

ADMINISTRATIVE PANEL DECISION

Jelani Jenkins v. Amy Lewis

Case No. D2014-0695

1. The Parties

The Complainant is Jelani Jenkins of Silver Spring, Maryland, United States of America, represented by The Law Offices of Manotti L. Jenkins, LTD., United States of America.

The Respondent is Amy Lewis of Bowie, Maryland, United States of America, self-represented.

2. The Domain Names and Registrar

The disputed domain names <jelanijenkins.com> and <jelanijenkins.net> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 28, 2014. On April 29, 2014, the Center transmitted, by email to the Registrar, a request for registrar verification in connection with the disputed domain names. On May 2, 2014, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 the Respondent of the Complaint, and that the proceedings commenced on May 14, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was set to June 3, 2014. The Response was filed with the Center on May 22, 2014.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on May 26, 2014. 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.

Subsequently, on June 1, 2014, the Complainant submitted a Supplemental Filing to the Center. In response to this filing and later the same day, the Respondent submitted its Supplemental Filing, in the bodies of two email messages, to the Center.

4. Factual Background

A. The Disputed Domain Names

According to entries from the public Whois database and which appear in Annexes 1 and 2 to the Complaint, and as confirmed by the Registrar, both disputed domain names were registered to the Respondent on January 29, 2008 and are set to expire on October 28, 2014.

B. Complainant's JELANI JENKINS Mark

As delineated below, the Complainant claims common law trademark rights in his personal name "Jelani Jenkins", based on his continuous prior use, since at least as early as December 19, 2007, of that name as a mark used in conjunction with his services as a football player. The Complainant has no trademark registration for this mark.

C. Complainant's Activities

During 2007-2009, the Complainant was a rather successful varsity football player at Good Counsel High School in Olney, Maryland. During the latter portion of that time, the Complainant gained notoriety in the U.S. media due to his athletic success. As a result of that success, a large number of U.S. collegiate football programs aggressively recruited him to enroll in their schools and join their teams. The Complainant ultimately selected the University of Florida to attend. His choice received considerable attention from the U.S. sports media as indicated by copies of various illustrative articles appearing in Annexes 5-8 of the Complaint.

During the Complainant's collegiate years of 2009-2013 at the University of Florida, he gained further national notoriety for his ability as a collegiate football player – as shown by copies of articles in Annexes 9-10 of the Complaint.

Since the University of Florida had won the National Collegiate Athletic Association (NCAA) National Football Championship in 2008, then, while the Complainant attended the university from 2009-2013, football games involving its team, including the Complainant, were frequently televised in the U.S. and were the subject of widespread attention in the national sports media.

Subsequently, considerable anticipation arose among American football enthusiasts, writers, and football and sports professionals as to whether the Complainant would forego his final year of collegiate eligibility and enter the National Football League (NFL) professional football draft in 2013. Ultimately, the Complainant decided to enter the 2013 NFL draft. His decision received extensive attention in the U.S. sports media – as indicated by copies of illustrative articles appearing in Annexes 12 and 13 to the Complaint. He was drafted by the Miami Dolphins.

The Complainant continued to receive national publicity during his NFL rookie season as a backup linebacker for the Dolphins (see copies of illustrative articles in Annexes 14-16 of the Complaint). He is presently preparing for his second year as a professional football player for the Dolphins.

D. Respondent's Activities and Her Interactions with the Complainant

While the Complainant was in high school and at the time the Respondent registered the disputed domain names, the Respondent was a Maryland resident located within generally the same Washington, D.C. suburban area as was the Complainant at that time. The Respondent continues to reside in this area.

On March 16, 2008, the Respondent married Kenneth Jenkins (unrelated to the Complainant), who was by then a former NFL football player. According to the Respondent, while the Complainant was still in high school and apparently before they were married, the Respondent and her husband, in anticipation of having children, found a personal name they liked, specifically "Jelani Jenkins". Based on that name, they then formulated and registered the two disputed domain names: <jelanijenkins.com> and <jelanijenkins.net>. Currently, as recited on the home page of the Respondent's website, the Respondent and her husband are CEO and President, respectively, of GotProHealth, a member program for the NFL Players Association and the National Basketball Association (NBA). See a copy of the home page appearing in Annex 21 of the Complaint. Both the Respondent and her husband had children from their prior marriages.

When the Respondent saw news on ESPN (a U.S. sports channel) that the Complainant was drafted by the Miami Dolphins, she put the disputed domain names up for auction sale apparently thinking that someone might find them sufficiently valuable. On September 24, 2013, a Mr. Evans, claiming he represented the Complainant who was then in the process of developing his own web site, contacted the Respondent by email and expressed the Complainant's desire to obtain the domain name <jelanijenkins.com> from the Respondent and offered her a few autographs by the Complainant in exchange. Later the same day, the Respondent responded by email to Mr. Evans declining the offer and stating that both names <jelanijenkins.com> and <jelanijenkins.net> were for sale for USD 10,000 total. See copies of emails appearing in Annex 2 to the Response.

On March 26, 2014 and apparently as a result of not hearing anything further from Mr. Evans and consequently questioning the legitimacy of Mr. Evan's offer, the Respondent contacted the Complainant's agent, Mr. Branion, by email. Mr. Branion responded to the Respondent by an email message dated March 27, 2014, in which he stated that he checked with the Complainant and the Complainant had no knowledge of Mr. Evans. See copies of emails appearing in Annex 3 to the Response.

On March 28, 2014, the Complainant's brother, Mr. Shomari Jenkins, contacted the Respondent by telephone after he was informed that the Respondent had contacted Mr. Branion concerning the disputed domain names. The Respondent told him that: she owned the rights to the disputed domain names, the then going rate for the disputed domain names was USD 25,000 each, but, because she knew that the Complainant, rather than a fan or football marketing firm, was personally interested in both names, she would sell both names to the Complainant at a discounted price of USD 10,000. The next day, the Complainant's attorney contacted the Respondent demanding the names. The Respondent refused. On April 28, 2014, the Complainant's attorney initiated the present proceeding to seek transfer of both disputed domain names.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

Though the Complainant does not have a trademark registration for his name, nevertheless his name has acquired common law trademark rights dating back to 2007 by virtue of the Complainant's consistent and continuing national recognition in the US sports media as a football player – on the high school, collegiate and professional levels.

Further, both disputed domain names are identical to the Complainant's common law trademark, *i.e.* his personal name "Jelani Jenkins".

Hence, the Complainant believes that he has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

There is no evidence that the Respondent has: (a) ever used, or prepared to use, either of the disputed domain names in connection with a *bona fide* offering of goods or services; (b) ever been commonly known by the personal name “Jelani Jenkins”; and (c) is making a legitimate noncommercial or fair use of either of the disputed domain names.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using each of the disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent, having registered the disputed domain names while the Complainant was in high school, realized the Complainant’s athletic abilities and registered these names as an investment. She fully recognized the Complainant’s likely potential as a successful professional football athlete and thus intended to monetize these names as some point in the future, either by then selling them at a significant profit to the Complainant or through other means.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent does not appear to contest that each of the disputed domain names are identical to the Complainant’s common law trademark.

(ii) Rights or Legitimate Interests

The Respondent, contrary to the Complainant’s position, appears to assert that she has rights and legitimate interests in both disputed domain names under paragraph 4(c)(iii) of the Policy.

Specifically, the Respondent’s marital surname is “Jenkins”. She and her husband selected the given name “Jelani” simply because they liked the name and, anticipating having a child, expected to name the child “Jelani Jenkins”. The Respondent had no knowledge of the Complainant at the time she registered both domain names. The Respondent registered the names “in advance [of having a child] because one of our children’s names was already being used by a porn website when we went to secure their domain and we didn’t want that to happen again”. (See Respondent’s Supplemental Filing).

Accordingly, the Respondent implicitly argues that her use of both disputed domain names, each of which includes “jelanijenkins” as its second level domain, constitutes a legitimate noncommercial or fair use.

(iii) Registered and Used in Bad Faith

Lastly, the Respondent contends that her registration and use of the disputed domain names does not reflect bad faith.

At the time the Respondent registered the names, she had no knowledge that the Complainant would become an NFL player. Moreover, she states that, the probability was (and remains) very low that any successful high school football player, as the Complainant was at the time, would ultimately play for the NFL. By the NFL’s own statistics only 215 out of 100,000 high school seniors ultimately do so. Hence, the Respondent could not have reasonably foreseen the Complainant’s ultimate success.

Further, if the Respondent’s intent, as the Complainant alleges, was to profit from the Complainant’s

eventual success, then given the rather low probability that any high school football player would similarly succeed, then the Respondent would have registered multiple domain names for multiple high school football players, with each domain name containing the name of a different player. She did not do so. She only registered the two disputed domain names that matched her own surname. In that regard, the Respondent points to two other individuals (S. Diggs and W. Brown), who attended the same high school in Maryland as the Complainant and, at the time the Complainant registered the disputed domain names, were more successful high school football players than was the Complainant.

C. Supplemental Filings

Both sides submitted Supplemental Filings. The Panel, exercising its sole discretion under the Rules, paragraphs 10 and 12, has carefully considered both filings. To the extent either filing provided any additional factual information beyond that in the main pleadings, that information has been incorporated into the factual summary above.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that each of the disputed domain names is identical to the Complainant's JELANI JENKINS Mark.

As a general matter, the Policy does not contain any restriction whatsoever that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence standing under the Policy, can lie with national trademark law. For a more general discussion of UDRP-relevant rights in a personal name, and for what typically needs to be shown for a complainant to successfully assert common law or unregistered trademark rights under the Policy, see paragraph 1.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"). In any event, in the present case, the Panel also finds it relevant to have regard to United States trademark law in particular. Under United States law which applies here, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof...which (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

Consequently, numerous UDRP panels, including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, NAF Claim No. FA 95560 held: "The ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy." Furthermore, the panel in *United States Postal Service v. Consumer Information Organization*, NAF Claim No. FA 95757 held: "The UDRP does not discriminate between registered and unregistered marks." In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, eResolution Case No. AF-0536, the panel recognized: "It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark."

Given that common law trademark rights in the United States suffice for purposes of invoking paragraph 4(a)(i) of the Policy, the inquiry shifts to whether the Complainant had acquired common law

trademark rights in his personal name “Jelani Jenkins”.

Under the facts of record, the Panel considers that the Complainant clearly accrued common law trademark rights – which the Respondent does not dispute – in his personal name commencing during 2007 in connection with being a football player, with those rights continuing to the present while the Complainant advanced his career from high school to collegiate to ultimately professional football. Specifically, during that time, the Complainant received increasing national notoriety and thus his name gained sufficient distinctiveness and secondary meaning throughout the national U.S. football industry to attain legal status as a common law mark in that industry.

Since, as a predicate, the Panel has found that the Complainant has common law rights in the mark JELANI JENKINS, then no doubt exists that the disputed domain name is identical to that mark.

The only differences between the disputed domain names and that mark are merely the omission of spaces between the individual words in the mark and the appending of the generic Top Level Domains (gTLDs) “.com” and “.net” – the latter being totally ignored in assessing confusing similarity/identity. Well-established UDRP precedent, including from this Panel, holds that the addition of a gTLD, the deletion of spaces or other such trifling changes are utterly *de minimus*, if not completely irrelevant, in assessing confusing similarity/identity and thus are typically ignored.

Therefore, the Panel finds that the disputed domain names are each identical to the Complainant’s JELANI JENKINS Mark as to cause confusion. Hence, the Complainant has shown identity between that mark and both disputed domain names under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to either of the disputed domain names under paragraph 4(c) of the Policy.

First, the Complainant never authorized the Respondent to utilize the JELANI JENKINS Mark nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. Furthermore, given the exclusive trademark rights that reside in the Complainant, the Respondent could not legitimately acquire any public association between herself and the mark JELANI JENKINS or even any mark similar thereto, at least for the services, including being a football player, which the Complainant provides under his mark.

The Respondent argues that, in the absence of having any prior knowledge of the Complainant, she selected the personal name “Jelani Jenkins”, as the basis of the two disputed domain names, simply because she and her husband – the latter then having the surname “Jenkins” – liked that name as the personal name of a child they expected to have. She registered both disputed domain names based on that personal name to prevent the disputed domain names from subsequently being taken by another party, such as a porn site operator. However, there is no evidence of record that the couple ever had a child together, much less named that child “Jelani Jenkins”. In that regard, the Respondent admits that she and her husband had children from their prior marriages, but there is no mention in the record of any subsequent children. The record also lacks any evidence showing that the Respondent was then or is now known by the personal name “Jelani Jenkins” or that any subsequent child of the Respondent, if in fact she had any, was or is commonly known by that name.

Further, as discussed below in the context of bad faith registration, the Panel finds that the only plausible reason why the Respondent registered the disputed domain names in January 2008 was that the Respondent then knew of the Complainant’s budding athletic prowess and reputation as a high school football player – particularly since both parties then resided in Maryland and in the same general area of suburban Washington DC – and, in light of the insignificant cost of registering disputed domain names, simply decided to take a very low cost gamble. She intentionally formulated the disputed domain names as

being identical to Complainant's personal name with the intent to eventually monetize those domain names and significantly profit from doing so when and if the Complainant ever achieved sufficient fame in his sport. While, in all likelihood, she was uncertain back in January 2008 as to whether the Complainant would ever achieve professional success or not, the cost of being mistaken was *de minimus*: two registration fees. However, if her prediction proved to be accurate – which in fact it did some 5 years later, then by virtue of owning domain names identical to the Complainant's personal name and mark, those domain names would possess value far greater than the relatively miniscule costs she incurred to register them. Nevertheless, when the Respondent registered the disputed domain names, the Complainant had already started accruing common law trademark rights in his personal name, perhaps not yet nationally but certainly locally within the same suburban Washington region in which they then both resided.

As the Respondent did not and could not own the personal name of the Complainant, her having registered domain names which identically reflect that personal name, and particularly with an intent to later profit from those registrations, does not constitute a legitimate noncommercial or fair use of the domain names.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in either of the disputed domain names.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain names within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain names, constitute bad faith registration and use.

Paragraph 4(b) of the Policy illustrates non-exhaustive circumstances, if found by the Panel, as evidence of registration and use of a domain name in bad faith, including.

“(i) circumstances indicating that you have registered or you have acquired the domain name[s] primarily for the purpose of selling, renting, or otherwise transferring the domain name registration[s] to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name[s]”.

While the Respondent strenuously argues that she registered the disputed domain names in good faith by virtue of having chosen the personal name “Jelani Jenkins” as that of her possible child and then having registered the disputed domain names on that basis, the Respondent's proof is materially deficient in several key aspects.

First, there is no evidence of record that shows that the Respondent even had a child at or shortly after she registered the names and even up to the present, let alone whether she and her husband named that child “Jelani” – and a reasonable inference based on her statement of record leads the Panel to find that she did not.

Second, the Respondent has not set forth any purpose as to what, from the standpoint of her future child, she intended to accomplish by the registrations and how her future child would benefit from the Respondent having registered the disputed domain names when she did, particularly given that her child did not exist at that time of registration. In that regard, the Panel does not see why a newborn or young child here would have any need for a domain name. While such a need may conceivably exist under certain circumstances, under the present facts of record, the Respondent has not convinced the Panel that such circumstances exist.

Accordingly, the Panel sees no plausible connection, at least in this dispute, between the Respondent's alleged desire to name her future child the personal name, *i.e.* "jelani jenkins", and the registration of the two disputed domain names.

As such, the Respondent's expressed intent in having selected and registered the disputed domain names simply lacks credibility.

The Panel believes that the Respondent's real intent was to exploit the potential value inherent in the disputed domain names for her own personal financial gain. That value was conditioned on whether the Complainant ultimately achieved professional success. She knew of the Complainant, but what she did not know was whether he would eventually succeed or not. The Respondent knew, at the time of registration, that the disputed domain names each included the Complainant's personal name and, if he ultimately achieved success as a professional football player, would command a price far in excess of her costs of registration. If the Complainant failed, then the names would be essentially worthless. She intended to passively hold the names – and she ultimately did – until such time in the future when the Complainant had achieved the requisite success and recognition at which point she could then sell the disputed domain names at what she then regarded to be a sufficiently high price (and profit margin). That opportunity first arose when the Complainant was drafted by the Miami Dolphins football team. At that point, the Respondent offered the names for auction sale. A few months later, she offered to sell the names to the Complainant, via his agent, for at least USD 5000 each. The fact that her husband was a former NFL player and, as such, could well have recognized the Complainant's innate talent as a football player and so informed the Respondent prior to her having registered the disputed domain names lends further credence to the Panel's view.

Hence, under the specific facts of record, the Panel finds that the Respondent's actions in first registering, then passively holding the disputed domain names – each of which identically includes the Complainant's personal name and mark until she could sufficiently exploit their value, and finally attempting to sell them to the Complainant at a price exceeding her cost of registration constitutes bad faith registration and use under paragraph 4(b)(i) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain names, to establish a case under paragraph 4(a)(iii) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain names <jelanijenkins.com> and <jelanijenkins.net> are ordered to be transferred to the Complainant.

Peter L. Michaelson
Sole Panelist
Date: June 23, 2014