



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Pernod Ricard v. Tucows.com Co

Case No. D2008-0789

1. The Parties

The Complainant is Pernod Ricard, Paris Cedex, France, represented by Cabinet Dreyfus & Associés, France.

The Respondent is Tucows.com Co, Toronto, Ontario, Canada, represented by Adorno Yoss, United States of America.

2. The Domain Name and Registrar

The disputed domain name <ricard.com> is registered with Tucows, Inc. (the "Registrar").

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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 Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on May 20, 2008, and in hard copy form on May 29, 2008, with accompanying Annexes 1-25.

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 three-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 May 20, 2008, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to the name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the name, (c) the language of the registration agreement, and (d) whether the name will remain “locked” during the proceeding.

Subsequently, on May 21, 2008, 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. Specifically, it stated that the Respondent, Tu cows.com Co. (also the Registrar) was listed as the registrant for the name. The response also indicated that: (a) the Registrar had not received a copy of the Complaint from the Complainant, (b) the Policy applies to the name, (c) Tu cows Inc. is the registrar, (d) the Registrant submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (e) the registration agreement is in English and (f) the 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 May 30, 2008, 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 post or courier, but without its annexes by facsimile and email¹. 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 May 30, 2008, 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 June 19, 2008, to file its Response with the Center and the Complainant.

The Response was timely filed on June 19, 2008, with the Center and was acknowledged by the Center through an email letter dated June 20, 2008.

Subsequently, on June 26, 2008, the Complainant filed its first Additional Submission

¹ A link to electronic copies of the Complaint annexes, provided by the Complainant’s counsel with the filed Complaint, was included in the Center’s notification email of May 30, 2008.

(Supplemental Filing) with the Center, which the Center acknowledged in an email letter dated the same day. The Panel, acting in its sole discretion and as noted below, has decided not to consider this submission. Nevertheless, the second paragraph of this submission raised a challenge to Panelist Smith's appointment² and which was addressed by the Center.

Specifically, the Complainant contended that, inasmuch as Panelist Smith worked several years ago "at a law firm in charge of IP-related issues linked to the trade mark MONTANA owned by the Complainant", he does not appear to be fully independent of the parties here. The Respondent did not join in this challenge.

In response to an inquiry from the Center, Panelist Smith informed the Center that he did not recall ever having acted for or against any owner or licensee of the New Zealand trademark MONTANA. In response to a request from the Center for further information, the Complainant's counsel stated, through an email dated July 4, 2008, that the basis of its challenge was that: (a) from 1989 to 1999 Panelist Smith was a partner in a New Zealand law firm, and (b) that firm now acts as counsel for the Complainant with respect to its interest in the New Zealand wine label MONTANA. However, the Complainant's counsel was unable to provide any evidence to the Center which demonstrated that Panelist Smith ever worked on any matter involving MONTANA while he was with that firm.

On July 14, 2008, the Center appointed Peter L. Michaelson as Presiding Panelist, and Ms. Brigitte Joppich and Mr. Warwick Smith as co-panelists in this matter. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules.

Subsequently, the Center, on the basis of the information it received regarding the challenge to Panelist Smith's appointment, concluded that no instance existed which could call either his independence or impartiality into question and, as such, confirmed his appointment to this Panel.

Shortly thereafter, on July 23, 2008, the Respondent filed its sole Additional Submission (Supplemental Filing) with the Center, which on July 24, 2008 the Center, in turn, acknowledged by email letter.

On July 31, 2008, the Complainant filed, by both email and facsimile, its second Additional Submission which the Center acknowledged in an email letter dated August 1, 2008.

The Panel, again acting in its sole discretion, has also chosen not to consider either the Respondent's sole Additional Submission or the Complainant's second Additional Submission.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before July 28, 2008. Owing to unexpected timing issues experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, subsequently extended this due date.

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

² Panelist Smith being one of the Respondent's three preferred candidates to serve as one of the Panelists, as submitted by the Respondent in accordance with paragraph 6(d) of the Rules.

The language of this proceeding is English.

4. Factual Background

A. The Disputed Domain Name

As indicated in the WhoIs registration record provided in Annex 1 to the Complaint, the disputed domain name was first registered on May 30, 1996. From the Response, it appears that: (a) the first registrant was Mailbank Inc., trading as NetIdentity, and (b) the Respondent registered the disputed domain name, and became the registrant, when it purchased the NetIdentity business (including an extensive portfolio of domain names) in June 2006.

B. The Complainant's RICARD Marks

The Complainant currently owns a considerable number of registered trademarks worldwide for the term RICARD. The marks encompass national, regional and international registrations and extend over 120 countries, including Canada, the European Union and the United States of America (subsequently referred to either as the "United States", or the "US"). The Complainant has provided, in Annex 7 to the Complaint, a worldwide listing of all its RICARD Marks, including both registered marks and pending applications, and in Annex 8, hard-copies of a small sample of its national registrations for this mark in Canada, US and France, and its international registrations. Pertinent details of two of its Canadian registrations are as follows:

1. RICARD (block letters)
Canadian registration: 279,587; registered July 5, 1968
filed: December 20, 1963; renewed to: July 5, 2013
goods: wines, aperitifs, alcohols, liquors and spirits (and others)
use of the mark, in Canada, claimed as having started in 1954
2. RICARD (stylized with logo)
Canadian registration: 456,338; registered: April 5, 1996
filed: September 26, 1984
goods: wines, anise-based aperitifs, anise-based spirits, anise-based drinks
use of the mark, in Canada, claimed as having started in 1954

C. The Complainant and its activities

The Complainant is a French-based corporation and one of the largest participants, by market share, in the global wine and spirits industry with a considerable international presence and distribution network on every continent. It has a large portfolio of well-known brands, some domestically within France and many others internationally, the latter including, e.g., the brands Ricard, Jameson, Chivas Regal, Havana Club, Malibu and, with its recent acquisition, Absolut.

Specifically, the Complainant is the world's second largest manufacturer of spirits with 78 million cases sold for 2006/2007 and fourth internationally for wines and champagnes with 24 million cases sold in 2006/2007. Approximately 90% of the Complainant's turnover occurs outside of France. In its industry, the Complainant ranks first in Europe and Asia-Pacific, and second in the Americas and particularly second in Canada and fifth in the United States. (see a copy of a press release provided

by the Complainant in Annex 3 to the Complaint).

With 17,680 employees in more than 70 countries, the Complainant's Pernod Ricard group recorded sales of 6,443 million Euros in the 2006/2007 financial year (see an extract of the Complainant's 2006/2007 annual report also provided in Annex 3).

Ricard SA, a member organization of the Complainant, produces the Ricard pastis beverage, which is anise-flavored liqueur that turns cloudy-white when water is added. It is apparently made from a secret recipe containing a blend of Chinese star anise, licorice and aromatic herbs from Provence (see copies of various articles and pages from the Complainant's website in Annex 4 to the Complaint).

Ricard SA currently sells its Ricard beverage in approximately 100 countries including Canada, United States, France, Spain, Portugal, Germany, AIPO, the United Kingdom of Great Britain and Northern Island ("UK") and Belgium and has been doing so for more than 75 years. Since 1932 when this beverage was created, the Complainant has invested considerable money, time and effort to develop and promote its Ricard beverage worldwide. As a result, since 1932, Ricard SA has sold almost two billion bottles of that beverage in 120 countries (see Annex 4).

In 1975 Ricard SA merged with Pernod to become the Complainant, Pernod Ricard.

D. The Respondent and its activities

The Respondent, Tucows, a Pennsylvania corporation based in Ontario, Canada, is an ICANN-accredited registrar (and is the Registrar here). The Respondent earns most of its revenue from domain name registration services plus hosted email, spam and virus protection, Blogware, website building tools, the "Platypus Billing System" and digital certificates. Unlike many domain name registrars, the Respondent primarily provides its services on a wholesale basis to third-parties for resale to the public. Currently, the Respondent serves over 6,000 third-party resellers, specifically Internet access and hosting providers.

On June 15, 2006, the Respondent acquired Mailbank, Inc. (also now known as "NetIdentity"). Since 1996, NetIdentity had provided personalized email, blogging, and web hosting services through a collection of personal surname addresses.

Prior to June 2006, Mailbank had acquired thousands of surname domain names, such as "smith.net" and "schafer.org", and used those names to sell vanity email and other Internet services ultimately to those in the public who want to use their surname as a second level email domain. For example, through its vanity email service, a name like "smith.net" can support email users, such as both "bill@smith.net" and "sue@smith.net," so long as each individual composite email address is unique. Various NetIdentity customers had also purchased website hosting services where some of those customers were given third-level domain names, for use as web site addresses, corresponding to their own first and surnames, such as "bill.smith.net" or "jennifer.smith.net", at which each customer could post his (her) own site.

The Respondent claims that an important aspect of the NetIdentity surname address collection was and is its substantial breadth. Prior to the acquisition by the Respondent, Mailbank compared all the domain names in its portfolio with relevant US census data and determined that it then held surname-type domain name registrations, in one top-level domain or another, for over 70% of the surnames listed in the census data, in the form "surname.gTLD" (henceforth called a "surname-type" domain name). The

Respondent continues to expand the NetIdentity service through the acquisition of additional surname-type domain names. For each of its different surname-type domain names, the Respondent has multiple customers with each having a unique email address and website but all sharing the same domain name. The Respondent, through its reseller network, offers all the NetIdentity surname-type domain names to the public.

The Respondent says that, prior to its having been contacted by the Complainant, it had no knowledge either of the Complainant or its trademark rights in the term RICARD. The Respondent has provided a declaration from Mr. Bill Sweetman (a copy of which appears in Annex F to the Complaint), the Respondent's General Manager, Domain Names Portfolio, in which Mr. Sweetman declared: "Prior to my contact by counsel for Pernod Ricard, the complainant in this arbitration, neither I nor Tucows was unaware of any trade mark rights, by any complainant or anyone else, in the word 'Ricard'." (A declaration discussed by the Panel further below under paragraph 6.D).

The Respondent says that the disputed domain name was also registered in 1996, given what NetIdentity then believed to be its well-known significance as a surname, in conjunction with its vanity email service. Ever since the disputed domain name has continually been used with that service.

On October 11, 1997, the domain name <ricard.net> was also registered (see a copy of the WhoIS record in Annex 23 to the Complaint). The Respondent has not denied the Complainant's contention that the registrant was Mailbank Inc. (trading as NetIdentity).

The Respondent's website, to which the disputed domain name <ricard.com> resolves, contains a list of sponsored (pay-per-click) links to third-party websites advertising goods and/or services to Internet users and for which the Respondent earns click-through revenue each time an Internet user clicks on one of those links. Those links are apparently selected automatically through use of an "advertising algorithm" employed by Oversee.net, the entity engaged by the Respondent for that purpose. When the Respondent received the Complainant's cease and desist letter, the Respondent immediately changed the algorithm, at least as it applied to the particular home page to which the disputed name resolved, to eliminate links to any possible websites and advertisements that might infringe the Complainant's rights in its mark RICARD and consequently any such concerns that might otherwise arise. See Sweetman declaration.

E. Use of the disputed domain name; Interactions between the parties

The Complainant discovered that the disputed domain name directs Internet viewers to a web page displaying various pay-per-click (sponsored) commercial links, one being entitled "Alcoholic beverages", and others to various entities which manufactured anis flavored spirits that competed with Complainant's Ricard beverage. Another link on the page was associated with a vanity email service. (See a copy of a bailiff's report dated February 25, 2008 in Annex 10 to the Complaint, with an English-language translation thereof appearing in Annex 11.)

Consequently, on March 10, 2008, the Complainant sent, by email and registered postal mail, a cease-and-desist letter (a copy of which appears in Annex 12 to the Complaint) to the Respondent requesting the latter to transfer the disputed domain name to the Complainant. In its email response on March 11, 2008 (a copy of which appears in Annex 13 to the Complaint), the Respondent stated that "Ricard" is a common surname then used by over 2,880 people in the US and, as such, contested the fact that the disputed domain name could infringe the Complainant's trademark rights.

Subsequently, on March 26, 2008, the Complainant responded, also by email (see Annex 13), to the Respondent and reiterated its prior assertions and its request for transfer of the disputed domain name.

Later, through an email dated March 26, 2008, the Respondent replied back to the Complainant (see Annex 13) stating that the former had modified the links on the web (landing) page to which the disputed domain name then resolved such that the links, which previously generated “automatically generated ads”, were now just “generic advertising links”.

However, in spite of the Respondent’s stated modifications, as of at least March 28, 2008 (see a copy of a bailiff’s report, including its English-language translation, in Annex 14 to the Complaint), various links on the Respondent’s <ricard.com> landing page were still associated with websites for alcoholic beverages, including anise flavored beverages, such as El Massaya which is a traditionally distilled arak aniseed based spirit, competitive with the Ricard beverage produced by the Complainant.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to its RICARD Marks.

Specifically, the Complainant states that the name consists of its mark RICARD along with the addition of a “.com” gTLD (generic top level domain), with the latter being insufficient to distinguish the resulting name from the mark.

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

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and in particular 4(c) of the Policy.

First, the Complainant states that the Respondent is not affiliated with the Complainant in any way and the Complainant has not authorized the Respondent to either use and register any of its marks or register a domain name incorporating any such mark.

Second, the Complainant states that the Respondent has no trademark rights in the term RICARD. Moreover, the Respondent has never been known by that term nor does it run any commercial business under it.

Third, the Complainant alleges that the Respondent is not using the disputed domain name: (a) in connection with a *bona fide* offering of goods or services, or (b) in a legitimate non-commercial or fair use manner without an intent for commercial gain by misleadingly diverting consumers or tarnishing the Complainant’s marks.

In particular, the Complainant alleges that while vanity email services offered through a

domain name that includes another's mark may be legitimate, the name must solely be used for that purpose and nothing else. Inasmuch as the Respondent's website, accessed through the name, not only provides a link to a vanity email service, but also provides commercial links from which the Respondent derives click-through revenue, including to third-party websites offering products competitive with that offered by the Complainant, such use is illegitimate. This use occurred before the Complainant sent its cease-and-desist letter to the Respondent and continued thereafter. Although the Respondent claims that the advertisements associated with these links were automatically generated, the Complainant contends that the Respondent bears ultimate control and hence responsibility over those links.

(iii) Registered and Used in Bad Faith

The Complainant contends that 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 inasmuch as laches, as a defense, has no application under the Policy, the Respondent's registration date back in 1996 is of no consequence.

Second, the Complainant alleges, that given the world-wide notoriety which the Complainant's brand RICARD has attained since 1932, the Respondent knew or must have known of the Complainant when it registered the disputed domain name, particularly since the Respondent inserted links on its <ricard.com> website to the alcoholic beverage industry.

Third, approximately one year after the Respondent registered the disputed domain name, it registered the same mark-based name but with a different gTLD, there being ".net", i.e., <ricard.net>. Since registration of this additional name is not necessary for a vanity email service, the Respondent registered this name to further exploit the Complainant's mark by generating more traffic to its website and so increasing its revenue over that attainable through use of just the disputed domain name alone, thus further leveraging off the Complainant's reputation and hence evidencing bad faith.

Fourth, by virtue of incorporating the Complainant's mark into the disputed domain name, the Respondent is diverting Internet traffic which has been destined for the Complainant's website to the Respondent's site instead. Moreover, even apart from that diversion, the Respondent's website serves as a portal site which provides sponsored links, under the Respondent's control, to some of the Complainant's competitors. Some of those links divert Internet users to, e.g., El Massaya Lebanon which offers anise-based spirits directly competitive with the Complainant's RICARD-branded anise beverage while other such links divert such users to various independent wine merchants. (See the bailiff's report in Annex 14 to the Complaint).

As such, the Respondent, through its commercial activity surrounding the disputed domain name, is intentionally exploiting the goodwill in the Complainant's RICARD Marks by confusing Internet users for its own pecuniary gain, which constitutes bad faith.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent concedes that the disputed domain name is identical to the Complainant's mark RICARD.

However, the Respondent argues that the exclusivity that the Complainant has to its mark is limited to alcoholic beverages, an area in which the Respondent does not use the term RICARD. Over the past 12 years, the use of the term by NetIdentity and the Respondent has been in conjunction with its vanity email service.

(ii) Rights or Legitimate Interests

Contrary to the Complainant's position, the Respondent contends that it has rights and legitimate interests in the disputed domain name.

Specifically, the Respondent argues that its use of the term RICARD, particularly here as a surname-type domain name, is in conjunction with its primary and well-known meaning as a surname, hence legitimizing its use in conjunction with the Respondent's vanity email service. Such a use does not infringe the Complainant's rights in its mark RICARD.

(iii) Registered and Used in Bad Faith

Here too, the Respondent rebuts the Complainant's position by contending that it did not register and does not use the disputed domain name in bad faith.

First, the Respondent states that prior to its having been contacted by the Complainant, it had no knowledge of the Complainant or its trademark rights in the term RICARD. The Respondent registered the disputed domain name 12 years ago, simply for its well-known significance as a surname, in conjunction with its vanity email service and ever since has continually used the name with that service.

The advertising links placed on the Respondent's web site – clearly including those to which the Complainant has taken offense – are selected through an automated process which employs an advertising algorithm. When the Respondent received Complainant's cease and desist inquiry, the Respondent immediately changed the algorithm, with respect to that site, to eliminate any possible links to advertisements that might otherwise infringe the Complainant's rights in its mark RICARD.

C. Supplemental Filings

The Complainant and the Respondent each filed a first additional submission, with the Complainant also filing a second such submission.

In its first additional submission, the Complainant challenged Panelist Smith's appointment. That challenge, as noted above, was appropriately considered and resolved by the Center.

The Rules make no provision for additional submissions beyond a complaint and a response, consequently permitting a UDRP panel to determine, in each situation and in its sole discretion, whether it will admit and consider any such submissions, or not. The Panel, in light of its analysis of the merits as discussed below, has found each of the three additional submissions here to raise contentions that are either duplicative, of those raised in the corresponding Complaint or Response, or simply irrelevant. Hence, the Panel, acting in its sole discretion, has decided not to consider any of the parties' three additional submissions in rendering this decision.

6. Discussion and Findings

A. Registrar as Registrant

This case presents a threshold question as to whether a registrar who appears to have registered a domain name, either on its own account or through a subsidiary, can be a proper Respondent in a proceeding under the Policy. The first place for guidance in this respect is the Rules themselves, Paragraph 1 of which defines “Respondent” as the “holder of a domain-name registration against which a Complaint is initiated.” There would appear to be no reason in principle why this definition should not also catch a registrar, who in acting as a registrant on its own behalf, was in fact found to be the “holder” of a domain-name registration at the time a Complaint was initiated, and thereby subject to a Panel’s jurisdiction under the Policy as a proper Respondent. Though the Policy, Rules and Supplemental Rules make no specific mention of encompassing registrars within their reach, one need only look at the registrar’s role in any given situation. Where a registrar’s conduct with respect to a domain name expands beyond performing mere administrative duties in accepting and implementing name registration for another into registration and use by itself of the name, then its role changes from that of a mere registrar to that of an owner-user. This exposes the registrar to the full force and effect of the Policy by virtue of the registrar having become a “holder of a domain-name registration”. See, e.g., *DAVIS VISION, Inc. v. Demand Domains, Inc.*, NAF Case No. FA 1142731 (March 26, 2008) and *Paxar Americas, Inc. v. eNom, Inc.*, NAF Case No. FA 980114 (June 22, 2007). As was emphasized by the panel in the latter case:

“In such instances where a registrar becomes an owner-user, no deference whatsoever is attributed to a registrar’s coordinate role as being the actual registrar of the disputed name itself. The registrar faces the exact same scrutiny and liability under the Policy for its conduct as would any domain name registrant. If this were not the case, then domain name registrars could, with impunity under the Policy, register and use domain names in a manner that inflicts harm on legitimate rights holders. Such a result would lie directly contrary to the very goals of the Policy -- recognition and preference to the legitimate rights of trademark holders as against abusive domain name registration.”

There have also been instances in which certain UDRP panels have, in the broader interest of the UDRP and domain name registration system, found it appropriate to consider and refer to ICANN’s attention matters involving the proper role of ICANN-accredited registrars. One such matter might be the fundamental question of whether a registrar can validly make a contract with itself.³ See, e.g., *General Electric Company v. Marketing Total S.A.*, WIPO Case No. D2007-1834 (February 1, 2008).

In the present case, the *registrar* is “Tu cows, Inc”, whereas the *registrant* of record is given as “Tu cows.com Co”. Little may turn on such distinction in practice, particularly where (as here) the latter has been expressly acknowledged in the Response as a wholly owned subsidiary of the former. In any event, previous UDRP panels have recognized that the WHOIS-listed, registrar-confirmed registrant of record may be considered a proper Respondent even where a subsidiary of the concerned registrar. See, e.g., *Markel Corporation. v. Tu cows.com Co*, WIPO Case No. D2007-1750 (June 5, 2008). The fact that a domain name registrant is also a subsidiary of a registrar in no way exempts that registrant from liability as the domain name “holder” under the Policy;

³ Even where it may use a subsidiary or shell company for this purpose.

nor does it mean that the actions or knowledge of the registrar itself should be immune from scrutiny where factually relevant to the circumstances of registration and use of a domain name by its subsidiary. That is particularly so where (as here) the registrar has submitted a Response, under its own name, describing the circumstances of the disputed domain name's acquisition by its subsidiary.

In addition to consulting the Rules regarding the definition of proper Respondent, the Panel notes that the Supplemental Rules of the Center do not aim to regulate this question in more detail, and consequently impose no restriction on a panel's discretion in this area. By comparison, the Supplemental Rules currently in effect for the National Arbitration Forum (NAF) do attempt to define a "Holder of a Domain Name Registration" as "the single person or entity listed in the WHOIS registration information at the time of the filing of the Complaint with the Forum; and once the registrar has verified registration, is limited to the single person or entity as verified by the registrar". This is the respondent against whom a complaint is filed by a complainant. Consequently, under NAF Supplemental Rule 1(d), a respondent is the single person or entity identified in the WHOIS registration information as the registrant of the name in question and so verified by the registrar.

In conclusion, where the Respondent is (as here) for practical purposes simultaneously both a registrar and a registrant, the Panel sees no reason to divert from the holding in the above-referred cases and thus views the Respondent, for purposes of assessing its liability under the Policy, as normally accountable under its latter role.

B. Identical or Confusingly Similar

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

From a simple comparison of the disputed domain name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, identical to the Complainant's mark RICARD. The only difference between the name is the appending of the gTLD ".com" to the mark, with that difference being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

Therefore, the Panel finds that the disputed domain name <ricard.com> is, for all practical purposes, identical to the Complainant's RICARD Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of its RICARD Marks or any mark confusingly similar thereto in conjunction with the goods with which the Complainant uses and registered that mark or for similar goods; nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any commercial use to which the Respondent were to put any of the RICARD Marks or one confusingly similar thereto in connection with the identical

or even similar goods to those currently provided by the Complainant and as recited in its trademark registrations would violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 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); and *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *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. 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), and *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *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 Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000). Consequently, the Respondent could not legally acquire any public association between it and the mark RICARD or one similar thereto, at least for the goods rendered by the Complainant or listed in any of its trademark registration, or, broadly speaking, any good likely perceived by its users to be so similar and/or to emanate from or be related, in any fashion, to those then offered by the Complainant.

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 RICARD.

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

Moreover, as discussed below the Panel is persuaded by the facts of record that, in spite of what might have been intended to be statements to the contrary in the Sweetman declaration, Mailbank was likely aware of the mark back when it registered the name in 1996 and the Respondent was aware of the RICARD mark when it acquired Mailbank's business in 2006, or in any event should have been so aware. Hence, under the specific facts at issue here, the Respondent's use of the disputed domain name as an address not only of a vanity email service but also, to the same if not greater extent, of a website providing third-party sponsored links does not constitute a *bona fide* offering of goods and is unquestionably commercial in nature. Hence, the Respondent's conduct does not fall within paragraphs 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.

D. 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.

Given the widespread international notoriety which the Complainant and particularly its mark RICARD had attained even by 1996 when Mailbank, which was subsequently acquired by the Respondent, registered the disputed domain name, the Panel believes that the Respondent was indeed aware of the Complainant and its mark RICARD when it registered the name, or at minimum should have been so aware.

When the Respondent acquired the Mailbank business in June 2006, it had already had a close association with Mailbank for some years, including as a supplier of certain services. The Respondent became the registrant of the disputed domain name (and other domain names in the Mailbank portfolio) for purposes of the Policy as at this time of acquisition. See, e.g., *Ticketmaster Corporation v. Global Access Case*, WIPO Case No. D2007-1921 (February 13, 2008). Immediately prior to the purchase, it appears to have conducted a due diligence exercise, in the course of which it no doubt focused closely on what it was buying and made an appropriate assessment of likely future revenue streams the purchased assets would provide. It knew that it was not just acquiring a set of vanity email addresses: as the Respondent's CEO put it in a 2006 podcast, there was "a fair chunk of pay per click revenue in there as well" (Response, Annex D).

Even brief further enquiries by the Respondent at that point (whether by Internet search engine search on "Ricard", or by trade mark search in the United States or Canada) would have led the Respondent directly to the Complainant. On the evidence produced, the Panel concludes that the Respondent either made those enquiries (and proceeded with actual knowledge of the Complainant and its mark), or was "willfully blind" in failing to make them (in the sense discussed in cases such as *Mobile Communication Service Inc. v. WebReg*, WIPO Case No. D2005-1304 (February 24, 2006), *mVisible Technologies Inc. v. Navigation Catalyst Systems Inc.*, WIPO Case No. D2007-1141 (November 30, 2007), and *Grundfos A/S v. Texas International Properties*, WIPO Case No. D2007-1448 (December 14, 2007). Either way, the Respondent's subsequent use of the disputed domain name (specifically, the links on the Respondent's website to third party sites selling products of the Complainant's competitors) leaves little room for doubt that the disputed domain name was registered in substantial part with a view to profiting from any trade mark value there might be in the name.

The Panel also notes that the Respondent's denial of any knowledge of the Complainant, is rather less than what one might describe as compelling. At paragraph 9 of his declaration, Mr. Sweetman denied that he or the Respondent was *unaware* of any trade mark rights in "Ricard". The double negative may have been a mistake, but if it was, it is surprising (and unfortunate for the Respondent) that such a basic mistake was made in an area of the case as critical as whether the Respondent did or did not know of the Complainant when it acquired the disputed domain name. Moreover, Mr. Sweetman has not provided any basis for an assertion (if such was intended) that "*Tucows*" was unaware of any trade mark rights in "Ricard". Given the links on the Respondent's website to sites selling products of the Complainant's competitors (a factor frequently identified by UDRP panels as an indicator of a

respondent's bad faith), the situation clearly called for a substantial explanation from Mr. Sweetman, including details of *when* these links first appeared on the Respondent's website, and what enquiries he made of his senior colleagues within the Respondent organization, before declaring that *the Respondent* had no knowledge of any third party trade mark rights in "Ricard".

It is patently clear that the Respondent does not use the disputed domain name solely with a vanity email service. The domain name is the address of a web portal which displays a list of sponsored links to third-party websites and through which the Respondent receives revenue. The link to the NetIdentity website appears to be only one of numerous such links, and it is not a particularly prominent one. The Respondent's website appears to operate primarily as a landing page, providing access to the sponsored third party sites. Various ones of these links have been to websites offering products competitive with the Complainant's anise flavored beverage – though some of those links were removed by mid-March 2008, others were apparently not.

Those links, coupled with the Panel's finding that the Respondent was aware of the Complainant and its mark when the disputed domain name was registered, point inevitably to the conclusion that the Respondent appreciated that some Internet users looking for sites associated with the Complainant would mistakenly come to the Respondent's website. Since the Respondent appreciated that, it is but a short step to conclude that the Respondent must have intended that such mistakes would occur, and was to that extent seeking to profit from the trademark value of the word "Ricard".

In essence, the Respondent used the name to divert Internet users intent on reaching the Complainant's website to the Respondent's website and through which those users would encounter sponsored links, certainly unrelated to the Complainant's goods, which, when clicked on by any such user, would yield click-through revenue to the Respondent. While the Respondent argues that its links were automatically generated through an "advertising algorithm" thus absolving it of liability, its argument is misplaced. The Respondent, having constructed the page – through whatever vehicle it chose – bears full responsibility over what links are selected and displayed on that page, and their ultimate effect.

Hence, when the facts of record are assessed in their entirety, the Panel finds that the Respondent registered the disputed domain name to exploit its potential to generate user confusion with the Complainant's RICARD Marks for the Respondent's eventual financial benefit. See, e.g., *Dreamworks*, *MySpace* and *F. Hoffmann-La Roche AG*, all cited *supra*.

The Respondent relied on the recent panel decision in *Ancien Restaurant Chartier v. Tucows.com Inc.*, WIPO Case No. D2008-0272 (May 6, 2008) in support of an argument that its vanity email services constitute a legitimate business activity. But that case was very different from the present one. Specifically and in contrast to the present situation, in *Ancien Restaurant Chartier* there were no links on the relevant website to sites offering products in competition with those of the complainant, and the complainant did not establish that it had any presence in Canada or the United States of America. On the facts of that case, the panel found no reason to reject the respondent's assertion that it had no knowledge of the complainant or its mark. Rather, the facts in the present case are more analogous to those in the *Ticketmaster Corporation* decision, cited *supra*, which similarly involved acquisition of a domain name portfolio at a time at which complainant's rights in a mark were found to be readily discoverable by the respondent, and the domain name at issue was apparently being used to resolve to a website at which services competitive with those of the complainant were being

offered.

Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(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, <ricard.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Presiding Panelist

Brigitte Joppich
Panelist

Warwick Smith
Panelist

Dated: August 21, 2008