASICCHEMICALSOLUTIONS.COM domain name is located in Coventry, England, making it appear Jas S. Rai carried out his threat.[2]

BASICCHEMICALSOLUTIONS.COM resolves to an "under construction" web page which uses the name "Basic Chemical Solutions" on top and refers to unspecified cleaning chemicals.

4. Parties' Contentions

Complainant Basic Chemical Solutions, LLC contends BCS California Corporation and Jason Singh registered and use the BASICCHEMICALSOLUTIONS.COM domain name in violation of the Uniform Dispute Resolution Policy by infringing (either directly or indirectly) on the Basic Chemical Solutions trademark.

Respondents have failed to respond to any of the allegations. This means Complainant's allegations are uncontested. A complainant still needs to make out a prima facie case because panelists do not render default awards simply because a respondent fails to respond, ICANN Rule 5(ix)(e).

5. Discussions and Findings

In order to obtain relief under the Uniform Domain Name Dispute Resolution Policy adopted on August 26, 1999 (and effective December 1, 1999 under the facts of this case because the

registrar is Register.com), a complaining party must prove ALL of the following to be entitled to relief in this process:[3]

- (i) the respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered and is being used in bad faith.

A. The Respondent's Domain Name Is Identical Or Confusingly Similar To A Trademark Or Service Mark In Which The Complainant Has Rights.

The domain name is BASICCHEMICALSOLUTIONS.COM, which is substantially similar to the Basic Chemical Solutions trademark. Complainant and Jas S. Rai (the real party in interest behind the Respondents) are in the same business (the "chemical" business), meaning confusion is likely. Given the facts, it is presumed the current registered owner of the BASICCHEMICALSOLUTIONS.COM domain name (Grewal) is either a direct competitor or a nominee for a direct competitor of Complainant.

B. The Respondents Have No Rights Or Legitimate Interests In Respect Of The Domain Name.

None of the standard indicia demonstrating rights to a domain name described in the ICANN Uniform Domain Name Dispute Resolution Policy Paragraph 4(c) appear to be present in this case:

(i) before any notice to respondent of the dispute, respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) respondent (as an individual, business, or other organization) have been commonly known by the domain name, even if respondent has acquired no trademark or service mark rights; or

(iii) respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panelist was unable to find any other factors which show Respondents have any rights or legitimate interest to the BASICCHEMICALSOLUTIONS.COM domain name. Respondents' silence suggests Respondents were also unable to demonstrate any factors which show a right or legitimate interest.

C. The Respondent's Domain Name Has Been Registered And Is Being Used In Bad Faith.

Under ICANN Uniform Domain Name Dispute Resolution Policy Paragraph 4(b), the following non-exclusive factors indicate registration and use of a domain name in bad faith:

(i) circumstances indicating that respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of respondent's documented

out-of-pocket costs directly related to the domain name; or

(ii) respondent has registered the domain name in order to prevent the owner of the trademark or

service mark from reflecting the mark in a corresponding domain name, provided that respondent

engaged in a pattern of such conduct; or

(iii) respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a

likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or

endorsement of respondent's web site or location or of a product or service on respondent's web

site or location.

Basic Chemical Solutions, LLC and Jas S. Rai work in the same industry. Basic Chemical Solutions, LLC and Grewal are presumed to be direct competitors in light of Jas S. Rai's statements to Louis S. Abronson, Esq. (see Annex 6). The threat to transfer the BASICCHEMICALSOLUTIONS.COM domain name to a relation who owns a British chemicals company in direct competition with Complainant Basic Chemical Solutions, LLC (if certain financial demands were not met) clearly shows bad faith.

A nominal respondent will not shield a real party in interest from the jurisdiction of a panel under the

Uniform Dispute Resolution Policy.[4]

A number of panelists have discussed the requirement that a domain name must not only be registered in based faith, but it also must be used in bad faith. A domain name may be used in any of the following ways (and can be used more than one way at the same time):

1. A location for a web site (and all that entails, ranging from the publication of information to electronic commerce).

2. An address for email.[5]

3. To prevent another from using the domain name.

"Bad faith" is defined in Black's Law Dictionary 7th edition at page 134 as: "1. Dishonesty

of belief or purpose..". In *Halsey v. Brotherhood* (1881), 19 Ch. D. 386 Lord Coleridge L.C.J. in determining whether there was evidence of *mala fides* stated that the task of the Court was to consider "whether there is anything to show that what the defendant stated was stated without reasonable and probable cause".

While it may be easy to prove a domain name was registered in bad faith, it is sometimes hard to prove it is being used in bad faith. However, this Panelist believes the Uniform Dispute Resolution Policy means simply that the domain name is being wrongfully retained by the registrant (otherwise the panel could not offer an effective remedy). A wrongful registrant should not be able to escape the jurisdiction of a panel simply because the domain name is being used only for email (or simply to prevent another from using the domain name). A number of other panelists seem to agree with this interpretation.[6]

Given the correspondence and other communications between the parties, it seems clear the BASICCHEMICALSOLUTIONS.COM domain name was both registered in bad faith[7] and is being used in bad faith. Furthermore, the BASICCHEMICALSOLUTIONS.COM domain name was transferred to a third party in an attempt to avoid this panel's jurisdiction and to further harm Complainant. This clearly demonstrates continuing bad faith.

6. Conclusion

For the foregoing reasons, the BASICCHEMICALSOLUTIONS.COM domain name shall be transferred to Basic Chemical Solutions, LLC.

7. Signature

(s) Houston Putnam Lowry
Meriden, Connecticut USA
August 3, 2001.
Sole Panelist

[1] According to the complaint, the contact telephone number is (925) 518-9558. According to Jas S. Rai's letterhead on August 24, 2000, his telephone number is (925) 518-9558.

[2] The Panel is concerned the Registrar might have allowed a transfer of the domain name's ownership while this proceeding was pending (although this proceeding started on July 6 and the domain name appears to have been transferred on the same date, making the timing uncertain).

[3] ICANN Uniform Dispute Resolution Policy Paragraph 4(a).

[4] *Parker Hannifin Corporation v. East Bay Web Site Company*, AF-0587 (12/22/00)

[5] See, for example, *Magic Software Enterprises v. Evergreen Technology Corp.*, WIPO D-2000-0746.

[6] *Telstra Corp. v. Nuclear Marshmallows*, WIPO D2000-0003; *MTR Software v. Esther Cao*, AF-0415; *Coty Cosmetics v. Jaguar Ltd*, AF-0416; *JVC America v. Damian Macafee*, CPR-007; and *Solomon R. Guggenheim Foundation v. Jesus J. Ruiz Zuazu*, FA0008000095319.

[7] Given the short amount of time between the registration of the domain name and the employment offer, Jas S. Rai knew, or should have known, about Complainant's registered trademark at the time of registration.

HOME	BACK	SITE MAP
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**Schouten
Industries**

v.

**Canadian
Soylife Health**

SoyLifeca.com



DECISION

Schouten Industries B.V. and Schouten Products B.V. v. Canadian SoyLife Health Co.
Ltd.
Claim Number: FA0303000149188

PARTIES

Complainants are **Schouten Industries B.V.** and **Schouten Products B.V.**, NETHERLANDS (“Complainants”) represented by **R. Peter Spies**, of **Dineff Trademark Law Limited**. Respondent is **Canadian SoyLife Health Co. Ltd.**, Vancouver, BC, CANADA (“Respondent”) represented by **Ari Goldberger**, of **ESQwire.com Law Firm**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**soylifeca.com**>, registered with **Tucows, Inc.**

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Houston Putnam Lowry (chair), Tom Arnold and David H. Bernstein as Panelists.

PROCEDURAL HISTORY

Complainants submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on March 12, 2003; the Forum received a hard copy of the Complaint on March 14, 2003.

On March 13, 2003, Tucows, Inc. confirmed by e-mail to the Forum that the domain name <**soylifeca.com**> is registered with Tucows, Inc. and that the Respondent is the current registrant of the name. Tucows, Inc. has verified that Respondent is bound by the Tucows, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On March 17, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of April 7, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@soylifeca.com by e-mail.

A timely Response was received and determined to be complete on June 9, 2003.

Complainants' timely Additional Submission was received on June 16, 2003.

Respondent's timely Additional Submission was received on June 23, 2003.

On July 2, 2003, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the Forum appointed Houston Putnam Lowry (chair), Tom Arnold and David H. Bernstein as Panelists.

RELIEF SOUGHT

Complainants request that the domain name be transferred from Respondent to Complainants.

PARTIES' CONTENTIONS

A. Complainants

[a.] The disputed domain name is identical to Complainants' trademarks; ICANN Rule 3(b)(ix)(1); ICANN Policy 4(a)(i).

- (i) Complainants, Schouten Industries B.V. and Schouten Products B.V. are sister corporations, which are both owned by the Royal Schouten Group.
- (ii) Complainants own a registered and pending trademark in the United States, a registered trademark in Canada as well as numerous registrations world

wide for SOYLIFE (hereinafter "the mark").

(iii) Complainants own a registration for the domain name "soylife.com."

(iv) Complainants have been using the mark in commerce since September of 1995. During this period, the mark has acquired distinctiveness and holds, for Complainants, substantial goodwill. The mark has been used on direct promotional materials, on customer packaging, at trade shows and has been advertised in professional trade magazines. Complainants have spent an estimated \$ 750,000.00 to \$ 1,000,000.00 in marketing expenses to promote its mark, SOYLIFE.

(v) The disputed domain name, soylifeca.com, and Complainants' trademarks are identical. The domain name is identical to Complainants' trademarks in appearance sound and connotation. See Restatement (Third) of Unfair Competition §21(a) (1995). Viewed in its entirety the domain name differs from Complainants' trademark solely by the suffix "ca", identifying the country code abbreviation for Canada, which, as such, has no distinguishable character, and may therefore be considered generic. The mere addition of a geographic prefix or suffix to a registered mark does not prevent the domain name from being found to be confusingly similar. See *Texaco, Inc. v. Texaco Domain Canada*, FA94869 (Nat. Arb. Forum June 27, 2000); *BPM Productions, Inc. v. Bog*, FA125814 (Nat. Arb. Forum Nov. 14, 2002).

Complainants' mark, SOYLIFE, is the dominant element of Respondent's soylifeca.com domain name and thereby will cause damaging confusion in the market. See *Reuters Ltd. v. Global Net 2000, Inc.*, D2000-0441 (WIPO July 13, 2000)

[b.] Respondent has no rights or legitimate interests in respect of the domain name that is the subject of the complaint. ICANN Rule 3(b)(ix)(2); ICANN Policy 4(a)(ii).

(i) Respondent's use of the domain name before prior to this dispute can not be considered a bona fide offering of goods or services.

A bona fide offering of goods and services requires that the Respondent had no knowledge of Complainants' prior rights in the trademark SOYLIFE and the domain name soylife.com. A bona fide offering further requires that the Respondent has engaged in a good faith attempt to establish its business.

Complainants' US trademark registered on June 24, 1997 with a priority date of December 29, 1995; the Canadian trademark registered on February 24, 1998 with priority of December 20, 1995. Complainants' domain name soylife.com was registered on July 31, 1997.

Respondent commenced its business activities in January 2000 and the company was registered pursuant to Canadian federal law in July of 2001. Respondent filed an Intent-to-Use application for the mark SOY LIFE with the Canadian Intellectual Property Office on July 18, 2001 and an Intent-to-Use application for the mark SOYLIFE with the USPTO on October 17, 2001. The domain name soylifeca.com was created on June 29, 2001.

Prior to Respondent's commencement of business, Complainants had already used and registered its mark SOYLIFE in commerce. Consequently, Complainants had already created and established goodwill in the mark before Respondent registered the disputed domain.

Respondent is not only using Complainants' trademark as a domain name, Respondent has also filed a separate Intent to Use application in Canada and the United States that are identical to Complainants' prior trademark registrations. A review of the US Patent and Trademark Office's on-line database shows that Complainants own the only Registration for the mark SOYLIFE. The US search result shows only two additional marks, namely, a pending application for SOYLIFE in the name of Complainants and a pending application in the name of Respondent.

A search of the Canadian Trademark Office's on-line Register mirrors the aforementioned finding. Complainants own the only registration for the mark SOYLIFE on the Canadian Register. The only other mark on the Canadian Register is a pending application for SOY LIFE in the name of Respondent.

The search results underline the strength of Complainants' mark in both countries. The results also suggest that it is unlikely that a third party would create the exact same mark for an accessory or related product without the intention to benefit from the goodwill that is associated with the senior mark.

In light of the above, it is apparent that Respondent had notice of Complainants' trademarks and domain name prior to starting its own business. The registration of Complainants' trademarks prior to Respondent's registration and use of the domain name soylifeca.com should have provided Respondent with public notice of Complainants' ownership and rights in the same.

Respondent has no overriding or superior rights or legitimate interests in the

domain name nor does he enjoy a license or is otherwise authorized to make any use of the SOYLIFE mark for any purpose. Respondent is simply exploiting the fact that consumers and potential; customers may include a geographic term, e.g. the country code "ca" when searching for consumer products on-line. See *Hewlett-Packard Company v. Alvaro Collazo*, FA144628 (Nat. Arb. Forum March 5, 2003).

(ii.) Respondent has not been commonly known by the domain name soylifeca.com.

At the time Respondent registered the domain name soylifeca.com, Respondent had just commenced its business activities. It registered its company under Canadian federal law one month after the registration of the domain name. Consequently, Respondent was not commonly known under the disputed domain name at the time of the filing.

Complainants' further investigation has not uncovered any evidence that Respondent has been commonly known by the disputed domain name. An on-line search for the key word "soylife" utilizing the search engines "Google", "Altavista", "Lycos" and "Yahoo", has revealed only web sites and articles related to Complainants' trademark and products.

In light of these results, Complainants conclude that Respondent was not at the time of filing, nor is now, commonly known by the domain name soylifeca.com.

(iii.) Respondent is not making a legitimate noncommercial or fair use of the domain name, but rather has shown a clear intent to commercially gain from misleading and diverting consumers and/or an intent to tarnish the trademark or service mark at issue.

Respondent is using the domain name soylifeca.com for its own commercial benefit, using the site to sell its soymilk maker. Respondent registered and used the soylifeca.com domain name to promote the sale of this product. It is neither a bona fide offering of goods or services nor an example of a legitimate noncommercial use when the holder of a domain name uses it to divert Internet users to its own unrelated site. See *AM. Online, Inc. v. Tencent Comm. Corp.*, FA 93668 (Nat. Arb. Forum Mar. 21, 2000). Respondent is not making a legitimate non-commercial or fair use of the domain name, since it clearly is seeking commercial gain by misleadingly diverting consumers to its own website. See *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000). Respondent's use of the domain name to sell competing goods or goods that relate to Respondent's products is an illegitimate use and not a bona fide offering of goods. See *The Chip Merch., Inc. v. Blue Star Elec.*,

D2000-0474 (WIPO Aug. 21, 2000).

In addition, the goods that are covered by Complainants' marks and the goods that are marketed under the disputed domain name stand in close proximity as Respondent's goods are accessory to those of Complainants. Respondent is taking advantage of the similarity between Complainants' registered mark and the disputed domain name to market its soymilk maker. See *Princeton University Press v. Good Domains*, FA 124993 (Nat. Arb. Forum Nov. 4, 2002)

Respondent markets an electronic device that enables consumers to produce soymilk from soybeans. Respondent's product uses Complainants' product (soy beans) in order to produce soy milk (non-alcoholic soy based beverages). Based upon the aforementioned, Respondent's product is clearly complementary to Complainants' products. The products stand in close proximity, which will cause consumers to likely associate Complainants' products with those of Respondent's. Both, Complainant and Respondent, target the same audience, namely, health conscious consumers or consumers with special dietary needs.

Respondent opportunistically uses Complainants' SOYLIFE mark to generate interest in its soylifeca.com domain name and corresponding website. Such commercial use of the domain name to confuse and divert Internet traffic is not a legitimate use. See *Arrow Electronics, Inc. v. Vitty, Inc.*, FA140637 (Nat. Arb. Forum Feb 18, 2003); *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum March 9, 2000) (finding no legitimate use when Respondent was diverting consumers to its own website by using Complainant's trademarks). Importantly, the site that an Internet user is accessing when they enter soylifeca.com offers Respondent's product, which relates to Complainants' products. Respondent's use of another organization's trademark to attract business is not a bona fide offering of goods. Diverting consumers to Respondent's competing site is incompatible with a legitimate noncommercial or fair use of a domain name. See *Best Western Int'l, Inc. v. Sepia*, FA 113984, at 3 (Nat. Arb. Forum June 26, 2002)

[c.] The disputed domain name has been registered and used in bad faith; ICANN Rule 3(b)(ix)(3); ICANN Policy 4(a)(iii).

By using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

As mentioned herein above, [5][b](i), a registered trademark operates as constructive notice of the existence of a mark. Yet, when a Respondent registers a domain name that is identical to a trademark, despite actual or constructive notice, this constitutes bad faith. See *Singapore Airlines Ltd. v. P & P Servicios de Comunicacion S.L.*, D2000-0643 (WIPO Aug. 29, 2000; *Princeton University Press v. Good Domains*, FA124993 (Nat. Arb. Forum Nov. 4, 2002).

In the year 2002, the on-line auction house www.auctionmart.canada.com linked to the AuctionMart Edmonton (edmontonauction.canada.com), which offered Respondent's soymilk maker for bid. On that same page, the Internet user could find a link to Complainants' web site www.soylife.com, which was posted right next to a picture of Respondent's product.

Respondent uses the SOYLIFE mark in the soylifeca.com domain name to divert Internet users to a website that sell accessory and related products. This is a commercial purpose for which Complainant has no legitimate reason to use the name or mark SOYLIFE or soylifeca.com. See *Hewlett-Packard Company v. Alvaro Collazo*, FA144628 (Nat. Arb. Forum March 5, 2003). By diverting consumers to sites selling related products, Respondent is opportunistically attempting to trade on and to profit from the goodwill in Complainants' mark.

It is evidence that a domain name has been registered in bad faith when a Respondent registers a domain name that is identical to a trademark despite actual or constructive notice of the mark. See *Princeton University Press v. Good Domains*, FA124993 (Nat. Arb. Forum November 4, 2002). Registration of a domain name, despite knowledge of Complainants' rights, is evidence of bad faith registration pursuant to Policy Section 4(a)(iii). See *HP Company v. Avaro Collazo*, FA144628 (Nat. Arb. Forum March 5, 2003); *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum April 17, 2000); *America Online, Inc. v. Fu*, D2000-1374 (WIPO December 11, 2000) (finding a suggestion of opportunistic bad faith where a mark was obviously connected with the complainant and its products and where respondent had no connection with the complainant or its products). The use of Respondent's product in connection with Complainants' trademark and domain name clearly indicates Respondent's bad faith.

When Complainant learned of Respondent's existence, Complainants sent a Cease & Desist letter requesting Respondent to cease all use of its mark SOYLIFE. Respondent has ignored these communications.

Respondent's use of Complainants' trademarks as a domain name does not constitute a bona fide offering of goods and services and shows Respondent's

bad faith in registering the disputed domain name. See *The Chip Merch., Inc. v. Blue Star Elec.*, D2000-0474 (WIPO Aug. 21, 2000)

The domain name at issue is so confusingly similar to Complainants' trademarks SOYLIFE and domain name soylife.com that reasonable Internet users will assume that the domain name is somehow affiliated with Complainants. See *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000). Internet users intending to access Complainants' web site will think that an affiliation of some sort exists between the Complainants' and the Respondent, when in fact, no such relationship exists.

B. Respondent

Respondent's Soymilk Maker Business

In or around January 2001, Respondent traveled to China seeking products to import for resale. On this trip Respondent found a product that makes fresh milk from soy beans (the "Soymilk Maker"). Respondent signed an agreement with the manufacturer to import and distribute the Soymilk Maker in North America. Respondent returned to Canada around March 2001 and commenced efforts to establish its business to sell the Soymilk Maker. As part of its business plan, Respondent planned to sell the machine under its own proprietary name under which the manufacturer would provide customized labeling and packaging. Respondent needed to create a name for its company and selected SoyLife after researching the names used by other competing sellers of soymilk makers. It learned that the names of some competitors were Soy Love, Soyajoy, Soy Club, Soy Wonder, Soy Toy, Soy 'n Joy, and Soy Wonder. Believing that the company and product needed to have the word "soy" in it, Respondent simply paired this word with other common words having positive health connotations and arrived at the SoyLife automatic soymilk maker for the machine and Canadian SoyLife Health for its company name. Because Respondent was aware of no other soymilk distributor operating under the name SoyLife, it concluded that it could operate under this name, and made this decision in the third week of June 2001.

To date, Respondent has invested over \$300,000 in its business operations and marketing. It has marketed the Soymilk Maker at numerous trade shows, advertised in newspapers and health magazines. Respondent's product is carried by over 200 retailers in North America. Sales revenue for 2002 was \$197,000.00 and is over \$120,000 so far in 2003. To date, Respondent has shipped approximately 4,000 total machines.

Respondent's Trademarks and Domain Name

On June 29, 2001, Respondent registered the domain name <soylifeca.com>

because <soylife.com> was unavailable and the addition of the "ca" related to both the fact that Respondent is a Canadian company and that its company name contained the word "Canadian." On July 18, 2001, Respondent filed an application for a Canadian trademark for SoyLife, which was approved by the Canadian Intellectual Property Office on November 26, 2002. Respondent established Canadian SoyLife Health Co. Ltd., which was federally registered under the Canadian Business Corporations Act as of July 19, 2001. In or around October 2001, Respondent placed an initial order for eight hundred soymilk makers, and began marketing them to stores, with the first shipment arriving in December 2001.

On October 17, 2001 Respondent filed an application to register SOYLIFE as a trademark with the U.S. Patent and Trademark Office ("PTO"). In a letter to Respondent dated January 18, 2002, the PTO trademark examiner reported that there were "NO CONFLICTING MARKS. Specifically, the trademark examiner stated:

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. 1052(d). TMEP section 1105.01.

The letter from the PTO further stated that Respondent could rely on its Canadian trademark application as a further basis for registration, something that Respondent desired to do in order to rely on its earlier priority date. On March 17, 2002 Respondent wrote to the PTO advising that it wished to rely on the Canadian trademark registration as a further basis for registration.

Complainant's SOYLIFE Trademarks and Business

Contrary to the allegations in the Complaint, Complainant does NOT have any registered trademark for the term SOYLIFE. To the contrary, both of Complainant's U.S. trademarks and its Canadian trademarks are "design" marks which all include an elliptical pattern in front of the term soylife in stylized lettering. Moreover, Complainant's Canadian trademark contains an express disclaimer which states:

The right to the exclusive use of the word SOY is disclaimed apart from the trademark

Complainant does not market soymilk makers. To the contrary, Complainant sells food ingredients. Complainant's web sites expressly states:

Our range of soy gem concentrates and extracts rich in isoflavones. These well-researched ingredients are used all over the world in foods and supplements to make our diets healthier

Complainant's Objection to Respondent's Use of its Trademark

On or about March 9, 2002, Complainant's counsel wrote to Respondent objecting only to its Canadian trademark application - and not to the Disputed Domain. Because Respondent had already made substantial investments in product and promotional materials in connection with its marketing of the Soymilk Maker, it could not comply with Complainant's request. Complainant also noted that an advertisement for Respondent's products on a Canadian auction web site listed Complainant's web site URL soylife.com, instead of Respondent's web site soylifeca.com. Of course, this was simply a typographical error made by the web site, since Respondent had no interest to send traffic to Complainant's web site. Respondent corrected this error. Respondent believed it had no obligation to comply with any of Complainant's other requests because i) Complainant was not engaged in the business of marketing soymilk machines or appliances of any kind; and ii) the PTO had already concluded that Complainant's mark was not a bar to registration of Respondent's mark and iii) the Canadian Intellectual Property Office had approved its mark. It would cause a tremendous hardship to Respondent if it had to now abandon the soylifeca.com domain name because the web site is listed on the written product materials enclosed with every Soymilk Maker that has been distributed, and the domain name is used for the technical support email address. If the Disputed Domain were transferred, thousands of consumers would not be able to contact Respondent to resolve customer service issues.

In April 2003, Complainant filed an opposition to the registration of Respondent's Canadian trademark. Because of the opposition filed by Complainant, it was likely that the U.S. trademark would be approved for registration prior to the registration of the Canadian trademark. To eliminate this potential problem, Respondent contacted the trademark examiner in May 2003 to request suspension of the application until registration of the Canadian mark was complete. The trademark examiner complied with this request and issued a Notice of Suspension on May 19, 2003.

C. Complainants' Additional Submission

1. Complainants own the exclusive right to use the mark SOYLIFE in commerce in the United States and Canada as afforded to them by federal

registration. As demonstrated in the Complaint, Complainants own two registrations for the mark SOYLIFE in the United States, namely,

SOYLIFE, US Reg. No. 2073367, Reg date: June 24, 1997 covering "preserved soybeans" in International Class 29 and "soybean parts used as foods supplements; preserved soybeans used as nutritional supplements" in International Class 5.

SOYLIFE, US Reg. No. 2705007 (US Serial. No. 75878899 in the Complaint has registered in the meantime) covering "Soy -based meals, powders and flour preparations for use as ingredients in food" in International Class 30 and "Non-alcoholic soy based beverages, non-alcoholic soy based beers and smoothies; concentrates, syrups and powders used in the preparation of non-alcoholic drinks" in International Class 32.

Complainants further own Canadian Registration No. TMA490433 for SOYLIFE covering "Preserved soybeans for nutritional purposes; parts of soybeans to be used as food supplements".

These marks are word marks as evidenced by the printouts of the official US Patent and Trademark Office's (USPTO) and Canadian Trademark Office's online databases and afford Complainants full and exclusive rights to any and all uses of the mark. As is apparent, the Complainants' marks are registered as composite marks, which entail the word SOYLIFE and a simple spiral design. The addition of the simple design portion of these marks along with the word mark do not render them design marks nor does the addition of a design portion diminish Complainants' exclusive right in the term SOYLIFE. Respondent's allegation, repeated throughout the Response, that Complainants' marks are design marks is wrong and misleading. In addition, the fact that Complainants have disclaimed exclusive ownership of SOY apart from the mark as registered in Canada is irrelevant to this dispute as Complainants, in this matter, object to Respondent's use of their trademarks SOYLIFE. The term SOY is free to be used by any interested party, including Respondent.

2. Respondent's trademark applications in the US and Canada have neither issued nor have these applications been approved for registration in either country. Throughout their response, Respondent has stated that the Canadian mark has issued, has been approved and that they have acquired rights

in these marks. The truth is that the Canadian application has been published and has subsequently been opposed by Complainants. The opposition proceeding is currently pending.

In this respect, Respondent's allegation that he had requested the suspension of the US application in light of the pending opposition in Canada is wrong and misleading since the US application had been based on Section 44(d) (foreign application) as well as Section 1(b) (intent to use) and it is common USPTO practice to suspend applications pending the receipt of a copy of the Certificate of Registration of the foreign base registration.

3. The disputed domain name is identical to Complainants trademarks. The dominant part of the disputed domain name, SOYLIFE, is identical to Complainants marks. The Respondent is outright using Complainants' registered marks. The mere addition of a generic or descriptive term to the trademark does not render the disputed domain name distinguishable. Respondent's attempt to label the generic abbreviation "ca", as part of soylifeca.com, as an abbreviation of their company name and therefore somehow unique and protectable, is unimpressive since such an abbreviation is on its face a geographic and generic term. In this respect, and contrary to Respondent's claims, Complainants supporting case law cited on this particular issue is relevant and on point since these cases deal with the issue of similarity of the disputed domain names with established trademarks.

4. Complainants stress that by copying Complainants' marks in their entirety for goods that are earmarked for use along with Complainants' goods, Respondent's pending trademark applications are clearly confusingly similar to Complainants' prior registered trademarks. The fact that the Examiner may not have cited Complainants' marks as an obstacle to registration against Respondent is not dispositive of whether the marks are, in fact, confusingly similar in the market place. Federal registration procedure in the US and Canada include publication of the respective application and the possibility for third parties to file oppositions against any mark that may be seen as confusingly similar. The issue of likelihood of confusion is rather subjective, which is why the registration procedure allows for third party intervention in the form of oppositions and cancellation actions. There is ample case law to illustrate the many, many instances where an Examiner has failed to cite a prior registered mark against a newly pending trademark application, but where the pending mark was deemed confusingly similar by the decision of the Trademark Trial and Appeal Board (TTAB) and related judicial venues. This is plainly illustrated by the number of marks approved for publication, thereafter opposed and litigated by a third party in the TTAB and found to be confusingly similar.

Therefore, it goes to reason that every decision rendered in favor of an opposing party would demonstrate the amount of times an Examiner's decision was not, in fact, controlling. Similarly, Respondent's argument that because an Examiner may have approved their mark for publication is controlling evidence of no confusion, is simply inaccurate and wrong.

5. Complainants have shown the confusing similarity of their respective marks and domain name soylife.com with the disputed domain name. Further, Complainants have demonstrated in the Complaint an actual incident of confusion in the market by showing that the Canadian auction house www.auctionmart.canada.com had provided a link to Complainants' homepage, which is located at www.soylife.com. This cite was intended to lead to Respondent, but instead merely highlights the confusing similarity between Complainants' trademarks and the disputed domain name and can not be discarded as a simple typographical error.

6. Not only is the disputed domain name identical to Complainants' trademarks, the Respondent has used the identical mark to offer related goods in association with the disputed domain name, only exacerbating the risk of confusion and further demonstrating its bad faith. In addition to Complainants' statements in the original Complaint, Complainants stress that the goods of the parties need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from the same source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Corning Glass Works, 229 USPQ 65 (TTAB 1985); In re Rexel Inc., 223 USPQ 830 (TTAB 1984)

Related goods are those "products which would be reasonably thought by the buying public to come from the same source if sold under the same mark." See *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 37 (CA 2 1945). For related goods, the danger presented is that the public will mistakenly assume there to be an association between the producers of the related goods, though no association exists. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 350 USPQ 808 (CA, Cal, 1979). Respondent markets an electronic device which enables consumers to produce soymilk from soybeans. Respondent's product uses Complainants' product (soy beans) in order to produce soy milk (non-alcoholic soy based beverages). Respondent's product is clearly complementary to Complainant's products. The products could not stand in closer proximity, which will cause consumers to likely associate and confuse Complainants' products with those of Respondent's. Both Complainant and Respondent target the same audience, namely, health conscious consumers or consumers with special dietary needs.

Therefore, Respondent's claim that the parties market completely different products is, in the least, inaccurate. As a side note, Complainants' point out that the cited case Lockheed Martin Corp. v. Dan Parisi, No. D2000-1015 (Jan. 26, 2001) citing Bally Total Fitness v. Faber, 29 F. Supp. 2d. 1161 (CD Cal 1998) as the source of Respondent's argument is distinguishable on its face as the panel in that case found the domain names to clearly not be confusingly similar since it was apparent that consumers would not look to the disputed domain names, i.e., lockheedsucks.com and lockheedmartinsucks.com, for purchasing goods offered by Lockheed on their own web site. In the instant case, however, consumers clearly can be and are confused about which domain name might offer information for each parties' goods and/or services as the disputed domain name is identical to Complainants' trademarks.

D. Respondent's Additional Submission

1. Complainant's Marks Are Not Identical to the Disputed Domain

Regardless of whether Complainant's mark is characterized as a design mark or composite word and design mark, the fact remains that the cylindrical design is a part of the mark and, together with that design, the mark is not identical to SOYLIFECA.COM.

2. Respondent DID NOT state that its Canadian mark has "Issued"

Complainant has attempted to malign Respondent by suggesting that Respondent dishonestly represented to the Panel that its "Canadian mark has issued." Respondent made no misrepresentation, whatsoever. . Nowhere in the Response does Respondent state, or even suggest, that the mark "issued." Respondent simply reports the truth: The mark was approved by the Canadian Intellectual Property Office which issued its "APPROVAL NOTICE" on November 26, 2002; and the U.S. Patent and Trademark Office reported that there were "no similar registered or pending mark which would bar registration." Moreover, Respondent expressly referred to the opposition proceeding filed by Complainant with the Canadian trademark office. It hid nothing.

3. Respondent Truthfully Stated that it Requested Suspension of its U.S. Trademark Application Until its Foreign (Canadian) Trademark Would Issue

Complainant again attempts to malign Respondent before this Panel suggesting that Respondent misled the Panel with respect to the suspension of its U.S. Application. The truth is that Respondent suspended the application so that it could rely on the earlier filing date of its Canadian mark, the registration of which was being held up by Complainant's opposition. A letter from U.S. Patent

and Trademark Office ("PTO"), was provided which expressly states: "action on this application is suspended pending receipt of a true copy, a photocopy, a certification, or a certified copy of a foreign registration." The letter from the PTO even goes on to state: "Please inform the examining attorney when the foreign application has been registered in Canada." Accordingly, the fact that Respondent requested the suspension in light of the pending opposition to the Canadian trademark cannot credibly be questioned.

4. Respondent's Use of its Trademark is Not Related to Complainant's Goods and Services but this Trademark Issue is not Relevant in a UDRP Proceeding in any Event.

Of course Respondent uses the disputed domain SOYLIFE in connection with Soy. But its product is a machine that makes soy milk, and Complainant does not make any kind of machine, its products and services being food additives and ingredients. Moreover, Complainant was required to disclaim the exclusive right to use the word "soy" for the very reason that it is descriptive of what Complainant sells. Accordingly, Respondent was, and is, entitled to use the Disputed Domain and the trademark SOYLIFE - a position vindicated by the U.S. PTO and the Canadian Trademark Offices which both found no confusingly similar trademarks which would bar registration. It is true that the trademark offices are not the final word on registration, because of Complainant's ability to oppose the marks. Nevertheless, the findings of not one, but two, trademark examiners should go a long way in demonstrating for this Panel that Respondent's use of the mark SOYLIFE for a machine that makes "soy" milk was lawful and in good faith. Moreover, the UDRP deals with abusive domain name registration, not with trademark claims. The extent of protection to which Complainant's trademark is entitled is not an issue for a UDRP Panel to decide. *Bridgestone Firestone, Inc. et al. v. Myers*, No. D2000-0190 (WIPO July 6, 2000) (<bridgestone-firestone.net>) ("the Panel does not have jurisdiction to decide claims of trademark infringement, dilution, unfair competition or other statutory or common law causes of action.") A proper application of the UDRP must lead to a ruling in favor. Respondent has indisputably used soylifeca.com in connection with the bona fide distribution of its SoyLife Automatic Soy Milk Maker - a fact which clearly establishes both Respondent's legitimate interest in the Disputed Domain and the lack of bad faith registration and use.

FINDINGS

The Panelists find by a majority vote:

- (1) Respondent's <soylifeca.com> domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain

- name; and
- (3) the domain name has been registered and is being used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that a Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainants have rights in the SOYLIFE mark by virtue of their registration of the mark in over 17 countries worldwide, including Canada, Respondent's nation of domicile. Complainants also have established common law rights in the mark due to use of the mark in commerce since 1995. In some jurisdictions, the registration is owned by Schouten Industries, in others it is owned by Schouten Products. Complainants have not explained why they have filed this proceeding jointly, but given that Respondent has not objected, the Panel will simply treat them as one entity.

Respondent's <soylifeca.com> domain name is confusingly similar to Complainants' SOYLIFE mark. *See Wal-Mart Stores, Inc. v. Walmarket Canada, D2000-0150 (WIPO May 2, 2000) (finding that the domain name, <walmartcanada.com> is confusingly similar to complainant's famous mark); see also Broadcom Corp. v. Myers & Myers; K Myers, FA 100136 (Nat. Arb. Forum Oct. 24, 2001) (finding the domain name <broadcomusa> is confusingly similar to complainant's BROADCOM mark).* The domain name contains Complainants' entire registered mark. *Wal-Mart Stores, Inc. v. MacLeod, Case No. D2000-0662 (WIPO Sept. 19, 2000) (a domain name is similar to a trademark for purposes of the first factor if it incorporates the mark in its entirety).* The addition of the “ca” suffix (a two letter designation for Canada

under the country code top level domain system) does not remove the confusion. The lack of the graphic to the left of the SOYLIFE mark is not meaningful in the domain name context because there is no way to display such graphics. Letters and characters that cannot be displayed must be ignored in determining whether or not a domain name is confusingly similar to a mark. *See* General Machine Prods. Co. v. Prime Domains, Nat. Arb. Forum File No. 92531 (Jan. 26, 2002).

Respondent claims that it also has trademark rights in the name SOYLIFE. Any such rights, though potentially relevant to the issue of the legitimacy of Respondent's interest, are irrelevant to the analysis with respect to the first factor, which looks only at Complainants' rights. *See* Smart Design LLC v. Hughes, D2000-0993 (WIPO Oct. 18, 2000) (Policy ¶ 4(a)(i) does not require complainant to demonstrate 'exclusive rights,' but only that complainant has a *bona fide* basis for making the complaint in the first place); *see also* The Men's Wearhouse, Inc. v. Brian Wick, FA No. 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning"). In any event, the Complainants are currently contesting Respondent's applications in both Canada and the United States to the SOYLIFE mark, and no *prima facie* evidence of validity attaches until registration. Therefore, Respondent does not have any present registered rights to the mark and the Panel will not speculate on whether or not Respondent will acquire such rights in the future.

In sum, while we note that the Respondent's domain name is different from Complainants' in some details (e.g., the absence of the design element and the addition of the letters "ca"), the Panel unanimously concludes that, in the key operative parts – SOYLIFE – the Respondent's domain name and the Complainants' trademark are confusingly similar for purposes of this first factor of the Policy.

Rights or Legitimate Interests

Respondent asserts that it has a legitimate interest in the <soylifeca.com> domain name because it has used the domain name and SOYLIFE trademark in connection with a *bona fide* offering of goods. Policy ¶ 4(c)(i).

The Panel agrees with Respondent's contention that it has been selling SOYLIFE soy milk makers since prior to the commencement of this dispute. The critical question under the Policy, though, is whether that use was "bona fide."

Respondent vociferously claims that its use was bona fide because it selected the SOYLIFE name to identify its soy milk machine, it adapted the mark with the good faith belief that no other distributor of soy milk machines used this mark, it has invested hundreds of thousands of dollars into its business, and it has sold significant quantities of machines. Those facts are relevant to the analysis, and, with other evidence, are persuasive to one of the Panelists, Mr. Arnold.

The majority of the Panel, though, while acknowledging the closeness of this issue, finds by a preponderance of the evidence that Respondent's use was not "bona fide." All three Panelists agree that, on this record, it appears that Respondent adopted the SOYLIFE mark with actual knowledge of Complainants' SOYLIFE mark. Respondent says that it was unaware of anyone else using this mark for soy *milk distribution*; the clear implication of this carefully crafted contention is that Respondent was well aware of Complainants' use of the mark for its soy*bean* products. Building on this finding, a majority of the Panel finds the parties' goods are closely related: "soy beans" versus "a machine that makes soy milk from soy beans." Given this similarity in the goods, the identity of the marks, and the Respondent's adoption of the mark with actual knowledge of Complainants' rights, the majority concludes that Respondent's use of the SOYLIFE mark is likely to confuse consumers into believing that its products come from the same source as Complainants', or that there is some other relationship or affiliation between the two. Indeed, Complainants have submitted evidence of actual confusion: a website selling Respondent's SOYLIFE machines provided a link to Complainants' web address (www.soylife.com), evidencing its belief that Respondent's machine comes from Complainants. Because Respondent's adoption and use of the SOYLIFE mark was thus infringing, the majority holds that it cannot qualify as "bona fide" for purposes of establishing a legitimate interest under the Policy. *Universal City Studios v. G.A.B. Enters.*, WIPO Case No. D2000-0416 (Nov. 4, 2000); *see also* *Chip Merch., Inc. v. Blue Star Elec.*, D2000-0474 (WIPO Aug. 21, 2000) (finding that the disputed domain names were confusingly similar to complainant's mark and that respondent's use of the domain names to sell competing goods was illegitimate and not a bona fide offering of goods).

Further supporting this conclusion is that Complainants acted with appropriate dispatch in challenging Respondent's use, once they became aware of it. Although Respondent registered its corporate name in 2001, it did not start to sell the SOYLIFE machines until January 2002. Complainants contacted Respondent just two months later to register their concerns over the use of that mark. Any sales and investment that Respondent made after that point was at its peril, and a majority of the Panel concludes that Respondent cannot avoid transfer by citing the growth of its business since then. Rather, it was on notice

of a potential problem; by ignoring the challenge, it alone bore the risk that its investment in the business might be undermined by a later, adverse ruling. This is thus not a situation where a trademark owner waited years before challenging a domain name, during which period the registrant innocently built up substantial good will in the domain name and related business.

The majority acknowledges Mr. Arnold's view that Complainant has not shown that the parties or their products compete with each other. The majority concedes that the record is thin on this point, but it seems to be a fair inference that machines that process soy beans into soy milk do trade in the same channels as the soy beans themselves, and that consumers viewing beans and machines that use the same mark would believe them to be connected. By analogy, consumers would similarly believe there to be a connection between STARBUCKS espresso machines and STARBUCKS coffee beans.

In sum, a majority concludes that Complainants have made in a *prima facie* showing that Respondent lacks a legitimate interest, and Respondent has failed to rebut that showing. *Document Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270 (June 6, 2000). The majority expressly recognizes, though, that this is a close question, and, when the parties contest the underlying facts, it is difficult to make these kinds of factual findings in the absence of discovery, cross-examination, and live testimony, at which credibility determinations can be made. Accordingly, should Respondent disagree with this finding, it is free, pursuant to Policy ¶ 4(k), to initiate litigation in a court of competent jurisdiction where it would be able to develop a fuller evidentiary record for presentation to the trier of fact. *EAuto LLC v. Triple S Auto Parts*, Case No. D2000-0047 (WIPO Mar. 24, 2000); *Jones v. Gregory*, FA No. 125747 (Nat. Arb. Forum Dec. 2, 2002).

Registration and Use in Bad Faith

Having concluded that Respondent lacks a legitimate interest, the majority finds it somewhat easier to adjudicate the claim that Respondent registered, and is using, the domain name in bad faith. For the reasons discussed in the proceeding section, a majority of the Panel concludes that Respondent is using the disputed domain name to attract Internet users to its website for commercial gain by capitalizing on the goodwill of Complainants' SOYLIFE mark and on the likelihood of confusion between that mark and the disputed domain name. This finding is sufficient to show bad faith under the paragraph 4(b)(iv) of the Policy. *See Busy Body, Inc. v. Fitness Outlet, Inc.*, D2000-0127 WIPO Apr. 22, 2000) (finding bad faith where respondent attempted to attract customers to its

website, <efitnesswholesale.com>, and created confusion by offering similar products for sale as complainant); *see also* eBay, Inc v. Progressive Life Awareness Network, D2000-0068 (WIPO Mar. 16, 2001) (finding bad faith where respondent is taking advantage of the recognition that eBay has created for its mark and therefore profiting by diverting users seeking the eBay website to respondent's site).

Mr. Arnold dissents because he believes Complainants have failed, albeit narrowly, to make their case for bad faith. He credits Respondent's assertion that it adopted the SOYLIFE mark in good faith on the belief that the soy bean and soy milk machine markets are diverse, and that, therefore, right or wrong, Respondent possible in good faith believe that consumers looking for Complainants' products are not likely to be diverted to Respondent's. In support of this conclusion, Mr. Arnold notes that both the Canadian and United States trademark offices apparently approved Respondent's SOYLIFE applications (though those applications are now subject to oppositions by Complainants). In any event, Mr. Arnold believes that the UDRP's fast-track process, which provides no opportunity for discovery or cross-examination, is not the proper vehicle for deciding an issue like this one, against a Respondent whose intent has not been subject to discovery or cross examination, where Respondent perhaps without knowledge of legal wrong has made an initial investment of \$300,000, sold thousands of units, and marketed at numerous trade shows. Rather, Respondent should be found to be within the Policy's "safe harbor" of having conducted a substantial and non-sham business using the domain name. This safe harbor should preserve the status quo unless and until Complainants elect to take the issue to court.

DECISION

Having established all three elements required under ICANN Policy, the Panel concludes (by a 2 to 1 vote, Mr. Arnold dissenting) that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**soylifeca.com**> domain name be **TRANSFERRED** from Respondent to Complainants.

Houston Putnam Lowry (chair), Tom Arnold and David H. Bernstein, Panelist
Dated: July 19, 2003

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Thrifty

v.

Airportparkinglots.com

Airportparkinglots.com



DECISION

Thrifty, Inc. and Thrifty Rent-a-Car System, Inc. v. Airportparkinglots.com
Claim Number: FA0211000129123

PARTIES

Complainant is **Thrifty, Inc.**, Tulsa, OK (“Complainant”) represented by **David R. Haarz**, of **Dickinson Wright, PLLC**. Respondent is **Airportparkinglots.com**, Suffield, CT (“Respondent”) represented by **John C. Linderman** of **McCormick, Paulding & Huber LLP**.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**thriftyairportparking.com**> and <**thriftyvaletairportparking.com**>, registered with **Intercosmos Media Group**.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

The forum appointed Hon. Carolyn M. Johnson, Mr. Houston Putnam Lowry and R. Glen Ayers as Panelists; R. Glen Ayers served as chair.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on November 4, 2002; the Forum received a hard copy of the Complaint on November 4, 2002.

On November 4, 2002, Intercosmos Media Group confirmed by e-mail to the Forum that the domain names <**thriftyairportparking.com**> and <**thriftyvaletairportparking.com**> are registered with Intercosmos Media Group and that the Respondent is the current registrant of the names.

Intercosmos Media Group has verified that Respondent is bound by the Intercosmos Media Group registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 5, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of November 25, 2002 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@thriftyairportparking.com and postmaster@thriftyvaletairportparking.com by e-mail.

A timely Response was received and determined to be complete on November 25, 2002.

Complainant filed a timely Additional Submission on November 27, 2002. Respondent also filed a timely Additional Submission on December 2, 2002.

On December 18, 2002, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the Forum appointed Hon. Carolyn M. Johnson, Mr. Houston Putnam Lowry, and R. Glen Ayers as Panelists.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant, Thrifty, Inc., is the parent company of the second Complainant, Thrifty Rent-A-Car System, Inc. (hereafter, both are referred to as "Thrifty"). The parent owns and licenses to the subsidiary trademarks relating to THRIFTY; the subsidiary owns a domain name, <thrifty.com>. The various registrations include a registration for the mark to be used for services including "parking place services." Complainant asserts that the two domain names are confusingly similar to the registered mark, THRIFTY, if the generic words relating to airport parking are ignored.

Complainant also asserts that Respondent has no rights in the name, since Complainant has not licensed or consented to use. And, says Complainant, there is no evidence that Respondent has made any *bona fide* offering of goods or

services under the domain names.

Finally, Complainant asserts that Respondent has acted in “bad faith,” registering and using the domain names to create confusion and attract business to its facilities. Complainant also offers evidence that Respondent has registered similar domain names, which incorporate other trademarks with the “parking” words. This pattern of conduct, says Complainant, clearly shows “bad faith.”

B. Respondent

Respondent has admitted that: “It is well taken that the Complainant’s [*sic*] mark, “Thrifty”, appears as a portion of the ... domain names.”

However, Respondent asserts that there is legitimate use – “to bring in visitors to airportparkinglots.com” which is the domain address to which the two names resolve. Respondent claims that this generates business for Complainants’ licensees. Respondent also asserts that Complainants have been aware of the two domain names since at least August of 2001 and that it has presented various proposals to Complainants for some sort of agreement on the use of the domain names.

Respondent, of course, denies “bad faith.” Respondent says that there is not bad faith because there is no confusion between its business and Complainant’s operations. It denies bad faith based upon its pattern of registering domain names incorporating other business names and parking services. It also asserts that it acted properly when requested to “cease and desist” when it “deactivated” the sites (both domain names only forwarded users to airportparkinglots.com). Respondent also notes that it has never attempted to sell the domain name registrations.

C. Additional Submissions

Both parties filed timely additional submissions, and Respondent filed a “Supplementary Declaration” correcting typographical errors in its “Declaration of Tom Lombardi,” which the Panel has determined to consider.

The “Complainants’ Additional Written Statement” asserts that Respondent cannot assert as a defense that the registration of the domain names benefited licensees of the THRIFTY marks. This “forced” or compulsory license is not permitted. Complainant also argues that the addition of generic terms to the THRIFTY mark or marks does not mean that the names and marks are not “confusingly similar,” and Complainant cites *Starwood Hotels & Resorts*

Worldwide, Inc. v. 613 181 BC Ltd. a/k/a Travel Domains, FA 0117051 (Nat. Arb. Forum, September 26, 2002) and another decision, *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co. Inc.*, Case No. D2000-0113 (WIPO April 13, 2000). Complainant goes on to assert that Respondent has admitted that it hoped to get business for its parking concessions by using the mark. Finally, Complainants assert that deactivation is not enough to satisfy its concerns.

“Respondent’s Additional Written Statement” denies the admissions asserted by Complainants. It also asserts that it is merely an independent dealer using the name or mark of goods in which it deals – like a used car dealer who advertises that he sells Chevrolets. Respondent also asserts that it should not have to transfer the domain names, since the domain names contain its own primary domain name, <airportparking.com>. Respondent also asserts that “deactivation” cannot be evidence of “bad faith.” Respondent’s declaration describes thirteen Thrifty Car Rental affiliates in Respondent’s program who have annualized potential revenue from the program of \$1,090,512.

FINDINGS

This case might be much closer if Respondent had not admitted the similarity between the domain names and the THRIFTY mark. Here we have four generic words, “thrifty”, “valet”, “airport”, and “parking.” Either combination indicates cheap parking at an airport, with or without valet service, and it is hard to get too concerned with this level of “confusing similarity”; but for Respondent’s admission, and its statements about the relationship between its business and the Thrifty rental car businesses, the Panel might well have stopped there. Perhaps not, since Complainant’s mark also relates to parking services. However, given Respondent’s statements and admissions, and the scope of the THRIFTY mark, the Panel must find that the domain names and marks are confusingly similar.

Since, by admission, Respondent has no rights in the names – it has admitted it has attempted without success to secure such rights from Complainant – the second issue in this dispute has been satisfied, largely from Respondent’s own mouth.

This leaves bad faith. Again, Respondent has virtually admitted that the addition of the word Thrifty to its domain name has generated business that it was looking for from a perceived affiliation with Complainant’s THRIFTY mark. While, as Respondent alleges, Complainant’s licensees may be pleased with referrals, this is clearly “bad faith” as that term is used in the ICANN Rules and Policies.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The generic additions to the THRIFTY mark(s) result in domain names that are confusingly similar to the THRIFTY marks, particularly since those additions have connotations that relate to Complainant’s business services. *See Space Imaging LLC v. Brownwell*, AF 0298 (eResolution Sept.22, 2000); *Marriott Int’l v. Café au lait*, FA 93670 (Nat. Arb. Forum Mar. 13, 2000). Given Respondent’s admissions, the domain names are confusingly similar to the marks held by Complainant.

Rights or Legitimate Interests

Respondent has no rights in the domain names and is using the names to divert traffic from Complainant’s sites to its own. It has no license or other rights in the THRIFTY mark. It is not commonly known by the name “Thrifty.” Its acts do not represent a bona fide offering of goods or services. *See Vapor Blast Mfg. Co. v. R. & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001). Again, even if there is some benefit to Thrifty or its licensees, Respondent still has no rights in the name “Thrifty.” The Panel declines to follow the reasoning of *Bankinter S. A. v. BI Fin. Inc.*, D2000-0460 (WIPO Sept. 5, 2000) (finding that Respondent is using the domain name for a legitimate and fair purpose because there is evidence that its use was known by Complainant) because Respondent incurred no expenses relying upon Complainants’ lack of action (the domain names were only forwarded to an existing web site), *see Yupi Internet Inc. v. Mercantil Inc.*, FA 117302 (Sept. 19, 2002). Further, and notwithstanding the arguments of Respondent, there is no evidence that any affiliate or licensee of

Complainant either authorized the use of the THRIFTY mark or had the authority to authorize that use.

Registration and Use in Bad Faith

Respondent has used the disputed domain names to divert Internet traffic from Complainant to its own websites. Complainant's mark is the predominate characteristic of the disputed domain names. Respondent admits to some commercial benefit. This is bad faith. *See G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002).

DECISION

Both domain names shall be **TRANSFERRED**.

R. Glen Ayers, Chair; with Hon. Carolyn Johnson and Howard Putnam Lowry, Panelists
Dated: January 2, 2003

[Click Here](#) to return to the main Domain Decisions Page.

[Click Here](#) to return to our Home Page

Agent Host
v.
Host Dot Com
Investments
HOST.COM

[List of Decisions](#)[Liste des décisions](#)

ADMINISTRATIVE PANEL DECISION

Under the ICANN Uniform Domain Name Dispute Resolution

Complainant: **AGENT HOST CO**
Respondent: **HOST DOT COM INVESTMENTS**
Cases Numbers: **AF-0343**
Contested Domain Names: **host.com**
Panel Member: **Houston Putnam Lowry**

1. Parties and Contested Domain Name

Gerald Mikkelson, a sole proprietor doing business as Agent Host Co (formerly doing business as Internet Host Corporation), of 1701 East 8th Street #259, Tempe, Arizona filed a complaint against Host Dot Com Investments of 159 Centre Street, Nutley, New Jersey 07110 requesting the transfer of the "HOST.COM" domain name.

2. Procedural History

The electronic version of the Complaint form was filed on-line through eResolution's Website on August 24, 2000. The hardcopy of the Complaint Form and annexes were received on September 11, 2000. Payment was received on September 5, 2000.

Upon receiving all the required information, eResolution's clerk proceeded to:

- Confirm the identity of the Registrar for the contested Domain Name;
- Verify the Registrar's Whois Database and confirm all the essential contact information for Respondent;
- Verify if the contested Domain Name resolved to an active Web page;
- Verify if the Complaint was administratively compliant.

This inquiry lead the Clerk of eResolution to the following conclusions: the Registrar is Tucows.Com, Inc., the Whois database contains all the required contact information, the

contested Domain Name resolves to an active Web page and the Complaint is administratively compliant.

An email was sent to the Registrar by eResolution Clerk's Office to obtain confirmation and a copy of the Registration Agreement on August 24, 2000. The requested information was received on August 25, 2000.

The Clerk then proceeded to send a copy of the Complaint Form and the required Cover Sheet in accordance with paragraph 2 (a) of the ICANN's Rules for Uniform Domain Name Dispute Resolution Policy. The Clerk's Office fulfilled all its responsibilities under Paragraph 2(a) in forwarding the Complaint to the Respondent, notifying the Complainant, the concerned Registrar and ICANN on September 12, 2000. This date is the official commencement date of the administrative proceeding.

The emails to the postmaster@host.com and to the administrative contact were not returned.

The complaint, official notification and all the annexes were sent via registered mail with proof of service, to the respondent. According to the Canada Post tracking system, all were delivered.

On October 4, 2000, the Clerk's Office notified the Respondent and the Complainant of the failure of the former to respond to the complaint. It also informed the parties that according to ICANN Rules Art. 5 (ix)(e) "If a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint."

On October 4, 2000, the Clerk's Office contacted Mr. Houston Putnam Lowry, and requested that he act as the sole Panelist in this case.

On October 4, 2000, Mr. Houston Putnam Lowry, agreed to act as the sole Panelist in this case and filed the necessary Declaration of Independence and Impartiality.

On October 5, 2000, the Clerk's Office forwarded a user name to Mr. Houston Putnam Lowry, allowing him to access the Complaint Form, and the evidence through eResolution's Automated Docket Management System.

On October 5, 2000, the parties were notified that Mr. Houston Putnam Lowry had been appointed and that a decision was to be, save exceptional circumstances, handed down on or before October 18, 2000.

On October 6, 2000, Mr. Houston Putnam Lowry requested additional information from the parties pursuant to Rule 12. The deadline for providing this information was October 13, 2000 by the close of business and the deadline for the decision was not extended. Only the Complainant responded to the request for additional information.

3. Factual Background

Internet Host Corporation established the host.com domain name in August 1994 (Complaint). The administrative contact for the domain was Gerald Mikkelson with an email address JLM@PRIMENET.COM. The billing contact was Gerald Mikkelson. Gerald Mikkelson's physical mailing address was the same as the physical address for Internet Host Corporation. The domain name fees were paid (at least for August 22, 1998 through August 22, 1999) by Gerald Mikkelson's visa credit card. The domain name was used by Internet

Host Corporation until June 1, 2000.

Interesting things began to happen in late May 2000. On May 24, 2000, DNSMASTER@JSPNETWORK.COM (not a genuine address) tried to change the authentication scheme for the domain name. The administrative contact, technical contact and billing contact were requested to be changed to NIC handle RSC101. This email also requested the domain name servers be changed to NS.SERVER7.SPEEDYSERVERS.COM. This did not work.

Not being discouraged, a new forged email was sent apparently from JLM@PRIMENET.COM on May 29, 2000 requesting the address for the organization using the domain name be changed to Lakewood, California. The administrative, technical and billing contacts were requested to be changed JN588-ORG. The domain name server was requested to be changed to NS3.JSPNETWORK.NET. These change were approved by a second forged email from JLM@PRIMENET.COM.

The Respondent's NIC handle JN588-ORG resolves to ADMIN@JSPNETWORK.COM. JSP Network.com's administrative contact and billing contact (NIC handle JN568-ORG) resolves to JONTOR20001@YAHOO.COM. The Panelist notes such addresses are not customarily used by legitimate businesses with web sites.

4. Parties' Contentions

Complainant contends Complainant's domain name was transferred without authorization by a person or persons unknown. Complainant further claims Respondent's contact information is false in an attempt to conceal Respondent's true identity.

Respondent has failed to respond to any of the allegations. This means Complainant's allegations are uncontested. A claimant still needs to make out a prima facie case because Panelists do not render default awards simply because the Respondent fails to respond, ICANN Rule 5(ix)(e).

5. Discussion and Findings

The Complainant is proceeding pro se in this matter. While reviewing the complaint, there were a number of inconsistencies apparent to the Panelist. In particular, it was not clear what the relationship was between Gerald Mikkelson, Agent Host Co and Internet Host Corporation. Rather than assume what the allegations were or dismiss the case for failure to state sufficient facts to justify relief, the Panelist requested further information from the parties pursuant to ICANN Rule 12. While other Panelists have discouraged such procedures on the grounds a complainant should bear the burden of proving its case¹, allowing a pro se party (or parties) to respond to an Panelist's concerns actually promotes efficiency in the process because it eliminates the need for a second, or even possibly a third, case. The subsequent information made it clear Gerald Mikkelson is a sole proprietor who does business as Agent Host Co and used to do business as Internet Host Corporation.²

This appears to be a case of first impression because it involves the use of a forged (or spoofed) email to steal a domain name from its rightful owner. The Panelist could not find any other cases on point in the ICANN list of proceedings despite a fairly extensive search. The Complainant did not draw the Panelist's attention to any such cases either. The closest reported case involved a web designer who transferred a domain name from the owner to the

web designer.³ However, the web designer appeared to be the technical contact for the domain name under the facts of that case.

In order to obtain relief under the Uniform Domain Name Dispute Resolution Policy adopted on August 26, 1999 (and effective January 3, 2000 under the facts of this case), a complaining party must prove ALL of the following to be entitled to relief in this process:⁴

- (i) the respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered and is being used in bad faith.

A. The Respondent's Domain Name Is Identical Or Confusingly Similar To A Trademark Or Service Mark In Which The Complainant Has Rights.

The domain name is identical under the facts of this case. Complainant did business at the domain name HOST.COM. The Respondent now owns the same domain name. This situation will certainly cause confusion.

B. The Respondent Has No Rights Or Legitimate Interests In Respect Of The Domain Name.

A thief does not have good title to what he steals, nor can a thief pass good title to another. The Respondent has made no claim to have any rights or legitimate interests with respect to the HOST.COM domain name. None of the standard indicia demonstrating rights to a domain name described in the ICANN Uniform Domain Name Dispute Resolution Policy Article 4(c) appear to be present in this case:

- (i) before any notice to respondent of the dispute, respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) respondent (as an individual, business, or other organization) have been commonly known by the domain name, even if respondent has acquired no trademark or service mark rights; or
- (iii) respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panelist was unable to find any other factors which showed Respondent has any rights or legitimate interest to the HOST.COM domain name.

C. The Respondent's Domain Name Has Been Registered And Is Being Used In Bad Faith.

Under ICANN Uniform Domain Name Dispute Resolution Policy Article 4(b), the following non-exclusive factors indicate registration and use of a domain name in bad faith:

- (i) circumstances indicating that respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a

competitor of that complainant, for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that respondent engaged in a pattern of such conduct; or

(iii) respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location.

There is no evidence in this case of a commercial or competitive relationship between the Complainant and the Respondent. The Panelist does not know the parties' area of business. Therefore, most of the factors described above are not applicable. There is no evidence of a pattern on Respondent's part. We must look beyond this list of non-exclusive factors to determine if there is bad faith.

"Bad faith" is defined in Black's Law Dictionary 7th edition at page 134 as: "1. Dishonesty of belief or purpose..". In *Halsey v. Brotherhood* (1881), 19 Ch. D. 386 Lord Coleridge L.C.J. in determining whether there was evidence of mala fides stated that the task of the Court was to consider "whether there is anything to show that what the defendant stated was stated without reasonable and probable cause".

Providing false contact information constitutes 'bad faith' as defined by the Anticybersquatting Consumer Protection Act, 15 U.S.C. §1125(d)(1)(B)(i)(VII). Other cases have agreed.⁵ It would also be difficult to say a thief acts other than in bad faith. While other cases have had difficulty in determining if the initial registration was in bad faith, that is very clear under the present circumstances. The continued possession of the domain name, under the special circumstances of this case, also clearly demonstrates the domain name is being used in bad faith.

6. Conclusions

For the foregoing reasons, the HOST.COM domain name shall be transferred back to Gerald Mikkelson d/b/a Agent Host Co.

7. Signature

Dated at Meriden, Connecticut USA on this 16th day of October, 2000

(s) **Houston Putnam Lowry**

Sole Panelist

1. *GA Modefine v. Sparco P/L*, WIPO D2000-0419.

2. It is unusual for a sole proprietor to use the word "Corporation" in his trade name. However, that is what happened here.

3. *Loaiza v LatinoWeb.com*, NAF-0094190.

4. ICANN Uniform Dispute Resolution Policy Article 4(a).

5. *Home Director v. HomeDirector*, WIPO D2000-0111.



Mattel, Inc.

v.

KPF, Inc.

bellemodebarbie.com



DECISION

Mattel, Inc. v. KPF, Inc.
Claim Number: FA0403000244073

PARTIES

Complainant is **Mattel, Inc.** (“Complainant”), represented by **William Dunnegan**, of **Perkins & Dunnegan**, 45 Rockefeller Plaza, New York, NY 10111. Respondent is **KPF, Inc.** (“Respondent”), P.O. Box 271193, Oklahoma City, OK 73137.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**bellemodebarbie.com**>, registered with **Network Solutions, Inc.**

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on March 4, 2004; the Forum received a hard copy of the Complaint on March 5, 2004.

On March 10, 2004, Network Solutions, Inc. confirmed by e-mail to the Forum that the domain name <**bellemodebarbie.com**> is registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On March 10, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of March 30, 2004 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@bellemodebarbie.com by e-mail.

A timely Response was received and determined to be incomplete on March 30, 2004.

A timely Additional Submission was received from Complainant and was determined to be complete on April 5, 2004.

A timely Additional Submission was received from Respondent but was determined to be deficient.

On April 15, 2004, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix):

Identical to and/or Confusingly Similar

- a. Complainant owns the trademark for BARBIE and has received U.S. Certificate of Trademark Registration Nos. 728,811 issued March 20, 1962 and renewed on March 20, 1982; 741,208 issued November 27, 1962 and renewed on November 27, 1982; 741,649 issued on December 4, 1962 and renewed on December 4, 1982; 768,331 issued on April 21, 1964 and renewed on April 21, 1984; 768,397 issued on April 21, 1964 and renewed on April 21, 1984; 772,298 issued on June 30, 1964 and renewed on June 30, 1984; 810,106 issued on June 21, 1966 and renewed on June 21, 1986; 814,091 issued on August 30, 1966 and renewed on August 30, 1986; 814,995 issued on September 13, 1966 and renewed on September 13, 1986; 816,601 issued on October 11, 1966 and renewed on October 11, 1986; 817,200 issued on October 25, 1966 and renewed on October 25, 1986; 1,000,125 issued on December 24, 1974 and renewed on December 24, 1994; 1,041,587 issued on June 22, 1976 and renewed on June 22, 1996; 1,300,766 issued on October 16, 1984; 1,693,139 issued on June 9, 1992; 1,746,477 issued on January 12, 1993; 1,754,535 issued on February 23, 1993; 1,769,285 issued on May 4, 1993; 1,773,571 issued on May 25, 1993; 1,775,637 issued on June 8, 1993; 1,795,876 issued on September 28, 1993; 1,710,196 issued on August 25, 1992; 1,760,729 issued on March 23, 1993; 1,947,330 issued on January 9, 1996; and 1,995,873 issued on August 20, 1996. These registrations are valid and subsisting.
- b. At the time of the filing of this Complaint, the disputed domain name was registered to KPF, Inc. The disputed domain name is confusingly similar to and dilutive of Complainant's registered trademark for BARBIE within the meaning of the Anticybersquatting Consumer Protection Act of 1999, 15 U.S.C. § 1125(d).

Rights or Legitimate Interests

- c. Respondent is not commonly known by the name Barbie and has acquired no trademark or service mark rights to the domain name <bellemodebarbie.com>.
- d. Respondent has not made a legitimate non-commercial or fair use of the domain name

<barbie1004.com>. The URL address <**bellemodebarbie.com**> advertises and sells clothing for fashion dolls.

Registration and Use in Bad Faith

- e. The registration of this domain name blocks Complainant from using this domain name for its own business. In connection with its BARBIE line of products, Complainant uses many domain names, including, but not limited to, <barbie.com>, <barbiecollectibles.com>, and <barbiecollectiblesstore.com>.
- f. Respondent has used the domain <**bellemodebarbie.com**> with the intent to trade on the goodwill Complainant has earned in its BARBIE products, and to enhance the commercial value of their own services. Respondent has damaged the reputation, business and goodwill of Complainant.
- g. By using the domain name <**bellemodebarbie.com**>, Respondent has diluted, and will continue to dilute, the distinctive quality of the BARBIE trademark by lessening its capacity to identify Complainant's products and services in violation of the Federal Anti-Dilution Act, 15 U.S.C. § 1125(c). Respondent's use of the domain name <**bellemodebarbie.com**> has infringed and will continue to infringe the BARBIE trademark in violation of 15 U.S.C. § 1114(a).
- h. By letter and e-mail dated June 12, 2002 and April 30, 2003, copies of which are annexed as Exhibit C, Complainant demanded that Respondent transfer ownership of the domain name to Complainant.

B. Respondent

The subject domain name is no longer being used for my website. I have registered a new domain name, <bellemodedolls.com>. Moreover, original registration of <**bellemodebarbie.com**> expired in 2002, and I did not renew registration of it at that time. There was never any intention on my part to come into conflict with any of the legitimate rights of the Mattel Corporation; my intention was merely to facilitate the location of my website for interested parties. This being the case, my voluntary relinquishment of the domain name of <**bellemodebarbie.com**> should be construed only as an indication of my unwillingness to enter into any sort of dispute with Mattel, regardless of the merit, or lack of merit in their claim. Please note that the correct e-mail address is: ktfinc@earthlink.net. It was previously, ktfinc@email.msn.com. At no time have I used kpfinc@email.msn.com, and to my knowledge, there has never been an entity named KPF, Inc. Any and all communications directed to me at the e-mail address of kpfinc@email.msn.com were incorrectly addressed and were never received by me.

C. Additional Submissions

Complaint's Additional Submission

Respondent, in her response, incorrectly argues that she is no longer the registrant of <**bellemodebarbie.com**>, that there was never an entity by the name KPF, Inc., and that the website is not operational. However, a search of the WHOIS database at Networksolutions.com, the registrar of the domain name, reveals that <**bellemodebarbie.com**> is in fact registered to KPF, Inc. and that it

is not due to expire until March 25, 2005. Furthermore, a visit to <bellemodebarbie.com> reveals that the site is, in fact, still operational.

Respondent's Additional Submission

Case No.FA0403000244073 Attention: M. Schaber This is my fifth attempt to contact you by e-mail. I have also tried to download your response forms on-line, but something is not working, because I do [sic] not receive the forms. RESPONSE: The subject domain name is no longer being used for my website. I have registered a new domain name, <bellemodedolls.com>. Moreover, original registration of <bellemodebarbie.com> expired in 2002, and I did not renew registration of it at that time. There was never any intention on my part to come into conflict with any of the legitimate rights of the Mattel Corporation; my intention was merely to facilitate the location of my website for interested parties. This being the case, my voluntary relinquishment of the domain name of <bellemodebarbie.com> should be construed only as an indication of my unwillingness to enter into any sort of dispute with Mattel, regardless of the merit, or lack of merit in their claim. Please note that the correct e-mail address is: ktfinc@earthlink.net. It was previously, ktfinc@email.msn.com. At no time have I used kpfinc@email.msn.com, and to my knowledge, there has never been an entity named KPF, Inc. Any and all communications directed to me at the e-mail address of kpfinc@email.msn.com were incorrectly addressed and were never received by me. /Kathy Fisher/ KTF, Inc. P.O. Box 271193 Oklahoma City, OK 73137 ktfinc@earthlink.net FAX No. NONE

Respondent then went on to indicate Network Solutions must have "obviously" misunderstood Respondent's contact information when the domain name was originally registered in 2000.

FINDINGS

The Panel finds for a variety of reasons that:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

This case presents a number of interesting issues.

Respondent's failure to include the certification statement required by ICANN Rule 5(b)(viii) makes the Response (and supplemental Response) deficient. This fact, coupled with the incorrect WHOIS information and Respondent's concession on the merits, causes this Panel to decline to accept Respondent's Response (and supplemental Response) in reaching the merits of this case. *See Talk City Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (concluding that no weight would be

afforded to the facts alleged in Respondent's deficient submission, partly because it "did not contain any certification that the information contained in the e-mail was, 'to the best of Respondent's knowledge complete and accurate'" in accordance with Rule 5(b)(viii)).

Any person who registers a domain name has a continuing duty to maintain up to date WHOIS information for their domain name. Somehow the WHOIS information for this domain has NEVER been correct since 2000. This is inexcusable and was not explained by Respondent. Even so, Respondent (a "corporation" which does not exist) did receive actual notice of this proceeding.

Respondent concedes voluntarily relinquishing the domain name. Somehow, this relinquishment has not been effectuated. The Panel notes Respondent's difficulties in sending e-mail and in controlling its website, suggesting Respondent is "technologically challenged." This Panel will give effect to Respondent's intentions that Respondent failed to carry out.

In an abundance of caution, this Panel will review the various factors under the ICANN Policy, admittedly drawing each inference in favor of Complainant and against Respondent in light of the very peculiar circumstances of this case.

Identical and/or Confusingly Similar

Complainant established rights in the BARBIE mark through registration with the U.S. Patent and Trademark Office ("USPTO"). Complainant holds several registrations with the USPTO for the mark, including Reg. Nos. 728,811 and 741,208 (registered on March 20, 1962 and November 27, 1962, respectively). *See Men's Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning."); *see also Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (finding that Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting this assumption).

Respondent's <**bellemodebarbie.com**> domain name is confusingly similar to Complainant's BARBIE mark. The Panel finds the domain name is confusingly similar to Complainant's mark because the domain name fully incorporates the mark and adds the generic words "belle" and "mode." *See Am. Online, Inc. v. Anytime Online Traffic School*, FA 146930 (Nat. Arb. Forum Apr. 11, 2003) (finding that Respondent's domain names, which incorporated Complainant's entire mark and merely added the descriptive terms "traffic school," "defensive driving," and "driver improvement" did not add any distinctive features capable of overcoming a claim of confusing similarity); *see also Am. Online Inc. v. Neticq.com Ltd.*, D2000-1606 (WIPO Feb. 12, 2001) (finding that the addition of the generic word "Net" to Complainant's ICQ mark, makes the <neticq.com> domain name confusingly similar to Complainant's mark).

The addition of the generic top-level domain ".com" is irrelevant in determining whether the <**bellemodebarbie.com**> domain name is confusingly similar to Complainant's mark. *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

Rights or Legitimate Interests

Respondent lacks rights and legitimate interests in the <**bellemodebarbie.com**> domain name because Respondent is not commonly known by the domain name. Respondent lacks rights and legitimate interests in the domain name pursuant to Policy ¶ 4(c)(ii). *See Tercent Inc. v. Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶ 4(c)(ii) does not apply); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) Respondent is not a licensee of Complainant; (2) Complainant’s prior rights in the domain name precede Respondent’s registration; (3) Respondent is not commonly known by the domain name in question).

Respondent’s <**bellemodebarbie.com**> domain name resolves to a website that sells clothing for fashion dolls (including the famous “Barbie” doll). Respondent is using a domain name confusingly similar to Complainant’s mark for commercial gain. Commercial use of a domain name confusingly similar to another’s mark does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See MSNBC Cable, LLC v. Tsysys.com*, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interests in the famous MSNBC mark where Respondent attempted to profit using Complainant’s mark by redirecting Internet traffic to its own website); *see also Pfizer, Inc. v. Internet Gambiano Prods.*, D2002-0325 (WIPO June 20, 2002) (finding that because the VIAGRA mark was clearly well-known at the time of Respondent’s registration of the domain name it can be inferred that Respondent is attempting to capitalize on the confusion created by the domain name’s similarity to the mark).

Respondent lacks rights and legitimate interests in the <**bellemodebarbie.com**> domain name because Respondent stated in its Response that it has relinquished its rights in the domain name. *See Taco Bell Corp. v. Tango Bella*, D2000-1229 (WIPO Dec. 12, 2000) (transferring the domain name where Respondent agreed that it had no rights in the domain name); *see also Colgate-Palmolive Co. v. Domains For Sale*, FA 96248 (Nat. Arb. Forum Jan. 18, 2001) (Respondent’s willingness to transfer the domain name at issue to Complainant, as reflected in its Response, is evidence that it has no rights or legitimate interests in the domain name). Such a declaration need not be under oath.

Respondent’s assertion that it is no longer the registrant of the <**bellemodebarbie.com**> domain name is demonstrably false because the WHOIS information clearly shows Respondent is the registrant and states the registration does not expire until March 25, 2005.

Registration and Use in Bad Faith

Respondent registered and used the <**bellemodebarbie.com**> domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because the domain name is confusingly similar to Complainant’s mark and is used for commercial gain by taking advantage of the goodwill associated with the mark. *See H-D Michigan, Inc. v. Petersons Auto.*, FA 135608 (Nat. Arb. Forum Jan. 8, 2003) (finding that the disputed domain name was registered and used in bad faith pursuant to Policy ¶ 4(b)(iv) through Respondent’s registration and use of the infringing domain name to intentionally attempt to attract Internet users to its fraudulent website by using Complainant’s famous marks and likeness); *see also G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that Respondent registered and used the domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because Respondent was using the confusingly similar domain name to attract Internet users to its commercial website).

Respondent had actual or constructive knowledge of Complainant’s mark because the mark is famous and is registered with the United States Patent and Trademark Office (and is even mentioned on the website as a trademark belonging to Complainant). Registration of a domain name confusingly

similar to a mark, despite knowledge of the mark holder's rights, is evidence of bad faith registration pursuant to Policy ¶ 4(a)(iii). *See Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (holding that "there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively"); *see also Orange Glo Int'l v. Blume*, FA 118313 (Nat. Arb. Forum Oct. 4, 2002) ("Complainant's OXICLEAN mark is listed on the Principal Register of the USPTO, a status that confers constructive notice on those seeking to register or use the mark or any confusingly similar variation thereof."); *see also Ty Inc. v. Parvin*, D2000-0688 (WIPO Nov. 9, 2000) (finding that Respondent's registration and use of an identical and/or confusingly similar domain name was in bad faith where Complainant's BEANIE BABIES mark was famous and Respondent should have been aware of it).

Respondent's statement that it has relinquished rights in the <**bellemodebarbie.com**> domain name is evidence that Respondent registered and used the domain name in bad faith. *See Marcor Int'l v. Langevin*, FA 96317 (Nat. Arb. Forum Jan. 12, 2001) (Respondent's registration and use of the domain name at issue coupled with its expressed willingness to transfer the name amply satisfies the bad faith requirements set forth in ICANN Policy); *see also Global Media Group, Ltd. v. Kruzicevic*, FA 96558 (Nat. Arb. Forum Mar. 7, 2001) (finding Respondent's failure to address Complainant's allegations coupled with its willingness to transfer the names is evidence of bad faith registration and use).

Failure to provide correct WHOIS information (whether contact information or the domain owner's correct name) is also strong evidence of bad faith. *See Home Dir. v. HomeDirector*, D2000-0111 (WIPO Apr. 14, 2000); *see also Agent Host Co v. Host Dot Com Invs.*, AF-00343 (eRes. Oct. 16, 2000).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**bellemodebarbie.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: April 26, 2004

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Mark Travel

v.

ATHS d/b/a

Snug Harbor

Travel

FunJetvacations.net



DECISION

The Mark Travel Corporation v. ATHS d/b/a Snug Harbor Travel
Claim Number: FA0304000154644

PARTIES

Complainant is **The Mark Travel Corporation**, Milwaukee, WI (“Complainant”) represented by **Brian G. Gilpin**, of **Godfrey & Kahn**. Respondent is **ATHS**, Amityville, NY (“Respondent”) represented by **Ari Goldberger**, of **ESQwire.com Law Firm**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**funjetvacations.net**>, registered with **Melbourne It, Ltd. d/b/a Internet Names Worldwide**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on April 16, 2003; the Forum received a hard copy of the Complaint on April 17, 2003.

On April 17, 2003, Melbourne It, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the Forum that the domain name <**funjetvacations.net**> is registered with Melbourne It, Ltd. d/b/a Internet Names Worldwide and that

the Respondent is the current registrant of the name. Melbourne It, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne It, Ltd. d/b/a Internet Names Worldwide registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On April 17, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 7, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@funjetvacations.net by e-mail.

A timely Response was received and determined to be complete on May 7, 2003.

Complainant submitted a timely Additional Submission on May 12, 2003.

On May 20, 2003, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant provides individuals, companies, and families outstanding travel services and low prices in connection with airfare, hotels, and travel packages. Currently, Complainant offers air, hotel and travel packages to some of the most popular destinations, including several destinations in Mexico, Europe, Florida, California, Aruba, Jamaica, and Las Vegas. Complainant has built an extensive travel network, partnering with airlines such as Air Jamaica, Alaska Airlines, Aloha Airlines, American Airlines, ATA, Continental Airlines, Delta, Hawaiian Airlines, Ryan International Airlines, US Airways, and United and hotels such as Buena Vista Suites, Marriott, Days Inn, Embassy Suites, Econolodge, Hilton, Holiday Inn, La Quinta, and Sheraton to name a few. In addition, Complainant operates charter flights to select locations. (Schaefer Aff. ¶ 2.)


Complainant owns many trademarks and registrations, including the following

(the “FUNJET Family of Trademarks”):

Since at least as early as 1994, Complainant has been using the mark FUNJET VACATIONS in connection with certain travel-related services. In 1994, Complainant filed an application in the United States Patent and Trademark Office to register the mark FUNJET VACATIONS. In 1995, Complainant’s U.S. Reg. No. 1,936,065 issued for the mark FUNJET VACATIONS in connection with “wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)


Since at least as early as 1994, Complainant has been using the following mark



in connection with certain travel-related services: . In 1995, Complainant filed an application in the United States Patent and Trademark Office to register the mark. In 1997, Complainant’s U.S. Reg. No. 2,031,874 issued for the mark for use in connection with “wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)


Since at least as early as 1994, Complainant has been using the following mark



in connection with certain travel-related services: . In 1995, Complainant filed an application in the United States Patent and Trademark Office to register the mark. In 1997, Complainant’s U.S. Reg. No. 2,040,036 issued for the mark for use in connection with “wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1994, Complainant has been using the following mark



in connection with certain travel-related services: . In 2002, Complainant filed an application in the United States Patent and Trademark Office to register the mark in connection with “wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 5.)

Since at least as early as 1975, Complainant has been using the mark FUNJET in connection with certain travel-related services. In 1982, Complainant filed an application in the United States Patent and Trademark Office to register the mark FUNJET. In 1983, Complainant’s U.S. Reg. No. 1,258,871 issued for the mark FUNJET in connection with “wholesale travel services-namely, arranging air

transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1975, Complainant has been using the mark LAS VEGAS FUNJET in connection with certain travel-related services. In 1978, Complainant filed an application in the United States Patent and Trademark Office to register the mark LAS VEGAS FUNJET. In 1980, Complainant’s U.S. Reg. No. 1,137,030 issued for the mark LAS VEGAS FUNJET in connection with “wholesale travel services-namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1977, Complainant has been using the mark FLORIDA FUNJET in connection with certain travel-related services. In 1978, Complainant filed an application in the United States Patent and Trademark Office to register the mark FLORIDA FUNJET. In 1978, Complainant’s U.S. Reg. No. 1,104,487 issued for the mark FLORIDA FUNJET in connection with “wholesale travel services-namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1986, Complainant has been using the mark FUNWAY HOLIDAYS FUNJET in connection with certain travel-related services. In 1986, Complainant filed an application in the United States Patent and Trademark Office to register the mark FUNWAY HOLIDAYS FUNJET. In 1997, Complainant’s U.S. Reg. No. 1,455,774 issued for the mark FUNWAY HOLIDAYS FUNJET in connection with “wholesale travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)


Since at least as early as 1987, Complainant has been using the mark FUNJET ... THE FUNWAY TO GET AWAY! in connection with certain travel-related services. In 1993, Complainant filed an application in the United States Patent and Trademark Office to register the mark FUNJET ... THE FUNWAY TO GET AWAY!. In 1993, Complainant’s U.S. Reg. No. 1,804,816 issued for the mark FUNJET ... THE FUNWAY TO GET AWAY! in connection with “wholesale travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1995, Complainant has been using the following mark



in connection with certain travel-related services: . In 1996, Complainant filed an application in the United States Patent and Trademark Office to register. In 1997, Complainant’s U.S. Reg. No. 2,115,459 issued for the mark in connection with

“wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

Since at least as early as 1995, Complainant has been using the following mark in connection with certain travel-related services: . In 1996, Complainant filed an application in the United States Patent and Trademark Office to register the mark. In 1997, Complainant’s U.S. Reg. No. 2,106,617 issued for the mark in connection with “wholesale and retail travel services, namely, arranging air transportation and ground accommodation travel packages for marketing by retail travel agents.” (Schaefer Aff. ¶ 4.)

In 1995, Complainant began using certain of its FUNJET Family of Trademarks on the internet in connection with travel services. (Schaefer Aff. ¶ 6.) Complainant has registered and is using the following domain names in connection with its internet-based sales and marketing efforts:

<u>Domain Name</u>	<u>Registration Date</u>
funjetvacations.com	June 17, 1998
funjet.com	April 24, 1995
lasvegasfunjet.com	December 8, 1998
funjetlasvegas.com	December 8, 1998
funjetjamaica.com	December 8, 1998
jamaicafunjet.com	December 8, 1998
cancunfunjet.com	December 8, 1998
funjetcancun.com	December 8, 1998

(Schaefer Aff. ¶ 6.) Through widespread use of its FUNJET Family of Trademarks and domain names throughout the United States and the world, Complainant has acquired a valuable reputation and developed goodwill.

First, Respondent registered the domain name funjetvacations.net on July 2, 2002 (Schaefer Aff. ¶ 13.) Complainant owned nine federal trademark registrations for the FUNJET Family of Trademarks at that time. (Schaefer Aff. ¶ 4.) The fact that Respondent registered the funjetvacations.net domain name, despite the existence of Complainant’s registration for an identical mark and many similar marks, is indicative that registration of the domain name was designed to trade on the goodwill of Complainant’s mark and was registered in bad faith. *Cellular One Group v. Paul Brien*, Case No. D2000-28 (WIPO March 10, 2000). “Respondent’s use of exactly the same name as Complainant’s trademark evidences an intent to attract Internet users to its website by creating a likelihood of confusion with the Complainant’s mark. Such intent

is manifest from the name itself.” *Infinity2, Inc. v. Total Health & Wellness*, FA 94867 (Nat. Arb. Forum Jul. 5, 2000).

Second, Respondent had constructive and actual knowledge of Complainant’s rights in the FUNJET Family of Trademarks, thus supporting a finding of bad faith. *See Expedia, Inc. v. European travel Network*, D2000-0137 (WIPO Apr. 19, 2000); *Document Technologies v. International Electronic Communications, Inc.*, D2000-0270 (WIPO Jun. 6, 2000) (Respondent’s knowledge of Complainant’s mark at the time of registration of the domain name suggests bad faith). Respondent had constructive notice of Complainant’s FUNJET Family of Trademarks marks due to Complainant’s numerous registrations prior to the registration of funjetvacations.net. *See Toyota Motor Sales USA v. Rafi Hamid d/b/a ABC Automobile Buyer*, D20001-0032 (WIPO March 28, 2001). Further, Respondent is a distributor of certain of Complainant’s travel packages. (Schaefer Aff. ¶ 8.) These travel packages are provided under the FUNJET Family of Trademarks. As Respondent distributes travel packages compiled by Complainant, there can be no doubt that Respondent was aware of Complainant’s trademarks when it registered the funjetvacations.net domain name. In addition, Respondent refers to itself on its website connected to funjetvacations.net as “Your Funjet Vacations Experts.” (Ex. 2). By doing so, Respondent refers to Complainant by one of its FUNJET Family of Trademarks. Such reference is tantamount to admitting to the existence of Complainant’s rights in the marks.

Third, Respondent registered a domain name containing at least two of Complainant’s trademarks in their entirety. (Schaefer Aff. ¶ 13). Such registration alone is evidence of bad faith. *See Toyota Motor Sales USA v. Rafi Hamid d/b/a ABC Automobile Buyer*, D20001-0032 (WIPO March 28, 2001). Specifically, “No plausible explanation exists as to why Respondent selected the name ... [FUNJET VACATIONS] as part of the Domain Name[s] other than to trade on the goodwill of ... [Complainant].” *Id.*

Lastly, Respondent’s offering to sell the disputed domain name to Complainant for an amount in excess of its out of pocket expenses is evidence of bad faith. *See Wellness International Network, LTD v. Apostolics.com*, FA 96189 (Nat. Arb. Forum Jan. 16, 2001) (finding that an offer to sell domain name for \$60,000 is evidence of bad faith); *Dollar Rent A Car Systems Inc. v. Jongho*, FA 95391 (Nat. Arb. Forum Sept. 11, 2000) (finding that Respondent demonstrates bad faith by registering the domain name for the purpose of transferring the domain name in the amount of \$3,000); *Moynahan v. Fantastic Sites, Inc.*, D2000-1083 (WIPO Oct. 22, 2000) (finding bad faith where Respondent offered to sell the domain name to Complainant for \$10,000). Here, Respondent has offered to sell Complainant the domain name funjetvacations.net for \$50,000. (Schaefer Aff. ¶ 12.) Such an amount is clearly in excess of Respondent’s expenses associated with the domain name funjetvacations.net.

B. Respondent

As noted in the Complaint, Respondent is an authorized distributor of Complainant. Complainant admits in the Complaint that:

Respondent has certainly been using the domain name in dispute in connection with the offering of goods or services [and]

...

may have limited rights to use and display Complainant's trademarks for promotional purposes relating to its resale of the travel products offered by Complainant.

Respondent is a licensed travel agent and has been an authorized reseller of Complainant's travel products and services since 2001. Declaration of Besnik Vathi at ¶ 1. ("Vathi Dec."). Complainant has consented to Respondent's sale of Complainant's products and services through its web site. Annexed as Exhibit 2 of the Response are various documents sent by Complainant to Respondent evidencing this relationship as well as copies of checks paid by Complainant to Respondent for commission earned in connection with booked vacations. In fact, Complainant has even paid commissions to Respondent as late as April 22, 2003 – following the filing of this Complaint. Id.

In 2002, Respondent sold Complainant vacation packages to approximately 450 passengers, which generated revenues for Complainant in excess of \$200,000. Beznik Dec. at ¶ 2. This year, Respondent has already sold Complainant vacation packages to approximately 550 passengers, with estimated revenues to Complainant of \$300,000. Id. at 3. Respondent spends approximately \$4,000 per month advertising Complainant's vacation packages. Id. at ¶ 4.

In early April 2003, counsel for Complainant, Peter Schaefer, verbally contacted Respondent and advised him to remove certain links from the bottom of Respondent's web site that were associated with travel products deemed competitive by Complainant. Id. at ¶ 5. This was the first complaint made by Complainant at any time. Id. Respondent removed those links on the same day of Mr. Schaefer's call. Id. During the phone call, Mr. Schaefer also stated, for the first time, that the Complainant objected to Respondent's use and registration of the Disputed Domain. Id. at ¶ 6. He offered Respondent \$50.00 to cease and desist its use of the domain name. Id. Respondent was infuriated with what he was as heavy-handed tactics from the lawyer of a company for whom Respondent had been working with in good faith to generate substantial travel business, and had invested substantial money in operating and advertising the business. Respondent indicated he had no intention of giving the name away, and that

Complainant would have to pay him \$50,000 to get the name. *Id.* This number certainly was not made as an offer to Complainant, as characterized by Respondent. *Id.* Respondent was simply expressing his outrage to Complainant's counsel with a response to Complainant's unreasonable demands and bullying tactics. *Id.*

Nothing governing Respondent's distributor relationship with Complainant limits Respondent's use of Complainant's mark in a domain name, and Complainant even admits that Respondent has limited rights to use the mark to promote its vacation packages. Respondent clearly states on the web site that is operated by Snug Harbor Travel, and that it is "one of the largest Seller[s] of Funjet vacations." Respondent did not register the Disputed Domain to sell to Complainant, to disrupt its business, to prevent Complainant from registering a domain name reflecting its trademark, or to confuse users. Vathi Dec. at ¶ 7.

C. Additional Submission by Complainant

"The majority view rejects any claim by a licensee to the right to register a domain name consisting of, or containing, the licensor's trademark." *Nikon, Inc. and Nikon Corp. v. Technilab, Inc.*, D2000-1774 (WIPO Feb. 26, 2001); *Hunter Fan Company v. MSS*, FA 98067 (Nat. Arb. Forum Aug. 23, 2001) (citing and agreeing with *Nikon*). Similarly, an authorized distributor or even an entity actually licensed to sell products has no claim to the right to register a domain name consisting of the manufacturer's trademarks. *Toyota Jidosha Kabushiki Kaisha t/a Toyota Motor Corp. v. Double Time Jazz a/k/a Jamey Aerbersold*, FA 113316 (Nat. Arb. Forum July 10, 2002); *Motorola Inc. v. NewGate Internet Inc.*, D2000-0113 (WIPO Apr. 14, 2000) (stating that "the right to resell products does not create a right to use a mark more extensively than required to advertise and sell the product. The use of a mark as a domain name clearly goes further than what is required merely to resell products."); *Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co.*, D2000-0113 (WIPO Apr. 13, 2000) (reasoning that "even if Respondent is a retail seller of Complainant's products, the collateral trademark use necessary to allow resell [sic] of Complainant's product is not enough to give Respondent proprietary rights in Complainant's trademarks, and certainly not enough to confer the right to use these trademarks as domain names."); *Ullfrotte AB v. Bollnas Imports*, D2000-1176 (WIPO Oct. 23, 2000) (finding that the fact that Respondent legitimately sold goods originating from the Complainant does not give Respondent the right to register and use the mark as a domain name without the consent of the trademark owner); *Gorstew Ltd. v. Caribbean Tours & Cruises*, FA 94927 (Nat. Arb. Forum July 28, 2000) (reasoning that use of the trademark in a domain name is "classic trademark infringement, even if the ultimate result of the same is that some revenue flows to the owner of the marks"). In this case, Respondent's assertion that it has legitimate interests in the disputed domain name is similar to the assertion made by the respondent in *Infinity2, Inc. v. Total Health &*

Wellness:

Respondent also asserts that it has a legitimate, fair use of the name, without intent to misleadingly divert consumers or to tarnish the . . . mark. Contrary to Respondent's assertion in this regard, its intent appears to be just the opposite, that is to attract consumers to Respondent's website by using Complainant's trademark as the **sole** component of its domain name except only for the domain level designation. The intent to divert consumers is manifest from the name itself, which suggests clearly and compellingly that that the website belongs not to an entity that simply distributes [Complainant's] products but to one that is [Complainant] itself.

Infinity2, Inc. v. Total Health & Wellness, FA 94867 (Nat. Arb. Forum July 5, 2000) (emphasis in original).

A distributor cannot use a manufacturer's trademark in a domain name when the distributor, even though selling the manufacturer's goods, has no permission to use the trademark as the domain name. *Avon Products, Inc. v. Lee*, D2001-0272 (WIPO Apr. 12, 2001). "Respondent in this case would only have a right to register the domain name . . . if Complainant had specifically granted that right." *Nokia Corp. v. Nokia Ringtones & Logos Hotline*, D2001-1101 (WIPO Oct. 18, 2001). See also *Nokia Corp. v. Nick Holmes t/a Etype Media*, D2002-0001 (March 6, 2002) (finding that respondent did not have the right to incorporate a trademark into a domain name without the authority of the trademark owner). "That is especially true if the domain name suggests a broader relationship than in fact is the case." *R.T. Quaipe Engineering, Ltd. v. Luton*, D2000-1201 (WIPO Nov. 14, 2000). The use of the domain under such circumstances is not in connection with a bona fide offering of goods or services. *Caterpillar Inc. v. off Road Equipment Parts*, FA 95497 (Nat. Arb. Forum Oct. 10, 2000).

FINDINGS

The operative acts of this case are very simple. Complainant provides travel packages under the mark "FunJet Vacations." Some of these packages are sold through travel agents, one of which is Respondent (who has been selling these packages since 2001 and apparently continues to sell them after this proceeding was commenced). Respondent earns a commission for each travel package sold. Respondent is *specifically* authorized to sell these packages electronically.

Respondent registered the domain name FunJetVacations.net on July 2, 2002.

While this web site originally contained links to travel offerings that competed with FunJet offerings, such links were removed at Complainant's request. The only offerings on the FunJetVacations.net are Complainant's travel products. The site contains the phrase "Your Funjet Vacations Experts" and contains Respondent's contact information.

Complainant markets its products under eight domain names and Respondent uses one domain name in addition to the one at issue in this proceeding.

Complainant notified Respondent by telephone on April 3, 2003 that it was not authorized to use the "FunJet Vacations" trademark in a domain name.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant has trademark rights in the following family of FUNJET marks: FUNJET VACATIONS, FUNJET, LAS VEGAS FUNJET, FLORIDA FUNJET, FUNWAY HOLIDAYS FUNJET, and FUNJET...THE FUNWAY TO GET AWAY! Complainant has used the FUNJET mark since at least as early as 1975, and has used the FUNJET VACATIONS mark since at least as early as 1994.

The <funjetvacations.net> domain name is identical to Complainant's FUNJET VACATIONS trademark because the generic top-level domain ".net" is irrelevant in a Policy ¶ 4(a)(i) analysis. *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the

top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Blue Sky Software Corp. v. Digital Sierra Inc.*, D2000-0165 (WIPO Apr. 27, 2000) (holding that the domain name <robohelp.com> is identical to Complainant’s registered ROBOHELP trademark, and that the “addition of .com is not a distinguishing difference”). Furthermore, the absence of a space between the words of the mark in the <funjetvacations.net> domain name is also inconsequential because spaces are not permitted in second level domains. Therefore, the Panel finds the <funjetvacations.net> domain name identical to Complainant’s FUNJET VACATIONS mark. *See Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2002) (finding <hannoverre.com> to be identical to HANNOVER RE, “as spaces are impermissible in domain names and a generic top-level domain such as ‘.com’ or ‘.net’ is required in domain names”); *see also Technology Prop., Inc. v. Burris*, FA 94424 (Nat. Arb. Forum May 9, 2000) (finding that the domain name <radioshack.net> is identical to Complainant’s mark, RADIO SHACK).

The Respondent also concedes this point.

Rights or Legitimate Interests

Under ICANN Dispute Resolution Policy §4(c), the following is a partial list of how one might prove rights to a domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent has rights and legitimate interests in the domain name because it is an authorized distributor of Complainant. As a distributor, Respondent argues it uses the domain name in connection with a *bona fide* offering of goods and services. *See Oki Data Americas, Inc. v. ASD Inc.*, D2001-0903 (WIPO Nov. 6, 2001). An authorized dealer of Complainant’s goods may use Complainant’s trademark in its domain name if

Respondent is

- 1) actually selling the goods or services at issue;
- 2) selling only Complainant's products on the web site in question;
- 3) accurately disclosing the relationship between Complainant and Respondent (meaning Respondent is not causing confusion by suggesting Respondent is the owner of the trademark); and
- 4) not attempting to corner the market in all domain names incorporating Complainant's mark and thereby prevent Complainant from reflecting its mark in its own domain name); *see also Weber-Stephen Prod. Co. v. Armitage Hardware*, D2000-0187 (WIPO May 11, 2000) (finding that Respondent, as an authorized dealer of Complainant's WEBER GRILL products, had rights and legitimate interests in <webergrills.com>, <webergrill.com>, <weber-grills.com>, <webergrillsource.com>, <webergrillstore.com>, <webergrillshowroom.com>, <webergrills-ah.com> and <webgrills.com> because it was using the domain names in order to make a bona fide offering of Complainant's goods and services).

In this case, Respondent is actually selling Complainant's travel services.

Respondent is selling only Complainant's travel products on the disputed domain name, although it is possible to eventually click through to Respondent's other site where competing products are sold. When Complainant objected to certain hyperlinks because they connected to competing products, Respondent removed the hyperlinks. Complainant neither disputes or admits this. The Panel has not independently reviewed the site because this proceeding only considers the parties' submission.

The web site bears a logo that says: "Funjetvacations.net – Your Funjet Vacation Experts." It clearly discloses Respondent's name (which allows a click through to Respondent's full contact information). Based upon this Panel's knowledge of the travel business as a consumer, this means Respondent re-sells Complainant's products. The page also discloses "Snug Harbor Travel is one of the largest Seller [sic] of Funjet Vacations." Respondent is not claiming the trademark as their own.

Respondent has registered only one domain name, while Complainant has registered eight domain names (including funjetvacations.com).

Other cases cited by Respondent, K&N Engineering, Inc. v. Kinnor Services aka Phenomena Ltd., No. D2000-1077 (WIPO Jan. 19, 2001), Draw-Tite, Inc. v. Plattsburgh Spring Inc., No. D2000-0017 (WIPO March 14, 2000), ABIT Computer Corporation v. Motherboard Super Store, Inc., No. D2000-0399 (WIPO Aug. 8, 2000), Canon U.S.A. Inc., Astro Business Solutions, Inc. and Canon Information Systems, Inc. v. Richard Sims, Case No. D2000-0819 (WIPO Oct. 16, 2000), Hewlett Packard Company, v.

Napier, No. FA 94368 (NAF April 28, 2000), The Kittinger Company, Inc. v. Figus, No. AF-108A-B and The New Piper Aircraft, Inc. v. Piper.com, Case No. FA0094367 (NAF May 2, 2000), are more persuasive than the cases Complainant cites.

Most of the cases cited by Complainant can be distinguished as follows:

Case name	Aggravating factor	Date
Stanley Works v. Camp Creek, Case D2000-0113	registered multiple names (10)	13-Apr-00
RT Quaife v. Bill Luton, Case D2000-1201	failed to respond honestly to customer inquiries	14-May-00
Infinity2 v. Total Health & Wellness, Case FA0005000094867	violated distributorship agreement	5-Jul-00
Gorstew v. Twinsburg Travel, Case FA0005000094944	registered multiple names (9)	7-Jul-00
Ullfrotte AB v. Bollnas Imports, Case D2000-1176	confusion over who owns site/trademark	23-Oct-00
Nikon et al v. Technilab, Case D2000-1774	sold competing goods using the trademark	26-Feb-01
UVA Solar GmbH v. Mads Kragh, Case D2001-0373	distributor terminated	7-May-01
Avon Products v. Lee, Case D2001-0272	confusion over who owns site/trademark	22-May-01
Nokia v. Nokia Ringtones, Case D2001-1101	sold competing goods using the trademark	18-Oct-01

There is no doubt an authorized distributor of a trademarked service may use the trademark in connection with the sale of the trademarked service. Without a specific demarcation of how far the trademark is used (and nothing specific was introduced into evidence here), it is clear the trademark may be used in advertisements for the trademarked service. The trademark may also be used on stationary and in brochures (once again in connection with the trademarked service). Although it is less common, distributors sometime construct words to represent telephone numbers that incorporate a trademark.

Respondent's web site was operational for about 8 months before Complainant contacted Respondent.

Under these circumstances it can be said Respondent meets the following safe harbors of the Uniform Dispute Resolution Policy to acquire an interest in the disputed domain name:

4 (c)(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name

corresponding to the domain name in connection with a bona fide offering of goods and services; or

4 (c)(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Registration and Use in Bad Faith

Under ICANN Uniform Domain Name Dispute Resolution Policy Paragraph 4(b), the following non-exclusive factors indicate registration and use of a domain name in bad faith:

- (i) circumstances indicating that respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that respondent engaged in a pattern of such conduct; or
- (iii) respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location.

"Bad faith" is defined in Black's Law Dictionary 7th edition at page 134 as: "1. Dishonesty of belief or purpose..". In *Halsey v. Brotherhood* (1881), 19 Ch. D. 386 Lord Coleridge L.C.J. in determining whether there was evidence of mala fides stated that the task of the Court was to consider "whether there is anything to show that what the defendant stated was stated without reasonable and probable cause".

Neither party provided the Panel with a copy of the agreement between the parties establishing Respondent as a reseller of Complainant's services. The Panel assumes this was not provided because it was silent on the issue at hand.

Complainant claims Respondent is violating the "eLN agreement" it has with Snug Harbor Travel. First of all, the eLN agreement supplied is between Respondent and Trisept Technology, LLC. For the purposes of this discussion, it is assumed Complainant does business under the Trisept tradename (if not, it would have been helpful to know the relationship between the entities). It is not even clear if (and if it does, how) the disputed domain name hooks up to the web interface discussed in the eLN agreement. For the purposes of this decision, the Panel assumes the hyperlinks somehow connect to the disputed domain name to the web interface discussed in the eLN agreement. Nothing in the eLN agreement explicitly says the "FunJet Vacations" mark may (or may not) be used in a domain name.

Complainant claims Respondent violated eLN agreement §3(b), which says in relevant portion, Respondent "must comply with all rules, procedures and requirements from time to time communicated by [Complainant] in connection with the installation, training, maintenance and use of eLN." No copies of any rules, procedures or requirements were provided. In addition, the use of a domain name doesn't really involve "the installation, training, maintenance and use of eLN." If Complainant didn't want Respondent to use its trademark in a domain name, it could have clearly imposed this requirement in the eLN agreement.

Complainant next claims eLN agreement §3(f) provides Respondent's "[s]ite may not contain or advertise any content, or link to a site that contains or advertises any content, that is . . . inappropriate in [Complainant's] sole judgment." This provision regulates **content** of a web site and not the use of domain names.

Respondent is using the domain name to generate hundreds of thousands of dollars of revenue for Complainant. Respondent was not diluting Complainant's mark.

Respondent raised the \$50,000 offer to sell registration rights to "express outrage" because Complainant contacted Respondent to request use of the domain name cease and Complainant offered to purchase the registration rights for \$50. Respondent spends \$4,000 per month to advertise Complainant's vacation packages and thus was offended by Complainant's actions. While this is not the best way to conduct business, nothing in the record as a whole indicates Respondent obtained the domain name **primarily** for the purposes of reselling it, *See Mark Warner 2001 v. Larson*, FA 95746 (Nat. Arb. Forum Nov. 15, 2000) (finding that considering or offering to sell a domain name is insufficient to amount to bad faith under the Policy; the domain name must be registered

primarily for the purpose of selling it to the owner of trademark for an amount in excess of out-of-pocket expenses); *see also LifePlan v. Life Plan*, FA 94826 (Nat. Arb. Forum July 13, 2000) (finding that “the mere offering [of the domain name for sale], without more, does not indicate circumstances suggesting that Respondent registered the domain name primarily for the purpose of selling . . . the domain name to the Complainant”); *see also Sumner v. Urvan*, WIPO D2000-0596 (WIPO July 24, 2000) (finding no bad faith where Respondent did not contact Complainant first, but rather, Complainant first contacted Respondent about purchasing the domain name); *see also General Mach. Prod. Co. v. Prime Domains*, FA 92531 (Nat. Arb. Forum Mar. 16, 2000) (finding it significant that the Complainant, and not Respondent, had initiated contact, inquiring about purchasing the domain name <craftwork.com>, and that this fact tended to weigh against a finding of bad faith).

It should be noted Complainant is not being blocked from using its trademarks as a domain name because it has eight domain names incorporating its marks, including funjetvacations.com (the **.com** equivalent of the **.net** domain name in dispute in this case). No pattern of domain name registration abuse is claimed here.

Respondent’s use of the disputed domain name does not disrupt Complainant’s business because Respondent is actually selling Complainant’s product. Likewise, there is no evidence of actual confusion even though the domain name is the same as one of Complainant’s registered marks.

The bad faith must exist both at the time of registration **AND** at the time of the complaint, *Parker Hannifin Corporation v. East Bay Website Company*, Case Number: AF-0587. Simply terminating Respondent’s distributorship agreement would not allow this particular case to fall under the ICANN Uniform Dispute Resolution Policy at a future time.

DECISION

Having failed to establish all three elements required under ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Houston Putnam Lowry, Panelist and Chartered Arbitrator
Dated: May 29, 2003

[HOME](#)

[BACK](#)

[SITE MAP](#)

000042

Yupi Internet

v.

Mercantil

amarillas.com



DECISION

Yupi Internet Inc. v. Mercantil Inc.
Claim Number: FA0207000117302

PARTIES

Complainant is **Yupi Internet Inc.**, Miami Beach, FL, USA (“Complainant”) represented by **Robin L. McGrath**, of **Alston & Bird, LLP**. Respondent is **Mercantil Inc.**, George Town, GRAND CAYMAN (“Respondent”) represented by **Luis Vidal Hamilton-Toovey**, of **Carey Allende & Asociados**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**amarillas.com**>, registered with **Tucows, Inc.**

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on July 29, 2002; the Forum received a hard copy of the Complaint on August 1, 2002.

On July 30, 2002, Tucows, Inc. confirmed by e-mail to the Forum that the domain name <**amarillas.com**> is registered with Tucows, Inc. and that the Respondent is the current registrant of the name. Tucows, Inc. has verified that Respondent is bound by the Tucows, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On August 2, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of August 22, 2002 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@amarillas.com by e-mail.

A timely Response was received and determined to be complete on August 22, 2002.

Complainant’s additional submissions were received on August 26, 2002. Respondent’s additional submissions were received on September 3, 2002.

On September 11, 2002, pursuant to Complainant’s request to have the dispute decided by a

single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Headquartered in Miami Beach, Florida, Complainant is the owner and operator of Spanish-language Internet websites located at the URLs <yupimsn.com>, <ciudadfutura.com> and, until recently, <amarillas.com>.

Launched in 1996, Complainant's flagship website, <yupi.com>, which is now located at <yupimsn.com> (in August of 2001, T1MSN, Corp., a joint venture of Microsoft and the Mexican telephone company Telmex, acquired Complainant and launched YUPIMSN), is an Internet portal which provides Spanish speaking people with ready access to news, information and services. Through <yupimsn.com>, visitors can, with a mere click of a button, access a myriad of Internet services, such as chat rooms and e-mail, in addition to information about a wide-variety of topics such as entertainment, news, weather, sports, education, technology and tourism among many others. Complainant's <ciudadfutura.com> website is one of the world's first Spanish-language online communities which is supported by over 300 webmasters from around the world.

In July of 1999, Complainant acquired the registration for the domain name <amarillas.com> from an Argentinean company Comint-ar S.A. Complainant first began using the AMARILLAS marks in August of 1999. In May of 2000, Complainant launched a new website at <amarillas.com> a comprehensive, business-to-business bilingual Internet portal to Latin America, Spain and the United States. The domain name <amarillas.com> was designed to serve as a tool to help businesspeople identify and develop international trade opportunities and business relationships. Complainant's relationships with trade associations, chambers of commerce, trade multipliers, industry associations and corporate leaders provided a comprehensive database of over 150,000 registered companies. Membership to <amarillas.com> offered businesses numerous benefits and advantages. For instance, registered members received in-depth industry specific content, including editorial briefs, corporate profiles, event and conference listings and industry guides, on various business sectors in over 28 countries and 216 industries. Members were also given access to such services as e-mail and forums, as well as a directory of corporate homepages designed to identify buying and selling opportunities.

Much of the success of Complainant's <amarillas.com> website was due, in no small part, to the substantial international advertising and promotional efforts in which Complainant engaged. Complainant spent over a hundred thousand dollars in a single year to advertise and promote the AMARILLAS marks. In addition to print advertisements in pan-regional publications such as *Nexos*, American Airlines' in-flight magazine, Complainant has used such highly visible media as large billboards strategically placed on high traffic highways in major cities such as New York, Los Angeles and Miami. Complainant's <amarillas.com> advertisements have also adorned the backs of airport shuttles and the tops of taxicabs in major metropolitan cities.

The services offered by Complainant in connection with the AMARILLAS marks have also received extensive coverage in the media, with articles appearing in such print and online publications as *The Wall Street Journal*, *Forbes*, *USA Today*, *the LA Times*, *CNN en Espanol*, *The Miami Herald*, *Miami Business Magazine*, *The Sun-Sentinel*, *Reuters*, *Daily Business Review*, *LatinCEO*, *American Airline News*, *Hispanic Magazine.com*, *Freemarkets.com*, *Hoovers Online* and *flashcommerce.com*. Complainant has also issued numerous press releases concerning the <amarillas.com> website. As shown by numerous third party websites identifying the AMARILLAS marks as being owned by Complainant, one need only perform a

cursory Internet search to conclude that since Complainant's adoption of <amarillas.com>, it has been identified by the public exclusively with Complainant.

In addition to the <amarillas.com> domain name registration, Complainant is also the owner of domain name registrations for the domain names <amarillas.com.mx> (Mexico), <amarillas.es> (Spain), <amarillas.net.do> (Dominican Republic), <amarillas.com.gt>, <amarillas.net.gt> (Guatemala), <amarillas.com.ni> (Nicaragua), <amarillas.com.pa> (Panama), <amarillas.com.pr>, <amarillas.net.pr> (Puerto Rico), and <amarillas.com.ve> (Venezuela). Additionally, Complainant has embarked on an international service mark registration program, with issued service mark registrations for either the mark AMARILLAS or AMARILLAS.COM in Venezuela, Peru, Ecuador, Guatemala, Honduras and El Salvador. Service mark applications for AMARILLAS or AMARILLAS.COM are pending in the United States, Argentina, Brazil, Mexico, Bolivia, Nicaragua, Paraguay, and Uruguay.

In April of 2002, unbeknownst to Complainant, Complainant's <amarillas.com> domain name registration expired. Complainant never received the renewal notices that Verisign claims to have sent it. Moreover, it had always been Complainant's experience that Verisign would send electronic notices to Complainant's designated contact for the domain name, but in this case, Complainant never received any such electronic notice. In June of 2002, Complainant learned that Respondent had registered the domain name <amarillas.com>. When Complainant learned about the lapse in its registration, it tried without success to work with Verisign to remedy the situation. However, Verisign could not explain why Complainant never received any renewal notices and indicated that it was unable to help Complainant reacquire the domain name. Because Verisign did not renew the registration, the <amarillas.com> domain name became available for registration to the general public on April 8, 2002.

According to Respondent's <mercantil.com> website, Respondent was founded in 1990 as a Latin American directory for small and medium-sized enterprises. Although it provides services in direct competition with those provided by Complainant, neither the parties' businesses, their websites nor the services offered in connection therewith are affiliated in any way.

According to a time line on its <mercantil.com> website, Respondent launched its first website in 1995, which it claims provided a bilingual on-line Latin American business directory. In the "about us" section of its site, Respondent indicates that in 1999 it launched "Mercantil.com," a site that Respondent currently bills as "Latin America's leading Business-to-Business ("B2B") site for small and medium-sized enterprises (SMEs)." Today, Respondent claims to be evolving toward "a total eCommerce solution for SMEs" offering businesses the ability to buy and sell goods and services throughout the region and the world. Respondent's goal as stated on its <amarillas.com> website is "to become THE one and only destination for SMEs."

On April 14, 2002, less than a week after Complainant's <amarillas.com> registration expired, Respondent quickly seized on Complainant's misfortune by registering with Tucows, Inc. the domain name of its competitor - <amarillas.com>. Respondent's intent in registering the <amarillas.com> domain name was made clear in an article appearing on the home page of its <mercantil.com> website and the site Respondent now operates under <amarillas.com>. The article was written by BNAmericas and dated June 20, 2002 (the "BNA article"). According to the BNA article, by registering Complainant's <amarillas.com> domain name, Respondent "stands to gain extra income from advertising since the larger directory will increase traffic to the site, and the site's clients will also benefit from a new tool to position themselves in Europe" In other words, by registering a domain name that is as well known to the public as <amarillas.com>, Respondent hopes to substantially increase its financial bottom line by attracting more traffic to its site. Put more succinctly, Respondent hopes to directly profit from the goodwill of Complainant's AMARILLAS marks.

Respondent's intent in this respect is further made clear by the blatant lies Respondent's chairman Jaime

Vargas told to the BNA reporter regarding the relationship between Respondent and Complainant, as quoted in the BNA article. Specifically, the BNA article indicates that Respondent “*acquired the company directory <amarillas.com> (www.amarillas.com)*” and then attributes that statement to Chairman Vargas, who, according to the article, made the announcement “without revealing the transaction figure.” This blatantly misleading account leads people to believe that Respondent purchased the assets of the <amarillas.com> business, when in fact Respondent only – and without authorization from Complainant – registered the <amarillas.com> domain name. The false notion that Respondent purchased Complainant’s business is further supported by the following statement in the BNA article:

The companies closed the sale in May and are now integrating their platforms, cleaning up their databases and setting up a portal, Vargas said. The acquisition provides Respondent with access to a directory of almost four million companies in 24 countries throughout Latin America. . . . Respondent performed the operation without resorting to external financing, Vargas said, and rather than give an idea of the transaction value he said it was simply a very good opportunity they decided to take advantage of.

Many of these same false and misleading statements also appear in a press release issued and widely circulated by Respondent. However, there is not a shred of truth to any of the foregoing representations. Simply put, these statements are pure fabrication. Respondent never acquired any database, directories or other assets of Complainant, including those associated with the <amarillas.com> website. As indicated above, the *only* thing Respondent “acquired” was a registration for the <amarillas.com> domain name and that was acquired not from Complainant, but improperly through the Registrar Tucows.

Shortly after registering the domain name, Respondent launched its <amarillas.com> website. It is clear from Respondent’s home page that Respondent is offering many of the identical B2B services that Complainant offered through the original, authentic <amarillas.com> site and is targeting the identical market. Moreover, in the “about us” section of the Respondent’s <amarillas.com> site, Respondent misleadingly claims that <amarillas.com> (as opposed to <mercantil.com>) “was founded in 1990.” This statement is misleading because Respondent only acquired the domain name registration in 2002, whereas prior to that time the registration was owned by Complainant. By stating that <amarillas.com> was founded in 1990, consumers are likely to mistakenly conclude that Respondent has continued the business originated by Complainant, when in fact nothing could be further from the truth.

B. Respondent

Mercantil, Inc. (“Respondent”) is a corporation duly organized under Cayman Islands Law. It is the parent company of Chilnet S.A. and also the owner of the trilingual business portal <mercantil.com> with a proprietary database of over 1.5 million companies.

Chilnet S.A. (“Chilnet”) is a Corporation organized under the Republic of Chile’s corporations law. It was founded in 1990 (originally as Fax Chile S.A.) as a company that developed a printed Business Directory of Chilean companies. Subsequently it also evolved into Chilean’s first Internet based business to business (“B2B”) directory. Chilnet has a B2B portal under the domain name <chilnet.cl>, also known as Chilnet Yellow Pages, with a proprietary database of over 65,000 companies.

At this time, Chilnet still handles this business directory in printed and online versions. The printed version has white and yellow pages. The online version has evolved towards offering eBusiness solutions for small and mid-size companies (“SMEs”), on top of other contents in the business portal and the online business directory.

Both Portals, allow members to expand and personalize their listings, build a free or paid-for homepage, list their products and services on-line, and market their brands to the world. The Portals also have a News

section, Business Opportunity identification tools, companies' Financial Information research and many others features, and content.

On May 14, 2002 Respondent was advised by its external marketing advisors, Nexsa S.A., that Buydomains.com ("the world's leader domain market", according to their own site presentation) was publicly offering the domain name <amarillas.com>. Also Chilnet personnel had detected sometime earlier to this date, that the site <amarillas.com> had been out of service.

The Spanish term "amarillas" is the plural Spanish word for "yellow" and is a common or descriptive term for yellow pages or business directories. Although it does not qualify for much trademark protection, and nobody can avoid or stop other companies to include this term in their own marks, as a common term it has value by itself. Throughout all Latin America many marks include this term in their business names and domain names. The owners of such business names and domain names are not entitled to avoid the use of these words in other names. It is common knowledge that by using common terms in a domain name, the owner of the name will have less protection against the users of similar domain names than he would if his domain name was distinctive.

Nevertheless, Respondent acquired (through Chilnet) the domain name <amarillas.com> and decided to build an International Business Portal under the domain name <amarillas.com> merging its platforms and databases from Chilean and Latin American companies with others from North American and European countries. Four platforms and databases, in addition to the new ones, were merged: <mercantil.com>, <chilnet.cl>, <export.cl> and <import.cl>.

In doing this, Respondent assessed that the shortness of the term represented a value its clients would appreciate, specially under the consideration that business and commercial directories of phone books are commonly called "amarillas" in Spanish, a short term for Yellow Pages.

For the purpose mentioned above, Respondent did not register but acquired the domain name to who was at the moment its legitimate owner. In doing this, Respondent executed the regular process, including payment, established by Buydomains.com.

It is a very important fact related to this case that this domain name was being offered to any person who wanted to buy the domain name through the website <buydomains.com>, for an unknown period of time.

Respondent thought it was good for its business and seized this opportunity. Yupi Internet, Inc. ("Complainant") lost this domain name because of its carelessness to pay the registration fee. It is a duty of the officers of a company to take proper care of its assets. The truth is that Complainant was careless with this domain name or, even worst, did not want to renew its registration. It is obvious that once Complainant realized that Respondent had acquired it and was bringing new value to it, Complainant had second thoughts about it and decided to initiate this Complaint.

One thing is for sure: Complainant did not give value to this domain name. It has a value of its own in the Spanish language, and this was the main reason why Respondent decided to acquire this domain name, publicly available at the time.

Finally, and very important, Respondent had not intended and does not want to be related to or being identified in any way with Complainant, since to Respondent's best knowledge Complainant didn't have a good corporate image in the countries where Respondent had operations, because of its financial troubles, before Microsoft and Telmex acquired it.

We must add to this, that in the Press Release communicating the Microsoft and Telmex acquisition of

Complainant there is not a word related to <amarillas.com>.

Respondent issued only one press release to communicate an important fact related to its business. This press release (in Spanish) stated that Respondent had acquired the domain <amarillas.com>.

In Respondent's press release nothing was said about acquiring assets of Complainant. Respondent has no interest in being associated to Complainant due to its former financial problems. What Respondent said was that it had acquired the domain name <amarillas.com> and was integrating its platforms from business directories <chilnet.cl> and <mercantil.com>, into this new world class portal being developed in 3 languages. In doing this, Respondent achieved through <amarillas.com> access to a directory built by its own personnel, of almost four million companies in 24 countries throughout America and Europe.

The translation into English language of this press release issued by Respondent (in Spanish) was made by Chilean journalist of BNAméricas, Claudio Ramirez, after a short telephone interview with Mr. Vargas from Respondent, in June 2002.

The Complainant wants to make Respondent appear as if it wanted to be identified with Complainant. This was not Respondent's purpose, and the only intention of the press release was to let Respondent's and Chilnet's clients know that they had a new way of accessing the old and new platforms of Respondent in one single site: the recently acquired <amarillas.com>.

Complainant claims that Respondent did inaccurate and misleading statements in the press release and in a news article published through "Business News America" on June 20, 2002. Their concern is that in those sources Respondent appears as claiming that it "has acquired the business of <amarillas.com> and that the companies are setting a new portal". Complainant continues to affirm that Respondent falsely claims that the acquisition provides Respondent with access to a directory of four million companies in 24 countries throughout Latin America, North America and Europe.

Business News America is a news provider of Respondent and as it can be seen in the original press release made by Respondent in Spanish and the article published by BNA in English, there are some differences, Respondent assumes it happened due to "translation problems".

On a close reading of the translation of the original press release it can be seen that Respondent informed that it acquired <amarillas.com>, which is not a company but a domain name. Respondent has never publicly disclosed the name of the seller of the domain, nor any transactional details (the seller was an internet brokerage firm).

After this domain name was acquired, Respondent built with its own resources a worldwide business portal located at <amarillas.com>. In this portal Respondent merged its directories <mercantil.com>, <chilnet.cl> and two other existing proprietary portals which –in total- give access to a directory of four million companies in 24 countries throughout Latin America, North America and Europe.

Respondent's Press Release is accurate and true.

Respondent and its subsidiaries have registered and filed for registration in Chile, various marks that include the terms "yellow pages" and "páginas amarillas".

There are also some other domain names registered by Respondent and its subsidiaries that include those terms. These are:

- <amarillasdelsur.com>
- <yellowssouth.com>

- <amarillasempresariales.com>

Furthermore one of the domain names that Complainant falsely claims to own is registered in Respondent's name. This is:

- <amarillas.com.mx>

Complainant claims that they did "substantial international advertising" of <amarillas.com> and that that effort brought "success" to Complainant's website. This is a misleading statement. All this happened during the first half of year 2000; two years ago; last century in terms of Internet. And it must be added that Complainant's website wasn't really a successful one, since nobody in the company even realized that they had lost the domain name for an important period of time (several weeks).

C. Additional Submissions

The parties submitted documentation in their additional responses that clarified certain issues.

FINDINGS

Given the complexity of the details involving this matter, the Panel wishes to set for the chronology of events:

1999	Complainant commences business operations.
July, 1999	Complainant acquires the <amarillas.com> domain name from Comint-ar S.A.
August, 1999	Complainant begins to use <amarillas.com>.
April 14, 2000	Complainant files a United States trademark application for <amarillas.com>.
August 2000	Complainant revamps <amarillas.com> and begins substantial advertising.
November 17, 2000	The United States Patent and Trademark Office mails a non-final action concerning the <amarillas.com> trademark application.
May 17, 2001	The United States Patent and Trademark Office received a communication from Complainant.
August, 2001	T1MSN Corp. acquires Complainant
August 27, 2001	The United States Patent and Trademark Office mails a final action concerning the <amarillas.com> trademark application.
November 26, 2001	Verisign mailed a paper invoice for <amarillas.com> to Complainant in Plantation, Florida, but Complainant claims it wasn't received.
December 30, 2001	Verisign mailed a second paper invoice for <amarillas.com> to Complainant in Plantation, Florida, but Complainant claims it wasn't received.
January 31, 2002	Verisign mailed a paper ten-day notice to Complainant in Miami, Florida, but Complainant claims it wasn't received.
February 14, 2002	Verisign mailed a second paper ten-day notice to Complainant in Miami, Florida, but Complainant claims it wasn't received.
April 8, 2002	<amarillas.com> was deleted for non-payment. At the time of deletion, <amarillas.com> was forwarded to <yupimsn.com> even though <amarillas.com> was not active itself.
April 14, 2002	Respondent purchases <amarillas.com> from BuyDomains.com for \$15,000.00.
May 5, 2002	The United States Patent and Trademark Office declares the <amarillas.com> trademark application abandoned due to a lack of response.
July 8, 2002	The United States Patent and Trademark Office receives a petition to revive from Complainant concerning the <amarillas.com> trademark application. No ruling has been issued on the petition to date, but such petitions are only rarely granted.
July 29, 2002	This proceeding was commenced.

DISCUSSION

The ownership of the <amarillas.com.mx> domain name is still uncertain to the Panel, but that issue does not affect the outcome of this case. No declarations by third parties were submitted.

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant has a service mark for AMARILLAS and AMARILLAS.COM based on its continuous use since 1999. Complainant obtained <amarillas.com> in 1999 from a Argentinean company, and immediately began using the domain name in relation to its business-to-business bilingual Internet portal to Latin America, Spain and the United States. The <amarillas.com> domain name was designed to serve as a tool to help businesspeople identify and develop relationships with trade associations, chambers of commerce, trade multipliers, and industry associations. Corporate leaders also provided the website with a comprehensive database of over 150,000 registered companies. Membership to <amarillas.com> also offered businesses numerous benefits and advantages including; in-depth industry specific content, including editorial briefs, corporate profiles, event and conference listings and industry guides, on various business sectors in over 28 countries and 216 industries.

In order to promote its <amarillas.com> website, Complainant engaged in substantial international advertising and promotional efforts. Complainant spent over a hundred thousand dollars in one year to advertise and promote the AMARILLAS.COM and AMARILLAS marks. Complainant advertised in pan-regional publications and on billboards, airport shuttles and taxicabs in major cities such as New York, Los Angeles and Miami.

Complainant has registered the AMARILLAS.COM mark in Venezuela, Peru, Ecuador, Guatemala, Honduras and El Salvador. Service mark applications are pending in Argentina, Brazil, Mexico, Bolivia, Nicaragua, Paraguay, and Uruguay (it should be noted the United States application is very unlikely to be reopened because it was deemed abandoned). Complainant has also registered various AMARILLAS domain names in various country codes throughout the world including: Mexico, Dominican Republic, Guatemala, Puerto Rico, Venezuela.

Complainant’s domain name registration <amarillas.com> apparently lapsed due to an error by Verisign Inc. (or perhaps Complainant itself). Complainant asserts it never received any renewal notices, and as a result its domain name registration for <amarillas.com> expired in April of 2002, unbeknownst to Complainant. Verisign told Complainant in June of this year that it was unable to help Complainant reacquire the domain name because the domain name had been registered by Respondent on April 14, 2002.

Respondent’s <amarillas.com> domain name is identical to Complainant’s AMARILLAS.COM service

mark(s) because it incorporates Complainant's entire mark. Respondent's <amarillas.com> domain name is identical to Complainant's AMARILLAS service mark(s) because it incorporates Complainant's entire mark. The Panel finds Respondent's domain name is identical to Complainant's mark because the addition of a top-level domain such as ".com," is irrelevant when determining whether the disputed domain name is identical. *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

While the marks may be somewhat descriptive, the Panel will not go behind the registration of the marks to determine their validity under local law. The mere fact the registration was issued is sufficient for the Panel.

Rights or Legitimate Interests

The Panel finds there is a presumption Respondent has no rights or legitimate interests in the disputed domain name based on Complainant's previous holding of the registration for <amarillas.com>. *See American Anti-Vivisection Soc'y v. "Infa dot Net" Web Serv.*, FA 95685 (Nat. Arb. Forum Nov. 6, 2000) (finding that Complainant's prior registration of the same domain name is a factor in considering Respondent's rights or legitimate interest in the domain name).

While it is very hard to prove a negative, Respondent has a safe harbor pursuant to Uniform Dispute Resolution Policy §4(c)(i): before any notice to the Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services. The information being offered here is real information and the transactions are real transactions. There is no claim Respondent's transactions are shams.

Complainant never contacted Respondent before Respondent began to use the <amarillas.com> domain name. Complainant knew the <amarillas.com> domain name registration had lapsed and Respondent acquired it. Instead of promptly contacting Respondent to advise Respondent of this, Complainant did nothing. Respondent built and installed a website for the domain. While the UDRP policy might well help in a lapsed domain name case, it won't help those that continue to slumber on their rights by failing to contact Respondent before Respondent incurs substantial expenses in creating a website at a newly acquired domain name.

Registration and Use in Bad Faith

Complainant must prove Respondent both registered and used the domain name in bad faith. Bad faith can be shown a number of ways, such as:

Circumstances indicating Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name.

The facts of this case do not support such a finding.

Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct.

The facts of this case do not support such a finding. There was no claim of a pattern of conduct.

Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor.

The facts of this case does not support such a finding, especially since this domain name was set up to forward to another website and Complainant did not provide any information on how much traffic came via <**amarillas.com**> and how much traffic arrived directly. There was no showing that Complainant's business was materially disrupted, much less that the domain name was acquired ***primarily*** to disrupt Complainant's business.

By using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

This happens automatically to some degree when a domain name acquires a new owner. Given the evidence of this case, Complainant has not proved this fact in light of the descriptive nature of the marks in question.

DECISION

For the foregoing reasons, the domain name shall ***NOT*** be transferred.

Houston Putnam Lowry, Chartered Arbitrator and Panelist

Dated: September 19, 2002

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YUM! Brands

v.

Ether Graphics

a/k/a Andrew

Gruner

colonelsanders.com



DECISION

YUM! Brands Inc. and KFC Corporation v. Ether Graphics a/k/a Andrew Gruner
Claim Number: FA0311000212651

PARTIES

Complainants are **YUM! Brands Inc.** and **KFC Corporation** (“Complainant”), represented by **Julia Anne Matheson**, of **Finnegan Henderson Farabow Garrett & Dunner L.L.P.**, 1300 I Street NW, Washington, DC 20005. Respondent is **Ether Graphics a/k/a Andrew Gruner** (“Respondent”), 13305 NE 171 St. Apt. J264, Woodinville, WA 98072.

REGISTRAR AND DISPUTED domain NAME

The domain name at issue is **<colonelsanders.com>**, registered with **Tucows**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainants submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on November 19, 2003; the Forum received a hard copy of the Complaint on November 20, 2003.

On November 20, 2003, Tucows confirmed by e-mail to the Forum that the domain name **<colonelsanders.com>** is registered with Tucows and that Respondent is the current registrant of the name. Tucows has verified that Respondent is bound by the Tucows registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform domain name Dispute Resolution Policy (the “Policy”).

On November 21, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of December 11, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@colonelsanders.com by e-mail.

A timely Response was received and determined to be complete on December 10, 2003.

On December 22, 2003, pursuant to Complainants’ request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

RELIEF SOUGHT

Complainants request that the domain name be transferred from Respondent to Complainant KFC Corporation.

PARTIES' CONTENTIONS

A. Complainant

1. YUM! Brands, KFC, and their Products and Services

YUM! Brands is the world's largest restaurant company in terms of system units with more than 33,000 restaurants in more than 100 countries and territories. YUM! Brands, a Fortune 300 company publicly traded on the New York Stock Exchange, owns and operates American restaurant favorites KFC, Pizza Hut, Taco Bell, Long John Silver's, and A&W All-American Food.

KFC is one of the most popular chicken restaurant chains in the world. From its humble beginnings in the front room of founder Colonel Harland Sanders' Corbin, Kentucky gas station over 50 years ago, the business that evolved into KFC serves more than 300 different products to nearly 8 million customers daily in more than 12,000 restaurants in 88 countries and territories around the world.

KFC's success owes much to the vision, energy, and heart of its founder and corporate icon, Colonel Sanders. Colonel Sanders developed the special cooking process and created the blend of 11 secret herbs and spices known to the world today as Original Recipe Kentucky Fried Chicken. In KFC, Colonel Sanders offered customers high quality, wholesome, tasty food at reasonable prices in clean and friendly surroundings. Today, the company continues to maintain rigorous quality control programs to ensure that its customers around the world enjoy the highest possible quality restaurant services and food products.

The image of company founder Colonel Harland Sanders (one of the most widely recognized individuals in the world), and the KFC Logo (comprised of a combination of the KFC trademark and the image of Colonel Sanders) are each famous marks that enjoy instantaneous recognition. The image of Colonel Sanders appears in numerous aspects of KFC's business: from the bucket in which KFC's famous chicken is sold and served, to its store signage, menus, posters, billboards, TV commercials, and Internet websites.

KFC engages in substantial advertising and promotion of its trademarks, its restaurant services, and its food products. KFC spends hundreds of millions of dollars each year to promote its products and services under the COLONEL SANDERS marks.

KFC's marketing efforts reach its ever-increasing number of customers through virtually every type of media. In the U.S. alone, users encounter KFC trademarks, including the image of Colonel Sanders and other COLONEL SANDERS-formative marks, in advertisements on broadcast television and cable television, in radio and print ads, in newspaper inserts, on outdoor signage and billboards, on product packaging, and menus, and as a result of the numerous sponsorships and community events KFC participates in every single year.

In addition to its more traditional marketing efforts, KFC also reaches out to its customers online through a number of associated websites. The company's primary website is located at the domain name <kfc.com>.

The extraordinary success of KFC's efforts is evident from KFC's annual sales figures. In 2002, KFC's worldwide system sales totaled \$9 billion. The reach, fame, and popularity of the KFC brands is beyond question.

2. KFC's Trademark Holdings

KFC owns numerous U.S. trademark registrations and applications for COLONEL SANDERS-formative marks, including the following

Registration No. 805,773 for the mark COLONEL SANDERS' RECIPE, first used December, 1956, issued March 15, 1966, covering services in International Class 42 (restaurant services).

Registration No. 814,610 for the mark COL. SANDERS' RECIPE, first used December, 1956, issued September 6, 1966, covering goods in International Classes 29 (meats and processed foods) and 30 (staple foods).

Registration No. 838,062 for the mark COLONEL SANDERS' RECIPE KENTUCKY FRIED CHICKEN, first used December, 1950, issued October 31, 1967, covering services in International Class 42 (restaurant services).

Registration No. 813,559 for the mark COLONEL SANDERS' RECIPE KENTUCKY FRIED CHICKEN, first used December, 1950, issued October 31, 1967, covering goods in International Classes 29 (meats and processed foods) and 30 (staple foods).

Registration No. 810,835 for the design mark image of Colonel Sanders (hereinafter "COLONELS' FACE DESIGN"), first used December, 1956, issued July 5, 1966, covering goods in International Class 29 (meats and processed foods).

Registration No. 806,104 for COLONELS' FACE DESIGN mark, first used December, 1956, issued March 22, 1966, covering services in International Class 42 (restaurant services).

Registration No. 1,491,641 for the design mark depicting a container with the COLONELS' FACE DESIGN mark and the words KENTUCKY FRIED CHICKEN, first used July 20, 1970, issued July 7, 1988, covering services in International Class 42 (restaurant services).

The dominant portion of KFC's trademarks is COLONEL SANDERS and/or the image of Colonel Sanders, as shown by KFC's disclaimers of the words "recipe" and "fried chicken" in its above-listed registrations.

KFC's trademark rights in the COLONEL SANDERS marks and variations thereof, based on its trademark filings and on its common law rights acquired through the use of those marks, long predate Respondent's registration of the domain name.

3. Respondent's Infringing Activities and Bad Faith Acts

Respondent registered the domain name <colonelsanders.com> on March 5, 2002, long after Complainant began using its COLONEL SANDERS marks and long after those marks became famous worldwide.

After registering the domain name, Respondent commenced use of it for a website displaying, without Complainant's authorization, Complainant's COLONELS' FACE DESIGN mark (as memorialized in Registration Nos. 810,835 and 806,104) surrounded by the nonsensical slogans "War is Peace," "Big Brother is Watching You," "Ignorance is Strength," and "Freedom is Slavery." The adulterated version of Complainant's logo included a link to his e-mail address andrew@andrewgruner.com.

On May 22, 2003, Complainant sent Respondent a cease-and-desist letter^[1] demanding the transfer of the domain name to Complainant.

After receiving Complainant's objection, Respondent ceased using the domain name for a website. The website is currently inactive.

Respondent further responded to Complainant's objection by offering to sell the domain name for \$5,000 in order for Complainant to "avoid the expenses involved if this were to proceed to legal action," a statement offered without explanation. Respondent claimed that his unauthorized use of the domain name and KFC's COLONELS' FACE DESIGN mark was done in the "context of political satire" and that he has "made no money from this site." Respondent failed to explain how the taking of Complainant's logo coupled with nonsensical slogans conveyed any message.

On July 23, 2003, Complainant replied to Respondent, stating that his offer to sell the domain name for \$5,000 constituted bad faith and offering to reimburse Respondent for his actual costs, not to exceed \$100, for the transfer of the domain name.

On August 20, 2003, Respondent again offered to sell the domain name for \$5,000, stating "many *popular domain names* [sell] in that range." Respondent also claimed that his offer to sell the domain name was not in bad faith because he did not initially contact KFC with his offer.

Respondent is a graphic designer who operates a website at the domain name <andrewgruner.com>. In connection with his promotion of his graphic design business, Respondent currently displays a series of images on that website, including the infringing version of Complainant's logo earlier displayed on his <colonelsanders.com> website, as well as various additional images incorporating famous marks such as the ABSOLUT logo and the APPLE logo, combined with copies of famous paintings, "Starry Night" by Vincent Van Gogh and "The Son of Man" by René Magritte. Respondent's résumé and website promote that Respondent has designed logos for various companies.

4. The domain name is confusingly similar to KFC'S COLONEL SANDERS marks

The test of confusing similarity under the UDRP is confined to a consideration of the disputed domain name and Complainant's trademark without reference to other issues. *See Microsoft Corporation v. WDW Inc.*, D2002-0412 (WIPO July 1, 2002). Here, the domain name <colonelsanders.com> is confusingly similar to KFC's COLONEL SANDERS marks, namely, COLONEL SANDERS' RECIPE and COLONEL SANDERS' KENTUCKY FRIED CHICKEN, because the domain name incorporates the dominant portion of those marks, COLONEL SANDERS. Indeed, as shown on KFC's trademark registrations, it disclaims the "recipe" and "fried chicken" portions of the COLONEL SANDERS marks, thus establishing that the dominant portion of those marks is COLONEL SANDERS. Respondent's subtraction of the words "recipe" and/or "kentucky fried chicken" does not distinguish the domain name from KFC's COLONEL SANDERS marks.

Pursuant to Section 4(a)(i) of the UDRP, KFC's burden is to show that "the domain name is identical *or confusingly similar* to a trademark or service mark in which Complainant has rights" (emphasis added). As shown above, KFC owns federal trademark registrations for the marks COLONEL SANDERS' RECIPE and COLONEL SANDERS' KENTUCKY FRIED CHICKEN. KFC does not need to show, as Respondent implies in his August 20, 2003 letter, that it owns a trademark that is identical to the domain name. Rather, KFC's burden is to prove that it owns a trademark to which the domain name is confusingly similar, which KFC has done.

Further, the interconnection between the domain name and KFC's COLONEL SANDERS marks is clearly shown by Respondent's use of the domain name for a website displaying an unauthorized copy of another of KFC's trademarks, namely, the COLONEL'S FACE DESIGN mark.

5. Respondent has no rights or legitimate interests in the domain name

Respondent is not using and has not used or is not demonstrating and has not demonstrated an intent to use the domain name in connection with a bona fide offering of goods or services. *See Ciccon v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000) (“use which intentionally trades on the fame of another can not constitute a ‘bona fide’ offering of goods and services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy”).

Respondent is not and has not been commonly known by the domain name.

Respondent is not making legitimate noncommercial or fair use of the domain name, without intending to mislead and divert consumers or to tarnish KFC’s COLONEL SANDERS marks for commercial gain. Respondent’s registration and use of the domain name to post an adulterated version of KFC’s famous and federally registered COLONELS’ FACE DESIGN coupled with a series of nonsensical statements unrelated to the Colonel, KFC, or its general business is not fair use under the UDRP and U.S. law.

Respondent’s mere assertion that he registered the domain name for a website featuring “political satire” is insufficient to support a finding of fair use. Respondent does not offer a discernable message other than an attempt to promote his graphic design business with the improper use of third party trademarks. Second, Respondent’s website is neither satire nor parody. In an analogous case relating to copyright law, *Campbell v. Acuff Rose Music*, 510 U.S. 569 (1994), the U.S. Supreme Court held “. . . the heart of any parodist’s claim to quote from existing material, is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works. [citation omitted.] If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger. Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing” (emphasis added). In this case, Respondent’s website does not qualify as parody because it has “no critical bearing” on KFC and/or KFC’s famous COLONEL SANDERS marks. Further, Respondent has no justification for his unauthorized use of KFC’s COLONEL SANDERS marks, let alone the higher threshold of justification required for satire. Simply put, Respondent had no need to use KFC’s famous COLONEL SANDERS marks in the domain name and on his website. It is clear that Respondent misappropriated KFC’s trademarks to “avoid the drudgery in working up something fresh.”

Even if Respondent’s <colonelsanders.com> website qualified as parody, that still would not justify his registration and use of the domain name because the domain name itself does not convey a parody. *See People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001) (holding the defendant’s registration and use of the domain name <peta.org> caused confusion because it was likely to prevent Internet users from reaching the website of the People for Ethical Treatment of Animals (“PETA”), and rejected the defendant’s parody defense because the domain name <peta.org> itself did not convey a parody and any parody could not be realized until after the visitor went to the defendant’s website).

6. RESPONDENT’S BAD FAITH UNDER SECTION 4(B) OF THE UDRP

Given the fame of Complainant’s COLONEL SANDERS marks, and the fact that Respondent’s <colonelsanders.com> domain name and website were used to display an adulterated version of

KFC's logo, there is no question that Respondent knew of Complainant's rights in the COLONEL SANDERS marks when he registered the domain name. In addition, as a graphic designer who creates logos, Respondent is well-aware of the rights associated with trademarks and design trademarks. By registering the domain name with knowledge of Complainant's rights in its COLONEL SANDERS marks, Respondent acted in bad faith. *See Compaq Info. Techs. Group, L.P. v. Dealer Direct, Inc.*, FA 97062 (Nat. Arb. Forum June 14, 2002) (finding respondent registered the domain name in bad faith because it was on notice of complainant's rights); *see also Yahoo! Inc. v. Kelvin Pham*, FA 109699 (Nat. Arb. Forum May 21, 2002) (same); *see also Europay Int'l S.A. v. domaines Ltd.*, D2000-0513 (WIPO July 31, 2000) (holding that respondents must have known they were infringing upon complainant's exceptionally well known mark by registering it as a domain name).

The names COLONEL SANDERS and KFC are inextricably intertwined in the public's eye because Colonel Sanders is both the name of the company's founder and is the personification of the company and its public image. Further, Complainant's COLONEL SANDERS marks are famous worldwide. There is therefore no question that Internet users typing in **<colonelsanders.com>** expect to reach KFC's website, and that many Internet users will do so, as Respondent admitted when he described the domain name as "popular." Respondent registered the domain name for that very reason, namely, to trade on the fame and goodwill of Complainant's COLONEL SANDERS marks and to intentionally attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with Complainant's COLONEL SANDERS marks to the source, sponsorship, affiliation and endorsement of his website. Because his website included a way for consumers to contact him and because he is using the adulterated COLONEL SANDERS logo to promote his graphic design business on his **<andrewgruner.com>** website, Respondent was using the **<colonelsanders.com>** website to generate potential customers for his graphic design business. As such, Respondent's registration and use of the domain name meet the bad faith element set forth in Section 4(b)(iv) of the UDRP. Furthermore, even if Respondent's claim that he did not intend to profit from his **<colonelsanders.com>** website were true, Respondent's registration and use of the domain name that is confusingly similar to Complainant's COLONEL SANDERS marks must be assumed to logically benefit Respondent to the detriment of Complainant, and therefore are in bad faith. *See David Taylor Cadillac/Buick Co. v. Spider Webs Ltd.*, FA 95832 (Nat. Arb. Forum Nov. 30, 2002) (finding bad faith in Respondent's use of the domain name for a free, consumer website because "confusion can result regardless of whether the content on [Respondent's] website is commercial or noncommercial").

Respondent's claim that he did not intend to profit from the domain name, however, is directly contradicted by the undisputable evidence that he offered to sell the domain name to Complainant for \$5,000, an amount that well exceeds his expenses for registering the domain name. As established above, soon after registering the domain name, Respondent offered to sell the domain name to Complainant for \$5,000. Respondent rejected Complainant's offer to reimburse him for \$100 in expenses, instead reiterated his offer to sell the domain name for \$5,000, citing the "popularity" of the domain name, a popularity which is inextricably rooted in the fame of the COLONEL SANDERS marks. As such, Respondent's activities constitute textbook bad faith pursuant to Section 4(b)(i) of the UDRP. *See, e.g., Federal Home Loan Mortgage Corp. v. Arshad*, FA 116767 (Nat. Arb. Forum Sept. 19, 2002) (finding bad faith in Respondent's offer to sell the disputed domain name to complainant).

Respondent's bad faith offer to sell the domain name is not mitigated by the fact that Complainant contacted him first. Respondent argues that he was "only responding to [KFC's] request." Under Respondent's flawed interpretation of the UDRP, responding to a cease-and-desist letter by offering to sell the trademark-related domain name for a tremendous profit would never be in bad faith, which

is clearly an absurd result. As the Panel noted in *Magnum Piering, Inc. v. Mudjackers*, D2000-1525 (WIPO Jan. 29, 2001), “. . .the Policy’s goal of preventing cybersquatting would not be furthered by excluding evidence of a registrant’s offer to sell or otherwise transfer the domain name for consideration in excess of out-of-pocket costs, even if the offer is made after the registrant is on notice of the dispute. Cybersquatters often wait until a trademark owner comes calling; they should not be able to avoid the Policy by being the second to speak.” Further, the fact that Respondent offered to sell the domain name in his letter to Complainant rather on his website is irrelevant, as Respondent’s attempt to make thousands of dollars in profit from his registration and use of the domain name is plainly evident.

Respondent’s subsequent removal of the objectionable material originally posted at the domain name website does not diminish the fact that Respondent registered and used the domain name in bad faith. *See Accu Weather, Inc. v. Global Net 2000, Inc.*, FA 94645 (Nat. Arb. Forum June 1, 2000) (finding Respondent’s removal of infringing website content at the domain name does not restrict Respondent from “reverting to this or similar behavior in the future”); *see also America Online, Inc. v. East Coast Exotics*, D2001-061 (WIPO July 10, 2001) (finding changes made to the website after the complaint was filed do not lessen Respondent’s prior bad faith acts); *see also Coral Trademarks, Ltd. v. Eastern Net, Inc.*, D2000-1295 (WIPO Dec. 26, 2000) (same).

Respondent’s current “passive holding” or non-use of the domain name constitutes bad faith. *See Telstra Corp. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000) (finding passive holding constitutes bad faith use of the domain name); *see also Aeroturbine, Inc. v. domain Leasing Ltd.*, FA 93674 (Nat. Arb. Forum Mar. 23, 2000) (same); *Estate of Tupac Shakur v. Andronian*, AF-0349 (eRes.Sept. 4, 2000) (same); *see also CBS Radio Inc. v. Oldies Radio*, D2000-1033 (WIPO Oct. 5, 2000) (same); *see also Sanrio Co., Ltd. v. DLI*, D2000-0159 (WIPO April 20, 2000) (same).

B. Respondent

Respondent has neither the time nor the resources to give sufficient response to what clearly took Complainant several months of preparation. Having received notice of this administrative proceeding at the start of the holiday season, it would appear that the timing of Complainant’s submission was calculated to overwhelm Respondent during an already busy time of year. If this was indeed Complainant’s intent, they have succeeded. The filing of an extension would be of no avail, as an extra twenty days would still heavily overlap the holidays, of which Respondent has prior commitments.

Furthermore, Respondent sees no reason to instruct the ignorant in the fundamentals of art interpretation, nor will Respondent pontificate on the staunching of free speech on the Internet at the hands of large corporations. Suffice it to say, this is exactly the kind of nonsense that Respondent was depicting though his artwork.

Lastly, the website is not “currently inactive” or in “passive holding” as Complainant contends. On November 16, 2003, prior to receiving any correspondence of this administrative proceeding, the website <colonelsanders.com> was repurposed to feature photo’s of Respondent’s pet guinea pig, known to friends and family as “Colonel Sanders”. The site now bears no resemblance to anything related to KFC.

FINDINGS

Based upon the information provided by both parties, the Panel finds:

- (1) The <colonelsanders.com> domain name registered by Respondent is identical or confusingly similar to a trademark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests with respect to the <colonelsanders.com>

domain name; and

- (3) The <colonelsanders.com> domain name was registered and is being used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform domain name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that Complainants must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant KFC Corporation has established rights in the COLONEL SANDERS’ formative marks (e.g. COLONEL SANDERS’ RECIPE, COLONEL SANDERS’ RECIPE KENTUCKY FRIED CHICKEN and COLONELS’ FACE DESIGN marks) through registration of those marks on the Principal Register of the U.S. Patent and Trademark Office, as well as through widespread and continuous use of the marks in commerce. *See Men’s Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) (“Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning”); *see also Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established).

The <colonelsanders.com> domain name is confusingly similar to its COLONEL SANDERS’ formative marks, as the dominant portion of each of those marks is the COLONEL SANDERS’ portion of the marks. *See Down East Enter. Inc. v. Countywide Communications*, FA 96613 (Nat. Arb. Forum Apr. 5, 2001) (finding the domain name <downeastmagazine.com> confusingly similar to Complainant’s common law mark DOWN EAST, THE MAGAZINE OF MAINE); *see also Nikon, Inc. v. Technilab, Inc.*, D2000-1774 (WIPO Feb. 26, 2000) (holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name rather than upon the likelihood of confusion test under U.S. trademark law).

Rights or Legitimate Interests

Respondent’s use of the domain name to feature Complainant’s COLONELS’ FACE DESIGN mark without authorization, along with phrases such as “War is Peace,” “Big Brother is Watching You” and “Freedom is Slavery” does not evidence a legitimate noncommercial or fair use of the domain name. *See Robo Enter., Inc. v. Tobiason*, FA 95857 (Nat. Arb. Forum Dec. 24, 2000) (holding that in order to qualify as a protected ‘parody’ which would confer rights or a legitimate interest, the domain name itself must signify critical purposes, as opposed to imitation of the service mark). In this case, the slogans in question had no discernable relationship to the trademarks. Without some relationship between the two, there can be no parody.

Respondent’s failure to use the disputed domain name for any bona fide purpose other than to display an adulterated version of Complainant’s mark does not evidence rights or legitimate interests in the disputed domain name. *See eBay Inc. v. Hong*, D2000-1633 (WIPO Jan. 18, 2001) (“use of

complainant's entire mark in infringing domain names makes it difficult to infer a legitimate use").

Respondent's offer to sell its domain name registration to Complainant is further evidence (but not conclusive evidence) that Respondent lacks rights or legitimate interests in the disputed domain name. *See Am. Nat'l Red Cross v. domains*, FA 143684 (Nat. Arb. Forum Mar. 4, 2003) ("Respondent's lack of rights and legitimate interests in the domain name is further evidenced by Respondent's attempt to sell its domain name registration to Complainant, the rightful holder of the RED CROSS mark"); *see also Cruzeiro Licenciamentos Ltda v. Sallen*, D2000-0715 (WIPO Sept. 6, 2000) (finding that rights or legitimate interests do not exist when one holds a domain name primarily for the purpose of marketing it to the owner of a corresponding trademark).

Needless to say, Respondent cannot acquire rights to the Colonel Sanders domain name simply by naming (or possibly even re-naming) his pet guinea pig after (or in honor of) Colonel Sanders. First of all, a pet guinea pig is not a party to this proceeding so Policy ¶ 4(c)(ii) does not apply (it applies only to respondents and animals cannot be respondents). Second, allowing this defense would simply promote a plethora of pet guinea pig websites (whether the pet guinea pig has died or not), all with rather esoteric names that just happened to be famous trademarks. This Panel declines to walk down that road.

Registration and Use in Bad Faith

Respondent's offer to sell the disputed domain name to Complainant for \$5,000 is evidence that the domain name was registered and used in bad faith. *See Prudential Ins. Co. of Am. v. TPB Fin.*, FA 105218 (Nat. Arb. Forum Apr. 8, 2002) (finding bad faith registration and use pursuant to Policy ¶ 4(b)(i) where Respondent offered to sell the domain name for \$900, specifically noting that it would cost Complainant more to enforce its rights legally than to succumb to Respondent's attempted extortion); *see also Pocatello Idaho Auditorium Dist. v. CES Mktg. Group, Inc.*, FA 103186 (Nat. Arb. Forum Feb. 21, 2002) ("[w]hat makes an offer to sell a domain [name] bad faith is some accompanying evidence that the domain name was registered because of its value that is in some way dependent on the trademark of another, and then an offer to sell it to the trademark owner or a competitor of the trademark owner"). Based upon the evidence at hand and the famous nature of these marks, it seems fairly obvious Respondent registered the domain name in bad faith. Putting Complainant's trademark on Respondent's website also suggests Respondent knew Complainant's trademark existed after the website was operational as well.

Respondent's registration and use of the disputed domain name with actual knowledge of Complainant's rights in the COLONEL SANDERS' formative marks, including the display of the COLONELS' FACE DESIGN mark, is evidence that the domain name was registered and used in bad faith. *See Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) ("there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively"); *see also Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration).

Respondent's use of the disputed domain name was not a parody, but rather tarnishes Complainant's mark, evidence that the disputed domain name was registered and used in bad faith.

Respondent's "use" of the domain name is nominal, and that its passive holding of the disputed domain name is evidence of bad faith registration and use. *See Parker Hannifin v. East Bay Website*, AF-0587 (eRes. Dec. 22, 2000) (a domain name can be used for several purposes, including: (1) a website (ranging from informational to eCommerce) (2) an address for email, or (3) to prevent

another from using the domain name); *see also Cruzeiro Licenciamentos Ltda v. Sallen*, D2000-0715 (WIPO Sept. 6, 2000) (finding that mere passive holding of a domain name can qualify as bad faith if the domain name owner's conduct creates the impression that the name is for sale); *see also Body Shop Int'l PLC v. CPIC NET & Hussain*, D2000-1214 (Nov. 26, 2000) (finding bad faith where (1) Respondent failed to use the domain name and (2) it is clear that Respondent registered the domain name as an opportunistic attempt to gain from the goodwill of Complainant).

Renaming Respondent's pet guinea pig "Colonel Sanders" and dedicating the website to him is further evidence that the domain name is being used in bad faith.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <colonelsanders.com> domain name be **TRANSFERRED** from Respondent to Complainant KFC Corporation.

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: January 2, 2004

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[1] The May 22, 2003 letter and subsequent correspondence was sent by YUM! Restaurants International, a division of Complainant KFC's parent company YUM! Brands, Inc., on KFC's behalf.

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