



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**eBay Inc.,**

**v.**

**G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.**

**Case No. D2000-1463**

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

Complainant is Ebay Inc., a Delaware Corporation, 2145 Hamilton Avenue, San Jose, California 95125, United States of America.

Respondents are G L Liadis Computing Ltd., John L. Liadis d/b/a G L Liadis Computing Ltd., 5165 Saling Court, Columbus, Ohio 43229, USA. Updated address, as supplied by the Respondents. G L Liadis Computing, Ltd. Incorporated, Attn.: Mr. John Boulgaris, 137-143 Karaiskou Street, Piraeus, Greece 81200.

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

Contested Domain Names: <ebayamerica.com> <ebaygreece.com>, <ebaynewzealand.com> , <ebayturkey.com> and <ebayunitedkingdom.com>.

Registrar is Network Solutions, Inc. (NSI), 505 Huntmar Drive, Herndon, Virginia 20170, United States of America.

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at "<http://www.icann.org/services/udrp/udrp-policy-24oct99.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 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 "Center") by e-mail on October 26, 2000 and in hard copy, with Exhibits A-N, as well as the appropriate payment on October 30, 2000. The

Complainant's attorney states that on or about October 25, 2000 she served a copy of the Complaint on the Respondents, by certified mail and e-mail and, in accordance with the methods set forth in paragraph 2(a) of the Rules, and provided a copy of the Complaint to the Registrar, NSI. Though the Complaint did not specify an exact day on which service occurred, this date was confirmed in an e-mail sent to the Center on November 30, 2000 by the Complainant's law firm.

The Center acknowledged receipt of the Complaint by e-mail dated November 1, 2000, to the Complainant's attorney. In an e-mail dated November 8, 2000 to the Complainant's attorney, the Center requested the Complainant to suitably amend its Complaint to consent to appropriate mutual jurisdiction in the event of a judicial challenge filed by the Respondents to a decision made by an administrative panel to either cancel or transfer any of the contested domain names. The Complainant, through its attorneys, filed a suitable statement with the Center consenting to mutual jurisdiction. The Center received a hardcopy form of this statement on November 13, 2000 and an electronic form by e-mail on November 14, 2000.

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 November 2, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to all the contested domain names; specifically, contact and registrant information for the contested domain names, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain names, and (b) the current status of each of those domain names. On November 7, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to each of the contested domain names from its WHOIS database, confirmed that NSI is the registrar of each of the contested domain names, stated that the Policy is in effect (through Network Solutions 4.0 Service Agreement for the domain name "ebayamerica.com", and through Network Solutions 5.0 Service Agreement for each of the other four contested domain names), and that each of the five contested domain names was then in an "active" status. The Center completed its review of the Complaint on November 16, 2000.

On November 16, 2000, the Center notified the Respondents of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondents, by e-mail, facsimile and in hardcopy form by courier (the last including a copy of the Exhibits supplied by the Complainant). 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) and 4(a) of the Rules.

Hence, the notification to the Respondents having occurred on November 16, 2000, 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 NSI, 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 Respondents were then provided with a 20 calendar day period, expiring on December 5, 2000, to file its response with the Center and serve a copy of the response on the Complainant.

In an e-mail dated November 30, 2000, the Complainant's law firm confirmed that it forwarded hardcopies of the complaint by certified mail to the Respondents at the addresses shown in the domain name registration records. These addresses were: "John Liadis, GL Liadis Computing Ltd, 5165 Saling Court, Columbus, Ohio 43329" and "John Liadis, GL Liadis Computing Ltd, 5167 Saling Court, Columbus, Ohio 43229". That e-mail noted that although the mailing to the 5165 Saling Court address was returned to the Complainant's law firm; the mailing sent to 5167 Saling court was not. Furthermore, that e-mail stated that the Complainant's attorney had spoken with Respondents' counsel and had received a letter dated November 27, 2000 from the latter stating that the latter had spoken with the Respondents in this matter.

During December 1-5, 2000, further e-mail correspondence occurred among the Respondents, Complainant and the Center principally regarding whether the Respondents received notice of the complaint or not. Specifically, on December 1 and 2, 2000, the Respondents notified the Center by e-mail that the Respondents were then located out of the United States, had not received a copy of the complaint and, as of that date, its statutory agent was Mr. John Boulgaris located at 137-143 Karaiskou Street, Piraeus, Greece 81200. In an e-mail dated December 4, 2000, the Center informed the Respondents that December 5, 2000 was the deadline for filing their response with the Center.

In an e-mail dated December 4, 2000, the Respondents informed the Center that they had not received a copy of the Complaint at their address in Greece. In a responding e-mail dated December 4, 2000, the Center informed the Respondents that the Center transmitted complete hardcopies of the Complaint to the Respondents' contact addresses shown on their domain name registration records maintained by NSI, and that the Respondents' address in Greece, as noted in the Respondents' December 1-2, 2000 e-mails, did not appear in the verification response dated November 7, 2000 which the Center received from NSI. Through responding e-mails dated December 4-5, 2000, the Respondents confirmed to the Center that their contact information in the NSI WHOIS database is incorrect, the Respondents needed to update its listed address accordingly, and the Respondents had not received a copy of the complaint presumably at their address in Greece. As apparently a courtesy, the Center, in an e-mail dated December 5, 2000 to the Respondents, stated that, on the next day, it would send the Respondents a complete copy of the Complaint by courier to their address in Greece, but indicated that the administrative panel would decide in its sole discretion whether to consider any response which the Respondents might later submit. The Center also informed the Respondents, in response to an inquiry made in the Respondents' December 5, 2000 e-mail to the Center, of the proper venue for filing any judicial challenge to an administrative panel decision.

The Center received a subsequent e-mail dated December 12, 2000 from Ms. Anderson, of the Complainant's law firm, specifying communications that had occurred between

the Complainant's and the Respondents' counsel, as well as between the former attorney and the Center.

As of December 5, 2000, the Center had not receive a substantive response to the Complaint from the Respondents.

Accordingly, pursuant to the Rules and Supplemental Rules, on December 20, 2000, 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 e-mail dated December 28, 2000, 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 January 10, 2001.

This dispute concerns five domain names, specifically <ebayamerica.com>, <ebaygreece.com>, <ebaynewzealand.com>, <ebayturkey.com> and <ebayunitedkingdom.com>.

The language of this proceeding is English.

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

Inasmuch as the Respondents, G L Liadis Computing Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd., have failed to substantively respond to the Complaint as required by the Policy and Rules, all the factual representations alleged by the Complainant, EBAY, Inc., will be accepted as undisputed. For convenience of the reader, factual allegations from the Complaint are reproduced below.

Complainant EBAY currently owns a single valid and subsisting U.S. service mark registration for the term "EBAY", in block letters; numerous pending U.S. trademark applications for the same term either in a block letter or in a stylized pattern; and numerous foreign trademark registrations and pending applications, in various countries, for the same marks (collectively all these marks will be referred to as the "EBAY marks"). Trademark registrations have issued to the Complainant for the term "EBAY" in: the European Community, New Zealand, Australia, Brazil, Benelux, Germany, Hungary, Iceland, Israel, Japan, Mexico, Norway, Peru, South Korea and Switzerland; with trademark applications pending for this term in: Turkey, United Kingdom, Canada, Chile, Colombia, Czech Republic, Egypt, Hong Kong, India, Indonesia, Malaysia, Philippines, Poland, Romania, Saudi Arabia, Singapore, Taiwan, Ukraine, Venezuela and Vietnam. A listing of the Complainant's registered and pending foreign marks appears in Exhibit G to the Complaint.

The Complainant uses the EBAY marks in connection with a wide variety of goods and services.

In that regard, the Complainant has provided copies, in Exhibit F to the Complaint, of its current US registration as well as copies of application records, currently available from the United States Patent and Trademark Office (US PTO) web server, of all its pending US trademark/servicemark applications (several of the latter do not include the

term "EBAY"). The US servicemark registration and a small sample of its pending US trademark/servicemark applications are as follows:

**A) U.S. service mark registration**

**1) EBAY (block letters)**

US registration 2,218,732; registered January 19, 1999

This service mark was registered, for use in connection with: "On-line trading services in which seller posts items to be auctioned and bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith", in international class 35. This mark claims first use and first use in inter-state commerce of September 4, 1995.

**B) Pending U.S. trademark/service mark applications**

**2) EBAY (stylized)**

US application 75/625,389; filed January 20, 1999

This trademark was filed, on an intent-to-use basis and for use in connection with: "Clothing, namely t-shirts, sweatshirts, jackets, caps and visors", in international class 25.

**3) EBAY (block letters)**

US application 75/620,501; filed January 13, 1999

This trademark was filed, on an intent-to-use basis and for use in connection with: "Clocks, watches and jewelry", in international class 14.

**4) EBAY (stylized)**

US application 75/611,780; filed December 23, 1998

This trademark was filed, for use in connection with: "Computer software to allow users to perform electronic business transactions conducted in the form of an auction via a global computer network and for use in the field of hobbies, collectibles and a wide variety of products", in international class 9. This mark claims first use and first use in commerce of September 30, 1995.

**5) EBAY (stylized)**

US application 75/613,531; filed December 30, 1998

This trademark was filed, for use in connection with: "Christmas tree ornaments and soft sculpture toys", in international class 28. This mark claims first use and first use in commerce of December 15, 1998.

**6) EBAY (stylized)**

US application 75/610,933; filed December 23, 1998

This trademark was filed, on an intent-to-use basis and for use in connection with: "Publications, namely, a series of fiction and nonfiction books, comic books and magazines concerning hobbies, collectibles, auctions, and a wide variety of products relating to antiques, art, literature, culture, technology, travel, sports, entertainment, home furnishings, garden items, musical instruments, motor vehicles, toys and games, fashion, jewelry, electronics, photography, holiday related items, film and video; paper and stationery items, namely wrapping paper, greeting cards, memorandum boards, memo pads, paper tablecloths, paper napkins, paper placements, paper party decorations, paper postcards, stationery, playing cards, address books, personal diaries, pens, pencils, erasers, desk top organizers, desk pads, desk stands and holders for pens, desk baskets for desk accessories, desk file trays, desk top stationary cabinets, desk sets, posters, bumper stickers, calendars and decorative stickers and decals", in international class 16.

**7) EBAY (block letters)**

US application 75/620,479; filed January 13, 1999

This trademark was filed, on an intent to use basis and for use in connection with: "Computer e-commerce software to allow users to perform electronic business transactions conducted in the form of an auction via a global computer network and computer software featuring information in the field of hobbies, collectibles and a wide variety of products", in international class 9.

**8) EBAY (stylized)**

US application 75/871,191; filed November 12, 1998

This service mark was filed, for use in connection with: "On-line trading services to facilitate the sale of goods by others via a computer network and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience", in international class 35. This mark claims first use and first use in commerce of January 15, 1998.

The Complainant operates its primary web site at the domain address <ebay.com>. The Complainant states that it was the first and is one of the most successful, person to person auction sites on the Internet. The Complainant notes that it provides its services in numerous countries around the world, including Canada, France, Australia, Germany, Japan and the United Kingdom.

The Complainant states that it has devoted substantial resources to advertise and promote its services and products under the EBAY marks with those marks embodying substantial goodwill that the Complainant has earned as a result of providing high quality services and products.

In that regard, as set for in a declaration from Mr. Jay Monahan, Esq., Associate General Counsel, Intellectual Property (a copy of which has been provided with the Complaint), during calendar year 1999, the Complainant has expended in excess of US \$ 30,000,000 to advertise and promote its services. Furthermore and as stated in the declaration, the Complainant, in addition to its own advertising efforts which include national and international print, radio and television media, has been the subject of numerous unsolicited media articles that highlighted the Complainant's efforts in on-line person-to-person trading. Copies of a small sample of the Complainant's print advertisements as well as of its unsolicited media articles collectively appear in Exhibit K to the Complaint. Furthermore, the Complainant alleges that the mark "EBAY" has acquired "fame" in the marketplace (hence qualifying that mark as being a "famous" mark under Section 43(c)(1) of the Lanham Act, i.e., 15 U.S.C. §1125(c)(1)).

Accordingly, the Complainant states that it enjoys a widespread reputation in the marketplace as a high-quality trading forum.

The Complainant's service, provided under its mark "EBAY", is accessible from every country that has access to the Internet. The Complainant uses its mark "EBAY CANADA" to promote its services in Canada and operates its services there through its domain name <ebaycanada.com>, (a copy of the home page of its associated Canadian web site appears in Exhibit H to the Complaint). The Complainant also owns various domain names that consist of the term "EBAY" prepended to the name of a country. In that regard, the Complainant maintains web sites reachable through <ebayfrance.com> and <ebayjapan> through which it provides its services in France and Japan, respectively. A copy the Complainant's home page of its French web site (reachable through ("www.ebayfrance.com")) is provided in Exhibit I to the Complaint.

The Complainant states that it coined the term "EBAY" and has been using it, as a trademark, since at least as early as September 1995, in connection with its on-line person-to-person trading services.

The Complainant states that as of September 28, 2000, over four million auction listings had been posted on the Complainant's web site (as indicated in its home page, a copy of which appears in Exhibit J to the Complaint). The Complainant states that each day, over 400,000 new items are listed for sale on its site, with over one million separate bids being placed, through its site, on items in over 2900 different categories of goods. In addition to its on-line trading services, the Complainant's web site offers a variety of related services, including, e.g., currency conversion tools, escrow services, charity auctions and theme-oriented pages that combine to make the Complainant, as it perceives, a unique person to person trading community.

As indicated in Exhibit A to the Complaint, the WHOIS registration records from NSI, as well as the confirmation information provided to the Center, indicate that the Respondents are the current owner of each of the contested domain names. These records indicate that the Respondents registered the contested domain name <ebayamerica.com> on August 31, 1999, and registered each of the other four contested domain names, specifically <ebaygreece.com>, <ebaynewzealand.com>, >ebayturkey.com> and >ebayunitedkingdom.com> on January 18, 2000.

Upon entering the contested domain name <ebayamerica.com>, as a URL, into a browser, an Internet user is directed to the Respondents' website, which, on its home page (a copy of which appears in Exhibit L to the Complaint), prominently lists each of the five contested domain names as being for sale. The home page also contains a

disclaimer, in smaller print than the "sale" information, disclaiming any association between the Respondent and the Complainant, EBAY Inc.

When each of the other four contested domain names is entered as a URL to a browser, a page containing an error message (copies of which appear in Exhibit M to the Complaint) is returned indicating that a corresponding web page addressable by that name can not be displayed. Hence, the Panel assumes that the Respondents have not established any web site reachable by any of these four pages.

Furthermore, the Respondents have apparently listed each of the five contested domain names with GreatDomains.com as being for sale. A print-out of the search results, through the GreatDomains.com web site, for each of these domain names also appears in Exhibit L to the Complaint.

On January 13, 2000, the Complainant, through its attorney Ms. Stern, sent a letter to the Respondents at their address in Columbus stating that the Complainant was aware that the Respondents had registered the domain name <ebayamerica.com>, stated that further use by the Respondents of this domain name would likely cause confusion with and dilute the Complainant's mark "EBAY", and demanded that, by February 4, 2000, the Respondents cease use of the term "ebay" as a meta-tag, and cease and desist from all further use of that domain name. Through this letter, the Complainant requested that the Respondents transfer this domain name to the Complainant and offered to reimburse the Respondents for their registration cost (US \$ 70).

As noted above, this particular domain name was registered on August 31, 1999, several months prior to the January 13th letter; each of the other four contested domain names was registered on January 18, 2000, i.e. a few days later.

The Respondents, through their attorney Mr. Cesner, replied to Ms. Stern on February 2, 2000, indicating that the Respondents required additional time to study the matter. In a subsequent letter dated March 13, 2000, Ms. Stern acknowledged that the Respondents had ceased using the term "ebay" as a meta-tag but demanded that the Respondents cease and desist from all further use of the term "ebay" in the Respondents' domain name <ebayamerica.com>. By letter dated May 30, 2000 to Ms. Stern, Mr. Cesner stated that:

- (a) the Respondent, Mr. Liadis, was then residing in Greece and had instructed Mr. Cesner to propose a "final resolution and settlement" of the matter;
- (b) the Respondents had been using the term "EBAY" for several years, wherein the "E" references Ellada, Greece and "BAY" references Bar Kardamyla located in Kardamyla, Chios, Greece which was described as being Respondent Mr. Liadis' birthplace;
- (c) that Mr. Liadis had registered the other four contested domain names;
- (d) the Respondents intend to sell merchandise, ostensibly using these domain names, directly rather than, as the Complainant does, through auction sales;
- (e) the term "ebay" is a common designation for sales activity on the Internet;  
and

- (f) expressed a willingness to transfer the contested domain names at a "mutually agreed sales price".

By letter dated June 6, 2000 to Mr. Cesner, Ms. Stern rejected any offers made by the Respondents to sell any of the contested domain names to the Complainant; though Ms. Stern indicated that the Complainant was willing to reimburse the Respondents for their registration costs.

In an e-mail to the Center dated December 11, 2000 (a hard-copy of which with attachments were received by the Center on December 14, 2000) from Ms. Anderson, of the Complainant's law firm, through which the Complainant states that the Respondents had actual notice of the Complaint, Ms. Anderson states:

- (a) on October 26, 2000, the law firm sent a copy of the Complaint to Mr. Cesner, whom Complainant then believed was acting as the Respondents' attorney;
- (b) on November 9, 2000, the law firm sent a copy of its amended statement of mutual jurisdiction to Mr. Cesner;
- (c) on November 15, 2000, Mr. Cesner contacted the Complainant's attorney to inquire about the Complaint and to indicate that he shortly expected to hear from his client;
- (d) by courier letter dated November 22, 2000, Ms. Stern forwarded, to Mr. Cesner, a copy of an e-mail message from the Center, including a letter attachment dated November 16, 2000, reporting the commencement of this proceeding;
- (e) by facsimile letter dated November 27, 2000 from Mr. Cesner, the Respondents offered to settle the dispute "for the sum of \$ 1500.00, plus any fee needed to amend registration records.";
- (f) by facsimile letter dated November 27, 2000 from Ms. Stern to Mr. Cesner, the Complainants rejected the offer; and
- (g) on November 30, 2000 through an e-mail sent by Ms. Anderson to the Center and copied to the Respondents, she notified the Center that one of its shipments of the Complaint sent by the law firm to the Respondent had been returned to the firm by the US Postal Service.

Copies of the November 22 and 27, 2000 letters from Ms. Stern and of the November 27, 2000 letter from Mr. Cesner and of the November 30, 2000 email from Ms. Anderson all accompanied the hard-copy version of the December 11, 2000 email sent to the Center.

The Complainant states that the Respondents have no connection or affiliation with the Complainant and have not received any permission or consent from the Complainant to use the mark "EBAY".

## **5. Parties' Contentions**

## **A. Complainant**

### **1. Similarity**

The Complainant takes the position that each of the contested domain names incorporates its identical mark "EBAY"; hence, satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

Specifically, the Complainant contends that each of these domain names consists of the mark "EBAY" plus the addition of the name of a country. Given this, the Complainant believes that an Internet user who visits web sites located at any corresponding domain address(es) would likely assume that such web sites and/or domain names are sponsored by or affiliated, in some manner, with the Complainant, when, in fact, they are not.

Furthermore, the Complainant contends that a likelihood that confusion will occur is exacerbated here because, in various countries, the Complainant uses its mark "EBAY" in combination with country names to promote its services in those countries. For example, the Complainant points to the fact that it has registered the domain name <ebaycanada.com> and uses the mark "EBAY CANADA" (for which it has a trademark application pending in Canada) to promote its services in Canada. Similarly, the Complainant points to its use of the domain name <ebayfrance.com> to promote its services in France, and its use of the names "eBay Australia", "eBay Germany", "eBay Japan" and "eBay United Kingdom" to promote its services in those countries (as indicated in the hard-copy printout appearing in Exhibit J of its home page at [www.ebay.com](http://www.ebay.com)).

In view of this usage, the Complainant contends that by adopting domain names that incorporate the identical mark "EBAY" and simply adding the name of a country, the Respondents are attempting to capitalize on the Complainant's goodwill associated with the mark "EBAY" by misleading Internet users into believing that the contested domain names are affiliated with the Complainant in order to gain commercial advantage, such as an increased selling price.

Hence, the Complainant concludes that each of the contested domain names is confusingly similar to the Complainant's mark "EBAY" under paragraph 4(a) of the Policy.

### **2. Legitimacy**

The Complainant contends, that the Respondents have no rights or legitimate interest in any of the contested domain names.

Specifically, the Complainant contends that:

- (a) the Respondents do not use, nor is there evidence of demonstrable preparation to use, a name or trademark corresponding to any of the contested domain names in connection with a bona fide offering of goods or services;
- (b) the Respondents have not been commonly known by any of the contested domain names; and

- (c) the Respondents are not affiliated with the Complainant and have not received any permission or consent from the Complainant to use the mark "EBAY".

Furthermore, the Complainant contends that while the Respondents have asserted (though not in the context of a response to this Complaint, but only, as it appears in the record before this Panel, through correspondence directly between Mr. Cesner and Ms. Stern) that they have made some preparations for using the <ebayamerica> name and <ebayamerica.com> domain name in connection with an online internet store, any such actions were not taken with a bona fide intent to provide goods and/or services. Specifically, the Complainant points to the information that is returned from the "ebayamerica.com" site itself to the effect that all the contested domain names are for sale.

Given this, the Complainant asserts that the Respondents would not openly advertise the contested domain names for sale if the Respondents had a genuine intent and plan to use any of these names as a fide basis for a business. Hence, the Complainants believe that the Registrants' only interest in any of the contested domain names is to sell that name for a large profit.

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

### **3. Bad Faith**

The Complainant contends that the Respondents registered each of the contested domain names in bad faith.

Specifically, the Complainants contend that the Respondents registered or acquired the contested domain names primarily for the purpose of selling, renting, or otherwise transferring registration of these names to the Complainant or a competitor thereof, for valuable consideration in excess of the Respondents' out-of-pocket costs directly related to registering those names.

In that regard, the Complainant contends that the date on which Respondents had registered the domain name <ebayamerica.com>, i.e. August 31, 1999, was quite some time after the Complainant had adopted its mark "EBAY", hence the Respondent has at least constructive notice of this mark.

Furthermore, the Complainant alleges that the Respondents do not have a bona fide intent to conduct business using any of the contested domain names, inasmuch as each of these names is offered for sale, and specifically through the Great Domains web site (www.greatdomains.com) and on the ebayamerica.com web site (www.ebayamerica.com). The Complainant points to the latter site which, when downloaded and rendered, specifies: "The following domains are for Sale: ebayamerica.com[,] ebaygreece.com[,] ebayturkey.com[,] ebaynewzeland[,] ebayunitedkingdom.com." (as shown in a hard-copy printout provided in Exhibit L of the Complaint).

The Complainant also contends that the Respondents have not made any preparations to offer goods and/or services through web sites accessible by any of the contested domain names. In that vein, the Complainant alleges that since registering the <ebayamerica.com> domain name, the Respondents have placed minimal content on this site, this content being limited to the offering of the contested domain names for sale, and that the Respondents have not placed any content and/or material on a corresponding web site for any of the other contested domain names, i.e., addressed through <ebaygreece.com>, <ebaynewzeland.com>, <ebayturkey.com>, and <ebayunitedkingdom.com>. The Complainant points to the message returned when each of the latter domain names is used in a URL to address a site, i.e., "The page cannot be displayed". (as shown in the print-outs provided in Exhibit M to the Complaint).

The Complainant also points to the intentional conduct of the Respondents in registering four of the contested domain names as evidencing bad faith. Specifically, rather than ceasing use of the contested domain name <ebayamerica.com> as demanded by the Ms Stern in her letter of January 13, 2000 to the Respondents, the Respondents then on January 18, 2000 registered the four other contested domain names, each of which incorporates the term "EBAY". The Complainant contends that this conduct constitutes a pattern of conduct that prevents the Complainant, as the rightful owner of the mark "EBAY", from reflecting that mark in corresponding domain name, therefore constituting bad faith registration.

Lastly, the Complainant contends that based on its registration for the mark "EBAY" it would be quite difficult for the Respondents to use any of the contested domain names, each of which includes the term "EBAY", without violating the Complainant's trademark rights.

Therefore, the Complainant concludes that the Respondents' conduct in registering each of the contested domain names amounts to bad faith under paragraph 4(a) of the Policy.

## **B. Respondent**

The Respondents stated that they had not received notice of the Complaint, presumably at their address in Greece.

Notwithstanding its position on notice, to date, the Respondent has not filed any substantive response to the allegations raised in the Complaint.

## **6. Discussion and Findings**

Prior to reaching the substantive issues raised in the Complaint, the Panel will first address the issue of admissibility of the Complainant's December 11, 2000 e-mail to the Center, followed by discussing the issue of whether the Respondent received adequate notice of the Complaint.

### **A. December 11, 2000 Submission by the Complainant**

Ordinarily, the Panel, in the interests of procedural expediency and efficiency under the Rules and Supplemental Rules, is reluctant to consider any further voluntary submissions from any complainant once a response period has commenced, let alone

after that period has ended unless the Panel has specifically requested such submission in accordance with paragraph 12 of the Rules.

Here, however, the information provided in Ms. Anderson's e-mail of December 11, 2000 to the Center has been submitted to counter a position taken by the Respondent, i.e. that it has not received notice of the Complaint.

A Respondent in any judicial or administrative proceeding, certainly including a domain name arbitration under the Policy, and as dictated by elemental and axiomatic jurisprudence, must receive proper notice of the proceeding. Such notice is such an essential pre-requisite that, in the Panel's mind, any claim made by any respondent that it has not been furnished with adequate notice must, as a threshold condition, be assessed by the Panel. For, should the Panel determine that proper notice had not been given to that Respondent, then the proceeding simply can not go forward with respect to that party and therefore must be so dismissed.

Given the importance of this issue coupled with the fact that it was first raised by the Respondent in its December 1, 2000 e-mail to the Center (after the Complaint had been filed and during the response period), then, in the interests of fairness and under paragraphs 10(b) and (d) of the Rules, the Panel has admitted the December 11, 2000 e-mail into evidence and has considered the material submitted therewith to assess the adequacy of the notice provided to the Respondents by both the Center and the Complainant.

#### **B. Adequacy of Notice**

For the reasons set forth herein, the Panel finds the notice provided by the Complainant and the Center to the Respondents to be proper and sufficient under the circumstances of this case.

Under provision 5 of version 5.1 of the NSI service agreement (a copy of which appears in Exhibit D to the Complaint), a registrant agrees to "(1) provide certain current, complete and accurate information as required by the application process; and (2) maintain and update this information as needed to keep it current, complete and accurate." In the absence of having been provided with copies of service agreements version 4 (which govern the contested domain name "ebayamerica.com") and 5 (which governs the four other contested domain names), the Panel has every reason to believe that the same or a very similar provision exists in both of those versions of the service agreement to which the Respondents are contractually subject.

Paragraph 2(a) of the Rules imposes a responsibility on a dispute resolution provider, i.e. the Center in this proceeding, to use "reasonably available means calculated to achieve actual notice to Respondent" and states that "Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility". This Rule then, to the extent salient, specifies sending copies of a complaint to all the registrant's postal addresses and facsimile numbers shown in the registrar's WHOIS database and supplied by the registrar to the provider; in electronic form (including annexes to the extent available in that form), to the e-mail address of the technical, administrative and billing contacts, the postmaster; and to any address the respondent has notified the provider it prefers and, to the extent practicable, to all other addresses provided to the provider by the complainant."

Through a contractually imposed obligation, set forth above, on a registrant to update its address information on file with its registrar such that the information on file is "current, complete and accurate", a dispute resolution service provider, through use of the modalities of service specified in paragraph 2(a) of the Rules, can provide notice to the registrant in a manner that is reasonably calculated to reach that registrant.

It is completely infeasible if not totally impossible to burden a complainant, any registrar, or any dispute resolution service provider, such as the Center, with the task of ensuring that all domain name registrants accurately and regularly check and update their contact information. It is only the registrant that is in ready possession of its current contact information, no one else.

Not only did the Complainant and the Center provide the requisite notice in full accord with the provisions of paragraph 2(a) of the Rules, but also, as indicated in the correspondence between Ms. Stern and Mr. Cesner, the Respondents, through their attorney, received actual notice of the Complaint. Even if the Respondents did not actually receive a physical copy of the Complaint, by virtue of having then been located in Greece at the time delivery of the Complaint was either attempted or made, their attorney was clearly acting within his representational authority in accepting service on their behalf. Ms. Stern in her letter dated November 27, 2000 to Mr. Cesner states: "I write to follow up on our telephone conversation of Wednesday, November 15, wherein we discussed the WIPO complaint ("Complaint") recently filed by our client, eBay, Inc.". Subsequently, Mr. Cesner, through a letter dated November 27, 2000 back to Ms. Stern, stated "I have had an opportunity to discuss this matter further with my client and obtained his authorization to settle this disputed matter for the sum of \$ 1,500.00, plus any fee needed to amend registration records." Clearly, this correspondence indicated that Mr. Cesner received the complaint and fully discussed it with his client, the Respondents, sufficiently so as to enable the Respondents to provide Mr. Cesner with authority to extend a settlement offer.

Hence, in the Panel's mind, it is totally inconsistent and defies common sense for the Respondents to now complain, through their December 1, 2000 e-mail to the Center, that they had no knowledge of the Complaint as the Respondents seem, at first blush, to allege. Obviously, when read in the context of the events that had transpired, the Respondents in stating, in their December 1, e-mail, "No copies of the Complaint were received" may be asserting that neither the Complainant nor the Center served the Respondent, at its address then in Greece, with a physical copy of the Complaint.

Such physical service here is unnecessary. All that is required is that manner employed to serve the complaint be such as to constitute "reasonably available means calculated to achieve actual notice" and, as effectively a safe harbor, be those delineated in paragraph 2(a) of the Rules.

Clearly, the Complainant and the Center, in following the procedures specifically enumerated in this paragraph of the Rules and serving the Respondents at their contact addresses shown in the registration records, did just that. Furthermore, there is no allegation in any of the correspondence between the Center, Complainant and Respondents that the Respondents did not receive the e-mail copy of the Complaint.

Any failure of the Respondents in not receiving a physical copy of the Complaint, as a result of shipments made on October 25, 2000 by the Complainant and subsequently on November 16, 2000 by the Center, lies with the Respondents for not timely updating their contact information with NSI as they are contractually obligated to do under the

registration agreements they signed. Thus, any consequence of such omission must fall on the Respondents here.

### **C. Issues raised in the Complaint**

Now, having dispensed with the issue of notice, the Panel turns its attention to the issues raised in the Complaint itself.

In view of the lack of a response filed by the Respondents as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondents, the Panel makes the following specific findings:

#### **1. Similarity**

It is beyond question that confusion would likely arise when and if the Respondents, or any third-party not affiliated with the Complainant to which either of the Respondents were to transfer any of the contested domain names, or were to start using that name in conjunction with goods and/or services similar to those of the Complainant.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through any of the contested domain names, to think that an affiliation of some sort exists between the Complainant and the Respondents or its third-party transferee, when, in fact, no such relationship would exist at all. See *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

This is particularly telling here inasmuch as the Complainant repeatedly promotes its services using domain names and marks that are formed by prepending its registered mark "EBAY" to a country name, such as France and Canada to form <ebayfrance.com> and <ebaycanada.com>, respectively.

Each of the contested domain names contains the mark "EBAY" followed by a country name; specifically, America, Greece, New Zealand, Turkey and the United Kingdom.

In the Panel's view, mere inclusion of a country name, or other geographic descriptor, is insufficient, in general and particularly here, to dispel user confusion from occurring. In fact, given the manner in which the Complainant regularly forms a name and a domain name for use in various countries through concatenating its mark "EBAY" with the name of each specific country, Internet users located in a specific country, such as in Greece, Turkey or New Zealand, who seek the Complainant's web site unique to that country, and are familiar with the Complainant's naming convention, would naturally think to form a domain name in the same manner, then enter that name into a web browser as a component of a URL and expect to reach the Complainant's web site for that specific country. The Panel takes notice of the large numbers of Internet users that visit the Complainant's web sites and/or are familiar with the Complainant. Hence, the contested domain names present considerable potential for user confusion.

See *AT&T Corp. v. WorldclassMedia.com* D2000-0553 (WIPO July 28, 2000) where the panel found confusing similarity to the mark AT&T by domain names formed by including a geographic descriptor following the term ATT. See also *America Online*,

*Inc. v. Dolphin@Heart* D2000-0713 (WIPO August 24, 2000) in which the panel there held: "The addition of the name of a place to a service mark, such as the addition of 'France' to 'AOL' is a common method for specifying the location of business services provided under the service mark. The addition of a place name generally does not alter the underlying mark to which it is added." In the *America Online* case, the panel further concluded: "A consumer or user of the Internet viewing the address 'www.aolfrance.com' is likely to assume that Complainant is the sponsor of or associated with the website identified by the disputed domain name, particularly in light of the fact that Complainant routinely uses its 'AOL' service mark in combination with country names in its advertisements on the Internet." Such is indeed the case here with respect to Complainant, eBay Inc., and its mark "EBAY". Also, for similar holdings, see, *Wal-Mart Stores, Inc. v. Walmarket Canada* D2000-0150 (WIPO May 2, 2000) and *Cellular One Group v. Paul Brien* D2000-0028 (WIPO March 10, 2000).

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

## **2. Illegitimacy**

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its mark "EBAY". Furthermore, by virtue of the registration of this mark, the US PTO has implicitly recognized that this mark has acquired appropriate secondary meaning in the marketplace.

The Respondents have yet to provide any basis that would legitimize any claim they have to any of the contested domain names. In fact, it is extremely unlikely that either of the Respondents can even make such a claim.

The simple reason is that each of the contested domain names includes the Complainant's mark "EBAY" mark under which the Complainant distributes its goods and services, and has been doing so for some time. The Complainant has never authorized the Respondents to utilize the mark "EBAY" or for that matter any of the EBAY marks, nor does the Complainant have any relationship or association whatsoever with either of the Respondents. Hence, any use to which either of the Respondents were to put of any of the EBAY marks, including the mark "EBAY" itself, in connection with the goods or services listed in the corresponding registration would directly violate the exclusive trademark rights now residing in the Complainant.

In light of the above findings, the Panel is not persuaded that the Respondents have any or, based on current facts provided to the Panel, are likely to acquire any legitimate interests in any of the contested domain names, whether on a commercial or non-commercial basis.

In that regard, the Panel finds that the Respondents' efforts in registering the <ebayamerica.com> domain name and using it, as a means to direct Internet users to Respondents' own website, through which they offer all five contested domain names for sale, fails to constitute a bona fide commercial offering of goods or services under the <ebayamerica.com> domain name. Moreover, the Panel finds that such use certainly does not constitute, under paragraph 4(c) of the Policy, a legitimate non-commercial or fair use without any intent either for commercial gain, or to misleadingly divert consumers or tarnish the trademark or service mark at issue. In fact, the Respondents' continued retention of all the contested domain names coupled with direction, through one of those domain names (here <ebayamerica.com>), of an

Internet user, who enters that domain name into his(her) browser, to the Respondents' site for the sole purpose of soliciting an offer to purchase any or all of the contested domain names, leads the Panel to conclude that the Respondents specifically intend to accomplish just the opposite.

In this instance, the effective retention and linkage of all the contested domain names for the same purpose, i.e. their attempted sale, infects all the Respondents' interest in all the domain names with the same cloak of illegitimacy.

The Respondents have put forth no forth proof that would legitimize any possible use Respondents are making or would make for each of the contested domain names. Listing domain names for sale does not constitute any demonstrable preparations to use the domain name in connection with a bona fide offering of goods and services. In fact, such listing, particularly when viewed in the context of the Respondents' willful registration of those names, clearly evidences use in bad faith.

Furthermore, the Panel is cognizant of the heavy burden that would be placed on complainants if in support of their cases on illegitimacy each of those complainants were to be impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their respondents. Such a burden is particularly problematic given that the underlying facts more than not are in exclusive or near exclusive possession and control of the respondents, particularly if they have not in fact made publicly discernible use. As such, the Panel believes that where allegations of illegitimacy are made, particularly as here, when coupled with conduct of respondents that evidences bad faith, it is quite reasonable to shift the burden of proof to each such respondent to adequately show that its use of the contested domain name is legitimate, such as by showing that, in conjunction with the contested domain name, it is making a bona fide commercial offering of goods or services or preparations for such offerings, or non-commercial or fair use. Given the situation now facing the Panel, it is beyond question that the Respondents' conduct falls far short of meeting this burden. There simply is no proof whatsoever of any such usage. *See Playboy Enterprises International, Inc. v. Hector Rodriguez* D2000-1016 (WIPO November 7, 2000) and *MSNBC Cable, LLC v. Tsysys.com* D2000-1204 (WIPO December 8, 2000).

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

### **3. Bad Faith**

The Panel is not persuaded that the Respondents chose any of the contested domain names, all of which contain the Complainant's registered mark "EBAY", for any reason other than a future expectancy of holding that name for sale to the Complainant, a competitor thereof or others for a sum well in excess of the Respondents' costs of registration. If this were not the case, then one could very well ask why would the Respondents offer all these domain names for sale, through its website, and particularly such a site accessible by one of the contested domain names, if their only motive were to recover the costs of registration.

Clearly, such altruistic motivation lacks credibility. People, who manifest an intent to traffic in domain names that incorporate well-known or famous trademarks, as the Respondents do here, simply do not expend their efforts with the sole intention of relinquishing those domain names for just their out-of-pocket registration costs. The goal of their efforts, simply put, is an expectation of receiving an adequate reward, i.e.,

sufficient profit, from this trafficking. See, e.g., *Treeforms, Inc. v. Cayne Industrial Sales, Corp.* FA0010000095856 (National Arb. Forum December 18, 2000).

Moreover, using the contested domain name to divert Internet users to a site held by the Respondents through which it offers domain names for sale, here being all the contested domain names, merely compounds the harm which the Respondent is inflicting on those trademark owners; harm which the Policy and the US Anti-Cybersquatting Act are designed to remedy.

The Panel firmly believes that the Respondents' willful conduct, of registering the four additional domain names all containing the Complainant's mark "EBAY" (<ebaygreece.com>, <ebaynewzealand.com>, <ebayturkey.com> and <ebayunitedkingdom.com>) after having received notice from the Complainant of its trademark rights and a demand from the Complainant to cease all further infringing use of its mark "EBAY", had as its likely goal attaining a competitive advantage and/or added leverage for use in subsequent negotiations with the Complainant so as to secure a larger financial settlement, in exchange for transferring these domain names to the Complainant, than might otherwise occur. Else, why would the Respondents register those names and at the time it did?

Paragraph 4(b)(i) and (ii) of the Policy respectively provide, as examples of bad faith registration, registration of a domain name: "primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark ... for valuable consideration in excess of ... out-of-pocket costs directly related to the domain name" or to "prevent the owner of the trademark ... from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct."

There can be no doubt that the Respondents' conduct clearly falls under paragraph 4(b)(i) and also constitutes a pattern of conduct falling within the strictures of paragraph 4(b)(ii).

Moreover, the Panel finds that the listing by the Respondents of all the contested domain names for sale with GreatDomains.com as well as through its own <ebayamerica.com> site constitutes further evidence of abusive registration and bad faith use of these domain names. In that regard, see the *Wal-Mart Stores, Inc.* case cited supra, as well as *Robert Ellenbogen v. Mike Pearson* D2000-0001 (WIPO February 17, 2000).

Hence, 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 (a)(iii) of the Policy.

In this connection the Panel notes that in its opinion, the Respondents' actions in registering and now retaining the contested domain names also evince bad faith in violation of the Anti-Cybersquatting provisions of the Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

Thus, the Panel concludes that the Complainant, even apart from default of the Respondents, 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 <ebayamerica.com>, <ebaygreece.com>, <ebaynewzealand.com>, <ebayturkey.com> and <ebayunitedkingdom.com>, are ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Sole Panelist

Dated: January 10, 2001