



Part of the Disputes.org/eResolution Consortium

Administrative Panel Decision

Under the ICANN Uniform Domain Name Dispute Resolution Policy

Complainant: The Pep Boys Manny, Moe and Jack of California

Respondent: E-Commerce Today, Ltd.

Case number: AF-0145

Contested Domain Name: pep-boys.com

Panel Members: Peter L. Michaelson, Esq.

1. Parties and Contested Domain Name

The complainant in this proceeding is THE PEP BOYS MANNY, MOE & JACK OF CALIFORNIA ('Pep Boys') of Philadelphia, Pennsylvania, USA.

The respondent is E-COMMERCE TODAY, LTD. ('E-Commerce') of Norton, Virginia, USA.

The domain name at issue is 'pep-boys.com', registered by the respondent with Network Solutions, Inc. ('NSI'), of Herndon, Virginia, USA.

The complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ('ICANN Policy'), available at http://www.eresolution.ca/services/dnd/p_r/icannpolicy.htm, which was adopted by the Internet Corporation for Assigned Names and Numbers on October 24, 1999. Pursuant to paragraph 4(d) of the ICANN Policy, Pep Boys selected the Disputes.org/eResolution Consortium as the ICANN-approved administrative dispute resolution service provider to administer this proceeding.

Pursuant to NSI's former policy concerning contested domain names, NSI has placed the domain name in question in a 'hold' state in which presumably the domain name remains to this date.

2. Procedural History

On March 9, 2000, Pep Boys filed its complaint electronically with e.Resolution through the e.Resolution web site. The hard copy of the complaint was received by e.Resolution on March 13, 2000.

To this day, E-commerce has not filed any formal response to the Complaint.

Given that neither party had requested a three-member panel, eResolution selected the undersigned, Peter L. Michaelson, from the Disputes.org/eResolution Consortium list of arbitrators to serve as the sole panelist (arbitrator) in this proceeding. On April 19, 2000, eResolution notified the parties of the panel appointment and that barring exceptional circumstances a decision would be handed down by May 4, 2000.

3. Factual Background

Inasmuch as the Respondent, E-Commerce, has failed to respond to the Complaint, all the facts alleged by the Complainant, Pep Boys, will be accepted as true. For convenience of the reader, the factual allegations, to the extent needed, from the Complaint are reproduced below.

The following marks are in question:

PEP BOYS PEPBOYS.COM The marks are used by the Complainant in connection with vehicle stores, parts, accessories and services; credit card services; information in the field of vehicle products, services, care and maintenance provided on-line and via the Internet; e-commerce; parts delivery; vehicle oils, lubricants, additives, and fluids; hand cleaners; batteries; vehicle appearance products and cleaners; key rings; money clips; pocket knives; tape measures; cigarette lighters; pens; playing cards; portfolios; pen and pencil sets; tote and duffle bags; umbrellas; backpacks; glasses, mugs, sports bottles and beverage coolers; beach towels; clothing and hats; toys;

footballs and golf balls; teddy bears; and sports exhibitions.

The Complainant has supplied copies of its US trademark registration certificates, as an annex to its complaint. The marks are, listed by mark, registration No. and issue date (hereinafter the 'PEP BOYS' family of marks):

THE PEP BOYS Manny, Moe & Jack 310,199

February 13, 1934

PEP BOYS (block letter) 1,288,346 July 31, 1984

PEP BOYS (block letter) 1,472,747 January 19, 1988

PEP BOYS (block letter) 1,562,598 October 24, 1989

PEP BOYS & Design 1,699,427 July 7, 1992

PEP BOYS & Design 1,883,212 March 14, 1995

1-800-PEPBOYS 1,997,613 August 27, 1996

PEP BOYS & Design 2,026,793 December 31, 1996

PEP BOYS (block letter) 2,036,750

February 11, 1997

PEP BOYS EXPRESS (block letter) 2,226,116

February 23, 1999

PEP BOYS EXPRESS (stylized) 2,228,755

March 2, 1999.

The domain name in question is identical to the Complainant's PEP BOYS name and mark, the mark having become incontestable under section 15 of the the Lanham Act 15 USC § 1065. The domain name is also virtually identical to Complainant's domain name, PEPBOYS.COM, which Complainant previously registered with NSI over seven years ago. A copy of that domain name registration from the WHOIS database is annexed (www.networksolutions.com/cgi-bin/whois/whois/?STRING=pepboys.com). The only difference between the domain name in question and that owned by the Complainant is the interposition of a hyphen between the words 'PEP' and 'BOYS' in the former.

4. Parties' Contentions

The Complainant contends that:

(a) the domain name in question is identical to its registered trademarks;

(b) any rights E-Commerce has in the domain name in contention are illegitimate; and

(c) E-Commerce has registered this domain name in bad faith.

A. Similarity

As to similarity to its registered trademarks, the Complainant has provided copies, as noted above, of various ones of its US trademark registrations, along with appropriate title reports indicating title, to the marks closest to the domain name in question, currently exists in the Complainant.

B. Illegitimacy

The Complainant has been known by, and has been using, the name and mark PEP BOYS for over 70 years. Pep Boys is a "Fortune 500" company, traded on the New York Stock Exchange. It is a leading automotive after-market retail and service chain in the U.S., with billions of dollars of sales, annually, under its 'PEP BOYS' mark. Over the years, Pep Boys has spent millions of dollars in advertising and promoting its 'PEP BOYS' mark, in national network and cable television advertising (including programs such as the baseball World Series and NFL and NCAA football), radio, and major city newspapers. Pep Boys also has sponsored major events, such as the PEP BOYS INDY RACING LEAGUE. As a result, and due to the endearing nature of the caricatures of its founders, "Manny, Moe & Jack", the PEP BOYS mark has become famous.

Many of the federal registrations noted above are now incontestable under the Lanham Act. Based on those registrations, Pep Boys has exclusive rights to use the marks in the PEP BOYS family of marks, specifically including the 'PEP BOYS' mark, throughout the United States in connection with the goods and services listed in those registrations. Moreover, the 'PEP BOYS' mark (and all of the marks in the 'PEP BOYS' family of marks) is highly distinctive, and is not descriptive of any goods or services with which the mark is registered.

When Pep Boys first learned of Respondent's registration of the PEP-BOYS.COM domain name, there was no active web site which could be accessed by that URL. Pep Boys promptly sent a letter to the Respondent, advising it of Pep Boys' incontestable rights in Pep Boys' federally registered 'PEP BOYS' mark. Through its response, Respondent provided no basis whatsoever for any claim of legitimate rights or interest in the PEP BOYS name, and made no claim of use of the mark in connection with any identified goods or services. When Pep Boys invoked the then existing domain name dispute policy of Network Solutions, Inc. ("NSI"),

Respondent did not even respond. See NSI's May 28, 1999 notice placing the domain name on "hold" status, a copy of which is annexed.

Hence, the Complainant concludes that in light of the fame of Complainant's PEP BOYS name and mark and the incontestable trademark rights Pep Boys enjoys therein, Respondent could not claim any legitimate interests in the contested domain name, comprised solely of the PEP BOYS mark (plus the top level domain '.com').

C. Bad Faith

The distinctiveness, fame and public recognition of, and goodwill in, the PEP BOYS name and mark is a basis, in and of itself, to infer Respondent's bad faith; that is, that Respondent registered the mark as a domain name primarily for the purpose either of renting or selling it; to interfere with Pep Boys' business and thereby cause Pep Boys to pay Respondent to relinquish the domain name; and/or to attract Internet users to a web site or on-line location for commercial gain, by relying on their mistaken impression that the domain name relates to Pep Boys.

According to the WHOIS database of NSI, Respondent has registered numerous domain names. Included among these are many which incorporate the famous names, or trademarks, of others. For example, there are several using the names of famous baseball players Mark McGwire and Sammy Sosa: (SOSABASEBALL.COM; MCGWIREATHLETICS.COM; MCGWIRECOLLECTOR.COM; SOSACOLLECTOR.COM; MCGWIREBASEBALL.COM; SOSATSHIRTS.COM; MCGWIRECOLLECTIBLES.COM; MCGWIREMEMORABILIA.COM; SOSATRADING.COM; SOSACOLLECTIBLES.COM; SOSAMEMORABILIA.COM; MCGWIREBASEBALL.COM; SOSATRADER.COM; SOSASPORTS.COM; MCGWIRETSHIRTS.COM; SOSAATHLETICS.COM; MCGWIRETRADER.COM; MCGWIRESPORTS.COM; MCGWIRETRADING.COM). Respondent also has registered the domain names SHIP-UPS.COM and SHIPFEDERAL EXPRESS.COM, as well as the registered trademarks of other parties. E.g., VISITDOLLYWOOD.COM; ARTURO-FUENTECIGARS.NET; ADVANCEAUTO-PARTS.COM; DUNHILLINTERNATIONAL.COM.

Finally, Respondent has solicited Pep Boys' representative to "tender to [Respondent's Chairman] an offer to purchase the domain name: PEP-BOYS.COM". At no time did Pep Boys raise with Respondent the possibility of Pep Boys' purchase of the domain name in question.

5. Discussion and Findings

In view of the lack of any response filed by E-Commerce, the arbitration has proceeded by way of default. Hence, in the absence of any refuting evidence, all the facts and allegations submitted by the Complainant, Pep Boys, are accepted as true.

Even apart from judging this proceeding through default of the Respondent, the panel makes the following specific findings:

A. Similarity

No doubt exists whatsoever that the domain name in question, while not absolutely identical to the Complainant's registered mark ('PEP BOYS'), is clearly sufficiently similar to it as to cause a likelihood of confusion to arise between the relevant consumers of the Complainant and those who view the domain name in question. Such confusion, should it occur, would undoubtedly cause consumers to think that a relationship of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship exists at all.

The difference between the domain name and the registered mark, being the imposition of a hyphen between the words 'PEP' and 'BOYS', is so de minimus that it is utterly inadequate to preclude any such confusion from occurring.

As such, sufficient similarity exists.

In fact, for the reasons set forth below with respect to Illegitimacy and Bad Faith, given the conduct of E-Commerce particularly as evidenced by its registrations of large numbers of domain names bearing very high degrees of similarity to other well known marks and names of contemporary notorious individuals as well as an offer to sell the domain name in question to the Complainant (see letter from Mr. J. Jack Kennedy, Chairman of E-Commerce, dated February 3, 2000 to Ms. Marsha G. Gentner, Esq., Atty for Complainant -- copy contained in Annex to Complaint), the panel concludes that:

(i) E-Commerce intentionally chose the domain name in question for its high and nearly identical degree of

similarity with the principal mark under which the Complainant undertakes its business, and

(ii) with the principal reason of causing consumer confusion to occur in order to injure the Complainant's business and reputation should the domain name become active in an attempt to induce the Complainant to purchase the domain name from the Respondent.

B. Illegitimacy

Based on the evidence submitted by the Complainant, the panel finds that, since the inception of the 'PEP BOYS' mark dating from 1925, this mark along with its progeny have garnered extensive recognition in the marketplace to the point where these marks currently have acquired considerable goodwill as a source and quality identifier of the goods and services, i.e. automotive and light truck aftermarket products and services, provided by the Complainant.

Though the Respondent in its February 3, 2000 letter to Ms. Gentner, Atty for Pep Boys, stated that it 'registered the domain name some several months ago with an intent to use it in a business venture unrelated to that of your client', the Respondent has provided absolutely no proof of such a venture and particularly no proof that, even if the Respondent were to use the mark as it suggests, that venture would neither illicitly trade upon the fame now inherent in the 'PEP BOYS' family of marks nor dilute the goodwill associated with any of the marks in this family.

Furthermore, the panel concludes that based on the evidence presented, the mark 'PEP BOYS' has attained status as a 'famous mark', under the provisions of 15 USC § 1125 (c)(1), given: the 70+ year duration during which the mark has been in active use; the highly distinctive nature of the mark; the extensive nature and extent of advertising undertaken during that period; the national nature of the market served through the mark; the recognition which the mark has achieved throughout the US as a source/quality indicator of the Complainant's business, as compared to no recognition whatsoever for the domain name in question with the Complainant's business.

Hence, the panel is unpersuaded that E-Commerce has any legitimate rights in the domain name in question.

C. Bad Faith

Given the Respondent's repetitive conduct in registering a plethora of domain names, that included the names of contemporary individuals who possess far-reaching fame, coupled with an expressed intent, rather than legitimizing its use of the domain name in question, to sell that domain name to the Complainant when faced with enforcement action over that name, the panel concludes that the Respondent's actions in registering the present domain name amount to nothing less than an attempt to register and hold the present name 'hostage' in pursuit of a sufficiently large ransom from its rightful user. Such actions clearly evince bad faith in violation of the Anti-Cybersquatting provisions of the Lanham Act (15 USC § 1125(d)(1) with 'bad faith' being defined in 15 USC § 1125(d)(1)(B)(i)).

6. Award

Accordingly, the relief sought by the Complainant is granted. The domain name is ordered transferred to the Complainant.

May 3, 2000

Peter L. Michaelson, Arbitrator
Red Bank, New Jersey USA