



NATIONAL ARBITRATION FORUM

DECISION

SAS Institute Inc. v. Tao Li
Claim Number: FA0709001082366

PARTIES

Complainant is **SAS Institute Inc.** ("Complainant"), represented by **Maury M. Tepper**, of **Womble Carlyle Sandridge & Rice, PLLC**, 150 Fayetteville Street, Suite 2100, PO Box 831, Raleigh, NC 27602. Respondent is **Tao Li** ("Respondent"), 10805 Will Painter Dr, Owings Mills, MD 21117.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**sasforum.org**>, registered with **Schlund+Partner AG**.

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 27, 2007; the National Arbitration Forum received a hard copy of the Complaint on September 28, 2007.

On October 2, 2007, Schlund+Partner AG confirmed by e-mail to the National Arbitration Forum that the <**sasforum.org**> domain name is registered with Schlund+Partner AG and that Respondent is the current registrant of the name. Schlund+Partner AG has verified that Respondent is bound by the Schlund+Partner AG 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 8, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 29, 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@sasforum.org by e-mail.

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

On November 2, 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.

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

Complainant makes the following assertions:

Complainant owns the following United States Trademark Registrations, among many others, for the mark SAS for computer software (Class 9), computer training manuals (Class 16) for educational services, namely, conducting seminars in computer training (Class 41), and for other related software and communications tools (collectively, the "SAS Marks").

SAS (U.S. Reg. Nos. 1,132,122; 2,484,944; 2,593,712; 2,657,842; 2,687,081)
SAS COM (U.S. Reg. No. 2,583,378)
SAS/SHARE (U.S. Reg. No. 1,459,092)
SAS CONSULTING (U.S. Reg. No. 1,606,066)
SAS TRAINING (U.S. Reg. No. 1,335,471)
SAS/TUTOR (U.S. Reg. No. 1,742,211)
SAS ONLINE TUTOR (U.S. Reg. No. 2,333,514)

FACTUAL AND LEGAL GROUNDS.

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

1. FACTUAL BACKGROUND

A. Complainant and its SAS Marks

Complainant was founded in 1976 and has since that time continually and exclusively used the SAS mark to identify its computer software-related products and services.

Today, Complainant is the largest privately-owned software company in the world and serves more than tens of thousands of business, government and university sites across 119 countries. The SAS Marks are recognized and identified worldwide to identify excellence in software solutions, software consulting services and software performance support. Complainant's products and services are advertised over the Internet via a Web Site hosted at the address SAS.COM. Complainant has expended considerable time and resources in promoting its SAS Marks and enjoys tremendous goodwill and recognition in these marks.

B. Respondent's Activities

As noted above, Respondent registered the Domain Name in dispute on July 13, 2006. The Domain Name is used in connection with what appears to be a website discussing "SAS products," "SAS programming," "SAS training and certificate[s]," and statistical applications. Clicking on any of the above topics, however, takes the user to a forum discussing a variety of pornographic topics.

LEGAL GROUNDS

A. The Domain Name is Confusingly Similar to Complainant's Trademark

Complainant respectfully asserts that Respondent's Domain Name is legally equivalent and confusingly similar to Complainant's SAS Marks. The Domain Name contains the Complainant's entire trademark with a descriptive term added. Although the Domain Name differs slightly from Complainant's trademark, the differences are insignificant and do not prevent the Domain Name from being confusingly similar to Complainant's trademark.

The addition of the descriptive word "forum" to Complainant's well-known trademark is insufficient to avoid a likelihood of confusion between the Domain Name and Complainant's mark. The Domain Name consists solely of Complainant's SAS trademark and the word "forum," which is merely descriptive of the function of websites in general. Several panels have found that the addition of generic or merely descriptive words to another's trademark creates a confusingly similar domain name and have ordered the transfer of such domain names. See *Google Inc. v. Smith Smithers* (Nat. Arb. Forum Dec. 7, 2006 (finding googleforums.com confusingly similar to the trademark Google); see also *Am. Online Inc. v. Neticq.com Ltd.*, D2000-1606 (WIPO Feb. 12, 2001) (finding that the addition of the generic word "Net" to the complainant's ICQ mark, makes the <neticq.com> domain name confusingly similar to the complainant's mark).

The fact that the Domain Name adds the ".org" top level domain name to Complainant's trademark does not keep the Domain Name from being confusingly similar to Complainant's mark. A number of panels applying the Policy have held that the addition of a top level domain, such as .us, .com, .net, or .org, to a trademarked word does not sufficiently differentiate the resulting domain name from the trademark wholly

incorporated in that domain name so that the domain name does not infringe the trademark incorporated therein. *See Actelion Pharmaceuticals Ltd. v. Kumar Bhatt dba Bosentan.com* (Nat. Arb. Forum Oct. 31, 2001) (finding respondent's domain name bosentan.com to be identical to complainant's BOSENTAN mark); *see also Boehringer Ingelheim Corp. v. Bhatt*, FA 560011 (Nat. Arb. Forum Aug. 11, 2000) (finding meloxicam.com and telmisartan.com identical to drugs MELOXICAM and TELMISARTAN); *Pomellato S.p.A. v. Tonneti*, D2000-0493 (WIPO July 7, 2000) (finding pomellato.com identical to Complainant's mark, because addition of generic top-level domain after POMELLATO is not relevant). Because the Domain Name consists solely of Complainant's GSK trademark with the addition of the descriptive term "forum," the Domain Name and Complainant's mark are confusingly similar.

The fact that the Domain Name has been registered in order to be confusingly similar to Complainant's trademarks is made even more clear by the fact that Complainant has been operating the website SAS.COM since 1990, 16 years prior to registration of the Domain Name. Complainant has common law use of SAS.COM since at least as early as the registration of the Domain Name.

B. Respondent Has No Rights or Legitimate Interests in the Domain Name

Complainant respectfully asserts that Respondent has no legitimate rights or interest in respect of the Domain Name.

Decisions applying the Policy have found that the fact that a Respondent is not known by a mark indicates the Respondent has no rights in the mark. *See Strojirny v. Rautiainen*, D2000-1394 (WIPO Dec. 20, 2000) (finding that respondent has no rights or legitimate interests in the domain name where respondent is not commonly known by the distinct ADAST mark and has made no use of the domain name in question); *Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that respondent does not have rights in domain name when respondent is not known by the mark); *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights where Respondent was not commonly known by the mark and never applied for a license from Complainant).

Respondent has no connection or affiliation with Complainant, and Complainant has not consented to Respondent's use of the Domain Name. Further, neither Respondent nor its business are known by the name "SAS" or "SAS Forum."

C. Respondent Has Registered and Is Using the Domain Name in Bad Faith

Complainant respectfully asserts that the Respondent has registered the Domain Name in bad faith. Paragraph 4(b) of the Policy sets forth a non-exclusive list of factors for determining bad faith.

The Respondent is attempting to increase its own internet traffic through association with Complainant's trademarked name. Use of the Domain Name will likely cause confusion as to Complainant's sponsorship of or affiliation with the resulting website. Complainant operates a web site at *SASFORUM.ORG* which prominently displays Complainant's trademark in connection with what appears to be a computer software forum. Users must register their personal information in order to participate, at which point they will be allowed to discuss a variety of sexually explicit topics.

Because the mark "SAS" is a well-known mark used to identify Complainant's computer products and services, it is clear that the Respondent registered the Domain Name with the intent to divert users seeking information about Complainant's products and services to Respondent's web site. Such use for Respondent's own commercial gain is additional evidence of Respondent's bad faith registration and use pursuant to Policy ¶4(b)(iv). See *Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with the complainant's well-known marks, thus creating a likelihood of confusion strictly for commercial gain).

Further, the diversion of a domain name to a pornographic web site, whatever Respondent's motivation, is in and of itself evidence that the disputed domain name was registered and is being used in bad faith. See *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. D2003-0022; *Caledonia Motor Group Limited v. Amizon*, WIPO Case No. D2001-0860; *Bass Hotels & Resorts, Inc. v. Mike Rodgerall*, WIPO Case No. D2000-0568.

Respondent's use of Complainant's entire mark in the Domain Name serves as an additional indication of bad faith. The use by Respondent of Complainant's entire mark makes it difficult to infer a legitimate use of the Domain Name by Respondent. In *Cellular One Group v. Paul Brien*, WIPO Case No. D2000-0028 (March 10, 2000), complainant filed a WIPO complaint against the registrant of domain name *cellularonechina.com*. The WIPO panel agreed with complainant that the registrant unlawfully registered an identical or confusingly similar domain name in bad faith. Moreover, the Panel inferred bad faith use of *cellularonechina.com*, because the domain name included Complainant's entire coined trademark.

As in *Cellular One*, use by Respondent of Complainant's entire mark makes it difficult to infer a legitimate use of the Domain Name. Respondent's Domain Name uses the entirety of Complainant's well-known SAS mark with the addition of the descriptive term "forum." On the website associated with the Domain Name, Respondent prominently displays Complainant's trademark in connection with what appears to be a software forum. No plausible explanation exists as to why Respondent selected an almost identical version of this mark as part of the Domain Name other than to trade on the goodwill of Complainant.

Finally, Respondent had constructive notice of Complainant's SAS mark prior to the selection of the Domain Name. Complainant's federal registrations, dating back to at

least as early as 1980, serve as constructive notice of its use of the SAS Marks. See *Pfizer, Inc. v. United Pharmacy, Ltd.*, D2001-0446 (WIPO June 8, 2001) (actual or constructive knowledge of the complainant's rights in the trademarks is a factor supporting bad faith); see also *Expedia, Inc. v. European Travel Network*, WIPO Case No. D2000-0137 (April 18, 2000); *Document Technologies v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270 (June 6, 2000) (respondent's knowledge of complainant's mark at the time of registration of the domain name suggests bad faith); *CCA Industries v. Dailey* (bikinizone.com), WIPO Case No. D2000-0148 (constructive notice found where domain name confusingly similar to complainant's mark and mark registered prior to respondent's domain name).

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

FINDINGS

Complainant, SAS Institute Inc., is the largest privately-owned software company in the world and has offered computer software-related products and services since 1976 under its SAS family of marks. Complainant serves tens of thousands of businesses, governments, and universities in more than 119 countries. Complainant holds several registrations for its marks with the United States Patent and Trademark Office ("USPTO"), including its SAS mark (Reg. No. 1,132,122 issued April 1, 1980; Reg. No. 2,484,944 issued September 4, 2001; Reg. No. 2,593,712 issued July 16, 2002; Reg. No. 2,657,842 issued December 10, 2002; and Reg. No. 2,687,081 issued February 11, 2003). Complainant also operates a website located at the <sas.com> domain name.

Respondent, Tao Li, registered the <sasforum.org> domain name on July 13, 2006. Respondent has located a website at the disputed domain name which appears to be an online forum for Internet users to discuss Complainant's products and services. However, once a forum link is clicked on the website, the Internet user is passed through to a page displaying several hyperlinks to websites featuring adult-oriented content.

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

Policy ¶4(a)(i) places the burden on Complainant to establish its rights in the SAS mark. The Panel concludes Complainant’s registrations of its mark with the USPTO adequately establish Complainant’s rights as contemplated by the Policy. *See Janus Int’l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (“Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.”); *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.”).

The <sasforum.org> domain name fully incorporates Complainants SAS mark and simply appends the mark with the generic term “forum” and generic top-level domain (“gTLD”) “.org.” These simple additions are inadequate to distinguish the disputed domain name from the SAS mark. It is common practice in the computer industry to have forums on software. Therefore, the Panel concludes the disputed domain name is confusingly similar to Complainant’s mark. *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 Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that “[n]either the addition of an ordinary descriptive word . . . nor the suffix ‘.com’ detract from the overall impression of the dominant part of the name in each case, namely the trademark SONY” and thus Policy ¶4(a)(i) is satisfied).

The Panel concludes Complainant satisfied Policy ¶4(a)(i).

Rights or Legitimate Interests

Under Policy ¶4(a)(ii), Complainant must present a *prima facie* case Respondent lacks all rights and legitimate interests in the disputed domain name. Complainant’s complaint is sufficient to shift the burden to Respondent to show he or she holds rights or legitimate interests in the disputed domain name pursuant to the Policy. *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).”).

As in the current case, when a respondent fails to submit a response, the Panel may presume Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶4(a)(ii). *See Do the Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (“Failure of a respondent to come forward to [contest complainant’s allegations] is tantamount to admitting the truth of complainant’s assertions in this regard.”); *see also BIC Deutschland GmbH & Co. KG v. Tweed*, D2000-0418 (WIPO June 20, 2000) (“By not submitting a response, Respondent has failed to invoke any circumstance which could demonstrate, pursuant to ¶4(c) of the Policy, any rights or legitimate interests in the domain name”). The Panel is not required to do so, but will review the evidence to determine if Respondent holds any rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c).

Nothing in the evidence persuades the Panel Respondent “Tao Li” is commonly known by the <sasforum.org> domain name. Consequently, the Panel finds Respondent is unable to establish rights under Policy ¶4(c)(ii). *See Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) (“Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name ‘welsfargo’ in any derivation.”); *see also Am. W. Airlines, Inc. v. Paik*, FA 206396 (Nat. Arb. Forum Dec. 22, 2003) (“Respondent has registered the domain name under the name ‘Ilyoup Paik a/k/a David Sanders.’ Given the WHOIS domain name registration information, Respondent is not commonly known by the [<awvacations.com>] domain name.”).

Respondent’s use of the disputed domain name to redirect unsuspecting Internet users clicking on “forum” links to the hyperlinks of websites containing adult-oriented content is neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii). Complainant’s product has nothing to do with sex or pornography. Links to pornographic web sites under the guise of a “forum” about a computer statistical package is a *non sequitur*. Therefore, the Panel determines Respondent is unable to establish rights or legitimate interests under Policy ¶4(c). *See Paws, Inc. v. Zuccarini*, FA 125368 (Nat. Arb. Forum Nov. 15, 2002) (holding

that the use of a domain name that is confusingly similar to an established mark to divert Internet users to an adult-oriented website “tarnishes Complainant’s mark and does not evidence noncommercial or fair use of the domain name by a respondent”); *see also Target Brands, Inc. v. Bealo Group S.A.*, FA 128684 (Nat. Arb. Forum Dec. 17, 2002) (finding that use of the <targetstore.net> domain name to redirect Internet users to an adult-oriented website did not equate to a *bona fide* offering of goods or services under Policy ¶4(c)(i), or a legitimate noncommercial or fair use of a domain name under Policy ¶4(c)(iii))

The Panel concludes Complainant satisfied Policy ¶4(a)(ii).

Registration and Use in Bad Faith

The website located at the <**sasforum.org**> domain name appears to be a legitimate forum for Internet users to discuss Complainant’s products and services. However, once unsuspecting Internet users click on one of the forum links, they are transported to a display of sexually explicit links to websites containing adult-oriented content (which has nothing to do with Complainant’s product). The Panel notes Respondent’s use of the disputed domain name to divert Internet users to adult-oriented material is sufficiently within Policy ¶4(a)(iii)’s contemplation of bad faith registration and use. The Panel finds the ruse employed by Respondent to lure unsuspecting Internet users is a further indication of bad faith registration and use under Policy ¶4(a)(iii). *See Wells Fargo & Co. v. Party Night Inc.*, FA 144647 (Nat. Arb. Forum Mar. 18, 2003) (finding that the respondent’s tarnishing use of the disputed domain names to redirect Internet users to adult-oriented websites was evidence that the domain names were being used in bad faith); *see also Six Continents Hotels, Inc. v. Nowak*, D2003-0022 (WIPO Mar. 4, 2003) (“[W]hatever the motivation of Respondent, the diversion of the domain name to a pornographic site is itself certainly consistent with the finding that the Domain Name was registered and is being used in bad faith.”).

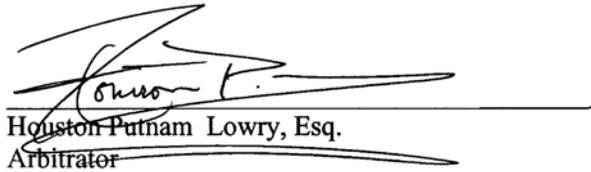
Respondent’s use of the confusingly similar <**sasforum.org**> domain name is likely to cause confusion among Internet users as to Complainant’s sponsorship of or affiliation with the resulting adult-oriented websites. Respondent apparently has been capitalizing off this confusion by collecting click-through fees for each misdirected Internet user. The Panel finds this to be further evidence of its bad faith registration and use under Policy ¶4(b)(iv). *See Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where the respondent directed Internet users seeking the complainant’s site to its own website for commercial gain); *see also Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) (“Registration and use of a domain name that incorporates another’s mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.”).

The Panel concludes Complainant satisfied Policy ¶4(a)(iii).

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 <sasforum.org> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Monday, November 16, 2007

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