

Register.com Inc. v. Reile, 70 USPQ2d 1351 (NAF 2004)

70 USPQ2D 1351
Register.com Inc. v. Reile

National Arbitration Forum

Claim No. FA0311000208576
Decided January 27, 2004

Headnotes

TRADEMARKS AND UNFAIR TRADE PRACTICES

[1] Infringement; conflicts between marks — Tests generally (§335.06)

REMEDIES

Non-monetary and injunctive — Equitable relief — Seizure; forfeiture (§505.0703)

Complainant seeking transfer of Internet domain name pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers must prove that respondent is utilizing domain name that is identical or confusingly similar to complainant's trademark, that respondent has no rights or legitimate interests in domain name, and that domain name has been registered, and is being used, in bad faith.

TRADEMARKS AND UNFAIR TRADE PRACTICES

[2] Infringement; conflicts between marks — In general (§335.01)

JUDICIAL PRACTICE AND PROCEDURE

Jurisdiction — Subject matter jurisdiction — In general (§405.0701)

Panel convened to resolve dispute over Internet domain names under Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers cannot decide questions of trademark infringement or registrability, since doing so is outside very limited and focused jurisdiction of ICANN panels, and since summary and abbreviated nature of ICANN proceeding precludes establishment of necessary factual record; in present case, in which complainant seeks transfer of respondent's domain names that incorporate complainant's federally registered "register" and "register.com" marks for computer services such as domain name registration, respondent may challenge validity of complainant's marks by filing cancellation action in U.S. Patent and Trademark Office, or by filing action in federal court.

TRADEMARKS AND UNFAIR TRADE PRACTICES

[3] Infringement; conflicts between marks — Likelihood of confusion — Particular marks — Confusion likely (§335.0304.03)

Infringement; conflicts between marks — Likelihood of confusion — Relatedness of goods or services — Similar (§335.0305.03)

Infringement; conflicts between marks — Willful (§335.11)

Respondent's use of Internet domain names that incorporate complainant's federally registered "register" and "register.com" marks for

Page 1352

computer services is likely to engender confusion among Internet users, since parties directly compete in provision of domain name registration services, since complainant enjoys positive reputation in marketplace and its marks have acquired secondary meaning, since generic terms "webpage" and "website," and numeric term "101," when prepended to complainant's marks to create respondent's domain names, do not render such domain names sufficiently distinctive to abate confusion, since respondent knew or should have known of complainant's reputation at time respondent registered its domain names, and since this finding indicates that respondent intentionally chose to cause and exploit

user confusion resulting from its practice of prepending generic terms to “register” marks in its domain names.

[4] Infringement; conflicts between marks — Likelihood of confusion —Particular marks — Confusion likely (§335.0304.03)

Infringement; conflicts between marks — Likelihood of confusion —Relatedness of goods or services — Similar (§335.0305.03)

Infringement; conflicts between marks — Willful (§335.11)

Respondent has no rights or legitimate interests in disputed Internet domain names incorporating complainant’s federally registered “register” and “register.com” marks for computer services, including domain name registration, since complainant has never authorized respondent’s use of “register” marks, and is not related to or associated with respondent, since respondent’s choice of domain names incorporating complainant’s marks, with generic or numeric terms prepended thereto, indicates intention to create confusingly similar names for purpose of diverting users to respondent’s Web site for respondent’s commercial advantage, since this finding is supported by fact that respondent obtained 21 domain names in this manner, some of which were registered after respondent’s receipt of cease and desist letters, and since respondent’s use of domain names is not “in connection with bona fide offering of goods or services,” in that such use is likely to engender user confusion; Uniform Domain Name Dispute Resolution Policy does not overreach by allowing complainant to monopolize uses of “register,” since respondent could retain disputed domain names if it could assert claim for rights in names based on something other than offering of competitive services.

[5] Infringement; conflicts between marks — Likelihood of confusion —Particular marks — Confusion likely (§335.0304.03)

Infringement; conflicts between marks — Likelihood of confusion —Relatedness of goods or services — Similar (§335.0305.03)

Infringement; conflicts between marks — Willful (§335.11)

Respondent has registered and is using, in bad faith, disputed Internet domain names that incorporate complainant’s federally registered “register” and “register.com” marks for computer services, including domain name registration, since respondent offers directly competing services through Web sites resolvable through disputed domain names, since sites in question are “copy-cat” sites that incorporate significant portions of complainant’s Web site design, since respondent’s conduct, including its registration of 21 domain names incorporating complainant’s marks, demonstrates on-going attempt

to cause confusion among Internet users and intentionally divert users to respondent's sites for respondent's commercial advantage, and since such conduct will cause harm to complainant, in form of lost revenue and injury to goodwill and reputation.

Case History and Disposition

Complaint filed by Register.com Inc. pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, against respondents Wolfgang Reile a/k/a RWG Internet and Marketing Rightway Gate Inc., 101 Internet Service, Internet Service, Rightway Gate Inc., RWG Marketing Rightway Gate Inc. NA, 101register.net, webpageregister.org, 101register.org, and webpageregister.net. Complainant requests that 21 Internet domain names containing "register" and "register.com" trademarks be transferred from respondents to complainant. Granted.

Attorneys:

Brett E. Lewis, Register.com Inc., New York, N.Y., for complainant.

Page 1353

Stephanie Chmura, of Gage Teeple, San Diego, Calif., for respondents.

Opinion Text

Opinion By:

Michaelson, panelist.

PARTIES

Complainant is *Register.com, Inc.* ("Complainant"), represented by *Brett E. Lewis*, 575 Eighth Avenue, 8th Floor, New York, NY 10018. Respondent is *Wolfgang Reile et.al.* ("Respondent"), represented by *Stephanie Chmura*, of *Gage Teeple, LLP*, 9255 Towne Centre Drive, Suite 500, San Diego, CA 92121-3038.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <*websiteregister.net*>, <*101register.com*>, <*webpageregister.com*>, <*101register.net*>, <*101register.org*>, <*webpage-register.net*>, <*websiteregister.org*>, <*website-register.org*>, <*website-register.net*>, <*websiteregister.com*>, <*webpage-register.org*>, <*webpageregister.org*>, <*website-register.biz*>, <*websiteregister.info*>, <*website-register.info*>, <*101register.info*>, <*webpage-register.info*> and

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<*webpageregister.info*>, registered with *Enom, Inc.*, and the <*webpage-register.com*>, <*website-register.com*> and <*webpageregister.net*> domain names registered with *Melbourne IT, Ltd.*, all twenty-one of which are collectively referred to hereinafter as the “disputed domain names.”

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 Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <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 National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on November 4, 2003; the Forum received a hard copy of the Complaint, together with Exhibits A-N, on November 5, 2003.

On November 5, 2003, Enom, Inc. confirmed by e-mail to the Forum that the domain names <*websiteregister.net*>, <*101register.com*>, <*webpageregister.com*>, <*101register.net*>, <*101register.org*>, <*webpage-register.net*>, <*websiteregister.org*>, <*website-register.org*>, <*website-register.net*>, <*websiteregister.com*>, <*webpage-register.org*>, <*webpageregister.org*>, <*website-register.biz*>, <*websiteregister.info*>, <*website-register.info*>, <*101register.info*>, <*webpage-register.info*> and <*webpageregister.info*> are registered with Enom, Inc. and that Respondent is the current registrant of the names. On November 5, 2003, Melbourne IT, Ltd. confirmed by e-mail to the Forum that the domain names <*webpage-register.com*>, <*website-register.com*> and <*webpageregister.net*> are registered with Melbourne IT, Ltd. and that Respondent is the current registrant of the names. Enom, Inc. and Melbourne IT, Ltd. have verified that Respondent is bound by their respective registration agreements and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On November 13, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of December 3, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and

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fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@101register.com, postmaster@webpage-register.com, postmaster@website-register.com, postmaster@webpageregister.com, postmaster@websiteregister.com, postmaster@101register.net, postmaster@101register.org, postmaster@webpageregister.net, postmaster@webpageregister.org, postmaster@website-register.net, postmaster@websiteregister.org, postmaster@website-register.org, postmaster@webpage-register.net,

Page 1354

postmaster@websiteregister.net, postmaster@webpage-register.org, postmaster@101register.info, postmaster@webpageregister.info, postmaster@webpage-register.info, postmaster@websiteregister.info, postmaster@website-register.info, postmaster@website-register.biz by e-mail.

A timely Response, together with Exhibit 1 and declarations of Ms. Chmura and Mr. Reile, was received and determined to be complete on December 10, 2003.

Complainant filed a timely additional submission on December 12, 2003. Respondent followed with a timely additional submission on December 12, 2003. Both of these submissions have been considered.

On December 12, 2003, Complainant subsequently filed its second additional submission, which was received without the required fee and is thus not in compliance with Forum Supplemental Rule #7. Thereafter, but on the same day, Respondent subsequently filed its second additional submission, which was also filed without fee and hence not in compliance with Forum Supplemental Rule #7. Nevertheless, the Panel has considered both of these second additional submissions as well.

On December 26, 2003, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a date of January 9, 2004 to receive the decision from the Panel.

On January 8, 2003 and owing to unforeseen and exceptional circumstances, the Panel extended the due date for its decision to January 27, 2004. The Panel appreciates the parties' indulgence and patience.

RELIEF SOUGHT

Complainant requests that the disputed domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant states that each of the disputed domain names incorporates Complainant's registered mark "REGISTER" or "REGISTER.COM" in its entirety.

Specifically, Complainant contends that four of the disputed domain names, specifically <101register.com>, <101register.info>, <101register.net> and <101register.org>, consist of a generic or non-distinctive term added to one of Complainant's registered marks.

Complainant contends that the remaining seventeen disputed domain names, specifically <webpage-register.com>, <website-register.com>, <webpageregister.com>, <websiteregister.com>, <webpagevregister.net>, <webpageregister.org>, <website-register.net>, <websiteregister.org>, <website-register.org>, <webpage-register.net>, <websiteregister.net>, <webpage-register.org>, <webpageregister.info>, <webpage-register.info>, <websiteregister.info>, <website-register.info> and <website-register.biz>, consist of Complainant's registered mark REGISTER preceded by words or combinations of words that simply describe Complainant's business, which is registering domain names for websites and webpages.

Hence, Complainant concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied with respect to each of the disputed domain names.

2. Rights and legitimate interests

Complainant contends that, for the following reasons, Respondent has no rights or legitimate interests in any of the disputed domain names.

First, Complainant states that it has not licensed, assigned or otherwise authorized Respondent to use any of Complainant REGISTER Marks, or any variations thereof, as domain names on the Internet.

Second, Complainant alleges that Respondent is known by the names Wolfgang Reile, Rightway Gate, Inc., RWG Internet and Marketing, RWG Marketing, 101 Internet Service and Internet Service. Accordingly, Complainant contends that prior to Respondent having registered any of the disputed domain names, Respondent was never, as an individual, business, or other organization, known by any of those names.

Third, Complainant alleges that Respondent never used any of the disputed domain names in connection with a bona fide offering of goods or services. In that regard, Complainant contends that Respondent operates "copy cat" websites that rely on domain names that are confusingly similar to Complainant's registered names in order to "trick" customers into using Respondent's competing domain name registration services.

Fourth, Complainant alleges that Respondent had no trademark rights in or to Complainant's REGISTER Marks prior to its having registered any of the disputed domain names and has not subsequently obtained any rights in or to those marks.

Lastly, Complainant alleges that Respondent uses the disputed domain names for the sole purpose of misleadingly diverting consumers for commercial gain. Specifically, Complainant states that home pages accessible through the following disputed domain names: <website-register.com>, <webpage-register.com>, <101register.com>, <101register.net>, <101register.org>, <websiteregister.com>, <webpageregister.com>, <webpageregister.net> and <webpageregister.org> are virtually identical to that which appeared at Complainant's <register.com> website from April 1999 through July 2002 — all as indicated by the hard-copy printouts of various home webpages appearing in Exhibit J to the Complaint, hence constituting “copy cat” sites. In that regard, Complainant notes that such “copy cat” sites use a central frame to prominently display a domain name search feature from which a customer navigates through pages where available domain names may be selected and purchased. Moreover, home pages appearing through the disputed domain names: <websiteregister.org>, <website-register.org>, <webpage-register.net>, <webpage-register.org>, <website-register.net> and <websiteregister.net>, also copy Complainant's <register.com> website. As for these latter names, Respondent's corresponding home pages also place links directly under the logo and at the top of the left-side navigation frame to “Domain Registration,” which when clicked, cause the central frame to display the same paid domain registration services as at Respondent's former sites listed above.

Thus, under Complainant's analysis, Respondent can not establish, under paragraph 4(c) of the Policy, rights to and legitimate interests in any of the disputed domain names.

3. Bad faith use and registration

Complainant contends that Respondent has registered and is using all of the disputed domain names in bad faith, hence in violation of paragraph 4(b)(iv) of the Policy, by intentionally attempting to attract, for commercial gain, Internet users to Respondent's websites by creating a likelihood of confusion with Complainant's REGISTER Marks as to the source, sponsorship, affiliation, or endorsement of those websites or of a service on those sites.

Complainant states as follows:

Respondent registered the disputed domain names between February 28, 1998 and May 10, 2002, starting four years after Complainant began using its REGISTER Marks in commerce, in connection with domain name registration, website hosting, electronic mail and related services. Further and as

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indicated in Exhibits E and F to the Complaint, these registrations also occurred after Complainant had become a well-known brand, registering over 300,000 domain names and making *PC Magazine's* top 100 best website list.

As early as April 21, 1999 and as indicated in Exhibit I to the Complaint, Complainant had become the second registrar accredited by ICANN to compete in the domain name registration business.

On or about February 8, 2001, Complainant learned of Respondent's websites located at <*website-register.com*> and <*webpage-register.com*>. Through these two websites and as indicated in Exhibit J to the Complaint, Respondent offered domain registration services and displayed webpages that contained characteristics strikingly similar to Complainant's website, logo and slogan as they appeared on Complainant's <*register.com*> site as early as April 1999. Specifically, Respondent's sites offered the same domain name search and registration service, used the same overall page layout, placed content on the same rounded background box, and displayed logos and slogans using the same font and text patterns as on Complainant's website. For example, on Complainant's website, the slogan "The First Step on the Web" appears beneath the Register.com logo in regular blue letters with the second word, "First", in red italics. Respondent's sites also contain the slogan "The Affordable Way to Web" which appears in the same exact color pattern and in the same location as on Complainant's site but with the second word, "Affordable", highlighted in italics.

Moreover, Respondent's site at <*website-register.com*> used the same red and blue colors in its logo, and both Respondent's sites at <*website-register.com*> and <*webpage-register.com*> used the same exact distinctive beige background color (expressed in hexadecimal format as "F7F2D0" or in RGB format

Page 1356

as "247,242,208") as had Complainant's <*register.com*> site during April 1999 through July 2002. (See Exhibit J, and source HTML code listing in Exhibit K attached hereto). Complainant cites to *TPI Holdings v. Mark Geiger, MARINEBAY*, D2001-0840 (WIPO Oct. 2, 2001) (finding that the requisite intent in violation of paragraph 4(b)(iv) of the UDRP Policy may be inferred from a "virtually identical layout").

Complainant's attorneys sent Respondent a cease and desist letter, a copy of which appears in Exhibit L to the Complaint, on February 8, 2001 apprising Respondent of Complainant's belief that, inter alia, his registration and use of the names <*webpage-register.com*> and <*website-register.com*> infringed Complainant's REGISTER Marks. The letter also requested that Respondent transfer registration of those names to Complainant. On June 21, 2001, Complainant sent Respondent a follow-up letter, a copy of which also appears in Exhibit L, reiterating the notice of infringement and again requesting the transfer of those two names.

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Following its receipt of the cease and desist letters, Respondent did not transfer the domain names to Complainant as the latter requested. Instead, Respondent registered six additional domain names, specifically <101register.info>, <webpageregister.info>, <webpage-register.info>, <websiteregister.info>, <website-register.info>, and <website-register.net>, all of which incorporated Complainant's REGISTER Marks. Additionally and as indicated in Exhibit J, Respondent modified the sites resolvable at many of, what would become, the disputed domain names to further mimic Complainant's <register.com> site by adding checkboxes and domain name extension options to its menu of domain name search functions.

Complainant subsequently became aware of Respondent's <101register.com> website, which, like the <website-register.com> website, imitated the color scheme, logo and layout of Complainant's <register.com> website. On February 5, 2002, Complainant sent Respondent a third cease and desist letter, a copy of which appears in Exhibit L, through which Complainant demanded transfer of the <101register.com> name to Complainant and notified Respondent that, inter alia, the <101register.com> name infringes Complainant's REGISTER Marks. Complainant views Respondent's continued refusal to transfer the domain name as further evidencing bad faith.

In May 2002, three months after receiving the third cease and desist letter, Respondent registered an additional domain name incorporating Complainant's REGISTER Marks, specifically <websiteregister.com>. This brought to twenty-one, Respondent's total number of such domain names through which it uses to offer commercial services in direct competition with Complainant.

Furthermore, as indicated in Exhibit J, the home page of Respondent's site resolvable through <websiteregister.com> is also virtually identical to Complainant's <register.com> website.

Complainant opines that Respondent in having registered so many similar domain names increases the likelihood that Complainant's customers will be diverted to Respondent's websites. This is particularly so inasmuch as the majority of those sites have been designed to resemble Complainant's site. Given this, Complainant contends that the large number of infringing domain names registered by Respondent should be seen as additional evidence of Respondent's intent to confuse or mislead, citing to *Nat'l Collegiate Athletic Ass'n v. Halpern*, D2000-0700 (WIPO Dec. 10, 2000) (panel held that “[o]verkill in registering domain names incorporating well-known trademarks for commercial purposes logically leads to an inference of bad faith registration and use”, even in cases where the marks in issue may not be “famous”).

Moreover, starting in August 2002, Respondent updated many of its sites resolvable through the disputed domain names, specifically <website-register.com>, <webpage-register.com> and <101register.com>, to copy additional features similar to those on Complainant's <register.com> website, including a left frame navigation bar, and the identical graphic and prominently displayed slogan “Make the Most of Your Domain!”. That slogan had not even appeared on Complainant's website until several months after Respondent received the first and second cease and

desist letters, in November 2001.

Complainant contends that Respondent's continued and defiant copying of Complainant's site further evinces Respondent's bad faith use and registration of the disputed domain names, citing *TPI Holdings v. JB Designs*, D2000-0216 (WIPO May 22, 2000)

Page 1357

may 30,(holding respondent's "slavish copying" of complainant's website and intentional infringement of complainant's copyright were evidence of bad faith use of a domain name).

Hence, Complainant concludes that Respondent's actions in registering and using each of the disputed domain names is in bad faith and contravenes paragraph 4(b) of the Policy.

B. Respondent

1. Complainant's federal trademark applications and registrations

Respondent states as follows:

On November 21, 2000, Complainant filed an application (serial number 76/169,140—a copy of the TARR record for that application appears as Exhibit 1 to the Response) for registration of the mark "Register.com." In that application, Complainant recited the services with which it uses its mark to include "computer network address management services, namely providing services enabling entities to reserve and secure computer network address and to access, add, modify, or delete information relating to their computer network addresses." Given this, Respondent contends that Complainant was seeking to use its mark "Register.com" as a vehicle to sell domain name registrations to its customers and the public. Subsequently during examination of that application, the PTO rendered a final refusal on November 17, 2003 denying registration of the mark due to its descriptive nature. See Chmura declaration.

Respondent contends that, in view of the Complaint's limited recitation of the services in its application as well as in the registrations supplied in the Complaint, none of Complainant's marks includes, as services, the sale of domain name registrations. In that regard, Respondent alleges that there is no registration by Complainant for the mark "Register.com" which was specifically intended to be used in conjunction with the sale of domain names.

Respondent states that it is in the business of, among other things, selling international and national domain name registrations. (See Reile declaration). Hence, Respondent argues that the "Complainant cannot be allowed to monopolize the domain name registration market and claim all uses of the word 'register.com' in the sale of domain name registrations when the U.S.P.T.O. conclusively determined that the mark is inherently descriptive of the goods and services and, thus, not a protected mark". In view of

the PTO refusal to register, the Panel should enter a judgment in favor of Respondent as there is no trademark infringement of Complainant's marks.

2. Policy factors

a. Confusing similarity/identity

Respondent takes the position that all the disputed domain names are neither confusingly similar nor identical to any of Complainant's marks inasmuch as, contrary to Complainant's position, Complainant has no federal trademark rights in the term "REGISTER".

As to the issue of Complainant's trademark rights, Respondent specifically states as follows:

When comparing two marks that contain the same generic term, "although the marks ultimately must be considered as a whole, the focus of the inquiry regarding appearance and sound is on the non-generic portion." *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 976 [219 USPQ 515] (11th Cir. 1983). Courts have consistently held that "when the common element of two trademarks is a generic term, the likelihood of confusion is reduced, as the public has come to expect that element on different products." *Kelley Blue Book v. Car-Smarts, Inc, et al.*, 802 F. Supp. 278 [24 USPQ2d 1481]; *Smithkline Beckham Corp. v. Proctor & Gamble Co.*, 591 F. Supp. 1229, 1238 [223 USPQ 1230]. (U.S.D.C. N.D.N.Y. 1984) Furthermore, Courts have held that if the primary significance of the trademark is to describe the *type of product* rather than the *producer*, the trademark is a generic term and cannot be a valid trademark. *Id.* Here, the US Patent and Trademark Office (PTO) determined that the mark "Register.com" was descriptive of the goods and services Complainant offered and refused to offer any trademark protection to Complainant. (See Chmura declaration).

Blacks' Law Dictionary defines the term "register" as "to record formally and exactly; to enroll; to enter precisely in a list or the like." The parties use the term "register" in their respective domain name registrations. As set forth in the Complaint, Complainant registered the terms "REGISTER" and "REGISTER.COM" with the US PTO. However, by

Page 1358

definition, "register" is a generic term used to describe the process by which one formally records something. Additionally, through its most fundamental use, "register" is a generic term, non-indicative of one particular process, product, or producer. Furthermore, the primary significance of the trademark, if any, is to describe the type of process rather than the producer. Most importantly, the PTO determined that the word "register" is a descriptive term and cannot be a valid trademark. (See Chmura declaration).

Apart from whether Complainant has federal trademark rights, Respondent separately contends that

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Complainant presented no evidence that the disputed domain names are confusingly similar to its REGISTER Marks. In that regard, Respondent states that Complainant's mark "Register.com" is distinct from all of the disputed domain names.

Specifically, seventeen of the disputed domain names contain the words "webpage" and "website" and are located before the term "register." The insertion of the words "webpage" and "website" before the term "register" create distinct and dissimilar domain name registrations compared to Complainant's REGISTER Marks. The first word within the disputed domain name registrations is not "register" and will not likely confuse consumers into believing that the domain names are related to Complainant. The words in Respondent's domain names are strategically placed in front of the descriptive term "register" so as to not confuse consumers into believing that Respondent's domain name registrations are anything other than Respondent's domain name registrations and are not the REGISTER Marks.

The remaining four disputed domain names do not contain the words "webpage" and "website," but start with a numeric term, "101" which is not contained in the REGISTER Marks. These names are <101register.com>, <101register.net>, <101register.org>, and <101register.info>. Complainant's REGISTER Marks do not contain any numbers whatsoever. As such, Respondent contends that the REGISTER Marks are not confusingly similar to any of the disputed domain names.

Moreover, Respondent contends that, even apart from the visual differences between the disputed domain names and the REGISTER Marks, Complainant's designated use of the marks "Register," and "Register.com", as indicated in Complainant's federal registrations and pending application, at the time, do not include the sale of domain names — the very services which, through the disputed domain names, Respondent provides. Respondent points to Complainant's designated services as being "computer and business services, namely hosting websites of others on a computer server for a global computer network, and providing information about website development, electronic mail, and electronic commerce." Given this, Respondent contends that Complainant, by its own description, was not seeking protection of its marks in connection with the sale of domain name registrations to other businesses or services — hence ostensibly excluding those services from coverage under its federal marks.

b. Rights and legitimate interests

Respondent contends that it has legitimate rights and interests in the disputed domain name under paragraph 4(c) of the Policy.

Respondent avers as follows:

First, although Complainant has not licensed, assigned or otherwise authorized Respondent to use the REGISTER Marks, or any variations thereof, as domain names, due to the generic and descriptive nature of the term "register," Respondent should not be prohibited from using the term as part of its

domain names.

Second, Respondent is commonly known by the disputed domain names. In that regard, Respondent has actively been engaged in search engine registration and optimization for approximately nine years. Approximately five years ago, Respondent expanded its registration business to include international and national domain registrations and became a web hosting provider focusing on search engines, optimized, national and international e-commerce systems. (See Reile declaration). As a simple result of its history of providing registration services to businesses and customers, it is “understandable that Respondent is known as the disputed domain names in this complaint”.

Third, Complainant first used its REGISTER Marks in commerce in 1994 and has, admittedly, “used them continuously and extensively in connection with the provision of domain name registration services, online search engine services, website hosting and development

Page 1359

services, electronic mail services and other related services ever since.” However, at no time prior to filing its Complaint, did Complainant ever allege that Respondent lacked an interest in the disputed domain names or that the disputed domain names were confusingly similar to the REGISTER Marks. Thus, for approximately nine years, Complainant failed to identify any reason or justification for challenging Respondent's use of the term “register.” As such, Complainant should be estopped from asserting, nine years after the fact, that Respondent has no interest in the disputed domain names or that the disputed domain names are confusingly similar to the REGISTER Marks.

Fourth, as indicated in the Reile declaration, Respondent's use of the disputed domain names is directly connected with a bona fide offering of services, i.e., domain name registrations. Specifically, unlike the business of Complainant, Respondent is in the business of selling and providing domain names to its clients and customers. Respondent is not using the term “register” in its domain names to divert and confuse Complainant's customers to Respondent's competing websites. In that regard, Respondent does not even engage in the same primary business as does Complainant. Furthermore, Complainant has presented no evidence that its customers are, in fact, confused by the alleged similarity of marks nor that its customers are being diverted from Complainant's websites to Respondent's websites.

In that regard, Respondent views Complainant as asserting that, merely because Respondent has the same website structure and central frame, Respondent is misleading and diverting customers for commercial gain. As understood by the Panel, Respondent is arguing that existence of the former does not necessarily result in the latter. Moreover, Respondent contends that absent any compelling evidence which actually and emphatically supports such a contention, it should be inferred that the sole purpose of Respondent's use of the disputed domain names is not to mislead and divert customers from Complainant for Respondent's commercial gain.

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Lastly, Respondent's use of the disputed domain names is not made with the sole purpose of misleadingly diverting consumers for commercial gain. As previously indicated, Respondent operates his own domain name registration business on a much smaller scale than does Complainant. Complainant stated that it has millions of visitors to its websites every month and is managing over 3 million domain names under the Register.com mark. On the other hand, Respondent, through its websites, has approximately 30,000-50,000 unique visitors per month and an average customer base of approximately 10,000 users. (See Reile declaration.)

Hence, Respondent submits that, under paragraph 4(c) of the Policy, it has legitimate interests and rights in each of the disputed domain names.

c. Bad faith

Respondent contends that it did not register and use any of the disputed domain names in bad faith.

Respondent contends that while Complainant describes the colors and font used by both Complainant and Respondent on their respective websites, Complainant has failed to state any facts which indicate that Respondent's use of the term "register" was improperly motivated. Insofar as Complainant alleges that Respondent's failure to cease and desist prior to its additional website uses of the disputed domain names was evidence of bad faith, this should not weigh against a finding of good faith fair use.

Further, Respondent has used the term "register" in the disputed domain names for several years. Complainant's and Respondent's websites are distinct in that they, as set forth in the Complaint, have different logos and main frames. While the websites utilize similar colors, this is not enough to rise to the level of bad faith by Respondent nor are the similarities enough to confuse consumers. Respondent contends that "[t]hese minute similarities do not demonstrate that Respondent intended to mislead and/or confuse the consumer as to source of the different products or services". Furthermore, Complainant and Respondent are in different fields whereby Complainant is not involved in the sale of domain name registrations but Respondent is.

Thus, because the domain name registrations differ visually and because Complainant and Respondent do not directly compete against each other, Respondent submits that it has not acted, with respect to paragraph 4(b) of the Policy, in bad faith by and through its use of the disputed domain names.

Furthermore, if the Panel determines that Respondent has infringed upon trademarks of Complainant, Respondent requests that the Panel should not order Respondent to transfer its domain

name registrations to Complainant. Respondent contends that such a transfer would constitute a windfall to Complainant inasmuch as it would include a transfer of goodwill that Respondent has established over the past nine years. Respondent submits that if a remedy is necessary, Respondent should be enjoined from using the disputed domain names which directly relate to the REGISTER Marks.

C. Additional Submissions

Both Complainant and Respondent have each filed two additional submissions: one submission from each was timely while the others were not submitted with the fee required by Forum Supplemental Rule #7. Nevertheless, as indicated above, the Panel has considered all these submissions.

1. Complainant's first additional submission

Complainant, in rebutting the allegations raised in the Response, posed the following counter-arguments in its first additional submission:

First, on November 25, 2003, twelve days after Complainant commenced this proceeding, the PTO granted Complainant's federal trademark application to register the mark "REGISTER.COM" on the principal register (now registration no. 2,785,206), in connection with domain name registration services—as indicated in Exhibit O to this submission. This information was plainly available to Respondent's counsel had they run a simple trademark search on the PTO's website. Curiously, no mention of that mark appears in Respondent's papers. Instead, Respondent relies entirely on an irrelevant discussion of a design mark application (serial number 76/169,140) which is incomplete and misleading since Complainant obtained a federal trademark registration, resulting from a different application, for the word mark "REGISTER.COM" covering exactly the same services at issue in the present dispute and specified in the '140 application.

As a federally registered mark on the principal register, that mark is presumptively viewed as being distinctive of Complainant's domain name registration services and is sufficient to establish Complainant's rights in that mark, in accordance with paragraph 4(a)(i) of the Policy. Accordingly, Respondent's allegation, that the PTO determined that the "REGISTER.COM" mark is inherently descriptive of the goods and services with which that mark is used, is erroneous.

Second, Respondent alleges that Complainant is not actually engaged in the business of providing domain name registration services. This Complainant states that this claim is "obviously a fiction devised in a desperate attempt to establish that Respondent's use of the disputed domain names is non-competing and, thus, bona fide". Complainant takes the position that the parties directly compete with each other in domain name services including domain name registration.

Third, Respondent failed to refute any of the authority cited by Complainant in its Complaint concerning the confusing similarity of the disputed Domain Names to the REGISTER Marks. There,

Complainant cited a number of UDRP decisions where panels have espoused the principle that confusing similarity could not be avoided merely by adding generic or descriptive terms to a distinctive mark. Also, in that regard, Complainant cites to *shopping 24 Gesellschaft fu'r multimediale Anwendungen mbH v. Rommel*, Case No. D2000-0508 (WIPO Aug. 22, 2000) (prefixing “home”-, “cyber”, “cyber-”, “e-home”, “internet-”, and “online-” to <shopping24.com> found confusingly similar to SHOPPING24 mark where panel felt there was a “serious risk” that Respondent might use the names to compete with complainant's general shopping business)).

Fourth, Complainant states that its REGISTER Marks are presumptively distinctive. The words “website” and “webpage”, as used by Respondent, are descriptive of the website registration services offered by Complainant in connection with the its REGISTER Marks. Additionally, the number “101” is essentially meaningless when added to a domain name that also contains a distinctive mark.

Hence, Complainant submits that Respondent's allegation that Complainant “presents no evidence” of confusing similarity between the disputed domain names and the REGISTER Marks is wholly unsupported.

Fifth, in light of Respondent's own admission that he was aware of and visited Complainant's

Page 1361

website on the Internet, as of at least three years ago, it is beyond reason that Respondent could not have known that Complainant was in the business of selling domain name registrations. (*See* Reile declaration). The <register.com> website that Respondent would have accessed on the Internet three years ago prominently and centrally advertised Complainant's domain name registration services, including registration services for domains with the .co.uk and .org.uk extensions, which are clearly international. (*See* Complaint Exhibit J specifically the home pages from Complainant's register.com site as posted in 1999). Moreover, screen shots (appearing in Exhibit J to the Complaint) providing evidence of Respondent's meticulous imitation of the register.com screen layout and domain name registration search features that were submitted with the Complaint conclusively contradict Respondent's claim that he was unaware of the nature of Complainant's business. (*See* Complaint Exhibit J).

Sixth, contrary to Respondent's allegation that Complainant never alleged that the disputed domain names were confusingly similar to the REGISTER Marks prior to filing the Complaint, Complainant sent Cease and Desist Letters to Respondent as early as February 8, 2001, informing Respondent of Complainant's belief that the domain names of which Complainant had then been made aware, <website-register.com> and <webpage-register.com>, were confusingly similar to Complainant's marks. Complainant's subsequent February 5, 2002 cease and desist letter to Respondent not only informed Respondent that the domain name <101register.com> was confusingly similar to Complainant's marks, but also that Complainant's customers had “contacted us [Complainant] based on

actual confusion....”.

Lastly, Complainant opposes Respondent's request to the Panel that, even if it should find “infringement” — which the Panel interprets to be a basis under the Policy to warrant either transfer or cancellation of the disputed domain names, the Panel should not transfer the disputed domain names to Complainant. Specifically, Complainant states that Respondent, by its own admission, has been aware of Complainant for at least three years. Respondent's actions suggest that it has been fully aware of Complainant's business for the entire 3-5 year period during which Respondent has been using the disputed domain names. Respondent's painstaking copying of Complainant's website belies Respondent's assertion that Respondent was unaware that Complainant sold domain names. If there was any doubt, the cease and desist letters sent by Complainant to Respondent placed Respondent on clear notice that Respondent was infringing on Complainant's trademarks. Hence, Complainant takes the position that Respondent cannot now be heard to complain that the transfer of the disputed domain names would in any way prejudice him. The goodwill that Respondent claims will be a windfall to Complainant was wrongfully usurped by Respondent, and the harm inflicted on Complainant will not be compensated by the mere transfer of the disputed domain names.

2. Respondent's first additional submission

Respondent does not dispute that Complainant has a federally registered trademark for the mark REGISTER.COM. Furthermore, Respondent acknowledges that it has seen and is aware of that registration as provided in Exhibit O (to Complainant's first additional submission).

Respondent's position is that the word REGISTER is not Complainant's trademark when used for the sale of domain name registrations. As such, sixteen of the twenty-one disputed domain names should not be subject to this arbitration as they do not deal with Complainant's valid trademark for “Register.com.”; instead, as set forth in Response, these disputed domain names simply utilize the term REGISTER and not “Register.com.”

As these sixteen disputed domain names are not under the umbrella of Complainant's trademark REGISTER.COM, the Panel should determine, based upon Complainant's own admissions, that they are not infringements upon Complainant's registered trademark for REGISTER.COM.

Finally, with respect to the remaining five disputed domain names, Respondent defers to the arguments set forth in the Response inasmuch as those names are not confusingly similar to those of Complainant.

3. Complainant's second additional submission

In its second additional submission, Complainant states essentially as follows:

First, Complainant has a federal trademark registration for the word REGISTER in connection with closely-related website hosting, email and related services. Second, a TLD suffix has no trademark significance under US law. Accordingly, there is no difference, for trademark purposes, between Complainant's REGISTER.COM mark and the mark REGISTER. Third, Complainant has common law rights in the REGISTER mark, as established through extensive use in commerce and recognized in prior UDRP and judicial proceedings. Fourth, nowhere in any of Complainant's papers has Complainant admitted that it lacks trademark rights in the term "Register." Finally, Complainant contends that any assertion that the term REGISTER is not widely associated with Complainant's domain name registration business "borders on the absurd".

4. Respondent's second additional submission

In its second additional submission, Respondent states essentially as follows:

While Respondent does not dispute that Complainant has a registered trademark for the term REGISTER.COM, Respondent is disputing Complainant's right to obtain "blanket" protection over any and every use of the term "register" when used in conjunction with other terms, etc. Complainant is attempting to argue that this Panel should extend trademark protection over all uses of the term "register", even if they are used in conjunction with additional words or terms. Respondent is arguing that this protection should not be over-extended to include sixteen websites such as <website-register.net> <website-register.org>, or <webpageregister.info> because they are not confusingly similar to Complainant's trademark and do not even contain the registered trademark, REGISTER.COM. This fundamental difference is neither absurd nor an attempt to deceive this Panel in any way. The differences speak for themselves.

As for the mark REGISTER, Complainant asserts that there is no difference, for trademark purposes, between Complainant's REGISTER.COM mark and the mark REGISTER. Nowhere in Complainant's registration for the REGISTER mark (appearing in Exhibit D to the Complaint) does that registration describe the mark as being used to sell domain name registrations. Instead, the recitation of services is limited to "computer and business services, namely hosting the websites of others on a computer server for a global computer network, and providing information about website development, electronic mail, and electronic commerce." Furthermore, Complainant's recitation does not contain use for selling domain name registrations. Thus, the mark does not afford the same breadth of protection as Complainant would like to believe. Complainant's arguments are over-reaching attempts to usurp the market and obtain "blanket" protection over any and all uses of the word "Register."

FINDINGS

A copy of the registration records for all twenty-one disputed domain names appears in Exhibit A to the Complaint. These records indicate that Respondent registered these names between February 28, 1998, and May 10, 2002.

A. Complainant's REGISTER Marks

Complainant owns several federal service mark registrations that either consist of or incorporate the term REGISTER and has provided, in Exhibit D to the Complaint and Exhibit O to Complainant's first additional submission, a copy of the registration records from the Trademark Electronic Search System (TESS) or the Trademark Applications and Registrations Retrieval (TARR) web servers, both of which are provided by the US Patent and Trademark Office (PTO) and are accessible through the Internet. The pertinent details are as follows:

1. REGISTER (block letter) US registration 2,664,968; registered December 24, 2002

This mark was registered for use in connection with: “electronic mail services” in international class 38 and “computer and business services, namely, hosting the websites of others on a computer server for a global computer network, and providing information about website development, electronic mail, and electronic commerce” in international class 42. This mark claims a first use and first use in commerce date of December 1, 1994 for class 38 and December 31, 1994 for class 42.

Page 1363

2. REGISTER.COM (block letter) US registration 2,664,967; registered December 24, 2002

This mark was registered for use in connection with: “electronic mail services” in international class 38 and “computer and business services, namely, hosting the websites of others on a computer server for a global computer network, and providing information about website development, electronic mail, and electronic commerce” in international class 42. This mark claims a first use and first use in commerce date of December 31, 1994 for both classes.

3. REGISTER.COM (block letter) US registration 2,785,206; registered November 25, 2003

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This mark was registered for use in connection with: “commercial information and directory services featuring directories for locating computer network addresses and demographic information of entities; providing an online directory of business organizations, individuals, addresses and resources” in international class 35 and “computer network address management services, namely providing services enabling entities to reserve and secure computer network addresses and to access, add, modify, or delete information relating to their computer network addresses; computer services, namely providing search engines for obtaining data on a global computer network; hosting the websites of others on a computer server for a global information network” in class 42. This mark claims a first use and first use in commerce date of December 1, 1994 for both classes.

B. The Parties' Activities

With respect to Complainant, Register.com Inc. is a publicly-traded company. Complainant was the second ICANN-accredited company to compete in the domain name registration field and has consistently been one of the leading companies in its industry. Complainant currently has a market capitalization of more than \$200 million and employs approximately 500 people. As of June 30, 2003, Complainant was managing over three million domain names under the REGISTER.COM mark and has millions of visitors to its website every month. Net revenues relating to services marketed and sold under the REGISTER Marks were \$86,109,514 in 2000, \$116,280,759 in 2001, approximately \$106,288,000 in 2002, and approximately \$53,257,000 for the first two quarters of 2003. (See declaration of Brett E. Lewis appearing in Exhibit G to the Complaint).

Complainant first used its REGISTER Marks in commerce in 1994 and has used them continuously and extensively in connection with the provision of domain name registration services, online search engine services, website hosting and development services, electronic mail services and other related services ever since. Register.com gained national press attention in early 1998, was ranked by *PC Magazine* as one of the top 100 Web Sites on the Internet in December 1998, and, by early 1999, had registered more than 300,000 domain names for Network Solutions, Inc., making Complainant one of the leading domain name registration services at that time. (See Exhibits E, F and M to the Complaint).

Complainant has extensively advertised its services provided under the REGISTER Marks through all forms of media, including national television and radio, nationally-distributed print publications, and on major websites. In that regard, Complainant has spent tens of millions of dollars on such advertising during the past four years. (See Lewis declaration).

Complainant has never licensed, assigned or otherwise authorized Respondent to use any of the REGISTER Marks as domain names on the Internet. Complainant and Respondent are direct competitors in the provision and sale of domain names.

On or about February 8, 2001, Complainant learned of Respondent's websites located at <*website-register.com*> and <*webpage-register.com*>. Through these two websites, Respondent offered domain registration services and displayed webpages that contained characteristics similar to

Complainant's website, logo and slogan as they appeared on Complainant's <register.com> site as early as April 1999.

Specifically, Respondent's websites offered the same domain name search and registration service, used the same overall page layout, placed content on the same rounded background box, and displayed logos and slogans using the same font, colors and text patterns as on Complainant's website — as that site

Page 1364

appeared during April 1999 through July 2002.

Complainant's attorneys sent Respondent a cease and desist letter on February 8, 2001 informing Respondent that its registration and use of the domain names <webpage-register.com> and <website-register.com> infringed Complainant's REGISTER Marks. The letter also requested Respondent to transfer registration of those two names to Complainant. On June 21, 2001, Complainant sent Respondent a subsequent letter which reiterated Complainant's view of infringement and again requested the transfer of those two names.

In spite of the letters, Respondent did not transfer the domain names. Instead, Respondent registered six additional domain names — of the 21 ultimately disputed, specifically <101register.info>, <webpageregister.info>, <webpage-register.info>, <websiteregister.info>, <website-register.info>, and <website-register.net>, all of which incorporate the term “register”. Furthermore, Respondent modified certain of its websites by adding checkboxes and domain name extension options to its menu of domain name search functions which had the effect of increasing the similarity between each of these sites and Complainant's site. Each corresponding domain name for these additional sites would eventually fall within the disputed domain names.

Complainant subsequently became aware of Respondent's <101register.com> website, which, like the <website-register.com> website, imitated the color scheme, logo and layout of Complainant's <register.com> site. On February 5, 2002, Complainant sent Respondent a third cease and desist letter through which Complainant demanded transfer of the <101register.com> name and notified Respondent that, inter alia, the <101register.com> name infringes Complainant's REGISTER Marks.

Some three months later, during May 2002, Respondent registered an additional domain name incorporating Complainant's REGISTER Marks, specifically <websiteregister.com>. The home page of Respondent's site resolvable through that particular name is also quite similar, if not virtually identical, to Complainant's <register.com> website.

Starting in August 2002, Respondent updated many of its sites resolvable through the disputed domain names, and specifically <website-register.com>, <webpage-register.com> and <101register.com>, to copy additional features into its sites that were similar to those on Complainant's

<register.com>website, including a left frame navigation bar, and the identical graphic and prominently displayed slogan "Make the Most of Your Domain!" That slogan had not even appeared on Complainant's website until November 2001 which would have been several months after the dates of the first and second cease and desist letters.

As for Respondent's business activities, for the past nine years since 1994, Respondent has engaged and continues to engage in search engine registration and optimization. Approximately five years ago — starting in the 1998-9 timeframe, Respondent expanded its registration business to include international and national domain registrations and became a web hosting provider focusing on search engines, optimized, national and international e-commerce systems. In doing so, Respondent operates various websites, resolvable through the disputed domain names, through which it sells and provides domain names to its clients and customers. Currently, Respondent, through its websites, has approximately 30,000-50,000 unique visitors per month and an average customer base of approximately 10,000 users.

DISCUSSION

Though the disputed domain names collectively embody various different generic top level domains ("gTLDs"), specifically ".com", ".org", ".net", ".biz" and ".info", the corresponding registrars have each adopted the Policy as the mechanism for use in resolving disputes that implicate prior trademark rights involving names having these gTLDs. Accordingly, the Panel will not differentiate among the various different gTLDs and will treat all the different gTLDs together.

Paragraph 15(a) of the Rules of the Policy 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."

[1] Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

Page 1365

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

Trademark Infringement/Validity issues

[2] Questions of trademark infringement, as Respondent raises, are clearly not within the purview of any ICANN proceeding and are best left for court adjudication. Not only is doing so outside the very limited and focused jurisdiction afforded to ICANN panels under the Policy but moreover the summary and rather abbreviated nature of ICANN proceedings totally precludes the establishment of a fully developed factual record that underlies such a question.

Issues concerning trademark invalidity, which Respondent here raises as a lack of registrability owing to descriptiveness/genericness, are no different. ICANN panels cannot and hence do not assess the validity of any federally registered trademark. Instead, such panels must, of necessity, accord significant deference to decisions of that government body, namely the US PTO, which, in the first instance, not only possesses the requisite expertise to assess such issues but also the federal statutory mandate to do so. It is simply not within the purview of any ICANN panel to evaluate and review the judgment of the US PTO on such questions. Moreover, even apart from those jurisdictional concerns but clearly in view of the rather summary and abbreviated nature of ICANN proceedings, ICANN panels are here too grossly ill-equipped to deal with an extensive factual inquiry that typically underlies an invalidity determination. *See, e.g., United States Office of Personnel Mgmt. v. MS Tech. Inc.*, FA 198898 (Nat. Arb. Forum Dec. 9, 2003), and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, D2002-0758 (WIPO Oct. 4, 2002).

Hence, once the US PTO has made a determination that a mark is registrable, as it has here by issuing a registration for each of the REGISTER Marks, an ICANN panel is not empowered to nor should it disturb that determination.

To the extent Respondent wishes to challenge the US PTO's determination that any of Complainant's REGISTER Marks have acquired sufficient distinctiveness upon which registration can be based, Respondent may well have appropriate administrative and/or judicial avenues available to it to do so, such as by filing an action in the US PTO to cancel any of Complainant's federal registrations or alternatively instituting federal litigation. Absent Respondent having done so and attained a final ruling that any of Complainant's federally registered marks is indeed merely descriptive or generic and thus not susceptible of registration, this Panel will simply defer, as it must, to the US PTO's determination implicit in its having granted a registration, i.e., that each of Complainant's REGISTER Marks have acquired sufficient distinctiveness and hence are not merely descriptive, and thus qualify for federal trademark protection and enjoy all the rights afforded thereby.

Identical and/or Confusingly Similar

The Panel finds that confusion is likely to arise as a result of Respondent's use of any and all of the disputed domain names.

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Each of the disputed domain names prepends a generic term (specifically “webpage” or “website”) or a numeric term (specifically “101”), with or without an intervening hyphen, to Complainant's mark REGISTER. As will be seen below, applicable UDRP precedent, illustratively discussed below, treats all these terms and the addition of punctuation marks in the same manner, i.e., each being insufficient in and of itself, when used in forming a domain name that results from adding that item to a mark, to confer the requisite distinctiveness that would sufficiently abate concomitant user confusion. Hence, for the sake of simplicity, the Panel will simply treat all the disputed domain names collectively.

[3] All Complainant's REGISTER Marks allege first use of those marks in commerce in connection with its e-commerce/website (including domain name registration) /e-mail services (collectively “Internet” services) as least as of December 31, 1994 — approximately 3 years prior to earliest date, February 28, 1998, on which Respondent began registering the disputed domain names. In the Panel's mind, even apart from Respondent's own admission, Complainant and Respondent directly and clearly compete in provision and registration of domain names and have done so for several years. Such domain name services are certainly encompassed within the

Page 1366

recitation of Complainant's Reg. No. 2,664,967 registration, namely, “commercial information and directory services” and “computer network address management services”.

As a result of Complainant's continuous and extensive use of its REGISTER Marks since 1994, those marks have certainly acquired requisite secondary meaning and distinctiveness prior to February 1998, and clearly to a level sufficient from which the Panel can infer that potential customers and Internet users are likely to recognize those marks as signifying the various Internet services offered by Complainant and not by Respondent.

Further, in the context of Internet services, and specifically domain name services—which both Complainant and Respondent competitively render—the Panel finds that the terms “website” and “webpage” are simply generic terms, each of which adds absolutely no distinctive element to any of the disputed domain names, let alone of any magnitude sufficient to distinguish that name from Complainant's REGISTER Marks and thus preclude user confusion. *See, e.g., Cable News Network LP, LLP v. Khouri*, FA 117876 [68 USPQ2d 1570] (Nat. Arb. Forum Dec. 16, 2002); *Pfizer Inc. v. Order Viagra Online*, D2002-0366 (WIPO July 11, 2002); *Dell Computer Corp. v. MTO C.A.*, D2002-0363 (WIPO July 5, 2002); *Am. Online, Inc. v. Woods*, D2001-0555 (WIPO June 13, 2001); *Dell Computer Corp. v. Logo Excellence*, D2001-0361 (WIPO May 7, 2001); and *Quixtar Invs., Inc. v. Hoffman*, D2000-0253 (WIPO May 29, 2000). The same is true for the addition of “101” or an insertion of a hyphen, with the latter being such a de minimus modification that it warrants no further comment of its own. *See, e.g., Cable News Network LP, LLP, supra; Southwest Airlines Co. v. TRN*, D2002-0893 (WIPO, Nov. 18, 2002) and *MPL Communications, Ltd. v*

LOVEARTH.net, FA 97086 (Nat. Arb. Forum, June 4, 2001).

Given that Respondent's services are identical and competitively overlap with those of Complainant and in view of Complainant's widespread and prior reputation in the marketplace, the Panel believes, and the record fails to indicate otherwise, that Respondent's prepending of either of the generic terms "webpage" or "website" to Complainant's REGISTER mark, as Respondent has done in some of the disputed domain names, is far more likely to exacerbate, rather than ameliorate, the confusion.

In fact, there can be no doubt that Respondent had just this goal in mind and hence intentionally chose to cause and opportunistically exploit the user confusion that would inevitably arise to Respondent's own commercial advantage when it formed the disputed domain names by prepending the generic word "website" or "webpage" to the mark REGISTER. Otherwise, why would Respondent have chosen a domain name that verbatim incorporates Complainant's mark REGISTER? The Panel can think of no plausible reason. It is simply inconceivable to the Panel that Respondent — contrary to its statements in the Reile declaration — was completely unaware of the REGISTER Marks and their reputation when Respondent formed and registered each of the disputed domain names. Given that the parties are direct competitors, it stands to reason that either Respondent knew of Complainant at the time the former started registering the disputed domain names or at least should have. It strains one's belief to think that anyone starting a business or offering a new service under a specific name (or here through a domain name) — as Respondent has done — would not know his primary competitors. Complainant was clearly one such competitor, particularly a rather large competitor, at the time and for some 3 years prior. There is simply nothing in the record to indicate that, during this time period, Complainant hid its identity from its user/customer community; in fact, the record clearly indicates the exact opposite.

Such confusion would undoubtedly cause Internet users intending to access Complainant's website, but who reach a website through any of the disputed domain names, to think that an affiliation of some sort exists between Complainant and Respondent, when, in fact, no such relationship would exist at all. *See, also, e.g., Caesars World, Inc. v. Japan Nippon*, D2003-0615 (WIPO Sept. 30, 2003); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); *Am. Family Life Assurance Co. of Columbus v. defaultdata.com*, FA 123896 (Nat. Arb. Forum Oct. 14, 2002); *AT&T Corp. v. Abreu*, D2002-0605 (WIPO Sept. 11, 2002); *Pfizer Inc., supra*; *L.F.P., Inc. v. B and J Prods.*, FA 109697 (Nat. Arb. Forum May 30,

Page 1367

2002); *Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002); *Spence-Chapin Servs. to Families and Children v. Wynman*, FA 100492 (Nat. Arb. Forum Dec. 10, 2001); *MPL Communications v. LOVEARTH.net, supra*; *Meijer, Inc. v. Porksandwich Web Servs.*, FA 97186 (Nat. Arb. Forum July 6, 2001); *MPL Communications v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001);

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Surface Prot. Indus., Inc. v. Webposters, D2000-1613 (WIPO Feb. 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.*, D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000); *see also Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that each of the disputed domain names sufficiently resembles Complainant's REGISTER Marks as to cause confusion; hence, Complainant has shown sufficient similarity between its marks and all the disputed domain names under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

The Panel believes that Respondent has yet to provide any basis that would legitimize any claim it has to any of the disputed domain names. In fact, it is extremely unlikely that Respondent can even make such a claim.

[4] The simple reason is that each of the disputed domain names contains one of Complainant's REGISTER Marks under which Complainant provides its Internet services. Furthermore, Complainant has never authorized Respondent to utilize any of its REGISTER Marks, or a mark confusingly similar thereto, in conjunction with the specific Internet services which Complainant provides under those marks, nor does Complainant have any relationship or association whatsoever with Respondent.

Hence, any use to which Respondent were to put any of the REGISTER Marks or a mark confusingly similar thereto, in connection with providing Internet services identical or similar to those currently provided by Complainant would directly violate the exclusive trademark rights now residing in Complainant. *See, e.g., Leiner Health Servs. Corp.; AT&T Corp.; MPL Communications*, FA 97086 and FA 97092; *Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000); and *Treeforms, Inc., all supra*.

It is eminently clear to this Panel, as stated previously, that Respondent, in choosing each of the disputed domain names that, at its essence, completely incorporates one of Complainant's REGISTER Marks and then prepending to it either a generic or a numeric term has been and is intentionally seeking to create confusingly similar names, each of which opportunistically exploits Internet user confusion by diverting, through re-direction and diversion, Internet users away from Complainant's site to Respondent's site for the latter's own pecuniary benefit. Specifically, those users would think they are purchasing Complainant's services through Respondent's site and, by doing so, generate profit to Respondent from those sales — to Complainant's ultimate financial detriment.

Moreover, this conclusion is reinforced by the sheer number of the disputed domain names registered, some of which were registered in spite of Respondent having received direct prior written notice from Complainant as to the latter's trademarks. The Panel has no doubt that Respondent, in

furtherance of rendering services identical to some of those provided by Complainant, registered each name in succession to incrementally heighten user confusion and thus, as an ensuing result, incrementally increase the amount of user traffic it diverted from Complainant's site.

Such parasitic use, which at its essence relies on instigating and exacerbating user confusion, can not and does not constitute bona fide commercial or fair use sufficient to legitimize any rights and interests Respondent might have in any of the disputed domain names. *See, e.g., Leiner Health Servs. Corp., supra and Frampton, supra.*

Respondent has repeatedly argued to the Panel that Complainant, in seeking transfer of the disputed domain names under the Policy, is essentially using the Policy as an instrumentality to monopolize all uses of the word “register” for use in any domain name. That argument, while often raised in numerous prior ICANN disputes to counter a complainant's transfer request, is both unpersuasive and rejected.

Page 1368

First, the Policy, through inclusion of a “bona fide” requirement within paragraph 4(c)(i):

“c. ... Any of the following circumstances, in particular but without limitation ... shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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 ...” [emphasis added]

clearly contemplates concurrent third-party use of trademark-containing domain names along with use of those same marks by their respective owners provided those domain names are used or are to be used (via a showing of demonstrable preparations) in conjunction with a “bona fide” offering of goods or services. In this context, the term “bona fide,” which is generally synonymous with “good faith” and in qualifying the term “offering,” implicates use, whether present or future, which, *inter alia*, is not likely to engender user confusion. Therefore, it is plainly evident that the Policy, parallel to most national trademark laws — of which US trademark law is clearly illustrative, does not proscribe all domain names that happen to contain a trademarked term, such as “register” or any other such term for that matter, but only those that are or would be used in any manner which is likely to cause confusion and hence conflict with activities of the trademark owner. Such a use is a competitive service offering — as Respondent's offering is here. The existence of such a conflict and its potential for confusion necessitates that any panel, as has the present Panel, examine the “bona fides” of any respondent in assessing whether, in fact, that respondent has rights and legitimate interests in a disputed domain name.

Second, the Policy, by expressly stating “but without limitation” has not restricted the grounds under

which any respondent can prove it has rights and legitimate interests to a domain name that includes a trademarked component. Paragraphs 4(c)(i)-(iii) simply provide three illustrative, though broad, bases. The respondent, to the extent it can assert and prove any other basis in support of its claim of rights and legitimate interests, can retain that domain name. However, Respondent here has not and is highly unlikely to ever have any such other basis.

In light of the above findings, the Panel is not persuaded that Respondent has any rights or legitimate interests or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in any of the disputed domain names under any provision of paragraph 4(c) of the Policy.

Thus, the Panel finds that Respondent has no rights or legitimate interests in any of the disputed domain names within paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

The Panel firmly believes that Respondent's actions constitute bad faith registration and use of all the disputed domain names.

As discussed above, it is absolutely inconceivable to this Panel that Respondent was unaware of Complainant's mark, either REGISTER or REGISTER.COM, when the former started registering its domain names in 1998 — some 3 years after the earliest date on which Complainant started using those marks.

[5] In fact, by virtue of offering Internet services directly competitive to those then being offered by Complainant through: (a) websites resolvable through domain names that incorporated Complainant's marks, and (b) website page design that copied significant portions of Complainant's website (i.e., to form a so-called "copy cat" site), Respondent's intention becomes inescapable: an on-going attempt to cause user confusion and, by doing so, misappropriate to itself a portion of the goodwill inherent in Complainant's REGISTER Marks for its own pecuniary gain. As discussed in the section above, that intention becomes all the more apparent, by virtue of Respondent's actions in registering not one single domain name that included the REGISTER Marks, but 21 of those names of which all are now disputed.

Further, in successively registering so many domain names, including registering some of those names in spite of having express prior written knowledge of Complainant's trademark rights, based on the record before the Panel, it is simply irrefutable that Respondent intended to cause and to opportunistically exploit escalating amounts of inevitable user confusion and diversion that would result from use of each additional one of the disputed domain names, and obviously achieve

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similarly increasing financial benefit there from. Such actions would yield, as their natural consequence, concomitantly escalating loss to Complainant not only in terms of revenue but also in terms of its goodwill and reputation. Thus, Respondent's conduct here regarding the disputed domain names directly contravenes paragraph 4(b)(iv) of the Policy. See *Cable News Network LP, LLP, supra*.

With Complainant having adduced sufficient evidence to substantiate its allegations of bad faith use and registration, the burden of going forward then shifted to Respondent to raise sufficient doubt and effectively rebut those allegations. Respondent has simply failed to meet its burden. Other than providing a declaration from Respondent Reile, which, given its self-serving nature, is necessarily met with skepticism, Respondent has provided no proof, let alone independent proof, to support its own contentions. In fact, the Panel doubts that such proof exists.

Therefore, the Panel views Respondents' actions as constituting bad faith use and registration in violation of paragraph 4(b)(iv) of the Policy.

Consequently, Respondent's conduct constitutes bad faith use under paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that Complainant 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.

DECISION

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by Complainant is hereby *GRANTED*.

Accordingly, the Panel orders that all the disputed domain names, specifically <101register.com>, <webpage-register.com>, <website-register.com>, <webpageregister.com>, <websiteregister.com>, <101register.net>, <101register.org>, <webpageregister.net>, <webpageregister.org>, <website-register.net>, <websiteregister.org>, <website-register.org>, <webpage-register.net>, <websiteregister.net>, <webpage-register.org>, <101register.info>, <webpageregister.info>, <webpage-register.info>, <websiteregister.info>, <website-register.info> and <website-register.biz>, are to be *TRANSFERRED* from Respondent to Complainant.

**- End of Case -
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