



NATIONAL ARBITRATION FORUM

DECISION

Allen-Edmonds Shoe Corporation v. Robert Galvin
Claim Number: FA0601000624520

PARTIES

Complainant is **Allen-Edmonds Shoe Corporation** ("Complainant"), represented by **Joseph J. Jochman**, of **Andrus, Scales, Starke & Sawall, LLP**, Suite 100, 100 East Wisconsin Avenue, Milwaukee, WI 53202. Respondent is **Robert Galvin** ("Respondent"), PO Box 21151, Washington, DC 20009.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**allenedmondsservice.com**>, <**allenedmondsrepair.com**>, <**allenedmondsofwashington.com**>, and <**allenedmondsofwashingtondc.com**>, registered with **Go Daddy Software, Inc.**

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 electronically on January 11, 2006; the National Arbitration Forum received a hard copy of the Complaint on January 12, 2006.

On January 11, 2006, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the <**allenedmondsservice.com**>, <**allenedmondsrepair.com**>, <**allenedmondsofwashington.com**>, and <**allenedmondsofwashingtondc.com**> domain names are registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the names. Go Daddy Software, Inc. has verified that Respondent is bound by the Go Daddy Software, 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 January 18, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of February 7, 2006 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@allenedmondsservice.com, postmaster@allenedmondsrepair.com,

postmaster@allenedmondsofashington.com, and
postmaster@allenedmondsofwashingtondc.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On February 15, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Respondent's <allenedmondsservice.com>, <allenedmondsrepair.com>, <allenedmondsofashington.com>, and <allenedmondsofwashingtondc.com> domain names are confusingly similar to Complainant's ALLEN EDMONDS mark.
2. Respondent does not have any rights or legitimate interests in the <allenedmondsservice.com>, <allenedmondsrepair.com>, <allenedmondsofashington.com>, and <allenedmondsofwashingtondc.com> domain names.
3. Respondent registered and used the <allenedmondsservice.com>, <allenedmondsrepair.com>, <allenedmondsofashington.com>, and <allenedmondsofwashingtondc.com> domain names in bad faith.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant Allen-Edmonds Shoe Corporation owns a trademark registration with the United States Patent and Trade Office ("USPTO") for the ALLEN EDMONDS mark.

Complainant first registered the ALLEN EDMONDS mark with the USPTO on January 24, 1967 (Reg. No. 822,911) and renewed its registration on January 24, 1987.

Complainant has been a manufacturer and distributor of shoes since 1936. Complainant has also participated in electronic commerce since 1995, advertising and selling its products via the Internet and at the <allenedmonds.com> domain name. Complainant later registered the <allenedmondsshoes.com> domain name in 2000.

Respondent registered the <**allenedmondsservice.com**>, <**allenedmondsrepair.com**>, <**allenedmondsofwashington.com**>, and <**allenedmondsofwashingtondc.com**> domain names on March 10, 2004. Respondent has parked the disputed domain names with a domain parking service, and is using the disputed domain names to provide links to websites offering Complainant's products, as well as to websites of Complainant's competitors. Respondent presumably receives 'click-through-fees' through its use of the disputed domain names. When contacted by Complainant's representatives in connection with its use of the disputed domain names, Respondent offered to sell the disputed domain name registrations to Complainant for \$5,000.

DISCUSSION

Paragraph 15(a) of 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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that 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 Respondent is identical or confusingly similar to a trademark or service mark in which 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.

Identical and/or Confusingly Similar

Complainant's registrations of its ALLEN EDMONDS mark with the USPTO adequately demonstrate Complainant's rights in the mark pursuant to Policy ¶4(a)(i). *See Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark."); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) ("Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.").

Respondent's **<allenedmondservice.com>**, **<allenedmondsrepair.com>**, **<allenedmondsofashington.com>**, and **<allenedmondsofwashingtondc.com>** domain names are confusingly similar to Complainant's registered ALLEN EDMONDS mark. Respondent's **<allenedmondservice.com>** domain name is confusingly similar to Complainant's mark because the disputed domain name wholly incorporates Complainant's mark and adds the generic term "service" and the generic top-level domain ".com." *See Am. Online, Inc. v. Anytime Online Traffic Sch.*, FA 146930 (Nat. Arb. Forum Apr. 11, 2003) (finding that the respondent's domain names, which incorporated the 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 Westfield Corp. v. Hobbs*, D2000-0227 (WIPO May 18, 2000) (finding the **<westfieldshopping.com>** domain name confusingly similar because the WESTFIELD mark was the dominant element).

Additionally, Respondent's **<allenedmondsrepair.com>** domain name is confusingly similar to Complainant's mark, as the disputed domain name likewise incorporates Complainant's mark in its entirety and adds the generic term "repair" and the generic top-level domain ".com." *See Oki Data Ams., Inc. v. ASD, Inc.*, D2001-0903 (WIPO Nov. 6, 2001) ("[T]he fact that a domain name wholly incorporates a Complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks"); *see also Body Shop Int'l PLC v. CPIC NET*, D2000-1214 (WIPO Nov. 26, 2000) (finding that the domain name **<bodyshopdigital.com>** is confusingly similar to the complainant's THE BODY SHOP trademark).

Respondent's **<allenedmondsofashington.com>** and **<allenedmondsofwashingtondc.com>** domain names are also confusingly similar to Complainant's mark, as both disputed domain names combine Complainant's mark with the preposition "of" and the geographic terms "washington" and "washingtondc," respectively. *See VeriSign, Inc. v. Tandon*, D2000-1216 (WIPO Nov. 16, 2000) (finding confusing similarity between the complainant's VERISIGN mark and the **<verisignindia.com>** and **<verisignindia.net>** domain names where the respondent added the word "India" to the complainant's mark); *see also CMGI, Inc. v. Reyes*, D2000-0572 (WIPO Aug. 8, 2000) (finding that the domain name **<cmgiasia.com>** is confusingly similar to the complainant's CMGI mark); *see also Net2phone Inc. v. Netcall SAGL*, D2000-0666 (WIPO Sept. 26, 2000) (finding that the respondent's domain name

<net2phone-europe.com> is confusingly similar to the complainant's mark because "the combination of a geographic term with the mark does not prevent a domain name from being found confusingly similar"); cf. *John Fairfax Publ'ns Pty Ltd. v. Pro-Life Domains Not for Sale*, FA 213460 (Nat. Arb. Forum Jan. 6, 2004) ("The addition of the article 'the' does not significantly distinguish the domain name from the mark for purposes of Policy ¶4(a)(i).").

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

In accordance with Policy ¶4(a)(ii), Complainant maintains the initial burden to establish Respondent does not have rights or legitimate interests in the disputed domain names. However, if Complainant demonstrates a *prima facie* case, the burden then shifts to Respondent to prove that he has rights or legitimate interests in the disputed domain names. See *Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) ("Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a *prima facie* case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question."); see also *Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide "concrete evidence that it has rights to or legitimate interests in the domain name at issue"). The Panel finds that Complainant has presented a *prima facie* case, and will evaluate whether the evidence on record demonstrates rights or legitimate interests for Respondent under Policy ¶4(c).

Based on the evidence in the record, Respondent is not commonly known by the <allenedmondsservice.com>, <allenedmondsrepair.com>, <allenedmondsofwashington.com>, or <allenedmondsofwashingtondc.com> domain names. Respondent's WHOIS information does not indicate Respondent is now, or has ever been commonly known by any of the disputed domain names. Therefore, Respondent has not established rights or legitimate interests in the disputed domain names pursuant to Policy ¶4(c)(ii). See *Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); see also *Tercent Inc. v. Lee 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).

The evidence on record does not demonstrate Respondent made use of the disputed domain names in connection with a *bona fide* offering of goods or services under Policy ¶4(c)(i). Respondent uses the disputed domain names to provide links to websites that offer either Complainant's products or links to providers that directly compete with Complainant. Such use does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i). *See TM Acquisition Corp. v. Sign Guards*, FA 132439 (Nat. Arb. Forum Dec. 31, 2002) (finding that the respondent's diversionary use of the complainant's marks to send Internet users to a website which displayed a series of links, some of which linked to the complainant's competitors, was not a *bona fide* offering of goods or services); *see also Computer Doctor Franchise Sys., Inc. v. Computer Doctor*, FA 95396 (Nat. Arb. Forum Sept. 8, 2000) (finding that the respondent's website, which is blank but for links to other websites, is not a legitimate use of the domain names). Additionally, the evidence on record fails to sufficiently establish that Respondent is making a legitimate noncommercial use or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers. Upon being contacted by Complainant, Respondent immediately offered to sell the disputed domain names to Complainant for \$5,000. Consequently, there is no legitimate noncommercial or fair use of the disputed domain names under Policy ¶4(c)(iii). *See Hewlett-Packard Co. v. High Performance Networks, Inc.*, FA 95083 (Nat. Arb. Forum July 31, 2000) (finding no rights or legitimate interests where the respondent registered the domain name with the intention of selling its rights); *see also Mothers Against Drunk Driving v. Hyun-Jun Shin*, FA 154098 (Nat. Arb. Forum May 27, 2003) (holding that under the circumstances, the respondent's apparent willingness to dispose of its rights in the disputed domain name suggested that it lacked rights or legitimate interests in the domain name).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Respondent's offer to sell the disputed domain name registrations to Complainant for \$5,000 suggests Respondent registered and used the domain names in bad faith under Policy ¶4(b)(i). *See Neiman Marcus Group, Inc. v. AchievementTec, Inc.*, FA 192316 (Nat. Arb. Forum Oct. 15, 2003) (finding the respondent's offer to sell the domain name for \$2,000 sufficient evidence of bad faith registration and use under Policy ¶4(b)(i)); *see also Campmor, Inc. v. GearPro.com*, FA 197972 (Nat. Arb. Forum Nov. 5, 2003) ("Respondent registered the disputed domain name and offered to sell it to Complainant for \$10,600. This demonstrates bad faith registration and use pursuant to Policy ¶4(b)(i)."). Respondent clearly states he is "in the business of selling domains and websites."

The evidence on record indicates Respondent registered and is using the disputed domain names with the intent to attract Internet users for commercial gain by creating a likelihood of confusion with Complainant's mark. Complainant's mark has been registered and widely used for nearly forty years. By providing links to websites offering

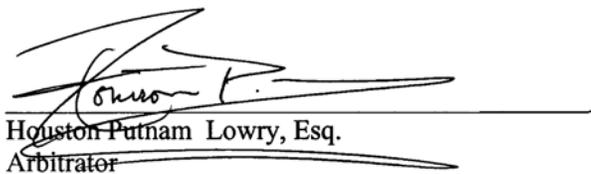
Complainant's products, as well as websites in direct competition with Complainant, Respondent makes evident its intent to divert Internet users through the use of confusingly similar domain names. Such use by Respondent, coupled with the presumption Respondent is receiving "click through fees" for its diversionary tactics, establishes that Respondent has registered and used the disputed domain names in bad faith under Policy ¶4(b)(iv). *See Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"); *see also Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) ("Registration and use of a domain name that incorporates another's mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.").

The Panel finds Policy ¶4(a)(iii) satisfied.

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 <**allenedmondsservice.com**>, <**allenedmondsrepair.com**>, <**allenedmondsofashington.com**>, and <**allenedmondsofashingtondc.com**> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: February 28, 2006

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