



NATIONAL ARBITRATION FORUM

DECISION

Vanounou Clothing Inc. c/o Zion Vanounou v Administrator c/o Domain Admin
Claim Number: FA0612000861280

PARTIES

Complainant is **Vanounou Clothing Inc. c/o Zion Vanounou** (“Complainant”), represented by **Ben Freylicher**, 341 N. Detroit, Los Angeles, CA 90036. Respondent is **Administrator c/o Domain Admin** (“Respondent”), represented by **Ari Goldberger**, of **ESQwire.com Law Firm** 35 Cameo Drive, Cherry Hill, NJ 08003, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**gojeans.com**>, registered with **Bulkregister, LLC**.

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 December 5, 2006; the National Arbitration Forum received a hard copy of the Complaint on December 6, 2006.

On December 13, 2006, Bulkregister, LLC confirmed by e-mail to the National Arbitration Forum that the <**gojeans.com**> domain name is registered with Bulkregister, LLC. and that the Respondent is the current registrant of the name. Bulkregister, LLC. has verified that Respondent is bound by the Bulkregister, LLC. 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 December 15, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 4, 2007 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@gojeans.com by e-mail.

Respondent's Additional Submission was received and determined to be complete on January 9, 2007.

On January 11, 2007, 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.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Go Jeans™ is a registered trademark of the Complainant, Vanounou Clothing Inc. The trademark is used or will be used in the future with the following goods:

WEARING APPAREL, NAMELY, T-SHIRTS, SWEATSHIRTS, TANK TOPS, WOVEN SHIRTS, SWEATERS, CARDIGANS, VESTS, JACKETS, PANTS, SWEATPANTS, JEANS, SHORTS, HATS, CAPS, COATS, SCARVES, NECKERCHIEFS, NECK BANDS, WRIST BANDS, HEAD BANDS, GLOVES, BELTS, PAJAMAS, SHOES, SOCKS, UNDERWEAR, SWIM WEAR, AND TRUNKS; FOUNDATION GARMENTS, PANTYHOSE, TEDDIES, BRAS, SKIRTS, DRESSES, BLOUSES AND BIKINIS

The mark has been in use since June 1981, however, the earliest indicator of use of this mark is dated March 7, 2005 – this indicates that the Complainant was conducting business using the mark “Go Jeans™” before the Respondent registered the domain in April of 2006.

FACTUAL AND LEGAL GROUNDS

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

- [a.] The domain name gojeans.com registered by the Respondent is identical to the registered trademark (GoJeans™) of the Complainant. ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

- [b.] The Respondent uses the domain name to park advertisements (i.e. Google adsense advertisements) for click revenue. The Respondent is not making a legitimate noncommercial or fair use of the domain name, since the intent is for commercial gain by diverting the Complainant's consumers to the domain and thus increasing click revenue. Use of the name “Go Jeans” by the Respondent is

not for market recognition but is specifically to redirect customers of the Complainant to the advertisement site.

In fact, Google has stopped serving advertisements to the Respondent's domain following a complaint by the Complainant regarding the Respondent's unauthorized use of the trademark. The Respondent has found a different company to provide advertisements in Google's stead.

ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

- [c.] It seems that besides the click revenue from the domain, the Respondent also has registered or has acquired the domain name for the purpose of selling the domain name registration to the Complainant who is the owner of the trademark, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name. The Respondent offered to sell the domain to the Complainant for the amount of \$5000. It seems that the Respondent has done this before as can be seen from previous decisions against him. In previous disputes brought against the Respondent, the Respondent did not even bother to respond to the complaint (all those disputes were decided in favor of the Complainant). It may be that the Respondent understands that there is no evidence to be provided in his/her favor.

Additionally, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site, by creating a likelihood of confusion with the Complainant's website.

Thus, the domain name should be considered as having been registered and being used in bad faith.

B. Respondent

Respondent failed to submit a response to the Complaint.

C. Additional Submissions

Respondent made the following timely and helpful additional submission:

PRELIMINARY STATEMENT

Rule 7 permits "a party to submit [an] additional written statement[] within five (5) calendar days after the . . . last date the Response was due to be submitted to the forum." There is nothing in the rule that prohibits a Respondent from using Rule 7 in lieu of filing a timely response. This is not an amendment to the Response since no response at all has been filed and, thus, there is nothing to amend. See e.g. Chef2Chef, LLC v.

Realtimeinternet.com, Inc., No. 137710 (NAF Feb. 26, 2003)(Panel which received “no response by the response due date... in accordance with Forum Supplemental Rule 7 . . . considered the Additional Response.”);ⁱ Florists’ Transworld Delivery v. Domain Deluxe, No. 102751 (NAF Mar. 1, 2002)ⁱⁱ (Additional Statement filed by Respondent and considered after NAF issued notice of default); Rule 7 even permits a Respondent, who has not submitted a timely Response, to submit an additional statement responsive to a Complaint even after NAF has issued a Notification of Default.BPI Communications, Inc. et al. v. Boogie TV LLC, No. 105755 (NAF Apr. 30, 2002)(Where “[no] response was filed,” . . . Additional Statement of Respondent Pursuant to Rule 7 . . . considered the substantive Response in th[e] proceeding.”). There is no requirement that a Response be filed in order for a party to submit an additional submission pursuant to NAF Supplemental Rule 7. See Limco, Inc. et al. v. Rarenames et al., No. 99693 (NAF Nov. 27, 2001)(Complainants’ Additional Statement submitted before any Response was filed).ⁱⁱⁱ Accordingly, the Panel should consider this Additional Submission as the substantive response in this proceeding.

Even if the Panel does not accept this Additional Submission as the substantive response in this matter, there is ample precedent for the Panel to accept an untimely Response, and the Panel has the discretion to do so. This is in the interest of fairness and justice, as a decision to cause the forfeiture of valuable property should be decided on the merits and not by default. Mirama Enterprises Inc. et al v. Aroma Housewares Co., No 588486 (Jan. 16, 2006);^{iv} Bd. of Governors of the Univ. of Alberta v. Katz, D2000-0378 (WIPO June 22, 2000) (finding that a panel may consider a response which was one day late, and received before a panelist was appointed and any consideration made);^v Gaiam, Inc. v. Nielsen, No. 112469 (NAF July 2, 2002) (“In the interest of having claims decided on the merits and not by default and because Complainant has not been prejudiced in the presentation of its case by the late submission, Respondent’s opposition documents are accepted as timely.”).^{vi} Respondent did not intentionally fail to file a timely Response, the deadline was missed due to an administrative oversight.

I. SUMMARY OF ARGUMENT

This is a blatant case of reverse domain name hijacking. At the outset, this case should be dismissed because Respondent’s domain name registration precedes the date that Complainant filed an application for its trademark GO JEANS. The disputed domain name <gojeans.com> (the “Disputed Domain”) was registered on April 9, 2006. Complainant did not file for a trademark for “go jeans” until 3 months later. This, in and of itself, is a basis for finding reverse domain name hijacking, because it is well-established that bad faith registration cannot be established where the domain name pre-dates the trademark. Complainant and its counsel should have understood this and known there was no valid basis for a complaint under the Policy. Moreover, it appears that the only reason Complainant filed this trademark application was for the purpose of hijacking the Disputed Domain, since Complainant filed it just one day before it offered to purchase the domain name for \$300. Complainant has not proffered sufficient evidence of common law rights to this mark, merely submitting an invoice carrying the words “go jeans.” There is no evidence that Complainant had promoted the mark on a global scale

and certainly no evidence that Respondent had any knowledge of the mark. Accordingly, there is no factual support for the existence of a trademark for GO JEANS prior to April 9, 2006 and, thus, no basis whatsoever to support this Complaint.

Complainant cannot satisfy its burden of proof under any of the prongs of the Policy and the Complaint must, therefore, be dismissed. Respondent registered the Disputed Domain because it incorporates the descriptive term “go jeans” which is composed of two generic words. As noted in the Complaint, Respondent has hosted the Disputed Domain with Google, and now with Domain Sponsor, a third party service that places pay-per-click advertising links on the web page and shares the revenue earned with Respondent. Contrary to Complainant’s allegations this does not establish bad faith but, rather, establishes Respondent’s legitimate interest based on use in connection with the bona fide offering of goods and services. The links on the web site relate to clothing, which relates to the descriptive meaning of the Domain. The links were not selected in relation to Complainant’s trademark or its goods and services and there are no links for Complainant’s products. Respondent has registered over 90 domain names beginning with “go,” so it is clear that it did not register <gojeans.com> to target Complainant. Complainant alleges that Respondent registered the Disputed Domain to sell to Complainant. However, the evidence is that Respondent had no knowledge of Complainant, and Complainant had not even filed for a trademark, when Respondent registered the Disputed Domain. Respondent simply replied to Complainant’s unsolicited offer to purchase the domain. That certainly does not constitute bad faith—at least not on the part of Respondent.

In summary, Complainant cannot establish that Respondent lacks a legitimate interest in the Disputed Domain because it is a descriptive term and because it uses it in connection with the bona fide offering of goods and services. Nor has Complainant established that Respondent has registered or used the Disputed Domain in bad faith. Accordingly, the Complaint must be dismissed.

II. FACTS

Respondent registered the Disputed Domain on April 9, 2006. This is more than 3 months before Complainant filed a trademark application for GO JEANS on July 17, 2006. It is thus factually impossible for Complainant to prove that Respondent had knowledge of its trademark when it registered the Disputed Domain. Moreover, as shown below, the facts demonstrate that Complainant filed for the trademark solely to invoke the Policy in an attempt to reverse hijack the Disputed Domain. This inference can be drawn from the fact that Complainant filed its trademark application the day before an offer to purchase the Disputed Domain for \$300 was presented to Respondent on July 18, 2006. Respondent’s trademark application states that it has used “GO JEANS” in commerce since 1981.¹ The fact that Complainant allegedly used this trademark for 25 years, and filed its trademark one day before submitting an offer to purchase the Disputed Domain is a strong indicator that the mark was filed in connection

¹ It should also be noted that Complainant’s earliest evidence of the mark GO JEANS in commerce, as indicated in the Complaint, is an invoice dated March 7, 2005 – which brings into question the 1981 alleged first use date in the mark.

with Complainant's nefarious scheme to hijack the domain. The emails between the parties tell the story best.

On June 13, 2006, Complainant's representative Ben Kender – without identifying himself as the owner of any trademark -- emailed the following from the address kender15@yahoo.com.

Hello,

I would like to know if you are interested in selling the domain name gojeans.com.

Thank you

Respondent did not reply to this email. Subsequently, on July 18th Sedo.com, a company that represent parties interested in purchasing domain names, presented Respondent with an offer from Complainant to purchase the Disputed Domain for \$300. The email was as follows:

From: christian@sedo.com
Sent: Tuesday, July 18, 2006 1:51 PM
To: admin@vmerchant.net
Subject: Sedo Offer for gojeans.com

Dear Sirs at vMerchant.net,

I am contacting you on behalf of an individual who has expressed interest in acquiring the domain name "gojeans.com".

If you are in a position to authorize the sale of this domain, the interested party would like to submit an offer of \$300 USD for your consideration.

At your convenience, I would appreciate your response to this offer. You may contact me by replying to this message, or by calling me directly at +1.617.758.4267.

Thank you again for your time and attention. I will look forward to your receiving your reply.

Best regards,

Christian Pierce Kalled
Director of North American Brokerage

Respondent replied to Sedo that it would accept \$5,000 in the following email:

-----Original Message-----

From: Admin [<mailto:admin@vmerchant.net>]
Sent: Tuesday, July 18, 2006 1:58 PM
To: christian@sedo.com

Subject: RE: Sedo Offer for gojeans.com

\$5,000

Thanks

At this point, neither Complainant nor Sedo.com had advised Respondent of its identity or that it possessed a trademark for GO JEANS or for GO. Accordingly, Respondent had no knowledge that it was responding to an offer from a trademark owner. It was only after Respondent advised Sedo.com that it would accept \$5,000 that Complainant advised Sedo to advise Respondent of its purported trademark rights and legal claim. It is also very interesting to note that Sedo presented the initial offer to Respondent on July 18, 2006 – just one day after Complainant filed its trademark application for GOJEANS. This was no coincidence. It is clear that Complainant's trademark application was part of Complainant's effort to acquire the Disputed Domain.

Respondent registered the Disputed Domain because it incorporated the descriptive term "go jeans." Respondent registered "go jeans" because it is desirable to have a domain name with the word "go" in front of a generic product or service. The term alerts users that by "going" to the particular web site the user can find the designated product or service. Id. Clear and convincing evidence proving that Respondent did not target Complainant is the fact that Respondent has registered over 90 other domain names with starting with "go." Examples include: Go-airlines.com; gocalendar.com; godictionary.com; gofreemusic.com; gogrill.com; gohomeinsurance.com; gohoroscopes.com; gomortgage.com; goroses.com; gosoaps.com; and gorecipe.com.

Complainant has not proffered any evidence demonstrating that Respondent had knowledge of its trademark when it registered the Disputed Domain, or at anytime before Complainant contacted Respondent. Respondent did not register the Disputed Domain with Complainant's trademark in mind and had no knowledge of Complainant, its web site, its business name or trademark when it registered the domain name. Respondent did not register the Disputed Domain with the intent to disrupt Complainant's business, or to confuse consumers seeking to find Complainant's web site. Id. Respondent did not register the Disputed Domain to prevent Complainant from owning a domain name incorporating its trademark. Id. at 3. Respondent hosts the Disputed Domain with Domain Sponsor, which provides generic sponsored advertising links and shares the revenue earned from advertisers with Respondent. Id. at 4. The links are for generic clothing advertisements are not associated with Complainant's brand or trademark. Prior to the Disputed Domain being hosted with Domain Sponsor, the advertising links were provided by Google. As noted in the Complaint, Google ceased providing ads on the Disputed Domain because Complainant alleged it violated its trademark. This was not based on any independent determination on the part of Google.

III. BASES FOR RESPONDENT TO RETAIN REGISTRATION AND USE OF DISPUTED NAME

A. Complainant Does Not Have Enforceable Trademark Rights Under the Policy

Under the Policy, a Complainant must have trademark rights that predate the registration date of a disputed domain. Here, the application date for Complainant's trademark post-dates the registration date of the Disputed Domain by three months. Accordingly, Complainant's alleged mark provides no enforceable rights under the Policy with respect to the Disputed Domain. Business Architecture Group, Inc. v. Reflex Publishing, No. 97051 (NAF June 5, 2001) ("trademark rights . . . [must] predate the Respondent's domain registration")^{vii}; John Ode d/b/a ODE and ODE - Optimum Digital Enterprises v. Intership Limited, Case No. D2001-0074 (May 1, 2001);^{viii} CHF Industries, Inc. v. Domain Deluxe, No. 97532 (July 26, 2001).^{ix} Moreover, the facts raise the inference that Complainant applied for its trademark solely for the nefarious purpose of reverse hijacking the Disputed Domain. Complainant should not be permitted to benefit from the trademark fruit from this poisoned application tree. Accordingly, the Complaint must be summarily dismissed due to the lack of Complainant's enforceable trademark rights.

B. Respondent Has Rights And A Legitimate Interest In The Domain Name

The Disputed Domain incorporates the common descriptive term "go jeans." Respondent registered the Disputed Domain simply because it was descriptive, without any knowledge of Complainant or its mark. Respondent has registered over 90 other domain names that begin with "go." Respondent has chosen this pattern of domain names because "go" in front of the name of a product or service in a domain name indicates to Internet users that they can find the respective product or service at the corresponding "go" domain name. On these facts alone the Panel should find that Respondent has a legitimate interest, and dismiss the Complaint because such registration establishes the Respondent's legitimate interest. Tire Discounters v. tirediscounters.com supra. (Respondent has persuasively shown that its <tirediscounter.com> domain name is comprised of common terms and, in any event is not exclusively associated with Complainant"). Incorp Services, Inc. v. RareNames, WebReg, No. 559911 (NAF Nov. 10, 2005) ("Complainant's mark is not distinctive, and, therefore, Complainant should not be able to prevent others from using the term")^x. See also Energy Source Inc. v. Your Energy Source, Case No. 96364 (NAF Feb. 19, 2001)(YOURENERGYSOURCE.COM) (finding that Respondent has rights and legitimate interests in the domain name where "[r]espondent has persuasively shown that the domain name is comprised of generic and/or common descriptive terms, and, in any event, is not exclusively associated with Complainant's business").

As the Panel explained in HP Hood LLC v. hood.com, No. 313566 (NAF Nov. 9, 2004),^{xi} "[t]he principal that the mere ownership of a descriptive term domain should, in and of itself, establishes the owner's rights and legitimate interest has been recognized by several ICANN panels." Referring to the *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* (Oct. 24, 1999), the Panel explained that where the domain name "comprise[s] no more than a single, short, common descriptive term — the rights/interests inquiry is more likely to favor the domain name owner."

Respondent's legitimate interest is bolstered by the fact that it uses the Disputed Domain in connection with the bona fide provision of advertising services. Respondent uses the Disputed Domain to post generic advertising links. This constitutes use in connection with the bona fide offering of goods and services. In Williams, Babbitt & Weisman, Inc. v. Ultimate Search, No. 98813 (NAF Oct. 8, 2001),^{xii} the Respondent had registered numerous common words and descriptive terms to generate advertising revenue. In finding a legitimate interest, the panel noted that "[n]either the current UDRP nor current ICAAN registrar contracts preclude this type of domain name use." See also Dial-a-Mattress Operating Corp. v. Ultimate Search, No. D2001-0764 (WIPO Sept. 26, 2001),^{xiii} Etam, plc v. Alberta Hot Rods, D2000-1654 (WIPO Jan. 31, 2001),^{xiv} GLB Servicios Interativos S.A. v. Ultimate Search, No. D2002-0189 (WIPO May 29, 2002),^{xv} See also The Landmark Group v. Digimedia L.P., No. 285459 (NAF Aug. 6, 2004);^{xvi} Sweeps Vacuum & Repair Center, Inc. v. Nett Corp., No. D2001-0031 (WIPO Apr. 13, 2001).^{xvii} It is irrelevant that Google turned off the advertisements on the Disputed Domain. Google did so only upon the request of Complainant, and there is no indication that Google rendered any opinion on the trademark issue, nor should any opinion by Google carry any weight in this forum in any event.

Accordingly, because Respondent has a legitimate interest in the Disputed Domain, the Complaint should be denied.

C. Complainant Has Not Demonstrated That The Domain Name Was Registered and Is Being Used In Bad Faith

Respondent registered the Disputed Domain on April 9, 2006, more than 3 months before Complainant a trademark application for GO JEANS. It is well established that a Complainant cannot meet its burden of proving bad faith registration of domain name that is registered prior to the date of a trademark application. Proto Software, Inc. v. Vertical Axis, Inc., No. D2006-0905 (WIPO Oct. 10, 2006) ("Complainant in this case cannot demonstrate bad faith registration of the disputed domain name. The disputed domain name was registered approximately 3 years prior to the application for registration of the Complainant's trademark, and more than 4 years prior to the Complainant's first use in commerce.");^{xviii} Intune Media Group LLC v. Vertical Axis, Inc., No. 385881 (March 2, 2005).^{xix} Bad faith registration cannot be proven because it is impossible for Respondent to have had knowledge of Complainant's mark when it registered the Disputed Domain, because no mark was in existence at the time. HQ Holdings, LLC v. Equicorp, Inc., No. 256402 (NAF June 15, 2004) ("given the absence of any trademark rights owned by Complainant at the time Respondent registered the domain name, Respondent could not have registered the domain name in bad faith as to Complainant as required by Policy ¶4(a)(iii).").^{xx} See also Carsales.com.au v. Flanders, No. D2004-0047 (WIPO Apr. 8, 2004)^{xxi}; Mytech Partners, Inc. v. Jebs Corp., No. 135645 (NAF Feb. 7, 2003);^{xxii} NetDeposit, Inc. v. NetDeposit.com, No. D2003-0365 (WIPO July 22, 2003) ("the Panel finds the Respondent could not have registered the disputed domain name in bad faith since the Complainant's trademarks did not exist at the time.");^{xxiii} John Ode et al. v. Intership Limited, Case No. D2001-0074 (WIPO May 1,

2001). AKCTS Television Inc. v. Get-on-the-Web Ltd., Case No. D2001-0154 (WIPO April 20, 2001)(“the Panel finds it difficult to infer that Respondent knew of the Complainant at the date of registration of the name . . .”). Futureworld Consultancy Pty Ltd. v. Online Advice, No. D2003-0297 (WIPO July 18, 2003)(“there is no evidence to show that the disputed domain was registered with the Complainant in mind...”).^{xxiv} Because the Disputed Domain was registered prior to the date Complainant applied for its trademark, it cannot possibly be established that the Disputed Domain was registered in bad faith. Accordingly, the Complaint must be denied.

Notwithstanding the impossibility of Complainant meeting its burden of proof, it is important to note that its specific allegations of bad faith registration and use fail as well. There is no evidence demonstrating that Respondent had knowledge, or should have had knowledge, of Complainant’s trademark when it registered the Disputed Domain. Absent evidence of such knowledge, or the basis for constructive knowledge, on the part of Respondent, bad faith cannot be proven. As explained in the 3-member panel decision in Mess Enterprises v. Scott Enterprises, Ltd., Case No. D2004-0964 (WIPO Jan. 25, 2005):

to prove bad faith registration under the Policy, it must be proven that a domain name was registered with a complainant’s trademark in mind. Since the Complainant here failed to demonstrate that the Respondent had any prior knowledge of the Complainant’s mark [] or the Complainant’s business operations in 1998, then the Respondent clearly did not register the name in bad faith. Further, since the Complainant filed its application to register its mark after the Respondent registered the disputed domain name, the Respondent could not have had any constructive notice of that mark when it registered the name. (emphasis added).

See also Futureworld Consultancy Pty Ltd. v. Online Advice, No. D2003-0297 (WIPO July 18, 2003)(“there is no evidence to show that the disputed domain was registered with the Complainant in mind...”).^{xxv}

Complainant makes the hollow argument, without any supporting facts, that Respondent has acted in bad faith by intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant’s mark. Respondent had no knowledge of Complainant or its trademark and nothing appearing on the web site creates an impression of an association with, or sponsorship by, Complainant. An allegation of bad faith under Paragraph 4(a)(iii) of the Policy must be supported by evidence. Complainant has proffered none. Lumena s-ka zo.o. v. Express Ventures LTD, Case No. 94375 (NAF May 11, 2000)(“no direct evidence that Respondent registered the [generic] domain name with the intent of capitalizing on Complainant’s trademark interest”).^{xxvi}

Complainant is flat out wrong that Respondent's reply to its unsolicited offers to buy the Disputed Domain constitute bad faith. Under the Policy, a Complainant must prove that Respondent registered the Disputed Domain with the intent to sell it to Complainant. Complainant contacted Respondent – not the other way around. It is Complainant, not Respondent, who has acted in bad faith. Several panels have rejected this malicious tactic of attempting to manufacture bad faith by baiting a domain owner into a sales negotiation. See Also General Machine Prods Co. v. Prime Domains, Case No. 92531 (NAF Jan. 26, 2000)(CRAFTWORK.COM);^{xxvii} Piper.com The New Piper Aircraft, Inc. v. Piper.com, No.FA94367 (NAF May 2, 2000).^{xxviii} Pocatello Idaho Auditorium District v. CES Marketing Group, Inc., Case No 103186 (NAF Feb. 21, 2002)^{xxix} had a similar set of facts to those here. There, the trademark owner contacted the respondent inquiring if it was willing to sell the disputed domain name. The respondent replied that it was willing to consider selling it for \$50,000. As here, the complainant alleged that the offer constituted bad faith registration. The 3-member panel disagreed, noting that there was “no evidence that [r]espondent registered the name for such purpose [and that] . . . the Complainant, itself, actually initiated the inquiry for purchase.” The panel held that this did not constitute bad faith, noting that there are “numerous ICANN decisions which have recognized the owner of a domain name has a legal right to sell a domain name when asked if he or she is will transfer or sell it.” Here, Complainant simply did not like the Respondent's price. Finally, it should also be noted that Complainant never identified itself in its email exchanges with Respondent, and did not state it held a trademark, nor did Sedo, prior to Complainant replying to Complainant's offer to purchase the Disputed Domain.. Therefore, Respondent did not know it was dealing with a trademark owner and could not have engaged in bad faith because it's only constitutes bad faith under the Policy to register a domain name with an intent to sell it to a trademark owner. Of course, as noted above there was no trademark when Respondent registered the Disputed Domain so even if the offer to sell the Disputed Domain were initiated by Respondent this would not prove bad faith registration.

Finally, in an attempt to prejudice Respondent, Complainant points to other decisions involving this Respondent. Other decisions simply are not relevant in a UDRP proceeding. An administrative panel must decide “each case on its own merits.” EPLAN Software & Service GmbH & Co K.G. v. Chad Folkening, ECORP.com, Inc E-PLAN, and ECAST, Case No. D2000-0806 (WIPO Sept. 28, 2000).^{xxx} As noted by the 3-member panel in Sustainable Forestry Management Limited v. SFM.com, et al., No. D2002-0535 (WIPO Sept. 13, 2002):^{xxxi}

The Complainant has referred to various other Panel decisions which it says show that the Respondent has acted in bad faith with regard to domain names on other occasions. However, the Panel must deal with this case on its own merits, and we cannot take into account decisions made in other cases on the basis of different evidence and submissions

Accordingly, this Panel should find that Respondent's reply to Complainant's unsolicited purchase inquiry does not constitute bad faith.

D. Complainant Has Engaged in Reverse Domain Name Hijacking

A finding of Reverse Domain Name Hijacking is warranted where “the Complainant knew or should have known at the time it filed the Complaint that it could not prove that the domain name was registered in bad faith.” Futureworld Consultancy Pty Ltd. v. Online Advice, No D2003-0297 (WIPO July 18, 2003).^{xxxii} Here, the Disputed Domain incorporates a descriptive term. Moreover, the Disputed Domain was registered 3 months before the Complainant filed its application for the mark. This supports a finding of Reverse Domain Name Hijacking. Carsales.com.au v. Flanders, *supra*. (“[A] finding of reverse domain name hijacking is . . . particularly appropriate where the Respondent’s registration of the domain name predates the very creation of the Complainant’s trademark.”) NetDeposit, Inc. v. NetDeposit.com, *supra*. (finding reverse domain name hijacking, and noting “there are many, many previous cases where panels have found there was bad faith in filing a Complaint under the Policy when the Respondent’s domain name registration preceded the Complainant’s creation of its trademark rights.”). Worst of all, the evidence demonstrates that Complainant filed for its trademark just one day before it made an offer to purchase the Disputed Domain, indicating the application was filed solely for purpose of invoking the Policy in the event it could not purchase the domain name. In another case with very similar facts, the Panel called such activity “one of the most egregious examples of reverse domain name hijacking.” Mess Enterprises v. Scott Enterprises Ltd., *supra*. As the panel explained there with words very fitting here:

this Panel finds that the Complainant had no trademark rights at the time the Respondent registered the domain name, and knew it and, in spite of that knowledge, then proceeded to intentionally secure a trademark registration with an express purpose of fraudulently invoking the Policy as a means to wrest the disputed domain name from the Respondent, by an order of transfer from an administrative panel, if the Respondent’s sales price was too high (which at \$25,000 it evidently was). To the Panel, this conduct constitutes a clear abuse of the Policy.

Accordingly, in addition to denying the Complaint, the Panel should issue a decision holding that Complainant has engaged in Reverse Domain Name Hijacking.

Complainant submitted the following timely and helpful additional response on January 17, 2007:

I. PRELIMINARY STATEMENT

In compliance with rule 7(f) of the NAF Supplemental rules, this Additional Submission is not an amendment to the Complaint since the Complainant’s position has not changed and, thus, there is nothing to amend. This submission is only to elaborate and clarify the complaint, and to supplement the evidence. Historically, the Respondent has not bothered to respond to similar disputes (at least 61 previous disputes) and thus a response was not

expected. As such, a decision was made to limit the time and expense incurred to pursue this dispute. The Complainant has invested additional time and expense to further anchor the validity of the case with supplemental evidence.

Since this dispute is brought before an arbitration panel and not a court of law, the Complainant was under the impression that the techniques allowable under the technicalities of the court's rules are not applicable to this dispute. Additionally, since there has been a change in the rules since the date of the referenced cases, it is inappropriate to reference precedents that are based on amended rules. As such, using precedents to justify for similar allowances to bend the rules of the Arbitration Panel should not be allowed. Each case should be decided on its own merit: only in the case of extenuating circumstances should the allowance of non-compliance with the rules be considered. Regardless, the Complainant will attempt to demonstrate how potentially applicable precedents are in fact non-applicable.

B. Additional Submission of Respondent is not valid, and is in fact the Response.

Respondent did not respond by the deadline assigned to the case; instead, the whole of the response was submitted as an "Additional Submission." The referenced precedents allowing this type of behavior were most likely due to the extenuating circumstances of the situation. Respondent's assertion, "Respondent did not intentionally fail to file a timely Response, the deadline was missed due to an administrative oversight," is highly questionable due to the vast history of at least **61** previous disputes against the Respondent not being responded to (further discussion of Respondent's case history will follow in upcoming sections).

Respondent asserts that "there is nothing in the rule that prohibits a Respondent from using Rule 7 [of the NAF Supplemental Rules] in lieu of filing a timely response." Case referenced was Limco, Inc. et al. v. Rarenames et al., No. 99693 (NAF Nov. 27, 2001) ^{xxxiii} (Complainants' Additional Statement submitted before any Response was filed)². However, the case referenced only indicates an allowance of an Additional Statement by the Complainant before a response. There is no mention of an allowance of the submission by the Respondent IN LIEU OF a response. Thus the assertion of the Respondent that the case of Limco, Inc. et al. v. Rarenames et al. is a precedent to allow Respondent's Additional Submission is false. In fact, "Additional Submission" implies that the submission is in addition to a previous filing. Using the Additional Submission as the whole of the response would be in contrary to the Rules barring valid extenuating circumstances. Complainant disputes the validity of attributing the label of "extenuating circumstances" to this situation, since the Respondent has a vast history of at least **61** disputes against it where there was no response. Thus it is highly questionable that in this case, in exception to all the other 61 disputes against it, the Respondent indeed has failed to file a timely response due to an "administrative oversight." Complainant additionally would like to point out to the Panel the Respondent's (and its counsel's) brazen use of

² Listed in Table 2 are URLs to Decisions cited herein. The Decisions can be accessed on the Internet by clicking the links in an electronic version of this Response.

inapplicable cases to bolster its position. **Such piling-on of cases to bolster Respondent's position by sheer volume is inappropriate. This is the first of many examples of such behavior.**

Respondent also references the case of Chef2Chef, LLC v. Realtimeinternet.com, Inc., No. 137710 (NAF Feb. 26, 2003).^{xxxiv} This case indicates that the decision of the Panel to allow the "Additional Statement . . . considered the substantive Response in th[e] proceeding" was based on the case of BPI Communications, Inc. et al. v. Boogie TV LLC, No. 105755 (NAF Apr. 30, 2002).^{xxxv} Thus the referencing of the first case of Chef2Chef, LLC v. Realtimeinternet.com, is itself only a reference to second case and should not be considered. Only the second case of BPI Communications, Inc. et al. v. Boogie TV LLC is a potentially valid reference. Respondent proceeds to reference this case of BPI Communications, Inc. et al. v. Boogie TV LLC, but, in exclusion to other cases referenced, the Respondent does not provide a hyperlink allowing an examination of the case (most likely because the case decision is no longer available on the internet). Without properly examining the case of BPI Communications, Inc. et al. v. Boogie TV LLC to determine the extenuating circumstances involved, it would be impossible to make a comparison between that situation and this one. The Respondent does not indicate what the exact circumstances of the non-hyperlinked case were, thus it is doubtful that the Respondent actually has a copy of the case decision. Again, the Respondent has referenced a case that does not clearly demonstrate the similarity of this dispute to the referenced case. **Regardless, it is highly unlikely that extenuating circumstances exist in this case, as the Respondent's vast history of at least 61 cases where the Respondent did not respond, indicates that the Respondent never intended to respond, but did so as an afterthought.**

Respondent also references the case of Florists' Transworld Delivery v. Domain Deluxe, No. 102751 (NAF Mar. 1, 2002).^{xxxvi} First and foremost, the dispute was settled without the Panel. The Respondent, Domain Deluxe, transferred the domain to the Complainant, Florists' Transworld Delivery, on January 16, 2002, and the additional submission was submitted on February 5, 2002, twenty days after the dispute was resolved! Most likely, the submission was to notify the Panel of the transfer by providing the confirmation email from the registrar dated January 16, 2002. Thus the "acceptance" of the additional submission in the referenced case can hardly be considered as similar to this dispute. *The Respondent has not only failed to demonstrate the acceptability of the additional submission, Respondent and counsel has also brazenly referenced cases that are not in any way similar to this dispute.* Accordingly, Complainant petitions the Panel to disregard the Respondent's Additional Submission in the evaluation of this case.

C. **Untimely Response of Respondent should not be allowed.**

Respondent also asserts "there is ample precedent for the Panel to accept an untimely Response." First referenced case is Mirama Enterprises Inc. et al v. Aroma Housewares Co., No 588486 (NAF Jan. 16, 2006),^{xxxvii} again a case that itself references the other cases referenced, and thus is not a valid reference.

The next case referenced, Bd. of Governors of the Univ. of Alberta v. Katz, D2000-0378 (WIPO June 22, 2000)^{xxxviii} (finding that a panel may consider a response which was one day late), is a special allowance for one day late NOT five days late. There are many possible nearly-valid excuses for a lateness of one day. Five days late is not readily excusable. Again, the case referenced is not similar to this dispute.

The last case referenced is Gaiam, Inc. v. Nielsen, No. 112469 (NAF July 2, 2002).^{xxxix} The extenuating circumstances of that case, as discussed in the case decision, is “Respondent claims that he did not receive the documents pertaining to this case until May 29 and that his time to respond should run from that date.” As discussed before, it is highly unlikely that the Respondent of this dispute planned to respond at all, based on the previous ### [sic] disputes against the Respondent not having a response submitted. Thus, the Respondent has a highly questionable, weak claim of extenuating circumstances in this dispute, allowing for an acceptance of a late response.

As mentioned in *Section A* above, there is no validity in accepting Respondent’s submission as an “Additional Submission.” In fact, Respondent does feel that the submission was a Response and not an “Additional Submission.” This is evidenced by the name of the files submitted by email: “gojeans.com response.doc” and “gojeans.com response.pdf.” Further evidence is the statement within the document: “Accordingly, the Panel should consider this Additional Submission as the substantive response in this proceeding (emphasis added).” The Respondent’s very weak evidence that this is a situation of extenuating circumstances does not justify accepting a response five days late. Accordingly, Complainant petitions the Panel to refuse acceptance of Respondent’s submission in the evaluation of this dispute.

II. CLARIFICATION OF COMPLAINT

A. Domain name is identical to trademark of Complainant

“Go” is the primary trademark of Vanounou Clothing Inc., registered under registration number 3,089,349. The trademark “Go” was filed on June 6, 2005, about 10 months before registration of domain “gojeans.com” by Respondent. “Go” is a trademark registered to apply to numerous garments with the inclusion of jeans. Complainant included a copy of this trademark information in its original submission as “*Annex B*.”

“Go Jeans” piggybacks on the fanciful portion of the trademark “Go” and has the same goods including jeans. In fact, the “Go Jeans” trademark file includes the clause: “Prior registrations: 3,089,349,” the registration number for the trademark “Go”. “Go Jeans” was filed to prevent further litigation where due to ignorance, “Go Jeans” would be used in violation of Complainant’s trademark. Complainant prefers to settle disputes with reasonable discussion, as is evidenced by its offer to Respondent to be reimbursed for costs. “Go Jeans” was also filed to indicate Complainant’s determination in protecting its trademark rights. IT WAS NOT FILED TO ATTEMPT REVERSE DOMAIN NAME HIJACKING!

“Go Jeans” has been in business since 1981. For purposes of overcoming domain name disputes, Vanounou Clothing Inc. (Complainant) will present evidence of use as early as December 2004 which significantly predates the registration date of the domain name in dispute. Use of the mark “Go Jeans” since over a year before Respondent registered the domain name “gojeans.com” gives Vanounou Clothing Inc. valid trademark rights to the mark “Go Jeans”. Respondent’s vast history of not responding to at least 61 previous disputes is the reason why more evidence was not originally provided. The collection of the supplemental evidence required a significantly large investment in time and cost that originally was thought unnecessary. Attached (*Annex K*) is nearly 40 pieces of evidence indicating “Go Jeans” has been in business since at least December 2004.

“Go” is a fanciful portion of Vanounou Clothing’s trademark and the combination terms “Go Jeans” is also a fanciful term which is protectable by Vanounou Clothing Inc. (Complainant) and is infringed by the domain name of Cayman Trademark Trust (Respondent). Respondent has a vast course of history of registering trademarks of other people See e.g. The Fresh Market Inc. v. Modern Limited-Cayman Web Development a/k/a Cayman Trademark Trust, No 2030205 (NAF December 4, 2003) – Decision references another decision against this Respondent:

Respondent registered and is using the Domain Name with the intent to profit from the goodwill attributable to the Trade Mark. In the case of *Georgia Boot LLC v. Modern Limited – Cayman Web Development*, FA149173 (Nat. Arb. Forum Apr. 21, 2003), it was found that the Respondent had registered over 2,200 domain names, that the Respondent is in the business of acquiring and selling domain name registrations, that many of the domain names registered to the Respondent are identical or confusingly similar to valuable, registered and famous trade marks and that the Respondent hopes to profit from the resale of its infringing domain name registrations to the owners of the trade marks.

To also quote the originating case for this reference (also against the same Respondent), *Georgia Boot LLC v. Modern Limited – Cayman Web Development*, FA149173 (Nat. Arb. Forum Apr. 21, 2003)^{x1}:

Based on Complainant’s research, the validity of which is uncontested, Respondent has registered over 2,200 domain names and is in the business of acquiring and selling domain name registrations. As stated, many of Respondent’s domain names appear to be identical or confusingly similar to valuable, registered and famous trademarks, examples of which are provided in the Findings. Respondent has failed to advance any conceivable reason for registering so many well-known trademarks and personal names as domain names. Therefore, the Panel is permitted to accept Complainant’s contentions as true, namely, that Respondent hopes to profit from the resale of its infringing domain name registrations to the owners of the trademarks. Thus, Respondent’s registration and use of the **<georgiaboots.com>** domain name, with the intent to profit from the goodwill attributable to

Complainant's registered mark, constitutes bad faith under Policy ¶4(b)(i). *See 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"); *see also Educ. Testing Serv. v. TOEFL*, D2000-0044 (WIPO Mar. 16, 2000) (finding that a general offer of sale combined with no legitimate use of the domain name constitutes registration and use in bad faith); *see also Am. Anti-Vivisection Soc'y v. "Infa dot Net" Web Serv.*, FA 95685 (Nat. Arb. Forum Nov. 6, 2000) (finding that "general offers to sell the domain name, even if no certain price is demanded, are evidence of bad faith").

Contrary to Respondent's assertions, it is clear from the vast history of Respondent's behavior that Respondent in fact must have been aware of Complainant's mark "Go Jeans," and specifically registered the domain name "gojeans.com" to target Complainant's customers. As such, Respondent is exercising extreme bad faith in its registration of the domain name "gojeans.com".

Respondent's asserts that "gojeans.com" was registered as two generic words – "go" and "jeans." Although this potentially may be arguable, Respondent's vast case history of at least ### [sic] previous disputes indicates the most likely "faith" at the time of registration. Precedents also indicate the unacceptability of claiming that the domain name is composed of generic terms. Respondent has not provided sufficient (if any) evidence that registration of "gojeans.com" was unlike the domain registrations of up to 2,200 other trademarks owned by others. References: Atlanta National League Baseball Club, Inc. v. Braves Cleaning Service and Lindsey Crawley, No 319615 (NAF October 28, 2004)^{xli}: Decision references decision in a different dispute:

"Respondents' assertion that a registrant "ipso facto has a legitimate interest" if the domain name at issue is a common word is incorrect. "[A] respondent should not be permitted to establish legitimate rights and interests in a domain name that is identical to complainant's registered, incontestable trade or service mark on the ground that the trademark or service mark is [a] 'common generic word.'" BPI Communications, Inc. v. Boogie TV LLC, No. 105755 (NAF April 30, 2002) (transferring <billboard.tv> domain name to owner of BILLBOARD family of marks)"

To summarize, Complainant has clarified how Respondent's ownership of "gojeans.com" infringes on Complainant's trademark rights. Complainant has also shown strong evidence that the Respondent specifically targeted Complainant and did not use generic terms.

B. Respondent has no rights or legitimate interests in respect of the domain name

As admitted by Respondent, Respondent uses “gojeans.com” to park advertisements to clothing. Examination of the site when hosted by Google adsense showed advertisements linking to [jeans](#). As mentioned above, Respondent’s vast case history of registering other people’s trademarks indicates Respondent’s knowledge of Complainant’s trademark, and that Respondent registered “gojeans.com” to attract Complainant’s customers. Customers that clicked on the advertisements for jeans would create revenue shared by the Respondent with the advertisement parking service. Since registration of the domain name was in bad faith, and the domain name is being used to generate revenue – a commercial endeavor, it follows that the Respondent is using the domain name without trademark rights and without legitimate non-infringing (on Complainant’s trademark) interests. Respondent obviously does not have market recognition as “Go Jeans,” as the Respondent wishes to divert Complainant’s customers by using the Complainant’s trademark. Complainant does have market recognition as “Go Jeans,” and thus Respondent specifically is trying to profit from Complainant’s market recognition. Precedents have shown that using an advertisement parking service for commercial gain is not a legitimate endeavor if the domain registration was in bad faith. See e.g. Chef2Chef, LLC v. Realtimeinternet.com, Inc., No. 137710 (NAF Feb. 26, 2003):

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 AltaVista v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000) (finding that use of the domain name to direct users to other, unconnected websites does not constitute a legitimate interest in the domain name).

...

Respondent is using Complainant’s mark for commercial gain by posting advertisements on a website that is confusingly similar to Complainant’s mark, and that such use does not constitute a legitimate use but instead is evidence of bad faith use and registration pursuant to Policy ¶4(b)(iv). *See Bama Rags, Inc. v. Zuccarini*, FA 94380 (Nat. Arb. Forum May 8, 2000) (finding bad faith where the Respondent attracted users to advertisements); *see also ESPN, Inc. v. Ballerini*, FA 95410 (Nat. Arb. Forum Sept. 15, 2000) (finding bad faith where the Respondent linked the domain name to another website <iwin.com>, presumably, the Respondent received a portion of the advertising revenue from site by directing Internet traffic to the site, thus using a domain name to attract Internet users, for commercial gain).

Complainant also alleged that Respondent has exhibited a pattern of preventing trademark holders from reflecting their marks on the Internet,

which is evidence of bad faith use and registration pursuant to Policy ¶4(b)(ii). *See Armstrong Holdings, Inc. v. JAZ Assoc.*, FA 95234 (Nat. Arb. Forum Aug. 17, 2000) (finding that the Respondent violated Policy ¶4(b)(ii) by registering multiple domain names, which infringe upon others' famous and registered trademarks); *see also America Online, Inc. v. iDomainNames.com*, FA 93766 (Nat. Arb. Forum Mar. 24, 2000) (finding a bad faith pattern of conduct where Respondent registered many domain names unrelated to its business which infringe on famous marks and websites).

Further proof of this is seen in a previous dispute against the Respondent, The Fresh Market Inc. v. Modern Limited-Cayman Web Development a/k/a Cayman Trademark Trust, No 2030205 (NAF December 4, 2003),^{xiii} regarding advertisement parking: "Such use is not a bona fide offering of goods and services as contemplated under the [UDRP] Policy."

Besides the parking of advertisements, the Respondent's vast case history of at least **64** disputes indicates that the Respondent is also in the business of buying and selling domains. See previous dispute involving Respondent: The Fresh Market Inc. v. Modern Limited-Cayman Web Development a/k/a Cayman Trademark Trust, No 2030205 (NAF December 4, 2003) (Respondent is in the business of acquiring and selling domain name registrations, that many of the domain names registered to the Respondent are identical or confusingly similar to valuable, registered and famous trade marks and that the Respondent hopes to profit from the resale of its infringing domain name registrations to the owners of the trade marks.) Registering a domain to resell the domain to the trademark owner is without question not a legitimate interest in respect of the domain name. Complainant has clearly shown how Respondent has no legitimate interests or rights in respect of the domain name.

C. Domain name has been registered and is being used in bad faith

Respondent has a vast case history of registering other people's trademarks. In the above referenced dispute against the Respondent, the Complainant presented evidence of Respondent registering up to 2,200 trademarks belonging to others ("Respondent has registered over 2,200 domain names and is in the business of acquiring and selling domain name registrations. As stated, many of Respondent's domain names appear to be identical or confusingly similar to valuable, registered and famous trademarks"). Respondent is known by a few names: "Cayman Trademark Trust", "Modern Limited-Cayman Web Development", "Domain Admin or Domain Administrator", and "Generic Search Terms" (sources provided as *Annex L*). Complainant's limited research based on these names has produced the following information: Respondent has had at least 64 disputes against it, of which only 3 received a response, and of which **none** were decided in its favor. List of hyperlinks to case decisions is annexed as *Annex M*. There is no doubt that additional research would provide a history of more cases.

Respondent has been shown to be in the business of buying and selling domains (not

necessarily excluding trademark owners of the domain name) and as such should not have offered to sell domain “gojeans.com” to Complainant regardless of solicitation.

History of disputes against Respondent show that Respondent commonly registers other’s trademarks, and contrary to Respondent’s assertions, it is clear from the vast history of Respondent’s behavior that Respondent in fact was aware of Complainant’s mark “Go Jeans,” and specifically registered the domain name “gojeans.com” to target Complainant’s customers, and intending an eventual sale of the domain to the trademark owner – the Complainant.

Case history indicates the high likelihood of bad faith at the time of registration. See EPLAN Software & Service GmbH & Co K.G. v. Chad Folkening, ECORP.com, Inc E-PLAN, and ECAST, Case No. D2000-0806 (WIPO Sept. 28, 2000)^{xliii}:

In the *Europay [Europay International SA .v. Eurocard.com Inc]* case the Panel found that the Respondent Folkening had engaged in a pattern of conduct consisting of registering Domain Names that incorporate trade marks owned by others not for legitimate commercial or non-commercial purposes, that such activities constituted registration and use in bad faith within the meaning of paragraph 4a(iii) of the Policy and were "consistent with the profile of a cybersquatter".

Also, the Respondent in this case did not provide its true name when registering the domain (whois information says “Domain Admin”), which is also evidence of bad faith as indicated in the same referenced case just mentioned:

Folkening used a fictitious name when registering the domain name in issue in the *Home Director* case in order to hide his true identity, which the Panel held in that case evidenced *bad faith* for the purposes of paragraph 4a(iii) of the Policy.

Lastly, the Respondent in this case did not solicit trademark owner (Complainant) to sell domain most likely because Respondent is aware of the consequences of such solicitation. Again seen in the just referenced case above:

Folkening, has established a pattern of conduct of offering to sell domain names to trademark owners for consideration in excess of his documented out of pocket costs [Policy paragraph 4b(ii)]. This was found to be evidence of *bad faith* in both the *Home Director* and *Southern Company* cases. In the *Europay* case no offer to sell the disputed domain name was made. The Complainant says this was because the Respondent has learned from earlier cases that such an offer could constitute evidence of registration and use in *bad faith*.

Complainant has fully clarified Respondent’s bad faith registration of “gojeans.com.”

III. RESPONSE TO CHARGE OF REVERSE DOMAIN NAME HIJACKING

Respondent has charged Complainant with Reverse Domain Name Hijacking. This charge is solely based on an assertion that Complainant does not have trademark rights. Since Complainant has demonstrated trademark rights, both with supplemental evidence, and clarification of rights, there is no basis for the charge of Reverse Domain Name Hijacking. As such, the charge should be ignored.

FINDINGS

The Panel makes the following findings:

- (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.

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 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.

While Respondent did not submit a Response, Respondent submitted an Additional Submission in a timely manner according to The Forum’s Supplemental Rule 7. Respondent asserts Supplemental Rule 7 does not prohibit a Respondent from submitting its Additional Submission in lieu of filing a timely Response. In *Chef2Chef, LLC v. Realtimeinternet.com, Inc.*, FA 137710 (Nat. Arb. Forum Feb. 26, 2003) and *BPI Commc’n, Inc. v. Boogie TV, LLC.*, FA 105755 (Nat. Arb. Forum Apr. 30, 2002), the panels found that pursuant to Supplemental Rule 7 the panel could consider an additional submission even when the respondent failed to submit a timely response. The Panel elects to consider Respondent’s Additional Submission as its substantive response.

For the purposes of this proceeding, the Panel finds the following facts:

Complainant claims a first use in June, 1981, but has no evidence to confirm this date.

Complainant has produced a December 27, 2004 invoice that uses the name “Go Jeans” at the top (along with a claim of being in business since 1981). The phrase “Go Jeans” as certainly being used as a tradename, even if the Panel was some questions about its use as a trademark. Undated photographs of the GO JEANS mark on a storefront were also submitted.

Complainant has produced a variety of business items both from it and to it, all of which seem to use the GO JEANS mark as a tradename for Complainant.

Complainant filed an application with the United States Patent and Trademark Office (“USPTO”) on June 6, 2005 for the GO mark.

An August 17, 2005 American Express bill addressed to Go Jeans (*inter alia*) as a business address was produced.

Respondent registered the <gojeans.com> domain name on April 9, 2006. Respondent has registered some 90 domain names which start with the phrase “Go.”

The USPTO registered the GO mark to Complainant on May 9, 2006.

Complainant initially inquired on June 13, 2006 about purchasing the <gojeans.com> domain name from Respondent.

Complainant filed a trademark application with the USPTO on July 17, 2006 (which recites an initial use date of June 1981). This application remains pending and no registration has been issued for the GO JEANS mark.

Identical and/or Confusingly Similar

Complainant is not required to hold a registered trademark in its GO JEANS mark to establish rights in the mark. Rights in a tradename are sufficient rights to the mark under the UDRP. Common law rights in a mark are sufficient to satisfy Policy ¶4(a)(i). *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); *see also British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy “does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names” and applying the Policy to “unregistered trademarks and service marks.”).

Complainant’s rights must predate Respondent’s registration of Respondent’s domain name. Complainant asserts it has conducted business continuously and extensively using the GO JEANS mark since 1981 in association with the sale of jeans and numerous other types of apparel. While Complainant has not submitted proof of the 1981 date, it has submitted proof that pre-dates Respondent’s registration of the domain name. The Panel

finds Complainant holds common law rights to the GO JEANS mark as evidenced by secondary meaning in the mark, establishing rights in the mark pursuant to Policy ¶4(a)(i). *See 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); *see also S.A. Bendheim Co., Inc. v. Hollander Glass*, FA 142318 (Nat. Arb. Forum Mar. 13, 2003) (holding that the complainant established rights in the descriptive RESTORATION GLASS mark through proof of secondary meaning associated with the mark). This finding would not have been possible without the facts contained in Complainant’s additional submission.

Respondent’s <gojeans.com> domain name uses Complainant’s GO JEANS mark in its entirety, merely adding the generic top-level domain “.com” to the mark. Respondent’s domain name is identical to Complainant’s mark because the addition of a top-level domain is irrelevant. The Panel finds the disputed domain name is identical to Complainant’s mark pursuant to Policy ¶4(a)(i). *See Daedong-USA, Inc. v. O’ Bryan Implement Sales*, FA 210302 (Nat. Arb. Forum Dec. 29, 2003) (“Respondent’s domain name, <kioti.com>, is identical to Complainant’s KIOTI mark because adding a top-level domain name is irrelevant for purposes of Policy ¶4(a)(i).”); *see also Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant’s mark because the generic top-level domain (gTLD) “.com” after the name POMELLATO is not relevant).

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

Rights or Legitimate Interests

Complainant’s assertion Respondent lacks rights or legitimate interests in the disputed domain name establishes a *prima facie* case pursuant to the Policy, shifting the burden to Respondent to demonstrate that it does have rights or legitimate interests as contemplated by Policy ¶4(c). *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (holding that, where the complainant has asserted that respondent does not have rights or legitimate interests with respect to the domain name, it is incumbent on respondent to come forward with concrete evidence rebutting this assertion because this information is “uniquely within the knowledge and control of the respondent.”); *see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO, Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent does not have rights or legitimate interests is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist).

Complainant contends Respondent is using the <gojeans.com> domain name solely to display various advertisements unrelated to Complainant’s goods. Complainant argues this use of the disputed domain name constitutes neither a *bona fide* offering of goods and services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶4(c)(iii). The Panel finds Respondent lacks rights or legitimate interests as outlined in Policy ¶¶4(c)(i) and (iii). *See Wells Fargo & Co. v. Lin Shun Shing*, FA

205699 (Nat. Arb. Forum Dec. 8, 2003) (finding that using a domain name to direct Internet traffic to a website featuring pop-up advertisements and links to various third-party websites is neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶4(c)(iii) because the registrant presumably receives compensation for each misdirected Internet user); *see also De La Rue Holdings PLC v. Video Images Prods. L.L.C.*, FA 196054 (Nat. Arb. Forum Oct. 27, 2003) (finding that the respondent was not using the <delaru.com> domain name for a *bona fide* offering of goods or services or a legitimate noncommercial or fair use because the respondent was using the domain name to “subject unsuspecting users to a barrage of unsolicited [pop-up] advertisements,” presumably for commercial benefit).

Respondent is not commonly known by the <gojeans.com> domain name. Respondent’s WHOIS information identifies Respondent as “Administrator,” a name with no apparent relationship to the disputed domain name. The Panel finds Respondent has not established rights or legitimate interests in the disputed domain name under Policy ¶4(c)(ii). *See RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy ¶4(c)(ii) “to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail.”); *see also Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, FA 95162 (Nat. Arb. Forum Aug. 29, 2000) (finding that the respondent has no rights or legitimate interests in domain names because it is not commonly known by the complainant’s marks and the respondent has not used the domain names in connection with a *bona fide* offering of goods and services or for a legitimate noncommercial or fair use); *see also 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).

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

Registration and Use in Bad Faith

Complainant claims Respondent recently offered to sell the <gojeans.com> domain name registration to Complainant for \$5,000, and Complainant has alleged this amount is in excess of Respondent’s out-of-pocket costs. Since the Panel has no idea what Respondent’s business is (and providing only click-through advertising isn’t a *bona fide* offering of goods and services even though it may generate revenue), the Panel assumes Respondent acquired the domain name *primarily* for the purpose of re-selling it (even if not to this particular Complainant). The Panel finds Respondent’s attempt to sell the disputed domain name for an amount in excess of its out-of-pocket costs (a fact Respondent does not dispute) in conjunction with this fact constitutes bad faith registration and use pursuant to 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 World Wrestling Fed’n Entm’t, Inc. v. Bosman*, D99-0001 (WIPO Jan. 14, 2000) (finding that the respondent used the domain

name in bad faith because he offered to sell the domain name for valuable consideration in excess of any out-of-pocket costs).

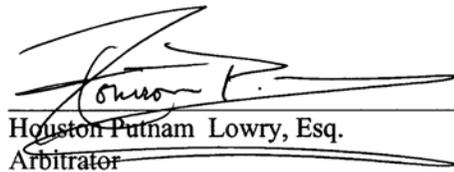
While Complainant claims Respondent has been a party to numerous other UDRP proceedings, the respondents' names in those cases do not sufficiently match this Respondent's name so that Panel may reach that conclusion (absent extrinsic or explanatory evidence Complainant did not provide). This factor is given no weight.

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 <gojeans.com> domain name be **TRANSFERRED** from Respondent to Complainant. The claim of reverse domain name hijacking is denied.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Friday, January 26, 2007

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ⁱ [Chef2Chef, LLC v. Realtimeinternet.com, Inc.](http://domains.adrforum.com/domains/decisions/137710.htm), No. 137710 (NAF Feb. 26, 2003)

ⁱⁱ [Florists' Transworld Delivery v. Domain Deluxe](http://www.arb-forum.com/domains/decisions/102751.htm), No. 102751 (NAF Mar. 1, 2002)

ⁱⁱⁱ [Limco, Inc. et al. v. Rarenames et al.](http://www.arb-forum.com/domains/decisions/99693.htm), No. 99693 (NAF Nov. 27, 2001)

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- iv Mirama Enterprises Inc. et al v. Aroma Housewares Co., No 588486 (Jan. 16, 2006)
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- v Bd. of Governors of the Univ. of Alberta v. Katz, D2000-0378 (WIPO June 22, 2000)
<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0378.html>
- vi Gaiam, Inc. v. Nielsen, No. 112469 (NAF July 2, 2002)
<http://domains.adrforum.com/domains/decisions/112469.htm>
- vii Business Architecture Group, Inc. v. Reflex Publishing, No. 97051 (NAF June 5, 2001)
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- viii John Ode d/ba ODE and ODE - Optimum Digital Enterprises v. Internship Limited, D2001-0074 (WIPO May 1, 2001)
<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0074.html>
- ix CHF Industries, Inc. v. Domain Deluxe, No. 97532 (July 26, 2001)
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- x Incorp Services, Inc. v. RareNames, WebReg, No. 559911 (NAF Nov. 10, 2005)
<http://www.arb-forum.com/domains/decisions/559911.htm>
- xi HP Hood LLC v. hood.com, No. 313566 (NAF Nov. 9, 2004)
<http://www.arb-forum.com/domains/decisions/313566.htm>
- xii Williams, Babbitt & Weisman, Inc. v. Ultimate Search, No. 98813 (NAF Oct. 8, 2001)
<http://www.arb-forum.com/domains/decisions/98813.htm>
- xiii Dial-a-Mattress Operating Corp. v. Ultimate Search, No.D2001-0764 (Sept. 26, 2001)
<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0764.html>
- xiv Etam, plc v. Alberta Hot Rods, D2000-1654 (WIPO Jan. 31, 2000)
<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1654.html>
- xv GLB Servicios Interativos S.A. v. Ultimate Search, No. D2002-0189 (WIPO May 29, 2002)
<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-0189.html>
- xvi the Landmark Group v. Digimedia L.P., No. 285459 (NAF Aug. 6, 2004)
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- xvii Sweeps Vacuum & Repair Center, Inc. v. Nett Corp., No. D2001-0031 (WIPO Apr. 13, 2001)
<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0031.html>
- xviii Proto Software, Inc. v. Vertical Axis, Inc., No. D2006-0905 (WIPO Oct. 10., 2006)
<http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0905.html>
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- xxi Carsales.com.au v. Flanders, No. D2004-0047 (WIPO Apr. 8, 2004)
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- xxii Mytech Partners, Inc. v. Jeb's Corp., No. 135645 (NAF Feb. 7, 2003)
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- xxiii NetDeposit, Inc. v. NetDeposit.com, No. D2003-0365 (WIPO July 22, 2003)
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- xxiv Futureworld Consultancy Pty Ltd. v. Online Advice, No. D2003-0297 (WIPO July 18, 2003)
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- xxx EPLAN Software & Service GmbH & Co K.G. v. Chad Folkening, ECORP.com, Inc E-PLAN, and ECAST,
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<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0806.html>
- xxxi Sustainable Forestry Management Limited v. SFM.com, et al., No. D2002-0535 (WIPO Sept. 13, 2002)
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- xxxiii Limco, Inc. et al. v. Renames et al., No. 99693 (NAF Nov. 27, 2001)
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- xxxiv Chef2Chef, LLC v. Realtimeinternet.com, Inc., No. 137710 (NAF Feb. 26, 2003)
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- xxxv BPI Communications, Inc. et al. v. Boogie TV LLC, No. 105755 (NAF Apr. 30, 2002)
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- xxxvi Florists' Transworld Delivery v. Domain Deluxe, No. 102751 (NAF Mar. 1, 2002)
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- xxxviii Bd. of Governors of the Univ. of Alberta v. Katz, D2000-0378 (WIPO June 22, 2000)

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^{xl} Georgia Boot LLC v. Modern Limited – Cayman Web Development, FA149173 (Nat. Arb. Forum Apr. 21, 2003)

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^{xlii} The Fresh Market Inc. v. Modern Limited-Cayman Web Development a/k/a Cayman Trademark Trust, No 2030205 (NAF December 4, 2003)

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