



NATIONAL
ARBITRATION
FORUM

START-UP TRADEMARK OPPOSITION POLICY

DECISION

The Paris Pages v. Wooho T&C Ltd. d/b/a/ RGNAMES.COM and Youngmi Park
Claim Number: FA0204000110763

PARTIES

Complainant is **The Paris Pages**, San Diego, CA, USA (“Complainant”) represented by **Norman H. Barth**. Respondents are **Wooho T&C Ltd. d/b/a/ RGNAMES.COM**, Seoul, SOUTH KOREA and **Youngmi Park**, Beijing, CHINA (“Respondents”).

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**paris.biz**>, registered with **Wooho T&C Co. d/b/a RGNAMES**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his 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 Start-up Trademark Opposition Policy (“STOP” or “Policy”) available at <http://www.neulevel.biz/ardp/docs/stop.html>, which was adopted by NeuLevel, Inc. (“NeuLevel”), as the Registry Operator, and approved by Internet Corporation for Assigned Names and Numbers (ICANN) on May 11, 2001, and revised by NeuLevel on September 19, 2001; and in accordance with the Rules for STOP as adopted by NeuLevel and also approved by ICANN on May 11, 2001 (“STOP Rules”) and as supplemented by the National Arbitration Forum Start-up Trademark Opposition Policy for .BIZ “STOP” Supplemental Rules then in effect (“STOP Supplemental Rules”).

The Complainant has standing to file a STOP Complaint, as it timely filed the required Intellectual Property (IP) Claim Form with NeuLevel. As an IP Claimant, the

Complainant timely noted its intent to file a STOP Complaint against Respondent Wohoo T & C Ltd. with NeuLevel and with the National Arbitration Forum (the "Forum").

The Complainant submitted its Complaint to the Forum electronically on April 21, 2002; the Forum received a hard copy of the Complaint on April 26, 2002.

On May 15, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of June 4, 2002 by which Respondent Wohoo T & C Ltd could file a Response to the Complaint, was transmitted to that Respondent in compliance with paragraph 2(a) of the Rules for the Start-up Trademark Opposition Policy (the "STOP Rules").

A timely Response was received and determined to be complete on June 3, 2002.

The Complainant's additional submissions were received on June 6, 2002. The Respondents' additional submissions were received June 8, 2002.

On June 24, 2002, pursuant to STOP Rule 6(b), the Forum appointed Mr. Peter L. Michaelson, Esq. as the single Panelist.

Due to existence of extraordinary circumstances, the Panel extended the due date of the decision one week from July 8, 2002 to July 15, 2002.

RELIEF SOUGHT

The Complainant requests that the domain name be transferred from Respondent Wohoo T & C Ltd. to the Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Identicality

The Complainant contends that the disputed domain name <**PARIS.BIZ**> is identical to the term "PARIS" in which it claims common law trademark rights.

Specifically, the Complainant states that it has been using the domain name <PARIS.ORG> since May of 1995. As evidenced by the front page of its web site accessible through the <PARIS.ORG> domain name, the Complainant contends that it is using the term "PARIS" in conjunction with the services of: promoting business and tourism in the area of Paris, France and, more generally, France in an electronic site accessible through a global computer network; and providing information, news, and research articles via an online web site and global computer information network on a wide range of business, cultural and educational issues related to Paris, France. The Complainant contends that, by virtue of its continuous use of the term "PARIS" via its

<PARIS.ORG> website since May of 1995, the Complainant has acquired common law trademark rights in that term in at least the United States of America.

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 Registrar has no rights or legitimate interests in the disputed domain name.

Specifically, the Complainant states that Respondent RGNAMES is an ICANN Accredited Registrar (as indicated on icann.org/registrars/accredited-list.html). This Respondent is properly known as Wooho T & C Ltd., d/b/a/ RGNAMES.COM, Korea.

In that regard, the Complainant contends that this Respondent, being a Registrar of domain names, is not the owner or beneficiary of a trade or service mark identical to the term "PARIS", this Respondent does not have use of or made any demonstrable preparations to use the term "PARIS" in connection with a bona fide offering of goods or services, and that this Respondent has not been commonly known by the term "PARIS". Further, the Complainant contends that as an official ICANN Accredited Registrar, this Respondent is in the business to register domain names, not in the business of using domain names, including domain names incorporating the term "PARIS". Hence, the Complainant believes that "[t]he only interest Respondent may have in the domain name PARIS.BIZ is to sell it for profit", which does not reflect a legitimate interest in that name.

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

3. Bad faith use or registration

The Complainant contends that the Respondent Registrar's conduct evidences bad faith registration of the disputed domain name.

In particular, the Complainant contends that as a domain name Registrar, RGNAMES has registered the disputed domain name <PARIS.BIZ> for the sole purpose of selling this domain name to interested parties either in competition with the Complainant, or to the Complainant himself for valuable consideration in excess of that Respondent's documented out-of-pocket costs directly related to the domain name, and, given that the Complainant is in the business of selling domain names, it will likely do so here at a profit.

Thus, the Complainant concludes that this Respondent has registered the disputed domain name in bad faith contrary to paragraph 4(a)(iii) of the Policy.

B. Respondents

1. Identicality

The crux of the Mr. Youngmi Park's (which this Panel has now joined to this action as an additional respondent -- henceforth referred to as "Respondent Park") argument, as best understood by the Panel, is that the Complainant has no trademark rights at all in the term "PARIS" inasmuch as that term is primarily geographically descriptive and as such can not be accorded common law trademark rights.

Specifically, Respondent Park takes the position that the term "PARIS" is a regional, i.e. geographic, word and, as such, may be "used by everybody without any restrictions on the Internet", i.e. it is "open to the public".

Hence, in the absence of having trademark rights, the Respondent Park appears to argue that the Complaint must fail.

2. Rights and legitimate interests

Respondent Park states that it has rights and legitimate interests in the disputed domain name.

Specifically, he states that he "won the word, Paris.Biz by the most fair method in the world of many people who want or need the word Paris.Biz. And as above the word, Paris is open to the public and general on the Internet".

3. Bad faith use or registration

First, as to bad faith registration, Respondent Park states that he never registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the word, "PARIS", to the Complainant or to a competitor of the Complainant.

Second, Respondent Registrar denies the Complainant's assertion that it, being a Registrar, is a reseller of domain names. With respect to the present dispute, Respondent Park specifically states that on February 5, 2001 he entered into a contractual agreement with the Registrar (a copy of that agreement in English translation is submitted with the Response) through which the Registrar agreed to manage the disputed domain name on behalf of Mr. Park with exception of ownership and use of the name. Respondent Park states that on March 13, 2002, he moved to Beijing, China for business reasons (and provided a copy of salient pages of his Chinese visa in the Response).

Hence, Respondent Park asserts that the Respondent Registrar is just temporarily holding the disputed domain name simply on his behalf, particularly since this name is the subject of pending IP Claims.

Respondent Park states that the Registrar, Wooho T & C Ltd d/b/a RGnames.com, uses @wooho.net or @rgnames.com for its e-mail addresses as seen in the RGnames.com site. However, as best understood by the Panel, Respondent Park apparently states that his registrant, administrative and technical contact e-mail address is cbg567@yahoo.com and not @wooho.net or @rgnames.com.

Furthermore, Respondent Park states that he is willing to use the disputed domain name for sales and leasing of real estate, hence in a different field than the Complainant's business.

In addition, Respondent Park states "[a]nyone doesn't confuse Paris.Biz (for Business) with Paris.Org (for Organization)." Hence, he concludes that "[t]here is no creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site." However, Respondent Park states that inasmuch as the disputed domain name is presently "locked", he is unable to use it at the moment.

Thus, Respondent Park concludes that he has neither registered nor used the disputed domain name in bad faith.

C. Additional Submissions

Since the additional submissions from both the Complainant and the Respondents were timely received by the Forum, along with the appropriate payment, the Panel has fully considered each of these submissions.

1. Complainant's Additional Submission

The Complainant essentially takes the position, contrary to Respondent Park's view, that the Registrar, RGNames, by virtue of being listed as the registrant in the corresponding WHOIS record for the disputed name, is the owner of record of that name and hence was correctly named as a Respondent (at that time being the sole Respondent).

Furthermore, the Complainant states that the WHOIS record was created on March 27, 2002 which is more than six weeks after the date of the contract between the Registrar and Respondent Park. Given this, the registrant submitted knowingly false registration information in the WHOIS record which is further evidence of either fraudulent and/or bad faith registration.

2. Respondents' Additional Submission

Respondent Registrar readily acknowledges that the WHOIS record names the wrong party as the registrant. The Registrar acknowledges that it registered the disputed domain name on behalf of Respondent Park but entered, by mistake, its name rather than that of Mr. Park as the registrant. In that regard, the Registrar stated that while the registrant name is incorrect, the address listed in the record is that of Mr. Park and not of the Registrar.

Further, the Registrar stated that it has tried on several occasions to correct the WHOIS record to properly reflect Mr. Park as the registrant, but has been unable to effectuate the necessary change. In that regard, the Registrar stated that Registry Operator, NeuLevel, will not correct the registrant name without an appropriate order to do so from the Forum.

Lastly, the Registrar contends that a city name, such as "PARIS", is not susceptible to registration as a trademark.

FINDINGS

A. The Complainant's mark

The term "PARIS" has not been registered by the Complainant as a trademark or service mark in any jurisdiction. Hence, to the extent this term conveys any exclusivity as a trademark or service mark, the extent of those rights, if any and in those jurisdictions (such as the United States) that recognize unregistered marks, must be determined under common law.

B. The Complainant's and the Respondents' activities

The Complainant has been using the domain name PARIS.ORG since May 1995. Through its web site resolvable through this name, the Complainant has been using the term "PARIS" since May 1995 through its web site for promoting business and tourism in the area of Paris, France and, more generally, France; and providing information, news, and research articles on a wide range of business, cultural and educational issues related to Paris, France.

On February 6, 2002, Respondent Park, then due to his impending relocation to Beijing, China, entered into an agreement with the Registrar for the latter to register and manage the disputed domain name for the former.

Subsequently, on March 27, 2002, the Registrar registered the disputed domain name <paris.biz>. A copy of the WHOIS registration record for this name has been provided to the Panel by the Forum. Though this record lists the Registrar as the registrant, rather

than Respondent Park, this Panel finds that this error is inadvertent and persists despite reasonable efforts by the Registrar to correct the record.

On April 21, 2002, the Complainant timely filed its STOP Complaint (ticket number HU73092117, challenge priority 1 with the Forum to challenge the registration of the disputed domain name, and to which a Response has been timely filed.

Since the date the name has been registered, Respondent Park has not used the disputed domain name, though he expressed plans on using that name in connection with a real estate business.

DISCUSSION

Paragraph 15(a) of the STOP 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 STOP Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be transferred:

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

Substantial commonality exists between the ICANN policies governing both the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and STOP proceedings. While numerous STOP decisions having been rendered to date, a far larger corpus of several thousand UDRP decisions currently exists and which provides very useful guidance for many of the same issues that arise under STOP. Hence, the Panel, where appropriate and pursuant to paragraph 15(a) of the STOP Rules, will exercise its discretion and rely on relevant UDRP decisions as applicable precedent here.

Ownership and compulsory joinder

The Panel is persuaded by the agreement provided by Mr. Park and existing between him and the Registrar -- which the Complainant does not dispute, that, in spite of the Registrar's name being listed as the registrant in the WHOIS record for the disputed domain name, Mr. Park and not the Registrar is the true owner of the domain name. Hence, the Panel, as indicated below, now orders the Registry Operator, to the extent such an order is needed, to either correct the WHOIS record for this name or permit the Registrar to appropriately correct that record.

Without full and proper jurisdiction over the domain name owner, the Panel is without authority to act. Though the Complaint was solely filed against Respondent Registrar, the Panel, to exercise complete jurisdiction over this dispute and to expeditiously resolve it and in accordance with its general powers under paragraphs 10(a)-(c) of the Rules, now joins Mr. Youngmi Park, being the true owner of the disputed domain name, as a compulsory Respondent. Doing so is consistent with paragraph 2 of the Response through which Mr. Park listed himself and his address as the Respondent's contact details, hence implicitly requesting and consenting to such joinder.

Identity/Complainant's rights in its mark

Under the STOP proceedings, a STOP Complaint may only be filed when the domain name in dispute is identical to a trademark or service mark for which a Complainant has registered an Intellectual Property (IP) claim form. Therefore, every STOP proceeding necessarily involves a disputed domain name that is identical to a trademark or service mark in which a complainant asserts rights. The existence of the “.biz” generic top-level domain (gTLD) in the disputed domain name is not a factor for purposes of determining that a disputed domain name is not identical to the mark in which the complainant asserts rights.

Numerous Panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.* FA 95560 (Nat. Arb. Forum, November 2, 2000) held: “ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required. Unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy”. See, e.g., *Frampton v. Frampton Enterprises, Inc.* D2002-0141 (WIPO April 17, 2002); *America Online, Inc. v. Deep d/b/a Buddy USA Inc.* FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.* FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Larson* FA 95746 (Nat. Arb. Forum November 15, 2000); *CMG Worldwide Inc. v. Page* FA 95641 (Nat. Arb. Forum, November 8, 2000); *Home Properties v. SMSOnline* FA 95639 (Nat. Arb. Forum November 2, 2000); and *Bridal Rings Company v. Yemenian* FA 95608 (Nat. Arb. Forum October 26, 2000). Furthermore, the Panel in *United States Postal Service v. Consumer Info. Org.* FA 95757, (Nat. Arb. Forum, November 27, 2000) held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE* AF-0536 (eResolution, December 11, 2000), the Panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton* FA 95970 (Nat. Arb. Forum December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum November 30, 2000). Similarly, see *American Home Products Corp. v.*

Healthy Futures D2000-0454 (WIPO August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.* D2000-0229 (WIPO May 10, 2000); *SeekAmerica Networks, Inc. v. Masood* D2000-0131 (WIPO April 13, 2000); and *Bennett Coleman & Co. v. Lalwani*; and *Bennett Coleman & Co. v. Long Distance Telephone Company*, D2000-0014 and 2000-0015, (WIPO March 11, 2000).

However, not all unregistered terms qualify for common law trademark protection.

Though common law marks are sufficient to trigger the Policy, nevertheless for a unregistered term to acquire common law trademark status, that term, as used in commerce by its owner, must have acquired, through its use, an appropriate level of distinctiveness such that the term has acquired sufficient secondary meaning in the mind of the relevant consuming public. Geographically descriptive terms are rarely, if ever, able to acquire secondary meaning sufficient to overcome their public recognition as a common name of a place or region. In that regard, the Panel in *City of Dearborn v. Mekled d/b/a ID Solutions* FA 99602 (Nat. Arb. Forum November 12, 2001) in assessing, in the context of the UDRP, whether the term “cityofdearborn” has any common law trademark significance to implicate that policy, quoted from *Glenwood Springs Chamber Resort Ass’n, Inc. v. College Transportation Inc.* FA 98825 (Nat. Arb. Forum Oct. 31, 2001):

“Moreover, we are persuaded by the reasoning of the Panel in *Brisbane City Council v. Warren Boulton Consulting PTY LTD*, D2001-0047 (WIPO May 7, 2001) and the Panel in *City of Salinas v. Baughn*, FA 97076 (Nat. Arb. Forum June 4, 2001), with respect to the limited applicability of the Policy to geographically descriptive marks. As the learned Panels noted in both *City of Salinas* and *Brisbane City*, the Interim Report of the Second WIPO Internet Domain Name Process (the “Interim Report”), issued on April 12, 2001, contained a detailed discussion pertaining to “Geographical Indications, Indications of Source and other Geographical Terms” and suggest that such names of geographical places are not within the Policy. While this discussion is not determinative of our decision here, it does inform our basic belief that the names of geographical locations, such as the City of Salinas, have a limited capacity to perform the function of a trademark as required by the Policy. See, e.g., Interim Report at paragraph 277 (stating that “the protection of place names within the gTLDs is a novel concept”); see also, Interim Report at paragraph 282 (stating that to provide such protection, it would be necessary to revise the Policy by way of ‘the incorporation into it of an additional cause of action’). See *Brisbane City of Salinas*, supra. As further noted in *Brisbane City Council v. Warren Bottom Consulting Pty Ltd.*, No. D2001-0047 (WIPO May 7, 2001), ‘The assumption which underlies this discussion in the Interim Report appears to be that, as a general rule, place names per se are not trademarks for the purposes of the Uniform Policy.’”

As to the present case, it is indisputable that the term “PARIS”, which forms the second level domain of the disputed domain name, is the name of an extremely well-known city in France. It is absolutely inconceivable that anyone, at first instance, hearing this term would think of anything other than that particular city. Accordingly, not only does this term not have any common law significance as a trademark, it strains reason to even contemplate that this term could ever obtain such significance.

Therefore, in the absence of the Complainant having any valid trademark rights in term “PARIS”, the Complainant has failed to satisfy paragraph 4(a)(1) of the Policy.

Respondents' Rights or Legitimate Interests

The Panel's inquiry now turns under the Policy to assessing whether the Respondents have rights and legitimate interests in the disputed domain name. If the Respondents have such rights and legitimate interests, then, under paragraph 4(a)(ii) of the Policy, the Panel must dismiss the Complaint and permit no subsequent challenges, as against the Respondents, to the disputed domain name. Alternatively, if the Respondents do not possess any rights or legitimate interests, the Panel then also dismisses the Complaint but permits subsequent challenges to the name.

For purposes of assessing rights or legitimate interests, the Panel will ignore the Respondent Registrar as it clearly, by virtue of its role as a Registrar and not a user or owner of the disputed domain name, has no rights or legitimate interests of its own in that name -- nor could it ever acquire any. Hence, any determination of the existence of rights or legitimate interests must be solely assessed based on Respondent Park's own actions.

Paragraph 4(c) of the Policy provides a non-exhaustive list of criteria which, if any are present, demonstrates that a respondent has rights or legitimate interests in the contested domain name. These are:

- (i) The respondent is the owner or beneficiary of a trade or service mark that is identical to the domain name;
- (ii) Before any notice to the respondent of the dispute, its 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; or
- (iii) The respondent (as an individual, business, or other organization) has been commonly known by the domain name, even though it has acquired no trademark or service mark rights.

Respondent Park has offered no proof that his actions with respect to the disputed domain name satisfy any of the criteria under paragraph 4(c) of the Policy. In fact, in the Panel's mind, it is highly unlikely given his non-use of the name and his inability, like that of the Complainant, to ever possess valid common law trademark rights in the term “PARIS”, that he will ever acquire any rights or legitimate interests in the disputed domain name.

Consequently, this Panel concludes that the Respondents have no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

Registration or Use in Bad Faith

In view of the above findings, there is no need for the Panel to address the issue of whether the Respondents either registered or used the disputed domain name in bad faith.

DECISION

In accordance with paragraphs 10 of the Policy and 15 of the STOP Rules:

- (a) the relief sought by the Complainant is hereby **denied**; and
- (b) inasmuch as the Complainant does not have rights in the mark to which it is asserting, the Complaint is hereby **dismissed**.

Further, inasmuch as the Panel finds that the Respondents do not have rights or legitimate interests in the disputed domain name, the Panel orders that subsequent STOP challenges to this domain name, as against these Respondents, will be **permitted**.

Lastly, to the extent an order is needed, the Panel now orders the Registry Operator, NeuLevel, to either correct the WHOIS record for the disputed domain name to properly reflect Mr. Youngmi Park as the registrant of that name rather than the Registrar, Wooho T&C Ltd. d/b/a/ RGNAMES.COM, or to permit the Registrar itself to make the correction.

Peter L. Michaelson, Esq., Panelist
Dated: July 10, 2002