



NATIONAL ARBITRATION FORUM

DECISION

Adjudicate, Inc. d/b/a Judicate West v. SeMi Jeong
Claim Number: FA0807001215366

PARTIES

Complainant is **Adjudicate, Inc.** d/b/a **Judicate West** ("Complainant"), represented by **Varooge Yerganian**, California, USA. Respondent is **SeMi Jeong** ("Respondent"), Korea.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**judicatewest.com**>, registered with **Onlinenic, 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 July 14, 2008; the National Arbitration Forum received a hard copy of the Complaint on July 18, 2008.

On July 16, 2008, Onlinenic, Inc. confirmed by e-mail to the National Arbitration Forum that the <**judicatewest.com**> domain name is registered with Onlinenic, Inc. and that Respondent is the current registrant of the name. Onlinenic, Inc. has verified that Respondent is bound by the Onlinenic, 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 July 30, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 19, 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@judicatewest.com by e-mail.

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

On August 28, 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:



Word Mark	JUDICATE WEST
Goods and Services	IC 042. US 100 101. G & S: arbitration, mediation, and alternative dispute resolution services. FIRST USE: 19961000. FIRST USE IN COMMERCE: 19961000
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	14.05.01 - Gavel; Hammers; Mallets (tools)
Serial Number	76622814
Filing Date	December 1, 2004
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	September 19, 2006
Registration Number	3178925
Registration Date	December 5, 2006

Owner	(REGISTRANT) Adjudicate, Inc. CORPORATION CALIFORNIA 1851 E. First Street, Suite 1450 Santa Ana CALIFORNIA 92705
Attorney of Record	Gene E. Royce
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

JUDICATE WEST

Word Mark	JUDICATE WEST
Goods and Services	IC 042. US 100 101. G & S: arbitration, mediation, and alternative dispute resolution services. FIRST USE: 19940110. FIRST USE IN COMMERCE: 19940110
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	76622813
Filing Date	December 1, 2004
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	September 19, 2006
Registration Number	3178924
Registration Date	December 5, 2006
Owner	(REGISTRANT) Adjudicate, Inc. CORPORATION CALIFORNIA 1851 E. First Street, Suite 1450 Santa Ana CALIFORNIA 92705
Attorney of Record	Gene E. Royce
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

FACTUAL AND LEGAL GROUNDS

1. The following complaint is filed in accordance with ICANN Rule 3(b)(ix) and NAF Supp. Rule 4(a).
2. Pursuant to ICANN Rule 3(b)(ix)(1) and ICANN Policy ¶4(a)(i), the domain name <**judicawest.com**> has been used and continues to be in use by the Respondent, SeMi Jeong and such name is identical to the name “Judicate West”.
3. The Respondent Jeong’s unauthorized use is in direct infringement upon the proprietary trademarks owned by Complainant listed herein and subject of this complaint.
4. Pursuant to ICANN Rule 3(b)(ix)(2) and ICANN Policy ¶4(a)(ii), the domain name <**judicawest.com**> has been owned and continues to be owned by the Respondent, SeMi Jeong.
5. The Respondent Jeong’s use of the trade name Judicate West in the form of a domain name <**judicawest.com**> has been and continues to be a completely illegitimate use, never having had any legitimate business purpose other than to be used as a cybersquat and to hold for sale of the domain name <**judicawest.com**>.
6. Respondent Jeong can not and has never filed, caused to be filed or claimed any authority for trademark approval in the United States or anywhere in the world for the use of the name Judicate West for any business purpose.
7. Respondent Jeong has never requested any licensing rights for any authority for trademark use of the name Judicate West from the Complainant at any time for any business purpose, including but not limited to alternative dispute resolution services.
8. Pursuant to ICANN Rule 3(b)(ix)(3) and ICANN Policy ¶4(a)(iii), the domain name <**judicawest.com**> has been held by Respondent Jeong in total and complete bad faith, having no legitimate business purpose, other than to hold the domain name for sale.
9. Complainant, has made offers to Respondent Jeong on many occasions from on or about April 27, 2002 up to the present day with offers ranging from \$500.00 USD and greater. At no time has Respondent Jeong accepted any of the offers made to him, presumably because Respondent was holding out for more money.
10. Clearly, these amounts offered in the past are well in excess of Respondent Jeong’s total cost of registration from such time as on or about April 27, 2002 to the present. Respondent Jeong’s total lack of communication and apparent refusal as to the acceptance of any such offers made consistent with ICANN Rules amounts to bad faith.

11. The continuous registration and withholding of the <**judicawest.com**> domain by Respondent Jeong, in light of Respondent Jeong's unwillingness to cooperate with Complainant at any length, is a clear pattern of obstruction, thus preventing Complainant from profiting from its proprietary marks as it would otherwise have used in effectively marketing and branding its business.
12. Respondent Jeong's holding of the domain name <**judicawest.com**> and intentional ransoming is clearly an attempt by Respondent Jeong to profit from the disruption he has created to Complainant's business and web-based marketing ability.
13. Respondent's current attempt to publicly sell the domain name and avoid resolution with the Complainant can only be seen as an attempt to harm the Complainant and Complainant's business.

History and Background

14. The Complainant, Adjudicate, Inc. is a California Corporation, having been duly incorporated to conduct business on or about October 1993.
15. From the Complainant's inception, the name Judicate West has been a trademark in use and widely recognized as the exclusive mark of the Complainant in the Southern California market for alternative dispute resolution.
16. From on or about October 1993 to the present, the Complainant has used the trademark of Judicate West to conduct its business as a neutral forum in the field of Alternative Dispute Resolution (the "Period of Use").
17. On or about December 5, 2006, well after the proprietary rights to the name and logo of Judicate West had been firmly established by actual use in the marketplace, the Complainant received notice from the United States Patent and Trademark Office that the trademark "Judicate West" was officially registered and lawfully belonged to Complainant Adjudicate, Inc.
18. From on or about July 1999 through on or about October 12, 2001 (the "Initial Registration Period"), the Complainant was in contact on multiple occasions, with Roy Israel ("Israel"), who by himself and through his company National Arbitration and Mediation Services, Inc. ("NAMS"), were the registrant(s) of the domain name <**judicawest.com**>.
19. During the Initial Registration Period, on verifiable information and belief, Israel was the Chairman and Chief Executive Officer of NAMS, then a publicly traded company operating in the field and business of alternative dispute resolution services.

20. During the Initial Registration Period, management of the Complainant informed Israel that he and his company were infringing upon the trademark and goodwill of Adjudicate, Inc. by cybersquatting and refusing to release the domain name <**judicatewest.com**>.
21. On or about July 2001, Israel informed the Complainant that the registration was going to lapse and before the registration lapsed, he wanted to transfer the domain to the Complainants for the nominal consideration of the cost of registration.
22. Israel agreed to make the transfer so as to avoid further legal proceedings threatened against Israel and NAMS.
23. Israel never processed the transfer, nor made any attempts to do so.
24. On or about October 12, 2001 and for several months thereafter, Complainant attempted to contact Mr. Israel regarding the failed transfer of the <**judicatewest.com**> domain name, to no avail.
25. On or about November 2001, Complainant ceased attempting to contact Mr. Israel.
26. On or about October 12, 2001, a new registrant, listed as judicatewest.com@ebqk.com, (the "EBQK Registrant"), became the owner of the domain name <**judicatewest.com**> (the "First Recorded Domain Registration").
27. The EBQK Registrant did not have any formal name listed in the registry.
28. The domain name registration for <**judicatewest.com**> would run from on or about October 12, 2001 and expire on or about October 12, 2003.
29. On or about January 9, 2002, the record with respect to the First Recorded Domain Registration was updated.
30. Many times, from on or about November 2001 through on or about April 2002, Complainant attempted to contact the EBQK Registrant via email regarding this registrant's unauthorized taking and squatting of the <**judicatewest.com**> domain name.
31. At no time during this period did the Complainant receive any return correspondence whatsoever from the EBQK Registrant.
32. Upon information and belief, EBQK.com is an affiliated website and correspondent of Westingarea, a China based industrial company.

33. On or about April 27, 2002 a new record was created regarding the registration of the domain name <**judicawest.com**>.
34. Curiously, the First Recorded Domain Registration had not yet lapsed as it was due to expire on or about October 12, 2003.
35. Upon information and belief, Respondent Jeong is also the EBQK Registrant.
36. On or about April 27, 2002 the Second Recorded Domain Registration listed the registrant and registrant administrator as SeMi Jeong (“Jeong” or “Respondent” or “Respondent Jeong”).
37. The Second Recorded Domain registration listed the creation date as April 27, 2002 and the expiration date as April 27, 2007.
38. While it is unknown whether or not the Second Recorded Domain Registration and First Recorded Domain Registration are controlled by the same entity or registrar, we believe this to be the case.
39. It is unknown whether or not there was a sale of the domain name <**judicawest.com**> from Mr. Israel to either the EBQK Registrant or from the EBQK Registrant to Jeong (assuming they are different entities).
40. On or about April 17, 2006, the record with respect to the Second Recorded Domain Registration was updated.
41. With respect to this update on April 17, 2006, there were no changes to the registrar or administrator.
42. For some reason, on or about April 27, 2002, a newer record was created regarding the registration of the domain name <**judicawest.com**>.
43. The Third Recorded Domain registration listed the creation date as April 27, 2002 and the expiration date as April 27, 2008.
44. On or about April 27, 2002 the Third Recorded Domain Registration listed the registrant and registrant administrator, as Jeong, the very same registrant and administrator of the Second Recorded Domain Registration.
45. On or about April 15, 2007, the record with respect to the Third Recorded Domain Registration was updated.
46. With respect to this update on April 15, 2007, there were no changes to the registrar or administrator.

47. Many times, from on or about April 27, 2002 through the present time, Complainant attempted to contact, directly and indirectly through an authorized third party, Respondent Jeong both via email and via telephone, regarding this registrant's unauthorized taking and squatting of the <**judicawest.com**> domain name.
 48. Many times, from on or about April 27, 2002 through the present time, did Complainant, directly and indirectly through an authorized third party, attempt to contact Jeong both via email and via telephone, in an attempt to purchase this registrant's unauthorized taking and squatting of the <**judicawest.com**> domain name.
 49. From on or about April 27, 2002 through on or about October 2007 Respondent Jeong used the <**judicawest.com**> domain much the same way as many cybersquatters use generic catch-all websites to link to industry specific targets.
 50. From on or about April 27, 2002 through on or about October 2007 did Respondent Jeong use the <**judicawest.com**> domain to place links to other alternative dispute resolution and legal services websites (the "JW Catch All").
 51. On or about October 2007, did Respondent Jeong cease to use the <**judicawest.com**> domain as the JW Catch All and began to list the <**judicawest.com**> website for sale.
 52. The email address and phone number listed belong to the registrant SeMi Jeong and Respondent Jeong, who are one in the same.
 53. The alleged attempted sale of the <**judicawest.com**> domain name by Respondent Jeong is an attempt to illegally sell for value a name that is trademark protected and represents the good will and invaluable commerce rights of the name Judicate West, belonging exclusively to the Complainant.
 54. At no time, throughout the entire period of time from on or about April 27, 2002 through the present, did the Complainant receive any written or verbal notice from Respondent Jeong indicating a willingness to surrender, or sell for a reasonable sum, the domain name <**judicawest.com**>.
 55. Respondent Jeong's attempt to sell and hold hostage the <**judicawest.com**> domain name for ransom of an unknown amount of money is an attempted extortion and fraud upon the Complainant.
- B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Adjudicate, Inc., has been in the business of alternative dispute resolution since October 1993. Complainant has used the JUDICATE WEST mark since January 10, 1994 and holds a registration for this mark with the United States Patent and Trademark Office ("USPTO") (Reg. No. 3,178,924 issued December 5, 2006).

Respondent registered the <**judicategest.com**> domain name on April 27, 2002. Respondent previously used the disputed domain name to display hyperlinks promoting alternative disputed resolution companies that compete with Complainant's business, and currently is not actively using the disputed domain name. Respondent also offered to sell the disputed domain name on or about October 2007.

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

Although Complainant holds a registration for the JUDICATE WEST mark with the USPTO, Respondent's registration of the <**judicategest.com**> domain name predates the registration date of Complainant's mark. However, registration of a mark is not necessary if Complainant can establish common law rights in the mark pursuant to Policy ¶4(a)(i) that predate Respondent's registration of the disputed domain name. *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 Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.”).

There seems to be some confusion about when Complainant first began to use its mark. Complainant claims in its complaint to have used the JUDICATE WEST mark extensively since its corporate inception in October 1993. In its stylized mark registration (#3,178,925), Complainant claims to have used the mark since October 1996. In its block mark registration (#3,178,924), Complainant claims to have used the mark since January 10, 1994. While the two registrations can be easily reconciled, it is difficult to reconcile the 3,178,924 registration with the complaint in this proceeding. Nevertheless, since all of these dates predate Respondent’s April 27, 2002 domain registration, any of them will suffice.

Thus, the Panel finds Complainant has sufficiently established common law rights in the JUDICATE WEST mark under Policy ¶4(a)(i). *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 Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established).

The <**judicategest.com**> domain name contains Complainant’s entire JUDICATE WEST mark without the space, and with the addition of the generic top-level domain (“gTLD”) “.com.” The Panel finds the disputed domain name is identical to Complainant’s mark under Policy ¶4(a)(i). *See Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2001) (finding <hannoverre.com> to be identical to HANNOVER RE, “as spaces are impermissible in domain names and a generic top-level domain such as ‘.com’ or ‘.net’ is required in domain names”); *see also Croatia Airlines v. Kwen Kijong*, AF-0302 (eResolution Sept. 25, 2000) (finding that the domain name <croatiaairlines.com> is identical to the complainant's CROATIA AIRLINES trademark).

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

Rights or Legitimate Interests

First, Complainant must make a *prima facie* showing Respondent has no rights and legitimate interests in the <**judicategest.com**> domain name. Then, the burden shifts to Respondent and Respondent must establish that it has rights or legitimate interests in the disputed domain name. The Panel finds Complainant has sufficiently made a *prima facie* showing pursuant to Policy ¶4(a)(ii). *See Compagnie Generale des Matieres Nucleaires*

v. Greenpeace Int'l, D2001-0376 (WIPO May 14, 2001) (“Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a prima facie case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”); *see also 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).”).

Respondent uses the domain name to forward to a page indicating it is for sale. Such use constitutes 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). The Panel finds this use of the <**judicategest.com**> domain name does not establish rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(a)(ii). *See TMP Int'l, Inc. v. Baker Enters.*, FA 204112 (Nat. Arb. Forum Dec. 6, 2003) (“[T]he Panel concludes that Respondent’s [inactive] holding of the domain name does not establish rights or legitimate interests pursuant to Policy ¶4(a)(ii).”); *see also Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001) (finding no rights or legitimate interests in the domain name <solgarvitamins.com> where the respondent merely inactively held the domain name).

The Panel also finds Respondent’s offer to sell the disputed domain name demonstrates a lack of rights and legitimate interests under Policy ¶4(a)(ii). *See Mothers Against Drunk Driving v. Hyun-Jun Shin*, FA 154098 (Nat. Arb. Forum May 27, 2003) (holding that under the circumstances, the respondent’s apparent willingness to dispose of its rights in the disputed domain name suggested that it lacked rights or legitimate interests in the domain name); *see also Am. Nat’l Red Cross v. Domains*, FA 143684 (Nat. Arb. Forum Mar. 4, 2003) (“Respondent’s lack of rights and legitimate interests in the domain name is further evidenced by Respondent’s attempt to sell its domain name registration to Complainant, the rightful holder of the RED CROSS mark.”).

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

Registration and Use in Bad Faith

The Panel finds Respondent’s offer to sell the disputed domain name constitutes bad faith registration and use under Policy ¶4(b)(i). *See Banca Popolare Friuladria S.p.A. v. Zago*, D2000-0793 (WIPO Sept. 3, 2000) (finding bad faith where the respondent offered the domain names for sale); *see also Am. Online, Inc. v. Avrasya Yayincilik Danismanlik*

Ltd., FA 93679 (Nat. Arb. Forum Mar. 16, 2000) (finding bad faith where the respondent offered domain names for sale).

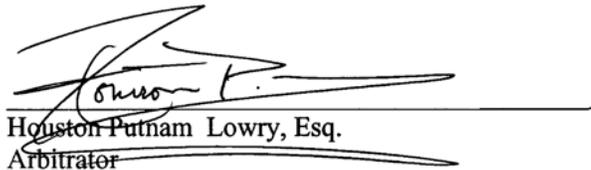
Currently, Respondent is not making any active use of the disputed domain name (other than to indicate it is for sale). The Panel finds this inactive holding of the disputed domain name constitutes bad faith registration and use under Policy ¶4(a)(iii). *See DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's inactive holding of the domain name satisfies the requirement of ¶4(a)(iii) of the Policy); *see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that merely holding an infringing domain name without active use can constitute use in bad faith).

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

DECISION

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

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



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: September 2, 2008

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