



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Oakley, Inc. v. Kate Elsberry, Elsberry Castro**

**Case No. D2009-1286**

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

The Complainant is Oakley, Inc. of California, United States of America, represented by Weeks, Kaufman, Nelson & Johnson, United States of America.

The Respondent is Kate Elsberry, Elsberry Castro, of Florida, United States of America.

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

The disputed domain name, <oakleyvenezuela.com>, is registered with 1 & 1 Internet AG (the "Registrar").

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

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

The Complaint, with accompanying Annexes 1-3, was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on September 30, 2009 and subsequently by hardcopy on October 1, 2009. In response to an e-mail message from the Center dated October 10, 2009 specifying a deficiency in the Complaint, the Complainant filed an amendment to the Complaint, with the Center, by e-mail on October 15, 2009. Accordingly, all references hereafter to the Complaint will be to the amended Complaint.

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, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on September 30, 2009, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in the Complaint relative to the disputed domain name, and whether the name is indeed registered with the Registrar. The Center also requested the Registrar to specify for the disputed domain name: (a) the dates on which the registrant registered the domain name (or acquired the registration) and when the registration will expire, (b) whether the Policy applies to that domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on October 1 2009, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIs database. Further, the Registrar stated that: it had received a copy of the Complaint, the Respondent was listed as the registrant for the domain name, and the domain name is registered with 1 & 1 Internet AG. The Registrar’s response further indicated that: (a) the registration was created on June 27, 2009 and will expire on June 27, 2010, (b) the Policy applies to the domain name, (c) the registration agreement is in English, and (d) the domain name will remain locked during the proceeding.

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

On October 16, 2009, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its annexes, by courier and email, and a copy of the Complaint without annexes by facsimile. 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 October 16, 2009, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

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

The Respondent was then provided with a 20 calendar day period, expiring on November 5, 2009, to file its Response with the Center and the Complainant.

As of November 6, 2009, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter dated November 6, 2009, notified the Respondent of its default.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated November 10, 2009, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as sole Panel for this dispute. Subsequently, on November 11, 2009, Mr. Michaelson accepted and returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated November 13, 2009, notified the Parties of the appointment of Mr. Michaelson as sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before November 27, 2009.

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

#### 4. Factual Background

As indicated in the WhoIs registration records provided in Annex 1 to the Complaint, the disputed domain name was registered on June 27, 2009.

##### A. Complainant's OAKLEY Marks

The Complainant owns various trademark registrations in over 100 countries, including both the United States ("US") and Venezuela, for the mark OAKLEY either in block letters or a stylized pattern. Some of its US registrations are as follows:

Trademark	Registration No.	Registered	Class
Oakley	1,356,297	Aug. 27 ,1985	9,12,25
Oakley	1,519,596	Jan. 10, 1989	9
Oakley	1,519,823	Jan. 10, 1989	18
Oakley	1,521,599	Jan. 24, 1989	9
Oakley	1,522,692	Jan. 31, 1989	25
Oakley	1,552,583	Aug. 22, 1989	9, 12
Oakley (w/ellipsoid o)	1,902,660	Jul. 4, 1995	16
Oakley (stretched)	1,908,414	Aug. 1, 1995	16
Oakley (stretched)	1,980,039	June 11, 1996	9, 25
Oakley	1,990,262	July 30, 1996	9, 25
Oakley	2,293,046	Nov. 16, 1999	25
Oakley	2,409,789	Dec. 5, 2000	14

Oakley (stretched)	2,875,361	Aug. 17, 2004	9, 25
Oakley (Rx)	3,153,943	Oct. 10, 2006	9

Its Venezuelan registrations are as follows:

<b>Trademark</b>	<b>Registration No.</b>	<b>Class</b>
OAKLEY (block)	P246186	16
OAKLEY (block)	P253 899	18
OAKLEY (block)	D031968	43
OAKLEY (stylized)	P243626	18
OAKLEY (stylized)	P243627	25

## **B. The Parties and Their Activities**

The Complainant's OAKLEY brand is a famous eyewear brand known throughout the world. The Complainant has developed a very tight distribution system such that its OAKLEY-branded products are only sold to authorized retailers. In the United States, this is accomplished through direct sales by the Complainant to its authorized accounts. In foreign markets, the Complainant's OAKLEY-branded products are likewise only sold to authorized retailers via a closely monitored distribution system which involves the Complainant's subsidiaries as well as trusted distributors. All authorized third party distributors are required, under contract with the Complainant, to sell OAKLEY-branded products only to authorized retailers which have been approved by the Complainant.

The Respondent, which is not an authorized retailer of the Complainant's OAKLEY-branded products, is nevertheless offering those products on its website resolvable through the disputed domain name.

## **5. Parties' Contentions**

### **A. Complainant**

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

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's OAKLEY Marks.

Specifically, the Complainant appears to implicitly take the position that inclusion of the country name "Venezuela" after the Complainant's mark OAKLEY to form the disputed domain name not only fails to adequately distinguish the resulting disputed domain name from the mark but also - since the Complainant apparently, directly or through third-parties, sells its products in Venezuela - creates an impression in the minds of Internet users that the disputed domain name confusingly refers to the Complainant's goods in that country and hence aggravates user confusion.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

**(ii) Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, there is no evidence of record that the Respondent: (a) has any rights in any of the OAKLEY Marks, (b) has been commonly known by the domain name, or (c) is making a legitimate non-commercial or fair use of the domain name without the intent for commercial gain misleading to divert consumers or tarnish the trademark at issue.

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

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

First, the Complainant alleges that the Respondent registered the domain name primarily to trade on the Complainant's goodwill.

Second, the Complainant alleges that the Respondent registered the domain name to seek commercial gain by depicting and attempting to sell on its own website the Complainant's OAKLEY-branded products which the Respondent acquired through channels which the Complainant has not authorized. In that regard, the Complainant distributes its OAKLEY-branded products only to its authorized retailers. The Respondent is not one of them. The Complainant requires, by contract, that any third party distributors sell OAKLEY-branded products only to authorized retailers which the Complainant has approved. The Respondent's sales of OAKLEY-branded products negatively impacts the Complainant and its authorized retailers.

Additionally, the Complainant also alleges that the Respondent has also intentionally attempted to attract, for its own commercial gain, Internet users to its website by attempting to create an impression that the website is somehow authorized or endorsed by Complainant or is otherwise affiliated with Complainant -- when in actuality no such relationship, endorsement or affiliation exists between the parties. These actions divert consumers from the Complainant's authorized retailers, both its retail shops and Internet websites, again causing harm to the Complainant and its authorized retailers.

**B. Respondent**

The Respondent failed to file any Response to the contentions raised in the Complaint.

**6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as permitted 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 may in its discretion decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

## A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's OAKLEY Marks.

From a simple comparison of the disputed domain name to the Complainant's mark OAKLEY, no doubt exists that the domain name is confusingly similar to the Complainant's marks.

The primary difference between the disputed domain name and the mark OAKLEY is the appending of the country name "Venezuela" to form a separate corresponding composite term along with, secondarily, appending the gTLD (generic top level domain) ".com" to that term to form the disputed domain name with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words, or country names to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, appending such a word, that being "Venezuela", in the manner which the Respondent specifically did, to the mark OAKLEY clearly resulted in such a minor variation. See, e.g., *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703 (August 11, 2009); *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099 (April 20, 2009); *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008 (March 25, 2009); *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265 (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876 (December 16, 2002).

Moreover, by including the country name “Venezuela” with the Complainant’s mark OAKLEY to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. By appending that term to the Complainant’s mark, such an Internet user would likely be deceived into thinking that the Respondent’s site, which offers the Complainant’s OAKLEY-branded products, is somehow affiliated, related to or sponsored by the Complainant and is thus authorized to sell those products -which in fact it is not. Including that term only increases the likelihood that user confusion will occur and does so to the Respondent’s ultimate benefit and the detriment of Complainant and its authorized retailers. See *Burberry*, *Krispy Kreme*, *Dreamworks* and *MySpace*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark OAKLEY as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

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

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its mark OAKLEY in conjunction with any of the products with which the Complainant uses that mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant’s mark OAKLEY or one confusingly similar thereto in connection with the identical or even similar products to those currently provided by the Complainant, as recited in its any of its trademark registrations, may in circumstances as are present here violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Burberry*, *HRB Innovations Inc.*, *Dreamworks*, *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *National Football League*, *Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823 (February 2, 2009); *GoDaddy.com, Inc., v. GoDaddysDomain.com*, *Clark Signs*, *Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc.*, *Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Claim No. FA 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000). Consequently, in the Panel’s view, the Respondent could not legitimately acquire any public association between it and either the mark OAKLEY or one similar thereto, at least for the OAKLEY-branded products provided by the Complainant to its authorized retailers.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark OAKLEY.

Nor could the Respondent in the Panel's view likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to at least as early as August 1985 - some 24 years prior to the date (June 27, 2009) when the Respondent registered the name, and the evident reputation and notoriety which the Complainant has gained in its marks ever since. See, e.g., *Burberry*, *Starline Publications*, *HRB Innovations Inc.*, *MySpace* and *Treforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, the Panel infers from the lack of any Response, that the Respondent's actions in using the name to resolve to a commercial website through which it offers the Complainant's branded goods, on an unauthorized basis, for sale does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute. Nor does such use constitute either a legitimate noncommercial or fair use of the name, without intent on the Respondent for commercial gain to misleadingly divert consumer or tarnish any of the Complainant's OAKLEY Marks. Consequently, the Respondent's conduct does not fall within paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

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

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel also infers, from the lack of any Response, that the Respondent was well aware of the Complainant's mark OAKLEY when the former registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the domain name in an effort to opportunistically exploit the Complainant's reputation and goodwill in that mark. This is rather evident in the Respondent having actually used the disputed domain name in conjunction with its website through which it offered the Complainant's OAKLEY-branded products for sale, even though the Respondent knew it was not authorized by the Complainant to do so and had no legitimate relationship whatsoever with the Complainant. Obviously, the Respondent did so to divert sales from the Complainant and disrupt the Complainant's business and, by so doing, monetarily benefit from that exploitation to the detriment of the Complainant and the Complainant's authorized retailers.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(iii) and 4b(iv) thereof.

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

## **7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants

the relief sought by the Complainant.

The disputed domain name, <oakleyvenezuela.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: November 18, 2009