



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Animals for Advertising, Inc. v. Cathryn Long**

**Case No. D2007-0049**

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

The Complainant is Animals for Advertising, Inc., New York, New York, United States of America, represented by Cooley Godward Kronish LLP, United States of America.

The Respondent is Cathryn Long, White Plains, New York, United States of America.

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

The disputed domain name <animalsforadvertising.com> is registered with Go Daddy Software, Inc. (the "Registrar").

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on January 12, 2007, and in hard copy form, along with accompanying Exhibits A-P, on January 16, 2007.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the

Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on January 15, 2007, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name: specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on January 15, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIS database, and which confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative and technical contacts. The response also confirmed that Go Daddy Software, Inc. is the registrar of that name and stated that: the Registrar had not received a copy of the Complaint, the Policy applied to the disputed domain name, and the name was then held in a “locked” status. The Registrar also indicated, through the response, that: the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the Registrar; and the registration agreement is in English.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules.

On January 19, 2007, the Center formally notified the Respondent, by e-mail letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by courier and without the Exhibits by both facsimile and e-mail. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on January 19, 2007, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on February 8, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant. Upon request by the Respondent and subsequent partial agreement of the Complainant, the Center on February 8, 2007 extended this due date to February 15, 2007.

The Respondent timely filed its Response, in email form on February 15, 2007 and subsequently in hard copy form together with accompanying Exhibits A-S.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated February 28, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on March 1, 2007, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated March 2, 2007, notified the parties of the appointment of Mr. Michaelson as Sole Panelist.

Apparently, the Respondent's courier shipment of the hard-copies of the Response to the Center experienced delays, owing to the weight of that shipment, in clearing customs in Geneva. Accordingly and with the Panel's prior approval, the Center, through an email dated March 6, 2007, instructed the Respondent to send a complete hard copy of the Response, including all the Exhibits, directly to the Panel. The Respondent did so. On March 7, 2007, the Panel received its hard copy of the Response including the Exhibits.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before March 16, 2007. Owing to the delays which the Panel experienced in receiving the Response as well as unexpected time conflicts experienced by the Panel, all of which constitute unforeseen circumstances, the Center extended this due date to March 30, 2007.

This dispute concerns one domain name, specifically: <animalsforadvertising.com>.

The language of this proceeding is English.

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

A copy of the WhoIS registration record for the disputed domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered the disputed domain name on April 16, 2004.

##### **A. Complainant's ANIMAL FOR ADVERTISING mark**

As delineated below, the Complainant claims common law trademark rights in the term ANIMALS FOR ADVERTISING, based on its continuous prior use, over the past 24 years, of that term as a mark used in conjunction with for its services in providing trained animals for use in motion pictures, television and print advertisements, photography shots, television show appearances and special events. The Complainant has no trademark registrations for this term.

##### **B. Complainant**

The Complainant is an animal representation agency based in New York City, owned and operated by Linda Hanrahan. The Complainant provides trained animals for motion pictures, television commercials, print ads, photo shoots, television show appearances, and special events. In addition to providing services to New York-based television shows such as *Late Show With David Letterman* and *Saturday Night Live*, the Complainant's services span across approximately 15 states in the United States of America, as well as in the UK, Italy, Germany and the Caribbean.

Since 1983, Ms. Hanrahan has continually operated the Complainant, first as a sole proprietorship and subsequently since 1998 as a corporation, under its name and mark ANIMALS FOR ADVERTISING. The Complainant's agency is described in "Yes, we have no Piranhas But ...", *Photo District News*, February 1985, a copy of which appears in Exhibit D to the Complaint.

The Complainant states that the animal representation industry is a specialized niche industry comprised of approximately 20 major representative agencies within the United States of America, including both the Complainant and the Respondent.

For the past 20 years, the Complainant has actively marketed and advertised its services in the nationally distributed trade publications: *New York Production Guide* and *Motion Picture TV and Theatre Directory*. Copies of illustrative advertisements which the Complainant recently ran in these publications appears in Exhibit F to the Complaint. Further, since 1985, nationally distributed publications such as: *The New York Times*, *USA Today*, *Photo District News*, and *Blender Magazine* have published stories on Ms. Hanrahan and the Complainant. Copies of illustrative ones of those articles in Exhibit G to the Complaint.

In 1961, when the Respondent was approximately 4 years old, Ms. Hanrahan went to work for Alltame Animals, an agency owned and operated by the parents of the Respondent. Ms. Hanrahan continued to work for the Respondent's family business for approximately 20 years, and thus became well acquainted with the Respondent. Exhibit H to the Complaint contains a copy of a promotional brochure for Alltame Animals, circa 1966, which lists Ms. Hanrahan as an assistant to the director.

The Complainant has never maintained a company website. The Complainant was first alerted to the Respondent's use of the disputed domain name, <animalsforadvertising.com>, when one of the Complainant's customers was directed to the website of the Respondent's company All Creatures Great & Small, while looking for information about the Complainant on the Internet. That customer telephoned Ms. Hanrahan and informed her that anyone typing in the Complainant's mark ANIMALS FOR ADVERTISING as a ".com" URL was then being sent to the Respondent's website.

### **C. Respondent**

The Respondent, Cathryn Long, and her mother, Ruth Manecke, operate an animal representation agency, All Creatures Great & Small of New York, Ltd. ("All Creatures"), that is a direct business competitor of the Complainant. All Creatures was incorporated on September 8, 1998. Given the niche nature of the animal representation business, both the Complainant and the Respondent are well aware of each other and directly compete with each other for assignments.

The Respondent's agency is, as is the Complainant, based in New York, and advertises its services online and in nationally distributed trade publications. Both the Complainant and the Respondent have advertised their competing businesses in some of the same publications for several years. In that regard, separate full page ads are provided in Exhibit L to the Complaint, taken from the same issue of the *New York Production Guide*.

On March 25, 1998, All Creatures registered the domain name <animalagent.com>. Six years later, on April 16, 2004, the Respondent registered the disputed domain

name.

## 5. Parties' Contentions

Inasmuch as both parties raise numerous allegations, then, for the sake of brevity, the Panel will summarize only those allegations which are particularly pertinent to the present decision and only to the extent necessary.

### A. Complainant

#### (i) Identical or Confusingly Similar

First, the Complainant asserts that, as a consequence of its continuous prior use of the term ANIMALS FOR ADVERTISING over the past 20 years as a mark for its animal representation agency, the Complainant has acquired common law trademark rights in that term which are sufficient to invoke paragraph 4(a)(i) of the Policy.

Given those rights, the Complainant appears to assert that, apart from the inclusion of the generic top level domain (gTLD) “.com” in the domain name, the domain name is identical to its 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 various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant contends that, although it never had a website, the Respondent's use of the name, over the past 2 1/2 years and continuing to the present, as a means to direct web traffic to the Respondent's website through which she offers services directly competitive with those offered by the Complainant does not constitute a *bona fide* offering of goods and services. Further, that use is likely to mislead Internet users into believing that the services offered by the Respondent are, in some fashion, affiliated with or endorsed by the Complainant -- when, in actuality, such is not the case. The resulting likelihood of consumer confusion, directly resulting from the Respondent's use of the name, is also inconsistent with a *bona fide* offering of goods and services.

Second, the Respondent, operating the All Creatures agency and prior thereto the “Alltame Animals” agency, has never been and is not now commonly known by the term ANIMALS FOR ADVERTISING.

Lastly, the Respondent, by using the disputed domain name to divert Internet users to the Respondent's website through which the Respondent offers services that directly compete with those of the Complainant, is not using the disputed domain name in a manner that reflects either a legitimate non-commercial use or a fair use.

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

The Complainant contends that, for either of two reasons, the Respondent has registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant contends that the Respondent had been aware of the Complainant's long prior use of the ANIMALS FOR ADVERTISING mark when the Respondent registered the name, thus evidencing bad faith registration.

Second, the Complainant contends that bad faith use is shown by the Respondent's use over the past 2 1/2 years of the domain name, which included the Complainant's mark, to intentionally direct Internet users to the Respondent's website. Through that site, the Respondent offered services for commercial gain that directly competed with those then offered by the Complainant. The Respondent, in spite of her knowledge that the Complainant did not then have a website, nevertheless used that domain name to confuse Internet users who would otherwise be searching for the Complainant's website -- even though such a site did not exist, to the ultimate detriment of the Complainant. Hence, the Complainant contends that the Respondent intentionally selected the disputed domain name in order to trade off the Complainant's trademark rights and reputation, and to disrupt the Complainant's competing business, thus further evidencing bad faith.

## **B. Respondent**

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

The Respondent counters the Complainant's contention by asserting that, for principally two reasons, the Complainant has no common law trademark rights in the term ANIMALS FOR ADVERTISING, namely, that (a) the Respondent, not the Complainant has superior trademark rights in that term, or (b) the term is generic and thus incapable of serving as a trademark for an animal representation agency.

As to the first reason, the Respondent asserts that rather than the Complainant having acquired any secondary meaning in that term, those rights were developed as "celebrity goodwill" by Ms. Manecke who is a founder of AllTame -- an animal representation agency at which the Ms. Hanrahan worked from 1961-1981, and now a co-owner with the Respondent of All Creatures. In that regard, the Respondent asserts that Ms. Manecke actually developed secondary meaning in the term ANIMALS FOR ADVERTISING and did so more than 30 years before the Complainant began its agency -- which the Complainant knew or should have known by virtue of her prior employment with the Respondent. Further, inasmuch as Ms. Manecke was one of the creators of the animal representation industry back in the mid-1950's and has been active in that industry ever since, consumers for those services would most likely associate the phrase "animals for advertising" with Ms. Manecke and not the Complainant.

Moreover, the Respondent asserts that the Complainant's mark ANIMALS FOR ADVERTISING has not become "famous." Specifically, the Respondent states that, due to various factors, the animal advertising industry is apparently local in nature and here being limited to the New York area and hence its publicity is similarly restricted -- as evidenced by the fact that the Complainant has provided examples of advertisements and articles only from the NY media. Thus, as understood by the Panel, the Respondent opines that the Complainant's geographically limited reputation precludes its mark from ever becoming famous and this, in turn, ostensibly precludes the

Complainant from having sufficient trademark rights to invoke paragraph 4(a)(i) of the Policy.

As to the second reason, the Respondent asserts that the Complainant cannot prove that its mark ANIMALS FOR ADVERTISING is not generic. Specifically, the Respondent contends that this mark simply identifies a type of service, rather than its source -- as evidenced by both animal agency competitors and other businesses that appear to use this term as a “generic identifier” (as shown, in Exhibit F to the Response, by printouts of the results of various Internet searches for that mark which the Respondent ran).

(ii) Rights or Legitimate Interests

The Respondent asserts, for what appears to be either of two basic reasons, that the Complainant has no rights or legitimate interests in the disputed domain name.

First, as discussed above and indicated by numerous instances of third-party use, the phrase “animals for advertising” is generic of the service being offered or sought; thus, any claim of exclusivity which the Complainant might have in that term is illegitimate.

Second, the Respondent asserts that she “has a legitimate interest in using this generic descriptive phrase to fairly compete for bids as a means for potential clients to locate her services” and that “she has equal and legitimate rights to the use of this phrase for her Domain Name that serves to assist potential clients in locating All Creatures website when gathering competitive bids.” The Respondent concludes by stating that she “has a legitimate right to employ a generic term in order to fairly compete for clients and bids as do all competitors within this niche industry.”

(iii) Registered and Used in Bad Faith

The Respondent contends that, for any of various reasons, she did not register or use the disputed domain name in bad faith.

First, as best understood by the Panel, the Respondent asserts that she is not a “classic cybersquatter” inasmuch as her business did not: engage in typosquatting, register and warehouse any domain name in an extort payment from a trademark holder by offering to sell that name to that holder, trade on the goodwill of a complainant, or divert Internet users to pornographic websites.

Second, the Respondent asserts that she uses the disputed domain name, not as a means “to divert Internet users from a marker [sic] holder’s online location in a way that could harm goodwill or tarnish or disparage the mark,” but rather as a means “to direct inquiries to find her services.” In that regard, the Respondent claims that her actions manifested her “good faith effort to facilitate use of her already well established website.” Further, the Respondent states that she “honestly believed that use of the Domain Name to direct potential clients to view the company’s website in order to view the credentials of her own firm was proper.”

Third, the Respondent contends that, since the Complainant never had a website, she could not divert any Internet users as the Complainant asserts, as presumably there is no site from which those users would be diverted.

Lastly, the Respondent states that she, not the Complainant, “took the initiative, in good faith, to develop a website and link a generic domain name in order to update her

business's Internet techniques and to promote a family business which was an originator of that very industry 50 years prior.”

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's ANIMALS FOR ADVERTISING 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 a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, 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 ... (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 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 Case No. FA 95560 (November 2, 2000) held: “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.” See, e.g., *William M. Krings v. Hugo Hernandez*, WIPO Case No. D2006-0237 (April 18, 2006); *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a “Nelly” v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, NAF Case No. FA 96795 (May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, NAF Case No. FA 95825 (November 20, 2000); *Mike Warner 2001 v. Mike Larson*, NAF Case No. FA 95746 (November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, NAF Case No. FA 95641 (November 8, 2000); *Home Properties v. SMSOnline*, NAF Case No. FA 95639 (November 2, 2000); and *Bridal Rings Company v. Yemenian*, NAF Case No. FA 95608 (October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, NAF Case No. FA 95757 (November 27, 2000), 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 (December 11, 2000), 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.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, NAF Case No. FA 95970 (December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, NAF Case No. FA 95832 (November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

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 the term ANIMALS FOR ADVERTISING as of the date, April 16, 2004, on which the Respondent registered the disputed domain name.

While some individuals who view this term, in vacuum, could conclude that the term is descriptive and thus not susceptible to acquiring any secondary meaning, the term must be assessed in light of Ms. Hanrahan’s continuous and undisputed use of that term since 1983 -- now for some 24 years -- as the name of her business. When viewed through the prism of the reputation which that business has acquired over that period, as illustratively demonstrated by the articles and advertisements in Exhibit G to the Complaint, this Panel concludes that, over that extended period of time, whatever descriptiveness which term might have had through use by Ms. Manecke and others prior to 1983, has probably given way, at least in some measure, in the minds of the relevant consuming public (e.g., Internet users seeking to rent trained animals for promotions, photo shoots and other endeavors), and been displaced by its association with the Complainant’s business of the same name and its services.

While the degree of distinctiveness which this mark enjoys is clearly open to question, the Policy does not differentiate between those common law marks that are relatively weak and those which enjoy considerable strength. Rather, paragraph 4(a)(i) merely requires that a complainant have trademark or service mark in which it “has rights.” Here, the Panel finds the Complainant has such rights.

Instructively, the Panel points to *WHM L.L.C. v. Northpoint, Inc.*, WIPO Case No. D2005-1134 (January 27, 2006), where, in finding that a complainant held common law trademark rights in the term EL SAN JUAN HOTEL by virtue of its 56 years of continuous prior use as a mark, the panel stated:

“The web pages from various third-party travel-related websites that the Complainant has referenced -which the Respondent has not refuted- show the reputation which the Complainant’s “EL SAN JUAN HOTEL” mark has acquired since that mark was first used with that hotel in 1943 and has been in continuous use ever since. This use began over 56 years prior to the date on which the Respondent registered <elsanjuanhotel.com>. Clearly, the quanta of evidence which the Complainant has adduced is rather underwhelming, to say the least, but as sparse as it is, it suffices. Even though this mark contains a highly geographic descriptor, when that mark is viewed in its entirety and particularly in light of its acquired reputation and 56 years of prior continuous use, it is clear to this Panel that, over the course of that period, whatever primarily geographic descriptiveness that mark may have had at its inception in 1943 has long since

dissipated and has been supplanted, in the minds of the consuming public and more specifically Internet users, by its association with the Complainant's hotel of the same name. Hence, this Panel finds that this mark has acquired sufficient distinctiveness and secondary meaning when used in conjunction with hotel services rendered at the El San Juan Hotel and thus, at least as of February 12, 1999 (if not far earlier in time), constituted a common law trademark."

This case presents a very similar situation. The documentary evidence presented here, as in *WHM*, suffices to confirm the secondary meaning which the Complainant's mark acquired through 24 years of continuous prior use. The fact that this mark was used primarily in the New York City area and its secondary meaning is hence localized, rather than national, is of no import as the Policy makes no distinctions between widespread and localized trademark rights. Nor is there any requirement under paragraph 4(a)(i) that the mark have acquired any fame for it to qualify for protection under the Policy. In that regard, see *Australian Trade Commission v. Matthew Reader* WIPO Case no. D2002-0786 (November 12, 2002), and *UEFA v. Funzi Furniture* WIPO Case No. D2000-0710 (October 22, 2000).

While the Panel concludes that the Complainant has common law trademark rights in its mark ANIMALS FOR ADVERTISING, the Panel is not in a position, by virtue of the summary nature of this ICANN proceeding and the very limited factual record associated therewith, to fully assess challenges to the validity of this mark -- particularly where, as here, the Complainant has submitted proof of its use of the mark in connection with its services and the resulting reputation it has acquired but the Respondent's ultimate success is not immediately and undeniably clear from the record itself. In those instances, this Panel believes that such challenges are best left to an appropriate adjudicatory forum where a rich and full factual record can be developed and analyzed. This proceeding is not such a forum. See this Panel's partial dissenting opinion in *WHM*.

Since, as a predicate, the Panel has found that the Complainant appears to have common law rights in the mark ANIMALS FOR ADVERTISING, then no doubt exists that the disputed domain name is, for all practical purposes, identical to that mark. The difference between the name and that mark is merely the appending of a generic top level domain (gTLD) ".com" to the mark and the omission of spaces between the individual words in the mark. Well-established UDRP precedent 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 identity/confusing similarity and thus is totally ignored. See, e.g., *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <animalsforadvertising.com> is identical to and sufficiently resembles the Complainant's ANIMALS FOR ADVERTISING mark as to cause confusion; hence, the Complainant has shown identity or confusing similarity between that mark and that name under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Panel believes that the Respondent has not provided any basis that would in the circumstances here legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

It is undisputed that, since well before the Respondent registered the domain name, she had been well aware of the Complainant and her animal representation agency named “Animals for Advertising,” which, since 1983, directly competed with that of the Respondent. In spite of that knowledge, the Respondent registered the disputed domain name which is identical to the Complainant’s business name and mark and then proceeded for the next 2 1/2 years to use that name in directing direct web traffic to her own site through which she offered services directly competitive with those then offered by the Complainant.

It is clear to this Panel that the Respondent’s use of the name constitutes opportunistic use and will not constitute *bona fide* commercial or fair use sufficient to legitimize any rights and interests the Respondent might have in the disputed domain name. See, e.g., *WHM*, cited supra, *True Blue Productions*, cited supra; *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al.*, NAF Case No. FA 208576 (January 27, 2004); and *Lockheed, Leiner Health Servs. Corp.*, and *Frampton*, all cited supra.

Moreover, there is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light the Complainant’s continuous use of its mark for the prior 24 years as having been associated with Ms. Hanrahan’s representation agency, without infringing on the exclusive trademark rights of the Complainant.

Accordingly, the Panel is not persuaded that the Respondent has any rights or legitimate interests in the disputed domain name under any provision of paragraph 4(c) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name <animalsforadvertising.com> within paragraph 4(a)(ii) of the Policy.

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

The Panel believes that the Respondent’s actions constitute bad faith registration and use of the disputed domain name.

For the Panel, the overriding element is that the Complainant’s animal representation agency had been in operation for 22 years when the Respondent registered its domain name. Whatever the weakness may be of the evidentiary filing by the Complainant, it stands to reason that the Respondent knew the reputation inherent in the Complainant’s mark ANIMALS FOR ADVERTISING at the time it registered the corresponding domain name and that Internet user confusion would likely occur should it then use that name, but, nevertheless, decided, in spite of that express knowledge, to register that name and exploit the ensuing confusion to its own pecuniary benefit. Clearly, if the Respondent’s goal was to select a term that she thought would generically describe the services provided by her agency and then register a domain name which included that term as a formative, she could certainly have selected any of a likely multitude of terms that were not identical to the Complainant’s mark. Yet, she intentionally choose the Complainant’s mark.

The Panel finds the Respondent’s purported justifications of good faith in its registration and use quite implausible. While she argues that she uses the name, not as a means “to divert Internet users from a marker [sic] holder’s online location in a way that could harm goodwill or tarnish or disparage the mark” but rather as a means “to

direct inquiries to find her services,” yet she does so using a name that identically includes the Complainant’s mark. While doing so will, as the Respondent opines, “facilitate the use of her already well established website,” it will do so at the expense and ultimate disruption of the Complainant’s business -- both of which the Respondent undoubtedly calculated would likely happen through her use of the name. In that regard, a percentage of prospective Internet users then seeking to access the Complainant’s website (which during that time did not exist) and do business with the Complainant, would as a result of the Respondent’s use of the domain name be directed to the Respondent’s website and do business with the Respondent, hence depriving the Complainant of an opportunity to obtain and profit from that business.

Hence, the Respondent’s actions, which were specifically intended to exploit the Complainant’s goodwill in its mark for the Respondent’s own pecuniary benefit and the Complainant’s detriment and, in fact, did so for the past 2 1/2 years during which the Respondent’s website, resolvable through <animalsforadvertising.com>, has been in operation, constitute, by their very illegality, bad faith under paragraph 4(b)(iv) and under the general requirement of paragraph 4(a)(iii) of the Policy as well disruption of the Complainant’s business under paragraph 4(b)(iii). See, e.g., *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004), and *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003).

In that regard, all paragraph 4(b)(iv) essentially requires for a finding of bad faith is that a respondent use a domain name which creates confusion with a complainant’s mark. That much the Respondent certainly did.

Moreover, these conclusions of bad faith are further demonstrated by the Respondent’s knowledge that, during the prior 2 1/2 years during which she used the disputed domain name incorporating the Complainant’s mark and exploited its goodwill, the Complainant did not have a website, and hence did not have any web presence, let alone one which could effectively counter the Respondent’s illicit use of the mark. Thus, the Respondent gained an even greater advantage over the Complainant at the latter’s expense than if the Complainant had then operated an active website.

Without any doubt whatsoever, this Panel is not persuaded that the Respondent, as she seemingly exhorts, “honestly believed that use of the Domain Name to direct potential clients to view the company’s website in order to view the credentials of her own firm was proper.”

Hence, the Panel views the Respondent’s actions as constituting bad faith registration and use of the disputed domain name <animalsforadvertising.com> in violation of paragraph 4(a)(iii), as well as paragraphs 4(b)(iii) and 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations 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, <animalsforadvertising.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Date: March 30, 2007