

National Association of Professional Baseball Leagues Inc. v. Zuccarini, 67 USPQ2d 1315 (WIPO 2003)

**67 USPQ2D 1315**  
**National Association of Professional Baseball Leagues Inc. v.**  
**Zuccarini**

**World Intellectual Property Organization**

**No. D2002-1011**  
**Decided January 21, 2003**

**Headnotes**

**TRADEMARKS AND UNFAIR TRADE PRACTICES**

[1] **Infringement; conflicts between marks — Likelihood of confusion — Particular marks — Confusion likely (§335.0304.03)**

**Infringement; conflicts between marks — Willful (§335.11)**

**REMEDIES**

**Non-monetary and injunctive — Equitable relief — Seizure; forfeiture (§505.0703)**

Complainant in Internet domain name dispute resolution proceeding has established that respondent engaged in cybersquatting by registering “minorleaugebaseball.com” domain name, since record shows

that complainant has both common law and registered rights in “Minor League Baseball” mark, as well as common law rights in expression “minorleaguebaseball”

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as used in complainant's “minorleaguebaseball.com” domain name, since disputed domain name, which is intentional misspelling of “minor league baseball,” is confusingly similar to complainant's mark, since respondent has no rights or legitimate interests in “typosquatted” domain name, which is intended to divert Internet users to respondent's pornographic World Wide Web site, and since respondent's typosquatting clearly manifests intent to capitalize on mark, and thus constitutes bad faith registration and use of domain name; transfer of disputed domain name to complainant is only effective remedy, since cancellation would allow re-registration by respondent or others.

### **Case History and Disposition**

Administrative proceeding pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, in which complainant National Association of Professional Baseball Leagues Inc., d/b/a Minor League Baseball, alleges cybersquatting by respondent John Zuccarini. Panel directs transfer of disputed domain name to complainant.

### **Judge:**

Before Limbury, presiding panelist, and Michaelson and Davis, panelists.

## **Opinion Text**

### ***1. The Parties***

Complainant is National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball, St. Petersburg, Florida 33701, United States of America, represented by Frost Brown Todd LLC of United States of America.

Respondent is John Zuccarini, Nassau, Bahamas.

### ***2. The Domain Name and Registrar***

The disputed domain name <minorleaugebaseball.com> is registered with CSL Computer Service Langenbach GmbH d/b/a Joker.com (“Registrar”).

### ***3. Procedural History***

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 30, 2002. Next day, the Center transmitted by email to the Registrar a verification request regarding the disputed domain name. On November 5, 2002, the Registrar confirmed that Respondent is listed as the registrant and provided contact details for the administrative, billing, and technical

contacts. The Center verified that 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 Respondent of the Complaint, and the proceedings commenced November 6, 2002. In accordance with the Rules, paragraph 5(a), the due date for the Response was November 26, 2002. Respondent sought a 20-day extension of time and, with Complainant's consent, the Center granted an extension until December 16, 2002. The Response was filed with the Center on December 17, 2002. The Panel admits the Response, although filed one day late.

The Center appointed Alan L. Limbury, Peter L. Michaelson and G. Gervaise Davis III as panelists in this matter on January 2, 2003. The Panel finds that it was properly constituted. Each member of the Panel has submitted a Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The languages of the registration agreement were German and English and the language of the proceeding was English.

#### **4. Factual Background**

Formed in 1901, Complainant has jurisdiction over professional baseball farm clubs affiliated with Major League Baseball in the United States and Canada. Complainant asserts that it has used the mark MINOR LEAGUE BASEBALL since its inception in connection with a very wide range of goods including jewelry, printed matter, housewares, containers, clothing and sporting equipment and in connection with entertainment services in the nature of baseball games and exhibitions.

Complainant registered the domain names <minorleaguebaseball.com> on July 3, 1996, and <minorleaguebaseball.org> on February 24, 2000. The website at <minorleaguebaseball.com> averaged over 10 million hits per month in 2001.

In early 2000, shortly prior to Respondent's registration of the disputed domain name,

Complainant filed applications to register at the USPTO six trademarks and one service mark, comprising in each case the same mark, MINOR LEAGUE BASEBALL AND DESIGN and citing dates in 1999, as the dates of first use in commerce. All the applications proceeded to registration in 2001, as follows:

Reg. Nos. 2,423,419 (toys and sporting goods) and 2,438,638 (paper goods and printed matter), in

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each case with a disclaimer of exclusivity in relation to the word “baseball”, apart from the mark as shown.

Reg. Nos. 2,423,416 (fabrics), 2,426,950 (housewares and glass), 2,423,415 (furniture and plastic goods) and 2,423,414 (jewelry), in each case with no disclaimer.

Reg. No. 2,426,954 – entertainment services in the nature of baseball games and exhibitions, with a disclaimer of exclusivity in relation to the words “minor league baseball” apart from the mark as shown.

Respondent registered the disputed domain name <minorleaugebaseball.com> on May 29, 2000. As at December 19, 2001, it redirected traffic to a pornographic website. Complainant’s attention was drawn to this by an informant who said: “...it’s not the kind of place that you want kids to hit by mistake”. As at October 2002, the disputed domain name redirected traffic to another pornographic site.

Respondent has a long history of registering as domain names the trademarks of others or slight misspellings of them: see, for example *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, WIPO Case No. D2000-0330, *Diageo p.l.c. v. John Zuccarini*, WIPO Case No. D2000-0541, *Dow Jones & Company, Inc. and Dow Jones LP v. John Zuccarini*, WIPO Case No. D2000-0578, *Yahoo!, Inc. v. Cupcake Patrol and John Zuccarini*, WIPO Case No. D2000-0928, *Abercrombie & Fitch Stores, Inc. and A & F Trademark, Inc. v. John Zuccarini d/b/a Cupcake Patrol*, WIPO Case No. D2000-1004, *Saks & Company v. John Zuccarini*, WIPO Case No. D2000-1285, and *America Online, Inc. v. John Zuccarini, also known as Cupcake Message, Cupcake Messenger, The Cupcake Secret, Cupcake Patrol, Cupcake City, and The Cupcake Incident*, WIPO Case No. D2000-1495.

In *Shields v. Zuccarini*, 254 F.3d 476; 2001 U.S. App. LEXIS 13288; 59 U.S.P.Q.2d (BNA) 1207 the U.S. Court of Appeals for the Third Circuit in June 2001, upheld summary judgment against Respondent under the Anticybersquatting Consumer Protection Act for registering domain names that were intentional misspellings of distinctive or famous names. In that case, Respondent admitted that he had registered thousands of domain names, *because [emphasis added]* they are confusingly similar to others’ famous marks or personal names — and thus are likely misspellings of these names — in an effort to divert Internet traffic to his sites.

In April 2002, Respondent was found to have engaged in unfair and deceptive acts or practices in violation of §5 of the Federal Trade Commission Act and permanently enjoined by the U.S. District Court for the Federal District of Pennsylvania from (inter alia) redirecting consumers on the Internet or World Wide Web and from representing that any domain names are associated with any third party or any trademark or service mark when in fact they are not: *Federal Trade Commission v. Zuccarini* 2002 U.S. Dist. LEXIS 13324; 2002-1 Trade Cas. (CCH) P73,690.

### 5. Parties’ Contentions

### A. Complainant

The disputed domain name is confusingly similar to Complainant's Registered marks MINOR LEAGUE BASEBALL AND DESIGN and common law mark MINOR LEAGUE BASEBALL. Only the service mark registration disclaims the entire phrase so even if the phrase is generic with respect to entertainment services in the nature of baseball games and exhibitions, the other six registrations create a presumption of the validity of the mark. In any event there is strong evidence of secondary meaning.

Respondent has no rights or legitimate interests in respect of the disputed domain name. Diverting traffic intended for Complainant's site, then providing access to pornography instead of minor league baseball information is not a bona fide offering of goods or services.

Respondent registered and is using the disputed domain name in bad faith. Respondent must have been aware of Complainant's trademark because of Complainant's use of it for

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decades, its heavy promotion and because Complainant owns domain name registrations without the typographical error. Respondent is not using the disputed domain name in connection with baseball but with pornography, to which children seeking the special zone for children's activities on Complainant's site might accidentally gain access. This is not legitimate use. Respondent has a pattern of registering common misspellings of others' trademarks.

### B. Respondent

Respondent registered the disputed domain name because it is a misspelling of the generic term "minor league baseball". Although cases have been decided against Respondent in connection with domain names containing misspelled trademark terms, this case is different from those cases because the present case involves a misspelling of a term, which, as Complainant has admitted, a jury has found to be generic.

Under the Policy, the first to register a generic term has a legitimate interest in it. The result should be no different for a domain name incorporating the misspelling of that term: *Knight-Ridder, Inc. v. Cupcake Patrol a/k/a John Zuccarini* (NAF Case No. FA96551).

To prove bad faith registration and use of domain name that incorporates a common (generic) term, Complainant must prove either that the domain name was registered specifically to sell to Complainant or that the value of the domain name derives exclusively from the fame of Complainant's mark: *Ultrafem, Inc. v. Warren R. Royal* (NAF Case No.97682). The analysis is the same for a misspelling of that common term. There is no such evidence here.

## 6. Discussion and Findings

### A. Rights in a mark

The critical issue in this case is whether Complainant has trademark rights in the words MINOR LEAGUE BASEBALL.

Complainant asserts common law rights in the words MINOR LEAGUE BASEBALL alone, deriving from use since 1901. There is evidence before the Panel of use of those words since 1999, as part of the design mark, not merely in connection with baseball but in connection with a variety of goods not connected with baseball. Since 1996, Complainant has operated a popular website at <www.minorleaguebaseball.com>. Further, Complainant exhibits a declaration from Sylvia Lind, Senior Manager of Minor League Operations for the Office of the Commissioner of Baseball, stating that she is aware Complainant uses the mark MINOR LEAGUE BASEBALL to identify the goods and services of Complainant and of its 19 member Leagues and their respective Clubs and in advertising and promotion of those goods and services. She also states that the mark MINOR LEAGUE BASEBALL is widely used by the press, print and broadcast media, the sports industry, sports fans and the public to identify and refer to Complainant and its member Leagues and Clubs.

[1] Although much of Complainant's evidence of its promotional activities and expenditure post-dates Respondent's domain name registration, the Panel is prepared to infer from the evidence mentioned above that, prior to registration of the disputed domain name, the design mark had acquired secondary meaning denoting a wide range of goods associated with Complainant, including jewelry, clothing, printed material, housewares and glass and sporting equipment. Accordingly the Panel finds Complainant has common law rights in the design mark, as well as registered rights.

The Panel also finds that prior to the registration of the disputed domain name, the second level domain in Complainant's domain name <minorleaguebaseball.com>, through use since 1996, at Complainant's website <www.minorleaguebaseball.com> had become distinctive of Complainant and of the goods and services of Complainant accessible from that site. Complainant possesses valuable goodwill in that second level domain, goodwill being "the attractive force which brings in custom" [business] *Commissioners of Inland Revenue v Muller & Companies Margarine Limited* 1901 A.C. 217 Lord Macnaghten. Accordingly Complainant has established that it has common law rights in the expression <minorleaguebaseball>when used as part of the domain name <minorleaguebaseball.com>.

### B. Identical or Confusingly Similar

Respondent concedes the disputed domain name, which transposes the letters "g" and "u" in the term "league" to yield "leauge"

(the latter being in the disputed domain name) is a misspelling of “minor league baseball”, which Respondent contends is generic but which the Panel has found, when used as a second level domain, to be a common law trademark of Complainant. Typosquatted domain names are intended to be confusing so that Internauts, who unwittingly make common typing errors, will enter the domain name instead of the mark. The contested domain name certainly qualifies in that regard. The Panel finds the disputed domain name is confusingly similar to that mark.

Complainant has established this element.

### *C. Rights or Legitimate Interests*

Respondent is not commonly known by the disputed domain name and has not at any time used or made any demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services. “Typosquatting”(an expression apparently coined by Respondent himself: *Shields v. Zuccarini*, 254 F.3d 476; 2001 U.S. App. LEXIS 13288; 59 U.S.P.Q.2d (BNA) 1207), as a means of redirecting consumers against their will to another site, does not qualify as a bona fide offering of goods or services, whatever may be the goods or services offered at that site. Nor does it constitute a legitimate noncommercial or fair use of the domain name without intent for commercial gain misleadingly to divert consumers.

Redirection of children to a pornographic site cannot give rise to legitimate interests in a typosquatted domain name.

Complainant has established this element.

### *D. Registered and Used in Bad Faith*

Respondent argues that, to prove bad faith registration and use of a common word domain name, Complainant must prove either that the domain name was registered specifically to sell to Complainant or that the value of the domain name derives exclusively from the fame of Complainant’s mark: *Ultrafem, Inc. v. Warren R. Royal* (NAF Case No.97682) and that the analysis is the same for a misspelling of that common term.

The relevant passage from the decision in *Ultrafem* is:

“A bad faith showing would require the Complainant to prove that the Respondent registered <*instead.com*> specifically to sell to the Complainant, or that the value of “instead” as a domain derived exclusively from the fame of its trademark. Neither has been proven in this case. In the absence of an intent to capitalize on the Complainant’s trademark interest, the Complainant cannot assert an exclusive right over a domain name that is a common, generic term.”

The critical part of this passage is *absent an intent to capitalize on the Complainant’s trademark*

*interest*. This Panel takes the view (not necessarily inconsistent with the learned panelist in *Ultrafem*) that where there is evidence of intent to benefit from the goodwill in the mark, even if there was also intent to take advantage of Internauts misspelling a generic word, bad faith may be found.

Thus, mere registration of a common word that also happens to be a trademark requires additional evidence before bad faith may be found. Typosquatting, however, 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. Where the misspelled word or words are generic, there is no remedy under the Policy. Where, however, they are trademarks, even though they may also be generic in a different context from that for which they are registered and/or used, (for example the term "apple" should it be used in <apple.com> with respect to a web site offering fruit, namely apples, is in all likelihood, generic), nevertheless, given the reputation of those marks in another field with which the mark is associated and where the mark is clearly not generic, then the intentional registration and use of the misspelled word or words (for example <appple.com>) clearly manifests an intent to capitalize on the mark and constitutes bad faith under the Policy. Such is the case here.

In addition, the facts that Respondent not only intentionally registered a domain name for the express purpose of misdirecting unaware persons mistyping or misspelling the trademark but also intentionally directs them to a pornographic site are clear evidence of exactly the bad faith conduct that the framers of the ICANN UDRP rules had in mind.

Complainant has therefore amply established its case on this aspect of the dispute.

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This conclusion is reinforced by the pattern in which this Respondent has engaged by registering multitudes of such misspelled names, which the Panel considers may be taken into account in finding bad faith in this case. Apart from the cases of *Shields v. Zuccarini*, 254 F.3d 476; 2001 U.S. App. LEXIS 13288; 59 U.S.P.Q.2d (BNA) 1207 and *Federal Trade Commission v. Zuccarini* 2002 U.S. Dist. LEXIS 13324; 2002-1 Trade Cas. (CCH) P73,690, Respondent's bad faith conduct in this case is no different in quality from that in over 50 ICANN cases in which he has been found to have violated the Policy, including *AT&T Corp. v. Zuccarini*, WIPO Case No. D2002-0666, (September 5, 2002); *Williams-Sonoma, Inc. v. Zuccarini*, WIPO Case No. D2002-0582, August 9, 2002); *OfficeMax, Inc. v. Zuccarini*, WIPO Case No. D2002-0354, (July 18, 2002); *State of Florida Dept. of the Lottery v. Zuccarini*, WIPO Case No. D2002-0307, (May 25, 2002); *Sierra Trading Post, Inc. v. Zuccarini*, WIPO Case No. D2002-0263, (May 24, 2002); *CareerBuilder, Inc. v. Zuccarini*, WIPO Case No. D2002-0282, (May 21, 2002); *VocieStream Wireless Corp. v. Zuccarini*, WIPO Case No. D2002-0146, (May 16, 2002); *NIHC, Inc. v. Zuccarini*, WIPO Case

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No. D2002-1260, (January 15, 2002); *Backstreet Productions, Inc. v. Zuccarini*, WIPO Case No. D20021-0654, (August 24, 2001); *TPI Holdings, Inc. v. Zuccarini*, WIPO Case No. D2001-0797, (August 22, 2001); *The Sportsman's Guide, Inc. v. Zuccarini*, WIPO Case No. D2001-0617, (July 19, 2001); *Disney Enterprises, Inc. v. Zuccarini*, WIPO Case No. D2001-0489, (June 19, 2001); *Cimcities, LLC v. Zuccarini*, WIPO Case No. D2001-0491, (May 31, 2001); *Dow Jones & Co., Inc. v. Zuccarini*, WIPO Case No. D2001-0302, (May 18, 2001); *Eddie Bauer, Inc. v. Zuccarini*, WIPO Case No. D2001-0224, (April 26, 2001); *Time Warner Entertainment Co., L.P. v. Zuccarini*, WIPO Case No. D2001-0184, (April 11, 2001); *Autosales Inc. v. Zuccarini*, WIPO Case No. D2001-0230, (March 30, 2001); *NCRAS Management, LP v. Zuccarini*, WIPO Case No. D2000-1803, (February 26, 2001); *At Home Corp. v. Zuccarini*, WIPO Case No. D2000-1524, (January 30, 2001); *Nicole Kidman v. Zuccarini*, WIPO Case No. D2000-1415, (January 23, 2001); *United Feature Syndicate, Inc. v. Zuccarini*, WIPO Case No. D2000-1449, (December 29, 2000); *PRIMEDIA Magazine Finance Inc. v. Zuccarini*, WIPO Case No. D2000-1186, (November 20, 2000); *Abercrombie & Fitch Stores, Inc. v. Zuccarini*, WIPO Case No. D2000-1004, (November 1, 2000); *Yahoo! Inc. v. Zuccarini*, WIPO Case No. D2000-0777, (October 2, 2000); *Encyclopaedia Britannica, Inc. v. Zuccarini*, WIPO Case No. D2000-0330, (June 7, 2000).

### *E. Form of relief*

Under Policy paragraph 4(i), where a Complainant has proved all three elements required under paragraph 4(a), the only available remedies are cancellation or transfer to Complainant. Under Rule 15(a), the Panel must decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law it deems applicable.

Complainant has requested cancellation of the registration. The Panel is concerned that cancellation will only place the domain name back into the public domain from which Respondent or others can re-register it, hence perpetuating the problem which Complainant now faces.

The courts of many countries, including the United States, where Respondent is located, have inherent power, under general principles of equity, to issue an order providing a remedy other than that sought if the court considers the remedy requested by a litigant to be inadequate or improper. Given the egregiousness and pattern of this Respondent's abusive registrations, conduct which the Policy is designed to eliminate, the Panel considers that transfer is the only effective remedy that will prevent repetition of the particular act of cybersquatting in this case. Accordingly, it is appropriate to remould the remedy sought by the Complainant.

The Panel will direct transfer rather than cancellation. If Complainant so wishes, it may thereafter cancel the registration.

### *7. Decision*

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For all the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel directs that the domain name <minorleaugebaseball.com>be transferred to Complainant.

**- End of Case -  
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