



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Wine.com, Inc. v. Zvieli Fisher

Case No. D2000-0614

1. The Parties

Complainant:
Wine.com, Inc.
650 Airpark Road, Suite D
Napa, California 94558
United States of America

Respondent:
Zvieli Fisher
18034 Ventura Blv. 225
Encino, California 91316
United States of America

2. The Domain Name and Registrar

Contested Domain Name: “virtualvineyards.com”

Registrar:
Network Solutions, Inc. (NSI)
505 Huntmar Drive
Herndon, Virginia 20170
United States of America

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at "<http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>", which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in

accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the 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, with Exhibits A-J, was filed both by e-mail form on June 16, 2000 and, in hard-copy form, with Exhibits A-J and the appropriate payment on June 19, 2000 with the Arbitration and Mediation Center of the World Intellectual Property Organization (the "Center"). The Complainant states that on June 15, 2000, its attorneys served a copy of the Complaint, by courier and e-mail, on the Respondent and provided a copy of the Complaint, by facsimile and e-mail, to the Registrar, NSI. The Center acknowledged receipt of the Complaint by e-mail dated June 20, 2000 to the Complainant.

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 Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined that the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on June 20, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to the domain name; specifically, contact and registrant information for the contested domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of the domain name. On June 25, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the Policy is in effect (through Network Solutions 4.0 Service Agreement), and that the domain name, as of June 25, 2000, was on "hold" status.

On July 10, 2000, the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, by e-mail, facsimile and in hardcopy form by courier (the latter including a copy of the Exhibits supplied by the Complainant). 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) and 4(a) of the Rules.

Hence, with the notification to the Respondent having occurred on July 10, 2000, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on July 10, 2000.

Having reviewed the Complaint and succeeding correspondence between the Center and NSI, in detail, 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 July 29, 2000, to file its response with the Center and serve a copy of the response on the Respondent.

As of August 23, 2000, the Center has received no such response from the Respondent. Hence, on that date, the Center so notified the Complainant by e-mail, and the Respondent, by e-mail and facsimile, that the administrative proceeding would proceed by way of default.

Accordingly, pursuant to the Rules and Supplemental Rules, on August 23, 2000, the Center contacted the undersigned requesting his service as a sole panelist to consider and decide this dispute. On August 25, 2000, the undersigned accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence.

On August 25, 2000, the Center appointed the undersigned as the sole panelist to consider this dispute, and so notified both parties by e-mail. Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the undersigned to the Center on or before September 8, 2000. The undersigned, traveling to Alaska on August 26, 2000, experienced logistical difficulties in receiving a hard-copy version of the file which the Center had forwarded by courier. The undersigned finally received its hard-copy version in Anchorage, Alaska on September 6, 2000. In view of the then impending deadline of September 8, 2000, the Panel required additional time to fully consider this matter and appropriately prepare its decision. Hence, acting in its sole discretion and under paragraph 10(c) of the Rules, the Panel extended the date by which it will render its decision to the date of the present decision.

This dispute concerns one domain name alone, specifically "virtualvineyards.com". The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, Zvieli Fisher, has failed to respond to the Complaint, all the facts alleged by the Complainant, Wines.com, Inc., will be accepted as un rebutted. For convenience of the reader, factual allegations, to the extent needed, from the Complaint are reproduced below.

The dispute is based on the following trademark and its usage by the Complainant:

VIRTUAL VINEYARDS (in block letters)

This mark is the subject of United States trademark registration 2,079,604 issued July 15, 1997 -- a copy of which was provided in Exhibit C to the Complaint. This registration, which claims first use and first use in commerce of December 31, 1994, covers use of the mark in conjunction with:

"Advertising, promoting and marketing premium wines and related goods of others via an on-line electronic communications network", in international class 35.

This mark was originally applied in the name of Net Contents, Inc.; however, through various assignments recorded in the United States Patent and Trademark Office, title to the registration now vests in the Complainant (as evidenced by the assignment information provided in Exhibit C).

The Complainant also owns trademark registrations in the European Community (via a Community Trademark registration), Japan and Australia, and pending applications in South Africa and Canada all for a common stylized version of this mark -- copies of which have been provided in Exhibit D to the Complaint. For purposes of simplification, further references hereinafter to the Complainant's "mark" and/or "trademark" will be to its block letter United States registration.

The Complainant is an on-line retailer of wine, food and related products.

Since as early as December 1994, Complainant has used the term VIRTUAL VINEYARDS in the United States in connection with advertising, promoting and marketing premium wines and related goods via an on-line electronic communications network. Since November 1998, Complainant has also been using the VIRTUAL VINEYARDS mark as a brand name in connection with wines that it sells on its website. The Complainant state that it has made a substantial investment in promoting its website and its brand name VIRTUAL VINEYARDS.

On November 19, 1998, the Complainant, through its counsel, sent the Respondent a certified letter (a copy of which is provided in Exhibit I to the Complaint) through which the Complainant objected to the Respondent's registration and possible use of the contested domain name. The certified letter was returned to Complainant, with the envelope (a copy of which is also enclosed in Exhibit I) marked as "refused." On December 4, 1998, the Complainant sent another letter to the Respondent, though not certified (a copy of which is provided in Exhibit J to the Complaint; other than a change in date, this letter appears identical to the November 19 letter). Though this latter correspondence was not returned to Complainant, the Complaint never received any response to this letter from the Respondent.

Various web-disseminated articles (a copy of which appears in Exhibit F to the Complaint) in the computer industry trade press indicate that the Respondent has registered hundreds of domain names that are highly similar to well-known trademarks.

As indicated by the materials provided in Exhibit G to the Complaint, both Prodigy Communications Corporation (Prodigy) and Microsoft Corporation (Microsoft) have filed lawsuits against the Respondent. The former action is captioned Prodigy Communications Corp. v. Pordigy.Com, et al Civil Case No. 99-1345-ABC(Mcx) (United States District Court for the Central District of California); the latter action is captioned Microsoft Corp. v. Zvieli Fisher, et al Civil Docket No. 99-CV-3929 (United States District Court for the Central District of California, Western Division). In each instance, the Respondent failed to appear and a default judgment was entered against the Respondent.

On March 31, 1999, the Complainant sent a formal request to the Registrar to place the contested domain name on "hold" pursuant to Network Solutions' then-applicable domain name resolution policy. On November 19, 1999, the Registrar informed the Complainant that it declined the request in light of the Policy that was then going to take effect on January 1, 2000.

As indicated in the WHOIS registration record for the contested domain name provided in Exhibit A to the Complaint as well as the confirmation provided by the Registrar, the Respondent is shown as the current owner of the contested domain name. The registration record provided in Exhibit A taken together with the Registrar's service agreement currently in effect (a copy of which is provided in Exhibit B to the Complaint) collectively indicate that the contested domain name was originally registered on March 27, 1998, for an initial two-year term, with that registration expiring on March 27, 2000. The Respondent renewed the contested domain name prior to March 27, 2000 -- after receipt, at least so the Panel assumes, of the December 4, 1998 letter from the Complainant.

5. Parties' Contentions

A. Complainant

1. Similarity

The Complainant takes the position that the contested domain name, with the exception of the top level domain, i.e. .com, is nearly identical to Complainant's mark; hence satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

2. Legitimacy

The Complainant states that it created the mark "VIRTUAL VINEYARDS" which is an inventive combination of words that evokes a unique commercial impression. The Complainant states that it has never authorized or licensed any use of its registered mark by Respondent. The Complainant further states that its registered mark is unique to its goods and services, and it has never authorized any use of that mark by the Respondent.

As such, the Complainant contends that the Respondent cannot have legitimately chosen the contested domain name unless he was attempting to create an impression of being associated in some fashion with the Complainant. However, since the Respondent was unauthorized to do so, its interest in the contested domain name is illegitimate.

To further support its view of illegitimacy, the Complainant alleges that, since it first discovered the Respondent's registration of the contested domain name in 1998, the Complainant has monitored the web for any use of that domain name in association with any active website. The Complainant alleges that during that time it found no such site specifically resolvable through that name. The Complainant states that it did notice that for a time, the contested domain name was linked to 800GO.COM which apparently had extensive links to pornographic websites.

In addition, Complainant believes that the Respondent has not used the contested domain name for any bona fide offering of goods and services.

Similarly, the Complainant states that it is not aware of any evidence demonstrating that Respondent has ever been commonly known by the domain name.

Furthermore, the Complainant alleges that the Respondent has not made, nor is he presently making any legitimate noncommercial use of the domain name for any purposes.

Hence, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the domain name at issue pursuant to paragraph 4(c) of the Policy.

3. Bad Faith

The Complainant believes that Respondent registered in excess of 256 domain names, as mentioned in the articles which the Complainant submitted in its Complaint, that were highly similar to registered trademarks with an intent to misdirect computer users who are attempting to find the official Websites associated with those trademarks to websites affiliated with the Respondent – either sites competing with corresponding legitimate sites (i.e. those owned by the trademark proprietor) or sites with pornographic content.

The Complainant contends that both Prodigy and Microsoft instituted their infringement actions against the Respondent in an effort to stop the Respondent's activities.

Furthermore, the Complainant contends that, given the highly distinctive nature of its registered mark and its extensive promotion in connection with its goods and services, it is inconceivable that the Respondent chose the contested domain name without prior knowledge of that mark; hence evidencing bad faith.

The Complainant also contends that the Respondent's use, more specifically its passive holding, of the contested domain name amounts to bad faith. In that regard, the Complainant points to:

- (a) a total lack of a legitimate web presence resolvable through the contested domain name, or other legitimate use of that domain name; and
- (b) the Respondent's conduct in renewing its registration for the contested domain name in spite of having knowledge, such as through, *inter alia*, the December 4, 1998, letter, of the Complainant's registered mark and its legitimate interests in that domain name.

Hence, the Complainant concludes that the Respondent's conduct amounts to bad faith under paragraph 4(a) of the Policy.

B. Respondent

To date, the Respondent has not filed any response to the Complaint.

6. Discussion and Findings

In view of the lack of any response filed by the Respondent, Zvieli Fisher, this proceeding has proceeded by way of default. Hence, in the absence of any refuting evidence, all the facts and allegations submitted by the Complainant, Wine.com, Inc., are accepted as true.

Apart from judging this proceeding through mere 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 trademark ("VIRTUAL WINEYARDS"), is clearly sufficiently similar to it as to cause a likelihood of confusion to arise on the part of the relevant consumers of the Complainant and those who were to view the disputed domain name -- when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer the disputed domain name, were to start using the domain name. Such confusion, should it occur, would undoubtedly cause consumers to think that a relationship of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all.

The differences between the domain name and the registered trademark, being the deletion of a space between the words "VIRTUAL" and "WINEYARDS", a change in case from upper to lower case, along with appending of a top-level domain (.com) are all so de minimis as to be utterly inadequate to preclude any such confusion from occurring.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy.

In fact, for the reasons set forth below with respect to Illegitimacy and Bad Faith, given the conduct of the Respondent, as evidenced by: (a) its numerous registrations of various domain names bearing very high degrees of similarity to the trademarks, (b) its intentional renewal of the contested domain name registration after having received notice from the Complainant as to its legitimate interests in the domain name and apparently in total disregard of those interests, and (c) trademark enforcement action taken by others against the Respondent ostensibly to halt similar action perpetrated by the Respondent, in connection with which the Respondent failed to appear, the Panel concludes that:

- (i) the Respondent, Zvielin Fisher, intentionally chose the contested domain name for its high and nearly identical degree of similarity with the Complainant's registered mark and under which the Complainant undertakes its business, and
- (ii) with the principal reason of causing consumer confusion to eventually occur in order to injure the Complainant's business and/or reputation should the contested domain name become active through an attempt to divert consumers, who seek the Complainant's website, from that site to a competing or pornographic website having no relation to the Complainant.

B. Illegitimacy

Based on the evidence submitted by the Complainant, the Panel makes the following findings regarding illegitimacy.

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its trademark in conjunction with the goods and services listed in its registration.

Furthermore, the trademark is highly distinctive and not descriptive of any goods and services with which the trademark is registered.

The Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name in connection with any goods or services which it might be providing. In fact, it is extremely unlikely that Respondent can even make such a claim. The simple reason is that the contested domain name includes the Complainant's registered mark under which the Complainant distributes its products. The Complainant have never authorized the Respondent to utilize the registered trademark, nor does the Complainant have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put to the Complainant's trademark in connection with the goods or services listed in the registration would directly violate the exclusive trademark rights now residing in the Complainant.

In light of the above findings, the Panel is unpersuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any legitimate rights in the contested domain name, whether on a commercial or non-commercial basis.

Furthermore, the Panel is cognizant of the heavy burden that would be placed on Complainants if in support of their cases on illegitimacy each of those Complainants were impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their Respondents. Such a burden is particularly problematic given that the underlying facts more than not are in exclusive or near exclusive possession and control of the Respondents, particularly if they have not in fact made publicly discernible use. As such, the Panel believes that where allegations of illegitimacy are made, particularly as here when coupled with conduct of the Respondent that evidences bad faith, it is quite reasonable to shift the burden of proof to each such Respondent to adequately show that its use of the contested domain name is legitimate, such as by showing that, in conjunction with the contested domain name, it is making a bona fide commercial offering of goods or services or preparations for such offerings, or non-commercial or fair use. Given the situation now facing the Panel, it is beyond question that the Respondent's conduct falls way short of meeting this burden. There simply is no proof whatsoever of any such usage.

Thus, the Panel finds that use of the contested domain name by the Respondent is illegitimate within paragraph 4(a)(ii) of the Policy.

C. Bad Faith

In the Panel's mind, there is simply no question here that the Respondent's conduct here, being as egregious as it is, amounts to bad faith.

The Panel need only point to the Respondent's willful actions in repetitively registering substantial numbers of domain names, each of which is highly and confusingly similar or identical to well known trademarks, and moreover continued retention of those names even after having been placed on notice of others having legitimate rights in those names. Clearly, such a pattern of conduct is one which the Policy targets for eradication.

It is undeniable that this repetitive conduct clearly manifests an intent by the Respondent, rather than to legitimize the use of the contested domain name, to prevent the Complainant, as lawful owner of the registered trademark, from reflecting its mark in a corresponding domain name. Also and just as importantly, this conduct manifests an intent by the Respondent to totally disregard the lawful and exclusive trademark rights which the Complainant and its counterpart trademark registrants have.

Furthermore, using those domain names to divert web visitors to sites held by competitors of those registrants or to pornographic sites merely compounds the harm which the Respondent is inflicting on those trademark owners; harm which the Policy and the AntiCybersquatting Act are designed to remedy.

The Panel infers, based on a lack of any response from the Respondent, that the Respondent has no reasonable grounds to believe that any use to which it has or will make of contested domain name constitutes fair or otherwise lawful use.

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith under paragraphs 4(a)(iii) of the Policy.

In this connection the Panel notes that in its opinion, the Respondent's actions in registering the present domain name clearly evince bad faith in violation of the Anti-Cybersquatting provisions of the Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

Thus, the Panel concludes that the Complainant, even apart from default of the Respondent, has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

In accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the relief sought by the Complainant is hereby granted. The domain name is ordered transferred to the Complainant.

Peter L. Michaelson, Esq.
Panelist

Dated: September 11, 2000