

Office of Personnel Management v. MS Technology Inc., 70 USPQ2d 1333 (NAF 2003)

**70 USPQ2D 1333**  
**Office of Personnel Management v. MS Technology Inc.**

**National Arbitration Forum**

**Claim No. FA0310000198898**  
**Decided December 9, 2003**

**Headnotes**

**TRADEMARKS AND UNFAIR TRADE PRACTICES**

**[1] Infringement; conflicts between marks — Defenses — Laches or limitations period (§335.1005)**

**JUDICIAL PRACTICE AND PROCEDURE**

**Procedure — Defenses — Laches (§410.1803)**

Equitable defense of laches is not available to respondent in proceeding for determination of rights in Internet domain name pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, since remedy sought by complainant in such proceeding is contractually based and specifically provided through Policy, to which respondent accedes upon entering into registration agreement and upon renewal of its registration; even if laches were available, complainant's delay in present case would not raise sufficient reliance interest in respondent to preclude complainant from securing its rights in disputed "usajobs.com" domain name,

since complainant's delay of 11 months in initiating proceeding was not unreasonable, and since respondent, having been aware of complainant's activities surrounding its "USAJOBS" trademark, acted at its own peril in registering, using, and renewing domain name.

Page 1334

## **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 name 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; to extent that respondent in ICANN proceeding wishes to challenge determination by U.S. Patent and Trademark Office that complainant's mark is registrable, respondent may file cancellation proceeding in PTO, or institute federal litigation.

## **TRADEMARKS AND UNFAIR TRADE PRACTICES**

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

Respondent's use of "usajobs.com" Internet domain name is likely to engender confusion among Internet users, since disputed domain name sufficiently resembles complainant's federally registered "USAJOBS" trademark to cause those Internet users intending to access complainant's "usajobs.opm.gov" Web site, but who instead reach respondent's site through disputed domain name, to falsely conclude that complainant and respondent are affiliated in some manner.

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

**Infringement; conflicts between marks — Willful (§335.11)**

Respondent has no rights or legitimate interests in disputed Internet domain name “usajobs.com,” since domain name incorporates complainant’s federally registered “USAJOBS” trademark, since complainant has never authorized respondent to use “USAJOBS” mark, or any mark confusingly similar thereto, in conjunction with specific services that complainant provides under mark, since complainant has no relationship or association whatsoever with respondent, since record indicates that respondent opportunistically adopted disputed domain name in order to exploit inevitable confusion resulting from use of Web address incorporating complainant's mark, since such “parasitic” use cannot and does not constitute bona fide commercial or fair use sufficient to legitimize any interest respondent may have in disputed domain name, and since respondent is not commonly known by disputed domain name.

**[5] Infringement; conflicts between marks — Willful (§335.11)**

Respondent's registration and use of disputed “usajobs.com” Internet domain name was undertaken in bad faith, since respondent has admitted that it was aware of complainant's federally registered “USAJOBS” trademark when it registered and subsequently renewed domain name, since respondent adopted domain name with intent to offer services very similar to, and effectively competitive with, those offered by complainant, since respondent established Web site resolvable by disputed domain name through which it offers those services, since respondent has blatantly copied and framed, onto its own site, considerable amount of content from complainant's “usajobs.opm.gov” Web site, and has deeply linked to portions of complainant's site without authorization, and since respondent derives revenue from users who visit its site.

**Case History and Disposition**

Complaint filed by U.S. Office of Personnel Management pursuant to Uniform Domain Name Dispute Resolution Policy of Internet Corporation for Assigned Names and Numbers, against respondent MS Technology Inc., a/k/a Mahendra Lamba. Complainant requests that Internet domain name “usajobs.com” be transferred from respondent to complainant. Granted.

**Attorneys:**

Susan G. Whitman, United States Office of Personnel Management, Washington, D.C., for complainant.

G. Carol Brani, of Womble Carlyle Sandridge & Rice, Charlotte, N.C., for respondent.

**Judge:**

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Before Michaelson, presiding panelist, and Yachnin and Hines, co-panelists.

**Opinion Text**

**Opinion By:**

Michaelson, panelist.

**PARTIES**

Complainant is *United States Office of Personnel Management*, Washington, DC (“Complainant”) represented by *Susan G. Whitman*, 1900 E Street N.W., Washington, DC 20415. Respondent is *MS Technology Inc. a/k/a Mahendra Lamba*, Charlotte, NC (“Respondent”) represented by *G. Carol Brani of Womble Carlyle Sandridge & Rice, PLLC*, 301 South College Street, Suite 3300, Charlotte, NC 28202-6025.

**REGISTRAR AND DISPUTED DOMAIN NAME**

The domain name at issue is *<usajobs.com>* registered with *Network Solutions. Inc.* (“NSI”).

**PANEL**

Each of 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 Presiding Panelist, and Hon. Ralph Yachnin (Ret) and Mr. P. Jay Hines, Esq. as Co-Panelists.

**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”).

The Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on September 30, 2003; the Forum received a hard copy of the Complaint, together with Annexes 1-25, on October 1, 2003.

On October 3, 2003, NSI confirmed by e-mail to the Forum that the domain name *<usajobs.com>*

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is registered with NSI and that the Respondent is the current registrant of the name. NSI has verified that the Respondent is bound by the NSI registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On October 6, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 27, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@usajobs.com by e-mail.

A Response, together with Annexes 1-2, was timely received by the Forum and determined to be complete on October 27, 2003.

Pursuant to Supplemental Rule 7, the Complainant timely filed an additional submission, together with its annex, by facsimile with the Forum on November 3, 2003.

On November 11, 2003, pursuant to the Respondent's request to have the dispute decided by a three-member panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Presiding Panelist and Hon. Ralph Yachnin (Ret.) and Mr. P. Jay Hines, Esq. as Co-Panelists and set a due date of November 25, 2003 to receive the decision from the Panel.

On November 24, 2003 and owing to unforeseen and exceptional circumstances, the Panel extended the due date for the decision by two weeks to December 9, 2003.

## **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

#### **1. Confusing similarity/identity**

The Complainant states that the disputed domain name <usajobs.com> incorporates the

Page 1336

Complainant's registered and common law mark "USAJOBS" in its entirety and thus is identical to the mark.

Hence, the Complainant concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

## 2. Rights and legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

First and with respect to paragraph 4(c)(i) of the Policy (lack of use of the name in connection with a bona fide offering of services prior to receiving notice of the dispute), the Complaint makes the following allegations.

The Respondent's <*usajobs.com*> web site offers essentially the same services as the Complainant's web site while displaying the Complainant's mark, and therefore cannot support a finding of bona fide offering of goods or services. The Complainant developed, implemented and sponsors the official Federal job search and recruitment web site known as "USAJOBS", which provides employment information and application assistance. The Respondent's web site similarly provides a database of Federal Government employment information. Since the Respondent web site offers the same services as the Complainant and displays the Complainant's "USAJOBS" mark, the Respondent's use of the domain is not in connection with a bona fide offering of goods or services.

Further, although the Respondent's web site purports to provide access to a forum from which paying non-Federal employers may view resumes, that forum provides no access to any employment information unless an individual first submits private, personal, identifying information and a resume, effectively relinquishing his or her privacy rights. Upon relinquishing those rights, third parties may access and use the private information so entered to distribute unsolicited messages. (See Comp. Annex 14 at p 3 for a copy of the Respondent's Privacy Statement posted to its <*usajobs.com*> web site). Hence, the Complainant alleges that the Respondent is using the private, personal identifying information it gathers for those who access its site to capitalize on those users who are attempting to reach the Complainant's web site but reach the Respondent's site instead. Hence, the Complainant concludes that the Respondent's use of the disputed domain name in this fashion does not and cannot constitute a legitimate or bona fide service.

Moreover, the Complainant contends, with citation to *Seymour v. Burgar d/b/a Stephanie Seymour Club*, FA 97112 (Nat. Arb. Forum May 29, 2001), that when a web site serves primarily as a portal to promote other web sites or services, that use evidences no bona fide authorized offering of goods and services whatsoever and does nothing but misappropriate a complainant's trademark in order to lure Internet users to respondent's commercial site. In that regard, the Complainant states that the Respondent's web site acts primarily as a portal to the Complainant's Federal employment information but with express notice that the Respondent owns copyright rights to the data —data that was compiled by the Complainant and then used by the Respondent. The Complainant notes, by pointing to third-party e-mail correspondence copied in Comp. Annex 17, that the Respondent's web site has resulted in confusion and has generated complaints by users.

The Complainant is well-known as the Federal Government's employment agency which assists

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U.S. Government agencies in recruiting, examining, training and promoting individuals in accordance with the laws imposed by Congress. In an effort to reach the general population, the Complainant has engaged in substantial advertising of "USAJOBS." Copies of a small sample of such advertisements appear in Comp. Annex 5. Consequently and as evidenced by these and other such advertisements, the Complainant's actions have established a high-quality, well-regarded web site that is recognized by the media (see Comp. Annex 6 for various media articles). Hence, the Complainant contends that the Respondent attempted to capitalize on this reputation, until immediately following the Complainant's objection, through which the Complainant specifically stated that it was the Federal Government's official "one-stop" source for Federal jobs and employment information. (See Comp. Annex 15 for copies of the Respondent's home page).

The Complainant further alleges that the Respondent's continued use of the Complainant's mark for no apparent reason other than to usurp the goodwill, security and reputation of the Federal Government for profit adversely affects the general public's perception

Page 1337

and confidence in the Complainant's ability to perform its statutory duties and responsibilities. The Complainant concludes, citing to *Wells Fargo & Co. v. Seventh Summit Ventures*, FA 155463 (Nat. Arb. Forum June 10, 2003) (respondent makes opportunistic use of complainant's mark in order to capitalize on the good will and fame associated with the WELLS FARGO moniker), that such a use is not bona fide.

Second and with respect to paragraph 4(c)(ii) of the Policy (respondent is not commonly known by disputed domain name nor has acquired any trademark or service mark rights in the disputed domain name), the Complainant makes the following allegations.

The Respondent is not commonly known by the disputed domain name. Nothing in the <usajobs.com> WHOIS registry information implies that the Respondent is commonly known by the disputed domain name. To support its view, the Complainant cites to *Am. Express Co. v. (This Domain is For Sale) Joshuathan Invs., Inc.*, FA 154647 (Nat. Arb. Forum June 3, 2003) where an ICANN panel found that WHOIS registration is a factor in determining that a registrant is not commonly known by a domain name for purposes of paragraph 4(c)(ii). Furthermore, the Complainant avers that the disputed domain name does not indicate to the public, whether by initials, acronym, trade-name or otherwise, the Respondent's business. In addition, the Respondent has not acquired any trademark or service mark rights in the disputed domain name. Moreover, the Complainant states that the Respondent's use of that name or the Complainant's mark "USAJOBS" is unauthorized. Neither the Respondent nor any component of the Respondent's company has applied for a license or permission from the Complainant to use the mark "USAJOBS".

Lastly and with respect to paragraph 4(c)(iii) of the Policy (legitimate non-commercial or fair use of

the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the mark at issue), the Complainant alleges as follows.

The Respondent's use of the domain name is neither legitimate nor fair. In that regard, the Complainant states that under the "fair use" doctrine, use of words for descriptive purposes is permitted even if the words themselves also constitute a trademark. See, *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 307 [23 USPQ2d 1534] (9th Cir. 1992). However, the narrow fair use exception allows usage of a trademark as a domain name "only when a non-trademark use is made, that does not depend for its value on the existence of the trademark." *United States Dep't of the Navy NAVSEA v. NAVYWEB*, FA 105977 (Nat. Arb. Forum May 21, 2002).

The Complainant alleges that use of <usajobs.com> is not merely descriptive; rather, it depends for its value on the existence of the Complainant's mark "USAJOBS". Internet users seeking the Complainant's web site accessible at <usajobs.opm.gov> are likely to enter <usajobs.com> into their browser simply because the latter domain name is formed of the Complainant's "USAJOBS" mark followed by the most common URL suffix ".com." See *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 493 [53 USPQ2d 1570] (2d Cir. 2000), *cert. denied*, 530 U.S. 1262 (2000) ("For consumers to buy things or gather information on the Internet, they need an easy way to find particular companies or brand names. The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com").

Furthermore, the Complainant alleges that the Respondent's use of <usajobs.com> is not a "legitimate noncommercial" use. In that regard, the Complainant states that the Respondent generates revenue from the web site. (See Comp. Annex 20 for a copy of a letter dated July 10, 2003 from the Respondent's Counsel to the Complainant's Counsel which states in pertinent part "My client is currently producing revenue from the web site USAJOBS.COM."). An unauthorized use of a trademark in a domain name to sell products branded under that trademark is not a legitimate interest, citing to *Gillette Co. v. Haynes*, FA 155904 (Nat. Arb. Forum June 4, 2003) (finding that use of the trademark domain name does not represent a legitimate noncommercial or fair use because respondent is using the domain name to sell complainant's goods without authorization.). Furthermore, the use of a domain name to confuse and divert Internet traffic is also not a legitimate use of that domain name, citing to *Vapor Blast Mfg. Co. v. R & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001); *see also Ticketmaster Corp. v. DiscoverNet, Inc.*, D2001-0252 (WIPO Apr. 9, 2001) (finding no rights or legitimate interests

where respondent generated commercial gain by intentionally and misleadingly diverting users away from complainant's site to a competing web site).

The Complainant further contends that prior to voicing its objection over use of the disputed domain

name to the Respondent, the Respondent, through use of the name, exhibited an intent to pass itself off to interested persons as the official web site of the Complainant, and to reverse pass off the Complainant's employment information services as that of the Respondent despite the fact that the Respondent is in no way affiliated with or authorized by the Complainant to use the Complainant's mark or the Complainant's information. Even after the Respondent eliminated its express claim that its web site was the official site of the Complainant, the services which the Respondent then offered through its site continue to be, in fact, the Complainant's own job information services, misleadingly identified as being subject to copyright by the Respondent. Hence, the Complainant concludes that the passing off of the Complainant's services as being offered by the Respondent, through its *<usajobs.com>* web site is not legitimate or fair, citing to *Toronto-Dominion Bank v. Karpachev*, 188 F.Supp.2d 110, 114 (D. Mass. 2002) (because respondent's sole purpose in selecting the domain names was to cause confusion with complainant's web site and marks, its use of the names was not legitimate or fair use).

Moreover, the Complainant opines that even if the Respondent's web site offered legitimate services, such as an employment information forum separate and apart from the Federal employment information, nonetheless the Respondent's use of the disputed domain name for commercial gain by misleadingly diverting consumers, who seek to reach the Complainant's site through use of its mark "USAJOBS", away from the Complainant's site and to the Respondent's site is neither a legitimate noncommercial nor a fair use of the mark.

### **3. Bad faith use and registration**

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of the Policy.

First and with respect to paragraph 4(b)(iii) of the Policy (registration of the disputed domain name primarily to disrupt the business of a competitor), the Complaint alleges as follows.

The Complainant contends that, through the Respondent's *<usajobs.com>* web site, the Respondent disrupts the Complainant's ability to accomplish its Congressionally mandated mission by diverting traffic intended for the official "USAJOBS" site. Bad faith intent to divert traffic has been presumed in cases where a respondent and a complainant were in the same line of business in the same market area, citing to *Lubbock Radio Paging v. Venture Tele-Messaging*, FA 96102 (Nat. Arb. Forum Dec. 23, 2000). Diversion of traffic can be in bad faith even where, as here, the Complainant's use of its mark is not-for-profit, with reference to *United States of Am. Dep't of the Navy NAVSEA v. NAVYWEB*, FA 105977 (Nat. Arb. Forum May 21, 2002) (Neither trademark law nor ICANN Policy or Rules require a use to be for-profit to be protected).

Furthermore, the Complainant contends that the Respondent uses the disputed domain name to offer the same business that the Complainant offers through its official *<usajobs.opm.gov>* web site. Because the business the Respondent offers through the disputed domain name confusingly overlaps with the service the Complainant offers, Internet users are likely to conclude that the disputed domain

name was endorsed by the Complainant, when it is not. As a result, the Respondent's use of that name interferes with the Complainant's mission, as dictated by Congress, by diverting traffic otherwise intended for the Complainant's official site.

Second and with respect to paragraph 4(b)(iv) of the Policy (use of the disputed domain name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant's mark), the Complaint alleges as follows.

“Where an alleged infringer chooses a mark he knows to be similar to another, one can infer an intent to confuse.” *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 [61 USPQ2d 1705] (9th Cir. 2002); see also *Treforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000). In that regard, the Complainant contends that the Respondent registered the disputed domain name in order to intentionally confuse Internet users seeking federal job information services

Page 1339

and, in so doing, caused confusion (see Comp. Annexes 17 and 18 — the latter being a copy of the results of a Google™ search dated July 15, 2003 that show other official sites linking through to the Respondent's site, ostensibly, as the Complainant infers, thinking their sites were linking to the Complainant's site instead).

At the time the Respondent registered the disputed domain name, the Complainant's <usajobs.opm.gov>site was successfully servicing millions of individuals seeking Federal employment information. As the Respondent's web site operates in the same field or industry as the Complainant's site, the Respondent must have been actually or constructively aware of the existence of the <usajobs.opm.-gov> web site, and must reasonably have known of the Complainant's prior use of its <usajobs.opm.gov>site and its “USAJOBS” mark. In that regard, the Complainant cites to *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding that a domain name so obviously connected with the Complainant and its products that its very use by someone with no connection with the Complainant suggests opportunistic bad faith) and *Digi Int'l Inc. v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (finding a legal presumption of bad faith when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively).

Further, the Complainant contends that the Respondent's actions evidence a bad faith attempt to confuse users. Factors which have been found to indicate bad faith include: (i) use of a complainant's logo; (ii) framing of a complainant's content; (iii) giving a description of services that are consistent with a complainant's activities but not the respondent's activities; and (iv) advertising the respondent's services. *British Broadcasting Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000). While a disclaimer on a web site may prevent user confusion as to sponsorship, the lack of such a disclaimer is further evidence of bad faith. See *Hunter Fan Co. v. MSS*, FA 98067 (Nat. Arb. Forum Aug. 23, 2001). With reference to the present dispute, the Respondent's web site here: (i) uses the Complainant's

“USAJOBS” mark and seamlessly links to the Complainant's web site and its logo; (ii) appropriates and displays the Complainant's content; (iii) gives a description of services that are consistent with the Complainant's services but are not the Respondent's services; and (iv) includes advertising. Moreover, the Complainant states that the Respondent's site does not display any disclaimer to the effect that its web site is not affiliated with the Federal government.

## **B. Respondent**

### **1. Threshold Issues**

#### **a. Laches**

The Respondent contends that the Complainant made no effort to protect its trademark rights prior to January of 2003. Specifically, the Respondent states that the Complainant admitted that it has been aware of Respondent's web site since at least 1999 (as indicated on page 4 of the Complaint). Yet not until January 2003 did the Complainant obtain a federal trademark registration for the term “USAJOBS”. The Respondent further states that, by the Complainant's own admission, the Complainant delayed almost four years from the time the Respondent's <usajobs.com> web site became active before contacting the Respondent on or around July 2, 2003 and asserting that the Respondent's conduct infringed Complainant's trademark rights.

#### **b. Invalidity of the Complainant's mark and inappropriate forum**

The Respondent contends that Complainant's mark “USAJOBS” is invalid and should not have received federal registration because “USAJOBS” is a descriptive term and is not distinctive. Given this, the Respondent views the nature of the present dispute to be a trademark infringement dispute which is more appropriate to the courts than to an ICANN panel operating under the Policy, and moreover believes that the Complainant cannot satisfy the three elements necessary to prevail under the Policy.

### **2. Policy Elements**

#### **a. Confusing similarity/identity**

Here, the Respondent contends that the disputed domain name is neither identical nor confusingly similar to a mark in which the Complainant has any rights.

In essence, the Respondent alleges that the Complainant's mark is a descriptive term that

is neither distinctive nor has any secondary meaning; hence the Complainant has no valid rights in its mark sufficient to invoke paragraph 4(a)(i) of the Policy.

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Furthermore and alternatively, the Respondent alleges that the disputed domain name, <usajobs.com>, is not “confusingly similar” to Complainant's mark. Specifically, the Respondent states, that practically speaking, “the vast majority of Internet job seekers are well aware that official government web sites have a dot-gov extension and, conversely, that government web sites do not have a dot-com extension” (see Resp. Annex 2 for a copy of Affidavit of Mr. Mahendra Lamba, President of Respondent corporation and henceforth the “Lamba affidavit”). Hence, the Respondent opines that job-seeking Internet users know that they do not access an official government web site whenever they enter a dot-com Internet address. Moreover, the Respondent points to the fact that the a job seeker running a Google™ search for “USAJOBS”, would obtain results, as the Complainant did, in which the Complainant's official web site is listed as a first entry. Given that the Respondent states that “It is reasonable to assume that most users utilizing the world's predominant search engine will select its first result.” Hence, the Respondent concludes that the Complainant has failed to prove that the disputed domain name is either identical or confusingly similar to an enforceable mark in which the Complainant has any rights.

### b. Rights and legitimate interests

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

With respect to the paragraph 4(c)(i) (demonstrable preparations to use the name, in connection with a bona fide offering of goods or services, the name prior to notice of the dispute), the Respondent states that, for four years prior to any notice of a dispute with the Complainant, it used <usajobs.com> in connection with a bona fide offering of employment and recruitment services. Specifically, the Respondent contends that the Complainant's annexed version of the Respondent's <usajobs.com> web site shows that the Respondent, through that site, offers bona fide employment and recruiting services.

Regarding paragraph 4(c)(ii) (commonly known by the domain name regardless of not having acquired any trademark or service mark rights), the Respondent contends that it has diligently worked to develop repeat and referral business resulting in good will associated with the domain name in dispute. Specifically, the Respondent states, in paragraph 8 of the Lamba affidavit:

“That, since 1999, my company has invested substantial resources in developing its reputation and goodwill associated with the domain name ‘USAJOBS.com’. Although I have resided in the United States for a few decades, I have countless contacts, as well as several business interests in India. Because of my Indian contacts and business interests, and since both goodwill and reputation travel across international borders, my company's services are commonly known by the domain name, USAJOBS.com. Moreover, my company's value is significantly greater than the fee for registering a domain name.”

Ultimately, the Respondent disputes that the Complainant's rights in its trademark have priority over the Respondent's rights. The Respondent takes the position that the Complainant's trademark should not

have received federal registration inasmuch as the term "USAJOBS" is a common descriptive name with substantial third party use. The Respondent contends that that name is neither an invented mark nor is it an inherently distinctive word; it has no secondary meaning. Hence, the Respondent concludes that it has rights and legitimate interests in the disputed domain name because it has invested four years of effort into developing a successful business trading at the <usajobs.com> address.

### **c. Bad faith**

The Respondent contends that it did not register and use the disputed domain name in bad faith.

Specifically, the Respondent states, with references (though here omitted for simplicity) made to the Lamba affidavit, as follows.

The Respondent is a privately-held corporation involved in an array of legitimate businesses. Respondent Lamba has a vast network of connections in the tech-savvy Indian community here and abroad. In 1997, Respondent Lamba's awareness of foreign nationals' interest in obtaining employment in the United States prompted him to purchase the disputed domain name in order to implement his business

Page 1341

model: the promotion of federal and private sector employment opportunities in the United States. Respondent Lamba focused on other business interests between 1997 and 1999; however, since late 1999, Respondent has operated a bona fide employment and recruitment service targeted toward, but not limited to, the international community. Since that time, and consistent with Respondent Lamba's legitimate business model, USAJOBS.com has developed substantial goodwill, generating repeat and referral business. At least one panel has described the "bad faith registration" element as follows.

The Respondent, citing to *Rusconi Editore v. Bestinfo*, D2001-0656 (WIPO July 5, 2001) and *Ode v. Intership Ltd.*, D2001-0074 (WIPO May 1, 2001), contends that for an allegation of bad faith registration and use of a domain name to succeed, the Complainant must show at the very least that when the Respondent registered the name, the Respondent was (or was likely to have been) aware of the existence of the Complainant or, more particularly, the Complainant's rights in respect of the trade mark in question.

Given this, the Respondent states that, in order to develop its employment and recruiting services business, it registered a descriptive domain name that fit his business model to attract foreign job seekers seeking employment in the U.S. and to connect them with jobs available in the U.S. The Respondent acknowledges that, at the time it purchased the disputed domain name, it was aware that the Complainant offered information regarding federal government jobs at an official government web site: <usajobs.opm.gov>. Nonetheless, prior to registering the <usajobs.com> web site in 1997, the Respondent researched and verified to itself that there was no federal trademark registration that might

impinge on the value of the domain name now in dispute.

The Respondent contends that it defies common sense for the Complainant to assert that the Respondent registered <usajobs.com> in bad faith when the Complainant has provided not one iota of evidence that it had any relevant trademark rights at the time the Respondent registered that name. Hence, the Complainant failed to show bad faith registration.

Furthermore, the Respondent contends that it has not used the disputed domain name in bad faith. To that end, the Respondent states that it has never offered to sell the disputed domain name nor is that name currently for sale.

Also, the Respondent stated that it intended to establish its employment and recruitment site immediately following registration, but other business concerns delayed its doing so. Nonetheless, delay alone does not support a finding of bad faith use. As soon as Respondent Lamba's other business interests permitted, he established the <usajobs.com> site consistent with his goals at the time of registration. In that regard, Respondent Lamba contends that he is not required to immediately take his web site live in order to support a contention of good faith. Respondent Lamba acted consistently with his business goals, did not ever try to sell his registration and worked hard to build a business associated with <usajobs.com>. His business was not about diverting Internet users from the Complainant's official government site. It was about capitalizing on a descriptive term, i.e., "USAJOBS", logically where a job seeker might expect to find information regarding employment in the United States. The Complainant's mark was and is neither strong or famous. Hence, the Respondent concludes that the Complainant has failed to show bad faith use.

## C. Complainant's Additional Submission

Through its additional submission, which the Panel has fully considered, the Complainant rebuts various contentions set forth in the Response.

### 1. Threshold Issues

#### a. Laches

First, the Complainant states that, contrary to the Respondent's view, the Complainant did not wait until 2003 to seek its trademark registration. Rather the Complainant filed its federal trademark application in February 1999 and vigorously prosecuted the application until the Complainant successfully obtained its registration in January 2003. (See Comp. Annex 9). Furthermore, the Complainant states that the date of its trademark registration is irrelevant, inasmuch as its mark "USAJOBS" was well-known and distinctive and has been used in commerce since 1996 — which is prior to the date on which Respondent registered the disputed domain name.

As to laches, the Complainant notes that ICANN panels have rejected the use of laches

under the Policy as long as the three elements of the Policy are met, citing to *E.W. Scripps Co. v. Sinologic Indus.*, D2003-0447 (WIPO July 1, 2003) (“If the requirements of a valid complaint under the Policy are established, the Policy does not provide any defense of laches.”). Furthermore, the Complainant notes that the laches defense was analyzed and rejected in *Hebrew Univ. of Jerusalem v. Alberta Hot Rods*, D2002-0616 (WIPO Oct. 7, 2002). There, the Panel indicated that laches is an equitable remedy which requires: (1) “unreasonable” delay in the commencement of proceedings, and (2) that delay must render the grant of relief unjust. In *Hebrew University*, the panel found that a complaint brought pursuant to the Policy gives rise to a contractual, not an equitable, remedy. Hence, the issue to be determined is whether the grounds set out in the Policy for transfer or cancellation have been established. There is no limitation period in the Policy; hence, the defense of laches has no application.

Furthermore, even if laches were available to the Respondent, the facts necessary for such a finding are not present in this matter. In *Miller Brewing Co. v. Miller Family*, FA 104177 (Nat. Arb. Forum Apr. 15, 2002), a domain name was transferred although the complaint was brought five years after the complainant actually became aware of the disputed domain name. The delay in filing the complaint was not unreasonable, because the respondent there had substantially changed its site during that period to make it more objectionable.

Similarly, in the present matter, although the Complainant became aware of the disputed domain name registration in 1999, as noted in the Complaint, the web site was merely a “placeholder” at the time. It was not until recently that the Complainant became aware that the Respondent had begun framing the Complainant's site, making explicit claims to be the official USAJOBS web site, and otherwise trying to divert traffic from the official site. These actions, which were brought to the Complainant's attention by members of the public who were actually confused by the Respondent's site, led to the Complainant's decision to file the Complaint.

## b. Invalidity of Complainant's mark

Further, while the Respondent attacks the Complainant's trademark as invalid, it has provided no factual evidence that would support its allegation that the mark is not distinctive. A Federally registered trademark is presumed to be valid in a UDRP proceeding. See *LTD Commodities Inc. v. Costnet*, D2002-0031 (WIPO May 2, 2002); see also *Amazon.-com, Inc. v. Rayaneh Net*, FA 196217 (Nat. Arb. Forum Oct. 28, 2003) (registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive; respondent has the burden of refuting this assumption). The Respondent has done nothing to rebut this presumption. Whether or not the Complainant's trademark was appropriately granted by the USPTO is therefore not at issue in this proceeding. At issue is the fact that the Complaint has shown that the Respondent's registration and use of the disputed domain name *<usajobs.com>* satisfies all three of the elements necessary for the

Complainant to prevail under the Policy.

The Respondent asserts that “the vast majority” of Internet job seekers are aware that Government web sites have a .gov rather than a .com extension. The Respondent's sole support is the Lamba affidavit, which does not constitute evidence regarding the vast majority of any population but rather speaks of Respondent Lamba's own personal experience. The Complainant disputes the Respondent's unfounded assumption that the public at large is sufficiently sophisticated in Internet usage ostensibly, as understood by the Panel, to such a point that a difference in the gTLD will ameliorate any likely user confusion. The Complainant points to Comp. Annex 17 which shows that confusion among members of the public has actually occurred among reasonably prudent Internet users.

## 2. Policy Elements

### a. Identity/confusing similarity

Additionally, the Complainant points out that the Policy requires that the disputed domain name be identical or confusingly similar to the registered mark. Hence, the Respondent's arguments regarding consumer confusion are irrelevant because the disputed domain name is identical to the Complainant's registered mark “USAJOBS”. Therefore, Complainant has satisfied the first element of the Policy.

Page 1343

### b. Rights and legitimate interests

Regarding the Respondent's assertion that it has rights in <usajobs.com> because it engaged in a bona fide service since 1999 and prior to notice of the present dispute, the Complainant states that the Respondent is ignoring its actions of framing and deep linking, together with incorporation of the <usajobs.-opm.gov> logo, expressly and falsely asserting at the bottom of the <usajobs.com> web site that: “This is a United States Office of Personnel Management web site. USAJOBS is the Federal Government's official one-stop source for Federal jobs and employment information.” See Complaint at page 4; and Comp. Annex 15 (hard copy printout of frame at bottom of page 2; and which in general provides a hard-copy of a download of the Respondent's site as that site existed in June 2003). These are hardly the characteristics of a bona fide service — rather, they show that the Respondent was attempting to capitalize on the goodwill associated with the Complainant's “USAJOBS” mark for the Respondent's own financial gain.

Alternatively, the Respondent contends that it has been commonly known by the disputed domain name <usajobs.com>, and therefore it has legitimate rights and interests in the domain name. The Respondent bases this argument on Respondent Lamba's statements, in his affidavit, through which he claims that “substantial resources” have been invested in popularizing <usajobs.com> in India, and as a

result the web site is commonly known as <usajobs.com> in that country. The Complainant asserts that paragraph 4(c)(ii) of the Policy states that rights or legitimate interests may be established by showing that: “you (as an individual, business, or other organization) have been commonly known by the domain name...”. Given this, the Complainant contends that neither the individual (Respondent Lamba) or the business (Respondent MS Technology, Inc.) involved here are known as “USAJOBS.com”. The Respondent's argument is that its service (i.e., its web site at <usajobs.com>) is commonly known as “USAJOBS.com”; however, this knowledge of the site itself — which obviously applies for all cases under the Policy involving disputed domain names — does not suffice under paragraph 4(c)(ii).

### **c. Bad faith**

With respect to the Respondent's bad faith registration of the disputed domain name, Respondent Lamba expressly admits (see paragraph 4 of the Lamba affidavit) that he was aware, prior to registering that name, that “an agency of the United States government maintained and managed a web site with a dot opm dot-gov extension” and that he searched federally registered trademarks prior to registration and did not find a registration or pending registration for the “USAJOBS” mark. The Complainant states that it is a fundamental principle of trademark law that it is not necessary to have a federal registration to have rights in a mark.

Moreover, the Complainant states that the Respondent does not contest that the Complainant used the mark “USAJOBS” first, and indeed expressly admits actual knowledge of the Complainant's use of the mark. As a result, the Complainant states that it maintains common law rights as of both the date of the Respondent's registration (1997) of the disputed domain name and its first use of that name (1999). Respondent Lamba's admitted awareness of the <usajobs.opm.gov> site prior to his domain registration is evidence that the mark “USAJOBS” had become distinctive and achieved secondary meaning at the time that the Respondent registered the name. The Complainant further states that beyond Respondent Lamba's admitted awareness of the <usajobs.opm.gov> site, it has also provided ample evidence of the distinctiveness of the mark and web site “USAJOBS”, including publicity of the site's rollout in 1996 (Comp. Annex 2), the numbers of OPM webpage visits (Comp. Annex 3), marketing pieces (Comp. Annex 5), and unsolicited media reports (Comp. Annex 6). Therefore, the Complainant contends that the Respondent's registration of the name while it admittedly knew of the existence of the Complainant's distinctive trademark is proof of the Respondent's bad faith registration.

As to the Respondent's bad faith use, the Complainant first points to the original format of the web site which blatantly claimed to be the official United States Office of Personnel Management web site and implemented confusing and unfair framing and linking to <usajobs.opm.gov>. These undisputed facts clearly show that the Respondent was trying to confuse or divert Internet traffic seeking the Complainant's

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official site. The Complainant also states that the Respondent's site displays a variety of marketing advertisements, presumably generating a profit for the Respondent. Moreover, the Respondent's site collects personally identifying information, which the Respondent plainly states may be collected and used by others, and which may result in unsolicited messages from third parties. (See Comp. Annex 14 at p 3.)

The Complainant strongly disputes the Respondent's contention that the Respondent's site at <usajobs.com> provides legitimate services for foreign nationals seeking Federal jobs, i.e., merely implementing a business model of promoting to foreign nationals Federal and private sector employment opportunities in the United States. Specifically, the Complainant states that it would make no sense to advertise Federal job openings to foreign nationals, Indian or otherwise. Almost without exception, Federal employment is limited to United States citizens. See, generally, Executive Order 11935, President Gerald Ford, 41 Fed. Reg. 37301, September 3, 1976. The Complainant posts content on citizenship requirements available within USAJOBS. See <http://www.usajobs.opm.gov/ei9.asp>. The <usajobs.opm.gov> web site offers job searching in overseas locations because the United States government employs people all over the world. However, the USAJOBS web site for the most part does not seek applications from foreign nationals. Even when a few jobs are open to non-citizens, they are typically not posted on the <usajobs.opm.gov> database because agencies recruiting for these jobs are not interested in publicizing them beyond the local geographic area. By simply framing and linking to the Complainant's entire database, the scope of the Respondent's web site is too broad to support any potentially legitimate focus on providing information regarding a limited number of Federal job opportunities for foreign nationals.

Lastly, the Complainant disputes the Respondent's argument that that latter uses the name <usajobs.com> because the term describes its services, i.e., jobs in the United States for foreign nationals. The Complainant states that while the Respondent's <usajobs.-com> site does provide listings of jobs in the United States, it also contains listings in various other countries, including Canada, the United Kingdom and India. See, Comp. Add. Sub. Annex 26 (providing a sample of six job listings in various countries obtained from <usajobs.com>). The Respondent's supposed good faith reason for using the name <usajobs.com> – that it accurately describes the Respondent's services – simply does not hold up to scrutiny. Rather, the only conceivable reason the Respondent could be using <usajobs.com> is to profit from the goodwill associated with the Complainant's web site, which clearly constitutes bad faith use.

## FINDINGS

A copy of the InterNIC and NSI WHOIS registration records for the disputed domain name appear in Comp. Annexes 10 and 11, respectively. These records collectively indicate that the Respondent registered the <usajobs.com> domain name on November 7, 1997 with NSI. The Respondent has since renewed its registration, with NSI, on October 18, 2002.

## A. The Complainant's "USAJOBS" mark

The Complainant owns a federal service mark registration for the term "USAJOBS" and has provided, in Comp. Annex 9, a copy of the federal registration, as issued by the United States Patent and Trademark Office ("USPTO"), for that mark. The pertinent details are as follows:

USAJOBS (block letter)

US registration 2,675,991; registered January 21, 2003

This mark was registered for use in connection with: "providing worldwide United States Federal job vacancy announcements and information, Federal employment fact sheets, and Federal job applications and forms via a global computer network" in international class 35. This mark claims a first use and first use in commerce date of September 30, 1996. The mark was registered based on acquired distinctiveness under Lanham Act §2(f).

## B. The Parties' Activities

The Complainant, the United States Office of Personnel Management ("OPM"), is a Federal executive agency vested by Congress with authority to ensure compliance with personnel laws and regulations that govern Federal

Page 1345

employees. 5 U.S.C. §1101 *et seq.* The Complainant assists US Government agencies in recruiting, examining, training and promoting people on the basis of their knowledge and skills, regardless of their race, religion, sex, political influence or other non-merit factors. Further, OPM provides guidance to agencies in operating human resources programs which effectively support their missions and provides an array of personnel services to applicants and employees.

In furtherance of its statutory mission, the OPM Human Resources Products & Services Division, Center for Talent Services, has developed, implemented and hosts a Federal job search and recruitment Internet web site known as "USAJOBS". USAJOBS is the Federal Government's official one-stop source for Federal jobs and employment information. Official vacancy announcements and other recruitment tools are available to the public without cost. USAJOBS is located on an Internet web site at <www.usajobs.opm.gov>.

The <usajobs.opm.gov> web site was officially announced by a news release dated September 13, 1996, and was unveiled on September 16, 1996 (see copy of OPM News Release provided in Comp. Annex 2). During the last three months of 1996, the <usajobs.opm.gov> web site received approximately 22,000 visits from individually identifiable IP addresses (with all visitors behind a single fire wall counting as a single visitor), performed approximately 70,000 searches and pulled over a hundred thousand files (or "hits") or search results. During 1997, the volume of use increased to approximately 3.8 million visitors performing approximately 11 million searches of Federal job data and

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resulting in approximately 149 million hits. By the end of 1999, approximately 13 million visitors performed over 43 million searches resulting in approximately 653 million hits. As of 2002, a newly added e-mail feature resulted in over 18 million e-mails of employment information and in addition, approximately 10 million visitors performing in excess of 113 million searches, resulting in over one billion hits (see Comp. Annex 3). A current Google™ search (a hard-copy printout appearing in Comp. Annex 4) yields <usajobs.opm.gov> as the first hit.

The Complainant's world-wide Federal employment information program has been a multi-million dollar program since it was initiated. Funding sources include appropriations from Congress and annual fees assessed from every competitive service agency in the Executive Branch of the United States Government. The "USAJOBS" program distributes advertising publications and thousands of pieces of outreach materials (copies of samples of which appear in Comp. Annex 5) each year to diversity organizations, colleges and universities, and other special interest groups. USAJOBS supports multiple career fairs for college and university career services offices, Congressional offices, and other organizations supporting promotion of Federal employment. Organizations including colleges and universities, diversity-related organizations, and local and state governments have links to USAJOBS on their web sites. USAJOBS has been the subject of a variety of unsolicited media coverage, as illustrated by the various materials appearing in Comp. Annex 6.

USAJOBS has been selected to be part of the "Recruitment One-Stop" e-Gov initiative in support of President Bush's Management Agenda. (See Comp. Annex 7) As a result, on August 4, 2003, USAJOBS rolled out its next generation USAJOBS system, which, as shown on the web pages provided in Comp. Annex 8, is focused on the job seeker and provides enhanced search capability, resume mining, one application process, one resume builder for all Federal jobs and applicant tracking, all hosted on a commercial platform.

As of approximately October 1999, the Respondent's web site at <usajobs.com> did not include substantive content. Until at least that date, the <usajobs.com> web page consisted, as reflected on the hard-copy web page provided in Comp. Annex 12, of a message stating "*USAJobs.com will be launching soon*" together with a note indicating an intention to establish a worldwide employment site, and encouraging companies and recruiters to contact marketing personnel for future posting and advertising opportunities. The home page as modified in July 2003, a copy of which appears in Comp. Annex 13, states that the web site has only been "running for more than 3 years."

During the period October 1999 to July 2003, the Respondent's web site provided a database of Federal Government jobs and employment information that has a very similar look and feel to the <usajobs.opm.gov> official site. Indeed, the Respondent's web site,

Page 1346

<usajobs.com>, expressly claimed, as shown on the web page printouts and on an enclosed CD

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provided in Comp. Annex 15, that it was the United States Office of Personnel Management web site, the Government's official "one-stop" source for Federal jobs and employment information, when in fact it was not. As indicated in the web page printouts provided in Comp. Annex 13, the Respondent displayed the Complainant's substantive content as its own, as modified with a "search and replace" function that removed the Complainant's URL and replaced it with the Respondent's URL. The URL substitution interfered with (and effectively terminated) an application process for any of the job vacancy announcements in the database that were connected to an automated staffing system. This occurred because the section of the vacancy announcement labeled "How to Apply" contained directions that were impossible to follow when the URL had been substituted. *Id.* at pages 11-12. Furthermore and as indicated in pages 1, 8 and 18 of Comp. Annex 13, the Respondent appended a copyright notice to the Complainant's vacancy announcements claiming ownership of the text as its own.

The Respondent's web site generated confusion among interested parties. As shown in Comp. Annex 18, a Google™ search for the web site "www.usajobs.com" revealed a series of "web pages that link to" <usajobs.com>. This seven page list of entities that linked to <usajobs.com> includes a significant number of official Federal, State, university and other entities such as the U.S. Fish and Wildlife Service, the U.S. Department of Energy, and even the Honorable Congressman John McHugh (23d Dist. New York) that are likely to have linked to the site in error, intending to have linked to the official OPM web site. The Complainant has since taken steps to inform these linking web sites that they have not linked to the Complainant's official web site.

As shown on the web page printouts provided in Comp. Annex 13, the Respondent's web site contained commercial advertising and links to opportunities to purchase job placement services. The appearance of commercial advertising on the web site leads users to believe that the Complainant, OPM, or the Federal Government sponsors or endorses these advertisers when in fact it does not.

By letter dated July 2, 2003 (a copy of which appears in Comp. Annex 19), the Complainant objected to the Respondent's use of the Complainant's mark "USAJOBS" and the confusing similarity to the official <usajobs.-opm.gov> web site. It was not until the day following receipt of the Complainant's objection that the Respondent removed the improper claim that it was in fact OPM. A copy of the Respondent's July 10, 2003 response to the Complainant's letter appears in Comp. Annex 20. The July 10, 2003 acknowledges that the Respondent's site is commercial in nature by stating, in pertinent part: "My client is currently producing revenue from the web site USAJOBS.COM."

On August 4, 2003, apparently in response to OPM's Recruitment One-Stop modifications to its web site, the Respondent removed its substantive content regarding Federal employment information from the web site and replaced it with an indication that the site was undergoing maintenance. See various web-page printouts provided in Comp. Annex 21. Also as shown in Comp. Annex 21, during the period August 5, 2003 through September 2, 2003, the Government jobs portion of <usajobs.com> was continuously off-line and the entire web site was sporadically off-line.

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On or about September 3, 2003, the Government jobs portion of <usajobs.com> reappeared on-line in a form that is similar to OPM's enhanced, official web site. The Respondent displays OPM's job vacancy database through the Respondent's own frames together with commercial advertising. The Respondent has modified the summary vacancy announcements to omit the closing date, an essential item of information for potential job seekers, and it labels the opening date of a position as "date". As a result, from the summary listing, an applicant cannot tell if a date is an opening date or closing date for the position. Compare Comp. Annex 22 at p 4, which provides hard-copy of a page of the Respondent's site, with a corresponding page from the Complainant's site appearing at Comp. Annex 23 at p 4.

While there is no longer a URL substitution to interfere with the application process, the Respondent's web site links to the enhanced official OPM web site using a very "deep linking" technique that it prohibits under the "Legal" section of its own web site. In that regard, see the Respondent's posted legal

Page 1347

policy from its site, specifically that for linking which appears on Comp. Annex 14 at p 8. The user is not provided with notice that the user is leaving the Respondent's web site or entering the OPM web site. As shown in Comp. Annex 22 at p 10, the Respondent continues to append a copyright notice claiming as its own the substantive content of each official job vacancy announcement retrieved through its site from the OPM database.

Through a letter dated September 29, 2003 — a copy of which appears in Annex 24 to the Complaint, the Complainant replied to the Respondent through which the Complainant continued to seek transfer of the domain name <usajobs.com>.

With few exceptions, Federal employment is limited to United States citizens. See, generally, Executive Order 11935, President Gerald Ford, 41 Fed. Reg. 37301, September 3, 1976. The Complainant posts content on citizenship requirements available within USAJOBS. See, <http://www.usajobs.opm.gov/ei9.asp>. The <usajobs.opm.gov> web site does offer job searching in overseas locations inasmuch as the US government employs people all over the world. However, USAJOBS for the most part does not seek applications from foreign nationals. Even when a few jobs are open to non-citizens, they are typically not posted on the <usajobs.opm.gov> database because agencies recruiting for these jobs are not interested in publicizing them beyond the local geographic area.

As indicated in the Lamba affidavit, the Respondent is a privately-held corporation involved in an array of businesses, with Respondent Lamba possessing a large network of connections in the tech-savvy Indian community both in the US and abroad. In 1997, Respondent Lamba's awareness of foreign nationals' interest in obtaining employment in the United States prompted him to register the disputed domain name, <usajobs.com>, in order to implement his business model: the promotion of

federal and private sector employment opportunities in the United States. Respondent Lamba focused on other business interests between 1997 and 1999; however, as soon as those interests permitted and since late 1999, Respondent has operated an employment and recruitment service targeted toward, but not limited to, the international community.

Respondent Lamba stated that, in order to develop its employment and recruiting services business, he registered a name that fit his business model to attract foreign job seekers seeking employment in the U.S. and to connect them with jobs available in the U.S. Respondent Lamba acknowledges that, at the time he purchased the disputed domain name, he was aware that the Complainant offered information regarding federal government jobs at an official government web site: <usajobs.opm.gov>. Nonetheless, prior to registering the disputed domain name in 1997, Respondent Lamba researched and verified that there was no federal trademark registration that might impinge on that name.

The Respondent states that it has never offered to sell the disputed domain name, <usajobs.com>, and that it is not currently offering that name for sale.

## **DISCUSSION**

### **A. Threshold Issues**

#### **1. Laches**

[1] The remedy which the Complainant now seeks is contractually based and specifically provided through the Policy to which the Respondent has acceded, by virtue of its having agreed to the NSI registration agreement, not only when the Respondent originally registered the disputed domain name in November 7, 1997 but again when it renewed its registration on October 18, 2002. Laches, being an equitable rather than a contractual remedy, is simply not available under the Policy. Once a complainant makes a prima facie showing of each of the elements set forth in the Policy, it is entitled to the relief requested under the Policy. *See E.W. Scripps Co. v. Sinologic Indus.*, cited *supra*. Such is the case here.

Moreover, even if laches were so available, the Panel does not see the Complainant's delay in instituting this action when it did as raising a sufficient reliance interest in the Respondent so as to preclude the Complainant from securing its rights against the Respondent at this point in time, i.e., relief which if granted now would be unjust to the Respondent. *See Hebrew Univ. of Jerusalem v. Alberta Hot Rods*, cited *supra*.

From a simplistic standpoint, the Respondent renewed its domain name registration in October 18, 2002, hence effectively re-starting

its registration period. Therefore, one can measure the Complainant's delay in filing the Complaint from that date until September 30, 2003, rather than from the date of its initial registration back on November 7, 1997. Measuring the period from the renewal date yields a delay of some eleven months which is certainly not an unreasonable period of time.

Furthermore, given that the Respondent was well aware of the Complainant's activities surrounding its mark "USAJOBS" all through that time and even back to its initial registration date of November 7, 1997 and thus likely to expect the Complainant to eventually assert its rights under its mark at some point during that entire period, the Panel simply views the Respondent as acting, in, e.g., initially registering, using and renewing the domain name, at its own peril. Hence, the Panel does not see grant of the relief to the Complainant coming at this point in time as being unjust to the Respondent.

## **2. Invalidity of the Complainant's mark and inappropriate forum**

The Respondent correctly recognizes that questions of trademark infringement 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 validity — as the Respondent has raised — are no different.

[2] 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 USPTO, which, in the first instance, not only possesses the requisite expertise 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 USPTO 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 grossly ill-equipped to deal with an extensive factual inquiry that typically underlies such a determination. *See, e.g. Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, D2002-0758 (WIPO Oct. 4, 2002).

Hence, once the USPTO has made a determination that a mark is registrable, by so issuing a registration, as indeed was the case here, an ICANN panel is not empowered to nor should it disturb that determination.

To the extent the Respondent wishes to challenge the PTO's determination that the Complainant's mark "USAJOBS" has acquired sufficient distinctiveness under §2(f) of the Lanham Act (presumably through five years of prior continuous use) upon which registration can be based, the Respondent can do so by either filing an action in the USPTO to cancel the Complainant's registration or alternatively instituting federal litigation. Absent the Respondent having done so and attained a final ruling that the

Complainant's mark is indeed merely descriptive so as to preclude its registration or not, this Panel will simply defer, as it must, to the USPTO's determination implicit in its having granted a registration, i.e., that the Complainant's mark has acquired sufficient distinctiveness and hence is not merely descriptive, and thus qualifies for federal trademark protection and enjoys all the rights afforded thereby.

Given the Complainant's federal trademark registration (even apart from the Complainant's common law rights under its mark), the Complainant has raised valid allegations under the Policy which: (a) collectively question whether the Respondent should retain the disputed domain name, and (b) entitle the Complainant to the relief it requests under the Policy which, as a contractual matter under the registration agreement to which the Respondent is a party, the Respondent is so bound. An ICANN panel, such as ours, is not only the appropriate forum but is the only forum through which such questions are resolved.

## **B. Policy Elements**

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

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

Page 1349

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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.

### ***Identical and/or Confusingly Similar***

The Panel finds that confusion unquestionably and inevitably arises as a result of the Respondent's use of the disputed domain name as an address of its web site. Further, the Panel can conceive of no situation where confusion would not likely arise out of the Respondent's use of that name with directly competitive service offerings or a transfer of that name to a third-party not affiliated with the Complainant for use with a web site offering similar services to those provided by the Complainant, OPM.

[3] Such confusion would cause and undoubtedly has caused Internet users intending to access the

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Complainant's web site, but who reach the Respondent's web site through the disputed domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. *See, 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); *Southwest Airlines Co. v. TRN*, D2002-0893 (Nov. 18, 2002); *Am. Family Life Assurance Co. v. defaultdata.com*, FA 123896 (Nat. Arb. Forum Oct. 14, 2002); *AT&T Corp. v. Abreu*, D2002-0605 (WIPO Sept. 11, 2002); *Pfizer Inc. v. RE THIS DOMAIN FOR SALE –EMAIL* D2002-0409 (WIPO July 3, 2002); *Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002); *MPL Communications, Limited v. LOVEARTH.net*, FA 97086 (Nat. Arb. Forum June 4, 2001); *MPL Communications, Limited et al v. I WebAddress.com*, FA 97092, (Nat. Arb. Forum June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001); *Surface Protection 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); and *Pep Boys Manny, Moe and Jack of Cal. v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

It has now become well established jurisprudence that the Policy does not discriminate between those marks in the US that are based on common law usage (unregistered marks) or grounded in federal registrations, and is thus inclusive in scope (*see e.g. Am. Online, Inc. v. Deep d/b/a Buddy USA Inc.* FA 96795 (Nat. Arb. Forum May 14, 2001); *see also Missing Children Minn. v. Run Yell Tell, Ltd.* FA 95825 (Nat. Arb. Forum Nov. 20, 2000); *see also Brooklyn Inst. of Arts and Sciences v. Fantastic Sites, Inc.* FA 95560 (Nat. Arb. Forum Nov. 2, 2000)). Such common law rights can and often exist simultaneously with and independently of trademark rights attained through registration and provide a separate basis to invoke paragraph 4(a)(i) of the Policy. Nevertheless, given the Panel's finding of identity predicated on the Complainant's federally registered mark, the Panel need not address the existence of the Complainant's common law rights arising from its prior use of its “USAJOBS” mark, and the impact of those rights under the Policy vis-à-vis the disputed domain name.

Therefore, the Panel finds that the disputed domain name <usajobs.com> sufficiently resembles the Complainant's “USAJOBS” mark as to cause confusion; hence, the Complainant has made a requisite showing of sufficient similarity between its registered mark and the disputed domain name to satisfy paragraph 4(a)(i) of the Policy.

### *Rights or Legitimate Interests*

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

[4] The simple reason is that the disputed domain name contains the Complainant's mark "USAJOBS" under which the Complainant provides its services. Furthermore, the Complainant has never authorized the Respondent to utilize the mark "USAJOBS", or a mark confusingly similar thereto, in conjunction with the specific services which the Complainant provides under that mark, nor

Page 1350

does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "USAJOBS" or a mark confusingly similar thereto, in connection with providing Federal job vacancy announcements and information, Federal employment fact sheets, and Federal job applications and forms via a global computer network would directly violate the exclusive trademark rights now residing in the Complainant. *See e.g. Leiner Health Servs. Corp. v. ESJ Nutritional Prods., supra; AT&T Corp., supra; MPL Communications, FA 97086 and FA 97092, supra; Am. Online, Inc. v. Fu, D2000-1374 (WIPO Dec. 11, 2000); Treeforms, Inc., supra.*

It is eminently clear to this Panel, as previously stated, that the Respondent, in having intentionally chosen a domain name that at its essence completely incorporates the Complainant's "USAJOBS" mark for use as an address of its web site which basically offers the same services as does the Complainant, has done so to opportunistically exploit the inevitable confusion that results thereby. This is particularly evident here by virtue of the Respondent's pre-existing knowledge of the Complainant's prior and continuing use of its mark "USAJOBS" in connection with the Complainant's site, wholesale and flagrant copying and framing of substantial portions of the Complainant's site into the Respondent's <*usajobs.com*> site and deep linking within the Respondent's site to portions of the Complainant's site. It simply defies credibility to think the Respondent had any other purpose in mind other than to opportunistically exploit Internet user confusion by diverting Internet users away from the Complainant's site to the Respondent's site for the latter's own pecuniary benefit. Specifically, those users would think they are accessing the Complainant's web site and using its services when, in actuality, they are accessing the Respondent's site and using its services and, by doing so, generating profit to the Respondent from their interaction — to the Complainant's ultimate detriment. Such parasitic use, which at its essence relies on instigating and exacerbating user confusion, cannot and does not constitute bona fide commercial or fair use sufficient to legitimize any rights and interests the Respondent might have in the disputed domain name. *See Leiner Health, supra; and Frampton, supra.*

Moreover, it is eminently clear that the Respondent itself is not commonly known by the disputed domain name and never has been so known.

In light of the above findings, the Panel is not persuaded that the 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 the disputed domain name under any provision of paragraph 4(c) of the Policy.

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

### *Registration and Use in Bad Faith*

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

[5] As previously noted, the Respondent has clearly admitted that it was quite aware of the Complainant's mark "USAJOBS" when it initially registered the disputed domain name back on November 7, 1997, with that knowledge continuing when it renewed its registration some five years later on October 19, 2002. At the time of its initial registration, the Respondent intended on offering services that were for all intents and purposes very similar to, and effectively competitive with, those then offered by the Complainant. Commencing a few years later in 1999, the Respondent actually established a web site resolvable by the disputed domain name through which it so offered those services and continues to do so to this date.

Not only has the Respondent intentionally misappropriated the Complainant's mark and offered competitive services through it, but moreover has blatantly copied and framed, onto its own site, considerable portions of the Complainant's site content and deeply linked to portions of the Complainant's site—all without authorization of the Complainant. Furthermore, the Respondent derives revenue from users that visit its site.

Clearly, when the Respondent's actions are viewed in their totality, the Respondent is effectively deceiving Internet users who visit its site into believing that its site is either the official U.S. web site for federal job information which clearly it is not, or in some manner is associated with or related to the Complainant's site, which is the official site, when again

Page 1351

the Respondent's site is not. Simply put, the Respondent's purpose in doing so has been and continues to be to opportunistically exploit the inevitable user confusion by diverting users away from the Complainant's site to the Respondent's site for the latter's own financial gain. If the Respondent did not have this very purpose in mind when it intentionally chose the disputed domain name in the first place, let alone subsequently renewed it five years later, what credible reason could it have possibly had? The Panel can think of none.

Such actions directly contravene paragraph 4(b)(iv) of the Policy, hence constituting bad faith

registration and use.

Thus, the Panel concludes that the 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 the Complainant is hereby *GRANTED*.

The disputed domain name, namely <*usajobs.com*>, is ordered *TRANSFERRED* from the Respondent to the Complainant.

**- End of Case -  
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