



## NATIONAL ARBITRATION FORUM

### DECISION

Yahoo! Inc. v. Teodulo Cabrera a/k/a Roccaforte Vision Entertainment  
Claim Number: FA0806001210332

#### PARTIES

Complainant is **Yahoo! Inc.** ("Complainant"), represented by **David M. Kelly**, of **Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P.**, Washington, D.C., USA. Respondent is **Teodulo Cabrera a/k/a Roccaforte Vision Entertainment** ("Respondent"), Germany.

#### REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**yahoosexxx.com**> and <**youtube-yahoo.com**>, registered with **Dotster**.

#### 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 June 18, 2008; the National Arbitration Forum received a hard copy of the Complaint on June 19, 2008.

On June 18, 2008, Dotster confirmed by e-mail to the National Arbitration Forum that the <**yahoosexxx.com**> and <**youtube-yahoo.com**> domain names are registered with Dotster and that Respondent is the current registrant of the names. Dotster has verified that Respondent is bound by the Dotster 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 June 23, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 14, 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@yahoosexxx.com and postmaster@youtube-yahoo.com by e-mail.

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

On July 22, 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 names be transferred from Respondent to Complainant.

### **PARTIES' CONTENTIONS**

A. Complainant makes the following assertions:

#### **Yahoo! and its Services**

1. Yahoo! is a global Internet communications, media, and commerce company that delivers a branded network of comprehensive searching, directory, information, communication, shopping services and other online activities and features to millions of Internet users daily.

2. Yahoo! is the owner of the service mark and trademark YAHOO!, the trade name YAHOO! as well as the domain name <yahoo.com>. In continuous use since 1994, the YAHOO! mark has become one of the most recognized brands in the world, and has been ranked as one of the top 100 global brands in the 2008 "BRANDZ Top 100 Most Powerful Brands" report issued by Millward Brown in cooperation with the Financial Times, and the 2007 BusinessWeek/Interbrand Annual Brand Report.

3. The main YAHOO! website, located at the domain name <yahoo.com>, has long been one of the leading websites on the Internet. For example, during the month of December 2007, the YAHOO! site received an average of approximately 5.5 billion page views per day from the world over. Yahoo!'s global audience was more than 647 million unique users in December 2007 (excluding Yahoo! Japan). More than 253 million active registered members from around the world (excluding Yahoo! Japan) logged onto their personalized YAHOO! accounts during December 2007 (e.g., to participate in Yahoo!'s registered member services, including shopping, classifieds, e-mail, clubs, calendars, message boards, chat rooms, and more). In addition, comScore Media Metrix ranked Yahoo! as the number one website in the U.S. in October 2007, with 136,775,000 unique visitors.

4. Yahoo!'s services include both local and international Internet search services covering a wide variety of subjects and media, including web, image and video search, and network software and services including, but not limited to, astrology, auctions, chat, corporate network software and services, e-mail, finance, games, greetings, groups, health, high-speed Internet and DSL, instant messenger, job search, maps, message boards, mobile services, movie information and reviews, music, news, people search, personals, photos, real estate and mortgage information, shopping, sports, television listings, travel-related services, weather, yellow pages, and entertainment.

5. In addition to the variety of services offered at Yahoo!'s main site located at the domain name <yahoo.com>, Yahoo! (either directly or through its licensees and related companies) operates many additional sites under the YAHOO! mark and using YAHOO!-formative trademarks and domain names, including sites specific to particular countries or regions such as Argentina, Asia, Australia, Austria, Brazil, Canada, China, Denmark, Finland, France, Germany, Greece, Hong Kong, India, Indonesia, Italy, Japan, Korea, Malaysia, Mexico, Netherlands, New Zealand, Norway, Philippines, Québec, Russia, Singapore, Spain, Sweden, Switzerland, Taiwan, Thailand, the United Kingdom and Ireland, and Vietnam.

6. Yahoo!'s website for Germany, where Respondent resides, is located at the URL <de.yahoo.com>.

7. Yahoo! offers and has offered for years a wide variety of services using its YAHOO! mark together with a descriptive name of the services. These include, for example, YAHOO! Mail, YAHOO! Finance, YAHOO! Games, YAHOO! Messenger, YAHOO! Movies, YAHOO! Music, YAHOO! News, YAHOO! Sports, and YAHOO! Weather.

8. Seventy (70) UDRP decisions involving the YAHOO! mark have been issued in Yahoo!'s favor, and the Panelists in at least thirty-seven (37) of these cases expressly found the YAHOO! mark to be famous.

### **Yahoo!'s Trademark Holdings**

9. Yahoo!'s YAHOO! mark is protected in countries around the world including Germany—where Respondent is located—and the United States.

10. Yahoo! owns numerous trademark registrations for the YAHOO! mark in the European Community that cover Germany where Respondent is located, including the following representative examples:

a. Registration No. 001076181 for the mark YAHOO! (block letters), priority date as early as August 13, 1998, filed February 12, 1999, and issued June 7, 2000, covering computer hardware, software, and accessories; instruction manuals; advertising services; travel services; online contests; and online computer services in International Classes 9, 16, 35, 39, 41, and 42.

b. Registration No. 001854215 for the mark YAHOO! (block letters), priority date as early as March 29, 2000, filed September 14, 2000, and issued November 20, 2001, covering computer software; publications; and financial and electronic commerce services in International Classes 9, 16, and 36.

c. Registration No. 002003150 for the mark YAHOO! (block letters), priority date as early as January 24, 1996, filed April 1, 1996, and issued March 5, 2002, covering scientific apparatus; jewelry; publications; leather goods; housewares; toys; education and entertainment services; and online computer services in International Classes 9, 14, 16, 18, 21, 28, 35, 41, and 42.

11. Yahoo! owns numerous trademark registrations for the YAHOO! mark in the U.S. including the following representative examples:

a. U.S. Registration 2,403,227 for the mark YAHOO! (block letters), first used June 1994, filed August 13, 1998, issued November 14, 2000, covering online advertising and retail services, telecommunications services, transportation services, computer services, and computer software in International Classes 35, 38, 39, 42, and 9.

b. U.S. Registration 2,040,222 for the mark YAHOO! (block letters), first used June 1, 1994, filed January 24, 1996, issued February 25, 1997, covering software, books, advertising services, and online services in International Classes 9, 16, 35, and 42.

c. U.S. Registration 2,187,292 for the mark YAHOO! (block letters), first used September 22, 1997, filed February 28, 1997, issued September 8, 1998, covering computer and online services in International Class 35.

d. U.S. Registration No. 2,040,691 for the mark YAHOO! (stylized), first used January 2, 1996, filed April 24, 1996, issued February 25, 1997, covering computer and online services International Class 42.

12. Yahoo!'s trademark rights in its YAHOO! mark and variations thereof predate Respondent's registration of the Domain Names.

### **Respondent's Infringing Activities and Bad-Faith Acts**

13. Respondent registered the Domain Names on January 11, 2008, long after Complainant began using its YAHOO! mark, long after Complainant's YAHOO! mark became famous worldwide, and long after Complainant registered its YAHOO! mark in the European Community, the U.S., and elsewhere.

14. Respondent uses the domain name <**yafoosexxx.com**> for a commercial website that offers directly competing Internet search services via search boxes displayed prominently on the pages of the website, and that features pay-per-click advertisements for pornographic websites.

15. Respondent uses the domain name <**youtube-yahoo.com**> for a commercial website that offers directly competing Internet search services via search boxes displayed prominently on the pages of the website, and that features pay-per-click advertisements for directly competing websites and other commercial websites. Some of these advertisements for third-party websites include text that plainly refers to Yahoo! and its services (e.g., “Yahoo Messenger Chat,” “Yahoo Mail”).

16. Respondent’s commercial pay-per-click websites are provided by the online advertising company RevenueDirect. Respondent undoubtedly receives commissions from RevenueDirect when Internet users click on the sponsored links displayed on Respondent’s websites.

17. Respondent owns at least two additional domain names that incorporate famous marks owned by third parties, namely, <1googlesex.com> and <myspace-sexxx.com>.

## **THE DOMAIN NAMES ARE CONFUSINGLY SIMILAR TO COMPLAINANT'S MARK**

18. The domain name <**yahoosexxx.com**> is confusingly similar to Complainant's famous YAHOO! mark because it is comprised of Complainant's mark and a misspelling of a generic term ("sexxx"). Omitting the exclamation point of Complainant's YAHOO! mark, as required under the DNS system that does not allow exclamation points in domain names, and combining Complainant's mark with a misspelling of a generic term renders the Domain Name confusingly similar to Complainant's mark. *See, e.g., Yahoo! Inc. and Overture Services, Inc. v. Lee*, FA 436932 (Nat. Arb. Forum April 26, 2005) (finding the domain names <pornoyahoo.com>, <yahooroups.com>, and <yahoomessenger.com> among others to be confusingly similar to Complainant's YAHOO! mark because the addition of a misspelled generic term does not differentiate respondent's domain names from Complainant's mark); *Yahoo! Inc. v. Domain Web* FA 128671 (Nat. Arb. Forum Dec. 31, 2002) (finding the domain name <yahoomail.com> to be confusingly similar to Complainant's YAHOO! mark); *see also Yahoo! Inc. v. WWW Enterprise et al.*, FA 535381 (Nat. Arb. Forum Sept. 28, 2005) (finding the domain name <yahoosex.org> among others to be confusingly similar to Complainant's YAHOO! mark); *Yahoo! Inc. v. Brotherton*, FA 778969 (Nat. Arb. Forum Sept. 22, 2006) (finding the domain names <yahoooy.com and yahoooyboys.com> confusingly similar to Complainant's YAHOO! mark and holding "the only special character allowed in a domain name is '-' and thus the string 'YAHOO!' cannot be registered as a domain name. Therefore, in order to obtain a domain name that includes and reflects its trademark, the Complainant has no choice except to register domain names containing the string 'yahoo.'"); *Yahoo! Inc. v. Whois Privacy Protection Service, Inc.*, FA 412705 (Nat. Arb. Forum Mar. 17, 2005) (finding the domain name <yahoomusic.com> confusingly similar to Complainant's YAHOO! mark because the addition of the generic term "music," the omission of the exclamation point, and the addition of the generic top-level domain ".com" are "minor alterations are insufficient to negate a finding of confusing similarity pursuant to Policy ¶4(a)(i).").

19. The domain name <**youtube-yahoo.com**> is confusingly similar to Complainant's YAHOO! mark because it is comprised of Complainant's mark without the impermissible exclamation point, the third party mark YOUTUBE, and a hyphen. UDRP Panels have consistently held that the addition of another's trademark in a domain name does not overcome a claim of confusing similarity. *See, e.g., Yahoo! Inc. v. M & A Enters.*, D2000-0748 (WIPO Nov. 3, 2000) (holding the domain name <visayahoo.com> comprised of Complainant's YAHOO! mark and the third-party mark VISA is confusingly similar to Complainant's mark); *Yahoo! Inc. and Overture Services, Inc. v. J. Lee*, FA 436932 (Nat. Arb. Forum April 26, 2005) (holding the domain names <yahooamericangreeting.com> and <fifaworldcupyahoo.com> comprised of Complainant's YAHOO! mark and the third-party marks AMERICAN GREETINGS, FIFA, and/or WORLD CUP are confusingly similar to Complainant's mark); *Yahoo! Inc. v. Edwards*, FA 535429 (Nat. Arb. Forum Sept. 26, 2005) (holding the domain names <sbbcyahoo.com>, <sbccyahoo.com>, <sbcyah00.com>, and <sbياهو.com> comprised of Complainant's YAHOO! mark and the third-party mark SBC are confusingly similar

to Complainant's mark); *G.D. Searle & Co. v. Pelham*, FA 117911 (Nat. Arb. Forum Sept. 19, 2002) (finding the domain name <doctorslink-viagra-xenical-propecia-celebrex.com> confusingly similar to the complainant's mark CELEBREX and holding "The addition of other [third-party] drug names does not create a distinct mark capable of overcoming a claim of [confusing] similarity, it merely creates a domain name with severe potential to confuse Internet users as to the source, sponsorship and affiliation of the domain name. This type of confusion is exactly the type that Policy ¶4(a)(i) is intended to prevent."); *G.D. Searle & Co. v. Christensen*, FA 100647 (Nat. Arb. Forum Dec. 4, 2001) (finding the domain name <celebrexclaritinpharmacy.com> confusingly similar to the complainant's mark CELEBREX despite the inclusion of the third-party mark CLARITIN).

### **RESPONDENT HAS NO LEGITIMATE INTEREST IN THE DOMAIN NAMES**

20. Respondent clearly has no rights or legitimate interest in the Domain Names for the following reasons.

21. First, Respondent is not and has not been commonly known by the Domain Names.

22. Second, Respondent's use of the Domain Names for commercial pay-per-click websites providing directly competing Internet search services and featuring links to pornographic, directly competing websites, and/or other commercial websites does not constitute a bona fide offering of goods or services or noncommercial fair use under the UDRP. *See, e.g., Yahoo! Inc. v. Zuccarini et al.*, FA 183997 (Nat. Arb. Forum Oct. 20, 2003) (holding respondent's use of the domain names <yahoofreeporn.com>, <yahooemal.com>, and <yahoofiance.com> among others for pornographic websites and to direct users to directly competing Internet search services does not constitute a bona fide offering of goods or services or noncommercial fair use); *Yahoo! Inc. v. Jalbert*, FA 166020 (Nat. Arb. Forum Aug. 26, 2003) (holding respondent's use of the domain names <yahhooecam.com>, <yahhoocams.com>, and <yahhoowebcams.com> for an adult-oriented website and respondent's use of the domain name <yahhoowebcam.com> for a website offering competing web directory services do not constitute a bona fide offering of goods or services or noncommercial fair use); *Yahoo! Inc. v. Chinayahoo.com*, FA 236538 (Nat. Arb. Forum Mar. 23, 2004) ("The use of a domain name confusingly similar to a mark to offer the same or similar services as those offered under the mark in competition with Complainant's services is not a use in connection with a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) or a non-commercial or fair use pursuant to Policy ¶4(c)(iii)."); *Yahoo! Inc. v. Edwards*, FA 535429 (Nat. Arb. Forum Sept. 26, 2005) (finding no legitimate interest in respondent's use of the domain names <baseballyahoo.com>, <financialsyahoo.com>, <footballyahoo.com>, <matchyahoo.com>, and <moneyyahoo.com> among others for pay-per-click websites); *Yahoo! Inc. v. WWW Enterprise et al.*, FA 535381 (Nat. Arb. Forum Sept. 28, 2005) (finding no legitimate interest in respondent's use of the domain names <auctionyahoo.net>, <blogyahoo.com>, <locallyahoo.net>, and <yahoovacationsstore.com> among others for pay-per-click websites).

## RESPONDENT'S BAD FAITH UNDER SECTION 4(B) OF THE UDRP

23. Respondent's registration and use of the Domain Names squarely meets the grounds of bad faith outlined in the UDRP, as well as additional grounds of bad faith defined in previous UDRP decisions.

24. First, Respondent's registration and use of the Domain Names meet the bad-faith element set forth in Section 4(b)(iv) of the UDRP because Respondent uses the Domain Names to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant and its YAHOO! mark as to the source, sponsorship, affiliation, and/or endorsement of Respondent and/or its pay-per-click websites. *See, e.g. Yahoo! Inc. v. Edwards*, FA 535429 (Nat. Arb. Forum Sept. 26, 2005) (holding respondent's use of the domain names <baseballyahoo.com>, <financialyahoo.com>, and <moneyyahoo.com> among others to divert Internet users searching under Complainant's YAHOO! mark to a commercial website, for which respondent presumably receives click-through fees, constitutes bad faith pursuant to Section 4(b)(iv)); *Yahoo! Inc. v. WWW Enterprise et al.*, FA 535381 (Nat. Arb. Forum Sept. 28, 2005) (holding respondent's use of the domain names <localyahoo.net> and <yahoovacationsstore.com> among others for websites featuring links to various third-party commercial websites, for which respondent presumably receives referral fees, constitutes bad faith pursuant to Section 4(b)(iv)); *Yahoo! Inc. v. Manage Technical*, FA 238649 (Nat. Arb. Forum Apr. 8, 2004) ("It is well established that when a domain name registrant incorporates a well-known registered mark in a domain name for the purpose of creating Internet-user confusion as to the sponsorship of the name and then uses it for commercial gain, the registrant has registered and used the name in bad faith pursuant to Policy ¶4(b)(iv).").

25. Second, Respondent's registration and use of the Domain Names to offer competing Internet search services, and its use of the domain name <youtube-yahoo.com> to display links to competing websites and/or third-party commercial websites, meet the bad-faith element set forth in Section 4(b)(iii) of the UDRP because Respondent's activities disrupt Complainant's business. *See, e.g., Yahoo! Inc. v. Chinayahoo.com*, FA 236538 (Nat. Arb. Forum Mar. 23, 2004) (holding respondent's use of the domain name <chinayahoo.com> to offer competing Internet search services constitutes bad faith pursuant to Section 4(b)(iii); *Yahoo! Inc. v. Jalbert*, FA 166020 (Nat. Arb. Forum Aug. 26, 2003) (holding respondent's use of the domain name <yahhoowebcam.com> for competing services constitutes bad faith pursuant to Section 4(b)(iii)); *TM Acquisition Corp. v. Lam*, FA 280499 (Nat. Arb. Forum July 9, 2004) (holding respondent's use of the disputed domain name for a commercial web directory website linking users to competing services constituted bad faith pursuant to Section 4(b)(iii) of the UDRP); *WeddingChannel.com, Inc. v. Jackson*, FA 273990 (Nat. Arb. Forum July 6, 2004) (holding respondent's registration of the disputed domain name to direct Internet users to a commercial website advertising services similar to complainant's constitutes bad faith pursuant to Section 4(b)(iii) of the UDRP).

26. Third, Respondent's use of the domain name <yahoosexxx.com> for a pornographic

website constitutes an independent ground for bad faith under prior UDRP decisions. *See, e.g., Yahoo! Inc. v. Zuccarini et al.*, FA 183997 (Nat. Arb. Forum Oct. 20, 2003) (holding respondent's use of the domain names <yahooofreeporn.com>, <yahooemal.com>, and <yahoofiance.com> among others for "pornographic websites and to offer search services in competition with Complainant demonstrate bad faith use as contemplated by the Policy."); *Yahoo! Inc. v. Jalbert*, FA 166020 (Nat. Arb. Forum Aug. 26, 2003) (holding respondent's use of the domain names <yahhoocam.com>, <yahhoocams.com>, and <yahhoowebcams.com> for an adult-oriented website indicates bad faith pursuant to Policy ¶4(a)(iii).

27. Fourth, Respondent has a bad-faith pattern of registering trademark-related domain names pursuant to Section 4(b)(ii) as shown by Respondent's registration of the two disputed Domain Names and its two additional domain names incorporating third-party marks references in Paragraph 29 above. *See, e.g., Yahoo! Inc. v. Syrynx*, D2000-1675 (WIPO Feb. 1, 2001) (respondent's registration of two domain names incorporating Complainant's mark constitutes bad faith); *H-D Michigan Inc. v. Network Operations Ctr.*, FA 671212 (Nat. Arb. Forum May 22, 2006) (holding respondent's registration of the domain names <harleydavidsonracing.com> and <harleydavidsonracers.com> constitutes bad faith pursuant to Policy ¶4(b)(ii) because respondent owns other domain names that incorporate third parties' trademarks).

28. Finally, Respondent undoubtedly registered the Domain Names in bad faith with knowledge of Complainant's trademark rights given (1) the international fame of Complainant's YAHOO! mark, (2) Complainant's registrations of its YAHOO! mark in the European Community, which covers Germany where Respondent is located, the U.S., and elsewhere, and (3) Respondent's use of the Domain Names to offer directly competing Internet search services and, in the case of <youtube-yahoo.com>, to advertise competing websites. Registration of a domain name with knowledge of the trademark owner's rights has been consistently found to constitute bad faith under the UDRP. *See, e.g., Yahoo! Inc. v. Yuan Zhe Quan*, FA 117877 (Nat. Arb. Forum Oct. 10 2002) (respondent's registration of the domain names with knowledge of Complainant's rights was in bad faith because "the YAHOO! mark has developed into one of the most famous marks associated with the Internet by way of the mark's use on the highly popular <yahoo.com> website."); *Yahoo! Inc. v. Pham*, FA 109699 (Nat. Arb. Forum May 21, 2002) ("Because of the famous and distinctive nature of Complainant's YAHOO! mark, [the respondent] is thought to have been on notice of the existence of Complainant's mark at the time [r]espondent registered the infringing [domain name]."); *Yahoo! Inc. v. Domain Web*, FA 128671 (Nat. Arb. Forum Dec. 31, 2002) (same); *Yahoo! Inc. v. Jalbert*, FA 166020 (Nat. Arb. Forum Aug. 26, 2003) ("It can be inferred that [r]espondent had either actual or constructive knowledge of Complainant's YAHOO! mark because the mark is registered with recognized authorities within the U.S. and Canada [where respondent is located], has been used in commerce since 1994, and [r]espondent registered several domain names that were confusingly similar to the YAHOO! mark. Registration of a domain name, despite knowledge of Complainant's rights in the mark, is evidence of bad faith registration pursuant to Policy ¶4(a)(iii)."); *Yahoo! Inc. v. Deiana*, FA 339579 (Nat. Arb. Forum Nov. 22, 2004) ("it is found and

determined that because of the fame of Complainant's YAHOO! mark, and because [r]espondent has used some of the disputed domain names for directly competing websites, it is obvious that [r]espondent had actual notice of Complainant's rights in the YAHOO! mark prior to registering the disputed domain names. Thus, it is found and determined that [r]espondent registered and used the disputed domain names in bad faith pursuant to Policy ¶4(a)(iii).").

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

## **FINDINGS**

Complainant, Yahoo!, Inc., is an international Internet communications, media and commerce company that provides Internet users with search engine, directory, information, communication and shopping services. Complainant registered its YAHOO! mark with the Office of Harmonization for the Internal Market ("OHIM") on June 7, 2000 (Reg. No. 1,076,181). Complainant also registered its YAHOO! mark with the United States Patent and Trademark Office ("USPTO") on November 14, 2000 (Reg. No. 2,403,227).

Respondent's disputed domain names were registered on January 11, 2008. Respondent's <**yahoosexxx.com**> domain name resolves to a website that offers search engine capabilities and advertisement links to websites with adult-oriented content. Respondent's <**youtube-yahoo.com**> domain name resolves to a website that offers search engine capabilities and advertisement links to products and services, some of which compete with Complainant's business. Complainant has provided evidence that Respondent is using the disputed domain names in connection with RevenueDirect, a company that provides compensation for click-through advertisement links placed on a website.

## **PROCEDURAL ISSUE - MARKS OF MULTIPLE PARTIES**

Respondent's <**youtube-yahoo.com**> domain name incorporates two parties' marks and interests. In particular, Respondent's domain name implicates the owners of Complainant's YAHOO! mark. Due to practical difficulties inherent in the Policy, cooperative complaint initiation is unlikely and unfeasible. Because Complainant initiated this dispute prior to any other interested party, it has the opportunity to acquire the domain name, while seeking to protect its YAHOO! mark from an infringing use. However, due to the procedural complexities presented by the current dispute, the following issue must be addressed: that Complainant seeks acquisition of the subject domain name in good faith, and will forfeit its interest in the contested domain name if the other represented marks are infringed upon following a transfer of the domain name registration to Complainant. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (Complainant's continuing control of the <**viagra-xenical-celebrex-propecia-meridia-zyban.com**> domain name is contingent upon good faith possession, and Complainant will forfeit its interest in the domain name if it infringes on the other represented marks); *see also G.D. Searle v. Dunham*, FA 123901 (Nat. Arb. Forum Oct. 9, 2002) ("Complainant seeks acquisition of the subject domain name in good faith, and

will forfeit its interest in the contested domain name if the other represented marks are infringed upon following a transfer of the domain name registration to Complainant”).

## **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 provided evidence of the registration of its YAHOO! mark with the OHIM and the USPTO. The Panel finds these submissions adequately establish Complainant's rights in its YAHOO! mark pursuant to Policy ¶4(a)(i). *See KCTS Television Inc. v. Get-on-the-Web Ltd.*, D2001-0154 (WIPO Apr. 20, 2001) (holding that it does not matter for the purpose of paragraph 4(a)(i) of the Policy whether the complainant's mark is registered in a country other than that of the respondent's place of business); *see also U.S. Office of Pers. Mgmt. v. MS Tech. Inc.*, FA 198898 (Nat. Arb. Forum Dec. 9, 2003) ("[O]nce the USPTO has made a determination that a mark is registrable, by so issuing a registration, as indeed was the case here, an ICANN panel is not empowered to nor should it disturb that determination.").

Respondent's <**yaoosexxx.com**> domain name incorporates Complainant's YAHOO! mark with the deletion of an exclamation point, the addition of the misspelled generic term "sexxx," and the addition of the generic top-level domain ".com." The Panel finds

these alterations do not detract from the dominant portion of the domain name which is Complainant's mark. Therefore, the Panel finds Respondent's <yaoosexxx.com> domain name is confusingly similar to Complainant's YAHOO! mark pursuant to Policy ¶4(a)(i). See *Mrs. World Pageants, Inc. v. Crown Promotions*, FA 94321 (Nat. Arb. Forum Apr. 24, 2000) (finding that punctuation is not significant in determining the similarity of a domain name and mark); see also *Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001) (finding confusing similarity where the domain name in dispute contains the identical mark of the complainant combined with a generic word or term); see also *Victoria's Secret v. Zuccarini*, FA 95762 (Nat. Arb. Forum Nov. 18, 2000) (finding that, by misspelling words and adding letters to words, a respondent does not create a distinct mark but nevertheless renders the domain name confusingly similar to the complainant's marks); 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 . . .").

Respondent's <youtube-yahoo.com> domain name incorporates Complainant's YAHOO! mark with the addition of the term "youtube," which describes a competitor of Complainant, as well as the addition of a hyphen, the deletion of the exclamation point and the addition of the generic top-level domain ".com." The Panel finds these alterations do not distinguish Respondent's disputed domain name from Complainant's YAHOO! mark. Therefore, the Panel finds the disputed domain name is confusingly similar to Complainant's mark pursuant to Policy ¶4(a)(i). See *G.D. Searle & Co. v. Entm't Hosting Servs., Inc.*, FA 110783 (Nat. Arb. Forum June 3, 2002) ("The Panel concludes that the <viagra-propecia-xenical-celebrex-claritin-prescriptions.com> domain name is confusingly similar to Complainant's CELEBREX mark because the mere addition of related competing products' names in the domain name does not defeat a confusing similarity claim."); see also *Mrs. World Pageants, Inc. v. Crown Promotions*, FA 94321 (Nat. Arb. Forum Apr. 24, 2000) (finding that punctuation is not significant in determining the similarity of a domain name and mark); see also *Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.").

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

### **Rights or Legitimate Interests**

Complainant has alleged Respondent does not have rights and legitimate interests in the disputed domain names. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to prove it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). The Panel finds Complainant has established a *prima facie* case. Due to Respondent's failure to respond to the Complaint, the Panel may assume Respondent does not have rights and legitimate interests in the disputed

domain names. Out of an abundance of caution, the Panel will examine the record to determine whether Respondent has rights or legitimate interests pursuant to Policy ¶4(c). *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 Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, D2000-1221 (WIPO Dec. 4, 2000) (finding that the respondents’ failure to respond can be construed as an admission that they have no legitimate interest in the domain names).

Respondent is using the disputed domain names to operate search engine services that directly compete with Complainant’s services. The Panel finds Respondent’s competing use of the disputed domain names is not a use in connection with 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 Yahoo! Inc. v. Web Master*, FA 127717 (Nat. Arb. Forum Nov. 27, 2002) (finding that the respondent’s use of a confusingly similar domain name to operate a pay-per-click search engine, in competition with the complainant, was not a *bona fide* offering of goods or services); *see also Coryn Group, Inc. v. Media Insight*, FA 198959 (Nat. Arb. Forum Dec. 5, 2003) (finding that the respondent was not using the domain names for a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use because the respondent used the names to divert Internet users to a website that offered services that competed with those offered by the complainant under its marks).

In addition, Respondent’s <**yahoosexxx.com**> domain name resolves to a website that displays advertisement links to adult-oriented websites. The Panel finds Respondent’s use of the disputed domain name is not 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. Boch*, FA 209902 (Nat. Arb. Forum Dec. 22, 2003) (“Respondent uses <aol-x.com> in connection with pornographic material, which is not a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the domain name, pursuant to Policy ¶¶4(c)(i) [and] (iii).”); *see also Sony Kabushiki Kaisha v. Domain rajadomain@yahoo.com +1.415.0*, FA 128701 (Nat. Arb. Forum Dec. 16, 2002) (finding that the respondent’s use of its domain name in order to divert Internet users to a website that offers search engine services and links to adult orientated websites was not considered to be in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use pursuant to Policy ¶¶4(c)(i) or 4(c)(iii)).

Also, Respondent’s <**youtube-yahoo.com**> domain name resolves to a website that offers links to goods and services, some of which compete with Complainant. The Panel finds Respondent’s use of the disputed domain name is not 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 Compaq Info. Techs. Group v Jones*, FA 99091 (Nat. Arb. Forum Oct. 4, 2001) (finding that the respondent had no rights or legitimate interests in a domain

name that it used to redirect Internet users to a commercial website as part of that website's affiliate program, where the resultant website contained banner ads as well as various links to offers for free merchandise, including merchandise from the complainant's competitor); *see also Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) ("Respondent's appropriation of [Complainant's] SAFLOK mark to market products that compete with Complainant's goods does not constitute a *bona fide* offering of goods and services.").

Respondent is not commonly known by the disputed domain names. The WHOIS information lists Respondent as "Teodulo Cabrera a/k/a Roccaforte Vision Entertainment." The record indicates Complainant has not authorized Respondent to use its YAHOO! mark. Therefore, the Panel finds Respondent is not commonly known by the disputed domain name pursuant to Policy ¶4(c)(ii). *See 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](http://awvacations.com)] domain name."); *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).

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

### **Registration and Use in Bad Faith**

Respondent's disputed domain names offer search engine services that compete with Complainant's services. Additionally, Respondent's <[youtube-yahoo.com](http://youtube-yahoo.com)> domain name resolves to a website that displays links, some of which are to Complainant's competitors. The Panel finds Respondent's use of the disputed domain names constitutes disruption of Complainant's business (or at least an attempt to disrupt) and is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iii). *See S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding that the respondent registered the domain name in question to disrupt the business of the complainant, a competitor of the respondent); *see also H-D Michigan Inc. v. Buell d/b/a Pre-owned Harleys*, FA 1106640 (Nat. Arb. Forum Jan. 2, 2008) ("The disputed domain names resolve to websites that list links to competitors of Complainant, evidence that Respondent intends to disrupt Complainant's business, a further indication of bad faith pursuant to Policy ¶4(b)(iii).").

Respondent is attempting to commercially benefit from its use of the confusingly similar disputed domain names. Complainant has provided evidence Respondent is using the disputed domain names in connection with RevenueDirect, a company that provides compensation for click-through links. The Panel finds Respondent is attempting to profit from its use of the confusingly similar disputed domain names, which is evidence of Respondent's bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Associated*

*Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) (“Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving ‘click-through-fees.’”); *see also 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)).

Respondent’s <**yahoosexxx.com**> domain name resolves to a website which displays advertisement links to adult-oriented websites. The Panel finds Respondent’s actions are evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii). *See Ty, Inc. v. O.Z. Names*, D2000-0370 (WIPO June 27, 2000) (finding that absent contrary evidence, linking the domain names in question to graphic, adult-oriented websites is evidence of bad faith); *see also Youtv, Inc. v. Alemdar*, FA 94243 (Nat. Arb. Forum Apr. 25, 2000) (finding bad faith where the respondent attracted users to his website for commercial gain and linked his website to adult-oriented websites).

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 <**yahoosexxx.com**> and <**youtube-yahoo.com**> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: August 5, 2008

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