

NATIONAL ARBITRATION FORUM

DECISION

The Wooden Soldier Ltd. v. RareNames, WebReg
Claim Number: FA0608000778960

PARTIES

Complainant is **The Wooden Soldier Ltd.** (“Complainant”), represented by **Scott C. Rand**, of **McLane, Graf, Raulerson & Middleton, P.A.**, 900 Elm St., P.O. Box 326, Manchester, NH 03105-0326. Respondent is **RareNames, WebReg** (“Respondent”), represented by **Ari Goldberger**, of **ESQwire.com Law Firm** 35 Cameo Drive, Cherry Hill, NJ 08003.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**woodensoldier.com**>, registered with **Domaindiscover**.

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.

Sandra J. Franklin, Houston Putnam Lowry, and David E. Sorkin as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on August 15, 2006; the National Arbitration Forum received a hard copy of the Complaint on August 18, 2006.

On August 17, 2006, Domaindiscover confirmed by e-mail to the National Arbitration Forum that the <**woodensoldier.com**> domain name is registered with Domaindiscover and that the Respondent is the current registrant of the name. Domaindiscover has verified that Respondent is bound by the Domaindiscover 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 August 22, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of September 11, 2006 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@woodensoldier.com by e-mail.

A timely Response was received and determined to be complete on September 11, 2006.

Complainant filed a timely Additional Submission on September 18, 2006. Respondent filed a timely Reply on September 25, 2006.

On September 27, 2006, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed David E. Sorkin, Houston Putnam Lowry and Sandra J. Franklin as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant contends the following:

1. Respondent's <**woodensoldier.com**> domain name is confusingly similar to Complainant's THE WOODEN SOLDIER mark.
2. Respondent does not have any rights or legitimate interests in the <**woodensoldier.com**> domain name.
3. Respondent registered and used the <**woodensoldier.com**> domain name in bad faith.

B. Respondent states the following:

1. Respondent's <**woodensoldier.com**> domain name is not confusingly similar to Complainant's THE WOODEN SOLDIER mark because it does not include the word "the", which is enough to distinguish a common term.
2. Respondent has rights and legitimate interests because "wooden soldier" is a common term, and because it posts links related to toys at <**woodensoldier.com**>
3. Respondent did not register and use the <**woodensoldier.com**> domain name in bad faith because it did not know of Complainant's trademark rights in THE WOODEN SOLDIER.

C. Additional Submissions

1. Complainant argues further that Respondent posts links to direct competitors of Complainant at <**woodensoldier.com**>.
2. Respondent further states that the link to "kids" at <**woodensoldier.com**> is just a generic category that it uses at all of its "hundreds of thousands" of other domain names.

FINDINGS

Complainant has been using the THE WOODEN SOLDIER mark in interstate commerce since 1977 to sell retail and mail order clothing, kids clothing, and novelty items. Complainant holds a U.S. Trademark Registration, showing use back to 1977. Complainant used the <woodensoldier.com> domain name from 1999 to 2004, when it inadvertently lapsed due to the bankruptcy of its service provider, whereupon Respondent snatched it up. In response to a cease and desist letter from Complainant, Respondent offered to sell the domain name back to Complainant for \$33,000, and subsequently for \$7,000.

DISCUSSION

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

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

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

Identical and/or Confusingly Similar

The Panel finds that Complainant has established rights in the THE WOODEN SOLDIER mark through registration under Policy ¶ 4(a)(i). *See 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."); *see also 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.")

Respondent's <woodensoldier.com> domain name is confusingly similar to Complainant's THE WOODEN SOLDIER mark, as it simply omits the word "the" from Complainant's mark. Such an omission is not enough to negate the confusing similarity between Complainant's mark and the <woodensoldier.com> domain name. *See Antoun v. Truth Squad*, FA 114766 (Nat. Arb. Forum Aug. 21, 2002) (stating that the article "the" is "often added only for grammatical purposes, and may be superfluous to the name itself"). While Respondent contends that the <woodensoldier.com> domain name is comprised of common, generic terms and as such cannot be found to be

confusingly similar to Complainant's mark, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i), as this portion of the Policy considers only whether the disputed domain name is confusingly similar to Complainant's mark, and thus whether the disputed domain name is comprised of common, generic terms is not relevant in a Policy ¶ 4(a)(i) analysis.

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

Rights or Legitimate Interests

Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests pursuant to Policy ¶ 4(a)(ii). See *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").

Complainant contends that Respondent has no legitimate rights or interests in the <**woodensoldier.com**> domain name, but is using Complainant's mark to attract Internet users to Respondent's website for the commercial benefit of Respondent, particularly through the earning of click-through fees. The Panel finds that Respondent has not made 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). See *WeddingChannel.com Inc. v. Vasiliev*, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that the respondent's use of the disputed domain name to redirect Internet users to websites unrelated to the complainant's mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the Policy); see also *Disney Enters., Inc. v. Dot Stop*, FA 145227 (Nat. Arb. Forum Mar. 17, 2003) (finding that the respondent's diversionary use of the complainant's mark to attract Internet users to its own website, which contained a series of hyperlinks to unrelated websites, was neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names); see also *Computer Doctor Franchise Sys., Inc. v. Computer Doctor*, FA 95396 (Nat. Arb. Forum Sept. 8, 2000) (finding that the respondent's website, which is blank but for links to other websites, is not a legitimate use of the domain names).

Respondent's WHOIS information does not indicate that Respondent is commonly known by the <**woodensoldier.com**> domain name and Complainant has asserted that Respondent is not authorized to use Complainant's mark. 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 *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).

Additionally, Complainant previously held the disputed domain name, and asserts that it lost holding through the fault of its service provider when this provider declared bankruptcy. *See Am. Anti-Vivisection Soc’y v. “Infa dot Net” Web Servs.*, FA 95685 (Nat. Arb. Forum Nov. 6, 2000) (finding that the complainant’s prior registration of the same domain name is a factor in considering the respondent’s rights or legitimate interests in the domain name).

Finally, Respondent is using <**woodensoldier.com**> to post links to competitors of Complainant, further supporting no legitimate interests. In *TM Acquisition Corp. v. Sign Guards*, FA 132439 (Nat. Arb. Forum Dec. 31, 2002), the panel found that the respondent’s diversionary use of the complainant’s marks to send Internet users to a website which displayed a series of links, some of which linked to the complainant’s competitors, was not a *bona fide* offering of goods or services.

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

Registration and Use in Bad Faith

This case turns on the question of bad faith. Respondent contends that it was not aware of Complainant’s trademark rights in THE WOODEN SOLDIER. This Panel finds it very improbable that Respondent, a savvy purchaser of “hundreds of thousands” of domain names, would not have done a search and quickly found Complainant on the Internet, both as the previous holder of the <**woodensoldier.com**> domain name and a long-standing retail presence; indeed, a cursory search of the U.S. Patent and Trademark Office website would have uncovered Complainant’s registration of THE WOODEN SOLDIER mark. *See Digi Int’l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (“[T]here is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively”); *see also Orange Glo Int’l v. Blume*, FA 118313 (Nat. Arb. Forum Oct. 4, 2002) (“Complainant’s OXICLEAN mark is listed on the Principal Register of the USPTO, a status that confers constructive notice on those seeking to register or use the mark or any confusingly similar variation thereof.”); *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”).

We do not believe it is just coincidence that Respondent posts direct competitors of Complainant at <**woodensoldier.com**>. This in itself is evidence of bad faith. *See EBAY, Inc. v. MEODesigns*, D2000-1368 (Dec. 15, 2000) (finding that the respondent registered and used the domain name <ebay.com> in bad faith where the respondent has used the domain name to promote competing auction sites). Though Respondent stated that it uses <**woodensoldier.com**> to post links related to selling toys, it did not provide any supporting exhibits. The fact that the words “wooden soldier” appear often on the Internet means nothing, as all words can be found in abundance on the Internet. Respondent provides a copy of the website <colonialsoldier.com>, which only shows that

even a seller of wooden soldiers can avoid using the terms “wooden soldier” in its domain name.

The Panel finds that Respondent registered the disputed domain name for the purpose of commercially benefiting from the good will associated with Complainant’s mark. *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).

Respondent’s bad faith registration and use is further demonstrated through its offer to sell the <**woodensoldier.com**> domain name to Complainant, first for \$33,000 and later for \$7,000, well above its out-of-pocket costs. *See Neiman Marcus Group, Inc. v. AchievementTec, Inc.*, FA 192316 (Nat. Arb. Forum Oct. 15, 2003) (finding the respondent’s offer to sell the domain name for \$2,000 sufficient evidence of bad faith registration and use under Policy ¶ 4(b)(i)); *see also 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).

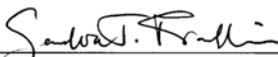
The Panel finds that Policy ¶ 4(a)(iii) has been satisfied.

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 <**woodensoldier.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

We respectfully disagree with our brother Panelist's dissent below. If it were adopted, any registered trademark which consisted of a misapplied description (such as Scotch® tape) would be without a remedy under the UDRP. Such a restrictive reading of the UDRP is unnecessary and unwise.


Sandra J. Franklin, Esq.
Arbitrator


Houston Putnam Lowry, Esq.
Arbitrator

Sandra J. Franklin, Panelist
Houston Putnam Lowry, Panelist

Dated: October 11, 2006

DISSENT

I respectfully dissent. The evidence before the Panel indicates that Respondent has used the disputed domain name exclusively in its generic or descriptive sense, as the name of a children’s

toy, and in a related suggestive sense, to refer to the class of toys in general; and that Respondent registered the domain name for these reasons rather than for reasons related to Complainant or its mark. Complainant uses the term “wooden soldier” in a different sense, as a suggestive trademark for children’s clothing and related products. The only evidence of use by Respondent that relates even remotely to Complainant’s trademark use is contained in Complainant’s additional submission, which I believe should not be considered by the Panel, for the reasons stated in *Deep Foods, Inc. v. Jamruke, LLC*, Case No. FA648190 (Nat’l Arb. Forum Apr. 10, 2006).

Even if Complainant’s additional submission is to be considered, however, the only evidence of trademark-related use is so indirect as to be inconsequential. Respondent uses the disputed domain name to redirect Internet users to a web page comprised of “sponsored results” links, with a list of “related links” in smaller type in the right margin, and a longer list of links to “related categories” in even smaller type at the bottom of the page. One of these “related categories” is “Kids.” Selecting the “Kids” link takes the user to a similar page captioned “KidsGuides.com.” On that page, under “related links” in the right margin, there is a link to “Kids Clothes”—a page that apparently includes links to competitors of Complainant. Under these circumstances, I do not see how it can seriously be contended that Respondent is using the disputed domain name in a manner related to Complainant’s mark.

Respondent states (and supports this statement with a signed affidavit) that its reason for registering the disputed domain name was related solely to its descriptive sense, as the name of a children’s toy, and not because of its correspondence to Complainant’s mark. The majority notes that Respondent has not provided any evidence to support its claim that it uses the disputed domain name to post links related to selling toys. However, the burden of proof here is on Complainant, and in any event, Complainant itself provided such evidence, both accompanying the Complaint and in its additional submission. The only evidence tending to belie Respondent’s claim that its registration and use of the disputed domain name were motivated by its descriptive sense rather than its trademark sense is the fact that Respondent’s asking price for the domain name is so high. But I do not find it entirely implausible that a price of \$7,000 or even \$33,000 could be supported by the descriptive sense of the domain name. And even if Respondent adjusted its expectations for the domain name sharply upward after receiving an inquiry from Complainant and subsequently learning of Complainant’s trademark, it does not follow that Respondent’s initial motivation for registering the domain name was related in any way to Complainant or its mark.

In my view Complainant has failed to meet its burden of proving that Respondent registered the domain name in bad faith.



Professor David Sorkin
Arbitrator

David E. Sorkin, Panelist