

## ADMINISTRATIVE PANEL DECISION

Philip Morris USA Inc. v. Computer Services, Inc.  
Case No. D2017-0847

### 1. The Parties

The Complainant is Philip Morris USA Inc. of Richmond, Virginia, United States of America ("United States" or "US"), represented by Arnold & Porter Kaye Scholer LLP, Washington, DC, United States.

The Respondent is Computer Services, Inc of Las Vegas, Nevada, United States, self-represented.

### 2. The Domain Name and Registrar

The disputed domain name <marlborosucks.com> is 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 26, 2017. On April 27, 2017, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. On April 28, 2017, 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 and 4, the Center formally notified the Respondent of the Complaint and that the present proceeding commenced on May 10, 2017. In accordance with the Rules, paragraph 5, the due date for the Response was set to May 30, 2017. On May 30, 2017, the Respondent filed its Response with the Center. On June 1, 2017, the Complainant submitted, to the Center, its Reply to the Response.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 9, 2017. 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.

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

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of the record appears in Annex A to the Complaint), the disputed domain name was registered on October 5, 1999 and its current registration will expire on October 5, 2017.

##### **A. The Complainant's MARLBORO Marks**

As indicated in the Complaint, the Complainant owns, among other trademark registrations, two United States trademark registrations for the word MARLBORO in a stylized fashion: one with the stylized word by itself, and the other for the stylized word together with various design elements. The Complainant has provided, in Annex E to the Complaint, a copy of its United States registration certificate for each of these marks, the pertinent details of which are:

###### **1. MARLBORO (stylized)**

United States Registration No.: 68,502

Registered: April 14, 1908; Renewed: April 14, 2008; Filed: October 17, 1907

This mark is registered for use in connection with: "Cigarettes" in international class 34. This registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of December 31, 1883.

###### **2. MARLBORO (stylized with design elements)**

United States Registration No.: 938,510

Registered: July 25, 1972; Renewed: July 25, 2012; Filed: March 30, 1971

This mark is registered for use in connection with: "Cigarettes" in international class 34. This registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of December 31, 1954.

##### **B. The Complainant and its interactions with the Respondent**

The Complainant manufactures, markets and sells cigarettes in the United States, including cigarettes branded under its MARLBORO Marks. These branded cigarettes have been made and sold by the Complainant (and various predecessor entities) since 1883, with the modern history of the brand beginning in 1955. Since 1883, the Complainant has expended substantial time, effort, and money advertising and promoting its MARLBORO Marks throughout the United States. As a result, those marks have become uniquely associated with the Complainant and its products.

Additionally, the Complainant has registered the domain name <marlboro.com> which resolves to the Complainant's website which provides information regarding the Complainant, its products and special offers for age-verified smokers 21 years or older. A screen shot of the home page and a print-out of the Whois record for this domain name both appear in Annex F to the Complaint.

The Complainant recently learned of the existence of the disputed domain name as a result of having conducted a search of the Internet for domain names that, it believes, might infringe its rights in its mark MARLBORO.

The disputed domain name does not resolve to any website. Upon entering the name into a browser, the time period, within which a connection to a web server must occur, subsequently simply times out with, as the Complainant experienced, the browser generating and displaying an error message stating: "This site

can't be reached" (or similar, depending upon the type of browser used, e.g., Firefox or Safari). A copy of this message appears in Annex B to the Complaint.

Shortly after learning of the disputed domain name, the Complainant's Counsel, on March 6, 2017, wrote to the Respondent, Computer Services, by email letter with a hardcopy sent by courier, at the address listed in the Whois record for that name. Counsel demanded that the Respondent transfer the name to the Complainant. Counsel addressed its letter to "Mary Ann Murray", inasmuch as Ms. Murray was listed as the present or past principal of the Respondent as reported in various business reports, provided by Dun & Bradstreet and other business reporting services, that the Complainant obtained on the Respondent. None of those reports listed any other representative of the Respondent. On March 9, 2017, Ms. Murray responded, by facsimile letter, stating that she "did not own or have financial ties to Computer Services Inc." or to the disputed domain name and thus could not countersign Counsel's demand letter and agree to transfer the name as Counsel had demanded. Counsel then replied on the same date, March 9, 2017, back to Ms. Murray asserting that her letter was disingenuous as the Respondent's business was "Computer Consulting Services" located at the exact same address as that to which Counsel's letter was addressed, rather than "Computer Services Inc." as the March 6th letter was specifically addressed. Counsel insisted, among other aspects, that the Respondent transfer the disputed domain name to the Complainant and that Ms. Murray identify another representative to whom Counsel could direct its demand for transfer of the name. Counsel received no further correspondence from the Respondent. A copy of all the correspondence between the parties appears in Annex C to the Complaint.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to its mark MARLBORO.

Specifically, the disputed domain name contains the mark MARLBORO to which the word "sucks" has been appended, with that word being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the disputed domain name and the Complainant's mark.

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

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent has no connection or affiliation with the Complainant or any of the Complainant's affiliates or any of the Complainant's products provided by the Complainant under its MARLBORO Marks. The Respondent has neither used nor made demonstrable preparations to use the disputed domain name and has never been commonly known by any name or trade name that incorporates the term MARLBORO. Further, the Complainant has never licensed, authorized or provided consent to the Respondent for it to use any of the Complainant's MARLBORO Marks whether in a domain name or otherwise either at the time the Respondent registered the disputed domain name or any other time since.

Further, as the name is not actively being used and has never been used, this inactivity does not constitute either: (a) a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, or (b) a legitimate noncommercial or fair use, without intent for commercial gain, under paragraph 4(c)(iii) of the Policy. Continuing non-use further reflects the Respondent's lack of rights or legitimate interests in the name.

### **(iii) Registered and Used in Bad Faith**

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

Specifically, the Respondent, having no connection whatsoever with the Complainant, intentionally registered the name, which fully incorporates the Complainant's mark MARLBORO, with full knowledge of and in spite of the Complainant's long-held, exclusive and substantial trademark rights in the US in that mark — rights that predate by over a century the date on which the Respondent registered the name. The Respondent's apparent motive in doing so is to intentionally exploit the substantial reputation inherent in the Complainant's Marks by using the name to cause confusion with those Marks and, by doing so, divert Internet users away from the Complainant's website for the Respondent's own benefit.

Further, ever since the Respondent registered the name in 1999, the disputed domain name has been inactive and the Respondent has merely passively held the registration for the name without manifesting any visible plans to actively use the dispute domain name to resolve to an operational website. Given the substantial reputation which resides in the Complainant's mark MARLBORO, bad faith is reflected in the Respondent having registered the name, which contains the mark, and then passively held the name ever since -- now reaching nearly 8 years.

### **B. Respondent**

The Respondent contends that First Amendment considerations, under the US Constitution, may trump the Complainant's trademark rights.

Specifically, the Respondent cites to decisions of various US Federal Courts (*Bosley Medical Institute v. Kremer*, 403 F.3d 672 (9th Cir. 2005); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); and *Cleary Bldg. Corp. v. David A. Dame, Inc.*, 674 F. Supp. 2d 1257 (D. Colo. 2009)) where in each case a domain name, which included a third-party mark, resolved to a website, commonly called a "gripe site". The site, noncommercial in nature and established by a disgruntled customer, provided content critical of the products or services provided to that customer by the owner of the corresponding mark. Because the site merely provided critical commentary, in each instance the corresponding court did not view the use of the name as cybersquatting and upheld that use as a valid exercise of free speech under the First Amendment.

The Respondent also cites to *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 585 (2d Cir. 2000), where the Second Circuit held: "[d]omain names... *per se* are neither automatically entitled to nor excluded from the protections of the First Amendment, and the appropriate inquiry is one that fully addresses particular circumstances presented with respect to each domain name." The Respondent further states that he has not used the disputed domain name commercially and, as a result, the Complainant is unable prove bad faith and accordingly the Complaint should be dismissed:

"They [Complainant] have no bad faith claim or trademark infringement case as the website has not been used commercially, but it is my right to own the domain and use it within my first ammedment [sic] rights."

He concludes by contending: "There is zero proof of cybersquatting or commercial use of the domain marlborosucks.com and this complaint should be thrown out immediately. ... I would like this case resolved immediately so that I can proceed with my plans for the domain".

### **C. Complainant's Supplemental Filing**

The Rules have no provision which expressly grants a party leave to submit a filing to the Center beyond a complaint or a response, as appropriate. Nevertheless, should either party provide such a filing, such as the Complainant's Supplemental Filing here, then, under Rules 10 and 12, the Panel has the sole discretion to

consider that filing. The Panel, in exercise of its discretion, has considered the Supplemental Filing.

Through the Supplemental Filing, the Complainant contends that each of four federal US cases cited by the Respondent, *Bosley Medical Institute, Lucas Nursery & Landscaping, TMI, Inc.* and *Cleary Bldg. Corp.*, is clearly distinguishable from the present dispute and irrelevant to it primarily because in each case the domain name was used to resolve to an active noncommercial website that provided critical content. Here, the Respondent made and continues to make no use whatsoever of the disputed domain name. The Complainant also points to other distinguishing aspects, including that these cases were decided under the Anti-Cybersquatting Consumer Protection Act (15 U.S.C. § 1051 *et seq.*) whereas the present dispute is governed by the Policy — both involving their own standards for liability and different penalties.

Further, while the Respondent alludes, in its Response, to having “plans” to use the name, it provides no further explanation at all as to what those plans are, or how or when they will be implemented. This intention, without more, is just a vague assertion which does not rise to the level of having sufficient specificity to constitute “demonstrable preparations” as required by paragraph 4(c)(i) of the Policy. Consequently, the Respondent does not have any legitimate rights or interests in the disputed domain name merely arising out of its assertion.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark MARLBORO.

The term “sucks” is a well-known pejorative descriptive word most often, in the Internet community, signifying or otherwise associated with sharp criticism. The Panel takes judicial notice of the fact that a domain name which contains the term “sucks” appended to a mark (e.g., in the form of (mark + sucks).gTLD), typified by the disputed domain name here, generally serves as a signal to an Internet viewer that a website accessed through such a name contains content highly critical, often caustic, in some fashion towards an owner of the mark and/or the goods or services which the owner provides.

Consequently, from a simple comparison of the name to the Complainant’s mark MARLBORO, no doubt exists that the disputed domain name is confusingly similar to the mark. The name <marlborosucks.com> consists of the term MARLBORO followed by the well-known term “sucks”. The name also contains the generic Top-Level Domain (gTLD) “.com”. The addition of the gTLD is generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It has become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain (SLD), that results from modifying the mark, to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent’s incorporation of the term “sucks” to form the SLD clearly constitutes such a minor variation and, as such, does not avoid a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), para. 1.13. Further, see, e.g., *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of*

*Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark MARLBORO. Hence, the Complainant has satisfied its burden 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 support a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant's MARLBORO Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent never did and does not now use nor has ever made any demonstrable preparations to use the disputed domain name to resolve to an operational website through which it does or will make *bona fide* offerings of any goods or services. Passively holding a domain name, which infringes the trademark rights of another, for nearly an 8 year period does not qualify, on any basis, as a *bona fide* offering of goods and services.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by the disputed domain name or any of the Complainant's MARLBORO Marks.

The Complainant's exclusive rights, in the US, in its mark MARLBORO significantly predate, by more than a century, the date, October 5, 1999, on which the disputed domain name was registered. As a result of the Complainant's marketing, promotional and other commercial activities during that time, the mark MARLBORO gained a huge reputation through which it not only acquired fame but also is likely to have become one of the most widely recognized and valuable marks in the US, and very likely in every country into which the Complainant sells its products branded with that mark. Against this backdrop, it is simply inconceivable that the Respondent could ever legitimately acquire either a public association with the mark MARLBORO or even an association with any mark similar to any of the Complainant's MARLBORO Marks — at least for the goods provided by the Complainant under any of those marks — without interfering with and likely infringing upon the exclusive trademark rights of the Complainant. See, e.g., *Compagnie Générale des Etablissements Michelin, supra*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No.

D2015-0787; and *Chicago Mercantile Exchange Inc.*, *supra*; *Cummins Inc.*, *supra*; and *Staatliche Porzellan-Manufaktur Meissen GmbH*, *supra*.

Consequently, the Respondent does not satisfy any of one of paragraphs 4(c)(i)-(iii) of the Policy, and thus the Respondent does not have any rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

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

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

The Panel believes the Respondent was well aware of the Complainant and its mark MARLBORO, and the substantial reputation, goodwill and fame which that mark acquired and the exclusive rights which the Complainant held in its MARLBORO Marks when the Respondent registered the disputed domain name. Nevertheless, the Respondent held the name, without ever using it to resolve to an operational website, for a period now reaching nearly 8 years. Even now, the Respondent merely states that it has "plans" to use the name without defining, with any degree of specificity whatsoever, what those plans are, and when and how they will be implemented. Such a vague assertion leads the Panel to believe that the Respondent has no concrete plans at all to ever use the name to resolve to an operational website and, during the course of holding the name for nearly 8 years, never did.

The disputed domain name, being a "sucks"-based name, could, under a proper set of circumstances, legitimately serve as an address of a noncommercial, operational website, e.g., a so-called gripe site, through which the Respondent posts content critical of the Complainant and/or its cigarette products offered under its mark MARLBORO. However, none of those circumstances has apparently ever existed here and certainly do not now exist. This is plainly evident as one absolutely crucial threshold requirement is glaringly absent: legitimate use. Apart from any illegitimate use, the Respondent has simply never used and does not now use the domain name at all. It merely passively holds the name and has done so for nearly 8 years.

Each of the federal cases which the Respondent cites for the proposition that free speech rights attach to a sucks-based domain name is not only clearly distinguishable from the present facts but is irrelevant to those facts simply because in each such case the name at issue was actually used by a defendant as an address of an operational noncommercial website providing critical comment, an aspect totally missing here. Specifically, in *Bosley Medical Institute*, a disgruntled customer registered and used a domain name incorporating plaintiff's mark for a website detailing investigation against plaintiff and other information "highly critical" of plaintiff). In *Lucas Nursery & Landscaping, Inc.*, a defendant registered a domain name incorporating plaintiff's "Lucas Nursery" mark and pointed that name to a gripe site "on which she detailed her complaints against Lucas for its allegedly bad service in landscaping". In *TMI, Inc.*, a defendant registered and used a domain name confusingly similar to plaintiff home builder's mark "to tell his story" about dissatisfaction with plaintiff's services. Lastly, in *Cleary Bldg. Corp.*, a defendant's gripe site "tell[s] his story and make[s] his complaints and grievances with Plaintiff known."

Consequently, the Panel finds, viewing the salient facts collectively, that the Respondent's acts of first intentionally registering the disputed domain name containing the Complainant's mark MARLBORO, given the substantial reputation and fame inherent in that mark, followed by merely passively holding the name for nearly 8 years constitute bad faith use and registration under paragraphs 4(a)(iii) and 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) 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 name, <marlborosucks.com>, is to be transferred to the Complainant.

**Peter L. Michaelson**

Sole Panelist

Date: June 15, 2017