



NATIONAL ARBITRATION FORUM

DECISION

Hennion & Walsh, Inc. v. Robert Isom
Claim Number: FA0712001118409

PARTIES

Complainant is **Hennion & Walsh, Inc.** ("Complainant"), represented by **Debbie Williams**, 2001 Route 46, Waterview Plaza, Parsippany, NJ 07054. Respondent is **Robert Isom** ("Respondent"), 3799 Route 46, Parsippany, NJ 07054.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**hennionandwalsh.com**>, registered with **Network Solutions, 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 December 7, 2007; the National Arbitration Forum received a hard copy of the Complaint on December 10, 2007.

On December 7, 2007, Network Solutions, Inc. confirmed by e-mail to the National Arbitration Forum that the <**hennionandwalsh.com**> domain name is registered with Network Solutions, Inc. and that Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On December 18, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 7, 2008 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@hennionandwalsh.com by e-mail.

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

On January 11, 2008, 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 name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

This Complaint is based on the following factual and legal grounds:

[a.] *[Specify in the space below the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.]* ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

The domain name <**hennionandwalsh.com**> is identical to the name of Complainant's business, Hennion and Walsh, Inc. (HW") and was intended to be identifiable as Complainant's website. HW is incorporated in NJ and is registered to do business in most states in the United States. Hennion and Walsh has been in business since 1990 and has advertised continuously in both print ads and radio ads. There is no dispute, as set forth below, about HW's exclusive rights to this domain name. This is not a case of confusion per se. It is a proceeding initiated in order to have Respondent officially renounce any purported interest he may have in the domain name he registered while in HW's employ.

[b.] *[Specify in the space below why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint.]* ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

[The Panel may consider any relevant aspects included in, but not limited to ICANN Policy ¶4(c):

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

(ii.) Whether Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if Respondent has not acquired trademark or service mark rights; or

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

Respondent was employed by HW from May 2001 to May 2004 as the firm's computer operator. His responsibilities included construction and maintenance of the firm's website. On or about June 2002 Respondent registered the domain name now in dispute. While setting up the Domain name with Network Solutions, he mistakenly put his name as registrant. He was also asked to encode a password in the firm's account access gateway to protect the firm's website against unauthorized access. In case Respondent forgot his password, he was asked to answer a specific security question, here, "Who's your Daddy?"

When Respondent left HW's employ, he did not leave the password or answer to the security question with his direct report at HW. The firm has not been able to access its account with Network Solutions because Respondent was the only person who knew the password and the answer to the security question. HW contacted Respondent when it realized it needed this information in order to make any changes to its website through Network Solutions. Respondent has no recall of the password or the answer to the alternate security question. Network solutions will not permit the firm access to the website (meaning, to bypass the security gate) unless Respondent renounces his interest in the domain name.

Respondent has not accessed the Network Solutions account since he left HW. The Network Solutions registration was never intended for Respondent's personal use. The only known use of the domain name has been for HW business. Respondent has never claimed, nor does he have, any direct or indirect personal interest in the domain name. He has cooperated with the firm's efforts to access its Network Solutions account but has no recall of the password or other information necessary for the firm to access its account.

Accordingly, this is not a dispute over rights to the domain name; this is an action that Network Solutions required HW to initiate for Respondent to officially renounce his rights to the domain name. We do not expect that he will resist HW's application and indeed likely will not answer it. The domain was and is the property of HW, as

Respondent was working in his capacity of HW employee and an agent of HW when he created the firm's account with Network Solutions.

[c.] *[Specify in the space below why the domain name(s) should be considered as having been registered and being used in bad faith.]* ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

[The Panel may consider any relevant aspects included in, but not limited to ICANN Policy ¶4(b):

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

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

(iii.) *Whether Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or*

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

See 5(b), the issues raised in these sections are not implicated by the facts in this case. There has been no use by Respondent contrary to HW's interest, there is no right by Respondent to the domain name under review, he admits it is the property of HW.

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

FINDINGS

Complainant, Hennion & Walsh, Inc., is a business which provides investment goods and services. Complainant has been in business since 1990 and has used their HENNION AND WALSH mark since that time to conduct business and to advertise their business through print and radio mediums.

Respondent is a former employee of Complainant's who was responsible for creating and maintaining Complainant's website. Respondent created Complainant's website at the website that resolves from the disputed domain name which he mistakenly registered under his own name. The <hennionandwalsh.com> domain name resolves to the website Respondent created for Complainant but only Respondent has access to the disputed domain name account and thus only Respondent has the ability to alter the website.

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

While Complainant does not have a registered trademark for the HENNION AND WALSH mark, such registration is unnecessary under Policy ¶4(a)(i), provided Complainant can establish common law rights in the mark. *See 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"); *see also 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).

Complainant has established common law rights in the HENNION AND WALSH mark pursuant to Policy ¶4(a)(i) through its history of use of the HENNION AND WALSH mark in its business operations and advertisements. Since 1990 Complainant has offered investment services under the mark and has advertised its business continuously in both radio and print ads. *See Keppel TatLee Bank v. Taylor*, D2001-0168 (WIPO Mar. 28, 2001) (“[O]n account of long and substantial use of [KEPPEL BANK] in connection with its banking business, it has acquired rights under the common law.”); *see also Fishtech, Inc. v. Rossiter*, FA 92976 (Nat. Arb. Forum Mar. 10, 2000) (finding that the complainant has common law rights in the mark FISHTECH that it has used since 1982).

Respondent’s <**hennionandwalsh.com**> domain name is identical to Complainant’s HENNION AND WALSH mark pursuant to Policy ¶4(a)(i) because Respondent’s domain name fully incorporates the HENNION AND WALSH mark and top-level domain names such as “.com” are not considered relevant in evaluating whether a disputed domain name is identical to a mark. *See 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); *see also Blue Sky Software Corp. v. Digital Sierra, Inc.*, D2000-0165 (WIPO Apr. 27, 2000) (holding that the domain name <robohelp.com> is identical to the complainant’s registered ROBOHELP trademark, and that the "addition of .com is not a distinguishing difference").

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

Rights or Legitimate Interests

Complainant has alleged Respondent does not have rights or legitimate interests in the <**hennionandwalsh.com**> domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to prove he does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). The Panel finds Complainant has established a *prima facie* case. Moreover, due to Respondent’s failure to respond to the Complaint, the Panel assumes Respondent does not have rights or legitimate interests in the disputed domain name. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that 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”).

However, the Panel will examine the record to determine whether Respondent has rights or legitimate interests under Policy ¶4(c).

At the time of registration, Respondent had no rights in the domain name. Respondent was simply Complainant's employee when he registered the domain name.

The record and WHOIS information indicates no evidence suggesting Respondent is commonly known by the <hennionandwalsh.com> domain name. There is also no evidence in the record Respondent is authorized to use Complainant's mark. Thus, Respondent has not established rights or legitimate interests in the <hennionandwalsh.com> domain name 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 Ian Schrager Hotels, L.L.C. v. Taylor*, FA 173369 (Nat. Arb. Forum Sept. 25, 2003) (finding that without demonstrable evidence to support the assertion that a respondent is commonly known by a domain name, the assertion must be rejected).

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

Registration and Use in Bad Faith

This is the most interesting aspect of this case. At the time the domain name was registered, Respondent was Complainant's employee. The domain name was registered in Respondent's personal name on July 2, 2002 "mistakenly" (Complainant's actual words). Respondent left Complainant's employment in May 2004.

Complainant work up 1,987 days after the domain name was registered and 1,288 days after Respondent left and realized it had to do something because the domain name was registered in its former employee's name. Apparently Network Solutions (the Registrar involved) has been unable to help for unknown reasons. Respondent doesn't remember his Network Solutions password.

Complainant itself recognizes there was no bad faith here. Complainant simply wants this Panel to correct its administrative failures. Respondent is silent. Regrettably, the UDRP was not designed for such uses.

The Panel finds Policy ¶4(a)(iii) **not** satisfied.

DECISION

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



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Thursday, January 25, 2008

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