

Domain Name Dispute Proceedings and Decisions

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198936	fallwell.com	The Reverend Dr. Jerry L. Falwell and The Liberty Alliance v Lamparello International	UDRP	10/7/2003	<u>Transferred</u>	11/20/2003

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DECISION

The Reverend Dr. Jerry L. Falwell and The Liberty Alliance v. Lamparello International
Claim Number: FA0310000198936

PARTIES

Complainant is **The Reverend Dr. Jerry L. Falwell and The Liberty Alliance**, Lynchburg, VA ("Complainant") represented by **John H. Midlen, Jr. of Midlen Law Center**, 7618 Lynn Drive, Chevy Chase, MD 20815-6043. Respondent is **Lamparello International**, New York, NY ("Respondent") represented by **Paul Alan Levy**, of **Public Citizen Litigation Group**, 1600 20th Street, N.W., Washington, D.C. 20009.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<fallwell.com>**, registered with **Network Solutions, Inc.**

PANEL

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

Honorable Tyrus R. Atkinson, Jr., David E. Sorkin, and Estella S. Gold, Chair as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on October 1, 2003; the Forum received a hard copy of the Complaint on October 1, 2003.

On October 6, 2003, Network Solutions, Inc. confirmed by e-mail to the Forum that the domain name **<fallwell.com>** is registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 7, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 27, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to **postmaster@fallwell.com** by e-mail.

A timely Response was received on October 27, 2003. However, Respondent failed to provide a signature with the Response as is required pursuant to Rule 3(b)(viii).

A timely Supplemental Response to Complaint from Respondent was received on November 10, 2003, in accordance with Supplemental Rule No. 7.

All of the above-listed Complainants, Respondents and Supplements have been considered by the Panelists.

On November 6, 2003, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the Forum appointed Honorable Tyrus R. Atkinson, Jr., David E. Sorkin, and Estella S. Gold, Chair as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant alleges that it has legal rights in the name FALWELL as follows:

- a. Complainant has a registered trademark in the name "Listen America with Jerry Falwell", USPTO Reg. 2382656 which incorporates the last name of the Complainant, Falwell;
- b. Complainant has a pending mark "Jerry Falwell", USPTO Serial No. 78,202,927 which incorporates the last name of the Complainant, Falwell;
- c. Complainant published a book entitled "Falwell" in 1997, which Complainant alleges was commercially marketed under the same name as the title;
- d. Complainant commercially markets goods and services on the Web at <store.falwell.com>, as well as marketing trips to Israel and other subject matter under this personal name, Jerry Falwell.
- e. Complainant alleges secondary meaning in the name FALWELL by reciting search engine results for his own domain name <falwell.com>;
- f. Complainant alleges that the domain name registered by the Respondent, <fallwell.com> is confusingly similar to Complainant's unregistered use of his last name and portions of the registered and pending mark recited above;
- g. Complainant alleges that Respondent has no right or legitimate interests in the domain name which is phonetically identical to Complainant's domain name as well as his personal last name, and that the use of this domain name misdirects internet traffic to the Respondent by creating confusion with Complainant's marks; and
- h. Complainant alleges that <fallwell.com> is being used in bad faith because Respondent should have been aware of Complainant's trademarks and Respondent established its website out of anger with Complainant.

B. Respondent

Respondent alleges that Complainant's UDRP Complaint is without merit because Complainant

is using the UDRP to silence constitutionally protected communications.

- a. Respondent alleges that Complainant has not used his last name as a trademark because Complainant does not use his name as a commercial source;
- b. Respondent alleges that its use of the name "fallwell" is a legitimate, non-commercial or fair use of a domain name without intent for commercial gain and denies an intent to misleadingly divert consumers, or to tarnish the trademark or service mark at issue";
- c. Respondent alleges that its use of the name "fallwell" is nominative fair use in that Respondent alleges that it has a legitimate interest in using a domain name that identifies the subject of his criticism;
- d. Respondent alleges that the website <fallwell.com> contains a disclaimer which resolves any initial interest confusion, and in addition, provides a link to Complainant's website to avoid consumer confusion;
- e. Respondent alleges that the book entitled "Falwell" is no longer in print, and therefore, is not commercially active; and
- f. Respondent alleges that the domain name is not a typosquat, but a parody on the words "fall" and "well".

FINDINGS

Preliminary Procedural Matters

The Panelists unanimously find on preliminary matters as follows:

1. That although the Response did not include a signature, as required under Rule 5(b)(viii), the Panel rules that the Response is admissible despite formal deficiencies because to find otherwise would be inconsistent with basic principles of due process. See *Strum v. Nordic Net Exch. AB*, FA 102843 (Nat. Arb. Forum Feb. 21, 2002).
2. That Respondent's contentions of forum shopping and the case being time barred are without merit under the Policy.
3. That Complainant's supplemental pleadings should be accepted and were reviewed.

While most facts in this matter are undisputed, the majority on the Panel finds the following on the disputed facts:

1. Complainant has made commercial use of his last name "Falwell" as an unregistered mark in the marketing of the book "Falwell: An Autobiography" at least as early as 1997, as well as more recently, in the use of a commercial website.
2. The name "fallwell" is phonetically identical to Complainant's last name, which Complainant has used as a trademark in the marketing of copyrighted material.
3. It is undisputed that Complainant has achieved the highest level access on commonly used search engines on the Web, and the majority of the Panel finds that such search engine access amounts to secondary meaning as defined by the Lanham Act.

4. Although Respondent alleges that “fallwell” represents the joining of the word “fall” and the word “well”, Respondent’s acknowledgement through the use of its disclaimer of the likelihood of misdirected Internet traffic, leads the majority of the Panel to conclude that use of the domain name <fallwell.com> will result in initial interest confusion.
5. Based upon the presentation of evidence from <web.archive.org>, the Panel finds that Respondent did not begin to use the website associated with <fallwell.com> until 1999, some two years after Complainant initiated commercial use of his last name as a trademark.

DISCUSSION

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

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

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

Identical and/or Confusingly Similar

The Panel finds a strong similarity to Complainant’s position in the case of *Planned Parenthood Assn. of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997), *aff’d* without op., 152 F.3d 920 (2d Cir. 1998). The Court found in *Planned Parenthood* that when a domain name is used on a website that promotes or preaches social, religious, or political beliefs, the Lanham Act would not be triggered unless there is some provision of services or commercial aspect to the website. The 1997 *Planned Parenthood* case was the first time that a court directly faced the issue of finding a commercial use when an otherwise infringing domain name is used on a political or religious website. Defendant in that matter was a religious talk show host who vigorously espoused the right-to-life position. Defendant admitted in that case that his purpose was to intercept potential viewers of plaintiff’s website and expose them to the right-to-life message of the book featured at the site. On appeal, the Second Circuit noted that while the prohibitions of the Lanham Act §43 (a) are limited to “commercial” activities, the prohibition of §32(1)(a) on infringements of registered marks has no such “commercial activity” requirement. See *United We Stand Am., Inc. v. United We Stand Am., N.Y., Inc.*, 128 F.3d 86, 44 U.S.P.Q.2d 1351(2d Cir. 1997); see also *Jesus for Jesus v. Brodsky*, 993 F.Supp. 282, 46 U.S.P.Q.2d 1652(D.N.J. 1998), *aff’d* without op. 159 F.3d 1351 (3d Cir. 1998) (where the court held that the defendant intended to intercept, through the use of deceit and trickery, the audience sought by the plaintiff organization).

Respondent, understanding that users of the Internet were likely to be deceived into believing that <fallwell.com> was associated with Complainant or who misspelled Complainant’s name, posted a disclaimer to redirect Internet traffic intended for the Complainant. In *People for Ethical Treatment of Animals, Inc. v. Doughney*, 113 F.Supp.2d 915 (E.D. Va. 2000) Judgment *aff’d* 263 F.3d 359, 60

U.S.P.Q.2d 1009, 1112 (4th Cir. 2001), the district court found that the challenged domain name was likely to prevent Internet users from reaching PETA's own website because if they mistakenly access defendant's website, they may "fail to continue to search for [PETA's] own home page due to anger, frustration, or the belief that [PETA's] homepage does not exist." Furthermore, Respondent acknowledges his motivation in his anti-Falwell message, expressing anger in response to the content of Complainant's site.

Complainant asserts that it has established rights in the JERRY FALWELL mark by filing an application with the U.S. Patent and Trademark Office ("USPTO") on January 13, 2003 (Ser. No. 78202927). See *SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that Complainant's trademark or service mark be registered by a government authority or agency for such rights to exist. Rights in the mark can be established by pending trademark applications).

Complainant contends that it has established rights in the LISTEN AMERICA WITH JERRY FALWELL mark through its registration with the USPTO on September 5, 2000 (Reg. No. 2382656). Complainant further alleges that it has established common law rights in the mark by using the mark in commerce since April 13, 1998. See *Men's Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning"); see also *Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000) (finding that trademark registration was not necessary and that the name "Julia Roberts" has sufficient secondary association with Complainant that common law trademark rights exist); see also *Jagger v. Hammerton*, FA 95261 (Nat. Arb. Forum Sept. 11, 2000) (Complainant held common law trademark rights in his famous name MICK JAGGER).

Complainant argues that it has established common law rights in the JERRY FALWELL and FALWELL marks because Complainant published a book for sale in 1997 called "Falwell, An Autobiography." Complainant has provided articles from newspapers to prove that Complainant is referred to as FALWELL. See *Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established); see also *BroadcastAmerica.com, Inc. v. Quo*, DTV2000-0001 (WIPO Oct. 4, 2000) (finding that Complainant has common law rights in BROADCASTAMERICA.COM, given extensive use of that mark to identify Complainant as the source of broadcast services over the Internet, and evidence that there is wide recognition with the BROADCASTAMERICA.COM mark among Internet users as to the source of broadcast services).

Furthermore, Complainant asserts that the <fallwell.com> domain name is confusingly similar to each of the marks discussed above because the domain name merely misspells the FALWELL mark by adding the letter "l" to the mark, which is a common typographical error committed by Internet users who attempt to access Complainant's <falwell.com> website. See *Victoria's Secret v. Zuccarini*, FA 95762 (Nat. Arb. Forum Nov. 18, 2000) (finding that, by misspelling words and adding letters to words, a Respondent does not create a distinct mark but nevertheless renders the domain name confusingly similar to Complainant's marks); see also *Hewlett-Packard Co. v. Zuccarini*, FA 94454 (Nat. Arb. Forum May 30, 2000) (finding the domain name <hewlitpackard.com> to be identical or confusingly similar to Complainant's HEWLETT-PACKARD mark).

Also, Complainant claims that the <fallwell.com> domain name is confusingly similar to Complainant's mark because the domain name is phonetically identical to the FALWELL mark. See *Hewlett-Packard Co. v. Cupcake City*, FA 93562 (Nat. Arb. Forum Apr. 7, 2000) (finding that a

domain name which is phonetically identical to Complainant's mark satisfies ¶ 4(a)(i) of the Policy); *see also* *YAHOO!, Inc. v. Murray*, D2000-1013 (WIPO Nov. 17, 2000) (finding that the domain name <yawho.com> is confusingly similar to Complainant's YAHOO mark).

Lastly, Complainant asserts that Respondent's disclaimer on its website is insufficient to prevent Internet user confusion because it causes "initial interest confusion," and therefore cannot circumvent the Panel from finding the domain name confusingly similar to Complainant's mark. *See AltaVista Co. v. AltaVista*, FA 95480 (Nat. Arb. Forum Oct. 31, 2000) (finding that since a disclaimer does not, and could not, accompany the domain name, then the "domain name attracts the consumer's initial interest and the consumer is misdirected long before he/she has the opportunity to see the disclaimer"); *see also DaimlerChrysler Corp. v. Bargman*, D2000-0222 (WIPO May 29, 2000) (finding that addition of a disclaimer, when the domain name consists of Complainant's well-known trademark, does not counter the expectation of Internet users that the domain name is sponsored by Complainant).

Rights or Legitimate Interests

Complainant asserts that Respondent is not commonly known by the <fallwell.com> domain name or the FALLWELL mark, and therefore lacks rights and legitimate interests in the domain name pursuant to Policy ¶ 4(c)(ii). *See Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where Respondent was not commonly known by the mark and never applied for a license or permission from Complainant to use the trademarked name); *see also Broadcom Corp. v. Intellifone Corp.*, FA 96356 (Nat. Arb. Forum Feb. 5, 2001) (finding no rights or legitimate interests because Respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use).

Also, Complainant asserts that Respondent's domain name is misleading and is being used for commercial gain. The Panel determines that the <fallwell.com> domain name is misleading and is being used to defeat Complainant's commercial benefit, in its mark. The Panel concludes that Respondent lacks rights or legitimate interests in the domain name because such use does not constitute a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i).

In addition, Complainant contends that Respondent's free speech conducted under Complainant's protected mark does not create rights or legitimate interests with respect to the domain name. Complainant argues that Respondent's use of the <fallwell.com> domain name does not constitute a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See Weekley Homes, L.P. v. Fix My House Or Else?*, FA 96609 (Nat. Arb. Forum Apr. 18, 2001) (finding that establishment of a website containing criticism is not a legitimate use of the <davidweekleyhome.com> domain name because the disputed domain name is confusingly similar to Complainant's DAVID WEEKLEY HOMES mark); *see also Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) (holding that Respondent's showing that it "has a right to free speech and a legitimate interest in criticizing the activities of organizations like the Complainant . . . is a very different thing from having a right or legitimate interest in respect of [a domain name that is virtually identical to Complainant's mark]").

Registration and Use in Bad Faith

Complainant asserts that Respondent's admission that it registered the <fallwell.com> domain name out of anger toward Complainant is evidence of bad faith. The Panel may find that the admission is evidence that Respondent knowingly registered the domain name with the intent to

infringe on Complainant's mark, and therefore registered the domain name in bad faith. See *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration); see also *Ty Inc. v. Parvin*, D2000-0688 (WIPO Nov. 9, 2000) (finding that Respondent's registration and use of an identical and/or confusingly similar domain name was in bad faith where Complainant's BEANIE BABIES mark was famous and Respondent should have been aware of it); see also *McClatchy Mgmt. Servs., Inc. v. Please DON'T Kill Your Baby*, FA 153541 (Nat. Arb. Forum May 28, 2003) (By intentionally taking advantage of the goodwill surrounding Complainant's mark to further its own political agenda, Respondent registered the disputed domain names in bad faith").

In addition, Complainant asserts that Respondent is using the <fallwell.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) because the domain name competes with Complainant's <falwell.com> website for Internet traffic. See *Mission KwaSizabantu v. Rost*, D2000-0279 (WIPO June 7, 2000) (defining "competitor" as "one who acts in opposition to another and the context does not imply or demand any restricted meaning such as commercial or business competitor"); see also *Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) (stating that although Respondent's complaint website did not compete with Complainant or earn commercial gain, Respondent's appropriation of Complainant's trademark with a view to cause "damage and disruption to [Complainant] cannot be right, still less where the use of the Domain Name will trick internet users intending to visit the trademark owner's site into visiting the registrant's site" in holding that the disputed domain name was registered in bad faith).

The majority of the Panel finds that Respondent has engaged in typosquatting by registering and using the <fallwell.com> domain name to redirect Internet users to Respondent's website by taking advantage of Internet users who commit common typographical errors when they attempt to access Complainant's <falwell.com> website. Typosquatting is evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii). See *Nat'l Ass'n of Prof'l Baseball Leagues, Inc. v. Zuccarini*, D2002-1011 (WIPO Jan. 21, 2003) ("Typosquatting ... is the intentional misspelling of words with intent to intercept and siphon off traffic from its intended destination, by preying on Internauts who make common typing errors. Typosquatting is inherently parasitic and of itself evidence of bad faith"); see also *Black & Decker Corp. v. Khan*, FA 137223 (Nat. Arb. Forum Feb. 3, 2003) (finding the <wwdewalt.com> domain name was registered to "ensnare those individuals who forget to type the period after the "www" portion of [a] web-address," evidence that the domain name was registered and used in bad faith).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be GRANTED.

Accordingly, it is Ordered that the <fallwell.com> domain name be TRANSFERRED from Respondent to Complainant.

Estella S. Gold, Panelist
Signing for the Majority
Honorable Tyrus R. Atkinson, Jr., Panelist
Dated: November 20, 2003

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DISSENTING OPINION

I respectfully dissent.

Respondent selected the disputed domain name because of its similarity to the name of a controversial public figure whom Respondent intended to criticize, and is using it for that purpose. The fact that Complainants have some trademark rights in various forms of Dr. Falwell's name is merely incidental. Respondent is using a variant of Dr. Falwell's name in a nominative sense in order to identify him as the focus of a noncommercial web site; Respondent is neither trading on Dr. Falwell's fame nor exploiting the value of his name, as a trademark or otherwise. Respondent's registration and use of the disputed domain name, therefore, cannot be said to be in bad faith.

Furthermore, in my view Complainants have also failed to meet their burden of proof on the question of rights or legitimate interests. At best Complainants have a legitimate dispute with Respondent regarding its right to use a variant of Dr. Falwell's name as a domain name for purposes of criticism—but much more likely, Complainants have no actionable claim whatsoever against Respondent. In either case, this is not an appropriate matter for resolution under the UDRP, which was designed to handle only a “relatively narrow class of cases of ‘abusive registrations.’” *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* (Oct. 24, 1999), <<http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm>>, ¶ 4.1(c).

[T]he fact that the policy's administrative dispute-resolution procedure does not extend to cases where a registered domain name is subject to a legitimate dispute (and may ultimately be found to violate the challenger's trademark) is a feature of the policy, not a flaw. The policy relegates all “legitimate” disputes—such as those where both disputants had longstanding trademark rights in the name when it was registered as a domain name—to the courts; only cases of abusive registrations are intended to be subject to the streamlined administrative dispute-resolution procedure.

Id.

I would dismiss the Complaint.

David E. Sorkin, Panelist
November 20, 2003

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Case Details for WIPO Case D2001-0376

WIPO Case Summary

WIPO Case Number	D2001-0376
DDomain name(s)	cogema.org
Complainant	Compagnie Générale des Matières Nucleaires (COGEMA)
Respondent	Greenpeace International
Panelist	Willoughby, Tony
Decision Date	17-May-2001
Decision	<u>Transfer</u>

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WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Compagnie Generale des Matieres Nucleaires v. Greenpeace International

Case No. D2001-0376

1. The Parties

The Complainant is Compagnie Generale des Matieres Nucleaires, 2, rue Paul Dautier, BP 4, 78141 VELIZY Cedex, France.

The Respondent is Greenpeace International, Keizersgracht 176, 1016 DW.. Amsterdam, Netherlands.

2. The Domain Name and Registrar

The Domain Name is <cogema.org>.

The Registrar is <Gandi>.

3. Procedural History

The Complaint was received by WIPO by email on March 15, 2001, and in hardcopy form on March 16, 2001. WIPO has verified that the Complaint satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules and that payment was properly made. The Administrative Panel ("the Panel") is satisfied that this is the case.

The Complaint was properly notified in accordance with the Rules, paragraph 2(a). The Registrar, Gandi, has confirmed that "cogema.org" ("the Domain Name") is registered with it in the name of Greenpeace International ("the Respondent"). The Registrar has further confirmed that the Policy is applicable to the Domain Name.

On March 26, 2001, WIPO notified the Respondent of the Complaint in the usual manner and informed the Respondent *inter alia* that the last day for sending its Response to the Complainant and to WIPO was April 14, 2001.

On April 2, 2001, the Respondent responded with a document entitled "Respondent's Preliminary Motions" in which it requested (a) a non-French national as panelist (on the basis that it has the right to a fair hearing), (b) the removal from the Complaint of two passages, one reading "the alleged fame and/or notoriety of the alleged trade mark COGEMA" and the other reading "...[t]he systematic demonstrations, accusations, and actions that the Respondent performed against the company [i.e. Complainant] ..." (on the grounds that those passages are "irrelevant and/or otherwise prejudicial", (c) an order that the Complainant number the paragraphs of the Complaint "properly" (to enable the Respondent more readily to answer each and every allegation point by point) and (d) an extension of time for filing the Response.

WIPO responded on April 3, 2001, stating that, because the Center was not in a position to accept Respondent's motions, the extension could not be granted. The rest of the matters were left to the Panel to deal with.

On April 12, 2001, the Response was received by WIPO. On April 26, 2001, the Complainant lodged with WIPO a document entitled "Observations Regarding the Response of Greenpeace International"

The Panel was properly constituted. The undersigned Panelist submitted a Statement of Acceptance and a Declaration of Impartiality and Independence.

No further submissions were received by WIPO or the Panel, as a consequence of which the date scheduled for the issuance of the Panel's Decision, is May 15, 2001.

4. Factual Background

The Complainant is a French based company engaged in the nuclear fuel industry, which operates under the acronym COGEMA. Its website is at <www.cogema.fr>

The Respondent is the governing body of the worldwide Greenpeace environmental movement.

The Respondent registered the Domain Name on or about July 4, 2000.

On December 22, 2000, the Complainant (through its attorney) wrote to the Respondent drawing the Respondent's attention to its trade mark rights and demanding transfer of the Domain Name. On February 1, 2001, not having received a reply, the Complainant's attorney wrote to the Respondent informing the Respondent that it proposed to launch this Complaint. On February 12, 2001, the Respondent replied, explaining the delay. The letter continued as follows:

"Please be informed that as a campaigning organisation Greenpeace reserves the right to engage in freedom of expression on the internet on matters of public interest in particular those matters which affect the environment. As you are aware, your client, Cogema, as a nuclear reprocessing company, is responsible for discharging radioactive waste into the North Sea.

For these reasons, Greenpeace has reserved the domain name "cogema.org" in order to engage in legitimate and peaceful protest on the internet. Considering the growing success Greenpeace has had in engaging dialogue on our own website regarding the campaign to stop nuclear processing, we may be willing to discuss terms under which we would transfer the "cogema.org" domain name site to your client. If you would be interested in this matter, in particular before the ICANN arbitration process, we would be most obliged."

5. Parties' Contentions

A. The Complainant's contentions are as they appear in the following extracts from the Complaint:

The complaint is based on :

- the well-known trade name COGEMA of the Complainant.

- the sixty-eight (68) notorious trademarks "COGEMA" filed, registered and used all over the world, in no less than 26 countries :

These trademarks are enjoying repute, insofar as they have been used since 1992 at least and are subject to wide advertising campaigns in the entire world. The trademark COGEMA is the house mark of the Complainant.

The factual and legal grounds on which the complaint is made are the following :

(1) The Domain Name is identical to the famous trade name COGEMA of the Complainant and to the 68 notorious trademarks COGEMA filed, registered and used all over the world by the Complainant.

(2) It is obvious that the Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant and the Respondent have no legal link between them (subsidiary, successors, assigns, licensees...) and the Complainant has never given any authorization to the Respondent to register the Domain Name. On the contrary, the only link existing between the Respondent and the denomination and trademarks COGEMA is the systematic denigrations, accusations, and actions that the Respondent performed against the company bearing this name and the trademarks of the latter.

(3) The Domain Name must be considered as having been registered and used in bad faith :

It is internationally known that the Complainant and the Respondent have permanently been in conflict, GREENPEACE INTERNATIONAL multiplying political, legal or even physical actions and harassments against the company COMPAGNIE GENERALE DES MATIERES NUCLEAIRES (COGEMA) for the purpose of blocking the activities of the latter.

The press articles annexed to the Complaint show very clearly that GREENPEACE INTERNATIONAL is systematically opposing the activities of COMPAGNIE GENERALE DES MATIERES NUCLEAIRES (COGEMA) and trying to ruin the reputation of COGEMA. These statements make it abundantly clear that the Domain Name was adopted with full knowledge of the Complainant's well-known COGEMA trade name and trademarks, and in bad faith.

Such articles as " *French police forcibly remove GREENPEACE protestors after 20-hour against COGEMA's nuclear waste dumping into the ocean* " or " *GREENPEACE accuses COGEMA of robbery* ", " *GREENPEACE reaffirms danger of COGEMA's particle discharges and launches new complaint* ", " *GREENPEACE finds evidence of illegal radioactive discharges by COGEMA* " are few examples of many of the controversies existing between the Complainant and the Respondent.

The registration of the Domain Name by such an aggressive opponent to the Complainant is, as such, a sufficient element to prove the bad faith of the Respondent. Indeed, this registration by GREENPEACE INTERNATIONAL of the Domain Name is evidently intended :

- to prevent the Complainant from reflecting its trade name, and its 68 trademarks COGEMA in a corresponding domain name and more generally to obstruct the general advertisement policy of the Complainant ;

- to disrupt the business of the Complainant ;

- to reserve the possibility of damaging the reputation of the Complainant by broadcasting denigrating information to the public and customers who intended and believed to access to the web site owned by COGEMA ;

Of course, the Respondent did not use, or make demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services, presumably for avoiding a trademark infringement action.

On the contrary, the Respondent has always quoted the denomination and trademarks COGEMA for the purpose of criticizing the Complainant, its business and activities.

Actually, the Domain Name registrant has been commonly known by the denomination COGEMA, but only for its actions against it.

Therefore, the Domain Name registrant is obviously making an illegitimate non-commercial and unfair use of the Domain Name, with a real intent to tarnish the trade name and the 68 trademarks at issue.

In the light of the above considerations, it is obvious that the Domain Name has been registered in bad faith.

Concerning the concept of "use in bad faith" of a domain name, we refer to the following decisions of the center :

Case No. D2000-0003 re <telstra.org>, per Andrew F. Christie ;

Case No. D2000-0055 re <guerlain.net>, per Anna Carabelli ;

Case No. D2000-0098 re <babydior.com>, babydior.net>, per François Dessemontet.

Case No. D2000-1407 re <ctv.com>, per Howard P. Knopf ;

Case No. D2000-1589 re <tf1.net>, per Isabelle Leroux ;

[The Complaint contains extensive quotes from some of those cases. In the view of the Panel, the point the Complainant seeks to make is sufficiently clear from the following extract from decision D2000 –0055]

"In other words, "the requirement of paragraph 4a(iii) that the domain name has been registered and is being used in bad faith will be satisfied only if the Complainant proves that the registration was undertaken in bad faith and that the circumstances of the case are such as that Respondent is continuing to act in bad faith" (Case No. D2000-0003).

However, this does not necessarily imply that the respondent is undertaking a positive action in bad faith in relation to the domain name. The concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept, as supported by the actual provision of paragraph 4(b) of the Policy. As a matter of fact, only one of the circumstances identified in paragraph 4(b) as "evidence of the registration and use of a domain name in bad faith" by necessity involves a positive action post registration undertaken in relation to the domain name (paragraph 4(b)(iv)) while the other three circumstances contemplate either a positive action or inaction in relation to the domain name (paragraphs 4(b)(i), (ii), (iii)). Of course, these three circumstances require additional facts (an intention to sell, rent or transfer the registration - paragraph 4(b)(i); a pattern of conduct preventing a trade mark owner's use of the registration - paragraph 4(b)(ii); the primary purpose of disrupting the business of a competitor - paragraph 4(b)(iii))."

We believe that in this case the following particular circumstances have to be taken into consideration and will lead the Panel to consider that the Domain Name is used in bad faith :

- the Complainant's trade name and trademarks are widely well known and have a strong reputation ;
- the Respondent has provided no evidence of nor alleged any actual or contemplated good faith use of the Domain Name ;
- in addition to the Domain Name at issue, Respondent owns at least one other domain name which is easily recognizable as a domain name consisting of the corporate name and trade name of another company working in the nuclear field and against GREENPEACE INTERNATIONAL acts very often in the same way it does with the COGEMA company. Indeed, GREENPEACE INTERNATIONAL registered the domain name <britishnuclearfuels.com>, reproducing the notorious corporate name and trade name of the company of the same name (abbreviated as BNFL).
- Moreover, as can be seen from the correspondence exchanged between the Complainant and the Respondent, in particular the response sent by GREENPEACE INTERNATIONAL to the lawyer of the Complainant, the Respondent expressly declared that the reason for the registration of the Domain Name consists in GREENPEACE INTERNATIONAL's reproaches to the COGEMA company : *"For those reasons, Greenpeace has reserved the domain name "cogema.org" in order to engage in legitimate and peaceful protest on the Internet. Considering the growing success Greenpeace has had in engaging dialog on our own website regarding the campaign to stop nuclear reprocessing, we may willing to discuss terms under which we would transfer the "cogema.org" domain name site to your client."* [emphasis added]

GREENPEACE INTERNATIONAL has registered willingly the Domain Name in view of requiring from the Complainant a consideration for transfer.

In other terms, the Domain Name has been registered by the Respondent in order to impose something to the Complainant.

Besides, the potential threat to create a web site www.cogema.org dedicated to criticize COGEMA or an hyperlink from www.cogema.org to the web site of GREENPEACE INTERNATIONAL for the purpose of confusing customers of the Complainant and tarnishing the reputation of it is implicitly comprised in this letter.

Conclusion

For all the foregoing reasons, we request the Panel to decide :

- To find that the Domain Name is identical or confusingly similar to the corporate name, trade name and the trademarks in which the Complainant has rights,
- To find that the Respondent has no right or legitimate interest in respect of the Domain Name,
- To find that the Domain Name has been registered and is being used in bad faith.

Accordingly, pursuant to Paragraph 4 of the Policy, we request the Panel to order that the registration of the Domain Name be transferred to the Complainant.

B. The Respondent's contentions are substantially as follows, being in the main verbatim extracts from the Response.

The Respondent repeats its preliminary objections to the Complaint, in particular,

- the unorthodox system of paragraph numbering resulting, in some instances, in the failure to accord numbers to several paragraphs (making it difficult properly to plead to the Complaint)
- the gratuitously inflammatory (and therefore irrelevant and/or otherwise prejudicial) statements contained in the Complaint

- averments concerning the alleged fame and/or notoriety of Complainant's alleged trade name and/or trade mark, such averments being irrelevant and/or otherwise prejudicial (and therefore lacking any probative value).

The Respondent is unable to admit or deny the alleged fame and/or notoriety of the alleged trade name and/or trade mark COGEMA. Further or alternatively, if, which is neither admitted nor denied, the alleged trade name and/or trade mark COGEMA is either well-known or notorious, the same is irrelevant and/or otherwise prejudicial. If, which is neither admitted nor denied, the trade name and/or trade mark COGEMA is the "house mark" of Complainant, whether as alleged or at all, the same is irrelevant.

The second unnumbered paragraph of paragraph [12.] at page 8 of the Complaint [concerning the Complainant's advertising] is not understood and Respondent hereby requests further and better particulars of the same.

The Respondent is unable to admit or deny the alleged fame of the trade mark COGEMA. The Respondent is unable to admit or deny the registration status of the trade mark COGEMA and denies that the Domain Name is identical to the alleged trade name and/or trade mark COGEMA. It is averred that the Domain Name is similar (though not identical) to the said trade name and/or trade mark.

It is specifically denied that Respondent has no legitimate interest in the Domain Name (for the reasons set forth below). The Respondent objects to the unnumbered paragraph in the Complaint reading "On the contrary, the only link existing between the Respondent and the denomination and trademarks COGEMA is the systematic denigrations, accusations, and actions that the Respondent performed against the company bearing this name and the trademarks of the latter" as being unnecessarily inflammatory, irrelevant and/or otherwise prejudicial.

Paragraph [12.] (3) at page 9 of the Complaint [the section of the Complaint quoted at A above and relating some of the history of the hostility between the parties] is embarrassing. Further, the same is inflammatory, irrelevant and/or otherwise prejudicial. Without prejudice to the generality of the foregoing, it is admitted that Respondent is opposed to nuclear power processing and testing.

As to the final (unnumbered) paragraph of paragraph [12.] (3) of the Complaint [the section quoted at A above wherein the Complainant asserts what were the Respondent's intentions when registering the Domain Name] it is specifically denied that the facts and matters pleaded are sufficient to prove the "bad faith" of Respondent. Without prejudice to the generality of the foregoing denial, and by way of explanation, Respondent is the international governing body of the worldwide Greenpeace environmental movement. As a campaigning organisation, Respondent's primary aim is to raise public awareness of ecological degradation in order to bring about lasting environmental protection. To achieve this aim Respondent relies on the ability to engage in innovative public campaigning through, for example, the active dissemination of information via the Internet. Internet based campaigns are, it is submitted, protected expression under the European Convention on Human Rights and Fundamental Freedoms, Article 10. Respondent reserved the Domain Name site in order to engage the public on the issue of nuclear processing. Complainant's reprocessing plant at La Hague is responsible for unacceptable levels of radioactive discharge directly into the North Sea. Further, Complainant, in accepting reprocessing contracts from overseas countries, is responsible for the shipment of nuclear waste and plutonium fuel globally. Respondent believes that this puts the global environment at unnecessary risk of a nuclear accident at sea. Further, Complainant, through its website, COGEMA.fr, fails to inform visitors and potential visitors to its website of its reprocessing activities and the resulting impact on the environment. This, it is averred, creates an information asymmetry, which Respondent seeks to redress.

The Domain Name was not registered for any purpose specified or enumerated at paragraph 4.(b.)(i) of Uniform Domain Name Dispute Resolution Policy and Complainant has adduced no evidence in support thereof.

The Domain Name was not registered for any purpose specified or enumerated at paragraph 4.(b.) (ii) of the Policy and, without prejudice to the generality of the foregoing, Complainant has failed to adduce any evidence that Respondent has "engaged in a pattern of such conduct... ."

The Domain Name was not registered for any purpose specified or enumerated at paragraph 4.(b.) (iii) of the Policy. The Domain Name was registered in order to further debate on matters of grave public concern, namely, the environmental effects of nuclear power processing and testing.

It is specifically denied that the Domain Name was registered for commercial gain, whether as alleged or at all, in contravention of or otherwise falling within the prohibition of paragraph 4. (b.) (iv) of the Policy. Further, Complainant has failed to adduce any evidence in support of its allegation that the said domain name was registered for commercial gain. Respondent joins, in this regard, with Complainant when it states in the Complaint that the said domain name was registered "for the purpose of criticizing the Complainant, its business and activities."

The Respondent is unable and does not plead to the case law cited by the Complainant. The case law of the Provider is not uniform and the case selected by Complainant is but one of a number of decisions rendered by the Provider. Further, and without prejudice to the foregoing, the case selected by Complainant is dissimilar from the present Complaint in a number of fundamental respects, including (i) Respondent in that case engaged in a pattern of such conduct (having registered 24 domain names) and (ii) Complainant has adduced no evidence to show that Respondent registers domain names in order to sell them for profit.

As to the paragraph of the Complaint dealing with the Respondent's registration of the domain name britishnuclearfuels.com, if, which is denied, the same be relevant (i) Respondent has not as at the date hereof made any use whatever of the domain name BRITISHNUCLEARFUELS.com (ii) the company, British Nuclear Fuels Limited, has not instituted or threatened to institute any legal or administrative proceedings in respect of the registration of the said domain name, BRITISHNUCLEARFUELS.com (iii) Respondent registered the said domain name in order to further debate on matters of grave public concern, namely, the environmental effects of nuclear power processing and testing.

The Domain Name has not as at the date of the Complaint herein been put to use by Respondent.

The Domain Name has not been offered for sale.

The Respondent does not and does not intend to supply any goods or services under the Domain Name. Respondent is a not-for-profit registered charity.

The Domain Name was registered for the purpose of furthering debate on matters of grave public concern, namely, the environmental effects of nuclear power processing and testing. In the premises, the use to which Respondent intended to put the Domain Name was a non-commercial, and therefore fair or referential, use. It is not every use of a trade name or trade mark, whether authorized or unauthorized, which infringes upon that trade mark. Examples include parodic and other referential uses. This is particularly so where the trade mark at issue is used for non-commercial purposes.

Further or alternatively, the use to which Respondent intended to put the Domain Name is protected speech or expression under The European Convention on Human Rights and Fundamental Freedoms, Article 10.

Further or alternatively, the Complaint herein is a barely veiled attempt (in the guise of intellectual property rights) to chill free speech on matters of grave public concern.

The Provider is respectfully requested to dismiss the Complaint herein.

C. The Complainant's contentions (supplemental filing) are as follows:

Concerning the paragraphs of the Response, which respectively point out that "*Respondent reserved the said domain name site in order to engage the public on the issue of nuclear reprocessing*" and "*Respondent registered the said domain name in order to further debate on matters of grave public concern, namely, the environmental effects of nuclear power processing and testing*", this sentence constitutes an admission that GREENPEACE INTERNATIONAL may create a web site or an hyper-link towards its web-site www.greenpeace.org for the purpose of misleading Internet users intending to access COGEMA site and

directing them to a site criticizing the Complainant and consequently disturbing the activity of COGEMA.

Concerning the paragraph of the Response in which the Complainant asserts that the use to which intended to put the Domain Name is protected under the European Convention on Human Rights, the Respondent holds its own domain name and web site www.greenpeace.org where it can exert its right of free speech and can freely "*debate on matters of grave public concern*".

The exercise of protected speech or expression under article 10 of The European Convention on Human Rights and Fundamental Freedoms is clearly possible without confiscating the property of someone else.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interest in respect of the Domain Name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

Procedural Issues

As to the Respondent's Preliminary Motions:

- (a) the first has been acceded to in that the Panel is not a French national;
- (b) the second is denied on the basis that the passages in question are irrelevant. For the record, the Panel derived no value from the first passage and very little from the second, which merely seemed to confirm the impression derived from the press comment and press releases exhibited to the Complaint that there is a regular and continuing state of conflict between the parties;
- (c) the third, as to the paragraph numbering of the Complaint, which raises a point with which the Panel has much sympathy, is now to all intents and purposes a 'dead' issue, the Respondent having found a satisfactory way of overcoming the problem;
- (d) the fourth, the request for an extension of time, was dealt with by WIPO and the Panel does not believe that the Respondent has suffered in any way from WIPO's refusal of the extension.

As to certain comments in the Response indicating that the Respondent has not understood a pleading in the Complaint or requires further particulars of a pleading in order to respond to it, the matters to which they pertain are immaterial to the issues which the Panel has to address and the Panel sees no need for any further filings.

As to the supplemental filing of the Complainant the Panel has read it and sees no point in refusing to allow it into the record. It is argumentative and adds nothing to the substance of the Complaint.

Identical or confusing similarity

The Domain Name comprises two elements, namely 'cogema', which is the Complainant's name and trademark, and '.org', which is generic. Clearly, whether or not one disregards the '.org' element of the Domain Name, it is either identical to or confusingly similar to the Complainant's name.

The Panel observes that the Complainant failed to exhibit any trade mark registration certificate to provide conclusive proof of its trade mark rights. It relied upon exhibiting its internal records. Perhaps it was for this reason that the Respondent failed to admit the existence of the registered rights. The course that the Complainant took is a risky one. It is not a course that the Panel recommends Complainants to take, but, here, the Panel has no reason to doubt that the registrations claimed for the mark do in fact exist and, in any event, the material exhibited to show how the Complainant trades demonstrates to the satisfaction of the Panel that the Complainant has unregistered rights in the name.

The Panel finds that the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

Rights or legitimate interest of the Respondent

Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purpose of this sub paragraph, however, it is sufficient for the Complainant to show a prima facie case and the burden of proof is then shifted on to the shoulders of the Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interest in respect of the domain name in question.

The Complainant's name and principal trademark, COGEMA, is a well-known name in its field of operation exclusively associated with the Complainant and its services/products. Significantly, it is well-known to the Respondent as being the Complainant's name and trade mark. The Domain Name is essentially the Complainant's name and principal trademark.

There is no reason obvious to the Panel why the Respondent might have a right or legitimate interest in respect of the Domain Name. The Panel has no evidence before it to suggest any reason why the Respondent might have any rights or legitimate interests in respect of the Domain Name. The relevant passage in the Response reads "it is specifically denied that Respondent has no legitimate interest in the said domain name (for the reasons set forth below)", but nothing that follows has any bearing on this issue.

The Response proceeds to show why the Respondent has a right to free speech and a legitimate interest in criticizing the activities of organizations like the Complainant, but that is a very different thing from having a right or legitimate interest in respect of the Domain Name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Bad Faith

Paragraph 4(b) of the Policy sets out four non-exclusive criteria, which shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b)(i) concerns acquisition of the Domain Name in order to sell it, but the only evidence that the Respondent may be prepared to release it to the Complainant (the Respondent's letter of February 12, 2001 quoted above) relates to the Respondent's recent realization that the Domain Name may be surplus to requirements. The Panel is satisfied that the Domain Name was not registered with a view to it being sold to the Complainant. Paragraph 4(b)(ii) concerns acquisition for the purpose of blocking the Complainant, provided that the Respondent has engaged in a pattern of such conduct. Notwithstanding the evidence of a pattern of conduct, namely the Respondent's registration of <britishnuclearfuels.com>, the Panel accepts the Respondent's denial that this was the reason for registering it. Paragraph 4(b)(iii) involves disruption of the business of a competitor, but the Respondent is not a competitor of the Complainant. Paragraph 4(b)(iv) involves use of the Domain Name for commercial gain for the purpose of attracting visitors to the Respondent's online location in the mistaken belief that they are visiting a location of or associated with the Complainant. Arguably that cannot apply to the Respondent because it is a non-profit making charitable organization.

However, paragraph 4(b) does not comprise an exhaustive list of the circumstances, which shall constitute evidence of registration and use in bad faith.

In assessing 'bad faith' for the purpose of the Policy, the motivation of the Complainant is all-important. In this case, the motivation is clear. As the Complainant claims in one part of the Complaint and as the Respondent expressly admits in the Response, the Domain Name "was registered for the purpose of criticizing the Complainant, its business and activities." The Panel accepts that that was the Respondent's intention. In so saying, it is also clearly the case that, as the Respondent stated in its letter of February 12, 2001, an important aim of the campaign in which the Domain Name was to be used was to stop nuclear processing. Necessarily, if successful, that would cause serious disruption and damage to the Complainant's business.

In short, what the Respondent has done is to select for the Domain Name a name which is not its own, which it knew at the time of registration to be the name and trade mark of the Complainant and which it proposed at the time of registration to use in a campaign against the Complainant to cause the Complainant disruption and damage. The Domain Name would be particularly useful for that purpose because it would catch by surprise visitors intending to reach the Complainant's website. That this last point was intended is clear from the passage in the Response reading:

"Further, Complainant, through its website, <cogema.fr>, fails to inform visitors and potential visitors to its website of its reprocessing activities and the resulting impact on the environment. This, it is averred, creates an information asymmetry, which Respondent seeks to redress."

In other words, visitors to the Complainant's website are insufficiently informed, so the Respondent proposes to redress the balance by sufficiently informing a proportion of those seeking to visit the Complainant's site. Nowhere in the Response does the Respondent deny the Complainant's allegation that registration of the Domain Name was intended:

"to reserve the possibility of damaging the reputation of the Complainant by broadcasting denigrating information to the public and customers who intended and believed to access to the web site owned by COGEMA;"

In the Response the Respondent merely says that as to that allegation "it is specifically denied that the facts and matters pleaded are sufficient to prove bad faith of Respondent".

Had the Respondent been a competitor, there can be no doubt that its behaviour would have come within the terms of paragraph 4(b)(iii) of the Policy. Had the Respondent been acting "for commercial gain", there can be no doubt that its behaviour would have come within the terms of paragraph 4(b)(iv) of the Policy.

In this Case, the Respondent is neither a "competitor" of the Complainant nor is it acting for "commercial gain" in the ordinary sense of those words. However, while the Panel recognizes the Respondent's right to campaign and to conduct its campaigns by way of the internet, the Domain Name is not necessary for that purpose. Moreover, registration of a domain name comprising the name and trade mark of another and specifically with a view to causing damage and disruption to that other cannot be right, still less where the use of the Domain Name will trick internet users intending to visit the trade mark owner's site into visiting the registrant's site. The Panel therefore finds that the Domain Name was registered in bad faith.

The fact that the Domain Name has not been used is not conclusive in favour of the Respondent. The Panel respectfully endorses the view of the Panelist in case D2000-0055 as expressed in the extract from her decision quoted at page 5 above.

The Respondent has made its intention clear and the continuing threat hanging over the Complainant's head constitutes bad faith use of the Domain Name.

Accordingly, the Panel finds that the Domain Name was registered and is being used in bad faith.

7. Decision

In the result, the Panel having found that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights and that the Respondent has no rights or legitimate interests in respect of the Domain Name and that the Domain Name has been registered in bad faith and is being used in bad faith, the Complaint succeeds.

The Panel directs that the Domain Name, <cogema.org>, be transferred to the Complainant.

Tony Willoughby
Sole Panelist

Dated: May 14, 2001

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Case Details for WIPO Case D2003-0230

WIPO Case Summary

WIPO Case Number	D2003-0230
DDomain name(s)	porschedesign.com
Complainant	Dr. Ing. h.c. F. Porsche AG
Respondent	Sabatino Andreoni
Panelist	Willoughby, Tony
Decision Date	16-May-2003
Decision	<u>Transfer</u>

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WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Dr. Ing. h.c. F. Porsche AG v. Domains by Proxy, Inc and Sabatino Andreoni

Case No. D2003-0230

1. The Parties

The Complainant is Dr. Ing. h.c. F. Porsche AG, Stuttgart, Germany ("the Complainant"), represented by Lichtenstein, Körner & Partners of Germany.

The Respondent are Domains by Proxy, Inc of Scottsdale, Arizona, United States of America ("the First Respondent") and Sabatino Andreoni of Montreal, Quebec, Canada ("the Second Respondent").

2. The Domain Name and Registrar

The disputed domain name <porschedesign.com> ("the Domain Name") is registered with Go Daddy Software ("the Registrar").

3. Procedural History

The Complaint against the First Respondent was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 22, 2003. On March 24, 2003, the Center transmitted by email to the Registrar a request for registrar verification in connection with the domain name at issue. That day the Registrar amended the Whois database to remove the First Respondent as registrant and to substitute the name of the Second Respondent. The Registrar then informed the Center that the Second Respondent, not the First Respondent, was the registrant. The Registrar provided to the Center the contact details for the administrative, billing, and technical contact for the Second Respondent.

In response to a notification by the Center that the Complaint was administratively deficient, in that the Respondent was not the First Respondent, but the Second Respondent, the Complainant filed an amendment to the Complaint on April 3, 2003, adding the Second Respondent to the proceedings. The Center verified that

the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 7, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was April 27, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 28, 2003.

The Center appointed Tony Willoughby as the sole panelist in this matter on May 2, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

No further submissions were received by WIPO or the Panel, as a consequence of which the date scheduled for the issuance of the Panel's Decision is May 16, 2003.

4. Factual Background

The Complainant is the world famous sports car manufacturer and the proprietor of a large number of trademark registrations worldwide including registrations of the mark PORSCHE DESIGN.

The Domain Name was originally registered in the name of Michel Galarnau of Quebec, Canada. The Complainant launched a Complaint against Mr Galarnau under the Policy in December 2001 (case number [D2001-1448](#)) and by a decision dated February 24, 2002, the panelist in that case ordered that the Domain Name be transferred to the Complainant. For reasons that are not explained, that transfer did not take place, but apparently the then registrar, Network Solutions, Inc., cancelled the registration.

On October 31, 2002, the First Respondent registered the Domain Name with the Registrar. The First Respondent, a sister company of the registrar, as its name suggests, is simply the 'front' for its clients, its raison d'être being to preserve the anonymity of its clients.

The Complainant conducted Internet investigations which gave it reason to believe that the anonymous client was in fact the Second Respondent, Sabatino Andreoni of Quebec, Canada.

On February 26, 2003, the Complainant sent a cease and desist email to both Respondents complaining about the Domain Name and other domain names held in the name of the Second Respondent. The letter ended with a threat to launch, inter-alia, a complaint under the Policy if the Respondents did not transfer the Domain Name to the Complainant. No response was received to that email.

On March 24, 2003, having been notified of the launch of the Complaint, the Registrar changed its Whois record and entered the name of the Second Respondent as the registrant. The apparent excuse for this is to be found in the First Respondent's domain name proxy agreement, paragraph 4(c), which reads:

"You further understand and agree that if DPB [Domains By Proxy] is named as a defendant in, or investigated in anticipation of, any legal or administrative proceeding arising out of Your domain name or Your use of DBP's services, ownership of Your private domain name will automatically revert back to You and Your identity will therefore be revealed in the Whois directory."

The Panel notes that the First Respondent did not react as set out in paragraph 4(c) of that Agreement when it received the cease and desist email from the Complainant. It only did so on being notified of the Complaint, a course of action calculated to inconvenience the Complainant and the Center and to delay the start of these proceedings.

The Domain Name is connected to a website operated by the Second Respondent offering various web design and marketing services.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its trademark PORSCHE and is identical to its trademark PORSCHE DESIGN.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant points to the fact that neither Respondent is known by the Domain Name and neither Respondent has been licensed by the Complainant to use the Complainant's trademark. The First Respondent is simply a 'front' for the Second Respondent and the Second Respondent is using the Domain Name and other 'Porsche', 'Ferrari', 'Mercedes' and 'BMW' domain names for the purpose of attracting visitors to his site in order to promote his services.

The Complainant contends that the First Respondent's behavior in respect of the Domain Name to conceal the true identity of the registrant is itself an abuse of the system, thereby constituting bad faith registration and use under paragraph 4(a)(iii) of the Policy. The Complainant contends that the abuse is particularly offensive in circumstances such as the present where the use of the Domain Name is so obviously an infringement of the Complainant's trademark rights, the Domain Name being used by the Second Respondent to deceive Internet users, attracting them to the Second Respondent's website by making them believe they are visiting a site connected with the Complainant and all for commercial gain.

When a visitor arrives at the site he/she is met with a notice reading "Andreoni recognizes that 'Porsche', the Porsche Logo and various model numbers and cars are registered trademarks of Porsche A.G.. These terms and images are used for identification and artistic purposes only. Andreoni is not affiliated in any way with Porsche A.G." The Complainant contends that this disclaimer is of no use. By then, the visitor has been attracted to the site by a deception and the Second Respondent has obtained the desired business opportunity.

The Complainant contends that the circumstances clearly merit a finding of bad faith registration and use.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

General

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interest in respect of the Domain Name; and
- (iii) The Domain Name has been registered in bad faith and is being used in bad faith.

A. Identical or Confusingly Similar

The Domain Name comprises the entirety of the Complainant's trademark PORSCHE DESIGN and nothing more save for the generic domain suffix.

The Panel finds that the Domain Name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Panel shares the Complainant's concerns at the behavior of the Registrar and its sister company, the First Respondent, and in particular at the change to the Whois database following notification of the Complaint. If it was appropriate to make that change, it should have been made on receipt of the Complainant's email which preceded the Complaint.

In this particular case, the inconvenience to the Complainant was slight given that the Complainant had already identified who the anonymous client was. However, it is not difficult to see that there could be other occasions where the identity of the anonymous client could have a major affect on the content of the Complaint, thereby calling for major additional expense in re-drafting of the Complaint.

The Panel takes the view that the Complaint was properly launched against the First Respondent which manifestly and self-confessedly has no rights or legitimate interests in respect of the Domain Name. It is simply a 'front' for the Second Respondent.

The Complainant contends that the Second Respondent deliberately sought registration of the Domain Name with a view to using it to advertise his web design and other services, visitors to the website believing that they are visiting a site connected with the Complainant.

Paragraph 4(c) of the Policy indicates to Respondents how they may successfully respond to allegations of this kind, but the Respondents have declined to take up this opportunity.

The Panel finds that the Complainant has made out a prima facie case under this head (paragraph 4(a)(ii) of the Policy) and that the Respondents have a case to answer. The Respondents having failed to provide an answer and the Panel being unable to think of any way in which the Respondents or either of them could reasonably be said to have rights or legitimate interests in respect of the Domain Name, the Panel finds that the Respondents have no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

For the same reasons, the Panel finds on the balance of probabilities that the Second Respondent procured the registration of the Domain Name by the First Respondent with the intention of using it to connect to a website advertising his commercial services, the benefit to him of the Domain Name being that he would attract visitors to his site who would not otherwise have visited the site had they known that the Domain Name was unconnected with the Complainant.

The disclaimer is, of course, useless. By the time a visitor to the site sees it, the deception has occurred. The visitor has been lured to the site and the Second Respondent has obtained the desired business opportunity. The fact that there was felt to be a need to include the disclaimer at all, demonstrates that the Second Respondent was well aware that visitors to the site might well believe that the site was connected in some way with the Complainant.

The Panel finds that the Domain Name was registered in bad faith and is being used in bad faith by the Second Respondent, contrary to paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

The First Respondent cannot distance itself from the *mala fides* of the Second Respondent. If it chooses to act as a 'front' in these situations, it has to bear responsibility for what goes on behind it.

7. Decision

In light of the foregoing findings, namely that the Domain Name is identical to a trademark in which the Complainant has rights and that the Respondents have no rights or legitimate interests in respect of the Domain Name and that the Domain Name was registered in bad faith and is being used in bad faith, the Panel directs that the Domain Name be transferred to the Complainant.

Tony Willoughby
Sole Panelist

Dated: May 16, 2003