

**THE ICANN CYBERSQUATTING DECISIONS**

**March 16, 2001 through April 15, 2001**

© 2001

M. Scott Donahey  
Tomlinson Zisko Morosoli  
& Maser LLP  
200 Page Mill Rd.  
Second Floor  
Palo Alto, CA 94306  
Tel.: (650) 325-8666  
Fax.: (650) 324-1808  
email: [msd@tzmm.com](mailto:msd@tzmm.com)  
web site: [www.tzmm.com](http://www.tzmm.com)

Christine Watson  
Santa Clara University  
School of Law  
Santa Clara, California  
Tel.: (650) 941-5323  
Fax: (408) 554-4191  
Email:  
[emailchristinewatson@yahoo.com](mailto:emailchristinewatson@yahoo.com)

Julia Wei  
Santa Clara University  
School of Law  
Santa Clara, California  
Tel.: (650) 616-6835  
Fax: (650) 616-6510  
Email: [jmwei@scu.edu](mailto:jmwei@scu.edu)

Mr. Donahey is a member of the panel of neutrals of the World Intellectual Property Organization, eResolution, and the CPR Institute for Dispute Resolution, three of the four providers currently certified by the Internet Corporation for Assigned Names and Numbers ("ICANN") to hear cases under the Uniform Domain Name Dispute Resolution Policy. Mr. Donahey has served as a panelist in numerous cases, including *The World Wrestling Federation v. Bosman*, D99-0001, the first case to be heard under the UDRP.

Christine Watson is a J.D./M.B.A. candidate (2001) at the Santa Clara University School of Law and Leavey School of Business, where she is pursuing the High Tech Law Certificate. Ms. Watson is the Senior Production Editor of the SCU Computer and High Technology Law Journal. She is a member of the SCU Intellectual Property Association, International Law Association, and Start-up Law Group.

Julia Wei is a third-year law student at Santa Clara University School of Law, and is as an editor for their *Computer and High Technology Journal*. She completed her undergraduate education at the University of California at Berkeley, where she received a B.A. in 1995 with a major in Asian Studies. Prior to attending law school, Ms. Wei worked at Oracle Corporation based in Redwood Shores. Currently, she divides her time between her studies and the legal department at Epinions, Inc. Epinions.com is a Web site for trusted consumer advice, ratings, and reviews offering more than one million consumer reviews and comments, covering over 200,000 products and services.

In this issue we feature our usual statistical analysis and focus specially on the Interim Report of the Second WIPO Internet Domain Name Process, which was issued April 12, 2001 (the “WIPO Domain Name II Report“). In order to give deserved attention to the WIPO Domain Name II Report, we are foregoing our expanded treatment of some of the more interesting decisions issued during this period. The highlighting of certain significant decisions will resume in our next digest.

This month's decisions revealed a significant and sudden increase in the selection of three-person panels. Historically, parties have elected three-person panels in only 5% of the cases. This month, that percentage increased to 22%, which represents a significant increase in the decision to use three person panels. Interestingly, the percentage of cases in which the Respondent prevailed increased to 23%, versus a recent historical trend of approximately 15%.

While this increase may be related to the increased use of three-person panels, it may also be seen to be the result of the increased percentage of cases in which the Respondent appeared and filed a Response. Historically, the Respondent has defaulted in 50% - 60% of the cases. During this past month, the Respondent defaulted in only 42% of the cases. This represents the highest monthly percentage of cases in which the Respondent has defended an action.

Finally, the number of decisions that cite at least one prior panel decision has increased to 77%, and most cases cite multiple decisions. Clearly, panelists are acknowledging the well-reasoned decisions of their colleagues, even though not required to do so. Such recognition and deference builds confidence in the system as one that is based on common reasoning, rather than on the whim of an individual panelist.

The WIPO Domain Name II Report deals with several areas suggested by member states to be investigated for domain name law reform. Those areas include International Nonproprietary Names (for pharmaceutical substances), names and acronyms of international governmental organizations, personal names, geographical indications, terms, or indications of source, and trade names. The entire report is available at <http://wipo2.wipo.int>. It is anticipated that the final report will be released in August 2001.

The WIPO Domain Name II Report recommends that, in the interests of health and safety, International Nonproprietary Names should be protected against registration as domain names. WIPO seeks additional submissions as to whether such protection should prohibit the registration of a domain name identical to an International Nonproprietary Name, should allow the registration as a domain name of an International Nonproprietary Name with the name of the manufacturer of the specific pharmaceutical substance, or should allow the registration of an International Nonproprietary Name together with any other word (such as <pharmaceuticalsubstanceinfo.com>). It was not recommended that registration of confusingly similar domain names should be prohibited. Whatever protection is recommended should extend to all gTLDs.

The report did not recommend that the UDRP be modified to protect International Nonproprietary Names. It is recommended that all International Nonproprietary Names in Latin, English, French, Russian, and Spanish be excluded from registration as domain names and that any existing registrations be cancelled and subject in the future to such exclusions.

Regarding international governmental organization names, Francis Gurry, the

Assistant Director General of WIPO recently stressed that the use of the *.int* gTLD should be encouraged, although this is not viewed as an entire solution. WIPO recommends that the names of international intergovernmental organizations protected under the Paris Convention and the TRIPS Agreement should be excluded from registration in all gTLDs. It is not recommended that the UDRP be modified to allow for claims by international intergovernmental organizations regarding the registration as domain names of their names or acronyms.

The report considered the nature of protection for personal names and invited additional comments. Possible alternatives include no changes to the UDRP, or an expanded scope for the UDRP to encompass a new category of claims brought on the basis of personality rights.<sup>1</sup>

The report recommended that measures be adopted to protect geographical indications and indications of source. The report recommended that the scope of the UDRP be broadened to cover abusive recommendations in all gTLDs. Such protection should be limited to the names of countries and the administratively recognized regions and municipalities within countries. The report detailed a possible new UDRP cause of action for abusive registration of domain names corresponding to administratively recognized regions or municipalities:

---

<sup>1</sup> Elements of such expanded scope could include: (i) a showing that the name is sufficiently distinctive as to identify the complainant; (ii) commercial exploitation of the personal name through its registration as a domain name; (iii) commercial exploitation is unauthorized; (iv) bad faith, as defined by UDRP, with additional factor that facts show intentional effort to take advantage of reputation or goodwill in personal identity, and (v) interests of freedom of speech and press do not need to be taken into account.

“1. The registration of a domain name shall be considered to be abusive and the competent national authorities shall be entitled to its cancellation or transfer when all of the following conditions are met:

- (i) The domain name is identical or confusingly similar to the name of a country or of an administratively recognized region or municipality within a country; and
- (ii) The registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

2. For the purposes of paragraph (1)(iii), the following, in particular, shall be evidence of the registration and use of a domain name in bad faith:

- (a) Circumstances indicating that the registrant has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (b) The registrant has registered the domain name in order to prevent the competent national authority from reflecting the name of the region or municipality in a corresponding domain name, provided the registrant has engaged in a pattern of such conduct; or
- (c) The use of the domain name as the address of a website or other on-line location without there being a connection between the information

provided on such website or location and the region or municipality corresponding to the domain name; or

(d) The use of the domain name as the address of a website or other on-line location in a manner that creates a likelihood of confusion as to the endorsement by the competent national authority of the information provided on such website or location.

3. For purposes of paragraph (1)(ii), the following, in particular, shall be evidence of the registrant's rights and legitimate interests in the domain name:

(a) The use of the domain name as the address of a website or other on-line location devoted to the provision of information concerning the region or municipality corresponding to the domain name that does not fall under paragraph 2 (d) above, whether or not such information is provided for financial gain; or

(b) The domain name corresponds to a trademark or service mark of the registrant; or

(c) The registrant (as an individual, business, or other organization) has been commonly known by the domain name; or

(d) The registrant is using the domain name for comment.”

At a consultation conducted in Washington, D.C. on May 29, 2001, the South African Ambassador to the United States argued for broader protection. Ambassador Sheila Sisulu argued that the UDRP should recognize that a private registrant of a country name with no connection to the country should be deemed to have registered the domain name in bad faith. The Republic of South Africa considers country names to be

national assets of sovereign nations and not subject to private registration.

Finally, as to trade names, the report did not recommend that special procedures be added for their protection by the modification of the UDRP. However, since many commentators argued for such modification, the report included a proposed modified cause of action under the UDRP, as follows:

“1. The registration of a domain name shall be considered to be abusive and the owner of a trade name shall be entitled to its cancellation or transfer when all of the following conditions are met:

(i) The domain name is identical or confusingly similar to a trade name in which the complainant has rights, whether registered or unregistered;

(ii) The registrant of the domain name has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

2. For the purposes of paragraph (1)(iii), the following circumstances, in particular but without limitation, shall be evidence of the registration and use of a domain name in bad faith:

(a) The registration of a domain name which is the trade name of another, primarily for the purpose of selling, renting or otherwise transferring the domain name to an owner of the trade name, at a cost which is in excess of the out-of-pocket expenses directly related to the domain name; or

- (b) The registration of a domain name to prevent an owner of a trade name from reflecting the name in a corresponding domain name, provided the registrant has engaged in a pattern of such conduct; or
  - (c) The registration of the domain name primarily for the purpose of disrupting the business of a competitor; or
  - (d) The registration of the domain name with the intention of attracting, for commercial gain, users to registrant's web site, by creating a likelihood of confusion with a trade name as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or of a product, services or trading entity on the registrant's web site.
3. For the purposes of paragraph (1)(ii), the following, in particular but without limitation, shall be evidence of the registrant's rights and legitimate interests in the domain name:
- (a) The use of, or preparations to use, the domain name or a name corresponding to the domain name, before any notice of the dispute, in connection with a bona fide establishment of a commercial operation or business; or
  - (b) The domain name corresponds to a trade name, trademark or service mark of the registrant; or
  - (c) The registrant (as an individual, business or other organization) has been commonly known by the domain name; or
  - (d) The registrant is using the domain name for legitimate noncommercial or fair use of the domain name, without intent for

commercial gain, to misleadingly divert consumers or otherwise damage the goodwill in the trade name at issue.”

To participate in the WIPO Process, send any comments you might have to

<http://wipo.int>.

The following are the digested decisions for this month:

**2270. Reed Elsevier Properties Inc. v. David Allen, No. FA0102000096667**

- a. Date: March 21, 2001
- b. Panelist(s): Judge Ralph Yachnin
- c. Domain Name(s) at Issue: <varietymagazine.com; <variety-magazine.com>
- d. Response: No
- e. Principle(s):
  - 1) “Adding a general word to a trademark held by another does not defeat the mark holder’s rights in the mark.”
  - 2) “Using another’s distinctive mark to redirect Internet consumers to one’s own website is not a bona fide use of a domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(iv), 4(c)(i)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Space Imaging LLC v. Brownwell*, Case No. AF 0298; *L.L. Bean, Inc. v. ShopStarNetwork*, Case No. FA 95404; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Identigene, Inc. v. Genetest Lab.*, Case No. D2000-1100.
- j. Judicial decisions and statutes cited: None

**2271. MBS Computers Ltd. v Richard Workman aka Portable World Computers, No. FA0102000096632**

- a. Date: March 16, 2001
- b. Panelist(s): Ralph Yachnin
- c. Domain Name(s) at Issue: <notebook-city.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Smart Design LLC v. Carolyn Hughes*, Case No. D2000-0993; *InfoSpace.com v. Tenenbaum Ofer*, Case No. D2000-0075; *CBS Broadcasting, Inc. v. LA-Twilight-Zone*, Case No. D2000-0397; *Nokia Corp. v. Private*, Case No. D2000-1271; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Reuters Ltd. v. Teletrust IPR Ltd.*,

Case No. D2000-0471; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650.

j. Judicial decisions and statutes cited: None

**2272. Workplace Safety and Insurance Board v Jonathan Kleiman, No. FA0102000096611**

- a. Date: March 13, 2001
- b. Panelist(s): Ralph Yachnin
- c. Domain Name(s) at Issue: <wsib.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent’s only use of the domain name at issue is to hyperlink Internet users to pornographic sites, which is not a bona fide use.”
  - 2) “Moreover, Respondent asserted no rights or legitimate interests in the domain name at issue, which entitles the Panel to conclude that Respondent has no such rights or legitimate interests in the domain name at issue.”
  - 3) “Respondent’s offer to sell the disputed domain name via a popular online auction site shows bad faith.”
  - 4) “Respondent offered hyperlinks to pornographic sites via the domain name at issue, which constitutes bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *BMW AG v. Loophole*, Case No. D2000-1156; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *MatchNet plc. v. MAC Trading*, Case No. D2000-0205; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Wrenchhead.com, Inc. v. Hammersla*, Case No. D2000-1222; *The Step2 Co. v. Softastic.com Corp.*, Case No. D2000-0393; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *ESPN, Inc. v. Danny Ballerini*, Case No. FA 95410; *CCA Indust., Inc. v. Dailey*, Case No. D2000-0148; *Youtv, Inc. v. Alemdar*, Case No. FA 94243.
- j. Judicial decision and statutes cited: *Interstellar Starship Services Ltd. v. EPIX, Inc.*, 983 F.Supp. 1331, 1335 (D.Or. 1997).

**2273. American Express Company v. Global Marketing, No. FA0102000096610**

- a. Date: March 20, 2001
- b. Panelist(s): Richard DiSalle
- c. Domain Name(s) at Issue: <americamexpress.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Common misspellings of a mark do not establish a distinct mark or defeat the owner’s rights in the mark.”

2) “Using a domain name, which infringes upon another’s trademark rights, to offer pornographic images, is evidence of bad faith registration and use.”

- f. Result: Name transfer
- g. Policy cited: 4(a), 4(c), 4(c)(i), 4(c)(ii), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Bama Rags, Inc. v. Zuccarini*, Case No. FA 94380; *MatchNet plc. v. MAC Trading*, Case No. D2000-0205; *Nintendo of America Inc v. Pokemon*, Case No. D2000-1230; *Singapore Airlines Ltd v. P & P Servicios de Comunicacion S.L.*, Case No. D2000-0643; *National Football League Properties, Inc., et al. v. One Sex Entertainment Co.*, Case No. D2000-0118; *MatchNet plc. v. MAC Trading*, Case No. D2000-0205.
- j. Judicial decisions and statutes cited: None

**2274. Advanstar Communications Inc. v Michael Dalrymple,  
No. FA0102000096604**

- a. Date: March 19, 2001
- b. Panelist(s): James P. Buchele
- c. Domain Name(s): <advanstar.org; <advanstar.net>
- d. Response?: Yes
- e. Principle(s):
  - 1) “A determination of bad faith under the Policy does not rest upon what the Respondent believes constitutes good business decisions or proper conduct on the part of the Complainant. But, the Respondents offer to sell the name for an amount far in excess of his actual costs constitutes bad faith.”

- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(ii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decision cited: *ViewSonic Corp. v. Informer Assoc. Inc.*, Case No. D2000-0852; *Open Systems Computing AS v. Alberto degli Alessandri*, Case No. D2000-1393; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *BMW AG v. Loophole*, Case No. D2000-1156; *Matmut v. Tweed*, Case No. D2000-1183; *Grundfos A/S v. Lokale*, Case No. D2000-1347; *Dynojet Research, Inc. v. Norman*, Case No. AF-0316; *Penguin Books Ltd. v. Katz*, Case No. D2000-0204.
- j. Judicial decisions and statutes cited: None

**2275. Bank of America Corporation v Premium Domains For Sale,  
No. FA0102000096584**

- a. Date: March 15, 2001
- b. Panelist(s): Paul A. Dorf
- c. Domain Name(s) at Issue: <investmentbankamerica.com>
- d. Response?: Yes
- e. Principle(s):

- 1) “The addition of this generic term coupled with the .com does not sufficiently set [Respondent’s domain name] apart from Complainant’s mark; in fact it enhances the probability of confusion in the marketplace as the Complaint is a provider of investment services.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Space Imaging LLC v. Brownwell*, Case No. AF 0298; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Educational Testing Service v. TOEFL*, Case No. D2000-0044.
- j. Judicial decisions and statutes cited: None

**2276. Bank of America Corporation v Cupcake Patrol, No. FA0102000096582**

- a. Date: March 19, 2001
- b. Panelist(s): James P. Buchele
- c. Domain Name(s) at Issue: <bankofamerica.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent asserted no rights or legitimate interests in the disputed domain name. Consequently, the Panel is free to conclude Respondent has no such rights or legitimate interests in the disputed domain name.”
  - 2) “[T]he evidence shows Respondent has registered many infringing domain names, which also shows bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Bank of America Corp. v. InterMos*, Case No. FA 95092; *America Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd.*, Case No. FA 93679; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *AltaVista v. Krotov*, Case No. D2000-1091; *Kosmea Pty Ltd. v. Carmel Krpan*, Case No. D2000-0948; *America Online, Inc. v. Tencent Comm. Corp.*, Case No. FA 93668; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *ESPN, Inc. v. Danny Ballerini*, Case No. FA 95410; *Armstrong Holdings, Inc. v. JAZ Associates*, Case No. FA 95234; *Encyclopaedia Britannica Inc. v. Shedon.com*, Case No. D2000-0753.
- j. Judicial decisions and statutes cited: None

**2277. Woody Development Corporation a/k/a Value Trips, Inc. v TheTrip.com, No. FA0102000096580**

- a. Date: March 12, 2001
- b. Panelist(s): John J. Upchurch
- c. Domain Name(s) at Issue: <valuetrip.com>
- d. Response?: No
- e. Principle(s):

- 1) Virtual identity to Complainant's well-established mark is established when the only difference between Respondent's domain name and the Complainant's mark is that the "s" has been deleted.
  - 2) The Panel is entitled to conclude Respondent has no rights or legitimate interests in the disputed domain name when Respondent has asserted no rights or legitimate interests in the domain name at issue.
  - 3) Where Respondent is Complainant's competitor, awareness of Complainant's mark prior to registering the disputed domain name may be imputed, and constitutes bad faith.
  - 4) Making no use of the disputed domain name since its registration demonstrates bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Universal City Studios, Inc. v. HarperStephens*, Case No. D2000-0716; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Alitalia –Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Armstrong Holdings, Inc. v. JAZ Associates*, Case No. FA 95234; *America Online, Inc. v. iDomainNames.com*, Case No. FA 93766.
- j. Judicial decisions and statutes cited: None

**2278. Bloomberg L.P. v Peter Schorsch, No. FA0101000096576**

- a. Date: March 19, 2001
- b. Panelist(s): Irving H. Perluss
- c. Domain Name(s) at Issue: <thebloombergmarket.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) The addition of generic terms to Complainant's mark does not avoid a finding of confusingly similarity or identity.
  - 2) "[T]here is a legal presumption of bad faith, when Respondent clearly was aware of Complainant's famous and distinctive trademark."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b), 4(b)(iv), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409; *Brookfield*, 174 F.3d at 1059; *Phat Fashions v. Kruger*, Case No. FA 96193.
- j. Judicial decisions and statutes cited: *Interstellar Starship Services, Ltd. v. Epix, Inc.*, 184 F.3d 1107, 1111(CA 9th 1999); *Green Products Co. v. Independence By-Products Co.*, 992 F.Supp. 1070 (N.D. Iowa 1997).

**2279. Grand Circle LLC v. Amsterdam Investments Limited,  
No. FA0101000096574**

- a. Date: March 15, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <grandcircletravel.com;  
<grandcirclecruiseline.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2280. Bloomberg L.P. v Hans Global Co., No. FA0101000096570**

- a. Date: March 15, 2001
- b. Panelist(s): John J. Upchurch
- c. Domain Name(s) at Issue: <asiabloomberg.com; bloombergkorea.com>
- d. Response?: No
- e. Principle(s):
  - 1) Where Respondent has asserted no rights or legitimate interests in the disputed domain names, the Panel is entitled to conclude that Respondent has no such rights or legitimate interests in the domain names.
  - 2) Only using the disputed domain names to offer them for sale constitutes bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Net2phone Inc. v. Netcall SAGL*, Case No. D2000-0666; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Cruzeiro Licenciamentos Ltda v. Sallen and Sallen Enterprises*, Case No. D2000-0715; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232.
- j. Judicial decisions and statutes cited: None

**2281. Navarro Discount v M. Garcia, No. FA0101000096568**

- a. Date: March 14, 2001
- b. Panelist(s): Judge Harold Kalina
- c. Domain Name(s) at Issue: <NAVARRO.com>
- d. Response?: Yes
- e. Principle(s): None
- f. Result: Name transfer

- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Koninklijke Philips Electronics NV v. Ramazan Goktas*, Case No. D2000-1638; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v. Tatu Rautiainen*, Case No. D2000-1394; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *CBS Broadcasting, Inc. v. LA-Twilight-Zone*, Case No. D2000-0397; *Home Interiors & Gifts, Inc. v. Home Interiors*, Case No. D2000-0010; *Alitalia-Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232.
- j. Judicial decisions and statutes cited: *Interstellar Starship Services Ltd. V. EPIX, Inc.*, 983 F. Supp. 1331, 1335 (D.Or. 1997).

**2282. Victoria's Secret et al v Harold R. Brown II/Ted Waitt, No. FA0101000096561**

- a. Date: March 19, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <urn2victoriasscret.com; urn2victoriasscrets.com>
- d. Response?: No
- e. Principle(s):
  - 1) Where Respondent asserts no rights or legitimate interests in the disputed domain names, the Panel is entitled to conclude that Respondent has no such rights or legitimate interests in relation to the disputed domain names.
  - 2) "The evidence of the widespread nature of use of Complainants' famous mark permits the inference that Respondent was aware of Complainants' famous mark prior to registering the disputed domain names. This is evidence of bad faith."
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *America Online, Inc. v. iDomainNames.com*, Case No. FA 93766; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312.
- j. Judicial decisions and statutes cited: None

**2283. Victoria's Secret et al v Serbjeet Ahluwalia dba TSE, No. FA0101000096559**

- a. Date: March 14, 2001

- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <victoriasecretsex.com>
- d. Response?: No
- e. Principle(s):
  - 1) Where Respondent has asserted no rights or legitimate interests in the domain name in question, the Panel is entitled to conclude that Respondent has no such rights or legitimate interests in relation to the domain name in question.
  - 2) Where Complainants have established their long-standing use of their famous mark, the reasonable inference may be drawn that Respondent knew or had to have known about Complainants' famous mark prior to registering the domain name in question. This is evidence of bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409; *Body Shop Int'l PLC v. CPIC NET and Hussain*, Case No. D2000-1214; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312.
- j. Judicial decisions and statutes cited: None

**2284. Collegetown Relocation, L.L.C. v. Concept Software and Technologies Inc., No. FA0101000096555**

- a. Date: March 14, 2001
- b. Panelist(s): P. Jay Hines
- c. Domain Name(s) at Issue: <collegetown.net>
- d. Response?: Yes
- e. Principle(s):
  - 1) "Complainant's Federal Trademark Registration...is *prima facie* evidence of the Complainant's exclusive right to use of the term in connection with the services covered by the registration."
  - 2) "The...conduct of a principal of Respondent's parent can[not] be attributable to the Respondent for the purpose of demonstrating a pattern of registering domain names in order to prevent trademark or service mark owners from registering corresponding domain names."
- f. Result: Decision for Respondent
- g. Policy cited: 4(a), 4(a)(3), 4(b)(i)-(iv), 4(c)(i)-(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *LifePlan v. Life Plan*, Case No. FA 94826.
- j. Judicial decisions and statutes cited: None

**2285. Dynamic Physical Therapy and Rehabilitation Center of Bear Inc. v. Pro**

**Physical Therapy, No. FA0101000096550**

- a. Date: March 13, 2001
- b. Panelist(s): Charles K. McCotter, Jr.
- c. Domain Name(s) at Issue: <dynamicphysicaltherapy.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) "Pending trademark applications can establish rights in a mark."
  - 2) "[T]he passive holding of a domain name can constitute use in bad faith where the registration deprives one with rights in the domain name use of the domain name."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(i)
- h. Uniform Rules cited: 15(a), 18(a)
- i. Panel Decisions cited: *MatchNet PLC. v. MAC Trading*, Case No. D2000-0205; *British Broadcasting Corp. v. Renteria*, Case No. D2000-0050; *Seek America Networks Inc. v. Tariq Masood and Solo Signs*, Case No. D2000-0131; *Wellness Int'l Network, LTD v. Apostolics.com*, Case No. FA 96189; *Asprey & Garrard Ltd v. Canlan Computing*, Case No. D2000-1262; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650; *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0003; *Parfums Christian Dior v. 1 Netpower, Inc.*, Case No. D2000-0022.
- j. Judicial decisions and statutes cited: None

**2286. Victoria's Secret et al v Amilcar Perez-Lista d/b/a Neuro Business, No. FA0101000096541**

- a. Date: March 19, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <800-victoriasscret.com; 800victoriasscret.com>
- d. Response?: No
- e. Principle(s):
  - 1) "Respondent asserted no rights or legitimate interests in the domain names in question. Thus, the Panel is entitled to conclude that Respondent has no such rights or legitimate interests in relation to the domain names in question."
  - 2) "The popularity of Complainants' famous mark permits the inference that Respondent knew of Complainants' mark prior to registering the disputed domain names. This is evidence of bad faith."
  - 3) "Respondent's registration of the domain names in question, which are comprised primarily of Complainants' famous mark, establishes Respondent's intent to create a likelihood of confusion with Complainants' mark as to the source sponsorship, affiliation, or endorsement of its web sites."
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)

- i. Panel Decisions cited: *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *Hitachi, Ltd. v. Fortune Int'l Dev. Ent.*, Case No. D2000-0412; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312.
- j. Judicial decisions and statutes cited: None

**2287. Vision Center Northwest Inc et. al. v. Individual, No. FA0101000096478**

- a. Date: March 14, 2001
- b. Panelist(s): James Buchele, Diane Cabell, Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <drtavel.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) "UDRP Panels have held that an individual has common law rights in his or her name."
- f. Result: Decision for Respondent
- g. Policy cited: 4(a), 4(b)(i)-(iv), 4(c), 4(c)(i)-(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Roberts v. Boyd*, Case No. D2000-0210; *Winterson v. Hogarth*, Case No. D2000-0235; *Jagger v. Hammerton*, Case No. FA 95261; *MPL Communications Ltd v. Hammerton*, Case No. FA 95633; *Sumner, p/k/a Sting v. Urvan*, Case No. D2000-0596; *Capt'n Snooze Management v. Domains 4 Sale*, Case No. D2000-0488; *Kittinger Co. v. Kittinger Collector*, Case No. AF-0107; *Chestnutt v. Tumminelli*, Case No. D2000-1758; *MatchNet plc. v. MAC Trading*, Case No. D2000-0205; *AltaVista v. Krotov*, Case No. D2000-1091; *Shirmax Retail Ltd. v. CES Marketing, Inc.*, Case No. AF-0104; *Etam, plc v. Alberta Hot Rods*, Case No. D2000-1654; *Chestnutt v. Tumminelli*, Case No. D2000-1758; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761; *Banco Mercantil del Norte, S.A., v. Servicios de Comunicación En Linea*, Case No. D2000-1215; *Wembley Nat'l Stadium Ltd. v. Thomson*, Case No. D2000-1233; *Dr. Karl Albrecht v. Eric Natale*, Case No. FA 95465; *Thibodeau, v. Yomtobian*, Case No. FA 94868; *Geocities v. Geociites.com*, Case No. D2000-0326; *Drs. Foster & Smith, Inc. v. Jaspreet Lalli*, Case No. FA 95284; *Energy Source Inc. v. Your Energy Source*, Case No. FA 96364; *Chestnutt v. Tumminelli*, Case No. D2000-1758.
- j. Judicial decisions and statutes cited: None

**2288. Judy Larson v. Judy Larson Club, No. FA0101000096488**

- a. Date: March 13, 2001
- b. Panelist(s): Jonathan Hudis
- c. Domain Name(s) at Issue: <judylarson.com>
- d. Response?: Yes
- e. Principle(s):

- 1) “[A] growing line of UDRP panel decisions have held that artists, performers, and the like, can acquire protectable rights in their names under the UDRP, if their names have been used and/or are recognized as indicators of the origin of their goods or services, even if they do not own registered trademarks.”
  - 2) “[W]here a person’s name is not being used as an indicator of the origin of his or her goods or services, or if the person’s stage name also is, and is being used as, a common word of ordinary vernacular, the person’s name is not the subject of protectable rights under the UDRP.”
  - 3) “Without more, the mechanical listing of "hits" from a search engine containing the words [in the domain name in question] does not establish trademark rights.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)-(iv), 4(c), 4(c)(i)
- h. Uniform Rules cited: 15(a); 4.1(c) of the UDRP staff report
- i. Panel Decisions cited: *Roberts v. Boyd*, Case No. D2000-0210; *Rudner v. Internetco Corp.*, Case No. D2000-0581; *Jagger v. Hammerton*, Case No. FA 95261; *Estate of Tupac Shakur v. Shakur Info. Page*, Case No. AF-0346; *Ciccone, p/k/a Madonna v. Parisi and "Madonna.com"*, Case No. D2000-0847; *Julie Brown v. Julie Brown Club*, Case No. D2000-1628; *Dion and Sony Music Entertainment (Canada) Inc. v. Burgar o/a Celine Dion Club*, Case No. D2000-1838; *Sun Int’l Resorts, Inc. v. Najar*, Case No. D2000-1349; *Sumner p/k/a Sting v. Urvan*, Case No. D2000-0596; *Tall Oaks Publishing, Inc. and Slejko v. National Trade Publications, Inc.*, Case No. FA 94346; *Wal-Mart Stores, Inc. v. Crews*, Case No. D2000-0580; *Springsteen v. Burgar and Bruce Springsteen Club*, Case No. D2000-1532.
- j. Judicial decisions and statutes cited: *U.S. Trademark Act*, 15 U.S.C. § 1125(a); 15 U.S.C. § 1127; *Canadian Trade-marks Act*, R.S., c. T-13, § 2.

**2289. Lucky Money, Inc. v ilovesschool.com, No. FA0101000096383**

- a. Date: March 9, 2001
- b. Panelist(s): R. Glen Ayers, Ralph Yachnin, Young Kim
- c. Domain Name(s) at Issue: <luckymoney.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “An expression comprised of generic terms, as to which Complainant cannot have exclusive rights, does not constitute a mark at common law.”
  - 2) “Respondent’s assertion that the domain name is a common expression comprised of generic terms is a defense to an allegation of bad faith.”
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 4, 15(a)
- i. Panel Decisions cited: *SOCCKERPLEX, INC. v. NBA Inc.*, Case No. FA 94361; *Interactive Television Corporation v. Noname.com*, Case No. D2000-0358; *Smart Design LLC v. Carolyn Hughes*, Case No. D2000-0993; *Goldmasters Precious Metals v. Gold Masters srl*, Case No. FA 95246; *Lumena s-ka zo.o. v.*

*Express Ventures LTD*, Case No. FA 94375.

j. Judicial decisions and statutes cited: None

**2290. United States Postal Service v. Postoffice.com, Inc., No. FA0012000096313**

a. Date: March 19, 2001

b. Panelist(s): Daniel B. Banks, Jr., Frederick Mostert, Carolyn Marks Johnson

c. Domain Name(s) at Issue: <postoffice.com>

d. Response?: Yes

e. Principle(s):

- 1) "It should be noted that URDP does not cover every possible violation of trademark rights."
- 2) "It should also be noted that ordering the transfer of a domain name is an extraordinary remedy that ought to be exercised only in clear cases. In addition, the UDRP is a limited administrative procedure designed only to prohibit clear cases of abusive registration. Where...evidence is presented to suggest that complicated trade mark and other legal issues (such as laches, estoppel, etc) are at stake, the proper forum is in a court of law."
- 3) "In this proceeding, which is in the nature of a civil proceeding, the civil standard of proof should apply in respect of issues 4(a)(ii) 'no rights or legitimate interests' and 4(a)(iii) 'bad faith'."

f. Result: Decision for Respondent

g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(i), 4(c)(i)

h. Uniform Rules cited: 15(a)

i. Panel Decisions cited: *Commercial Publishing Co. v. EarthComm, Inc.*, Case No. FA 95013; *Funkskool (India) Ltd v. funschool.com Corp.* Case No. D2000-0796; *United States Postal Service v. Consumer Info. Org.*, Case No. FA 95757; *Bibbero Sys., Inc. v. Tseu & Assoc.*, Case No. FA 94416; *Hammond Suddards Edge v. Westwood Guardian Ltd.*, Case No. D2000-1235; *3Z Productions v. Globaldomain*, Case No. FA 94659; *Newport News v. VCV Internet*, Case No. AF 0238; *Port of Helsinki v. Paragon Int'l Projects Ltd.*, Case No. D2001-0002; *DFJ Associates, Inc. v. AIB Communications*, Case No. FA 95612; *Schering Aktiengesellschaft v. Metagen GmbH*, Case No. D2000-0728; *Lumena s-ka zo.o. v. Express Ventures LTD*, Case No. FA 94375; *Chestnutt v. Tumminelli*, Case No. D2000-1758.

j. Judicial decisions and statutes cited: 18 U.S.C. § 1729.

**2291. Broadcom Corporation v. Philippines Online c/o InfoDyne, No. FA0102000096683**

a. Date: March 20, 2001

b. Panelist(s): Charles K. McCotter

c. Domain Name(s) at Issue: <broadcomasia.com>

d. Response?: Yes

e. Principle(s):

- 1) "This Policy is designed to prevent a Respondent from evading the proceeding by transferring the domain name to a third party... There is no obligation under the Policy to recognize any party other than the holder of

- the domain name registration.”
- 2) “The combination of a geographic prefix or suffix to a mark does not prevent the domain name from being found confusingly similar.”
  - 3) “The Respondent’s unauthorized use of the [Complainant’s] trademark undermines any legitimate interest in the web site.”
  - 4) “Infringement of trademark rights is evidence of bad faith.”
  - 5) “[In Complainant’s field,] Complainant’s...trademark is so obviously connected with the Complainant that use by someone with no connection with the Complainant suggests bad faith.”
- f. Result: Name transfer
  - g. Policy cited: 4(a), 4(i)
  - h. Uniform Rules cited: 5(b)(i), 5(d), 14(a), 15(a)
  - i. Panel Decisions cited: *Net2phone Inc v. Netcall Sagl*, Case No. D2000-0666; *Cellular One Group v. Paul Brien*, Case No. D2000-28; *CMGI, Inc. v. Reyes*, Case No. D2000-0572; *Wal-Mart Stores, Inc. v. Lars Stork*, Case No. D2000-0628; *Household Int’l, Inc. v. Cyntom Enterprises*, Case No. FA 95784; *Big Dog Holdings, Inc. v. Frank Day*, Case No. FA 93554; *Reuters Ltd. v. Global Net 2000, Inc.*, Case No. D2000-0441; *Deutsche Bank AG v. Diego-Arturo Bruckner*, Case No. D2000-0277.
  - j. Judicial decisions and statutes cited: None

**2292. Unitas Management Corp. v. Noreserve Inc., No. FA0102000096671**

- a. Date: March 22, 2001
- b. Panelist(s): John A. Bender
- c. Domain Name(s) at Issue: <johnunitas.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Respondent admits desire to use domain name because of secondary meaning in violation of common law rights, sufficient to find bad faith for these purposes.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Roberts v. Boyd*, Case No. D2000-0210.
- j. Judicial decisions and statutes cited: None

**2293. Polaroid Corporation v Damian Macafee, No. FA0102000096660**

- a. Date: March 26, 2001
- b. Panelist(s): Harold Kalina
- c. Domain Name(s) at Issue: <polaroid.net>
- d. Response?: No
- e. Principle(s):
  - 1) “Given the fame of Complainant’s mark, coupled with the mark’s inherently arbitrary nature, it is inconceivable that Respondent innocently registered [the domain name] without having a design to exploit the domain name’s similarity to Complainant’s famous...mark and web sites.”

2) “[T]he fact that Respondent provided fictitious contact information to the Registrar further demonstrates Respondent’s bad faith.”

- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Kabushiki Kaisha Toshiba v. Shan Computers*, Case No. D2000-0325; *AltaVista v. Krotov*, Case No. D2000-1091; *Nintendo of America Inc. v. Pokemon*, Case No. D2000-1230; *Home Director, Inc. v. HomeDirector*, Case No. D2000-0111.
- j. Judicial decisions and statutes cited: None

**2294. Premier Laser Systems Inc. v. EyeSys Vision Group, No. FA0102000096638**

- a. Date: March 24, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <eyesys.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b)(iv)
- h. Uniform Rules cited: 5(a)
- i. Panel Decisions cited: *Gutterbolt, Inc. v. NYI Building Products Inc.*, Case No. FA 96076; *State Fair of Texas v. Granbury.com*, FA 95288.
- j. Judicial decisions and statutes cited: None

**2295. Hardy Diesel & Equipment Inc. v China Diesel Generators, No. FA0102000096636**

- a. Date: March 27, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <chinadiesel.net>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent asserted no rights or legitimate interests in the disputed domain name, which entitles the Panel to conclude it has no such rights or legitimate interests in the domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *American Golf Corp. v. Perfect Web Corp.*, Case No. D2000-0908; *Nike, Inc. v. Coleman*, Case No. D2000-1120; *Rollerblade, Inc. v. McCrady*, Case No. D2000-0429; *AT&T Corp. v. Domains by Brian Evans*, Case No. D2000-0790; *State Farm Mut. Auto. Ins. Co. v. LaFaive*, Case No. FA 95407; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *State Fair of Texas v. Granbury.com*, Case No. FA 95288; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471.

j. Judicial decisions and statutes cited: None

**2296. The Norac Company, Inc. v Nicolas Petit, No. FA0102000096634**

a. Date: March 26, 2001

b. Panelist(s): James A. Carmody

c. Domain Name(s) at Issue: <be-nox.com; benox.com>

d. Response?: No

e. Principle(s):

1) “Respondent asserted no rights or legitimate interests in the disputed domain names, which entitles the Panel to conclude Respondent has no such rights or legitimate interests in the domain names.”

2) Passively holding a domain name constitutes bad faith.

f. Result: Name transfer

g. Policy cited: 4(a), 4(a)(i)-(iii)

h. Uniform Rules cited: 5(e), 14(a), 15(a)

i. Panel Decisions cited: *InfoSpace.com v. Tenenbaum Ofer*, Case No. D2000-0075; *Dollar Fin. Group, Inc. v. Advanced Legal Sys., Inc.*, Case No. FA 95102; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Alitalia –Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312.

j. Judicial decisions and statutes cited: None

**2297. Bloomberg L.P. v http://esex.org, No. FA0102000096608**

a. Date: March 26, 2001

b. Panelist(s): Harold Kalina

c. Domain Name(s) at Issue: <bloomberg.com>

d. Response?: No

e. Principle(s):

1) “The addition of the letters ‘er’ fails to take away the distinguishing and recognition of the Complainant's famous mark.”

f. Result: Name transfer

g. Policy cited: 4(a), 4(b)(iv), 4(c)(i)-(iii)

h. Uniform Rules cited: 5(e), 14(a), 15(a)

i. Panel Decisions cited: *Kelson Physician Partners, Inc. v. Mason*, Case No. CPR003; *Yahoo! Inc. v. Zviely*, Case No. D2000-0273; *America Online Inc. v. Tencent Communications Corp.*, Case No. FA 93668; *MSNBC Cable, LLC v. Tsys.com*, Case No. D2000-1204; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Drs. Foster & Smith, Inc. v. Jaspreet Lalli*, Case No. FA 95284; *AltaVista v. Krotov*, Case No. D2000-1091.

j. Judicial decisions and statutes cited: None

**2298. Bloomberg L.P. v The International Capital Group, Inc.,  
No. FA0102000096607**

- a. Date: March 27, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <bloomburge.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent asserted no rights or legitimate interests in the disputed domain name in issue and that entitles this Panel to conclude that Respondent has no such rights or legitimate interests in the domain name.”
  - 2) “The evidence shows Respondent offered to sell the domain name to Complainant for an amount in excess of out-of-pocket costs. This permits an inference that Respondent acted in bad faith.”
  - 3) “Given the worldwide nature of Complainant’s business and development of its mark, it is reasonable to conclude that the Respondent knew or had constructive notice of Complainant’s well-established mark prior to registering the disputed domain name. This also is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Hewlett-Packard Co. v. Cupcake City*, Case No. FA 93562; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Hewlett-Packard Co. v. Cupcake City*, Case No. FA 93562; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Dynojet Research, Inc. v. Norman*, Case No. AF-0316; *World Wrestling Fed’n Entertainment, Inc. v. Bosman*, Case No. D0099-0001; *Moynahan v. Fantastic Sites, Inc.*, Case No. D2000-1083; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Luck’s Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650.
- j. Judicial decisions and statutes cited: None

**2299. V&S Vin & Sprit Aktiebolag v Spion Network, No. FA0102000096606**

- a. Date: March 26, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <absolut-vodka.com>
- d. Response?: No
- e. Principle(s):
  - 1) The mere insertion of a hyphen in Complainant’s mark does not avoid a finding of identity or confusing similarity between Complainant’s mark and Respondent’s domain name.
  - 2) “Respondent is using the disputed domain name to divert Internet traffic to its own web site, using a domain name that infringes upon the mark of another. This is not a bona fide, legitimate use.”
  - 3) “Respondent asserted no rights or legitimate interests in the disputed domain name. Consequently, the Panel is free to conclude Respondent has

no such rights or legitimate interests in the disputed domain name.”

- 4) “The evidence supports the conclusion that Respondent registered the domain name at issue intentionally to attract Internet users to its web site, strictly for commercial gain, utilizing a likelihood of confusion with Complainant’s famous mark to obtain personal gain. This is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *General Electric Co. v. Bakhit*, Case No. D2000-0386; *CBS Broadcasting, Inc. v. LA-Twilight-Zone*, Case No. D2000-0397; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Big Dog Holdings, Inc. v. Day*, Case No. FA 93554; *MSNBC Cable, LLC v. Tsysys.com*, Case No. D2000-1204; *Nokia Corp. v. Private*, Case No. D2000-1271; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *America Online, Inc. v. Tencent Comm. Corp.*, Case No. FA 93668; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761.
- j. Judicial decisions and statutes cited: None

**2300. The Cold War Museum v Nicolas Jampol, No. FA0102000096594**

- a. Date: March 26, 2001
- b. Panelist(s): Herman D. Michels
- c. Domain Name(s) at Issue: <coldwarmuseum.com; coldwarmuseum.net; coldwarmuseum.org>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 4(i), 15(a)
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2301. Cambridge Technology Partners, Inc. v Joe Mastriano, No. FA0102000096591**

- a. Date: March 26, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <cambridgetechnologypartners.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent asserted no rights or legitimate interests in the domain name at issue, which entitles the Panel to conclude that Respondent has no such rights or legitimate interests in the disputed domain name.”
  - 2) “Respondent’s only use of the disputed domain name was to offer it for sale to the Complainant for an amount in excess of any out-of-pocket costs

directly related to the domain name. This is evidence of bad faith.”

- 3) “Respondent has passively held the disputed domain name since its registration. This also permits an inference of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *American Golf Corp. v. Perfect Web Corp.*, Case No. D2000-0908; *Football Ass’n Ltd. v. UKIP*, Case No. D2000-1359; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Grundfos A/S v. Lokale*, Case No. D2000-1347; *Dynojet Research, Inc. v. Norman*, Case No. AF-0316; *Alitalia –Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232.
- j. Judicial decisions and statutes cited: None

**2302. Broadcom Corporation v. Broadcom Technologies, No. FA0101000096573**

- a. Date: March 27, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <broadcomtech.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Adding a generic word to an established and distinctive mark does not create a distinguishable domain name and does not defeat the mark holder’s rights in the mark.”
  - 2) “Respondent’s use of the contested domain name appears to be with the intent to secure commercial gain through intentional diversion of Complainant’s consumers to Respondent’s web site. This conduct is not a bona fide or legitimate use of the domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i), 4(a)(ii), 4(b)(iii), 4(b)(iv), 4(c)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409; *Big Dog Holdings, Inc. v. Frank Day*, Case No. FA 93554; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374.
- j. Judicial decisions and statutes cited: None

**2303. Technology Properties, Inc. v. Personal, No. FA0101000096569**

- a. Date: March 26, 2001
- b. Panelist(s): Harold Kalina
- c. Domain Name(s) at Issue: <wwwradioshack.com>
- d. Response?: No
- e. Principle(s):
  - 1) “[A] domain name that takes advantage of this common typographical error is confusingly similar to any such mark held by the Complainant.”

- 2) “Offering bona fide services or products in connection with a website is evidence of rights and legitimate interests in the domain name. However, offering services or products, via a confusingly similar domain name, that are comparable to the products and services of the trademark owner, is not a bona fide use of the domain name.”
  - 3) “Respondent has linked the domain name to a website offering similar merchandise for sale to Internet users. This conduct has been held to be an element of bad faith under Policy ¶ 4(b)(iii) and (iv).”
- f. Result: Name transfer
  - g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(iii), 4(b)(iv), 4(c)(i)
  - h. Uniform Rules cited: 5(e), 14(a), 15(a)
  - i. Panel Decisions cited: *Bank of America Corp. v. InterMos*, Case No. FA 95092; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *EBAY, Inc. v. MEODesigns and Matt Oettinger*, Case No. D2000-1368; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650.
  - j. Judicial decisions and statutes cited: None

**2304. Best Western Internat'l., Inc. v Walter Wieczorek, No. FA0101000096557**

- a. Date: March 27, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <bestwestern.tv>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent asserted no rights or legitimate interests in the domain name at issue, which entitles the Panel to conclude that Respondent has no such rights or legitimate interest in the domain name.”
  - 2) “The popularity of Complainant’s mark permits the conclusion that Respondent knew or should have known of Complainant’s well-known mark prior to registering the disputed domain name. This is evidence of bad faith.”
  - 3) “Respondent has passively held the disputed domain name since its registration. This is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Hollywood Network, Inc. v Video Citizen Network*, Case No. FA 95897; *Rollerblade, Inc. v. McCrady*, Case No. D2000-0429; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Alitalia –Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *DCI S.A. v. Link Commercial Corp.* Case No. D2000-1232; *Hewlett-Packard Co. v. Martineau*, Case No. FA 95359.
- j. Judicial decisions and statutes cited: None

**2305. General Media Communications, Inc. v Vine Ent., No. FA0101000096554**

- a. Date: March 26, 2001
- b. Panelist(s): Harold Kalina
- c. Domain Name(s) at Issue: <penthaus.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent has shown bad faith by preventing Complainant from registering a domain name that reflects Complainant’s mark and by exhibiting a pattern of registering misspellings of famous trademarks and names.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *VeriSign Inc. v. VeneSign C.A.*, Case No. D2000-0303; *Kosmea Pty Ltd. v. Carmel Krpan*, Case No. D2000-0948; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *Nike, Inc. v. B. B. de Boer*, Case No. D2000-1397; *America Online, Inc. v. iDomainNames.com*, Case No. FA 93766; *Southern Exposure v. Southern Exposure, Inc.*, Case No. FA 94864.
- j. Judicial decisions and statutes cited: None

**2306. The Pennsylvania State University v. Joel Gehman d/b/a WeArePennState.com, No. FA0103000096842**

- a. Date: April 2, 2001
- b. Panelist(s): Daniel B. Banks, Jr.
- c. Domain Name(s) at Issue: <nittanylions.org; pennstatebookstore.com; pennstatestore.com; and wearepennstate.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Attracting Internet users, for commercial gain, to Respondent’s web site or other on-line location, 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 services is evidence of bad faith registration and use.”
  - 2) “Passive holding of a domain name not connected to Respondent may be evidence of bad faith registration and use.”
- f. Result: Name Cancellation
- g. Policy cited: 4(a), 4(a)(iii), 4(b)(iv), 4(c)(i), 4(c)(ii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *University of Alberta v. Katz*, Case No. D2000-0378; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Leland Stanford Junior Univ. v. Zedlar*, Case No. FA 94970; *Univ. of Wyoming v. Horton*, Case No. D2000-0366; *Imperial College of Science, Technology and Medicine v. Webweaver Media Construction*, Case No. D2000-1146; *Alitalia – Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *Phat*

- Fashions v. Kruger*, Case No. FA 96193;  
j. Judicial decisions and statutes cited: None

**2307. Travel In A Moment, Inc. v. F.S. Janco, No. FA0103000096821**

- a. Date: April 9, 2000  
b. Panelist(s): Nelson A. Diaz  
c. Domain Name(s) at Issue: <momentsnoticetravel.com>  
d. Response?: Yes  
e. Principle(s):  
1) "It is well-established that the addition of a generic word to an established trademark does not defeat the owner's rights in the mark."  
2) "Moreover, the addition of .com or the absence of a hyphen or apostrophe is not significant in determining similarity."  
3) "Based on the failure to produce any evidence of a business plan, an inference may be fairly drawn that there never was an intention to use the contested domain name for a bona fide business."  
4) "A demand for payment [by Respondent for an amount in excess of the out of pocket expenses for registering the domain names] has been deemed evidence of bad faith where Respondent has made no other use of the domain name."  
f. Result: Name transfer  
g. Policy cited: 4(a), 4(b), 4(b)(i), 4(c), 4(c)(i)-(iii).  
h. Uniform Rules cited: None  
i. Panel Decisions cited: *Space Imaging LLC v. Brownwell*, Case No. AF 0298; *Yahoo! Inc. v. Casino Yahoo, Inc.*, Case No. D2000-0660; *Mrs. World Pageants, Inc. v. Crown Promotions*, Case No. FA 94321; *Hewlett-Packard Co. v. High Performance Networks, Inc.*, Case No. FA 95083; *Educational Testing Service v. TOEFL*, Case No. D2000-0044; *Wrestling Fed'n Entertainment, Inc. v. Bosman*, Case No. D99-0001.  
j. Judicial decisions and statutes cited: *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 127 (S.D.N.Y. 1989); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999); *Dreamwerks Prod. Group v. SKG Studio*, 142 F.3d 1127, 1131 (9th Cir.1998); *Knightside Marketing Svcs. v. Promociones & Proyectos*, 728 F.2d 572, 575 (1st Cir.1984).

**2308. Micron Electronics, Inc. v. Frank Holden d/b/a Magical Islands Sounds, No. FA0103000096797**

- a. Date: April 4, 2001  
b. Panelist(s): Ralph Yachnin  
c. Domain Name(s) at Issue: <Micron-PC.com>  
d. Response?: No  
e. Principle(s):  
1) "For purposes of assessing the confusing similarity between domain names and trademarks, UDRP Panels have held that top-level domain extensions, spaces, hyphens and punctuation are ignored."

- 2) “UDRP Panels have held that bad faith registration and use can be established by other factors that are not set forth in paragraph 4(b).”
  - 3) “Respondent’s warehousing of the domain name, in addition to his failure to submit a response in this proceeding, reveal that Respondent registered and used the domain name in bad faith.”
- f. Result: Name transfer
  - g. Policy cited: 4(a), 4(b), 4(c)(i)-(iii)
  - h. Uniform Rules cited: 5(e), 14(a), 15(a)
  - i. Panel Decisions cited: *Talk City, Inc. v. Robertson*, Case No. D2000-0009; *InfoSpace.com v. Tenenbaum Ofer*, Case No. D2000-0075; *Columbia Sportswear Co. v. Keeler*, Case No. D2000-0206; *Nike, Inc. v. Crystal Int’l*, Case No. D2001-0102; *Chanel, Inc. v. Urainia Heyward*, Case No. D2000-1802; *Home Interiors & Gifts, Inc. v. Home Interiors*, Case No. D2000-0010; *Educational Testing Service v. TOEFL*, Case No. D2000-0044; *America Online Inc. v. Shenzhen JZT Computer Software Co. Ltd*, Case No. D2000-0809; *Chanel, Inc. AG v. Designer Exposure*, Case No. D2000-1832; *Hewlett-Packard Co. v. Martineau*, Case No. FA 95359.
  - j. Judicial decisions and statutes cited: None

**2309. Dollar Financial Group, Inc. v. Robert Wells, No. FA0103000096787**

- a. Date: April 3, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <cashtopayday.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent’s domain name...is phonetically similar, and therefore confusingly similar to the Complainant’s well-established mark.”
  - 2) “Respondent asserted no rights or legitimate interests in regard to the disputed domain name; therefore, the Panel is free to conclude Respondent has no such rights or legitimate interests in the domain name.”
  - 3) Passive holding of a domain name since its registration demonstrates bad faith.
  - 4) “[G]iven Complainant’s high profile presence in the [relevant] community, Respondent knew or reasonably should have known of Complainant’s mark prior to registering the disputed domain name.”
  - 5) Registering a domain name to intentionally attract Internet users to a web site, or other on-line location, via a likelihood of confusion with Complainant’s well-established mark is evidence of bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Hewlett-Packard Co. v. Cupcake City*, Case No. FA 93562; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Alitalia –Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *DCI S.A. v. Link Commercial Corp.* Case

No. D2000-1232; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA 96356.

j. Judicial decisions and statutes cited: None

**2310. Dollar Financial Group, Inc. v. MH2 & Associates, No. FA0102000096775**

a. Date: April 3, 2001

b. Panelist(s): James A. Carmody

c. Domain Name(s) at Issue: <shoploanmart.com>

d. Response?: No

e. Principle(s):

- 1) “[I]t has been established in other UDRP proceedings that use of a confusingly similar website in connection with competing services is not a ‘bona fide’ use under the Policy.”
- 2) “Respondent’s use of the domain name to link to his website which offers competing loan services undoubtedly reveals bad faith under Policy ¶¶ 4(b)(iii) and (iv).”

f. Result: Name transfer

g. Policy cited: 4(a), 4(a)(i), 4(a)(ii), 4(b), 4(b)(iii), 4(b)(iv), 4(c), 4(c)(i)-(iii)

h. Uniform Rules cited: 5(e), 14(a), 15(a)

i. Panel Decisions cited: *L.L. Bean, Inc. v. ShopStarNetwork*, Case No. FA 95404; *North Coast Medical, Inc. v. Allegro Medical*, Case No. FA 95541; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *America Online Inc. v. Shenzhen JZT Computer Software Co. Ltd.*, Case No. D2000-0809; *Fossil Inc. v. NAS*, Case No. FA 92525; *Busy Body, Inc. v. Fitness Outlet, Inc.*, Case No. D2000-0127; *MathForum.com, LLC v. Weiguang Huang*, Case No. D2000-0743.

j. Judicial decisions and statutes cited: None

**2311. Amherst LLC d/b/a Amherst Corporate Sales & Solutions v. IFC Corporation, No. FA0102000096768**

a. Date: April 3, 2001

b. Panelist(s): Ralph Yachnin

c. Domain Name(s) at Issue: <customcommerce.com>

d. Response?: No

e. Principle(s):

- 1) “Prior UDRP Panels have held that the ‘.com’ is insignificant when determining whether a domain name is identical or confusingly similar.”
- 2) “By failing to respond, Respondent has fallen short of asserting rights and legitimate interests in the domain name.”
- 3) “Prior UDRP Panels have held that providing misleading or inaccurate information to the domain name registrar is evidence of bad faith.”
- 4) “Respondent’s use of a fictitious corporate front for registration of a domain name is additional evidence of bad faith.”
- 5) “Passive holding of a domain name is evidence of bad faith use.”

f. Result: Name transfer

- g. Policy cited: 4(a), 4(a)(i), 4(a)(ii), 4(c), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Visit America Inc. v. Visit America*, Case No. FA 95093; *Banco Mercantil del Norte, S.A., v. Servicios de Comunicación En Linea*, Case No. D2000-1215; *BIC Deutschland GmbH & Co. KG v. Tweed*, Case No. D2000-0418; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-0039; *Home Director, Inc. v. HomeDirector*, Case No. D2000-0111; *Video Direct Distributors, Inc. v. Video Direct, Inc.*, Case No. FA 94724; *Visit America, Inc. v. Visit America*, Case No. FA 95093; *Quixtar Inv., Inc. v. Smithberger and QUIXTAR-IBO*, Case No. D2000-0138; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232; *Mondich & Am. Vintage Wine Biscuits, Inc. v. Brown*, Case No. D2000-0004.
- j. Judicial decisions and statutes cited: None

**2312. Bloomberg L.P. v. Grandtotal Finances Limited, No. FA0102000096760**

- a. Date: April 5, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <bloombrg.com>
- d. Response?: No
- e. Principle(s):
  - 1) “[T]he disputed domain name is deemed to be identical because phonetically it is the same as Complainant’s mark.”
  - 2) Using a domain name to redirect Internet traffic is not a bona fide use.
  - 3) “Respondent has asserted no rights or legitimate interests in the disputed domain name, which entitles the Panel to conclude that Respondent has no such rights or legitimate interests in the domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(ii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decision cited: *Universal City Studios, Inc. v. HarperStephens*, Case No. D2000-0716; *Hewlett-Packard Co. v. Cupcake City*, Case No. FA 93562; *MSNBC Cable, LLC v. Tsys.com*, Case No. D2000-1204; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA 96356; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *America Online, Inc. v. iDomainNames.com*, Case No. FA 93766; *Encyclopaedia Britannica Inc. v. Shedon.com*, Case No. D2000-0753; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471.
- j. Judicial decisions and statutes cited: None

**2313. Marubeni Corporation v. Marubeni Family, No. FA0102000096703**

- a. Date: March 28, 2001
- b. Panelist(s): Ralph Yachnin
- c. Domain Name(s) at Issue: <marubeni.net>
- d. Response?: No
- e. Principle(s):

- 1) “Respondent’s passive holding of the domain name is evidence of Respondent’s lack of rights and legitimate interests in the domain name.”
  - 2) “Offering a domain name, which infringes upon another’s trademark, for sale in excess of out of pocket costs is evidence of bad faith.”
  - 3) “Complainants have established their long-standing use of their famous mark. The reasonable inference may be drawn, therefore, that Respondent knew or had to have known about Complainants’ famous mark prior to registering the domain name in question. This is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Technology Properties, Inc. v. Burris*, Case No. FA 94424; *Surface Protection Indus., Inc. v. The Webposters*, Case No. D2000-1613; *Ritz-Carlton Hotel v. Club Car Executive*, Case No. D2000-0611; *Flor-Jon Films, Inc. v. Larson*, Case No. FA 94974; *The Step2 Co. v. Softastic.com Corp.*, Case No. D2000-0393; *Kraft Foods (Norway) v. Wide*, Case No. D2000-0911; *Telstra Corp. v. Nuclear Marshmallows*, Case No. D2000-0003.
- j. Judicial decisions and statutes cited: None.

**2314. Bank of America Corporation v. Stonybrook Investments, Ltd.,  
No. FA0102000096702**

- a. Date: April 4, 2001
- b. Panelist(s): Harold Kalina
- c. Domain Name(s) at Issue: <bankoamerica.com; bankofamerca.com; bankfoamerica.com>
- d. Response?: No
- e. Principle(s):
- 1) “Using a confusingly similar domain name to divert Internet users to another Internet location is not a bona fide offering of goods and services under Policy ¶ 4(c)(i).”
  - 2) “Respondent’s registrations of misspellings and ‘typos’ of other famous marks also provide strong evidence of Respondent’s bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(ii), 4(a)(iii), 4(b)(iv), 4(c)(i), 4(c)(ii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Bank of America Corp. v. Yomtobian*, Case No. FA 94889; *Bank of America Corp. v. InterMos*, Case No. FA 95092; *Parfums Christian Dior v. QTR Corp.*, Case No. D2000-0023; *Société des Bains v. International Lotteries*, Case No. D2000-1326; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Dr. Karl Albrecht v. Eric Natale*, Case No. FA 95465; *Encyclopaedia Britannica Inc. v. Shedon.com*, Case No. D2000-0753.
- j. Judicial decisions and statutes cited: *Electronics Boutique Holdings Corp. v. Zuccarini*, 56 U.S.P.Q.2d 1705, 1710-11 (E.D. Pa. 2000).

**2315. The Black & Decker Corp. v. Eric Savelle dba Tools Plus, Inc.,  
No. FA0102000096700**

- a. Date: April 10, 2001
- b. Panelist(s): Daniel B. Banks, Jr., Louis E. Condon, M. Kelly Tillery
- c. Domain Name(s) at Issue: <dewalt-power-tools.net; dewalt-woodworking-tools.com; dewalt-woodworking-tools.net; dewaltwoodworkingtools.org; dewaltpowertools.org; dewalt-power-tools.org; dewalt-power-tools.com; dewalt-power-tool.com; dewalt-woodworking.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Using a domain name, to attract Internet users, for commercial gain, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the web site is evidence of bad faith registration and use.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b)(i), 4(b)(iv), 4(c), 4(c)(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *PG&E Corporation v. Anderson*, Case No. D2000-1264; *Caterpillar Inc. v. Quin*, Case No. D2000-0314; *State Farm Mut. Auto. Ins. Co. v. LaFaive*, Case No. FA 95407; *Ullfrotté AB v. Bollnas Imports*, Case No. D2000-1176; *Volkswagen of Am., Inc. v. Site Design Online*, Case No. FA 95753; *Fossil, Inc. v. NAS*, Case No. FA 92525; *Nokia Corp. v. Uday Lakhani*, Case No. D2000-0833; *Gorstew Ltd. & Unique Vacations, Inc. v. Satin Leaf, Inc.*, Case No. FA 95414; *Matmut v. Tweed*, Case No. D2000-1183.
- j. Judicial decisions and statutes cited: None

**2316. Water Pik, Inc. v. Nam Kyoon Kwon, No. FA0102000096699**

- a. Date: April 4, 2001
- b. Panelist(s): Harold Kalina
- c. Domain Name(s) at Issue: <waterpik.net; waterpik.org>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent’s failure to use the domain names and failure to assert any legitimate interest in the domain names satisfies Complainant’s burden under Policy ¶ 4(a)(ii).”
  - 2) “Registration with actual or constructive knowledge of Complainant’s marks is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(ii), 4(c)(ii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Coty Cosmetics Inc. v. Jaguar Ltd.*, Case No. AF 0416; *State Fair of Texas v. State Fair Guides*, Case No. FA 95066; *Geocities v. Geociites.com*, Case No. D2000-0326; *Ty. Inc. v. Parvin*, Case No. D2000-0688; *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409; *Phat Fashions v. Kruger*, Case No. FA 96193; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *London Metal Exch. Ltd. v. Hussain*, Case No. D2000-1388; *America Online Inc. v. Shenzhen JZT Computer Software Co. Ltd*, Case No. D2000-0809.

j. Judicial decisions and statutes cited: None

**2317. PepsiCo, Inc. v. Datasphere Ltd., No. FA0102000096695**

- a. Date: April 9, 2001
- b. Panelist(s): Irving H. Perluss
- c. Domain Name(s) at Issue: <pepsicola.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “[I]nactivity and failure to create a website can be the indicia of bad faith.”
  - 2) “[T]here is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Hollywood Network, Inc. v. Video Citizen Network*, Case No. FA 95897; *Muggles Magical Toys, Inc. v. Muggles.org*, Case No. FA 94798; *CBS Broadcasting, Inc. v. Edward Enterprises*, Case No. D2000-0242; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA 96356; *Nike, Inc. v. B.B. de Boer*, Case No. D2000-1397; *Gorstew Ltd. v. Twinsburg Travel*, Case No. FA 94944; *Phat Fashions v. Kruger*, Case No. FA 96193; *Bloomberg LP v. Schorsch*, Case No. FA 96576; *Hungry Minds, Inc. v. Mall For Dummies*, Case No. FA 96635; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232; *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409.
- j. Judicial decisions and statutes cited: Restatement of the Law, Third, *Unfair Competition* (1995) Section 29, Comment c; *Carl Zeiss Stiftung v. VEB Carl Zeiss, Jena* (SDNY 1968) 293 F.Supp. 892, 917, affirmed (2d Cir. 1970) 433 F.2d 686, cert. denied (1971) 403 U.S. 905, *Interstellar Starship Services, Ltd. v. Epix, Inc.* (CA 9th 1999) 184 F.3d 1107, *Brookfield*, 174 F.3d at 1059, *Sleekcraft*, 550 F.2d at 354, *Green Products Co. v. Independence By-Products Co.* (N.D. Iowa 1997), 992 F.Supp. 1070.

**2318. Victoria's Secret et al v. Sherry Hardin, No. FA0102000096694**

- a. Date: March 31, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <bodybyvictoria.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Under certain facts and circumstances even inaction can constitute "bad faith" use of a domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i), 4(a)(iii), 4(c), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *American Golf Corp. v. Perfect Web Corp.*, Case

- No. D2000-0908; *BIC Deutschland GmbH & Co. KG v. Tweed*, Case No. D2000-0418; *State Fair of Texas v. State Fair Guides*, Case No. FA 95066; *Exxon Mobil Corp. v. Fisher*, Case No. D2000-1412; *Dr. Karl Albrecht v. Eric Natale*, Case No. FA 95465; *Telstra Corp. v. Nuclear Marshmallows*, Case No. D2000-0003; *Telstra Corp. v. Nuclear Marshmallows*, Case No. D2000-0003.
- j. Judicial decisions and statutes cited: *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999).

**2319. Sunglass Hut Corporation v. Domain Administrator, No. FA0102000096691**

- a. Date: April 9, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <sunllasseshut.com>
- d. Response?: No
- e. Principle(s):
- 1) "Prior UDRP Panels have found no rights or legitimate interests in a domain name where respondent's purported use seems rather dubious."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(iv)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *National Geographic Soc. v. Stoneybrook Inv.*, Case No. FA 96263; *Cream Pie Club v. Halford*, Case No. FA 95235; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA 96356; *Phat Fashions v. Kruger*, Case No. FA 96193; *CCA Indust., Inc. v. Dailey*, Case No. D2000-0148; *MatchNet plc. v. MAC Trading*, Case No. D2000-0205.
- j. Judicial decisions and statutes cited: None

**2320. The State-Record Company, Inc & Knight Ridder, Inc. v. Godpilot, No. FA0102000096686**

- a. Date: April 4, 2001
- b. Panelist(s): Ralph Yachnin, M. Scott Donahey, James A. Carmody
- c. Domain Name(s) at Issue: <thestatenewspaper.com; thestatepaper.com>
- d. Response?: Yes
- e. Principle(s):
- 1) "Respondent's passive holding of the domain names at issue is evidence of Respondent's lack of rights and legitimate interests in the domain names."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Space Imaging LLC v. Brownwell*, Case No. AF 0298; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Ritz-Carlton Hotel v. Club Car Executive*, Case No. D2000-0611; *Open Systems Computing AS v. Alberto degli Alessandri*, Case No. D2000-1393; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-0039; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232; *Caravan Club v. Mrgsale*, Case No.

FA 95314; *Cruzeiro Licenciamentos Ltda v. Sallen and Sallen Enterprises*, Case No. D2000-0715; *Grundfos A/S v. Lokale*, Case No. D2000-1347; *Wembley Nat'l Stadium Ltd. v. Thomson*, Case No. D2000-1233.

j. Judicial decisions and statutes cited: None

**2321. Hachette Filipacchi Presse v. Fortune Int'l Development, No. FA0102000096685**

a. Date: April 6, 2001

b. Panelist(s): James A. Carmody

c. Domain Name(s) at Issue: <elle2000.com>

d. Response?: No

e. Principle(s):

- 1) “[P]assive use does not constitute a legitimate commercial or non-commercial use under paragraph 4(c) of the Policy.”
- 2) “Many UDRP Panels have held that, under appropriate circumstances, passive holding evidences bad faith use of a domain name...The ‘passive holding’ test has been well established in the UDRP.”

f. Result: Name transfer

g. Policy cited: 4(a), 4(a)(i), 4(a)(iii), 4(b)(ii), 4(c), 4(c)(i)-(iii)

h. Uniform Rules cited: 5(e), 14(a), 15(a)

i. Panel Decisions cited: *Omnitel Pronto Italia S.p.A. v. Carlo Dalla Bella*, Case No. D2000-1641; *American Home Prod. Corp. v. Malgioglio*, Case No. D2000-1602; *Hitachi, Ltd. v. Fortune Int'l Dev. Ent.*, Case No. D2000-0412; *Pep Boys Manny, Moe, and Jack v. E-Commerce Today, Ltd.*, Case No. AF-0145; *JVC Americas Corp. v. Damian Macafee*, Case No. CPR007; *Pacific Investment Management Co. LLC v. Alex Szabo*, Case No. FA 95614; *National Australia Bank Ltd. v. Quality Systems Consulting*, Case No. D2000-0765; *Gonvarri Industrial, S.A. v. Gon Varr I An Sexo a Domicilio*, Case No. D2000-0637; *Garage Records, Inc. v. Garage Records*, Case No. FA 95071; *Dollar Financial Group, Inc. v. RXW Management*, Case No. FA 95108; *Lusomundo - Sociedade Gestora de Parcipacoes Sociais, S.A. v. Inmo Soria and Andres Ceballos Moscoso*, Case No. D2000-0523; *Valigene Corp. v. MIC*, Case No. FA 94860; *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, Case No. FA 95095; *Hewlett-Packard Co. v. High Performance Networks, Inc.*, Case No. FA 95083; *CBS Broadcasting, Inc. v. Toeppen*, Case No. D2000-0400; *August Storck KG v. Tony Mohamed*, Case No. D2000-0196; *Recordati S.P.A. v. Domain Name Clearing Co.*, Case No. D2000-0194; *Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau*, Case No. D2000-0172; *Telstra Corp. Ltd. v. Nuclear Marshmallows*, Case No. D2000-0003.

j. Judicial decisions and statutes cited: None

**2322. Netfolio Inc. v. Tantalus Investments, No. FA0102000096684**

a. Date: March 27, 2001

b. Panelist(s): Roger P. Kerans

c. Domain Name(s) at Issue: <enetfolio.com>

d. Response?: Yes

- e. Principle(s):
  - 1) “Valuable preparatory work done in connection with the proposed use of a web-site creates a minimal commercial interest, and, if proven, can rebut an inference of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *EBAY, Inc. v. MEOdesigns and Matt Oettinger*, Case No. D2000-1368; *SFX Entertainment, Inc. v. Phillip Cushway*, Case No. D2000-0356; *Adamovske Strojirny v Tatu Rautiainen*, Case No. D2000-1394; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Goldmasters Precious Metals v. Gold Masters srl*, Case No. FA 95246.
- j. Judicial decisions and statutes cited: None

**2323. Dollar Financial Group Inc. v. Jewald & Associates Ltd., No. FA0102000096676**

- a. Date: April 6, 2001
- b. Panelist(s): Charles K. McCotter, Jr.
- c. Domain Name(s) at Issue: <usaloanmart.com; usloanmart.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Often trademarks are formed of generic components; however the marks are viewed in their entirety.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Marriott Intl’l, Inc. v. Café au Lait*, Case No. FA93670; *Net2phone Inc, v. Netcall SAGL*, Case No. D2000-0666; *Treeforms, Inc. v. Cayne Ind. Sales Corp.*, Case No. FA 95856; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA96356; *SFX Entertainment, Inc. v. Phillip Cushway*, Case No. D2000-0356; *3Z Productions v. Globaldomain*, Case No. FA94659; *Energy Source Inc. v. Your Energy Source*, Case No. FA96364; *Dollar Financial Group, Inc. v. VQM NET*, Case No. FA96101; *Samsonite Corp. v. Colony Holding*, Case No. FA 94313; *Reuters Ltd. V. Teletrust IPR Ltd.*, Case No. D2000-0471; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232.
- j. Judicial decisions and statutes cited: None

**2324. Sorel Corporation v. Domaine Sales Ltd., No. FA0102000096674**

- a. Date: March 28, 2001
- b. Panelist(s): James P. Buchele
- c. Domain Name(s) at Issue: <sorel.com>
- d. Response?: Yes
- e. Principle(s): None
- f. Result: Decision for Respondent
- g. Policy cited: 4(a), 4(b)(i)-(iv), 4(c)(ii)

- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Melbourne IT Ltd. v. Stafford*, Case No. D2000-1167; *Wal-Mart Stores, Inc. v. Walmarket Canada*, Case No. D2000-0150; *Goldmasters Precious Metals v. Gold Masters srl*, Case No. FA 95246.
- j. Judicial decisions and statutes cited: None

**2325. The Washington Post Company v. Names OZ, No. FA0102000096670**

- a. Date: April 6, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <washigtonpost.com>
- d. Response?: No
- e. Principle(s):
  - 1) Using the disputed domain name to redirect Internet traffic to Respondent's own web site is not a bona fide commercial use and does not establish rights to or interests in Complainant's marks.
  - 2) "Respondent asserted no rights or legitimate interests in the disputed domain name, which entitles the Panel to conclude that Respondent has no such rights or legitimate interests in the domain name."
  - 3) Engaging in a pattern of conduct by registering several infringing domain names comprised of common misspellings of famous marks is evidence of bad faith.
  - 4) Where the Complainant's famous mark is so popular that it permits the strong inference that Respondent knew of Complainant's well-known mark prior to registering the disputed domain name, this is evidence of Respondent's bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(ii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Universal City Studios, Inc. v. HarperStephens*, Case No. D2000-0716; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *MSNBC Cable, LLC v. Tysys.com*, Case No. D2000-1204; *Broadcom Corp. v. Intellifone Corp.*, Case No. FA 96356; *Boeing Co. v. Bressi*, Case No. D2000-1164; *Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc. and D3M Domain Sales*, Case No. AF-0336; *Harcourt, Inc. v. Fadness*, Case No. FA 95247; *Armstrong Holdings, Inc. v. JAZ Associates*, Case No. FA 95234; *Bama Rags, Inc. v. Zuccarini*, Case No. FA 94381; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Reuters Ltd. v. Global Net 2000, Inc.*, Case No. D2000-0441; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471.
- j. Judicial decisions and statutes cited: None

**2326. Harley Shipbuilding Corporation et al v. Fast Cat Boat Works, No. FA0102000096669**

- a. Date: April 6, 2001
- b. Panelist(s): Richard DiSalle
- c. Domain Name(s) at Issue: <harleyshipbuilding.org; harleyshipbuilding.com; harleyshipbuilding.net; harleyboat.com; harleyboat.org; harleyboat.net;

- harleyboats.net; harleyboats.org>
- d. Response?: Yes
  - e. Principle(s):
    - 1) Engaging in a pattern of conduct by registering the disputed domain names, which prevents Complainant (the trademark owner) from reflecting its marks in a corresponding domain name is evidence of bad faith.
  - f. Result: Name Transfer
  - g. Policy cited: 4(a)
  - h. Uniform Rules cited: 15(a)
  - i. Panel Decisions cited: *Hollywood Network, Inc, v Video Citizen Network*, Case No. FA 95897; *Cream Pie Club v. Halford*, Case No. FA 95235; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Household Int'l, Inc. v. Cyntom Enter.*, Case No. FA 95784; *State Farm Mut. Auto. Ins. Co. v. LaFaive*, Case No. FA 95407; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Samsonite Corp. v. Colony Holding*, Case No. FA 94313; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Gamesville.com, Inc. v. John Zuccarini*, Case No. FA 95294.
  - j. Judicial decisions and statutes cited: None

**2327. Decisioneering, Inc. v. PA Gordon, No. FA0102000096668**

- a. Date: March 31, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <crystalball.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Respondent’s failure to make any use of the domain name at issue, during several years of registration, indicates a lack of legitimate interest.”
  - 2) “Respondent has never been known or recognized by the domain name at issue or any name corresponding to such domain name. Thus, Respondent is not making any legitimate noncommercial or fair use of the domain name.”
  - 3) Passive holding of a domain name constitutes bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Blue Sky Software Corp. v. Digital Sierra Inc.*, Case No. D2000-0165; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-0039; *State Fair of Texas v. State Fair Guides*, Case No. FA 95066; *Leland Stanford Junior University v. Zedlar Transcription & Translation*, Case No. FA 94970; *Telstra Corp. v. Nuclear Marshmallows*, Case No. D2000-0003; *Alitalia – Linee Aeree Italiane S.p.A v. Colour Digital*, Case No. D2000-1260; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232.
- j. Judicial decisions and statutes cited: None

**2328. E Street Communications, Inc. v. Middleware Corporation,  
No. FA0102000096663**

- a. Date: March 29, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <estreetcommunications.com>
- d. Response?: No
- e. Principle(s):
  - 1) Respondent's intention is to sell the domain name for a profit is evidence of bad faith.
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b)(iv)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Home Director, Inc. v. HomeDirector*, Case No. D2000-0111; *General Electric Co. v. Forddirect.com, Inc.*, Case No. D2000-0394; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *America Online, Inc. v. Tencent Comm. Corp.*, Case No. FA 93668; *ESPN, Inc. v. Danny Ballerini*, Case No. FA 95410; *Encyclopaedia Britannica Inc. v. Shedon.com*, Case No. D2000-0753; *Globosat Programadora Ltda v. Artmidia Comunicacao Visual Criacao E Arte Ltda*, Case No. D2000-0605.
- j. Judicial decisions and statutes cited: None

**2329. Steamboat Chamber Resort Association Inc. v. Ed Mooney,  
No. FA0102000096662**

- a. Date: March 30, 2001
- b. Panelist(s): Ralph Yachnin
- c. Domain Name(s) at Issue: <steamboatchamber.com>
- d. Response?: No
- e. Principle(s):
  - 1) "Linking a domain name that infringes on another's trademark rights to one's own web site is not a bona fide use of the domain name."
  - 2) "Respondent's offering of services similar to those found at Complainant's web site was not a bona fide offering of goods or services."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *Fishtech v. Rossiter*, Case No. FA 92976; *Chernow Communications Inc. v. Kimball*, Case No. D2000-0119; *Big Dog Holdings, Inc. v. Day*, Case No. FA 93554; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *America Online, Inc. v. Xianfeng*, Case No. D2000-1374; *Lubbock Radio Paging v. Venture Tele-Messaging*, Case No. FA 96102.
- j. Judicial decisions and statutes cited: None

**2330. Stussy Inc. v. Valhalla Promotions aka VP, No. FA0102000096661**

- a. Date: April 2, 2001
- b. Panelist(s): James P. Buchele
- c. Domain Name(s) at Issue: <stussygear.com; stussygirl.com; stussysista.com;

- stussystuff.com>
- d. Response?: No
  - e. Principle(s):
    - 1) Merely combining Complainant's mark with a generic term results in a finding of confusing similarity.
    - 2) Respondent's passive holding of a domain name demonstrates that Respondent has not established rights or legitimate interests in the domain name.
    - 3) "Respondent's attempt to sell the domain names to Complainant for excess of out of pocket expenses shows bad faith on the part of the Respondent."
  - f. Result: Name transfer
  - g. Policy cited: 4(a), 4(a)(i)-(iii), 4(i)
  - h. Uniform Rules cited: 5(e), 14(a), 15(a)
  - i. Panel Decisions cited: *Croatia Airlines v. Kijong*, Case No. AF 0302; *VeriSign, Inc. v. Tandon*, Case No. D2000-1216; *General Electric Co. v. Forddirect.com, Inc.*, Case No. D2000-0394; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-0039; *J. Paul Getty Trust v. Domain 4 Sale & Co.*, Case No. FA 95262; *Hewlett-Packard Co. v. Martineau*, Case No. FA 95359; *Grundfos A/S v. Lokale*, Case No. D2000-1347.
  - j. Judicial decisions and statutes cited: None

**2331. Bloomberg L.P. v. C&C Multimedia, No. FA0102000096659**

- a. Date: April 4, 2001
- b. Panelist(s): Irving H. Perluss
- c. Domain Name(s) at Issue: <bloomberg.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) "It is established that in determining credibility, a witness false in one part of his testimony is to be distrusted in others, and the entire testimony of a witness who willfully has testified falsely on a material point may be rejected."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b), 4(b)(iv), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Cream Pie Club v. Halford*, Case No. FA 95235; *Luck's Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650; *Perot Sys. Corp. v. Perot.net*. Case No. FA 95312; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471.
- j. Judicial decisions and statutes cited: None

**2332. Bloomberg L.P. v. Bloomberg Sports, No. FA0102000096639**

- a. Date: April 2, 2001
- b. Panelist(s): Paul A. Dorf
- c. Domain Name(s) at Issue: <bloombergproductions.com>;  
<bloombergsports.com>; <bloombergsportsinfo.com>; <bloombergsportsnews.com>;

- bloombergssportspicks.com; michaelrbloomberg.com>
- d. Response?: Yes
  - e. Principle(s):
    - 1) “Even though the Respondent’s last name is Bloomberg, which is the same as the Complainant’s famous mark, it may not give the second mark user the right to use his own name to engage in unfair competition.”
  - f. Result: Name transfer
  - g. Policy cited: 4(a)
  - h. Uniform Rules cited: 15(a)
  - i. Panel Decisions cited: *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409; *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, Case No. FA 95856; *Hartford Fire Ins. Co. v. Webdeal.com, Inc.*, Case No. FA 95162; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471.
  - j. Judicial decisions and statutes cited: None

**2333. Lone Wolf Guide Service v. Lone Wolf Guide Service, No. FA0102000096637**

- a. Date: April 6, 2001
- b. Panelist(s): Carolyn Marks Johnson
- c. Domain Name(s) at Issue: <lonewolfguideservice.com>
- d. Response?: No
- e. Principle(s):
  - 1) “Respondent failed to assert rights or legitimate interests in the disputed domain name, which allows the Panel to conclude that Respondent has no such rights or legitimate interests in the domain name.”
  - 2) “[T]he evidence permits the inference that Respondent knowingly attempted to infringe upon Complainant’s mark prior to registration of the disputed domain name because Respondent’s domain name provides a link to Complainant’s own web site via the disputed domain name. This is obvious bad faith use of another’s mark.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)
- i. Panel Decisions cited: *American Golf Corp. v. Perfect Web Corp.*, Case No. D2000-0908; *Wembley Nat’l Stadium Ltd. v. Thomson*, Case No. D2000-1233; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Household Int’l, Inc. v. Cyntom Enter.*, Case No. FA 95784; *AT&T Corp. v. Domains by Brian Evans*, Case No. D2000-0790; *Pavillion Agency, Inc. v. Greenhouse Agency Ltd.*, Case No. D2000-1221; *Luck’s Music Library v. Stellar Artist Mgmt.*, Case No. FA 95650; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Reuters Ltd. v. Teletrust IPR Ltd.*, Case No. D2000-0471; *Twentieth Century Fox Film Corp. v. Risser*, Case No. FA 93761.
- j. Judicial decisions and statutes cited: None

**2334. Hungry Minds, Inc. v. Mall For Dummies, No. FA0102000096635**

- a. Date: April 4, 2001
- b. Panelist(s): Irving H. Perluss

- c. Domain Name(s) at Issue: <mallfordummies.com; mall4dummies.com; booksfordummies.net; books4dummies.com; mallfordummies.net; mallfordummies.org; mall4dummies.net>
- d. Response?: Yes
- e. Principle(s):
  - 1) “[I]t is actual use of a mark that creates legal rights. It is not a race to the United States Patent and Trademark Office that is important, but it is a race to the marketplace.”
  - 2) “In addition to the demonstration of bad faith by the application of subparagraph (iv) of Section 4(b) of the Policy, there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b), 4(b)(iv), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Phat Fashions v. Kruger*, Case No. FA 96193; *Bloomberg LP v. Schorsch*, Case No. FA 96576; *Madonna v. Parisi*, Case No. D2000-0847.
- j. Judicial decisions and statutes cited: *MGM-Pathe Communications v. Pink Panther Patrol* (S.D.N.Y., 1991) 774 F.Supp. 869; *Avery Dennison Corp. v. Sumpton* (9th Cir. 1999) 189 F.3d 868; *Interstellar Starship Services, Ltd. v. Epix, Inc.* (CA 9th 1999) 184 F.3d 1107; *Sleekcraft*, 550 F.2d at 354; *Green Products Co. v. Independence By-Products Co.* (N.D. Iowa); 1997) 992 F.Supp.1070; *Brookfield Comm., Inc. v. West Coast Entertainment Corp.* (9th Cir. 1999) 174 F.3d 1036.

**2335. US Relocation Services Inc. v Terry Hastings, No. FA0102000096633**

- a. Date: April 6, 2001
- b. Panelist(s): Paul A. Dorf
- c. Domain Name(s) at Issue: <usrelocation.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) A finding of no bad faith may be reached when the domain name is comprised of generic terms and there is no direct evidence that Respondent registered the domain name with the intent of capitalizing on Complainant’s trademark interest.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Rollerblade, Inc. v. CBNO and Ray Redican Jr.*, Case No. D2000-0427; *SOCCKERPLEX, INC. v. NBA Inc.*, Case No. FA 94361; *SFX Entertainment, Inc. v. Phillip Cushway*, D2000-0356; *3Z Productions v. Globaldomain*, Case No. FA 94659; *Lumena s-ka zo.o. v. Express Ventures LTD*, Case No. FA 94375; *Goldmasters Precious Metals v. Gold Masters srl*, Case No. FA 95246.
- j. Judicial decisions and statutes cited: None

**2336. Down East Enterprise Inc. v. Countywide Communications,  
No. FA0102000096613**

- a. Date: April 12, 2001
- b. Panelist(s): R. Glen Ayers
- c. Domain Name(s) at Issue: <downeastmagazine.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Respondent’s conduct in providing a link from its website to that of a competitor of the Complainant is clear evidence of bad faith for such a link would direct legitimate traffic from Complainant’s business to the business of a competitor. Whether the Respondent stands to gain financially is not relevant.”
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Anne of Green Gables Licensing Authority, Inc. v. Internetworks*, Case No. AF 0109; *Toronto Dominion Bank v. Karpachev*, Case No. D2000-1571; *American Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *Big Dog Holdings, Inc. v. Day*, Case No. FA 93554; *Matmut v. Tweed*, Case No. D2000-1183.
- j. Judicial decisions and statutes cited: None

**2337. Northwest Airlines, Inc. v. Cynthia Jorgenson, No. FA0102000096586**

- a. Date: March 28, 2001
- b. Panelist(s): Tyrus R. Atkinson, Jr.
- c. Domain Name(s) at Issue: <northwestairlines.org>
- d. Response?: Yes
- e. Principle(s):
  - 1) “As a result of Complainant’s showing, and Respondent’s apparent lack of rights and legitimate interests in the domain name, the burden must shift to Respondent to demonstrate Respondent’s rights and legitimate interests in the domain name.”
  - 2) “It is inappropriate to permit trademark owners to shut down sites that are aimed at criticism of the trademark holder because the content contained in the site is unfair, unwarranted, or untrue. Trademark rights may be limited by First Amendment concerns.”
  - 3) “It is beyond the scope of domain dispute cases to consider the issue of the boundaries of free speech generally and the manner and extent to which a trademark may be used fairly and without infringement.”
  - 4) “A distinction must be drawn between the domain name itself and the contents of the site which is reached through the domain name.... A party may have First Amendment rights as to the content of the site, but that does not give the party an equal right to use the marks of another in the domain name.”
  - 5) “A domain name is not only an address, it is a personal identifier.”

- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b)(iii), 4(c)(i)-(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Teleplace, Inc. v. Eileen De Oliveira*, Case No. FA 95835; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Robo Enterprises, Inc. v. Orvin Tobiason*, Case No. FA 95857; *The New York Times Co. v. New York Internet Services*, Case No. D2000-1072; *Wal-Mart Stores, Inc. v. walmartcanadasucks.com and Kenneth J. Harvey*, Case No. D2000-1104; *Mission KwaSizabantu v. Benjamin Rost*, Case No. D2000-0279; *Estee Lauder Inc. v. estelauder.com, estelauder.net and Jett Hanna*, Case No. D2000-0869; *E. & J. Gallo Winery v. Hanna Law Firm*, Case No. D2000-0615; *BMW AG v. Loophole*, Case No. D2000-1156; *Chi-Chi's Inc. v. Restaurant Commentary*, Case No. D2000-0321.
- j. Judicial decisions and statute cited: None

**2338. Aquarius Enterprises, Inc. v. Pet Expo Online, No. FA0102000096585**

- a. Date: April 6, 2001
- b. Panelist(s): Tyrus R. Atkinson, Jr.
- c. Domain Name(s) at Issue: <petexpo.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) "Common law rights in a mark are certainly valid and will be considered in a domain name dispute."
  - 2) "[T]he Uniform Domain Name Dispute Resolution Policy does not require a Complainant to show exclusive trademark rights to proceed under Section 4(a)(i). All that must be shown is a bona fide basis for making the complaint. That is to say, proof of an interest in an alleged mark sufficient to illustrate some rights or interest in the mark. Complainant has made an ample showing on that issue."
  - 3) "It is important to note that the ICANN Rules contemplate only limited evidentiary presentations by the parties. As such UDRP proceedings are inappropriate for conclusively deciding serious questions as to the ownership and proper classification of unregistered marks."
- f. Result: Decision for Respondent
- g. Policy cited: 4(a), 4(a)(i), 4(a)(ii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Hollywood Network, Inc. v. Video Citizen Network*, Case No. FA95897; *Bibbero Sys., Inc. v. Tseu & Assoc.*, Case No. FA 94416; *Smart Design LLC v. Carolyn Hughes*, Case No. D2000-0993; *General Mach. Prod. Co., v. Prime Domains*, Case No. FA 92531; *Tough Traveler Ltd v. Kelty Pack, Inc.*, Case No. D2000-0783; *The Energy Authority v. Maslowski*, Case No. FA 95313; *Pet Warehouse v. Pet.Com, Inc.*, Case No. D2000-0105; *Marbil Co. Inc. v. Sangjun Choi*, Case No. D2000-1275; *High Speed Productions, Inc. v. Thrasher Magazine, Ltd.*, Case No. FA96099.
- j. Judicial decisions and statutes cited: *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.* 469 U.S. 189, (1985).

**2339. Cast & Crew Payroll, Inc. v. Cast Creative Ltd., No. FA0101000096572**

- a. Date: March 28, 2001
- b. Panelist(s): Karl V. Fink
- c. Domain Name(s) at Issue: <castandcrew.net>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Passive holding of a domain name is evidence of bad faith registration and use of a domain name.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b), 4(c)(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *McKinsey Holdings, Inc. v. Indidom*, Case No. D2000-1616; *Melbourne IT Ltd. v. Stafford*, Case No. D2000-1167; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Telstra Corp. v. Nuclear Marshmallows*, Case No. D2000-0003.
- j. Judicial decisions and statutes cited: None

**2340. SEVCOR, International, Inc. v. Innovation International, No. FA0101000096567**

- a. Date: March 29, 2001
- b. Panelist(s): Nelson A. Diaz
- c. Domain Name(s) at Issue: <retingency.com>
- d. Response?: Yes
- e. Principles(s):
  - 1) “Prior to any notice of a dispute, a respondent’s use of ‘the domain name or a *name corresponding to the domain name* in connection with a bona fide offering of goods or services’ is evidence of a legitimate interest in the domain name.”
  - 2) “The act of registering a lapsed domain name in and of itself does not necessarily evidence bad faith.”
- f. Result: Decision for Respondent
- g. Policy cited: 4(a), 4(c), 4(c)(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Welltec ApS v. Dave Gardner*, Case No. D2000-1145; *BAA plc v. Spektrum Media Inc.*, Case No. D2000-1179.
- j. Judicial decisions and statutes cited: None

**2341. Primo Incense v. Spring.net, No. FA0101000096565**

- a. Date: April 12, 2001
- b. Panelist(s): R. Glen Ayers
- c. Domain Name(s) at Issue: <primoincense.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)

- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2342. Brown Shoe Company, Inc. v. Compana LLC, No. FA0101000096562**

- a. Date: April 5, 2001
- b. Panelist(s): John J. Upchurch, Sandra Jo Franklin, Charles K. McCotter, Jr.
- c. Domain Name(s) at Issue: <naturalizer>
- d. Response?: Yes
- e. Principle(s):
  - 1) “[T]he mere assertion by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that a right or legitimate interest does exist.”
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Sydney Opera House Trust v. Trilynx Pty. Ltd.*, Case No. D2000-1224; *Smart Design LLC v. Carolyn Hughes*, Case No. D2000-0993; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *White Pine Software, Inc. v. Desktop Consulting, Inc.*, Case No. D2000-0539.
- j. Judicial decisions and statutes cited: None

**2343. Victoria's Secret et al v. Netchem, Inc., No. FA0101000096560**

- a. Date: April 2, 2001
- b. Panelist(s): Karl V. Fink
- c. Domain Name(s) at Issue: <victoriassecre.com; victoriassecret.com; victoriasseret.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “Respondent’s domain names...are confusingly similar because each domain name only differs from Complainants’ mark by dropping one or two letters.”
  - 2) “The VICTORIA’S SECRET mark is so famous that the Respondent had to have been aware of Complainants’ mark prior to registering the domain names at issue.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(c)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Universal City Studios, Inc. v. HarperStephens*, Case No. D2000-0716; *Reuters Limited v Global Net 2000, Inc.*, Case No. D2000-0441; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Bama Rags, Inc. v. Zuccarini*, Case No. FA 94380; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci*, Case No. D2000-1244; *Flor-Jon Films, Inc. v. Larson*, Case No. FA 94974; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-

0039; *Charles Jourdan Holding AG v. AAIM*, Case No. D2000-0403; *Perot Sys. Corp. v. Perot.net*, Case No. FA 95312; *Nintendo of America Inc v. Pokemon*, Case No. D2000-1230.

j. Judicial decisions and statutes cited: None

**2344. Victoria's Secret et al v. National Rag, No. FA0101000096492**

a. Date: April 3, 2001

b. Panelist(s): Karl V. Fink

c. Domain Name(s) at Issue: <victoriasscretexposed.com>

d. Response?: Yes

e. Principle(s):

- 1) "The addition of a generic word to a mark held by another does not defeat Complainant's rights in the mark."
- 2) "UDRP Panels have found no rights and legitimate interests in a domain name where Respondent is using the domain name to mislead and redirect Internet users."

f. Result: Decision for Respondent

g. Policy cited: 4(a), 4(b)(i)-(iv), 4(c)

h. Uniform Rules cited: 15(a)

i. Panel Decisions cited: *Space Imaging LLC v. Brownwell*, Case No. AF 0298; *Yahoo! Inc. v. Casino Yahoo, Inc.*, Case No. D2000-0660; *PG&E Corporation v. Anderson*, Case No. D2000-1264; *Toronto-Dominion Bank v. Karpachev*, Case No. D2000-1571; *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, Case No. D2000-1228; *Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci*, Case No. D2000-1244; *Flor-Jon Films, Inc. v. Larson*, Case No. FA 94974; *Nintendo of America Inc. v. Jones*, Case No. D2000-0998; *Energy Source Inc. v. Your Energy Source*, Case No. FA 96364.

j. Judicial decisions and statutes cited: None

**2345. EMONEY GROUP Inc. v. Eom, Sang Sik, No. FA0012000096337**

a. Date: March 26, 2001

b. Panelist(s): Bruce Meyerson, Daniel Banks, David Sorkin

c. Domain Name(s) at Issue: <emoney.com>

d. Response?: Yes

e. Principle(s):

f. Result: Decision for Respondent

g. Policy cited: 4(a)

h. Uniform Rules cited: 15(a)

i. Panel Decisions cited: *Successful Money Management Seminars, Inc. v. Direct Mail Express*, Case No. FA 96457; *Pet Warehouse v. Pets.com*, Case No. D2000-0105.

j. Judicial decisions and statutes cited: None

**2346. ActivCard, Inc. v Han-chul Chung, No. FA0010000095838**

a. Date: March 9, 2001

b. Panelist(s): Moon Sung Lee

- c. Domain Name(s) at Issue: <activecard.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(b)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2347. Sony Corporation v. Times Vision, Ltd., No. FA0009000095686**

- a. Date: March 9, 2001
- b. Panelist(s): Tyrus R. Atkinson, Jr., Howard C. Buschman III, James P. Buchele
- c. Domain Name(s) at Issue: <jumbotron.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “In a case where the parties have co-operated in business in the past, and where Respondent acknowledges the registered trademark of Complainant on its web page, the use of a domain name identical to the mark of Complainant by Respondent is not in connection with a bona fide offering of goods or services.”
  - 2) “The mistaken belief that a term is generic is no defense to bad faith registration and use of a registered mark of another.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii), 4(b), 4(b)(iv), 4(c), 4(c)(i), 4(c)(iii)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Interactive Television Corp. v. Noname.com*, Case No. D-2000-0358; *Robus v. Suard*, Case No. D2000-0941; *Welltec ApS v. Gardner*, Case No. D2000-1145; *Rollerblade, Inc. v. CBNO and Ray Redican Jr.*, Case No. D2000-00427; *Rollerblade, Inc. v. CBNO and Ray Redican, Jr.*, Case No. D2000-00427; *General Mach. Prod. Co. v. Prime Domains*, Case No. FA 92531; *The Energy Authority v. Maslowski*, Case No. FA 95313; *High Speed Productions, Inc. v. Thrasher Magazine, Ltd.*, Case No. FA 96099; *Primedia Special Interest Publications v. Treadway*, Case No. D2000-0752; *Welltec ApS v. Dave Gardner*, Case No. D2000-1145; *Robus v. Suard*, Case No. D2000-0941; *Marioff Corporation Oy v. Untra Fog AB*, Case No. D2000-0521; *Volkswagen of Amer., Inc. v. Site Design Online*, Case No. FA 95753; *Fossil, Inc. v. NAS*, Case No. FA 92525; *Nokia Corp. v. Uday Lakhani*, Case No. D2000-0833; *Gorstew Ltd & Unique Vacations, Inc. v. Satin Leaf, Inc.*, Case No. FA 95414; *Sydney Opera House Trust v. Trilynx Pty. Ltd.*, Case No. D2000-1224; *Drew A. Kaplan Agency, Inc. v. DAK.com*, Case No. FA 94328.
- j. Judicial decisions and statutes cited: *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985), *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d. 1036 (9th Cir. 1999), *Twyne’s Case*, 3 Co. Rep. 806, 76 Eng.Rep. 809 (1601).

**2348. Advanced Internet Technologies, Inc. v. AIT, Inc, Case No. D2000-0597**

- a. Date: February 20, 2001
- b. Panelist(s): Mark V. B. Partridge, Terrell Birch, James Dabney
- c. Domain Name(s) at Issue: <ait.com>
- d. Response?: Yes
- e. Principle(s): "...although Respondent asserts that it had no knowledge of Complainant when it registered the Domain Name, it apparently admits that Mr. Richard Lee, who signs the response on behalf of Respondent, was a reseller of Complainant's services prior to registration of the Domain Name. Thus, Respondent's claimed lack of knowledge appears to be false."
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2349. Bombay Dyeing & Manufacturing Co. Ltd. v. Bharat Kumar, Case No. D2000-0616**

- a. Date: March 13, 2001
- b. Panelist(s): Gary Biesty
- c. Domain Name(s) at Issue: <bombaydyeing.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 3(b)
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2350. Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems, Case No. D2000-0858**

- a. Date: December 4, 2000
- b. Panelist(s): Clark W. Lackert, Frederick M. Abbott, Dana Haviland
- c. Domain Name(s) at Issue: <ahmanson.org>
- d. Response?: Yes
- e. Principle(s):
  - i. The Panel has reviewed the evidence submitted by the Complainant concerning ownership of the term AHMANSON and is not satisfied that the Complainant has proven trademark rights in such term. Accordingly, the Panel finds that the domain name "ahmanson.org" is not identical or confusingly similar to a trademark in which the Complainant has rights.
  - ii. The record does show legitimate noncommercial use or fair use by Respondents since the purpose of Respondents' website is to serve as a noncommercial platform to criticize the development activities of Complainant. Determinations regarding legitimate

noncommercial and fair use under the Policy require a balancing of trademark holder and other public interests. Respondent Save Open Space solicits contributions to a cause as a non-profit organization. This distinguishes its activities from those of the respondent in *Monty and Pat Roberts, Inc.v. J. Bartell*, Case No. D2000-0300...

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Monty and Pat Roberts, Inc.v. J. Bartell*, Case No. D2000-0300; *Bridgestone/Firestone, Inc. v. Jack Myers*, WIPO Case No. D2000-0190
- j. Judicial decisions and statutes cited: None

**2351. Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems, Case No. D2000-0859**

- a. Date: December 4, 2000
- b. Panelist(s): Clark W. Lackert, Frederick M. Abbott, Dana Haviland
- c. Domain Name(s) at Issue: <ahmansonranch.com, ahmanson-ranch.com>
- d. Response?: Yes
- e. Principle(s): The record does show legitimate noncommercial use or fair use by Respondents since the purpose of Respondents' website is to serve as a noncommercial platform to criticize the development activities of Complainant. Determinations regarding legitimate noncommercial and fair use under the Policy require a balancing of trademark holder and other public interests. Respondent Save Open Space solicits contributions to a cause as a non-profit organization. This distinguishes its activities from those of the respondent in *Monty and Pat Roberts, Inc.v. J. Bartell*, Case No. D2000-0300...
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Monty and Pat Roberts, Inc.v. J. Bartell*, Case No. D2000-0300; *Bridgestone/Firestone, Inc. v. Jack Myers*, WIPO Case No. D2000-0190
- j. Judicial decisions and statutes cited: None

**2352. NCAA v. Randy Pitkin, et al., Case No. D2000-0903**

- a. Date: March 9, 2001
- b. Panelist(s): Neil Smith, T. Creel, Richard W. Page
- c. Domain Name(s) at Issue: <womensfinalfour.com, finalfourseats.com , final-four-seats.com , final-4-tickets.com, final-four-tickets.net, womensfinalfourtickets.com, sweetsixteentickets.com, sweet-sixteen-tickets.com>
- d. Response?: Yes
- e. Principle(s):

- i. Complainant seeks to add the Supplemental Domain Names to the original Complaint. The filing of this Supplemental Complaint is hereby denied. There is no provision for this in the Policy or Rules and Complainant only filed this after reviewing the Respondents' Response. If new Complaints could be routinely added after a Response, this would potentially disrupt the entire proceedings.
- ii. The majority of the Panel feels that the Respondents' arguments regarding fair use of the Trademarks are correct. Respondents were intentional about the inclusion of the specific words "seats" or "tickets." First, the Respondents wish to guide potential ticket purchasers to these domains so that a potential re-sale of the tickets will be enhanced. Second, the Respondents want to limit the persons visiting their websites to those interested in purchasing tickets. Therefore, not only do the Respondents use the terms "seats" and "tickets" in the Domain Names to enhance this objective, but the websites include disclaimers of affiliation with the Complainant both to satisfy the Complainant's requirements and to exclude persons who are interested in any other aspect of the Complainant or its information.
- iii. The majority agrees that the Complainant owns or is entitled to the Trademarks and agree that in the absence of "fair use," the Domain Names might infringe upon one or more of these marks. However, the Respondents' "fair use" constitutes a complete defense to the Complaint (15 U.S.C. 1115 (b) and (b) (4) (1999). The Complainant fails to address the "fair use" defense, with the exception of the unsupported assertion in Complaint paragraph 18, Sentence 5 which states: "Respondents are able to conduct their business without using NCAA trademarks."
- iv. The majority of the Panel concludes from this analysis of "fair use" that Respondents are asserting that the criteria of paragraph 4(c)(iii) are applicable. Respondents assert that their use of the Domain Names is not misleading because the NCAA is identified as the source of the tickets and any relationship between the NCAA and Respondents is disclaimed.
- v. The majority further agrees with Respondents citation to *Adaptive Molecular Technologies, Inc. v. Priscilla Woodward & Charles R. Thorton, d/b/a Machines & More* WIPO Case No. D2000-0006 (February 28, 2000). Respondents assert they are selling items originated by the Complainant and are using the Complainant's marks to identify the source of the items. The panel in *Adaptive* concluded that this constituted a sufficient basis to conclude that the right to use the name was at least arguably a "fair use" and that any further determination was an issue "... for the courts."
- vi. The majority of the Panel concludes (a) that the Domain Names are confusingly similar to Complainant's registered Trademarks; (b) that Respondents do have rights or legitimate interests in the

Domain Names; and, (c) that Respondents did not register and use the Domain Names in bad faith.

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Nike, Inc. v. Farrukh Zia*, WIPO Case No. D2000-0167; *International Data Group, Inc. v. Maruyama & Co., Ltd.*, WIPO Case No. D2000-0420; *World Wrestling Federation Entertainment Inc (WWFE) v. Rooij*, WIPO Case No. D2000-0290 *Yahoo! Inc. v. Zviely*, WIPO Case No. D2000-0273; *Teradyne, Inc. v. 4Tel Technology*, WIPO Case No. D2000-0026; *EAuto, L.L.C. v. Triple S. Auto Parts*, WIPO Case No. D2000-0047; *Parfums Christian Dior v. I Netpower, Inc.*, WIPO Case No. D2000-0022; *Adaptive Molecular Tech., Inc. v. Priscilla Woodward & Charles R. Thorton, d/b/a Machines & More*, WIPO Case No. D2000-0006; *Adaptive Molecular Technologies, Inc. v. Priscilla Woodward & Charles R. Thorton, d/b/a Machines & More* WIPO Case No. D2000-0006
- j. Judicial decisions and statutes cited: *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054-55 (9th Cir. 1999); *Playboy Enterprises, Inc. v. Terri Welles, Inc.* 78 F. Supp. 2d 1066 (S.D. Cal. 1999); *Kassbaum v. Steppenwolf Productions, Inc.*, 236 F.3d 487; 57 USPQ2d 1300 (9th Cir. Dec. 29, 2000).

**2353. National Collegiate Athletic Association v. Rodd Garner and IntheZone.ws, Case No. D2000-0940**

- a. Date: November 7, 2000
- b. Panelist(s): Frederick M. Abbott
- c. Domain Name(s) at Issue: <ncaalogo.com, ncaalogos.com, ncaabasketballchampion.com, wncaa.com, ncaapick.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Educational Testing Service v. TOEFL*, Case No. D2000-0044; *General Electric Company v. Online Sales.com, Inc.*, Case No. D2000-0343; *General Electric Company v. John Bakhit*, Case No. D2000-0386; *Wal-Mart Stores, Inc. v. Kenneth E. Crews*, Case No. D2000-0580
- j. Judicial decisions and statutes cited: 15 USCS § 1057(b). See, e.g., *Avery Dennison v. Sumpton*, 189 F.3d 868 (9th Cir. 1999); *Sporty's Farm v. Sportsman's Market*, 202 F.3d 489, 498 (2d Cir. 2000), *citing* *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036 (9th Cir. 1999);

**2354. Fairchild Publications Inc. v. Saeid Yomtobian, Case No. D2000-1003**

- a. Date: February 14, 2001
- b. Panelist(s): Dana Haviland, David H. Bernstein, Kevin H. Fortin
- c. Domain Name(s) at Issue: <childrenbusiness.com>

- d. Response?: Yes
- e. Principle(s): The Panel finds that the Respondent's assertion that he registered the Domain Name to establish an internet search directory is not credible and does not comport with the evidence. Respondent has submitted no documentary evidence of any, let alone "demonstrable," preparation to use the Domain Name for the purpose claimed.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Barney's Inc. v. BNY Bulletin Board*, WIPO Case No. D2000-0059, *E.I. du Pont de Nemours and Company v. Avant Garde Composition*, WIPO Case No. D2000-0130; *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles*, WIPO Case No. D2000-1306; *Massachusetts Medical Society v. Michael Karle*, WIPO Case No. D2000-0282; *Cyro Industries v. Contemporary Design*, WIPO Case No. D2000-0386; *Educational Testing Service v. TOEFL*, WIPO Case No. D2000-0044; *Parfums Christian Dior v. QTR Corporation*, WIPO Case No. D2000-0023; *Unibanco v. Vendo Domain Sale*, WIPO Case No. D2000-0671; *Nicole Kidman v. John Zuccarini*, WIPO Case No. D2000-1415
- j. Judicial decisions and statutes cited: None

**2355. Lockheed Martin Corporation v. Dan Parisi, Case No. D2000-1015**

- a. Date: January 26, 2001
- b. Panelist(s): Dennis A Foster, David E Sorkin, David E. Wagoner
- c. Domain Name(s) at Issue: <lockheedsucks.com, lockheedmartinsucks.com>
- d. Response?: Yes
- e. Principle(s): A majority of this Panel agrees with the result reached by the panelist in the *Wallmartcanadasucks.com* case, and disagrees with the opposite view in the previously cited cases. Both common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word "sucks" or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Diageo PLC v. Zuccarini*, WIPO Case No. D2000-0996; *Wal-Mart Stores, Inc. v. MacLeod*, WIPO Case No. D2000-0662; *Cabela's Inc. v. Cupcake Patrol*, NAF Case No. FA95080; *Direct Line Group Ltd. v. Purge I.T.*, WIPO Case No. D2000-0583; *Dixons Group PLC v. Purge I.T.*, WIPO Case No. D2000-0584; *Freeserve PLC v. Purge I.T.*, WIPO Case No. D2000-0585; *National Westminster Bank PLC v. Purge I.T.*, WIPO Case No. D2000-0636; *Standard Chartered PLC v. Purge I.T.*, WIPO Case No. D2000-0681; *Wal-Mart Stores, Inc. v. Walsucks*, WIPO Case No. D2000-0477
- j. Judicial decisions and statutes cited: *Bally Total Fitness v. Faber*, 29 F.

Supp.2d 1161 (C.D. Cal. 1998), *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535, (E.D. Va. 2000)

**2356. American Mensa, Ltd. v. Millennium Energy Niche Studies Associative, Case No. D2000-1030**

- a. Date: January 26, 2001
- b. Panelist(s): Edward C. Chiasson, Sally M. Abel, Luis H. de Larramendi
- c. Domain Name(s) at Issue: <mensa.com>
- d. Response?: No
- e. Principle(s): Prior to January 23, 1999, the Respondent and Mr. Ambrose were not using the subject domain name. The Respondent's full name – Millenium Energy Niche Studies Associative – is alleged by the Complainant to be an attempt to give legitimacy to the use of the word "mensa", which contains all of the first letters of the words in the Respondent's name. The Respondent makes no comment on this. It does not appear to carry on any business activity under its name or to use the subject domain name. When acquired, the subject domain name was under challenge. After its acquisition, the Respondent was prepared to have it put on hold. It has been used as a link to a pornography site, as an advertisement for sale and to link to a site dealing with German restaurants. The latter occurring after this proceeding was initiated. While these may be proper, they do not establish a right or legitimate interest in the subject domain name which is identical to the Complainant's existing rights.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2357. American Mensa, Ltd. v. Access NOW!, Case No. D2000-1031**

- a. Date: January 3, 2001
- b. Panelist(s): Edward C. Chiasson, Sally M. Abel, Frederick M. Abbott
- c. Domain Name(s) at Issue: <mensa.org>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2358. Maruti Udyog Limited v. Subba Raju, Case No. D2000-1036**

- a. Date: January 30, 2001
- b. Panelist(s): Hariram Jayaram, Jeffrey Kaufman, Pravin Anand
- c. Domain Name(s) at Issue: <maruticars.com>
- d. Response?: Yes
- e. Principle(s): The neologisms 'maruticars' and 'maruticar' consist of a

combination of two words put together having an obvious meaning to, at least Indian consumers. The domain names would refer to cars under the brand name MARUTI. The use of "maruticars.com" or "maruticar.com" is bound to create confusion resulting in the Internet users associating the domain names "maruticars.com" and "maruticar.com" with the business of the Complainant and visiting the websites of the Respondent under the mistaken belief that they are websites of the Complainant. The Respondent ought to have known this. The Panel has no alternative but to conclude that there is bad faith in the choice and registration of the domain names "maruticars.com" and "maruticar.com".

- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Telstra Corporation Ltd. v Nuclear Marshmallows*, WIPO Case No. D2000-0003
- j. Judicial decisions and statutes cited: None

**2359. Teranet Land Information Services Inc. v. Verio, Inc., Case No. D2000-1123**

- a. Date: January 25, 2001
- b. Panelist(s): Clive Duncan Thorne, Jacques Leger, Milton L Mueller
- c. Domain Name(s) at Issue: <teranet.com>
- d. Response?: Yes
- e. Principle(s):
  - i. It is material that on 8 August 8, 1998, a US corporation called TerraNet Inc was acquired by Verio Inc. It appears that this acquisition included the assets of TerraNet Inc and that a number of domain names were acquired as part of the assets of TerraNet Inc including the disputed domain name "teranet.com". Details of this are set out in the declaration of MrMr. J R Oldroyd whose affidavit is annexed to the Response. Mr . Oldroyd gives evidence to the fact that TerraNet Inc purchased the domain name in dispute in 1996, from a prior registrant in order that TerraNet Inc might use the domain name to direct emails which were not being received as a result of the misspelling of the domain name with only one letter "r" in the name "TerraNet". TerraNet according to MrMr. Oldroyd's evidence also owned the domain name "terranet.com".
  - ii. The Respondent denies that it has no rights or legitimate interest in respect of the domain name. It refers to the fact that although there is no separate web site being maintained at "www.teranet.com" the domain name has been used since its acquisition by TerraNet Inc and continues to be used by Verio for the redirection of misaddressed to customers with email addresses in the ""terranet.com" domain and asserts that this is a legitimate and good faith use of the domain name. However, the Panel is of the view that the use of a web site merely for the purpose of redirecting visitors to a different site does not per se create an

- absence of legitimate interest.
- iii. In the case at hand, redirection is not misleading to consumers, since the parties are involved in two distinct business undertakings, in two different fields of activity. Furthermore, such redirection leads to verio.com, which is the Respondent's main page: hence it cannot per se tarnish the Complainant's trademark in any way failing or in the absence of proof to the contrary.
- iv. The burden of proof is upon the Complainant to prove that the Respondent has no rights or legitimate interest in respect of the domain name. Given the admission of the Complainant and the explanation by the Respondent that the domain name is used for the purposes of redirection and to avoid lost email and which is supported by the evidence of MrMr. Oldroyd the Panel finds that the Complainant has failed to discharge its burden of proof in respect of this paragraph of the Policy.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Shirmax Retail Ltd/Détailants Shirmax Ltée v. CES Marketing Group Inc.*, AF-0104
- j. Judicial decisions and statutes cited: None

**2360. VeriSign, Inc. v. Michael Brook, Case No. D2000-1139**

- a. Date: March 7, 2001
- b. Panelist(s): Thomas L. Creel
- c. Domain Name(s) at Issue: <vrsn.com>
- d. Response?: Yes
- e. Principle(s):
  - i. United States courts have held that the "confusingly similar" language merely requires a comparison of the domain name itself to the trademark itself (*Northern Light Technology, Inc. v. Northern Lights Club, et al.*, 97 F.Supp. 2d 96,115-118 (D. MA 2000), affirmed 236 F. 3d 57 (1<sup>st</sup> Cir. 2001)). That is, the standard does not require a contextual comparison of the mark versus the domain name as used in commerce, including for example, an analysis of the specific lines of commerce in which in the mark and the domain name are used. To equate "confusingly similar" with "likelihood of confusion" would undermine the goal of the statute of stopping individuals who use domain names that approximate distinctive marks, but who do not actively use the domain names other than to make them available for sale. Applying this standard, the Panel finds there is no confusing similarity between the vrsn domain names and the stylized V trademark.
  - ii. The Panel, however, does find there is confusing similarity between the vrsn domain names and the verisign trademark. While

Complainant has not alleged or shown any trademark rights in vrsn itself, it has asserted that vrsn is the NASDAQ symbol for VeriSign i.e., that vrsn is recognized as another designation for "verisign." Thus, if a person tried to reach the VeriSign website by entering its NASDAQ symbol, it would be sent to Respondent's site. Other panels have found confusing similarity between abbreviations of the trademark used as domain names and the trademark itself.

- f. Result: Name transfer
- g. Policy cited: 3(b), 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: Successful Money Management Seminars, Inc. vs. Financial Services of California, Claim No. FA 0006000095042, *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270; *SADD, Inc. v. Steven Weber, et al.*, WIPO Case No. D2000-0170; *Stella D'oro Biscuit Co., Inc. v. The Patron Group Inc.*, WIPO Case No. D2000-0012; *Time Inc. v. Chip Cooper*, WIPO Case No. D2000-1342; *CBS Broadcasting Inc. v. Bert Grovers*, Case No. D2000-0254; *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0003; *August Storck KG v. Mohamed*, ICANN Case No. D2000-0196
- j. Judicial decisions and statutes cited: *Northern Light Technology, Inc. v. Northern Lights Club, et al.*, 97 F.Supp. 2d 96,115-118 (D. MA 2000), affirmed 236 F. 3d 57 (1<sup>st</sup> Cir. 2001)).

**2361. Giddings & Lewis LLC v. Neal McKean d/b/a Machineworks, Inc. d/b/a IMachineTools.com, Case No. D2000-1150**

- a. Date: March 14, 2001
- b. Panelist(s): Natasha C. Lisman, James Dabney, Jordan Weinstein
- c. Domain Name(s) at Issue: < "usedfadal.net", "usedfadal.com", "used-fadal.com", "fadal-used.com", "usedfadalcnc.com", "usedfadals.net", "usedfadals.com", "used-fadals.net", "used-fadals.com", "fadalsused.com", "fadalused.com". >
- d. Response?: Yes
- e. Principle(s): "...as the Complainant forthrightly acknowledges, "used Fadal machine tools" or the colloquial equivalent, "used Fadals," accurately describe the line of products, which the Respondent has long been selling in a legitimate manner. Therefore, combining "used" and "Fadal" in a domain name is a fair, nominative use to describe the products that the registrant offers in its "brick and mortar" and e-commerce business ventures."
- f. Result: For the reasons stated above, it is ordered that the domain name "fadals.com" be transferred to the Complainant, Giddings & Lewis, L.L.C. With respect to the remaining contested domain names, "usedfadal.net", "usedfadal.com", "used-fadal.com", "fadal-used.com", "usedfadalcnc.com", "usedfadals.net", "usedfadals.com", "used-fadals.net", "used-fadals.com", "fadalsused.com", and "fadalused.com", the Complainant's request for transfer is DENIED.

- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *The Kittinger Company Inc. v. Kittinger Collector*, Case Nos. AF-0107a and AD-0107b; *Consorzio del Prosciutto di Parma v. Domain Name Clearing Company, LLC*, Case No. D2000-0629
- j. Judicial decisions and statutes cited: None

**2362. AltaVista Company v. O.F.E.Z. et al., Case No. D2000-1160**

- a. Date: February 28, 2001
- b. Panelist(s): Jonathan Hudis
- c. Domain Name(s) at Issue: <allavista.com>, <altavists.com>, <altaavista.com>, <altaviesta.com>, <altavasta.com>, <aitavista.com>, <altavisra.com>, <altavisto.com>, <laltavista.com>, <altavsita.com>, and <altavistacom.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Yahoo! Inc. v. Eitan Zviely, et al.*, Case No. D2000-0273; *AltaVista Company v. Grandtotal Finances Limited et al.*, Case No. D2000-0848; *AltaVista Company v. Jean-Daniel Gamache*, Case No.; *AltaVista Company v. Astavista.com*, Case No. 95251; *Reuters Limited v. Global Net 2000, Inc.*, Case No. D2000-0441; *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, Case No. D2000-0330 *Microsoft Corporation v. Microsof.com a/k/a Tarek Ahmed*, Case No. D2000-0548; *America Online, Inc. v. Tencent Communications Corp.*, Case No. 93668; *Bennett Coleman & Co. Ltd v. Steven S. Lalwani*, Case No. D2000-0014; *Nokia Corporation v. Nokiagirls.com a.k.a. IBCC*, Case No. D2000-0102; *Barney's Inc. v. BNY Bulletin Board*, Case No. D2000-0059; *Samsonite Corporation v. Colony Holding*, Case No. 94313; *Yahoo!, supra, and CeoCities v. Data Art Corp. et al.*, Case No. D2000-0587; *Quixtar Investments, Inc. v. Scott A. Smithberger and QUIXTAR-IBO*, Case No. D2000-0138; *3636275 Canada, d/b/a eResolution v. eResolution.com*, Case No. D2000-0110
- j. Judicial decisions and statutes cited: None

**2363. International Raelian Religion and Raelian Religion of France v. Mailbank.com Inc., Case No. D2000-1210**

- a. Date: April 4, 2001
- b. Panelist(s): David H. Bernstein, Frederick Abbott, David Maher
- c. Domain Name(s) at Issue: <rael.com>
- d. Response?: Yes
- e. Principle(s):
  - i. Respondent has provided evidence that it is in the business of registering common surnames for use with vanity email addresses and that "Rael" is one such surname. There is evidence that many

different people use the name "Rael" and therefore may have an interest in using "rael.com" as a vanity address. Complainants have not shown that "Rael" is so singularly associated with Complainants and their religion that use of the surname alone is likely to confuse Internet users.

- ii. The Panel specifically declines to rely on the fact that Complainant owns a number of other "rael.TLD" registrations as evidence of Respondent's legitimate use of "rael.com." A use is not legitimate merely because alternatives remain for a mark holder and, in other circumstances, the fact that a mark owner defensively uses another TLD should not insulate a cybersquatter from losing a .com domain name.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Buhl Optical Co. v. Mailbank.com, Inc.*, Case No. D2000-1277; *Pet Warehouse v. Pets.com, Inc.*, Case No. D2000-0105; *Experience Hendrix, L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club*, Case No. D2000-0364
- j. Judicial decisions and statutes cited: *Avery Dennison v. Sumpton*, 189 F.3d 868 (9<sup>th</sup> Circular 1999)

**2364. Christiana Bank & Trust Company v. John David Lake and Lori Lake d/b/a World Think Tank, Case No. D2000-1212**

- a. Date: January 22, 2001
- b. Panelist(s): R. Eric Gaum
- c. Domain Name(s) at Issue: <christianabank.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Motorola, Inc. v. NewGate Internet, Inc.*, WIPO D2000-0079. *Gateway, Inc. v. Pixelera.com, Inc.*, WIPO D2000-0109
- j. Judicial decisions and statutes cited: None

**2365. Nintendo of America, Inc. v. Gray West International, Case No. D2000-1219**

- a. Date: January 10, 2001
- b. Panelist(s): Richard W. Page
- c. Domain Name(s) at Issue: <pokemon-games.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Wal-Mart Stores, Inc. v. Walsucks & Walmarket*

*Puerto Rico*, No. D2000-0477; *Parfums Christian Dior v. I Netpower, Inc.*, No. D2000-0022; *Chernow Communs., Inc. v. Kimball*, No. D2000-0119; *Channel Tunnel Group Ltd. v. John Powell*, No. D2000-0038; *Expedia, Inc. v. European Travel Network*, D2000-0137 (WIPO April 18, 2000); *Document Technologies v. International Electronic Communications, Inc.*, D2000-0270; *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *Cellular One Group v. Paul Brien*, D2000-0028

j. Judicial decisions and statutes cited: *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000); *Brookfield Communs, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054-55 (9th Cir. 1999) *Bigstar Entertainment, Inc. v. Next Big Star, Inc.*, 54 U.S.P.Q.2d 1685 (BNA) (2000)

**2366. Viacom International, Inc., Paramount Pictures Corporation, and Blockbuster Inc. v. TVdot.net, Inc. f/k/a Affinity Multimedia, Case No. D2000-1253**

- a. Date: January 16, 2001
- b. Panelist(s): R. Eric Gaum, Carol Anne Been, Richard Hill
- c. Domain Name(s) at Issue: <viacomtv.net>, <paramounttv.net>, <vh1tv.net>, <nickkidstv.net>, <bluescluestv.net>, <blockbustertv.net>
- d. Response?: Yes
- e. Principle(s): "...the respondent's plans are to use domain names which incorporate the complainant's trademarks in a business (online TV) which is substantially similar to the complainant's business. Such use would undoubtedly create customer confusion."
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999), *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 53 USPQ 2D (BNA) 1570 (2000), *Polaroid Corp. v. Polarad Electronics Corp.*, 287F.2d 492 (2d Cir.) cert. Denied, 368 US 820 (1961)

**2367. Eveready Battery Company Inc v. Michael Behrens, Case No. D2000-1261**

- a. Date: December 8, 2000
- b. Panelist(s): Dawn Osborne
- c. Domain Name(s) at Issue: <energizerbunny.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2368. Buhl Optical Co. v. Mailbank.com, Inc., Case No. D2000-1277**

- a. Date: March 1, 2001
- b. Panelist(s): M. Scott Donahey, David H. Bernstein, Jeffrey M. Samuels
- c. Domain Name(s) at Issue: <buhl.com>
- d. Response?: Yes
- e. Principle(s): Because "Buhl" is a *bona fide* surname, the Panel finds that Respondent is not using the SLD in its trademark sense, but rather is using the SLD in a legitimate business enterprise. Therefore, assuming that registration of an SLD that corresponds to a mark in the ".com" gTLD does not have independent significance, the Panel would find that the Respondent has rights and legitimate interests in respect of the domain name at issue.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Steven H. Schimpff v. Jerry Sumpton*, ICANN Case No. FA94333; *Bosco Products, Inc. v. Bosco E-Mail Service and Mailbank.com*, ICANN Case No. FA94828; *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc. and Bridgestone Corporation v. Jack Myers*, ICANN Case No. D2000-0190; *Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club*, ICANN Case No. D2000-1532; *Allocation Network GmbH v. Steve Gregory*, ICANN Case No. D2000-0016; *Car toys, Inc. v. Informa Unlimited, Inc.*, ICANN Case No. FA93682; *Etam, plc v. Alberta Hot Rods*, ICANN Case No. D200-1654
- j. Judicial decisions and statutes cited: *Avery Dennison Corp., v. Sumpton, et al.*, 189 F. 3d 868 (9<sup>th</sup> Cir. 1999)

**2369. Cimpor-Cimentos de Portugal, SGS, S.A. v. Contemporary Engineering, Case No. D2000-1281**

- a. Date: January 31, 2001
- b. Panelist(s): Peter Dirk Siemsen
- c. Domain Name(s) at Issue: <cimpor.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2370. Firstgate Internet A.G. .v. David Soung, Case No. D2000-1311**

- a. Date: January 29, 2001
- b. Panelist(s): David Perkins, Peter Chrocziel, Thomas L. Creel
- c. Domain Name(s) at Issue: <firstgate.com>
- d. Response?: Yes
- e. Principle(s): In the Panel's view, there is nothing in the evidence to indicate registration in bad faith. Given the chronology of events it is not credible that the Respondent knew of the incorporation and activities of nascent

Complainant company in Germany some 2½ months before the registration of the domain name in issue. The Complainant has offered no evidence of an international, let alone national, press / media campaign surrounding the incorporation of the Complainant in mid December 1999. (There may, also, be some doubt as to whether the Complainant began trading at a later date in April 2000).

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Geniebooks.com Corp. v. William E. Merritt*, Case No D 2000-0266
- j. Judicial decisions and statutes cited: None

**2371. La Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Thomas Proud, Case No. D2000-1316**

- a. Date: March 12, 2001
- b. Panelist(s): Benoit Van Asbroeck
- c. Domain Name(s) at Issue: <casinodemonaco.com>
- d. Response?: Yes
- e. Principle(s): Notwithstanding that Monte Carlo and Monaco are not synonymous, it cannot be reasonably challenged that the two geographical locations are commonly, albeit wrongly, used to describe the same area. In other words, the distinction between "Monaco" and "Monte Carlo" does not appear to be determining, since Monte Carlo is commonly associated with the State of Monaco. Thus, the Administrative Panel finds that the domain name <casinodemonaco.com> is confusingly similar to Complainant's trademark.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2372. Time Inc. v. Chip Cooper, Case No. D2000-1342**

- a. Date: February 13, 2001
- b. Panelist(s): M. Scott Donahey, David H. Tatham, Diane Cabell
- c. Domain Name(s) at Issue: <lifemagazine.com, lifemagazine.net, lifemagazine.org>
- d. Response?: No
- e. Principle(s): Why was it necessary to register the Complainant's mark in all three generally available gTLDs in order to accomplish any of the aims Respondent professed to have? The majority believes that it was not necessary.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Document Technologies, Inc. v. International Electronic Communications, Inc.*, ICANN Case No. D2000-0270; *Inter-*

*Continental Hotel Corporation v. Khaled Ali Soussi*, ICANN Case No. D2000-0252. "Concrete evidence" is more than mere assertions. "Concrete evidence" is documents or sworn declarations or affidavits. *Do The Hustle, LLC v. Tropic Web*, ICANN Case No. D2000-0264; *The Hamlet Group, Inc. v. James Lansford*, ICANN Case No. D2000-0073. Neither is the knowing adoption of the well-known trademark of another. *Guerlain, Inc. v. Peikang*, ICANN Case No. D2000-0055. *Kittinger Company, Inc. v. The Kittinger Collector*, ICANN Case No. AF-107. *The Kittinger Company, Inc v. James Fisgus*, ICANN Case No. AF-108;

j. Judicial decisions and statutes cited: None

**2373. Sun International Resorts, Inc. v. Adrian Najar, Case No. D2000-1349**

- a. Date: February 13, 2001
- b. Panelist(s): Jordan S. Weinstein
- c. Domain Name(s) at Issue: <solkerzner.org, solkerzner.ws, solkerzner.net>
- d. Response?: Yes
- e. Principle(s):
  - i. Complainant asserts that Mr. Kerzner has used his name in connection with motivational speeches. Such use certainly could be akin to trademark or service mark use. Yet Complainant has presented absolutely no evidence that the name "Sol Kerzner" or "Solomon Kerzner" has been used in this fashion.
  - ii. The most telling evidence that Complainant has not proven rights to the personal name "Sol Kerzner" is the fact that, as Complainant asserts, Respondent's offer to sell the domain names was addressed not to Complainant, but to Mr. Kerzner, at a company apparently related, but not identical to Complainant. Absent some other evidence to the contrary, this Panel cannot grant relief to a Complainant who has not proven rights in the domain name at issue.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *World Wrestling Federation Entertainment, Inc. v. Michael Bossman*, Dispute No. D99-0001; *Robert Ellenbogen v. Mike Pearson*, Dispute No. D00-0001
- j. Judicial decisions and statutes cited: None

**2374. Credit Suisse Group v. Milanes-Espinach, Fernando and Milanes-Espinach, SA, Case No. D2000-1376**

- a. Date: March 20, 2001
- b. Panelist(s): James Bridgeman
- c. Domain Name(s) at Issue: <creditswiss.net>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer

- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Creo Products Inc. v. Website In Development*, Case No. D2000-1490; *Intocast AG v. Lee Daeyoon*. WIPO Case No. D2000-1467; *Rádio Globo S.A. v. The Paradigm Corporation* WIPO Case No. D2000-1704; *Mondich v. Brown*, WIPO Case No. D2000-0004; *Alcoholics Anonymous World Services, Inc., v. Lauren Raymond*, WIPO Case No. D2000-0007; *Yahoo! Inc. v. Eitan Zviely, et al.* WIPO Case No. D2000-0273; *Cyro Industries v. Contemporary Design* WIPO Case No. D2000-0336, *Edgar Rice Burroughs, Inc. v. Adtel Communications*, WIPO Case No. D2000-0115; *Arthur Guinness Son & Co. (Dublin) Limited v. Executive Products Ltd.*, WIPO Case No. D2000-1785
- j. Judicial decisions and statutes cited: None

**2375. Haymarket Business Publications Limited v. Shots, Case No. D2000-1387**

- a. Date: January 2, 2001
- b. Panelist(s): Tony Willoughby
- c. Domain Name(s) at Issue: <campaignscreen.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2376. Société du Figaro v. Tropic Telecom, Case No. D2000-1389**

- a. Date: December 22, 2000
- b. Panelist(s): Thomas H. Webster
- c. Domain Name(s) at Issue: <figaromagazine.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Chanel, Inc. v. Estco Technology Group*, Case No. D2000-0413; *Marriott International, Inc. Thomas, Burstein and Millar*, Case No. 2000-0610; *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, Case No. 2000-0834; *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, Case No. 2000-0226; *GA Modefine SA v. Armani International Investment*, Case No. D2000-0305, *GA Modefine SA v. AES Optics*, Case No. Case No. D2000-306
- j. Judicial decisions and statutes cited: None

**2377. Alloy Rods Global, Inc. v. Nancy Williams, Case No. D2000-1392**

- a. Date: January 31, 2001
- b. Panelist(s): Frederick M. Abbott, Richard W. Page, David G. Post
- c. Domain Name(s) at Issue: <alloyrods.com>

- d. Response?: Yes
- e. Principle(s): The Panel accepts that registration on the Principal Register constitutes constructive notice of ownership of a mark under U.S. trademark law, and generally negates a junior user's defense of good faith adoption of a mark. However, the Panel is reluctant to construe paragraph 4(c)(i) of the Policy in a way that equates trademark registration with notice of a dispute since to do so would largely eliminate the defense of *bona fide* use before notice. Respondent received a cease and desist and transfer demand from Complainant on August 9, 2000 and had notice of a dispute from at least that date.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: *Avery Dennison v. Sumpton*, 189 F.3d 868 (9<sup>th</sup> Cir. 1999); *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036, 1055 (9<sup>th</sup> Cir. 1999); *Sporty's Farm v. Sportsman's Market*, 202 F.3d 489, 498, (2d Cir. 2000)

**2378. Vetrotex France v. Domain Name Clearing Company LLC,  
Case No. D2000-1396**

- a. Date: February 22, 2001
- b. Panelist(s): Geert Glas
- c. Domain Name(s) at Issue: <vetrotex.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2379. IG Index Plc v. Fruit Group Inc., Case No. D2000-1413**

- a. Date: March 17, 2001
- b. Panelist(s): Cecil O.D. Branson
- c. Domain Name(s) at Issue: <igindex.org>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Vertical Computer Systems Inc. v. Registrant of "Pointmail.com"* (D2001-0006); *CellControl Biomedical Laboratories GmbH v. Mike Flowers* (D2000-1257); *Jeanette Winterson v. Mark Hogarth*, (D2000-0235); *Julia Fiona Roberts v. Russell Boyd* (D2000-0210). ; *Hewlett-Packard Co. v. Full System* (FA 0094637); *David G. Cook v. This Domain is For Sale* (FA 0094957); *Gorstew Jamaica and Unique Vacations Inc. v. Travel Concierge* (FA

0094925); *America Online Inc. v. Anson Chan* (D2001-0004); *Reuters Limited v. Global Net 2000 Inc.* (D2000-0441); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and 'Madonna.com'* (D2000-0847), and *America Online Inc. v. Anson Chan* (D2001-0004).

j. Judicial decisions and statutes cited: None

**2380. GA Modefine S.A. v. Mark O'Flynn, Case No. D2000-1424**

- a. Date: February 27, 2001
- b. Panelist(s): Geert Glas
- c. Domain Name(s) at Issue: <armaniboutique.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2381. Telefonica de Argentina S.A., v. Rancho Grande Ltd., Ernesto Serigos, Case No. D2000-1443**

- a. Date: January 24, 2001
- b. Panelist(s): Pedro W. Buchanan
- c. Domain Name(s) at Issue: <paginasdoradas.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: 14, 15, 17
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2382. Aço Minas Gerais S.A. Açominas v. José Dutra, Case No. D2000-1458**

- a. Date: March 5, 2001
- b. Panelist(s): Manoel J. Pereira dos Santos
- c. Domain Name(s) at Issue: <acominas.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Etam, plc v. Alberta Hot Rods, WIPO Case No. D2000-1654*; *America Online, Inc. v. Frank Albanese, WIPO Case No. D2000-1604*; *Etam, plc. v. Alberta Hot Rods, WIPO Case No. D2000-1654* and *Magnum Piering, Inc. v. Mudjackers, WIPO Case No. D2000-1525*; *Avnet, Inc v. Aviation Network, Inc. (WIPO Case No. D2000-0046)* *Telaxis Communications Corp. v. William E. Minkle (WIPO Case No. D2000-0005)*; *Allocation Network GmbH*

*v. Gregory (WIPO Case No. D2000-0016); TV Globo Ltda. v. Radio Morena (WIPO Case No. D2000-0245)*

j. Judicial decisions and statutes cited: None

**2383. Office Club, Ltd. v. John Adem, Case No. D2000-1480**

- a. Date: March 6, 2001
- b. Panelist(s): D.J. Ryan
- c. Domain Name(s) at Issue: <officeclub.com>
- d. Response?: Yes
- e. Principle(s):
  - i. First of all, Complainant has not produced any evidence to support its assertion that the domain name was for sale. The fact that the domain name is associated with the server of a site that offers domain names for sale does not establish this. Complainant has produced evidence that other domain names at the MindRush site are for sale, but has not produced such evidence in respect of the domain name <officeclub.com>. Complainant was given the opportunity to produce further evidence in support of its assertion, but failed to do so. Respondent has asserted, but not supported by evidence, that the domain name was registered with intent that it be used in association with its apartment management business. Secondly, it is well established that mere offering of a domain name for sale is neither illegal nor contrary to the Policy
  - ii. Complainant's submission is that paragraph 4(a)(iii) is satisfied because Respondent sought to sell the domain name for more than his out-of-pocket expenses. As shown above, Complainant has produced no evidence to support the allegation of attempted sale and even if it had, it would not have satisfied the requirement of paragraph 4(a)(iii). Complainant appears to rely on the circumstances set out in paragraph 4(b)(i) of the Policy. That paragraph requires a showing that the domain name was registered primarily for the purpose of sale or other transfer to the Complainant or to a competitor of the Complainant. There is no evidence to support this, nor is there evidence to support a finding of bad faith on any other basis. Evidence of communications between Complainant and Respondent and of the nature of these communications might have been of assistance in resolving the conflicting assertions on this issue, but no such evidence was before the Panel.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *World Wrestling Federation Case* – WIPO Case No. D99-0001; *Foreign and Colonial Case* – WIPO Case No. D2000-1383; *John Swire & Sons Ltd v. David Huang* – WIPO Case No. D2000-1106; *J. Crew International, Inc. v. crew.com* – WIPO Case No. D2000-0054; *Meteor Mobile*

*Communications v. Frank Dittmar* – WIPO Case No. D2000-0524; and, *John Fairfax Publications Pty Ltd v. Domain Names 4U and Fred Gray* – WIPO Case No. D2000-1403;

j. Judicial decisions and statutes cited: None

**2384. Online Motorsport Ltd v SuperSite. Net, Inc, Case No. D2000-1494**

a. Date: March 14, 2001

b. Panelist(s): D.J. Ryan

c. Domain Name(s) at Issue: <onlinemotorsport.com, onlinemotorsport.net>

d. Response?: No

e. Principle(s):

i. Complainant has failed, notwithstanding the further opportunity afforded to it by the Panel, to produce any evidence of use of "onlinemotorsport" as a trade mark. The fact that that expression appears in its corporate name does not, without more, constitute evidence of use as a trade mark. Furthermore, in view of the fact that the alleged trade mark is aptly descriptive of the field in which Complainant operates and the goods and services which it supplies substantial evidence of use and the establishment of the reputation and secondary meaning is required before trade mark rights can be established. Clearly Complainant has failed to do this.

ii. It is not for the Panel to determine whether or not a legally binding agreement has been reached or to assist Complainant in giving effect to any such agreement. It is further to be noted that in this case, if Respondent is in fact in liquidation, then presumably any rights or interests which Respondent possessed in the domain names now vest with the liquidator for the benefit of the creditors.

f. Result: Decision for Respondent

g. Policy cited: 4(a)(i)-(iii)

h. Uniform Rules cited: None

i. Panel Decisions cited: *Rapido TV Ltd v. Jan Duffy-King* (Case D2000-0449), *Gordon Sumner p/k/a Sting v. Michael Urvan* (Case D2000-096); *Document Technologies Inc., v International Electronic Communications, Inc.* (Case D2000-0270).

j. Judicial decisions and statutes cited: None

**2385. Telstra Corporation Limited v. Peter Lombardo, Marino Sussich and Ray Landers, Case No. D2000-1511**

a. Date: March 23, 2001

b. Panelist(s): Clive Elliott

c. Domain Name(s) at Issue: <telstrafreeonline.com, telstrafree>

d. Response?: No

e. Principle(s): The question arises whether the alleged current registrant, telstrafreeonline.com should be a party to the proceeding and/or whether it has a right or legitimate in respect of the Domain Names. The Registrar confirmed that

it is not, the registrant. But, the panelist considers the alternative position alleged by the Respondents and makes certain assumptions solely for purposes of the argument. It was possible, through a tortuous path of errors, corrections and transfers, to trace the Domain Names from a company in which the first respondent had an interest, to the current registrant. It is clear that complainant has had some difficulty in tracing the correct parties to this dispute and errors in the registration details have not assisted. Whether these errors were inadvertent or deliberate cannot be resolved on the evidence as it stands. However, the question arises whether an entity, whatever it is, is entitled to take transfer of the Domain Names from the current respondents and claim to have a legitimate interest in the Domain Names because it is a separate entity (at least to some extent). In the panelist's view while it does not need to resolve this issue in this case, a complainant with a valid claim against a respondent should not be denied relief solely because the respondent transferred the domain name to another entity, subsequent to the filing of a complaint by the trademark holder.

- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Quixstart Investments Inc. v Dennis Hoffman*, WIPO D2000-0253; *Cherno Communications Inc. v Jonathan Dennis Kimball*, WIPO D2000-0119; *Telstra Corporation Limited v Barry Cheng Kwok Chu*, WIPO D2000-0423
- j. Judicial decisions and statutes cited: None

**2386. DIMC, Inc. & The Sherwin-Williams Company v. Quang Phan, Case No. D2000-1519**

- a. Date: February 20, 2001
- b. Panelist(s): Natasha C. Lisman
- c. Domain Name(s) at Issue: <krylon.net>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 5
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2387. CGNU PLC v. commercialunion, Case No. D2000-1529**

- a. Date: April 2, 2001
- b. Panelist(s): Christophe Imhoos
- c. Domain Name(s) at Issue: <commercialunion.net>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: None

- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2388. Anti Flirt S.A. and Mr. Jaques Amsellem v. WCVC, Case No. D2000-1553**

- a. Date: February 28, 2001
- b. Panelist(s): Angelica Lodigiani
- c. Domain Name(s) at Issue: <antiflirt.net>
- d. Response?: No
- e. Principle(s):
  - i. the Panel cannot ignore that the evidence submitted to prove Respondent's bad faith is insufficient to ascertain the presence of Respondent's bad faith in the registration and use of the Domain Name, even taking into account Respondent's default. In particular, the only evidence supported by documents in the Complaint is: (1) the fact that Anti-Flirt is a French company incorporated in 1981, and operating in the field of the manufacture and sale of ready-to-wear and clothing in general; (2) the fact that Complainants own the ANTI-FLIRT trademark in 27 countries including the United States where - according to the relevant certificate of registration - the use in commerce started in 1987, and (3) the fact that the ANTI-FLIRT trademark is used to identify clothing apparels in the Paris-Summer 2000 catalogue. The Panel finds that such evidence does not confirm Complainants' allegations that both the trademark and the company name ANTI-FLIRT are well known all over the world. From the foregoing circumstances, the Panel may only draw the inference that use must have been made of the ANTI-FLIRT mark since *no one would lightheartedly undertake the cost and effort of registering a trademark in so many countries unless such registrations are instrumental for the protection of good will and investments related to such trademark*"
  - ii. However, while such use might have been held a sufficient evidence that the ANTI-FLIRT mark and company name perhaps are well known in their country of origin (France), the same conclusion cannot be reached as to the international renown of the mark and company name, which is necessary in the case of the Domain Name at issue which was registered by an entity residing in Arizona, United States. Therefore, in the Panel's view, Complainants failed to provide a *prima facie* evidence that the ANTI-FLIRT trademark and company name are well known in the United States and particularly in Arizona where the Respondent is located. Although the Panel may be satisfied that the ANTI-FLIRT mark is used in the United States, in the absence of any further specification as to the extent of such use, penetration in the market, amount of advertising, and any other relevant information, the Panel cannot infer that said mark is well known in this country, and in Arizona in particular and thus it cannot be inferred that

Respondent registered "antiflirt.net" being aware of Complainants' earlier trademark rights. Accordingly, the Panel cannot reach the reasonable conclusion that Respondent registered the disputed Domain Name in bad faith.

- iii. Furthermore, Complainants allege that Respondent certainly aimed at selling, renting or otherwise transferring the Domain Name for a valuable consideration in excess of the costs directly related to the Domain Name. The Panel did not find in the Complaint any support for this statement. Complainants have not proved that Respondent was aware of the Complainants' mark prior to acquisition of the Domain Name. From the summary of the facts included in the Complaint, it does not appear that Complainants challenged the Respondent's Domain Name registration and use before the filing of the Complaint. Accordingly, there is no evidence that had the Respondent been requested to do so, it would have claimed a valuable consideration to transfer or cancel the Domain Name at issue.

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 3(b), 14(b), 15
- i. Panel Decisions cited: *Club Méditerranée v. Yosi Hasidim*, WIPO Case No. D2000-1350; *Gateway, Inc. v. Pixelera.com, Inc.*, WIPO Case No. D2000-0109 *Ticketmaster Corporation v. Dimitri Prem*, WIPO Case No. D2000-1550; *Intocast AG v. Lee Daeyoon*, WIPO Case No. D 2000-1467; *Cellular One Group v. COI Cellular One, Inc.*, WIPO Case No. D 2000-1521; *Ermenegildo Zegna Corporation, Lanificio Ermenegildo Zegna & Figli S.p.A., Consitex S.A. v. Steven Shiekman*, WIPO Case No. D2000-1375
- j. Judicial decisions and statutes cited: None

**2389. Hola S.A. v. Ajax Private Holdings Inc. and Worldwide Journey Inc.,  
Case No. D2000-1555**

- a. Date: March 21, 2001
- b. Panelist(s): Thomas H. Webster, Isabelle Leroux, Jonas Gulliksson
- c. Domain Name(s) at Issue: <ohla.com>
- d. Response?: No
- e. Principle(s):
  - i. Based on the facts as outlined above, it appears that the First Respondent registered and used the domain name in question to attract consumers so that they will access the web site operated by the First Respondent. That site in turn was a hypertext link to what appear to be a pornographic site. Therefore, it appears clear to the Panel that the First Respondent has sought to increase the number of "hits" to its site by using the trademark "OH LA!" as a domain name. That increases the commercial value of the First Respondent's site, but at the expense of misuse by the First Respondent of the trademark in which the Complainant hold

rights. That is evidence of bad faith within the meaning of Paragraph 4(b)(iv) of the Policy.

- ii. The First Respondent appears to have transferred the domain name in dispute to the Second Respondent in October 2000. That was after the dispute between the parties had arisen with respect to the domain name but before these administrative proceedings were commenced. Such transfer does not affect the fact that the domain name was registered in bad faith by the First Respondent, but it requires us to examine the use of the domain name since that date to determine whether the domain name "is being used in bad faith" by the Second Respondent.
- iii. If that use had continued, in the absence of an explanation by the Respondents it would be taken as an attempt to attract Internet users to the Second Respondent's sites and to other on-line locations for commercial gain by "creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement" of the web sites. This constitutes evidence of bad faith under paragraph 4(b)(iv) of the Policy.

- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, Case No. 2000-0834; *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0003
- j. Judicial decisions and statutes cited: None

**2390. Rádio Globo S.A. v. Rádio Morena, Case No. D2000-1558**

- a. Date: March 22, 2001
- b. Panelist(s): Pedro W. Buchanan
- c. Domain Name(s) at Issue: <globofm.com>
- d. Response?: Yes
- e. Principle(s): This Panel considers that even if a trademark is not yet approved by the authorities and the relevant certificate is not yet granted, this does not mean that such a trademark does not exist, with substantial goodwill generated on someone's businesses, with name and brand recognition, and with certain expectation rights that may become reality as soon as the authority grants such recognition and validates such prior use as constitutive of the right to such trademark.
- f. Result: Name transfer
- g. Policy cited: 3(c), 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 14, 15, 17
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2391. Programma Electric AB v. Daniel Yomtov, Case No. D2000-1570**

- a. Date: February 14, 2001
- b. Panelist(s): Clive Elliott
- c. Domain Name(s) at Issue: <programma.com, programma.net, programma.org>
- d. Response?: Yes
- e. Principle(s):
  - i. It is clear that the Complainant has certain rights in the Programma trade mark. However, while the Complainant trades internationally, it has only secured registration in three countries and all in relation to a combined device and word mark. There is some merit in the Respondent's contention that the Complainant's trade mark rights should be narrowly construed. That is, on the basis that Programma has a meaning in various languages and is akin to the English word program, as in computer program. In this dispute, the Respondent has raised a reasoned and spirited defence. Its submission is that the complaint is without foundation and that the areas of activities of the parties are quite separate, and if any reputation exists in relation to the Complainant's activities, it should be restricted to a narrow and specialised niche of high voltage electric equipment and apparatus.
  - ii. Whilst the Complainant may succeed in establishing that the Domain Names and its Programma trade mark are identical, it also needs to be shown that such identity is in relation to a trade mark in which the Complainant has rights. This raises the question as to where such rights must subsist. While arguably the Complainant is able to show it has an international reputation, it has made little effort to allege and substantiate a particular reputation in Israel. This issue has a bearing on the question of bad faith, particularly as the Respondent resides in Israel and his state of mind must be judged, at least in part, against a background of whether such reputation exists in Israel, as well as internationally.
  - iii. When asking whether the Respondent has any rights or legitimate interests in the Domain Names, it needs to be borne in mind that while the Complainant has certain rights in the Programma trade mark and has likewise registered certain Domain Names with that element, so have other parties in other countries. The Complainant can certainly claim to have no exclusive right to the Programma word, particularly in areas outside its narrow business activities.
  - iv. It is common ground that the <programma.net> and <programma.org> domain names were registered after the parties were in communication and according to the Respondent such registration was "justified to protect Respondent's rights in <programma.com>." It is unclear as to why the Respondent felt justified in registering these two additional domain names in order to protect its so-called rights. The Respondent has indicated that there was nothing untoward about his communications with the

Complainant. However, it may also be reasonable to infer from the statement "How much are you willing to pay for the domain name?" an intention or willingness to sell the domain name for the right price.

- f. Result: The Complainant's claim is dismissed in relation to <programma.com>, but upheld in relation to <programma.net> and <programma.org>. Accordingly, the former domain name should remain with the Respondent, while the latter two Domain Names should be transferred to the Complainant.
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2392. The Mills Limited Partnership v. Michael G. Miller, Case No. D2000-1577**

- a. Date: March 8, 2001
- b. Panelist(s): David W. Plant
- c. Domain Name(s) at Issue: <arundelmills.com, arunde-mills.com, arundenmillsblvd.com>
- d. Response?: Yes
- e. Principle(s): As the Panel has already stated, regardless of one's view of the implications of Miller's actual use or non-use of the three websites, the record here supports the inference that Miller has not registered the domain names for the purpose of attracting Internet users to his web sites by creating a likelihood of confusion with Mills's ARUNDEL MILLS service mark. Although such confusion may arise in the future, there simply was no ARUNDEL MILLS service mark at the time of Miller's registrations. Miller argues, correctly, that Mills's service mark rights are limited in terms of time and of subject matter. Both limitation are relevant to the issue of bad faith registration and bad faith use now under consideration. Mills has had no rights in the mark until November 17, 2000. Presumably, if Mills's February 1999 application matures into a registration, Mills will have constructive use rights going back to February 1999. But that date is not yet available to Mills. Thus, Miller's registrations of his domain names at a time when Mills enjoyed no trademark or service mark rights in ARUNDEL MILLS cannot be regarded as bad faith registrations. In light of the foregoing, the Panel finds that Miller did not register *and* use in bad faith each of the domain names in issue.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Potomac Mills Limited Partnership v. Gambit Capital Management*, WIPO Case D2000-0062, *General Electric v. John Bakhit*, WIPO Case D2000-0386, *Cisco Systems v. Mike Haag*, Case Nos. AF-0585a, AF 0585b;
- j. Judicial decisions and statutes cited: None

**2393. Briggs & Stratton, Corporation v. Suresource, Case No. D2000-1582**

- a. Date: March 29, 2001
- b. Panelist(s): William Lowrey MATHIS
- c. Domain Name(s) at Issue: <briggsandstratton-store.com>
- d. Response?: No
- e. Principle(s): The Complaint does not explain why registration of a domain name that is known to be similar to a famous mark is proof of bad faith registration and use. Such knowledge might be pertinent in some contexts, but the present Complaint does not include particular proofs that might make knowledge of the famous character of Complainant's mark a significant factor. Similarly, the Complaint fails to explain why an intention on Respondent's part to link the disputed domain name to Respondent's web site "at some time in the unknown future" is pertinent to the issue of whether the disputed domain name has been registered and is being used in bad faith. Complainant's position in this respect becomes even more problematic in view of the Complaint's allegations in paragraphs 25 and 26 asserting that Respondent "has yet to activate the link" and that Respondent[s] "are not sure whether they will use the ... domain name to sell legitimate products." The Panel does not find that these allegations prove bad faith registration and use.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Hewlett-Packard Company v. High Performance Networks, Inc.*, FA 0006000095083; *Weber-Stephen Products Co. v. Armitage Hardware*
- j. Judicial decisions and statutes cited: None

**2394. FleetBoston Financial Corporation v. Medfield Builders, Case No. D2000-1585**

- a. Date: March 29, 2001
- b. Panelist(s): B A Solomon
- c. Domain Name(s) at Issue: <bankboston-pavilion.com, thebankbostonpavilion.com, fleetboston-pavilion.com, fleetbostonpavilion.com>
- d. Response?: No
- e. Principle(s): With respect to rights in the marks BANKBOSTON and BANCOSTON, the panelist had been concerned that as a result of the merger between BankBoston Corp. and Fleet Financial Group, use of the mark BANKBOSTON had stopped. However, Loraine Parkinson, Senior Counsel for Fleet Boston Financial Corporation, in a sworn affidavit, has provided information making it clear that the BANKBOSTON mark (as well as BANCOSTON) continues to be used in connection with goods and services provided in the United States as well as abroad. Based on this evidence, it is evident that the Complainant has proven rights in the mark FLEET as well as in the marks BANKBOSTON and BANCOSTON, which predate the registrations of the domain names.
- f. Result: Name transfer

- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Eauto, LLC v. Triple S Auto Parts et al*, WIPO D2000-0047; *SFX Entertainment, Inc. v. Medfield Builders*, WIPO D2000-0547; *Embratel v. McCarthy*, WIPO D2000-0164
- j. Judicial decisions and statutes cited: None

**2395. Backstreet Boys Productions, Inc. v. John Zuccarini, Cupcakeparty, Cupcake Real Video, Cupcake-Show, and Cupcakes-First Patrol, Case No. D2000-1619**

- a. Date: March 27, 2001
- b. Panelist(s): M. Scott Donahey, Frederick Abbott, David Wagoner
- c. Domain Name(s) at Issue: <backstreetboys.com, backstreetboys.com, backstreetboypics.com etc.>
- d. Response?: Yes
- e. Principle(s):
  - i. In the present case Complainant has failed to establish that Complainant has rights in the trademark on which Complainant relies. Complainant identifies itself as Backstreet Boys Productions, Inc., a Florida corporation, and lists two addresses for itself, one in Beverly Hills, California, and one in Los Angeles, California. Complainant submitted evidence that the trademark BACKSTREET BOYS was held by one Louis J. Pearlman. Upon request for further information concerning Complainant's rights to or interests in the trademark submitted, Complainant produced an Assignment showing that all right, title and interest to the trademark had been transferred to an entity known as Backstreet Productions, Inc., a Delaware corporation, located in Sherman Oaks, California. Thus, Complainant has failed to carry its burden that it has rights in the trademark on which it relies.
  - ii. What is to be the effect of a dismissal of the Complaint in this matter? A recent Panel decision analyzed when a Complaint should be accepted when refiled and when it should be rejected. In *Creo Products Inc. v. Website In Development*, ICANN Case No. D2000-1490, the learned Panelist carefully analyzed the proper grounds for acceptance of a complaint filed following a dismissal of a previous claim brought by the same complainant against the same respondent concerning the same domain name(s). The learned Panelist found that to the extent that the refiled complaint concerned acts which formed the basis of the original complaint, the refiled complaint should only be entertained in certain limited circumstances, such as a breach of natural justice or due process in the prior proceeding, the discovery of new evidence which, with the exercise of due diligence, would not have been reasonably available at the time of the original hearing, etc. The Panel agrees with this analysis.

- iii. The learned Panelist in the *Creo Products* case further found that where the refiled complaint concerned acts which occurred subsequent to the dismissal of the original complaint, the refiled complaint is essentially a new action, and it should be entertained. The Panel agrees with this analysis also.
- iv. Finally, the learned Panelist disapproved of the practice of dismissing a complaint without prejudice, stating that "such a practice is not desirable, and should be avoided wherever possible." While the Panel agrees that such dismissals should be used sparingly, the Panel believes that "dismissals without prejudice" serve an important purpose in certain cases, and that the present case is one of those cases. A failure of proof, especially one of a technical nature, frequently arises in court litigation. Because the parties are present, such evidentiary deficiencies can often be cured by oral testimony given when the failure arises, by explanation of the seeming inconsistency, or by the production or creation of documents which serve to establish the technical evidentiary point at issue. However, proceedings under the UDRP do not provide for oral hearings, except in exceptional circumstances. Thus, the parties' ability to correct technical failures of proof are severely limited. The Panel believes that in such instances a "dismissal without prejudice" is the procedure to be followed in order to insure that substantial justice is done between the parties.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Creo Products Inc. v. Website In Development*, ICANN Case No. D2000-1490
- j. Judicial decisions and statutes cited: None

**2396. Franchise Recruiters, Ltd. v. Franstaff, Inc., Case No. D2000-1625**

- a. Date: March 18, 2001
- b. Panelist(s): Frederick M. Abbott
- c. Domain Name(s) at Issue: <franchiserecruiters.com>
- d. Response?: Yes
- e. Principle(s): Respondent was well aware of Complainant's interest in its mark prior to registration of the disputed domain name. Respondent's claimed performance of a trademark search at or about the time of registration of the disputed domain name does not establish a good faith interest in the name. Respondent acknowledges that it found Complainant's Canadian trademark registration, but asserts it concluded that Complainant had disclaimed its interest in "franchise recruiters" at the time it secured the registration. To the extent that Respondent indeed reached such a conclusion, it was not warranted as a matter of law. Moreover, in light of Respondent's prior dealings with Complainant, and Complainant's very well known presence in Respondent's industry sector,

Respondent cannot disclaim knowledge of Complainant's common law interests in its mark.

- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Educational Testing Service v. TOEFL*, Case No. D2000-0044
- j. Judicial decisions and statutes cited: 15 USCS § 1057(b). *Avery Dennison v. Sumpton*, 189 F.3d 868 (9<sup>th</sup> Cir. 1999).

**2397. Scholastic Inc. v. Applied Software Solutions, Inc., Case No. D2000-1629**

- a. Date: March 15, 2001
- b. Panelist(s): M. Scott Donahey, Frederick M. Abbott, Dennis A. Foster
- c. Domain Name(s) at Issue: <escholastics.com>
- d. Response?: Yes
- e. Principle(s):
  - i. However, Respondent argues that Complainant has no rights to the name since Complainant has registered as a trademark a generic term. However, the term was not generic, at least as of the time of the various registrations of the mark, since the USPTO will not issue registrations for generic terms. Respondent has produced no evidence that such terms are generic.
  - ii. Perhaps by "generic" Respondent intends to suggest that the term SCHOLASTIC is merely descriptive. If so, prior Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is the Panel's belief that Respondent has not met its burden. is distinctive. Respondent has the burden of refuting this assumption. Respondent has failed to produce any evidence, beyond a mere assertion, that the trademark at issue is or has become merely descriptive.
  - iii. Even had Respondent shown that Complainant's mark embodied a descriptive term, Complainant could show that the mark has acquired a secondary meaning by having been used for so long and so exclusively by one merchant with reference to the particular article that in that trade and to the particular branch of the purchasing public, the word or phrase has come to mean that the article was the product of the merchant in question.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Busy Body, Inc. v. Fitness Outlet Inc.*, ICANN Case No. D2000-0127; *InfoSpace.com, Inc. v. Registrar Administrator Lew Blanck*, ICANN Case No. D2000-0069; *Scholastic Inc. v. 366 Publications*, ICANN Case No. D2000-1627; *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, ICANN Case No. D2000-0047; *Broadway Trading, LLC v.*

*Gene Weissman*, ICANN Case No. FA 94310; *The British Broadcasting Corporation v. Jaime Renteria*, ICANN Case No. D2000-0050; *Busy Body, Inc. v. Fitness Warehouse, Inc.*, ICANN Case No. D2000-0127; *Scholastic Inc. v. 366 Publications*, ICANN Case No. D2000-1627

j. Judicial decisions and statutes cited: None

**2398. Infospace, Inc. v. Siavash Jimmy Behain, et al., Case No. D2000-1631**

- a. Date: March 30, 2001
- b. Panelist(s): Richard W. Page
- c. Domain Name(s) at Issue: <nfospace.com, infoospace.com, infospacer.com, infospacer.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Madonna Ciccone p/k/a Madonna v. Parisi*, WIPO Case No. D2000-0847; *Corinthians Licenciamentos Ltda. v. Sallen*, WIPO Case No. D2000-0461; *InfoSpace.com, Inc. v. Delighters, Inc. d/b/a Cyber Joe's Internet Café*, ICANN Case No. D2000-0068; *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, ICANN Case No. D2000-0047; *Adaptive Molecular Tech., Inc. v. Woodward*, WIPO Case No. D2000-0006; *Expedia, Inc. v. European Travel Network*, D2000-0137; *Document Technologies v. International Electronic Communications, Inc.*, D2000-0270; *The Channel Tunnel Group Ltd. v. Powell*, WIPO Case No. D2000-0038; *Encyclopaedia Britannica v. Zucarini*, D2000-0330
- j. Judicial decisions and statutes cited: 15 U.S.C. § 1115; *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054-55 (9th Cir. 1999).

**2399. Schiavello (Vic) Pty Ltd. v. Gaynor Wedley, Case No. D2000-1634**

- a. Date: March 21, 2001
- b. Panelist(s): Pravin Anand
- c. Domain Name(s) at Issue: <schiavello.com, schiavello.org>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *The Stanley Works and Stanley Logistics, Inc. vs. Camp Creek Co., Inc. Case No. D2000-0113*
- j. Judicial decisions and statutes cited: *J.R. Parkington and Coy Ltd. v. Frederick Robinson Ltd*, 63 RPC 171, 181 (1946)

**2400. Omnitel Pronto Italia S.p.A. v. Carlo Dalla Bella, Case No. D2000-1641**

- a. Date: March 12, 2001
- b. Panelist(s): Richard Hill
- c. Domain Name(s) at Issue: <omnitel2000.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2401. Bosley Medical Group and Bosley Medical Institute, Inc. v. Michael Kremer, Case No. D2000-1647**

- a. Date: February 28, 2001
- b. Panelist(s): Dana Haviland
- c. Domain Name(s) at Issue: <bosleymedical.com>
- d. Response?: Yes
- e. Principle(s): The evidence demonstrates that the Respondent has legitimate rights or interests in the Domain Name. The Respondent's contention that he has registered the site to make information regarding Bosley Medical more widely accessible, without any intent for commercial gain, is clearly fair use.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Compusa Management Company v. Customized Computer Training*, NAF No. FA0006000095082; *TMP Worldwide Inc. v. Jennifer L. Potter*, ICANN Case No. D2000-0536; *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myers*, WIPO Case No. D2000-0190; *Estee Lauder, Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869 and *Mission KwaSizabantu v. Benjamin Rost*, WIPO Case No. D2000-0279; *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO Case No. D2000-0477 and *Telstra Corp. Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003
- j. Judicial decisions and statutes cited: None

**2402. Creative NetVentures, Inc. v. Webheads, Case No. D2000-1655**

- a. Date: March 9, 2001
- b. Panelist(s): M. Scott Donahey, James Wilson Dabney, Jeffrey M. Samuels
- c. Domain Name(s) at Issue: <anteup.com>
- d. Response?: Yes
- e. Principle(s):
  - i. Respondent registered the domain name at issue on July 10, 1996. This is more than three years before Complainant filed for registration of the trademark, more than four years prior to the issuance of registration, and more than fifteen months before

Complainant claims to have first used the mark in commerce. Prior panel decisions have found that this fact of prior registration in and of itself gives Respondent rights and legitimate interests in respect of the domain name.

- ii. The fact that Complainant's mark is a common descriptive term which has been in use by Complainant for only a short period indicates that the mark is a weak one. In such cases, it has been held that this would not defeat the rights or legitimate interests of a Respondent in respect of a domain name incorporating such mark where such adoption was not intended to cause confusion or diversion of business.

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Draw-Tite, Inc. v. Pittsburgh Spring Inc.*, ICANN Case No. D2000-0017; *High-Class Distributions S.r.l. v. Online Entertainment Services*, ICANN Case No. D2000-0100; *Chernow Communications, Inc. v. Jonathan D. Kimball*, ICANN Case No. D2000-0119; *Mpower Communications Corp. v. Park Lodge Hotel*, ICANN Case No. D2000-0078; *EAuto, L.L.C. v. EAuto Parts*, ICANN Case No. D2000-0096;
- j. Judicial decisions and statutes cited: None

**2403. William Grant & Sons Limited v. Daniel Scotto, Case No. D2000-1656**

- a. Date: March 18, 2001
- b. Panelist(s): Mark V B Partridge
- c. Domain Name(s) at Issue: <balvenie.com>
- d. Response?: Yes
- e. Principle(s): "...the mere fact that a party offers to sell a Domain Name for a premium is not conclusive proof of bad faith. The specific circumstances of the offer must be considered. In this case there is nothing to indicate that it was Respondent's intention to squat on the name of another in hopes that he could extract an offer for payment. There is also nothing to indicate that his explanation for selecting the Domain Name is a sham. His registration of other domain names has been adequately explained. Given that Respondent demonstrated a bona fide intent to use the Domain Name for a non-infringing purpose, I find that his offer to surrender his rights in the domain name for a premium does not establish bad faith use and registration."
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2404. McNeil Consumer Brands, Inc. v. Washington Surgical Services, Case No. D2000-1657**

- a. Date: March 23, 2001

- b. Panelist(s): Marylee Jenkins
- c. Domain Name(s) at Issue: <Tylenol.net>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO D2000-003
- j. Judicial decisions and statutes cited: None

**2405. Amazon.com, Inc. v. MCL International Limited, Case No. D2000-1678**

- a. Date: March 12, 2001
- b. Panelist(s): Clive Duncan Thorne, M Scott Donahey, Bernhard F Meyer-Hauser
- c. Domain Name(s) at Issue: <yuamazon.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2406. TV GLOBO LTDA. v. RÁDIO MORENA, Case No. D2000-1685**

- a. Date: March 20, 2001
- b. Panelist(s): Pedro W. Buchanan
- c. Domain Name(s) at Issue: <jornalhoje.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i), 4(k)
- h. Uniform Rules cited: 14, 15
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2407. RE Infolink v. Nathan Frey d/b/a 123 Mail, Case No. D2000-1687**

- a. Date: March 26, 2001
- b. Panelist(s): Dana Haviland, Sally M. Abel, Carol Anne Been
- c. Domain Name(s) at Issue: <reinfoolink.com>
- d. Response?: Yes
- e. Principle(s):
  - i. Although Complainant did not obtain any registered trademark rights until after the Respondent's registration of the Domain Name, the Complainant may have had common law trademark or trade name rights to the mark RE infolink at the time of the

Domain Name registration. Although WIPO is currently considering whether to expand the ICANN Policy to cover trade names, the Policy does not presently offer protection for trade name rights, and the Panel cannot determine whether Complainant had any common law trademark rights at the time of the registration of the Domain Name on the basis of the evidence submitted.

- ii. In the Panel's view, proof of the first element of Complainant's claim would require the submission of additional evidence and more detailed direct and cross-examination of the various witnesses whose testimony has been referred to in the pleadings. For this reason, the Panel believes that the claim is not appropriate for resolution in this summary ICANN proceeding and would be more appropriately resolved in judicial or arbitration proceedings designed for fuller development of the evidence.
- iii. Respondent has submitted some evidence of preparations to use the Domain Name in connection with a bona fide offering of goods and services, thus demonstrating a possible right or legitimate interest in the Domain Name under Paragraph 4(c)(i) of the Policy. Again, this evidence, as well as both parties' evidence as to Respondent's actual notice of Complainant's rights to the name, consists primarily of conclusory allegations unsupported by documentary evidence and untested by cross-examination. Thus, as to the second element of the claim, the Panel reiterates that resolution of the Complainant's claim would be more appropriately dealt with in judicial or arbitral proceedings rather than this summary ICANN proceeding.
- iv. This case is not a typical cybersquatting case. The evidence submitted by the parties presents complex issues of fact and credibility as to each element of the claim which are not appropriate for resolution in this summary ICANN proceeding and would be better resolved in a judicial or arbitral proceeding designed for a fuller development and presentation of documentary and testimonial evidence. The Panel finds that on the basis of the evidence submitted, the Complainant has failed to carry its burden of proof as to each of the three elements of its claim, and the claim for transfer of the Domain Name <reinfolink.com> is therefore denied.

- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2408. Newman/Haas Racing v. Virtual Agents, Inc., Case No. D2000-1688**

- a. Date: March 29, 2001

- b. Panelist(s): Tony Willoughby, David H Bernstein, Jacques A Leger
- c. Domain Name(s) at Issue: <newmanhaasracing.com, >
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2409. Fábricas Agrupadas de Muñecas de Onil S.A. (FAMOSA) v. Gord Palameta, Case No. D2000-1689**

- a. Date: March 14, 2001
- b. Panelist(s): David E. Sorkin, Roberto A. Bianchi, Dennis Foster
- c. Domain Name(s) at Issue: <famosa.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Viz Communications, Inc. v. Redsun*, No. D2000-0905 (WIPO Dec. 22, 2000); *Shirmax Retail Ltd. v. CES Marketing Group*, No. AF-0104; *Passion Group Inc. v. Usearch, Inc.*, No. AF-0250; *Tata Sons Ltd. v. D & V Enterprises*, No. D2000-0479; *Ciccone p/k/a Madonna v. Parisi*, No. D2000-0847; *Etam, plc v. Alberta Hot Rods*, No. D2000-1654; *Zero International Holding GmbH v. Beyonet Services*, No. D2000-0161, *Shirmax Retail Ltd. v. CES Marketing Group*
- j. Judicial decisions and statutes cited: None

**2410. Nike, Inc. v. Paul Verschoor, Case No. D2000-1707**

- a. Date: March 2, 2001
- b. Panelist(s): Clive Elliott
- c. Domain Name(s) at Issue: <nike-soccer.com, nike-soccer.net, nike-soccer.org>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2411. Natural Microsystems Corporation v. William P. Benac, Jr., Case No. D2000-1712**

- a. Date: March 22, 2001
- b. Panelist(s): James Bridgeman, Jeffrey Samuels, Richard Hill

- c. Domain Name(s) at Issue: <naturalmicrosystems.com>
- d. Response?: Yes
- e. Principle(s): In conclusion, this Administrative Panel is satisfied that the Complainant has succeeded in establishing that the said domain name is identical to a trademark or service mark in which the Complainant has rights, but has failed to prove that the Respondent has no rights or legitimate interest in the said domain name and consequently the Complainant cannot succeed so there is no necessity for this Administrative Panel to consider the questions of whether the said domain name has been registered and is being used in bad faith.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: 15 USC 1125

**2412. Freni Brembo S.p.A. v. Webs We Weave, Case No. D2000-1717**

- a. Date: March 19, 2001
- b. Panelist(s): Kamen Troller
- c. Domain Name(s) at Issue: <brembobrakes.com>
- d. Response?: Yes
- e. Principle(s):
  - i. The Respondent has presented sufficient evidence to prove that it has used the domain name in connection with the bona fide offering of Complainant's goods before it received notice of the dispute. It is apparent from the Respondent's website that Respondent is reselling Complainant's products under the Trademark in its capacity as a distributor for Complainant. Although it appears that Respondent has also used its web page to sell products other than those of the Complainant's (Valter Moto components), these instances appear to be minor.
  - ii. It does not appear that the Respondent's actions are intended to tarnish, or have tarnished, the Complainant's trademark. Nor does it appear that Respondent's registration and use of the domain name have harmed the Complainant commercially. Respondent's use of "brembobrakes.com" has not prevented Complainant from making its commercial presence known on the Internet. The Complainant and its affiliates themselves have registered "brembo.it" and "brembo.com". There is no rule that the registration of a mark gives the owner the right to all TLDs using the mark or a portion of the mark. As demonstrated above, the test to be applied is far more complicated.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Gateway, Inc. v. James Cadieux* (D2000-0198); *Chanel, Inc. v. Estco Technology Group* (D2000-0413); *The Journal Newspapers*,

- Inc. v. DomainForSale 980dollars* (FA8000095395).
- j. Judicial decisions and statutes cited: None
- 2413. NIIT Ltd v. Ghazanfar, Ali on behalf of National Institute of Information Technology, Case No. D2000-1718**
- a. Date: March 9, 2001
- b. Panelist(s): Sir Ian Barker
- c. Domain Name(s) at Issue: <niit.net>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None
- 2414. Salomon Smith Barney Inc. v. Daniel Singer d/b/a Build Me A Website.com, Case No. D2000-1722**
- a. Date: February 28, 2001
- b. Panelist(s): Dana Haviland
- c. Domain Name(s) at Issue: <salomansmithbarney.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *E.I. du Pont de Nemours and Company v. Avant Garde Composition*, ICANN Case No. D2000-0130; *Rice Burroughs, Inc. v. Adtel Communications*, ICANN Case No. D2000-0115
- j. Judicial decisions and statutes cited: None
- 2415. Wockhardt Limited v. Margold Associates, Case No. D2000-1725**
- a. Date: March 1, 2001
- b. Panelist(s): Clive L Elliott
- c. Domain Name(s) at Issue: <wockhardt.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Telstra Corporation Limited v Nuclear Marshmallows*, Case number D2000-0003
- j. Judicial decisions and statutes cited: None
- 2416. General Electric Company v. Momm Amed Ia, Case No. D2000-1727**
- a. Date: March 21, 2001

- b. Panelist(s): Clive Elliott
- c. Domain Name(s) at Issue: <gebenefits.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2417. Barry Diller v. INTERNETCO CORP, Case No. D2000-1734**

- a. Date: March 9, 2001
- b. Panelist(s): Dennis A. Foster, Jeffrey H. Kaufman, Richard W. Page
- c. Domain Name(s) at Issue: <barrydiller.org>
- d. Response?: No
- e. Principle(s): "...the Panel agrees with the Complainant that the Respondent, in bad faith, is tarnishing the Complainant's common law servicemark by associating the Respondent's name, without the Respondent's permission, with commercial pornography..."
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case No. D2000-0299; *World Wrestling Federation Entertainment, Inc. v. Matthew Bessette*, WIPO Case No. D2000-0256
- j. Judicial decisions and statutes cited: None

**2418. Sun Pacific Marketing Coop, Inc. v. Arnold Li, Case No. D2000-1744**

- a. Date: March 30, 2001
- b. Panelist(s): M. Scott Donahey
- c. Domain Name(s) at Issue: <sunpacific.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *Alcoholics Anonymous World Services, Inc. v. Raymond*, WIPO Case No. D2000-007; *Bronson Plc v. Unimetal Sanayai ve Tic. A.S.*, WIPO Case No. D2000-0011; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *Ingersoll-Rand v. Frank Gully, d/b/a Advcomren*, WIPO Case No. D2000-0021; *Guerlain, S.A. v. Peikang*, WIPO Case No. D2000-0055; *Compaq Computer Corp. v. Boris Beric*, WIPO Case No. D2000-0042; *Association of British Travel Agents Ltd. v. Sterling Hotel Group Ltd.*, WIPO Case No. D2000-0086; *Sanrio Co. Ltd. and Sanrio, Inc. v. Lau*, WIPO Case No. D2000-0172; *3636275 Canada, dba eResolution v. eResolution.com*, WIPO Case No. D2000-0110; *Marconi Data Systems, Inc. v.*

*IRG Coins and Ink Source, Inc.*, WIPO Case No. D2000-0090; *Stralfors AB v. P D S AB*, WIPO Case No. D2000-0112; *InfoSpace.com, Inc. v. Ofer*, WIPO Case No. D2000-0075

j. Judicial decisions and statutes cited: None

**2419. Calçados Azaléia S/A v. Link Commercial Corp., Case No. D2000-1745**

- a. Date: March 20, 2001
- b. Panelist(s): Peter Dirk Siemsen
- c. Domain Name(s) at Issue: <azaleia.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(c), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2420. Diversified Gestao e Investimientos Lda. v. Krikor Doumanian, Case No. D2000-1749**

- a. Date: February 13, 2001
- b. Panelist(s): Anna Carabelli
- c. Domain Name(s) at Issue: <gilli.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Pharmacia & Upjohn Co v. People Revolutionary Suicide Jazz Band – WIPO Case No. D2000-0816*; *Spadel S.A v. Peter Kisters WIPO Case No. D2000-0526*; *Deutsche Bank AG v. Diego-Arturo Bruckner WIPO Case No. D2000-0277*; *Talkcity Inc. v. Robertson WIPO Case No. D2000-0009*.
- j. Judicial decisions and statutes cited: None

**2421. Casa Editorial El Tiempo S.A, v. Spider Webs Ltd, Case No. D2000-1757**

- a. Date: April 8, 2001
- b. Panelist(s): Luca Barbero, Dana Haviland, Luis H. de Larramendi
- c. Domain Name(s) at Issue: <casaeditorialtiempo.com>
- d. Response?: Yes
- e. Principle(s): Panel finds Paragraph 4 (b)(i) applicable in the instant case since the offer to lease the domain name "casaeditorialtiempo.com" and the explicit request for an "offer I can't refuse" shows an intent to transfer rights to the site for amounts in excess of the out of pocket cost. The fact that the respondent offers to lease rather than sell is to be considered immaterial.
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)

- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2422. Beiersdorf AG v. Good Deal Communications, Case No. D2000-1759**

- a. Date: April 2, 2001
- b. Panelist(s): Jonathan Turner
- c. Domain Name(s) at Issue: <niveasun.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Jeanette Winterson v Mark Hogarth*, Case No. D2000-0235
- j. Judicial decisions and statutes cited: None

**2423. Koç Holding A.S. v. MarketWeb A.S., Case No. D2000-1764**

- a. Date: March 2, 2001
- b. Panelist(s): Thomas H. Webster
- c. Domain Name(s) at Issue: <koc.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Mpower Communications Corp. v. Park Lodge Hotel*, Case No. D2000-78; *Double T Radio Pty Ltd. v. Michael Lopez* WIPO Case No. D2000-1600
- j. Judicial decisions and statutes cited: None

**2424. NetWizards, Inc. v. Spectrum Enterprises, Case No. D2000-1768**

- a. Date: April 4, 2001
- b. Panelist(s): Peter L. Michaelson
- c. Domain Name(s) at Issue: <netwizard.net>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 15
- i. Panel Decisions cited: *MSNBC Cable, LLC v. Tsysys.com* D2000-1204 (WIPO December 8, 2000), *Wine.com, Inc. v. Zvieli Fisher* D2000-0614, *Lana Marks, Ltd., Inc. v. SYP Web* D2000-0304; *Dollar Financial Group, Inc. v VQM NET* FA 96101 (Nat. Arb. Forum January 25, 2000); *eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* D2000-1463; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.* FA 95856 (Nat. Arb.

Forum December 18, 2000), and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145; *Hollywood Casino Corporation v. Go Call Inc.* FA 95741 (Nat. Arb. Forum October 30, 2000), *Marriott International, Inc. v. Vladimir Kyznetsov* FA 95648 (Nat. Arb. Forum October 24, 2000), *Bank of America Corporation v. Micah Abrams* FA 95479 (Nat. Arb. Forum October 11, 2000), *ESPN, Inc. v. Danny Ballerini* FA 95410 (Nat. Arb. Forum September 15, 2000), and *Anne of Green Gables Licensing Authority, Inc. v. Internetworks* AF-00109; *Cabletron Systems, Inc. v. DSL Enterprises* D2000-0571; *Cisco Systems, Inc. v. Mike Haag* AF-0585a-b (eResolution December 29, 2000), *Zwack Unicum Rt. v. Erica J. Duna* D2000-0037 (WIPO March 10, 2000), *Oly Holigan, L.P. v. Private* FA 95940

j. Judicial decisions and statutes cited: 15 USC § 1125(d)(1)

**2425. Tribeca Film Center, Inc. v. Lorenzo Brusasco-Mackenzie, Case No. D2000-1772**

- a. Date: April 10, 2001
- b. Panelist(s): David H. Bernstein
- c. Domain Name(s) at Issue: <tribecafilmcenter.com>
- d. Response?: Yes
- e. Principle(s): The parties have submitted conflicting affidavits regarding whether Respondent offered to sell the domain name. Two of Complainant's employees, Trina Wyatt and Sandra O'Hearen, swear that, after Complainant contacted Respondent to discuss transfer of the domain name, Dara McQuillan left a message with Complainant stating that "they" were "willing to entertain an offer." Although it would seem unlikely that both Wyatt and O'Hearen are wrong, McQuillan swears that he never left any such message. This leaves open the question of whether someone else left the message (which, if left by Respondent or his agent, would constitute an offer to sell that would support a finding of bad faith). Complainant, though, has not proven who else could have left the message and Respondent swears both that he did not and that he told Benincasa that "he was not interested in selling." Given the truncated nature of this proceeding, the lack of live testimony to facilitate credibility findings, and the lack of any documentary evidence to support either side's version of the events (such as contemporaneous notes, recordings of messages, or memoranda to the parties' files), it is impossible to reconcile the affidavits or to determine which report of the facts more likely than not is correct. The Panel thus is unable to determine whether or not an offer to sell was made. The burden of this uncertainty falls upon Complainant because, pursuant to Paragraph 4(a) of the Policy, it is Complainant who bears the burden of proving bad faith. Although it is a close decision, the Panel is constrained to find that Complainant has not met its burden of proving by a preponderance of the evidence that an offer to sell was made.
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Madonna Ciccone v. Parisi*, WIPO Case No. D2000-0847; *Van Halen v. Morgan*, WIPO Case No. D2000-1313; *TABCORP*

*Holdings Ltd. v. Hertzberg*, WIPO Case No. D2000-0566; *Compare Mission KwaSizabantu v. Rost*, WIPO Case No. D2000-0279; *Compusa Management Co. v. Customized Computer Training*, File No. FA0006000095082;

j. Judicial decisions and statutes cited: *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 345 (2d Cir. 1999)

**2426. FC Bayern München e.V v. Miguel Garcia, Case No. D2000-1773**

- a. Date: March 20, 2001
- b. Panelist(s): Andrea Mondini, William Cornish, Thomas Hoeren
- c. Domain Name(s) at Issue: <fcbayern.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Rollerblade, Inc. v. CBNO and Ray Redican Jr.*, D2000-0427; *Gordon Summer, p/k/a Sting v. Michael Urvan*, D2000-0596; *Football Club des Girondins de Bordeaux v. Annie Arr*, D 2000-0149; *Lancôme Parfums et Beauté & Cie v. SL, Blancel Web*, D2001-0028; *Do The Hustle, LLC v. Tropic Web*, D2000-0624; *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO 2000-0003; 3636275 *Canada, dba eResolution v. eResolution.com* WIPO D2000-0110; *Parfums Christian Dior v. Javier Garcia Quintas and christiandior.net* WIPO D2000-0226; *Hyosung Corporation v. HH* WIPO D2000-0236; *Mrs. America Productions, Inc. v E.T. Corp.*, NAF 0003000094377; *Michelin & Cie. v. Tgifactory*, WIPO D2000-1414
- j. Judicial decisions and statutes cited: None

**2427. Koninklijke Philips Electronics N.V. v. Cun Siang Wang, Case No. D2000-1778**

- a. Date: March 15, 2001
- b. Panelist(s): Jonathan Turner
- c. Domain Name(s) at Issue: <Philips-indonesia.com>
- d. Response?: No
- e. Principle(s):
  - i. The Panel notes that there have been differing decisions under the Policy on whether a complainant can object to the use of a domain name corresponding to its mark for a website selling the complainant's own products. Complaints succeeded in "*heelquick.com*", "*fanuc.com*" and "*cunardcruise.com*", but failed in "*militec.com*", "*drawtite.com*" and "*kittinger.com*".
  - ii. There is no evidence of any attempt to sell the domain name to the Complainant or a competitor of the Complainant. While the Respondent's registration may block the Complainant from using a domain name, which would be suitable for its Indonesian subsidiary, branch or distributor, there is no evidence of such an intention on the part of the Respondent and certainly no evidence

of a pattern of such conduct. The Panel also notes that, despite being a major international consumer products company, the Complainant has not previously felt the need to have this particular domain name, but has found it sufficient to have pages for Indonesia on its website at "www.philips.com".

- iii. The Panel is not satisfied that the domain name was registered primarily for the purpose of disrupting a competitor. Although from one point of view an unauthorized distributor may be regarded as disrupting a distribution network, the Panel considers that this provision of the Policy should be interpreted taking into account the principle of exhaustion discussed above. The Panel considers that the resale of genuine products placed on the market by the owner of the mark or with its consent in their original condition does not constitute "bad faith" within the meaning of the Policy where it is permitted by the applicable law, even if the distributor is not authorized by the owner of the mark.
- iv. The incorrect inclusion of the US as the country in the Respondent's address in the Registrar's whois database is not evidence of bad faith. The address gives the city as "Jakarta Barat" and the state as "WJ", which are presumably correct. The reference to the US is probably due to a failure to amend a default in the Registrar's registration form.
- v. While the Respondent is no doubt using the Domain Name intentionally to attract Internet users to its website for commercial gain, the Panel is not satisfied that it is doing so by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on it. The first page of the Respondent's website makes it clear that it is not affiliated to or sponsored or endorsed by Philips. While the website indicates that the products offered for sale are products manufactured and placed on the market by the Complainant's group, if in fact this is true, it is not causing confusion. In the absence of any evidence that the Respondent is not selling genuine Philips products, the Panel is unable to conclude that the Respondent is using the Domain Name in bad faith on this basis.

- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: *Prestonettes v Coty* (1924) 264 US 359, the German Federal Supreme Court in Case I ZR 85/71 *Cinzano v Java* [1974] 2 CMLR 21 and the European Court of Justice in Case 16/74 *Centrafarm v Winthrop* [1974] ECR 1183; *Volkswagenwerk v Church* (CA9, 1969) 411 F2d 350, 161 USPQ 769, Case C-337/95 *Parfums Christian Dior v Evora* (ECJ, 1997) [1997] EC I-6013 and Case C-63/97 *BMW v Deenik* (ECJ, 1999) [1999] ECR I-

**2428. The Professional Golfers' Association of America v. Geoff Watson, Case No. D2000-1779**

- a. Date: March 8, 2001
- b. Panelist(s): D.J. Ryan
- c. Domain Name(s) at Issue: <ryder-cup.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *ISL Marketing AG and FIFA v. JY Chung and others*- WIPO Case No. D2000-0034; *Hoblaw v. Carlow Borbosa* – AFO163; *Dow Jones v. Hephzabah Intro-Net Project Ltd* – WIPO Case No. D2000-0704;
- j. Judicial decisions and statutes cited: None

**2429. America's Community Bankers Corporation v. Charles R. Wing and Wing Broadcasting, Inc., Case No. D2000-1780**

- a. Date: March 5, 2001
- b. Panelist(s): David M. Kelly
- c. Domain Name(s) at Issue: <americascommunitybanks.com, americascommunitybanks.net, americascommunitybanks.org, acbbanks.com>
- d. Response?: Yes
- e. Principle(s): Complainant has neither alleged in its Complaint nor submitted any evidence that its admittedly descriptive marks AMERICA'S COMMUNITY BANKER and AMERICA'S COMMUNITY BANKERS have acquired distinctiveness. Relying solely upon Complainant's registrations on the Supplemental Register, the Panel must conclude that Complainant's marks AMERICA'S COMMUNITY BANKER and AMERICA'S COMMUNITY BANKERS are descriptive terms that have not acquired distinctiveness. Accordingly, the Panel finds that Complainant has not proven the first prong of the UDRP, which provides that the complainant must have rights in the mark upon which the complaint is based. For this reason, the Panel need not examine whether the Domain Names are confusingly similar to Complainant's marks AMERICA'S COMMUNITY BANKER and AMERICA'S COMMUNITY BANKERS. Consequently, the Panel need not examine whether Respondent has any rights or legitimate interests in the domain names <americascommunitybanks.com>, <americascommunitybanks.net>, and <americascommunitybanks.org>, or whether Respondent registered and used those domain names in bad faith. The Panel's finding under UDRP Section 4(a)(i) does not mean that Complainant's marks AMERICA'S COMMUNITY BANKER and AMERICA'S COMMUNITY BANKERS have not acquired distinctiveness, but rather simply means that no evidence of acquired distinctiveness has been presented to the Panel.
- f. Result: The Panel dismisses Complainant's Complaint against

Respondent's registration and use of the domain names <americascommunitybanks.com>, <americascommunitybanks.net>, and <americascommunitybanks.org>. The Panel requires that the domain name <acbanks.com> be transferred to America's Community Bankers Corporation, Complainant.

- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: *Clairol Inc. v. Gillette Co.*, 389 F2d 264 (2d Cir. 1968)

**2430. Israel Discount Bank of New York v. Richard A. Galvin, Case No. D2000-1781**

- a. Date: March 12, 2001
- b. Panelist(s): Ross Carson
- c. Domain Name(s) at Issue: <idbbank.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2431. Emilio Pucci SRL v Mailbank.com, Inc., Case No. D2000-1786**

- a. Date: March 19, 2001
- b. Panelist(s): Tony Willoughby, Luca Barbero, David W. Maher
- c. Domain Name(s) at Issue: <pucci.com>
- d. Response?: Yes
- e. Principle(s): Here there is no evidence that the Respondent had the Complainant in mind when registering the Domain Name. "Pucci" was just one of many thousands of surnames registered as domain names by the Respondent. The evidence filed by the Respondent appears to support the proposition that the registration of the Domain Name was intended to attract business from people with the surname "Pucci"
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2432. Sankyo Co., Ltd. v. Zhu Jiajun, Case No. D2000-1791**

- a. Date: March 23, 2001
- b. Panelist(s): Sang Jo JONG
- c. Domain Name(s) at Issue: <三共.com>
- d. Response?: Yes

- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None.
- i. Panel Decisions cited: *VAT Holding AG v Vat.com*, Case No. D2000-0607; *L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, Case No. D2000-0047; *Barney's Inc. v. BNY Bulletin Board*, Case No. D2000-0059; *ISL Marketing AG, and The Federation Internationale de Football Association v. J.Y. Chung, Worldcup2002.com, W Co., and Worldcup 2002*, Case No. D2000-0034; *Port of Helsinki v. Paragon International Projects Ltd.*, Case No. D2001-0002; *Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic*, Case No. D2000-1698; *Yahoo! Inc., v. Silicon City and Osama Al-Ayoub*, Case No. D2000-1711; *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.*, Case No. D2000-0802; *Nabisco Brands Company v. The Patron Group, Inc.*, Case No. D2000-0032
- j. Judicial decisions and statutes cited: None

**2433. Titan Industries Limited v. Tanishq Corporation, Case No. D2000-1793**

- a. Date: March 14, 2001
- b. Panelist(s): Mark V. B. Partridge, Desmond J. Ryan, Tony Willoughby
- c. Domain Name(s) at Issue: <tanishq.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2434. Ferrero S.p.A. v. Mario Pisano, Case No. D2000-1794**

- a. Date: March 23, 2001
- b. Panelist(s): Anna Carabelli
- c. Domain Name(s) at Issue: <nutellaparty.com>
- d. Response?: yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Libro AG v. NA Global Link Limited* – WIPO D2000-0186; *Interep National Radio Sales Inc. v. Technical Staffing* – WIPO D2000-0175; *Société des Hotels Meridien SA v. United States of Moronica* -- WIPO D2000-0405; *Manchester Airport PLC v. Club Club Limited* -- WIPO D2000-0638; *Veuve Cliquot Ponsardin v. The Polygenix Group Co.* -- WIPO D2000-00163; *Parfums Christian Dior v. Javier Garcia* -- WIPO D2000-0226
- j. Judicial decisions and statutes cited: None

- 2435. Bellsouth Intellectual Property Corporation v. Freeworld and/or Luis, Case No. D2000-1807**
- a. Date: March 14, 2001
  - b. Panelist(s): Barbara A. Solomon
  - c. Domain Name(s) at Issue: <bellsouthpages.com>
  - d. Response?: No
  - e. Principle(s):
  - f. Result: Name transfer
  - g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
  - h. Uniform Rules cited: 15
  - i. Panel Decisions cited: *Georgia Gulf Corporation v. The Ross Group*, WIPO case no. D2000-0218
  - j. Judicial decisions and statutes cited: 15 USC 1125(d)
- 2436. Bodegas y Bebidas, S.A. v. Eduardo Duro García, Case No. D2000-1815**
- a. Date: February 22, 2001
  - b. Panelist(s): Mario A. Sol Muntañola
  - c. Domain Name(s) at Issue: <bodegasybebidas.com>
  - d. Response?: No
  - e. Principle(s):
  - f. Result: Name transfer
  - g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
  - h. Uniform Rules cited: None
  - i. Panel Decisions cited: *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co*, Case No. D2000-0163
  - j. Judicial decisions and statutes cited: None
- 2437. MAHA Maschinenbau Haldenwang GmbH & Co. KG v. Deepak Rajani, Case No. D2000-1816**
- a. Date: March 2, 2001
  - b. Panelist(s): Andrea Jaeger-Lenz
  - c. Domain Name(s) at Issue: <maha.com>
  - d. Response?: Yes
  - e. Principle(s): Although the Panelist suspects that the Complainant used the administrative proceeding because it knew it would not be able to succeed under its jurisdiction, there is no real evidence that shows that Complainant's only aim was to deprive the Respondent of his domain name. In Complainant's view there may have existed reasonable scope for suspicion, so that it would be unduly harsh to characterize this complaint as Reverse Domain Name Hijacking.
  - f. Result: Decision for Respondent
  - g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c)
  - h. Uniform Rules cited: None
  - i. Panel Decisions cited: *Copart, Inc. v. SalvageNow*, Case No. D2000-0417; *LIBRO AG v. NA Global Link Limited*, WIPO Case No. D 2000-0186; *Smart Design LLC v. Hughes*, WIPO Case No. D2000-0993; *Plan Express Inc. v. Plan Express*, WIPO Case No. D2000-0565;

- j. Judicial decisions and statutes cited: None
- 2438. Banque Bruxelles Lambert S.A. and One Two Trade S.A. v. AIB and M123 Multimedia Inc., Case No. D2000-1818**
- a. Date: March 13, 2001
- b. Panelist(s): Jacques A. Léger
- c. Domain Name(s) at Issue: <12trade.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Welltec ApS v. Dave Gardner*, WIPO Case No. D2000-1145; *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Integroweb (Bahamas) Ltd*, WIPO Case No. D2000-1325; *Telstra Corporation v. Nuclear Marshmallows*, WIPO Case No. D2000-0003
- j. Judicial decisions and statutes cited: None
- 2439. Sport Chalet, Inc. v. Ski Chalet, Inc, Case No. D2000-1834**
- a. Date: April 2, 2001
- b. Panelist(s): Frederick M. Abbott
- c. Domain Name(s) at Issue: <sportchalet.net>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Educational Testing Service v. TOEFL*, Case No. D2000-0044
- j. Judicial decisions and statutes cited: 15 USCS § 1057(b); *Avery Dennison v. Sumpton*, 189 F.3d 868 (9<sup>th</sup> Cir. 1999).
- 2440. Le Grand Livre Du Mois S.A. v. Beaufort Holding Ltd., Case No. D2000-1835**
- a. Date: March 27, 2001
- b. Panelist(s): Christophe Imhoos
- c. Domain Name(s) at Issue: <legrandlivredumois.com>
- d. Response?: No
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(b)(i)-(iv), 4(c), 4(i)
- h. Uniform Rules cited: 14 (b)
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None
- 2441. Häfele America Co. v. Hafele, LLC, Case No. D2000-1839**

- a. Date: March 23, 2001
- b. Panelist(s): Timothy D. Casey
- c. Domain Name(s) at Issue: <hafele.com>
- d. Response?: Yes
- e. Principle(s):
- f. Result: Name transfer
- g. Policy cited: 4(a)(i)-(iii), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None

**2442. City of Hamina v. Paragon International Projects Ltd., Case No. D2001-001**

- a. Date: March 12, 2001
- b. Panelist(s): Gunnar Karnell
- c. Domain Name(s) at Issue: <portofhamina.com>
- d. Response?: Yes
- e. Principle(s): The Respondent has registered and uses the domain name "portofhamina.com" within a business concept of presenting under domain names of the type "portof[name of port].com" information intended for users of the respective ports or services rendered there or in connection with the ports by port authorities, servicing companies etc. The Administrative Panel considers that by materializing this business concept which, as such, has not been proven to be in disaccord with honest practices in industrial and commercial matters, the Respondent has acquired a legitimate interest in the domain name "portofhamina.com".
- f. Result: Decision for Respondent
- g. Policy cited: 4(a)(i)-(iii), 4(c), 4(i)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: *Port of Helsinki vs. Paragon International Projects Ltd.*, Case No. D2001-002
- j. Judicial decisions and statutes cited: None

**2443. Dollar Financial Group, Inc. v. MH2 & Associates, No. FA0102000096775**

- a. Date: April 3, 2001
- b. Panelist(s): James A. Carmody
- c. Domain Name(s) at Issue: <shoploanmart.com>
- d. Response?: No
- e. Principle(s):
  - 1) "The addition of 'SHOP' does not alter the underlying mark held by Complainant."
  - 2) "[I]t has been established in other UDRP proceedings that use of a confusingly similar website in connection with competing services is not a 'bona fide' use under the Policy."
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i), 4(a)(ii), 4(b), 4(b)(iii), 4(b)(iv), 4(c), 4(c)(i)-(iii)
- h. Uniform Rules cited: 5(e), 14(a), 15(a)

- i. Panel Decisions cited: *L.L. Bean, Inc. v. ShopStarNetwork*, Case No. FA 95404; *North Coast Medical, Inc. v Allegro Medical*, Case No. FA 95541; *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374; *America Online Inc. v. Shenzhen JZT Computer Software Co. Ltd*, Case No. D2000-0809; *Fossil Inc. v. NAS*, Case No. FA 92525; *Busy Body, Inc. v. Fitness Outlet, Inc.*, Case No. D2000-0127; *MathForum.com, LLC v. Weiguang Huang*, D2000-0743.
- j. Judicial decisions and statutes cited: None

**2444. Minnesota State Lottery v Bryan Mendes, No. FA0102000096701**

- a. Date: April 2, 2001
- b. Panelist(s): James P. Buchele
- c. Domain Name(s) at Issue: <mnlottery.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) Passive holding of a domain name is evidence demonstrating that Respondent has not established rights or legitimate interests in the domain name(s). “Passive holding of a domain name permits an inference of registration and use in bad faith.”
  - 2) “It has been established that when a party obtains a domain name of a well known trademark with no connection to the entity holding the mark it is evidence of bad faith.”
- f. Result: Name transfer
- g. Policy cited: 4(a), 4(a)(i)-(iii),
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Microsoft Corp. v. Montrose Corp.*, Case No. D2000-1568; *Ziegenfelder Co. v. VMH Enterprises, Inc.* Case No. D2000-0039; *Ritz-Carlton Hotel v. Club Car Executive*, Case No. D2000-0611; *DCI S.A. v. Link Commercial Corp.*, Case No. D2000-1232; *Caravan Club v. Mrgsale*, Case No. FA 95314; *Singapore Airlines Ltd v. P & P Servicios de Comunicacion S.L.*, Case No. D2000-0643.
- j. Judicial decisions cited: None

**2445. Pasadena Tournament of Roses Assn' Inc. v Wholesale Company, No. FA0102000096675**

- a. Date: April 2, 2001
- b. Panelist(s): Charles K. McCotter, Jr.
- c. Domain Name(s) at Issue: <rosebowlgame.com>
- d. Response?: Yes
- e. Principle(s):
  - 1) “The Respondent cannot avoid confusing similarity simply by deleting a generic word such as ‘the’.”
  - 2) “It is well-established that the warehousing of a famous trademark... by itself is evidence of bad faith.”
  - 3) A pattern of registering third party trademarks as domain names, and in which Respondent has no right, is evidence of bad faith.
- f. Result: Name transfer

- g. Policy cited: 4(a), 4(i)
- h. Uniform Rules cited: 15(a)
- i. Panel Decisions cited: *Marty Rodriguez Real Estate, Inc. v. Lancaster Industries*, Case No. D2000-1468; *FAO Schwarz v. Zuccarini*, Case No. FA 95828; *Nike, Inc. v. B. B. de Boer*, Case No. D2000-1397; *Ritz-Carlton Hotel v. Club Car Executive*, Case No. D2000-0611; *Flor-Jon Films, Inc. v. Larson*, Case No. FA 94974; *Ziegenfelder Co. v. VMH Enterprises, Inc.*, Case No. D2000-0039; *Telstra Corp. Ltd. v. Nuclear Marshmallows*, Case No. D2000-0003; *Yanni Management, Inc. v. Progressive Industries*, Case No. FA 95063; *MPL Communications Ltd. v. Hammerton*, Case No. FA 95633.
- j. Judicial decisions and statutes cited: None

**2446. Big O Dodge of Greenville, Inc. v. Turf Touch, Inc., No. AF-0697**

- a. Date: March 27, 2001
- b. Panelist(s): Sandra A. Sellers
- c. Domain Name(s) at Issue: <bigododge.com>
- d. Response?: No
- e. Principle(s): None
- f. Result: Name transfer
- g. Policy cited: 4(a)
- h. Uniform Rules cited: None
- i. Panel Decisions cited: None
- j. Judicial decisions and statutes cited: None