



NATIONAL ARBITRATION FORUM

DECISION

International PADI, Inc. v Abner Santiago
Claim Number: FA0509000570120

PARTIES

Complainant is **International PADI, Inc.** ("Complainant"), represented by **Diane M. Reed**, of **Knobbe, Martens, Olson & Bear, LLP**, 2040 Main Street, Fourteenth Floor, Irvine, CA 92614. Respondent is **Abner Santiago** ("Respondent"), 1530 Elgaen PL. Drive, Roswell, GA 30075.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**>, registered with **Go Daddy Software, Inc.**

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on September 30, 2005; the National Arbitration Forum received a hard copy of the Complaint on October 3, 2005.

On September 30, 2005, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names are registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the names. Go Daddy Software, Inc. has verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 3, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 24, 2005 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@padidivemaster.com, postmaster@padiinstructor.com and postmaster@padirescuediver.com by e-mail.

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

On October 31, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

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

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

[c.] **The complaint is based on the following trademarks and services marks belonging to the Complainant:**

[i] Marks: PADI

PADI

PROFESSIONAL ASSOCIATION OF DIVING INSTRUCTORS
PADI PROS

Goods/Services with which the marks are used: Providing instructional facilities and underwater safety and underwater diving instruction; Offering diver training on the instructor level; Association services to promote the interest of professional diving instruction; Instructional handbooks, textbooks, manuals, dive tables, equipment manuals, and audio visual materials all dealing with scuba diving and underwater safety; conducting diving exhibitions; clothing

[ii] Mark: PADI DIVING SOCIETY

Goods/Services: Educational and entertainment services and publications all in the field of marine conservation programs, diving, snorkeling, diving centers and resorts, and diving related health and safety.

[iii] Mark:



Goods/Services: Arranging travel tour packages related to diving; and chartering of boats for diving



[iv] Mark:

Goods/Services: Educational services in the field of diving and self contained breathing apparatus, snorkeling, safety and oceanography and related printed materials.

[5.] **FACTUAL AND LEGAL GROUNDS**

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

- (1) Complainant's PADI trademark is famous throughout the world for use in connection with services relating to scuba diving. PADI is an invented word, being an acronym for "Professional Association of Diving Instructors." PADI trains and certifies scuba divers and diving instructors throughout the world. Divers who complete approved courses of instruction provided by Complainant are certified as "PADI divers" and become members of PADI. Diving instructors who complete approved courses and instruction provided by the Complainant are certified as "PADI Instructors" and become members of PADI. PADI is the world's largest single entity in the diving industry with retail sales in excess of \$250 million. PADI has offices in 10 countries, including its headquarters in the United States, has over 100,000 individual members and over 4,600 retail and resort location members located in 175 countries worldwide. PADI's website is located at www.padi.com.
- (2) Complainant has used the PADI trademark since at least as early as 1966.
- (3) In or about February 2005, Complainant first became aware that Respondent had registered the Domain Names and was signing up customers who wanted "...@PadiDiveMaster.com," "...@PadiInstructor.com" "...@PadiRescueDiver.com" and "...@PadiScubaPro.com" e-mail addresses. Complainant believes that Respondent no longer uses or offers the "...@PadiScubaPro.com" email addresses and has allowed its registration of padiscubapro.com to lapse.
- (4) Respondent operates a website located at <scubadivers.ws>. The home page of Respondent's website is titled "Scuba Divers WorldSite" and is further described on the home page as "The Ultimate Scuba Diving Guide." On this website, Respondent offers links to Scuba diving centers, resorts, and equipment manufacturers. Respondent also provides free email accounts from a selection of many Scuba related domain names. For example, YourName@AdvanceDiver.com, and YourName@Love2Dive.com, etc. Attached as Annex 6 is a copy of the page on which Respondent offers "Free Scuba email Accounts. Respondent prominently displays the "...@PadiDiveMaster.com" "...@PadiInstructor.com" and "...@PadiRescueDiver.com" email addresses on this page.

- (5) Each of the domain names padidivemaster.com, padiinstructor.com, and padirescuediver.com automatically redirects the user to Respondent's home page at scubadivers.ws.
- (6) Respondent is not a member of PADI. Complainant has never authorized Respondent to offer email address that include the PADI trademark. On information and belief, anyone can obtain a free email address through Respondent's website, including an @PadiDiveMaster, @PadiInstructor, or @PadiRescueDiver email address regardless of whether they are a certified PADI diver, dive master, or instructor.
- (7) Complainant contacted Respondent by email correspondent dated March 1, 2005 and requested that Respondent cease the use of the Domain Names. Complainant received an e-mail from Respondent on March 1, 2005 in which Respondent stated "We believe that PADI certified Scuba Divers have the right to use PADI to identify themselves as PADI Certified Divers" and indicated that Respondent would continue to allow users to continue using their email accounts, "since we believe they have the right to use them."
- (8) On May 26, 2005, Complainant wrote to Respondent again and explained that Complainant does not allow PADI Members or non-members to use PADI in their domain names. On June 27, 2005, Respondent responded and again refused to stop using the Domain Names, stating "I guess the best thing is to let UDRP decide."
- (9) On June 30, 2005, Complainant wrote to Respondent again as one last attempt to resolve this matter amicably by further explaining Complainant has the right to control use of its trademarks. Complainant has not received any further reply from Mr. Santiago.
- (10) Respondent offers the free email addresses, including those that include "PADI" as part thereof, for purposes of profit. Respondent sells advertising on its site and offers to display paid advertisements to its email subscribers. Respondent states on its website that "periodically we may email Scuba Divers with special deals on trips, promotions, dive gear, etc."

[a.] **The Domain Names are confusingly similar to trademarks and service marks in which the Complainant has rights.**

- (1) Complainant has strong rights in the PADI name and mark by virtue of its extensive use of the mark throughout the world and since at least as early as 1966. Since this date, Complainant has used the PADI name and mark in connection with scuba diving instruction, certification, training, and education, retail services, travel services, and entertainment services and related products, all related to scuba diving.
- (2) Complainant is the owner of the following trademark registrations for its PADI trademarks in the United States:

Mark

Reg'n No.

Reg'n Date

PADI	1,005,461	5/25/75
PADI	1243542	6/28/83
	1595478	5/08/90
	1645599	05/21/91
PROFESSIONAL ASSOCIATION OF DIVING INSTRUCTORS	1164966	08/11/81
	1282464	06/19/84
PADI DIVING SOCIETY	2272724	08/24/99
	2202584	11/10/98
	2236431	04/06/99
	2316350	02/08/00
	2668729	12/31/02
	2695113	03/11/03

- (3) In addition to the foregoing U.S. Registrations, Complainant owns **86** registrations for its PADI mark in **39** other countries *plus* in the European Community (OHIM), and has another **25** pending applications for PADI in another **19** countries.
- (4) Complainant uses the domain name PADI.COM and has had an active website at that address since January 1995.
- (5) Complainant's PADI mark appears prominently on all of Complainant's products and advertising and promotional materials. Further, Complainant's licensed retail and resort location members prominently display the PADI mark at their centers, on their websites and in their advertising materials.
- (6) Respondent is using the Domain Names to provide Free email addresses to anyone interested in Scuba diving regardless of whether or not such persons are members of PADI or are PADI certified divers, dive masters or instructors. Respondent can then use the list of subscribed email addresses to provide advertising to those subscribers. Targeted email lists such as this are very valuable to advertisers. Each of the Domain Names includes "PADI" as the dominant portion thereof. The only difference from Complainant's famous PADI mark, is the addition of the terms "dive master" "instructor" and "rescue diver" each of which are generic terms used to describe scuba divers trained at various levels.
- (7) Members of the public, and in particular, scuba divers, are likely to think that the offering of email addresses "@PadiDiveMaster.com" "@PadiInstructor.com" and "@PadiRescueDiver.com" relate to the provision of e-mail services to PADI members by the Complainant, or with the Complainant's endorsement. Accordingly, Respondent's registration and use of the Domain Names will cause confusion.

(8) Similarly, and even more potentially harmful, members of the public are likely to think that individuals that use the email address “@PadiDiveMaster.com” “@PadiInstructor.com” and “@PadiRescueDiver.com” are in fact, PADI certified dive masters, instructors, and/or rescue divers when there is no guarantee that they are certified as such. Accordingly, Respondent’s registration and use of these Domain Names will cause confusion and could endanger the public.

[b.] **Respondents should be considered as having no rights or legitimate interests in respect of the Domain Names.**

(1) On information and belief, Respondents have no rights or legitimate interest in respect of the Domain Names other than to trade-off of the Complainant’s goodwill. When Respondent registered the Domain Names, he was fully aware of PADI and its trademark rights. Nonetheless, Respondent registered the Domain Names and started soliciting customers.

(2) Respondent’s website at scubadivers.ws is an information and advertising website for scuba divers. It is directed to divers to provide links to dive shops that provide instruction, equipment and other dive related services.

(3) Respondent’s actions demonstrate that the sole purpose in use of the Domain Names is to confuse consumers into thinking Respondent’s services are affiliated with the Complainant. Respondent has stated that: “We believe that any PADI certified diver has the right to use the word PADI to identify to the world that they have been certified by PADI as a Scuba Diver and can use it as part of their email address.”

Respondent registered and is using the Domain Names in Bad Faith.

(1) Before notice to the Respondent of the dispute, Respondent did not use the Domain Names in connection with a bona fide offering of goods or services. Respondent used the Domain Names prior to notice to him of the dispute, yet he was aware of Complainant’s rights in the PADI name and mark and was targeting scuba divers to intentionally lead them to believe there was an affiliation with or sponsorship by Complainant. Respondent never used the Domain Names in connection with a bona fide offering of goods or services. In fact, Respondent claims it has the right to use the Domain Names so that its users can “identify to the world that they have been certified by PADI as a Scuba Diver”.

(2) Respondent is making no legitimate noncommercial or fair use of the Domain Names. To the contrary, Respondent is attempting to get Complainant’s members and nonmembers to sign up for Respondent’s e-mail service so Respondent can build an email list for purposes of advertising, and is misleading divers into believing Respondent’s website is affiliated with the legitimate PADI.

[c.] **The Domain Name(s) should be considered as having been registered and being used in bad faith for the following reasons:**

(1) By using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site, 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.

(2) As set forth above, Respondent emphasizes PADI as part of email addresses on its website to make it appear that the email addresses, or the users of such email addresses are affiliated with or certified by Complainant. In addition, Respondent's website is directed to Complainant's customers, namely, scuba divers. Users that reserve one of the email addresses "@PadiDiveMaster.com" "@PadiInstructor.com" or "@PadiRescueDiver.com" may not be PADI members and may not be certified by PADI as instructors, dive masters or rescue divers, and might thereby mislead consumers.

(3) Respondent uses the Domain Names to direct traffic to Respondent's web site to increase traffic to Respondent's website and to profit from that traffic and from building an email list.

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

FINDINGS

Complainant, International PADI, Inc., is engaged in the business of training and certifying SCUBA divers and diving instructors throughout the world. Complainant is the world's largest single entity in the diving industry with retail sales in excess of \$250 million. Complainant has offices in ten countries, including its headquarters in the United States, with over 100,000 individual members and over 4,600 retail and resort location members located throughout 175 countries worldwide. Complainant owns and operates a business website at the <padi.com> domain name.

Complainant holds numerous trademark registrations with the United States Patent and Trademark Office ("USPTO") for the PADI mark (e.g., Reg. No. 1,005,461, issued February 25, 1975) and has been using the mark since at least as early as 1966.

Respondent registered the <**padiivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names on June 1, 2003, July 25, 2003 and August 27, 2003, respectively. Respondent is using the domain names to redirect Internet users to Respondent's commercial website, where Respondent offers links to SCUBA diving centers, resorts and equipment manufacturers, sells advertising and offers to display paid advertisements to its email subscribers. Respondent also provides free email accounts from a selection of many SCUBA related domain names.

DISCUSSION

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

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

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

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

Identical and/or Confusingly Similar

Complainant has rights in the PADI mark through registration with the USPTO and through continuous use of the mark throughout the world since at least as early as 1966. *See Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark."); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) ("Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark."). PADI is a fanciful mark which deserves the highest level of protection. It is not a common word nor is it a word which is being used in an usual manner. Everyone in the diving world knows what "PADI" means.

The <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names are confusingly similar to Complainant's PADI mark because the domain names incorporate Complainant's mark in its entirety and deviate from it only with the addition of the generic or descriptive terms, "divemaster," "instructor" and "rescuediver." The mere addition of a generic or descriptive word to a registered mark does not negate the confusing similarity of Respondent's domain name pursuant to Policy ¶4(a)(i). *See Christie's Inc. v. Tiffany's Jewelry Auction, Inc.*, D2001-0075 (WIPO Mar. 6, 2001)

(finding that the domain name <christiesauction.com> is confusingly similar to the complainant's mark since it merely adds the word "auction" used in its generic sense); *see also Brown & Bigelow, Inc. v. Rodela*, FA 96466 (Nat. Arb. Forum Mar. 5, 2001) (finding that the <hoylecasino.net> domain name is confusingly similar to the complainant's HOYLE mark, and that the addition of "casino," a generic word describing the type of business in which the complainant is engaged, does not take the disputed domain name out of the realm of confusing similarity).

The addition of the generic top-level domain ".com" does not negate the confusingly similar aspects of Respondent's domain names pursuant to Policy ¶4(a)(i). *See Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Busy Body, Inc. v. Fitness Outlet Inc.*, D2000-0127 (WIPO Apr. 22, 2000) ("[T]he addition of the generic top-level domain (gTLD) name '.com' is . . . without legal significance since use of a gTLD is required of domain name registrants . . .").

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

Rights or Legitimate Interests

Complainant asserts that Respondent does not have rights or legitimate interests in the <padidivemaster.com>, <padiinstructor.com> and <padirescuediver.com> domain names. When a complainant establishes a *prima facie* case pursuant to Policy ¶4(a)(ii), the burden shifts to the respondent to prove that it has rights or legitimate interests. Due to Respondent's failure to respond to the Complaint, the Panel infers that 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, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent").

Respondent is not commonly known by the <padidivemaster.com>, <padiinstructor.com> and <padirescuediver.com> domain names. The Panel concludes Respondent has not established rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). *See Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); *see also 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").

Respondent is using the <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names to redirect Internet users to its own commercial website where Respondent offers links to SCUBA diving centers, resorts and equipment manufacturers, sells advertising and offers to display paid advertisements to its email subscribers. The Panel finds Respondent's use of a domain name that is confusingly similar to Complainant's mark to divert Internet users to Respondent's website for Respondent's own commercial gain (or to harvest specially targeted email accounts) does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). See *Am. Online, Inc. v. Tencent Communications Corp.*, FA 93668 (Nat. Arb. Forum Mar. 21, 2000) (finding that use of the complainant's mark "as a portal to suck surfers into a site sponsored by [the respondent] hardly seems legitimate"); see also *MSNBC Cable, LLC v. Tsys.com*, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interests in the famous MSNBC mark where the respondent attempted to profit using the complainant's mark by redirecting Internet traffic to its own website).

Respondent's claim PADI certified divers are entitled to use a domain name with "PADI" imbedded in it does not apply here. Such divers are not parties to this UDRP proceeding; only Respondent is. Respondent is not a PADI certified anything. A party to a UDRP proceeding may assert only their own rights. A party may not (absent some fairly rare circumstances) assert the rights of a third party in UDRP proceedings.

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

Registration and Use in Bad Faith

The Panel infers Respondent receives click-through fees for diverting Internet users to various commercial websites, including its own commercial website. Respondent also appears to be selling its email addresses to advertisers. Respondent registered and used the disputed domain name in bad faith under Policy ¶4(b)(iv) as Respondent is using the <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names to intentionally attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant as to the source, sponsorship, affiliation or endorsement of its website. See *Kmart v. Khan*, FA 127708 (Nat. Arb. Forum Nov. 22, 2002) (finding that if the respondent profits from its diversionary use of the complainant's mark when the domain name resolves to commercial websites and the respondent fails to contest the complaint, it may be concluded that the respondent is using the domain name in bad faith pursuant to Policy ¶4(b)(iv)); see also *G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that the respondent registered and used the domain name in bad faith pursuant to Policy ¶4(b)(iv)).

because the respondent was using the confusingly similar domain name to attract Internet users to its commercial website).

Respondent is using the <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names, which contain Complainant's PADI mark, to redirect Internet users to Respondent's website featuring advertisements and links to diving-related websites that compete with Complainant's business. This suggests Respondent had actual knowledge of Complainant's rights in the mark when it registered the domain names and chose the disputed domain names based on the goodwill Complainant has acquired in its PADI mark. Respondent's registration of domain names containing Complainant's mark in spite of Respondent's actual knowledge of Complainant's rights in the mark is evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii). *See Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration); *see also Pfizer, Inc. v. Suger*, D2002-0187 (WIPO Apr. 24, 2002) (finding that because the link between the complainant's mark and the content advertised on the respondent's website was obvious, the respondent "must have known about the Complainant's mark when it registered the subject domain name").

The Panel finds Policy ¶4(a)(iii) has been 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 <**padidivemaster.com**>, <**padiinstructor.com**> and <**padirescuediver.com**> domain names be **TRANSFERRED** from Respondent to Complainant.

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: November 10, 2005