



NATIONAL
ARBITRATION
FORUM

DECISION

Lane-Labs USA, Inc. v. Powell Productions
Claim Number: FA0304000155896

PARTIES

Complainant is **Lane-Labs USA, Inc.**, Allendale, NJ (“Complainant”) represented by **Marc A. Lieberstein** of **Ostrolenk, Faber, Gerb & Soffen, LLP**. Respondent is **Powell Productions**, Pinellas Park, FL (“Respondent”).

REGISTRAR AND DISPUTED DOMAIN NAMES

The disputed domain names at issue are <**advacal.com**> and <**benejoint.com**> registered with **Tucows, Inc.**

PANEL

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

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

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/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 National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

The Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on April 25, 2003; the Forum received a hard copy of the Complaint, together with a declaration of Andrew Lane dated April 11, 2003 and accompanying Exhibits A-Z, on April 28, 2003.

On April 28, 2003, Tucows, Inc. confirmed by e-mail to the Forum that the domain names <advacal.com> and <benejoint.com> are registered with Tucows, Inc. and that the Respondent is the current registrant of both names. Tucows, Inc. has verified that Respondent is bound by the Tucows, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On May 1, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 21, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@advacal.com and postmaster@benejoint.com by e-mail.

A timely Response, together with Exhibits A-I, was received and determined to be complete on May 21, 2003.

An additional submission from the Complainant, captioned "Reply" together with Exhibit A, was received by the Forum on May 27, 2003. In response to that submission, the Respondent submitted its additional submission, also captioned "Reply", which was timely received by the Forum on June 2, 2003.

On June 3, 2003, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a due date of June 17, 2003 to receive the decision from the Panel.

Being that both additional submissions were timely received, the Panel has considered them along with the Complaint and Response.

Due to an unavoidable time conflict, the Panel extended the due date for its decision to July 1, 2003.

RELIEF SOUGHT

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

The Complainant contends that the disputed domain names are identical to and confusingly similar with the Complainant's ADVACAL and BENEJOINT marks because those domain names wholly incorporate these marks. Hence, Internet users who are

interested in the Complainant's ADVACAL and BENEJOINT products by entering the corresponding disputed domain name, when attempting to find the source or origin of the product on the Internet, will mistakenly find the Respondent.

The Complainant further contends that, since it has registered and uses its other product marks as its domain names, the Respondent's use of those names exacerbates any likelihood of confusion. In that regard, the Complainant states that it owns U.S. Trademark registration 2,673,330 for the mark VIRACLE for dietary supplements and the domain name VIRACLE.COM, and uses its website at <viracle.com> to promote its VIRACLE supplement.

Further, the Complainant asserts that the confusing similarity of the disputed domain names with the Respondent's ADVACAL and BENEJOINT trademarks is heightened by the manner through which the Respondent maintains its website at <healthspotlight.com>. In that regard, the Complainant states that:

"Without the permission of LaneLabs, the Complainant's web site at <healthspotlight.com> includes many references to LaneLabs including a separate tab on the home page specifically designated for LaneLabs' products. There are also sections variously titled 'Who is Lane Labs?' and 'FDA vs. Lane Labs' as well as photographs of LaneLabs and its employees. Most confusing, and again without any consent, there was a letter written by Andrew Lane, President of LaneLabs, on Powell's web site."

In the Complainant's view, those written materials falsely imply that the Complainant is affiliated, connected or associated with the Respondent.

Hence, the Complainant concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

2. Rights and legitimate interests

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

Specifically, the Complainant states that the Respondent has no relationship with Complainant and is not an authorized dealer or distributor of the Complainant's products. In that regard, the Complainant points to the fact that it affirmatively terminated the Respondent's right to purchase product directly from the Complainant. Consequently, the Complainant contends that the Respondent's unauthorized use of the disputed domain names <advacal.com> and <benejoint.com> to sell Complainant's products under the same ADVACAL and BENEJOINT trademarks is not a bona fide offering of goods pursuant to paragraph 4(c)(i) of the Policy.

Moreover, the Complainant asserts that the Respondent's use of the disputed domain name <**advacal.com**> in connection with the sale of third party goods is also wholly illegitimate. Specifically, the Complainant points to the home page of the <**advacal.com**>, which includes links to products, such as Royal Bee that are not manufactured or sold by the Complainant.

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

3. Bad faith use and registration

The Complainant contends that the Respondent has registered and is using both disputed domain names in bad faith in violation of the Policy.

Specifically, the Complainant points to another domain name that it contends the Respondent "hijacked" from the Complainant, namely <3acalcium.com>, which ultimately the Respondent sold to the Complainant for \$500.00—an amount that exceeded the cost of its registration. From this, the Complainant contends that the Respondent has offered to sell the disputed domain name <**advacal.com**> to the Complainant for \$3,000.00, hence indicative of bad faith.

The Complainant also contends that the Respondent's bad faith is further manifested in that: (a) the Respondent's continued registration of the disputed domain names disrupts the Complainant's business inasmuch as by preventing the Complainant from registering its trademarks as .COM domain names; and (b) the Respondent has registered multiple domain names to prevent the Complainant from using them to promote its products.

B. Respondent

1. Confusing similarity/identity

The Respondent concedes that the terms BENEJOINT and ADVACAL are trademarks of the Complainant and hence that the disputed domain names are identical to these trademarks.

2. Rights and legitimate interests

The Respondent states that it has a legitimate interest in the disputed domain names inasmuch as it markets and supplies the Respondent's products, including ADVACAL and BENEJOINT, hence providing a bona fide offering of goods.

Such offerings continue to date, even though the Complainant has ceased directly supplying its products to the Respondent, which now procures those products from

several distributors. Hence, the Respondent states that the Complainant, which indirectly receives sales revenue from the Respondent's on-going sales effort, still benefits from the Respondent's activities.

With respect to the Complainant's assertion that the Respondent's website at <advacal.com> contained links to products from others than the Complainant and hence its use of that name was illegitimate, the Respondent states that it has removed all links from that site to all such products. In that regard, the Respondent states:

"We have always made the many changes in our Web sites as requested by Lane Labs, usually within 48 hours. Lane Labs has never in three years complained about links to other products from the Benejoint and/or the Advacal sites. Nor have they requested any changes to these sites."

3. Bad Faith

The Respondent states it originally registered the disputed domain names in good faith to create new sales of the corresponding products of the Complainant, and the Respondent continues to make such sales today. The Respondent states that, through its sales efforts, it has helped the Complainant market its products to the public since 1998.

Moreover, the Respondent states that its intention was never to sell the disputed domain names to the Complainant but rather to keep those names and continue with its sites through which the Respondent sells the Complainant's products, as it does so today.

With respect to the Respondent's site on which it displays sales copy from the Complainant, the Respondent states that:

"As to our sales copy, we have always been limited to using the copy direct from the Lane Labs site. We have worked very closely with Lane Labs staff making almost a hundred Web site changes. Especially when the FDA filed suit against Lane Lab, we had many different changes on our site just to keep up the legal changes on their site. Lane Labs monitors our site on a regular basis. Note any changes Lane Labs had us do were new changes to their original copy."

Lastly, with respect to the offer which the Respondent made to transfer the disputed domain name <advacal.com>, the Respondent justifies its offer as follows:

"The cost of the domains at this date goes far beyond the simple registration, we are building a business, we have three years of Web site hosting, plus the Web site design. Hundreds of dollars alone went into getting the right keywords, a constant changing traffic factor. We use a service KeywordSpinner.com. We have Benejoint.com and Advacal.com submitted to over 700,000 search engines, directories and links every 21 days. This is done by Submit Pro submission service at \$100.00 per month. When Andy Lane asked us what we wanted we replied only \$3,000.00 (in Lane Labs products), our out-of-pocket expense. All we are asking for is our out-of-pocket expenses for supporting the domain name

with massive traffic which will move with the domain names if they are transferred to Lane Labs."

C. Additional Submissions

Through their additional submissions, which, as noted above, the Panel has considered, both the Complainant and Respondent provide further, but essentially cumulative, arguments to those supplied in their main submissions. Hence, to avoid unduly extending an already protracted decision and further taxing the reader's patience, the Panel will simply dispense with summarizing these submissions.

FINDINGS

A copy of the WHOIS registration record for each of the disputed domain names appears in Exhibit U to the Complaint (though Complainant's Exhibits A-Z are actually associated with the Lane declaration that accompanies the Complaint, for simplicity, the Panel will just refer to those Exhibits as if they were directly associated with the Complaint). These records indicate that the Respondent registered <advacal.com> on November 13, 2002 and <benejoint.com> on September 5, 2000 with Tucows, Inc.

A. The Complainant's Marks

1. ADVACAL mark

Presently, the Complainant owns one federal trademark application for the term ADVACAL and has provided, in Exhibit D to the Complaint, a copy of a database record (accessed from the site <trademark.com>) for this mark. The pertinent details are as follows:

ADVACAL (block letter)
US serial number 78/048,169

This trademark application is pending for use in connection with: "calcium mineral supplements" in international class 5. This mark claims first use and first use in interstate commerce of December 31, 1999. As of April 8, 2003, this mark has been published for opposition.

2. BENEJOINT mark

The Complainant owns a federal registration for the term BENEJOINT and has provided, in Exhibit I to the Complaint, copy of a database record (also accessed from the site <trademark.com>) for this mark. The pertinent details are as follows:

BENEJOINT (block letter)

US registration 2,211,209; registered December 5, 1998

This service mark was registered for use in connection with: "analgesic skin cream" in international class 5. This mark claims first use and first use in inter-state commerce of April 30, 1998.

B. The Complainant and its activities

The Complainant, established in 1994, manufactures and sells a wide variety of proprietary natural supplements and has sales of approximately \$30,000,000 a year and approximately 50 employees.

Among its many products, the Complainant markets and sells a natural calcium supplement product under its mark ADVACAL which, Complainant states, has been clinically shown to increase bone density in women by as much as 10% in a year. This product is a patented blending of calcium hydroxide and calcium oxide with a natural heated algal ingredient for bone support.

In addition, the Complainant also sells a topical pain reliever under its mark BENEJOINT. The BENEJOINT product is a concentrated mousse that penetrates to a pain source. According to the Complainant, BENEJOINT mousse provides pain relief by combining effective levels of both capsaicin and menthol plus soothing essential oils and glucosamine.

The Complainant prominently features its name and its mark LANE LABS on all bottles for its calcium mineral supplements sold under its mark ADVACAL and for all bottles of its pain reliever sold under its mark BENEJOINT. As a result, consumers associate the marks ADVACAL and BENEJOINT with the Complainant as a source of origin of the products. As such, the Complainant claims to have developed significant goodwill in both of these marks.

C. The Respondent and its activities

The Respondent provides website design, promotion and marketing services. In that regard, see the home page at Respondent's website <powellproductions.com>—a hard-copy version of which appears in Exhibit K to the Complaint.

In particular, the Respondent owns different websites, including <healthspotlight.com> that specialize in various activities. That particular site went online on January 28, 1999 to exclusively promote the sale of various natural supplements, including those marketed and sold by the Complainant. Previously, the Respondent has purchased the Complainant's supplements directly from the Complainant for resale; but, now, for reasons that will become clear below, it does so through distributors. Copies of

illustrative invoices from the Complainant to the Respondent, for certain direct sales made from the former to the latter, are provided in Exhibit M to the Complaint.

The Respondent has registered the disputed domain names without the permission of the Complainant and maintains websites <advacal.com> and <benejoint.com> for the purpose of marketing the Complainant's ADVACAL and BENEJOINT products. Hard-copy printouts of various pages from these sites appear in Exhibit A to the Response. In that regard, the Respondent states in its Response:

"The Advacal.com and Benejoint.com domain name registration, Web site construction and site promotion was done (and continues on today) for the purpose of selling and shipping Lane Labs products Benejoint and Advacal. Our goal since 1998 has been to help support a then little known company by promoting their excellent and amazing products."

The Respondent's <healthspotlight.com> website includes many references to the Complainant including a separate tab on its home page specifically designated for the Complainant's products. There are also sections variously titled "Who is Lane Labs?" and "FDA vs. Lane Labs" as well as photographs of the Complainant and its employees. Further, the site contains a letter written by Andrew Lane, President of the Complainant.

Two years ago, and again without authorization from the Complainant, the Respondent registered the domain name <3acalcium.com>. The term 3ACALCIUM is a trademark of the Complainant. In that regard, the Complainant owns federal trademark application serial number 76/163,719 for the term 3ACALCIUM for dietary supplements. However, as indicated in a database printout (also from <trademark.com>), this application was filed on an intent-to-use basis. As of May 20, 2003, this application has been allowed by the U.S. Patent and Trademark Office (on November 20, 2001) but the Complainant has yet to show use of the mark, such as by filing a Statement to Allege Use. The Respondent states that the reason it registered <3acalcium.com> was to market the Complainant's 3ACALCIUM product.

The Respondent offered to sell his <3acalcium.com> domain name registration to the Complainant in exchange for \$3,500. In response to the offer and to settle its dispute over the name, the Complainant offered to buy that name from Respondent for \$500. The Respondent accepted. The Complainant then paid the Respondent \$500 in exchange for which the Respondent transferred that domain name registration to the Complainant.

Specifically, as to the events underlying the transfer of <3acalcium.com>, the Respondent states that while it had its website set up and running and its marketing promotions underway, the Complainant called the Respondent and said that it had a special project for the domain name <3acalcium.com> and demanded the Respondent transfer that name to the Complainant or the Complainant would cease supplying all of its products to the Respondent. The Respondent suggested that the Complainant pay its out-of-pocket domain expenses estimated at \$3,500. According to the Respondent, the Complainant

replied that it would accept transfer of the domain name for \$500 or it would close the Respondent's wholesale product account with the Complainant. This, in turn, notes the Respondent, would force the Respondent to not only close out its 3ACALCIUM product but also its main site at <healthspotlight.com> as well. Further, the Respondent stated:

"There [sic] were holding our sites for ransom. My wife and partner, Dr. Judith Powell wanted to keep the products of Lane Labs available to our clients. So I rolled over and accepted the \$500.00. By the way, during our original phone conversation unbeknownst to us, Lane Labs held up shipping the large order we had prepaid the previous day, without telling us. This was blackmail."

As for the presently disputed domain name <**advacal.com**>, during February 2003, approximately two years after the incident involving <3acalcium.com>, the Complainant, this time through Mr. Russell Mendola, contacted the Respondent again and inquired about "what it would take to transfer the **advacal.com** registration". At that time, the Respondent's sales through its <**advacal.com**> site had finally started climbing. The Respondent determined its out-of-pocket expense connected with that to be \$3,000, and "cut it in half to \$1,500.00". In that regard, the Respondent stated:

"We expected their counteroffer to be \$500.00 with the ultimatum. We would bite the bullet and keep peace and agree to accept the offer. But they came back with an offer of NOTHING but a year's domain name registration cost. At that time I asked Mr. Mendoza why Lane Labs was always harassing me and not the other domain holders of their trademarked names. His reply was: 'Because they can. Powell Productions was the only company they could actually speak with. No one else replied back to them.' Please remember I have over three years registration expense on Benejoint.com plus Web hosting expenses, etc. We found their offer insulting. The next day we received an ultimatum call from Andy Lane who eventually offered the \$500.00 or else. I rejected his offer and said the least I would expect is the \$1500.00. He said no."

In an effort to amicably resolve the dispute over ownership of the domain names, without resort to arbitration, the Complainant instructed its counsel to write to the Respondent to advise the latter of possible trademark infringement. A copy of an ensuing letter dated March 18, 2003 appears in Exhibit Y to the Complaint. Also, through this letter, the Complainant recently terminated the Respondent's right to purchase these products directly from the Complainant. A copy of the Respondent's April 3, 2003 responding letter appears in Exhibit Z to the Complaint.

In the Respondent's letter, the Respondent expressed surprise that its right to purchase product direct from the Complainant had been terminated by the Complainant. In that regard, the Respondent's letter stated, in pertinent part:

"First, you say my right to purchase Lane Labs products has been terminated. May I ask when and on what grounds was our account was terminated? I have not received a notice of termination from Lane Labs. I would also like a explanation for termination. We prepay everything, there is simply no reason for termination.

To our knowledge, we are still an authorized distributor of Lane Labs products. We have received no notice nor reason to believe differently with exception of your letter. We were told our last order was on hold. This was not surprising as Lane Labs has often not shipped orders for no good reason."

The Respondent, citing his considerable investment in the <advacal.com> domain name, including designing and creation of the <advacal.com> website, web hosting expenses, and expenses charged by various search engines to presumably list the <advacal.com> site, offered to sell the disputed domain name <advacal.com> to the Complainant for \$3,000.

The Respondent established its <healthspotlight.com> website in 1999 with the specific purpose of selling and distributing the Complainant's products. That site was specifically approved by Mr. Lane—who was well aware of its content. Each web page on that site (examples are provided in hard-copy form in Exhibit O to the Complaint) is taken from the Complainant's product brochures and its website. Moreover, Mr. Lane specifically requested certain changes in various ones of these pages, to which the Respondent promptly complied.

The Respondent's business quickly grew through which it was supplying the Complainant's products, at wholesale pricing, to doctors and health food stores and, at retail pricing, to its online customers. For no apparent reason known to the Respondent, the Complainant suddenly increased the Respondent's minimum order from \$2,500/month, which the Complainant had imposed several months after the <healthspotlight.com> site went online, to \$2,500/order. The Respondent quickly reached that level. On about August 15, 2000, the Complainant increased the Respondent's minimum order level to \$3,500/order, which, shortly thereafter, the Respondent also reached. Through the same letter which increased the Respondent's minimum order level, the Complainant also introduced and offered a new product called NK-1000 to the Respondent. The Complainant sent the Respondent a sample of that product; however, when the Respondent subsequently tried to order it, the Respondent was advised that the Complainant would not sell that product to the Respondent.

Thereafter, on or about September 2000, the Respondent terminated the Complainant's distributor discount which had the effect of preventing the Respondent from wholesaling the Complainant's products to the Respondent's professional and health food accounts. In the absence of providing wholesale discounts, the Respondent lost those accounts to either the Complainant directly or to other distributors. The Complainant's proffered explanation for cutting off the Respondent's discounts was simply "that's the way it is". This action severely cut into the Respondent's business, which, at the time, was doing about \$3,000/week and growing. The Respondent, in inquiring with Andrew Lane as to how he expected the Respondent to survive, was told that they should carry other companies products on the site, which the Respondent ultimately did.

About the same time, the U.S. FDA (Food and Drug Administration) filed suit against the Complainant for false advertising of its products. Mr. Lane told the Respondent that the FDA had fined the Complainant \$2 million. At Mr. Lane's request, the Respondent removed specific pages and certain quotes and statements from its <healthspotlight.com> site (all of which had previously been approved by Mr. Lane for inclusion on the site). The Respondent stated, in its April 3, 2003 letter, that it saw no problem in removing from its site the pages "Who is Lane Labs", "FDA vs. Lane Labs", the photos of the Complainant's employees and letter written by Mr. Lane. The Respondent states that the reason for having those pages present was to "build the Lane Labs credibility after losing the FDA court case".

The Respondent continues to market the Complainant's ADVACAL and BENEJOINT products which it obtains, on a wholesale basis, through several distributors.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

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

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

Identical and/or Confusingly Similar

No doubt exists whatsoever that the contested domain names are identical to the Complainant's ADVACAL and BENEJOINT marks. The difference between the domain names and the corresponding marks are simply the inclusion of the generic top level domain ".com" to the domain name. This difference is utterly de minimus.

Though, based on the record before the Panel, the term ADVACAL has not yet been federally registered, to simplify this decision particularly since the Respondent concedes that the Complainant has trademark rights in both ADVACAL and BENEJOINT, the Panel will assume that the term ADVACAL has acquired sufficient distinctiveness in the market so that the Complainant has acquired common law trademark rights in the term ADVACAL sufficient for purposes of invoking paragraph 4(a)(i) of the Policy.

Therefore, the Panel also finds that sufficient similarity exists under the Policy for each of the contested domain names.

Rights or Legitimate Interests

The Policy, under paragraph 4(c), provides a non-exclusive list of factors, any one of which, if proven by a respondent, demonstrates that the respondent has legitimate rights and interests in a contested domain name. Of particular relevance here is the factor recited in paragraph 4(c)(i) which states: “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services”.

The Respondent has clearly proven by substantial, overwhelming and undisputed evidence that prior to his having received notice of this dispute, via the March 18, 2003 letter from Complainant’s counsel, that not only had the Respondent made demonstrable preparations for using the disputed domain names in connection with bona fide offerings of goods, specifically the Complainant's goods, but, in fact, the Respondent had been so offering those goods for sale via its websites resolvable through these names, as well as for over a two-year period through its <healthspotlight.com> site. While use of the <healthspotlight.com> name is not disputed by the Complainant, the totality and consistency of the Respondent's sales activities (along with their growth) across its three sites, as reflected in the record before the Panel, clearly indicate that all these activities and the associated sales, which ultimately benefited not just the Respondent but also the Complainant, were made not only with the knowledge of the Complainant but also, and more telling, its active participation and approval. In short, the Complainant authorized the Respondent to do exactly what it did and to continue doing so until arguably March 18, 2003, which was well after the Complainant prepared its corresponding websites and started its sales activities through the disputed domain names.

In view of the facts at hand here, various panels have upheld the actions of a respondent in using a domain name that includes a mark owned by a complainant-manufacturer (or licensor) for a website through which the respondent sells legitimate goods from the complainant where the respondent's acts of doing so were authorized and even, in those instances, where they were not, did not cause consumer confusion by, e.g., selling products of others competitive to those of the complainant. In that regard, see *Koninklijke Philips Electronics N.V. v. Cun Siang Wang* WIPO Case No. D2000-1778 (March 15, 2001) (where, in finding for the respondent, the panel found that the respondent was not licensed to use the complainant's marks but no evidence existed that the respondent was selling products other than those "placed on the market by the claimant's group"); *Weber-Stephen Products Co. v. Armitage Hardware* WIPO Case No. D2000-0187 (May 11, 2000) (where, in finding for the respondent, the panel found that the respondent was a licensed sales representative of the complainant and licensed to use the complainant's mark in advertising and sales of the complainant's products); and *Nikon Inc. and Nikon Corporation v. Technilab, Inc.* WIPO Case No. D2000-1774 (February

26, 2001) (where, in finding for the complainant and ordering transfer of the disputed domain names, the panel found that the respondent used at least one of the disputed domain names to sell competitive products of the complainant). By the facts of the record, this Panel is persuaded that this case involves a respondent honestly selling legitimate goods from a complainant and no others through websites bearing the disputed domain names to the ultimate benefit of both. In that regard, see *Utensilerie Associate S.p.A v. C & M* WIPO Case No. D2003-0159 (April 22, 2003) where the panel recognized, as here, a right in a respondent to utilize a domain name where a complainant specifically granted that right in stating:

"Respondent would only have a right to the domain name <usagshop.com> if Complainant had specifically granted that right. Although Respondent received permission from Complainant to use the USAG logo and promotional materials for Usag products on its website, it did not inform Complainant of, let alone [sic] ask permission for the registration and use of the domain name <usagshop.com>. Clearly, Complainant's permission to use the trademark USAG on the website does not include permission for registration and use of the domain name <usagshop.com>."

Under the present facts, even if the Complainant did not provide its explicit permission to the Respondent for it to register and use the disputed domain names as it has, that permission, can, at the very least, be unquestionably inferred from the Complainant's actions.

Therefore, it is beyond doubt that the Respondent's activities directly fall within the purview of paragraph 4(c)(i) of the Policy. Consequently, the Panel finds that the Respondent has legitimate rights and interests in the disputed domain names.

Registration and Use in Bad Faith

Given that the Respondent has clearly proven that it has legitimate rights and interests in the disputed domain names, the issue of whether the Respondent registered and used these in bad faith is moot. Hence, the Panel sees no need to address that issue and declines to do so.

While the Complainant may have disputes with the Respondent involving the Respondent's continued sale of the Complainant's products or other matters, which the Panel infers from an otherwise silent record, all such disputes lie outside the purview of the Policy and thus must be relegated to an appropriate judicial forum for review. ICANN panels, such as this one, simply have no authority to consider such disputes. See, e.g., *Citigroup, Inc. v. Joseph Parvin* WIPO Case No. D2002-0969 (May 12, 2003); *AutoNation Holding Corp. v. Rabea Alawneh* WIPO Case No. D2002-0058 (May 1, 2002); *Continental Design and Management Group v. Technet, Inc.* FA 96564 (Nat. Arb. Forum March 21, 2001); *The Thread.com, LLC v. Jeffrey S. Poploff* WIPO Case No.

D2000-1470 (January 5, 2001); and *Commercial Publishing Co., Inc. v. EarthComm, Inc.*
FA 95013 (Nat. Arb. Forum July 20, 2000).

DECISION

In accordance with paragraph 15 of the Rules, the relief sought by the Complainant is hereby **DENIED**.



Peter L. Michaelson, Esq.
Arbitrator

Peter L. Michaelson, Esq., Panelist
Dated: July 1, 2003