



# **WIPO Arbitration and Mediation Center**

## **ADMINISTRATIVE PANEL DECISION**

### **Dell Computer Corporation v. Logo Excellence**

**Case No. D2001-0361**

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

The Complainant is Dell Computer Corporation, a Corporation of the State of Delaware, having a principal place of business at One Dell Way, Round Rock, Texas 78682, USA.

The Respondent is Logo Excellence, 1211 Eddington, Houston, Texas 77023, USA.

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

The contested Domain Names, ten in number, are <dellconnect.com>, <delletrade.com>, <delle-trade.com>, <delleway.com>, <delle-way.com>, <dellfirst.com>, <dellmight.com>, <dellpower.com>, <dellwebsite.com> and <dellwork.com>.

The Registrar is Domains Direct, Tucows, Inc., 96 Mowat Avenue, Toronto, Ontario, Canada M6K 3M1.

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("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 ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999 and supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 ("Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on March 13, 2001, and in hard copy, with Annexes A-Q, as well as the appropriate payment on March 20, 2001. The Complainant's attorneys, stated that they separately served a copy of the Complaint, by courier, on the Respondent and, by email, on the Registrar.

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 original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 16, 2001, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to each of the contested domain names; specifically, contact and registrant information for each such 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 ICANN Policy applies to the contested domain names, and (b) the current status of each such domain name. In its original verification request, the Center inadvertently omitted one of the contested domain names, specifically <dellconnect.com>. As such, by email dated May 2, 2001, to the Registrar, the Center also requested the Registrar to specify the same information for the missing domain name <dellconnect.com>. On March 21, 2001 and May 2, 2001, the Registrar provided its responses to the Center through which the Registrar collectively provided contact information pertinent to each of the ten contested domain names from its WHOIS database, confirmed that Tucows, Inc. is the registrar of each of the contested domain names, stated that the Policy is in effect for each of the contested domain names, and each such name was then in a "hold" status. In its March 21, 2001 response, the Registrar indicated that it had not received a copy of the Complaint.

On March 26, 2001, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, both in email and hard copy form, to the Respondent (with the latter method forwarding a copy of all the annexes as well). 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 March 26, 2001 under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and the Registrar, in detail, 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 April 14, 2001 to file its response with the Center and serve a copy of the response on the Complainant.

As of March 27, 2001, the Center received an email message, apparently in the context of a Response, from the Respondent through which the Respondent contested the Complaint. On March 28, 2001, the Center issued, by email, a Response Deficiency Notification to the Respondent through which the Center indicated that the Response, specifically the email received on March 27, 2001, was deficient as a response because it was not compliant with the Rules and Supplemental Rules. In particular, the Center specified that the Response was not submitted in one original and four copies, did not specify either a preferred address or preferred method for communications to the

Respondent or its authorized representative, did not state that a copy of the Response was sent to the Complainant, did not contain the full statement required by paragraph 5(b)(viii) of the Rules, and was not signed by the Respondent or its representative. Through a series of email correspondence between the Respondent and the Center, the Respondent submitted its Response, that cured the noted defects, on April 2, 2001, which was also received by the Center in signed hard-copy form on April 9, 2001.

Accordingly, pursuant to the Rules and Supplemental Rules, on April 10, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. On the same day, 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 April 18, 2001, notified the parties of the appointment of Mr. Michaelson as the panelist.

Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before May 1, 2001.

Subsequent to the Panel's appointment and between April 18-20, the Respondent sent further email communications, evidently supplementing its Response, to the Center, the Panel and the Complainant.

On April 30, 2001, the Panel, in view of a time conflict it was experiencing, extended the due date of its decision by one-week to May 8, 2001.

This dispute concerns ten domain names, specifically <dellconnect.com>, <delletrade.com>, <delle-trade.com>, <delleway.com>, <delle-way.com>, <dellfirst.com>, <dellmight.com>, <dellpower.com>, <dellwebsite.com> and <dellwork.com>.

The language of this proceeding is English.

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

A copy of the WHOIS registration record for each of the contested domain names appears in Annex A to the Complaint.

The Complainant currently owns more than thirty U.S. trademark registrations and pending applications for marks that contain the word "DELL". These marks include the following four registrations, on which this dispute is based. A copy of each of the registrations, as issued by the United States Patent and Trademark Office (PTO), appears in Annex C to the Complaint. For ease of reference, the Panel will collectively refer to these registered marks as the "DELL" marks. The earliest three marks (labeled (c)-(e) below) have each become incontestable under the Lanham Act as a result of the registrant having filed, and the PTO having accepted, suitable declarations of continued use and incontestability under §§ 8, 15 of the Lanham Act (15 USC §§ 1058, 1065).

##### **a) WWW. DELL.COM**

US registration 2,390,851; registered October 3, 2000

This trademark was registered, for use in connection with: "Computers, computer peripheral devices, namely, monitors, keyboards, printers, mouses, co-processors,

modems, hard and floppy disk drives, dvd drives, electronic or magnetic cards for memory add-on and memory boards and chips, data storage units, namely, fibre channel drives and SCSI (small computer system interface) drives, cables and connectors, parts and fittings for all of the above, all for use with computers; computer operating software and instruction manuals (all sold together as a unit)" in international class 9. This mark claims first use and first use in inter-state commerce of December 31, 1997.

**b) DELL (block letters)**

US registration 2,236,785; registered April 6, 1999

This service mark was registered, for use in connection with: "Custom manufacture of computers for others", in international class 40. This mark claims first use and first use in inter-state commerce of November 1, 1987.

**c) DELL (stylized)**

US registration 1,860,272; registered October 25, 1994

This trademark was registered, for use in connection with: "Computers and parts therefor", in international class 9. This mark claims first use and first use in inter-state commerce of July 31, 1992.

**d) DELL (block letters)**

US registration 1,616,571; registered October 9, 1990

This trademark was registered, for use in connection with: "Computers and computer peripherals, namely monitors, keyboards, printers, mice, co-processors, modems, hard and floppy disk drives, tape drives, cards and memory add-ons, memory boards and chips, cables and connectors, operating software and instruction manuals sold together as a unit", in international class 9. This mark claims, for both classes, first use and first use in inter-state commerce of November 31, 1987.

**e) DELL (stylized)**

US registration 1,498,470; registered August 2, 1988

This trademark was registered, for use in connection with: "Computers", in international class 9. This mark claims first use and first use in inter-state commerce of November 31, 1987.

The Complainant is the world's largest direct seller of computer systems, with revenues of approximately \$25.3 billion in its 2000 fiscal year (February 1, 1999 to January 31, 2000). Founded in 1984, the Complainant began using the name and mark "DELL" as a trade name, trademark and service mark in 1987. Since that time, the Complainant has made extensive and prominent use of its "DELL" marks in connection with a wide range of computer related goods and services, including offering its goods and services online through such web sites as <www.dell.com>.

The Complainant spends millions of dollars each year in advertising and promoting its trademarks, products, services and image, thereby creating substantial goodwill in its

marketplace. During the 2000 fiscal year, the Complainant spent over US \$300 million in advertising and promotion. As a result of these efforts, the mark "DELL" has become an asset of incalculable value to the Complainant.

In addition to the "DELL" marks, Complainant uses a family of marks consisting of the term "DELL" combined with another term. These include, but are not limited to, the registered marks "DELL DIMENSION", "DELL PRECISION", "DELLWARE", "DELL TALK", "DELL DOLLARS", "DELLWARE FACTS LINE" and "DELL FINANCIAL SERVICES", as well as marks for which trademark/service mark applications are currently pending, such as "DELL4ME", "DELL E COM", "DELL HOST", and "DELL WEBPC". Annex D to the Complaint contains a copy of the registration for each of those marks that have been registered and, for each of the pending applications, either a corresponding official filing receipt or information accessed from the PTO web site.

The mark "DELL" and variations are also registered by the Complainant in more than 130 countries around the world.

The Complainant conducts business on the Internet through numerous "DELL" domain names, including <dell.com>, <dellcomputers.com>, <delldirect.com>, <dellnet.com>, <dellhost.com>, <dellauctions.com>, <dellplus.com>, <dell4me.com> and others. The earliest domain name, <dell.com>, was registered on November 22, 1988. The Complainant's online Internet presence is extremely important to its business. In that regard, by the end of fiscal year 2000, online Internet sales to the Complainant's customers reached nearly 50 percent of its revenue and averaged approximately US \$ 40 Million per day.

In August of 2000, the Complainant became aware that the Respondent had registered all the contested domain names.

On December 27, 2000, the Complainant, through its attorneys, contacted the Respondent by way of letter sent via email and overnight courier. This letter, a copy of which appears in Annex E to the Complaint, informed the Respondent that the contested domain names infringed the Complainant's trademark rights. Through that letter, the Complainant requested that the Respondent transfer all the domain names to the Complainant.

On January 3, 2001, Mr. Byron Hoffman replied to the Complainant's attorney via email. In the response, a copy of which appears in Annex F, Mr. Hoffman requested additional time to respond in order to seek counsel. On that same day, January 3, 2001, counsel for the Complainant sent an email reply to Mr. Hoffman, a copy of which appears in Annex G, through which counsel agreed to provide additional time.

On January 9, 2001, Mr. Hoffman responded to the request of the Complainant's counsel. Through his response, a copy of which appears in Annex H to the Complaint, Mr. Hoffman stated that he had purchased the names for his own use, claimed that he was known by his middle name "Dell" and had never been addressed by or gone by any other name, including his given first name.

The Respondent and Mr. Hoffman had been previously found to have registered a domain name which was confusingly similar to another party's trademark in bad faith with no legitimate rights to use that name. See *Businessway Computer Centers Inc. v. Logo Excellence* AF-0217 (e-Resolution July 18, 2000) wherein the panel there found the Respondent and Mr. Hoffman to have engaged in a practice of registering and using

domain names confusingly similar to tradenames of others in bad faith with no legitimate rights therein. The decision notes that Mr. Hoffman registers domains as a "hobby." In that case the panel found:

"On April 14, 2000 Mr. Hoffman agreed to transfer the said domain name to the Complainant in return for a payment of \$500 USD. The Respondent had paid only \$70 USD to register the said domain name. Mr. Heddo agreed to this payment because he thought it would be the quickest way to resolve this ongoing issue. Subsequently the Respondent did not fulfill its obligations under the agreement. Mr. Heddo was contacted by Mr. Hoffman and directed to a www site on which the said domain name was being offered for auction with an asking price of \$100,000 USD.

Mr. Heddo called Mr. Hoffman to get clarification concerning this turn of events. Mr. Hoffman's response was that he had changed his mind and that now he desired to sell the domain name for \$100,000 USD or best offer."

The Respondent holds more than 800 top-level domain name registrations, which it markets on the web site <domainxcel.com>. Annex J to the Complaint contains a copy of this web site which lists those marketed domain names. Annex K to the Complaint contains a copy of a WHOIS record showing that the Respondent is the owner of the <domainxcel.com> web site (domain name).

The WHOIS database for certain of the Respondent's domain name registrations, accessed through Network Solutions.com, specifically <alogoexcellence.com>, <logoexcellence.com>, <logoexcellence.net>, <logo-web.net> and <alogoexcellence.net>, all list the Administrative Contact, under two different handles, as Byron Hoffman, not "Dell". Copies of the WHOIS information for these particular domain names have been provided in Annex L to the Complaint.

Various domain names that include Mr. Hoffman's name are available for registration, to wit: <dellhoffman.com>, <dellhoffman.net>, <dellhoffman.org>, <byronhoffman.com>, <byronhoffman.net>, <byronhoffman.org>, <byrondellhoffman.com>, <byrondellhoffman.net> and <byrondellhoffman.org>. Printouts from Network Solutions Inc. (NSI) registration services web site showing these names and their availability are provided in Annex M to the Complaint.

The Respondent has registered, and is currently offering for sale, numerous domain names that consist of a term followed by the suffix "might", such as the contested domain name <dellmight.com>. The Respondent owns nearly 100 domain names containing this suffix including, e.g.: "etrademight", "e-trademight", "dellmight" and "intelmight".

As indicated by copies of WHOIS registration records provided in Annex P to the Complaint, the Respondent has also registered domain names that encompass well-known trademarks or names of third parties such as E-Trade and Intel. In that regard, the Respondent owns over 20 domains beginning with or encompassing "etrade" or "e-trade." In addition, the Respondent also owns domain names containing the names of well-known individuals such as <einsteinmight.com>, and well-known cities such as <beijingmight.com> and <moscowmight.com>.

In the Respondent's email of April 20, 2001 to the Center, the Panel and the

Complainant, the Respondent acknowledged that his purpose in buying all the domain names he markets on his <domainxcel.net> site was "clearly for the purpose of resale".

## 5. Parties' Contentions

### A. Complainant

#### Similarity

The Complainant takes the position that each of the ten contested domain names is confusingly similar to its "DELL" marks.

Specifically, the Complainant contends that each of the contested domain names contains the term "DELL" combined with generic terms, or the well-known trademark of others such as E-TRADE. Given the strength and fame of the "DELL" marks standing alone, and since the Complainant uses many composite word marks in which the mark "DELL" is combined with other terms relating to computers, e-commerce, the Internet and other services, the Complainant asserts that the contested domain names will confuse consumers into believing that those domain names are associated with the Complainant, when, in fact, they are not.

Further, the Complainant contends that in view of the Respondent's other registrations of well-known trademarks in the technology business, including <intelmight.com> and <e-tradeco.com>, the Respondent intentionally chose to register domain names incorporating well-known marks of global technology corporations. Thus, the Complainant submits that it is appropriate to presume or infer that there is a likelihood of confusion between the contested domain names and Complainant's "DELL" marks.

Hence, by virtue of this similarity, the Complainant concludes that each of the contested domain names is confusingly similar to its registered "DELL" marks, thus satisfying the confusing similarity requirement in paragraph 4(a)(i) of the Policy.

#### Legitimacy

The Complainant contends that the Respondent has no rights or legitimate interests in any of the contested domain names.

First, the Complainant contends that the Respondent is not commonly known by any of the contested domain names and has not acquired any lawful trademark or service mark rights in that name.

In that regard, the Complainant points to the WHOIS database for the Respondent's domain registrations through NetworkSolutions.com (<alogoexcellence.com>, <logoexcellence.com>, <logoexcellence.net>, <logo-web.net> and <alogoexcellence.net>) which all list the Administrative Contact as "Byron Hoffman", not "Dell".

Given Mr. Hoffman's claim that he registered the contested domain names only because they relate to his actual name, the Complainant points to the availability for registration of various domain names that actually are Mr. Hoffman's claimed name, i.e., <dellhoffman.com>, <dellhoffman.net>, <dellhoffman.org>, <byronhoffman.com>, <byronhoffman.net>, <byronhoffman.org>, <byrondellhoffman.com>, <byrondellhoffman.net> and <byrondellhoffman.org>.

Despite Respondent's clear affection for registering "might" domains with famous trademarks, the domain names <hoffmanmight.com>, <hoffmanmight.net> and <hoffmanmight.org> all remain available for registration. Hence, the Complainant also contends that Mr. Hoffman recognizes that registering and selling of well-known trademarks of others is much more financially lucrative than registering his own name(s) as a domain and offering a service.

Further, the Complainant not only questions whether, but also believes that it is absurd to suggest that, Mr. Hoffman has any of the following multiple nicknames: "dellconnect", "delltrade", "delleway", "dellfirst", "dellmight", "dellpower", "dellwebsite" and "dellwork".

In addition, the Complainant notes that the Respondent is not currently using any of the contested domain names and has no apparent plans to engage in a legitimate activity involving any of them, hence the Complainant contends that the Respondent has no legitimate interest in any of them. In that regard, the Complainant asserts that the record before the Panel contains no evidence of Respondent's use of, or demonstrable preparations to use, any of the domain names or a name corresponding to any of the domain names in connection with a bona fide offering of goods or services.

Furthermore, the Complainant contends that the Respondent is not making a legitimate noncommercial or fair use of any of the contested domain names.

Lastly, the Complainant asserts that the Respondent registered the contested domain names long after they had become famous trademarks of the Complainant and with full and complete knowledge of the Complainant's superior and prior trademark rights.

Accordingly, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in any of the contested domain names pursuant to paragraph 4(a)(ii) of the Policy.

### **Bad Faith**

The Complainant contends that the Respondent has registered each of the contested domain names in bad faith, and its current use, actually here being non-use, also amounts to bad faith.

First, the Complainant implicitly contends that since no connection exists between it and the Respondent, the Respondent's registration of the ten different contested domain names, each of which suggests such a connection, was done in bad faith.

Second, the Complainant contends that the Respondent has engaged in a pattern of registering domain names for resale that incorporate well-known trademarks followed by the suffix "might", registering, for example and ignoring a generic top level domain (gTLD), "etrademight", "e-trademight", "dellmight" and "intelmight", as well as names of well-known individuals, such as <einsteinmight.com>, or cities <beijingmight.com> and <moscowmight.com>.

In that regard, the Complainant points to prior domain name registrations made by the Respondent which were found, specifically in *Businessway Computer Centers Inc. v. Logo Excellence*, cited *supra*, to be confusingly similar to a complainant's trademark, to have evidenced no legitimate rights or interests, and to have been made in bad faith, as evidencing a pattern of conduct that apparently reflects bad faith.

Further, the Complainant states that all the contested domain names include the mark "DELL" combined with either a corresponding generic term or with a well-known trademark of another, such as the mark "E-TRADE". As such, the Complainant asserts that each of these names is likely to be confused with the Complainant's family of "DELL" marks and domain names.

By having registered such names -- particularly those that incorporate the "DELL" mark, the Complainant contends, that the Respondent is intentionally availing itself of any ensuing user confusion that would arise between that name and the marks, thus evidencing bad faith registration.

Further, the Complainant points to the fact that the Respondent is not currently using any of the ten contested domain names and apparently has no interest in doing so; thus evidencing bad faith use.

In addition, the Complainant contends that, given the strength and fame of the mark "DELL" standing alone and that the Complainant uses many multi-word marks in which the mark "DELL" is combined with other terms relating to computers, e-commerce, the Internet and other services, any of the contested domain names, if and when it is used, would confuse consumers into believing that that mark is associated with the Complainant, when it is not.

Lastly, the Complainant contends that the Respondent registered each of the contested domain names after it had become aware of the "DELL" marks and with full and complete knowledge of the Complainant's superior and prior rights in those marks, and apparently did so in order to intentionally avail itself of any ensuing user confusion that would arise between that name and the Complainant.

Therefore, the Complainant concludes that the Respondent's conduct in registering and then not using each of the contested domain names constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.

## **B. Respondent**

The Respondent, while not addressing any of the specific elements of paragraph 4(a) of the Policy, generally rejects the Complainant's basic assertions.

In that regard, the Respondent takes the position that he purchased all of the contested domain names during the year 2000 but had never offered them for sale to the Complainant. The Respondent also takes the position that he kept these domain names off the market in order to retain them for his own Internet business purposes. Specifically, he states, in the Response:

"In reference to the 10 domain names I purchased this past year that start with 'Dell', I did not market these 'Dell'...com names any where; most certainly, these names were never offered to Dell Computer. I deliberately kept these names off the market for my own Internet business purposes. I have started two Internet businesses this past year using other domain names."

and in his April 20, 2001 email to the Center, Panel and Complainant:

"I have never marketed these dell....com names; not on my domainxcel.com web site, not anywhere, and not at any time."

The Respondent also contends, in his Response as well as in his subsequent communication with the Center, the Panel and the Complainant, that he has been known by his middle name "Dell". Specifically, in the Response, he states:

"I have been known by my middle name, Dell, all of my life. Everyone knows me as Dell; family, friends and business associates. Although my first name is Byron, I have never been addressed by or gone by any other name than Dell. I am 59 yrs. old."

Lastly, in his April 20, 2001 communication, the Respondent provided its explanation of its conduct that was the subject of the *Businessway Computer Centers Inc. v. Logo Excellence case*, cited *supra*, as:

"This to the only other UDRP domain dispute that I have been engaged in prior to this dispute ... was with a Canadian Company by the name of Businessway Computers, who had the URL www.businessway.com . Early on in my business start-up last year I was buying up hundreds of available domain names for my new domain names resale business www.domainxcel.com. As I was searching data bases one day for available URL's to buy, I came across www.businessway.net. I was very naive and unknowledgeable regarding the inn's and out's and rules of legitimate domain name purchases. At this time, I didn't even bother to investigate whether or not www.businessway.com was an operating business or not. I naively assumed it didn't matter and that if a domain name and extension was available and one could purchase it, then one owned the rights to that URL. About 10 days after I had marketed www.businessway.net on my web site for resale, I was contacted by a representative of Businessway Computers in Canada, stating that they had a right to www.businessway.net and wanted me to hand it over to them. I responded by saying that I didn't think they had the right to the name and if they wanted it, it was for sale. They then took the issue to arbitration and the name was awarded and transferred back to them. I consulted an intellectual property lawyer wanting to know why they were entitled to the name I had purchased. It was then that my education concerning buying domain names started. Since then I've done my homework before buying any domain name. The purpose of buying all of the domain names I have marketed on www.domainxcel.net, including business.net were clearly for the purpose of resale."

## **6. Discussion and Findings**

### **Similarity**

The Panel finds that confusion would likely arise as a result of the Respondent's current use of the contested domain name.

The Panel views that, for confusing similarity to occur between a domain name and a mark, identity is not necessary.

All that is necessary is that the domain name misappropriate sufficient components from the mark such that an ordinary Internet user who is familiar with the goods or services distributed under the mark would upon seeing the domain name likely think that owing to the visual and/or phonetic similarity between the mark and the domain name that an affiliation exists between the site identified by that domain name and the

owner or licensed user of the mark. See, e.g., Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications D2001-0210 (WIPO April 16, 2001) and Playboy Enterprises International, Inc. v. Hector Rodriguez D2000-1016 (WIPO November 7, 2000)

With respect to a test for "confusing similarity", § 5.01[3], page 5-15 of J. Gilson, et al, Trademark Protection and Practice (© 1996, Matthew Bender & Co., Inc.) states:

"When one trademark is said to be 'confusingly similar to another', it is so similar to the other that, when it is used on products the purchasing public is likely to be confused. The term [confusingly similar] is simply another way to express the fact that confusion is likely. "

In assessing whether sufficient similarity exists between two marks, Gilson, at § 5.02[1], further states: "If a word trademark sounds similar to the plaintiff's mark courts often find likelihood of confusion, especially if the associated product is typically ordered orally. Visual similarity frequently causes confusion if there is sufficient resemblance in overall appearance. Even if word trademarks neither sound alike nor look alike, similarity in meaning may cause confusion.". In its seminal decision on the issue, In re E.I. du Pont de Nemours & Co. 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) , the U.S. Court of Customs and Patent Appeals (predecessor to the U.S. Court of Appeals for the Federal Circuit), in its definitive listing of factors to assess in determining whether likelihood of confusion exists or not, enumerated as its first factor: "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."

There can be no question here that each of the contested domain names, by virtue of its inclusion of the term "DELL", if and when used by the Respondent or a third-party to which the Respondent might transfer that name, will cause user confusion. In fact, the Panel finds that, in all likelihood, this is the very reason why the Respondent acquired all these domain names in the first place.

As for domain names that incorporate personal names, the mere inclusion of a personal name, that is the subject of a trademark, without more, as here, does not automatically defeat the rights of a trademark owner. Identity/confusing similarity can be found between such a domain name and a trademark based on comparing the domain name against the mark, when each is viewed in its entirety. In assessing a potential for confusion, personal names are to be treated no differently than any term that is the subject of a mark. Whether a particular use of a personal name within the context of a domain name gives rise to legitimate rights and interest in the latter, as discussed below, that is an entirely separate inquiry from assessing identity/similarity. Hence, the Panel sees no reason to depart from the test, for similarity, set forth above by the Court in the DuPont decision and elucidated by Gilson.

Therefore, through applying that test to each of the contested domain names, the Panel finds that each of these names sufficiently resembles the Complainant's "DELL" marks as to cause confusion.

Accordingly, the Panel also finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy for each of the ten contested domain names.

### **Illegitimacy**

The Panel infers from the Complaint and the lack of any statements to the contrary in the Response, that the Respondent is neither a licensee or sublicensee from the Complainant of any right to utilize any of the "DELL" marks.

Based on its federal service mark registrations, the Complainant has acquired exclusive rights to use its "DELL" marks in connection with the goods and services set forth in its registrations. Furthermore, by virtue of the registration of these marks, the US PTO has implicitly recognized that each of these marks has acquired appropriate secondary meaning in the marketplace.

The Respondent has not proven any basis that would legitimize any claim it has to any of the contested domain names under paragraph 4(a)(ii) of the Policy. The Panel believes that, under the present facts, it is extremely unlikely that the Respondent can even make such a claim.

Specifically, as noted above, each of the contested domain names is sufficiently similar to the Complainant's "DELL" marks under which the Complainant provides its products and services.

The Complainant has never authorized the Respondent to utilize any of the "DELL" marks in any manner, nor does the Complainant have any relationship, affiliation or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put of the term "DELL", in connection with products identical or similar to those with which the Complainant is using its marks, would directly violate the exclusive trademark rights now residing in the Complainant -- rights which began accruing to the Complainant during November 1987.

Furthermore, as noted above, the Respondent contends that it is commonly known by the surname "DELL", yet it has adduced absolutely no proof to support its contention. A party alleging, under paragraph 4(c)(ii) -- as the Respondent purports to do here -- that it is commonly known by a particular name, sufficient to show legitimate rights and interest in a domain name that contains that particular surname, must provide adequate extrinsic proof that a corresponding group of consumers, e.g., Internet users, who are likely to access that party's web site, associates that domain name with that party rather than with the trademark owner, i.e., that domain name possesses requisite secondary meaning, or at least that party has used or is using the name sufficiently broadly such a Panel can infer that such meaning exists.

In balancing the tension between an individual's right to use his(her) personal name in connection with a business vis-à-vis the interest of a trademark owner having a mark in the same name, the Panel finds that analysis set forth by the US Court of Appeals for the Ninth Circuit in Avery Dennison Corp. v. Sumpton 51 U.S.P.Q.2d 1801, 1809 (CA 9 1999) (thought there in the context of assessing distinctiveness for purposes of trademark dilution) not only pertinent to the present facts before this Panel but also highly instructive:

"No dispute exists that 'Avery' and 'Dennison' are common surnames -- according to evidence presented by Appellants, respectively the 775th and 1768th most common in the United States. A long-standing principle of trademark law is the right of a person to use his or her own name in connection with a business. *See Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 140 (1905). This principle was incorporated into the Lanham Act, which states that a mark that is 'primarily merely a surname' is not protectable unless it acquires secondary meaning. 15 U.S.C. Section 1052(e)(4), (f) (1994); *Abraham Zion Corp. v.*

*Lebow*, 761 F.2d 93, 104 [226 USPQ 104] (2d Cir. 1985); see *L.E. Waterman Co. v. Modern Pen Co.*, 235 U.S. 88, 94 (1914) (pre-Lanham Act case stating that protection from confusion is available to the holder of a surname trademark that has acquired public recognition); *Horlick's Malted Milk Corp. v. Horluck's, Inc.*, 59 F.2d 13, 15 [13 USPQ 296] (9th Cir. 1932) (pre-Lanham Act case limiting the defendant's right to use his surname as a trademark where the name has acquired public recognition from the efforts of a competitor). Avery Dennison cannot claim that 'Avery' and 'Dennison' are inherently distinctive, but must demonstrate acquired distinctiveness through secondary meaning."

Here, the Panel readily takes judicial notice that the term "DELL" is a surname within the United States and a relatively popular one at that. Hence, it is not inherently distinctive by itself. However, in the Panels' mind, there can be no question that given the extensive, substantial and widespread public advertising and promotion which the Complainant has continuously made of its "DELL" marks dating from 1987 to the present, each of those marks has acquired considerable secondary meaning, and consequently distinctiveness, in the Internet community, if not a much larger community of mass market consumers, in conjunction with and as a source indicator of the goods and services which the Complainant offers.

Therefore, under the analysis set forth in *Avery Dennison*, the Complainant's "DELL" marks, having acquired requisite secondary meaning, are protectable from confusion, even though the term "DELL" is, in one context, also a common surname. The US PTO recognized that as such by registering each of these marks, evidently concluding that each such mark has acquired sufficient secondary meaning and is thus distinctive such that, when used by the Complainant in conjunction with its goods and services, it is not "primarily merely a surname".

Moreover, in view of the secondary meaning residing in the "DELL" marks in favor of the Complainant, the Respondent, at the very least, would need to put forth sufficient evidence of its actual use of any of the contested domain names and the extent of its use, including, e.g., advertising and promotional activities, in order for this Panel to infer that those Internet users who would most likely come into contact with that domain name would probably associate that particular name, through its having attained sufficient secondary meaning, with the Respondent rather than Complainant trademark owner. Clearly, as the notoriety of a mark increases in its given product/service market, then so will the quanta of proof which an opposing party must put forth to counter the likely consumer perception of associating a domain name that incorporates that mark with the trademark owner.

This Panel believes that, in view of the widespread, worldwide notoriety enjoyed by the "DELL" marks in connection with the Complainant's goods and services -- particularly in view of the Complainant's long-term, continuing and substantial efforts and expenditures aimed at increasing public recognition of these marks, the Respondent here faces an exceedingly difficult, if not impossible, task of showing satisfactory proof of its use of the term "DELL", for use in connection with goods and services similar to those offered by the Complainant or in reaching similar Internet users as the Complainant does, to establish that it has legitimate rights and interest in any of the contested domain names sufficient to justify its retention of that name.

Fortunately, the Panel need not reach the question of just what that quanta is here for the simple reason that the Respondent has yet to use any of the contested domain names at all and apparently has no plans to do so. Hence, the Respondent is completely precluded, by virtue of its own inaction, from proving that any secondary meaning

exists in its favor in any of the contested domain names.

While Mr. Hoffman himself may be commonly known, among his own associates, by the name "DELL", this in and of itself is clearly insufficient to establish the Respondent is "commonly known" by that name consistent with paragraph 4(c)(ii) of the Policy in order to successfully counter the rights of the Complainant trademark owner.

Thus, any use to which it may put of any of the contested domain names will violate paragraph 4(c)(ii) of the Policy. See, e.g., *Cabletron Systems, Inc. v. DSL Enterprises* D2000-0571 (WIPO August 18, 2000).

Furthermore, in view of the Respondent's continued non-use of all the contested domain names, there are no issues of non-commercial or fair use of any of these names. Also, the Respondent, given that lack of any relevant proof, has not shown that it has undertaken any demonstrable preparations to use any of these names in a bona fide offering of goods or services prior to having received notice of this dispute.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in any of the contested domain names within paragraph 4(a)(ii) of the Policy.

### **Bad Faith**

Though the Respondent argues that its actions were motivated by an intent to reflect its own personal name "DELL" in its domain names, the Panel categorically rejects this view.

It is eminently clear to this Panel, that the Respondent, by having intentionally registered a large number of domain names that incorporate well-known marks (not only of the Complainant but others) or widely-recognized individual names, expressly recognized, though its actions, the potential for such confusion and now, by virtue of offering those domain names for resale, seeks to obtain some measure of financial gain from doing so -- clearly, when examining the prices quoted on the domain name listings from its domainxcel web site, substantially in excess of its costs of registration. A few examples will suffice: the listing includes <e-tradeinternational.com> offered at US \$ 100,000; <e-trademax.com> offered at US \$ 200,000; <intelmight.com> offered at US \$ 1,000,000, and so forth.

The simple question one can ask is that if the Respondent had no intention of securing financial gain, then why would it have registered those domain names to begin with? The Panel believes, that, in the absence of sufficient pecuniary gain, the Respondent simply would not have done so.

The Panel believes that the Respondent intentionally chose each of the contested domain names for its inclusion of the Complainant's mark "DELL". Clearly, the Panel believes that in doing so the Respondent intended at some point to reap financial benefit from that name by eventually offering that name to the Complainant or a third-party for pecuniary gain or using that name in a manner that, through diverting Internet users away from the Complainant's web site to either the Respondent or a third-party to whom the Respondent might subsequently transfer the domain name, would cause consumer confusion and concomitant injury to the Complainant.

Given that use of the Complainant's "DELL" marks started in 1987 many years prior to the year 2000 during which the Respondent, by its own admission, acquired each of the contested domain names, the Panel infers, and it is difficult to contemplate otherwise,

that the Respondent was well aware of the Complainant's "DELL" marks but chose, in spite of that knowledge, to purchase each of the contested domain names that incorporated the mark "DELL", and with the intent of misappropriating and ultimately financially benefiting, from the ensuing consumer confusion and to the detriment of the Complainant, from the goodwill inherent in the Complainant's mark.

The pattern inherent in the Respondent's actions is further evident by the Respondent's having repetitively registered a myriad number of domain names that incorporate the marks of widely recognized individual names of others.

Hence, the Respondent's acts in registering each of the contested domain names clearly constitute bad faith registration.

Under the present facts, the Respondent's continuing retention of each of the contested domain names amounts to passive holding which, while being fully cognizant of the Complainant's trademark rights, evidences bad faith use.

Various panels, including this Panel on a prior occasion, have held that passive holding, coupled with knowledge of trademark rights of a complainant in the name being so held, can amount to bad faith use. Under the present facts, this Panel sees no reason to depart from that view. In that regard, see, e.g., *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, cited *supra*, *Liberty Public Limited Company v. Thomas Guarrera* FA 95103 (Nat. Arb. Forum August 17, 2000), *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev* FA 95078 (Nat. Arb. Forum August 9, 2000), and *Telstra Corporation Limited v. Nuclear Marshmallows* D2000-0003 (WIPO February 18, 2000).

Therefore, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of each of the contested domain names under paragraph 4(a)(iii) of the Policy.

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

## **7. Decision**

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby granted.

All the contested domain names, specifically <dellconnect.com>, <delletrade.com>, <delle-trade.com>, <delleway.com>, <delle-way.com>, <dellfirst.com>, <dellmight.com>, <dellpower.com>, <dellwebsite.com> and <dellwork.com>, are ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Sole Panelist

Dated: May 7, 2001