



NATIONAL
ARBITRATION
FORUM

NATIONAL ARBITRATION FORUM

DECISION

CafePress.com v. Michael Fragomele
Claim Number: FA0502000428848

PARTIES

Complainant is **CafePress.com** (“Complainant”), represented by **Jill M. Pietrini**, of **Manatt, Phelps and Phillips, LLP**, 11355 W. Olympic Blvd., Los Angeles, CA 90064. Respondent is **Michael Fragomele** (“Respondent”), represented by **Steve S. Moutsatsos**, of **Weaver Simmons LLP**, 233 Brady Street, Sudbury, ON P3B 4H5, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**canpress.com**>, registered with **Domainpeople Inc.** (“**Domainpeople**”).

PANEL

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

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, 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 ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum electronically on February 22, 2005; the National Arbitration Forum received a hard copy of the

Complaint, together with Exhibits 1-3 and a declaration of Ms. Candice Carr (itself containing a separate set of exhibits numbered 1-3), on February 22, 2005, and within the time limit allotted, submitted a slightly amended Complaint to correct various minor deficiencies.

On February 22, 2005, the Registrar, Domainpeople, confirmed by e-mail to the National Arbitration Forum that the domain name <**canpress.com**> is registered with Domainpeople Inc. and that the Respondent is the current registrant of the name. Domainpeople Inc. has verified that Respondent is bound by the Domainpeople Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On March 1, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of March 21, 2005 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@canpress.com by e-mail.

A timely Response was received and determined to be complete on March 21, 2005.

Subsequently and pursuant to Supplemental Rule 7, Complainant timely filed an additional submission on March 28, 2005.

Thereafter and also pursuant to Supplemental Rule 7, Respondent timely filed an additional submission on April 5, 2005.

On March 29, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as the Panelist and set a deadline of April 12, 2005 to receive the decision from the Panel. Due to exceptional circumstances experienced by the Panel, the Forum, at the Panel's request, extended this deadline to April 29, 2005.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant contends that the disputed domain name is confusingly similar to Complainant's "CAFEPRESS.COM" marks. In that regard, Complainant points

to various factors which, associated with a likelihood of confusion test, collectively support its view. Specifically, and in context of the present dispute, the Complainant believes that its marks are relatively strong; the Complainant and Respondent offer identical services; the disputed domain name and the marks differ by only a few letters but are otherwise the same; both parties use identical marketing channels in selling their respective services; the end customers of both the Complainant's and Respondent's services are generally not sophisticated purchasers; and while the Respondent may not have intended to deceive the purchasing public by choosing the disputed domain name, nevertheless the Respondent was aware of the Complainant's mark when the former choose and adopted the disputed domain name.

Consequently, Complainant believes that it has satisfied the requirements of paragraph 4(a)(i) of the Policy with respect to the disputed domain name.

2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant predicates its view on the following reasons:

(a) Complainant never provided its authorization, license or consent to Respondent to permit the latter to use the disputed domain name for the same services offered by Complainant.

(b) Respondent has not made any legitimate use of the disputed domain name in connection with a bona fide offering of goods and services. In that regard, Complainant notes that Respondent does not own a trademark registration for the term "CANPRESS.COM" or "CANPRESS" nor has he made any bona fide offering of goods or services under the name or term, prior to the Complainant's use of its marks. Further, Complainant alleges that Respondent was actually and fully aware of Complainant's "CAFEPRESS.COM" marks when Respondent adopted the disputed domain name and thus, its subsequent use of that name does not qualify as being "bona fide."

(c) Respondent is not commonly known by the disputed domain name. By virtue of being a "shopkeeper," under a contractual agreement with Complainant, Respondent is not authorized to use a mark that is confusingly similar to the Complainant's "CAFEPRESS.COM" marks but did so nevertheless.

(d) Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain. Here, Complainant alleges that Respondent financially gains by misleadingly diverting consumers, through use of the disputed domain name which differs by two letters from Complainant's domain name, away from Complainant's web site and to Respondent's competitive site instead.

3. Bad faith use and registration

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

In that regard, Complainant specifically alleges Respondent's bad faith is evidenced by the following:

(a) Respondent has had an account with CafePress.com since April 22, 2003;

(b) with full knowledge of Complainant's rights in its domain name <cafepress.com>, Respondent, during July 2003, registered the disputed name <**canpress.com**>, which differs by only two letters from Complainant's name; and

(c) not only did Respondent register a similar domain name, he also copied Complainant's services, as well as the layout and specific portions from Complainant's web site thus violating Complainant's copyrights, in order to attract internet users to Respondent's site for his commercial gain. Though Complainant raises questions of copyright infringement, the Panel is simply incompetent to assess any such issue -- as doing so lies outside of its jurisdiction under the Policy; thus, it dispenses with any further discussion of the issue.

Based on these contentions, Complainant asserts that one could reasonably infer that Respondent's intention in becoming a "shopkeeper" of Complainant was solely to learn of Complainant's services offered under its CAFEPRESS.COM marks, and then to register a very similar domain name and substantially copy Complainant's web site all for Respondent's own commercial gain. As evidence of the Respondent's intent, the Complainant opines that the dates of the Respondent's actions relative to the Complainant's activities are not a coincidence and inescapably lead one to conclude that Respondent's actions constitute bad faith.

B. Respondent

1. Confusing similarity/identity

Not surprisingly, Respondent contends that the disputed domain name, <**canpress.com**>, is neither identical nor confusingly similar to the Complainant's domain name, <**cafepress.com**>, or more generally speaking the CAFEPRESS.COM Marks.

Specifically, Respondent while acknowledging that the name and marks share a common formative term "PRESS," that term simply reflects the business of both Complainant and Respondent, i.e., pressing digital images onto various merchandise. Respondent then points to the remaining portion of its name "CAN" which is meant to connote the Canadian nature of its services, which

sharply contrasts with the term "CAFE" used by Complainant in its marks and name. As such, when the disputed name is viewed in its entirety, that name suggests a "Canadian photo pressing service that can print digital photos onto virtually any merchandise."

Given the differences between the disputed domain name and Complainant's domain name and its CAFEPRESS.COM marks, Respondent asserts that the former is not identical to the latter two.

As to confusing similarity, Respondent asserts that, for various reasons, the disputed domain name is not confusingly similar, under either a source confusion or initial interest confusion analysis, to Complainant's domain name and its CAFEPRESS.COM marks. The Panel, in light of its conclusions below and in the interest of brevity, sees no reason to specifically dwell on any of these reasons.

2. Rights and legitimate interests

Respondent contends that, under paragraph 4(a)(ii) of the Policy, he has legitimate rights and interests in the disputed domain name and thus rebuts Complainant's assertions to the contrary.

First, Respondent states that his use of the disputed domain name in connection with a bona fide offering of goods or services predates any notice from Complainant of the present dispute.

Second, Respondent contends that his business is commonly known in and around the town of Sudbury, Ontario (where Respondent is based) by the name "CANpress".

Lastly, Respondent contends that he is making legitimate and fair use of the disputed domain name without any intent to misleadingly divert customers from Complainant's web site or to tarnish Complainant's CAFEPRESS.COM marks. In that regard, Respondent argues that Complainant has simply not provided any evidence to the contrary.

3. Bad faith use and registration

For several reasons, Respondent contends that his behavior does not reflect bad faith registration and use under paragraph 4(b) of the Policy.

Specifically, Respondent alleges there is no evidence of record that shows:

(a) Respondent registered the disputed name primarily for the purpose of selling or otherwise transferring that name to Complainant.

(b) Respondent registered the disputed name in order to prevent Complainant from reflecting its mark in its domain name -- which in fact the Complainant has already done.

(c) Respondent's use of the disputed name has disrupted or otherwise interfered with Complainant's business. In that regard and as discussed above, Respondent notes that Complainant has failed to provide evidence of any consumer confusion, whether likely or actual, resulting from Respondent's use of the disputed name or of any disruption to Complainant's business as a result of such use, let alone that Respondent's primary purpose in registering the name was to cause any such disruption.

Further, Respondent alleges that given minimal, if any, source or initial interest confusion flowing from his use of the disputed domain name, the Complainant has failed to prove that Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's CAFEPRESS Marks as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or service.

C. Additional Submissions

Inasmuch as both Complainant and Respondent timely filed its respective additional submission, the Panel has appropriately considered both of these submissions.

With respect to the issue of confusing similarity, each of these submissions continues the parties', rather strident, debate over whether the disputed domain name is confusingly similar to the Complainant's CAFEPRESS.COM marks and, if so, the affect thereof, and more specifically the applicability of the various tests for determining whether such confusion is likely and the analysis of the appurtenant factors underlying those tests. As all these issues are moot in light of the Panel's conclusion below, the Panel sees no benefit in summarizing these specific arguments, let alone further considering them.

Further, as to legitimate rights and interests, Complainant alleges that:

- (a) Respondent has not provided any evidence to support his contention that his business is known by the term "CANPRESS.COM" and specifically that Respondent, contrary to his claims, has since September 2003 offered any services on a bona fide basis through a retail outlet in Sudbury, Ontario; and
- (b) Respondent, while claiming to be making legitimate and fair use of the disputed domain name, has not provided requisite evidence to support it.

Regarding bad faith, Complainant points to the following chronology as illustrating that Respondent adopted the disputed domain name only after he

became a "shopkeeper" of Complainant's business, CAFEPRESS, and thus learned Complainant's business model, thus evincing bad faith:

- a) April 2003 -- Respondent first became a shopkeeper of CAFEPRESS (and continues to this day to be one);
- b) July 2003 -- Respondent registered the disputed name (3 months after being a shopkeeper of CAFEPRESS); and
- c) September 2003 -- Respondent, some five months after he became a shopkeeper of CAFEPRESS, supposedly began operating a CANPRESS retail outlet in Sudbury, Ontario, Canada, in direct competition with CAFEPRESS.

Respondent, for its part, states, with reference to the declarations of Mr. Michael Fragomele (dated April 4, 2005 and submitted with the Respondent's Additional Submission) and Mr. Brad Tompkins who is Complainant's private investigator in Sudbury, Ontario (his declaration was submitted with Complainant's Additional Submission):

- a) CANpress has been operating in Sudbury, Ontario since September of 2003;
- b) CANpress had its grand opening on December 10, 2003. It was then located in the City Centre, next to "A Buck or Two," in downtown Sudbury, Ontario;
- c) The present dispute first came to the attention of Complainant in November of 2004 with Respondent then having first received notice of it in December of 2004, more than one year after CANpress began operating in Sudbury, Ontario; and
- d) Respondent was using its domain name in connection with a bona fide offering of goods and services long before he received any notice of the present dispute.

Further, the Respondent states that, for the following reasons, it has been commonly known in and around Sudbury, Ontario by the term "CANpress":

- a) Respondent has been operating a retail outlet in Sudbury, Ontario since September, 2003;
- b) Respondent has advertised itself in the local media (referencing Tompkins declaration);
- c) Respondent is listed in the local telephone directories (referencing Tompkins declaration);
- d) Respondent held its grand opening in Sudbury's Tom Davies Square in Dec. 2003 (referencing Tompkins Declaration); and
- e) the "Stepping Stone Program" (a program that supports young entrepreneurs in and around the City of Greater Sudbury) featured CANpress in one of its on-line articles (here too referencing the Tompkins declaration).

Lastly, as to bad faith, the Respondent counters the Complainant's allegations by again pointing to a lack of supporting evidence as well as asserting that the disputed domain name is not confusingly similar to the disputed domain name so all of Complainant's allegations predicated on a finding of such similarity must necessarily fail.

FINDINGS

A copy of the WhoIs registration record for the disputed domain name appears in Exhibit 1 to the Complaint. This record indicates that Respondent registered <canpress.com> on July 16, 2003.

A. Complainants' CAFEPRESS Marks

Complainant currently owns three federal trademark registrations for the term "CAFEPRESS.COM," and has provided, in Exhibit 1 to the Carr Declaration, a copy of the registration certificate of each mark. The pertinent details are as follows:

1. CAFEPRESS.COM (stylized)
registration: 2,824,950; registered: March 23, 2004

This mark was registered for use in connection with "specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized advertising materials, namely, customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mouse pads, totebags, bumper stickers and posters; computerized online retail stores featuring customized t-shirts, sweatshirts, baby doll-t-shirts, baseball caps, coffee mugs, mouse pads, totebags, bumper stickers and posters; management services, namely, online business development services, namely, providing start-up support for businesses of others; business development services, namely, retail and storefront development services; business management services; order fulfillment services; customer services in the field of specialty merchandising and product manufacturing, supplying and order fulfillment", all in international class 35; and "manufacture of customized advertising materials and specialty merchandise for others, namely, customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mouse pads, totebags, bumper stickers and posters", all in international class 40. This mark claims, for both classes, a first use and first use in commerce date of June 1, 2002.

2. CAFEPRESS.COM (block letters)
registration: 2,571,049; registered: May 21, 2002

This mark was registered for use in connection with "specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized advertising materials, namely, customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mouse pads, totebags, bumper stickers and posters; and computerized on-line retail stores featuring customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mousepads, totebags, bumper stickers and posters", all in international class 35. This mark claims a first use date of June 30, 1997 and a first use in commerce date of July 31, 1997.

3. cafepress.com (stylized and with logo)
registration: 2,569,567; registered: May 14, 2002

This mark was registered for use in connection with "specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized advertising materials, namely, customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mouse pads, totebags, bumper stickers and posters; and computerized on-line retail stores featuring customized t-shirts, sweatshirts, baby doll t-shirts, baseball caps, coffee mugs, mousepads, totebags, bumper stickers and posters", all in international class 35. This mark claims a first use date of June 30, 1997 and a first use in commerce date of July 31, 1997.

In addition to these marks, the Complainant also owns domain name registrations for <cafepress.com> and <cafeshops.com> and web sites accessible through those names.

B. Complainant

Complainant is a privately owned company based in San Leandro, California. Complainant permits individuals, organizations and businesses to create, buy and sell customized merchandise online using its print-on-demand and e-commerce services. Currently, the Complainant has nearly 2 million members who have created more than 6 million original designs on more than 70 customizable products ranging from apparel, home and office accessories to music and data CDs and books, to prints, posters and cards.

Through Complainant's business, a so-called "shopkeeper" (or member) can set up a shop on Complainant's <cafepress.com> web site. That shopkeeper can then select the merchandise available to him through the Complainant's service and customize it, e.g., imprint the shopkeeper's favorite photograph or design on a t-shirt. The shopkeeper can then sell that t-shirt through his shop on the <cafepress.com> site. The Complainant prints the merchandise, as customized or designed by the shopkeeper, and ships the product to the shopkeeper or his designated customer.

Through independently run shops, as well as syndicated and corporate stores, the Complainant offers various aspects of doing business online for its members, including storefront development, site hosting, order management, fulfillment, secure payment processing, and quality customer service, thereby enabling anyone to open a free shop with no upfront costs and no inventory to maintain, thus allowing those individuals to easily expand their on-line presence.

Complainant has 17 federally registered copyrights on various aspects of its website content (copies of the copyright registration certificates appear in Exhibit 2 to the Carr declaration) including: its Intellectual Property Rights Policy, Shopkeeper FAQs (Frequently Asked Questions), Terms of Service, and overall look and feel of its CafePress.com web site.

C. Respondent

Respondent, doing business as CanPress.com, offers customized digital photo merchandise at a retail store located in Sudbury, Ontario, Canada as well as online at <**canpress.com**>. As noted above, Respondent registered the disputed domain name on July 16, 2003.

The Respondent began operating its retail store in September 2003 and the online component of its business began in March of 2004. Both have been operating ever since.

Respondent is a current user of the CafePress.com service and has been a CafePress.com "shopkeeper" since April 22, 2003. Respondent has three CafePress.com shops: the "buggutz" shop, the "TAT2" shop; and the "test12341234" shop. Respondent opened his first CafePress.com shop on April 22, 2003 and opened its last shop, the "test12341234" shop, on August 8, 2003. In the "test12341234" shop, Respondent created merchandise with the text "CanPress Coming Soon ! October, 2003."

D. General dispute between the parties

The parties are apparently involved in a broad business dispute, of which the present domain name dispute is but one component, flowing from Respondent's status as one of Complainant's "shopkeepers" and Respondent's subsequent opening, under the presently disputed domain name, of its own business directly competitive to that of the Complainant. While the Panel will not opine on this broad dispute, nevertheless the Complainant's general allegations, as follows, place the present domain name dispute in its proper context.

First, Complainant states that Respondent presently offers the exact same services as Complainant, including allowing his customers to upload content and create customized merchandise that they can then sell in shops or purchase themselves.

Complainant generally alleges that the Respondent copied Complainant's business model and web site content, and infringed on the Complainant's trademarks and copyrights all in an effort to unfairly compete with Complainant's CafePress.com service by passing off his business as affiliated with, or connected to, CafePress.com.

In that regard, Complainant alleges that Respondent used Complainant's CafePress.com service to learn intimate details of how CafePress.com does business and the services that

it offers and then registered a confusingly similar domain name in order to lure potential CafePress.com customers to his site and unfairly compete with CafePress.com.

Further, Complainant also alleges that the Respondent copied, almost word-for-word, Complainant's copyrighted CafePress.com Intellectual Property Rights Policy, Terms of Service, and Shopkeeper FAQs sections of its site. In that regard, Respondent's web site takes his customer through virtually the same process, with the same links, and many of the same features as Complainant's websites. Further, certain pages of Respondent's web site are nearly identical, or at least substantially similar, to the corresponding pages on Complainant's websites.

Complainant also alleges that, apart from Respondent's willful trademark infringement and dilution, copyright infringement, bad faith registration of the disputed domain name and unfair business practices, Respondent has also violated Complainant's Terms of Service, Shopkeeper Agreement and Privacy Policy. Specifically, in order to become a CafePress.com shopkeeper, Respondent had to agree to Complainant's Terms of Service, Shopkeeper Agreement and Privacy Policy. Anyone who does not agree to be bound by these policies cannot become a CafePress.com shopkeeper. Complainant's Terms of Service includes a provision which grants a shopkeeper a limited, revocable license to access Complainant's websites and Complainant's service for its intended purpose. The Terms of Service expressly provide that this license does not include the right to collect or use information contained on Complainant's websites for purposes prohibited by CafePress.com, create derivative works based upon the content of Complainant's websites, or download or copy Complainant's websites.

With reference to Respondent's web site, the Complainant alleges that Respondent's Intellectual Property Rights page is a direct reproduction of Complainant's Intellectual Property Rights Policy page. Likewise, Respondent's Storeowner FAQs are substantially similar to Complainant's Shopkeeper FAQs. Finally, Respondent's User Agreement contains sections that have been taken almost word for word from Complainant's Terms of Service page.

E. Knowledge of the present dispute

Complainant first learned of the Respondent's allegedly offending activities during November 2004. Consequently and on December 22, 2004, Complainant's counsel sent a cease and desist letter (a copy of which appears in Exhibit 2 to the Complaint) to Respondent alleging trademark and copyright infringement and demanding, among other things, transfer of the disputed domain name. By letter dated January 7, 2005 (a copy of which appears in Exhibit 3 to the Complaint), Respondent replied to counsel and refused all of counsel's demands.

DISCUSSION

A. Jurisdiction

As a general matter, the pleadings are rife with allegations of general trademark infringement, copyright infringement, unfair competition and other allegations all outside the purview of the Policy.

An ICANN panel is solely entrusted under the Policy with determining questions of cybersquatting which is a highly focused and specific form of trademark infringement. Issues such as trademark infringement lie completely outside the narrow confines of cybersquatting and hence the very limited jurisdiction of any ICANN panel. Accordingly, the Panel leaves all such issues for resolution by appropriate judicial tribunals. See, e.g., this Panel's recent decision in *Lockheed Martin Corporation v. The Skunkworx Custom Cycle* WIPO Case No. D2004-0824 (January 18, 2005).

Lately, this Panel is seeing a very disturbing trend, namely, an increasing number of ICANN complaints which at their core are nothing more than broad business disputes that happen to be colored by allegations of cybersquatting, where on close examination the latter are often found quite wanting. Such complaints have absolutely no basis being before an ICANN panel. Nevertheless, as this Panel surmises, they are intentionally filed, simply as a "strong arm" tactic to exert sufficient leverage on a respondent, through a modality that is typically much less expensive and much more time-efficient than conventional litigation, in order to force that respondent to desist from whatever activity the complainant happens to find offensive.

This Panel, like others, being highly cognizant and mindful of its limited role, competence and jurisdiction, clearly admonishes all would-be complainants against filing such complaints as those complaints and the ensuing ICANN proceedings involve nothing more than wasted time, effort and expense for all concerned.

The remedies which any ICANN panel can award under the Policy are sharply limited, under Paragraph 4(i) of the Policy, to transfer or cancellation of the registration of the disputed domain name(s) and unfortunately and regrettably do not extend to any award of sanctions, let alone sufficient to deter such intentional errant and misguided complaints. As such, this Panel must and does limit its action to only that which it can legitimately do: categorically refusing Complainant's implicit invitation to opine on any such issue over which it has absolutely no jurisdiction. Consequently, the Panel will limit its consideration to just those allegations and defenses that directly concern the three elements of cybersquatting as specifically defined under the Policy -- thus considerably simplifying its efforts and this decision.

B. Policy elements

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and

documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

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

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

Rights or Legitimate Interests

The Panel finds that Respondent has rights and legitimate interests in the disputed domain name and specifically under paragraph 4(c)(i) of the Policy.

Paragraph 4(c)(i) states that a respondent has rights and legitimate interests in a domain name that respondent, before it receives any notice of the dispute, has made “demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.”

The record unequivocally reflects that Respondent registered the disputed domain name on July 16, 2003 and started using that name in connection with his offering of on-line printing services in March 2004 -- some nine months before Complainant's counsel, through its letter of December 22, 2004, notified Respondent of the present dispute.

Respondent obviously knew of Complainant's business as early as April 22, 2003 when it became a "shopkeeper" and began engaging in business with Complainant. Obviously, Respondent started learning about Complainant's business and its business methodology on that date, if not earlier. Yet, Respondent's acts alone are insufficient to impute any objection from Complainant onto Respondent so as to constitute adequate notice under paragraph 4(c)(i) of the Policy. In that regard, paragraph 4(c)(i) states, in pertinent part, that a respondent has rights and legitimate interests in a domain name if "before *any notice to you* of the dispute", the respondent used the domain name "in connection with a bona fide offering of goods or services" [emphasis added].

The Panel interprets the wording of "any notice to you" as requiring actual notice from a complainant, not notice by implication or inference. Imputing requisite notice on a respondent, simply by virtue of its own actions and prior to the receipt of actual notice from a complainant, would require the respondent to speculate about the complainant's perceptions and intentions, possibly erroneously so and hence to the ultimate detriment of the respondent. A complainant has an affirmative duty not only to object to a

respondent's conduct but equally importantly to actually notify the respondent of that objection. It is only when the respondent is placed on actual notice that the dispute, for purposes of paragraph 4(c)(i) of the Policy, can be said to begin. While such notice need not be in writing -- and paragraph 4(c)(i) is devoid of any such written requirement, due process requirements dictate that the complainant's objections must be adequately communicated to the respondent both in an appropriate manner and with sufficient content to properly place the respondent on notice of its objectionable conduct.

Complainant simply supplied no supporting evidence, let alone persuasive, that it provided actual notice of the present dispute to Respondent at any time prior to March 2004 when Respondent first started using the domain name in connection with its on-line commercial offerings. Further, the Panel, strictly in light of the present record, is also not persuaded that those offerings were not bona fide.

Therefore, Respondent has met its burden under paragraph 4(c)(i) of the Policy. Accordingly, the Respondent has sufficiently demonstrated that it has rights and legitimate interests in the disputed domain name, and, as such, has met the requirements of paragraph 4(c) of the Policy.

Identical and/or Confusingly Similar; Registration and Use in Bad Faith

In light of the Panel's finding that the Respondent has rights and legitimate interests in the disputed domain name, all issues as to whether: (a) under paragraph 4(a)(i) of the Policy, the disputed domain name is confusingly similar or identical to the Complainant's CAFEPRESS Marks; and (b) under paragraph 4(a)(iii) of the Policy, the Respondent's actions amounted to bad faith use and registration of the name are now moot. Thus, the Panel declines to consider these issues any further.

DECISION

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist

Dated: April 27, 2005