



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

NCRAS Management, LP v. Cupcake City and John Zuccarini

Case No. D2000-1803

1. The Parties

The Complainant is NCRAS Management, LP, a Delaware limited partnership, 200 South Andrews Avenue, Fort Lauderdale, Florida 33301, USA.

The Respondent is Cupcake City, John Zuccarini, 957 Bristol Pike, Suite D-6, Andalusia, Pennsylvania 19020, USA.

2. The Domain Name and Registrar

The Contested Domain Name is <nationalrentalcar.com>

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

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at

"<http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>", which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 ("Supplemental Rules").

The Complaint was filed with WIPO Arbitration and Mediation Center (the "Center") by e-mail on December 22, 2000 and in hard copy, with Annexes A-S, as well as the appropriate payment on December 27, 2000. The Complainant's attorney, Ms. Lisa R. Trovato, states that on December 22, 2000, she served a copy of the Complaint on the Respondent, by US mail, and, in accordance with the methods set forth in paragraph 2(b) of the Rules; and, on the same date, also provided a copy of the Complaint to the

Registrar, NSI.

The Center acknowledged receipt of the Complaint by e-mail dated December 29, 2000, to the Complainant's attorney.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN-approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on January 3, 2001, the Center requested confirmation from NSI of information set forth in the Complaint relative to the contested domain name; specifically, contact and registrant information for the contested domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of this domain name. On January 5, 2001, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the Policy is in effect (through Network Solutions' version 4.0 registration agreement) for the contested domain name, and that this domain name was then in an "active" status.

Inasmuch as version 4.0 of the NSI service agreement governed the contested domain name, the Center, through an e-mail letter, captioned Complaint Deficiency Notification, to the Complainant and dated January 8, 2000 notified the Complainant's attorney that the Complainant must consent to jurisdiction, in the event of a challenge by the Respondent to a decision by the Panel to transfer or cancel the contested domain name, of the courts of the location of the domain holder's address. On January 8, 2001, the Complainant's attorney submitted a suitable response to the Center, as well as to the Respondent and NSI, that in effect, corrected this deficiency by amending the mutual jurisdiction clause of the Complaint. The Center received this response by e-mail on January 8, 2001 and in hardcopy form on January 11, 2001.

The Center completed its formality review of the Complaint on January 11, 2001.

On January 11, 2001, the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, by e-mail and in hardcopy form by post/courier (the latter including a copy of the Annexes supplied by the Complainant). The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on January 11, 2001, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the

Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on January 30, 2001, to file its response with the Center and serve a copy of the response on the Complainant.

As of January 30, 2001, the Center had not received any response to the Complaint from the Respondent; hence, the Center, in an e-mail letter dated February 5, 2001 notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on February 9, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. On the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated February 13, 2001, notified the parties of the appointment of Mr. Michaelson as the panelist.

Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before February 26, 2001.

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

The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, Cupcake City (John Zuccarini), has failed to substantively respond to the Complaint as required by the Policy and Rules, all the factual representations alleged by the Complainant, NCRAS Management, LP, will be accepted as undisputed. For convenience of the reader, factual allegations from the Complaint are reproduced below.

The Complainant currently owns, as indicated in a list provided in Annex C to the Complaint, approximately 40 valid and subsisting U.S. service mark registrations ("National Marks") on which this dispute is based. The marks are used in connection with, inter alia, automobile rental and leasing services. Of all those marks, those most pertinent to the present dispute are as follows:

a) NATIONAL (stylized)

US registration 1,338,402; registered May 28, 1985

This service mark was registered, for use in connection with: "Car rental services", in international class 39. This mark claims first use and first use in inter-state commerce of August 31, 1984.

b) NATIONAL CAR RENTAL (stylized)

US registration 1,534,668; registered April 11, 1989

This service mark was registered, for use in connection with: "Automobile rental and leasing services", in international class 39. This mark claims first use and first use in inter-state commerce of September 19, 1987.

c) NATIONAL (stylized)

US registration 1,534,669; registered April 11, 1989

This service mark was registered, for use in connection with: "Automobile rental and leasing services", in international class 39. This mark claims first use and first use in inter-state commerce of September 19, 1987.

d) NATIONAL (block letters)

US registration 1,537,711; registered May 2, 1989

This service mark was registered, for use in connection with: "Automobile rental and leasing services", in international class 39. This mark claims first use and first use in inter-state commerce of November 1, 1949.

e) NATIONAL CAR RENTAL (block letters)

US registration 1,540,913; registered May 23, 1989

This service mark was registered, for use in connection with: "Automobile rental and leasing services", in international class 39. This mark claims first use and first use in inter-state commerce of November 1, 1949.

i) Complainant

As the owner of the National Marks, the Complainant states that it is responsible for licensing the authorized uses of the National Marks and for protecting the National Marks from infringement, dilution, disparagement, misappropriation and unfair competition. Complainant states that it licenses the National Marks to its affiliate National Car Rental Systems, Inc., the National Car Rental operating company and its affiliate National Car Rental Licensing, Inc., which franchises the National Car Rental business (all of which, including their predecessors-in-interest, are collectively referred to herein as "National").

The Complainant states that National is known throughout the United States, Canada and the world as a provider of high-quality vehicle rental and leasing services. In that regard, the Complainant notes that for over half a century, since as early as November 1949, National has prominently used the National Marks in connection with National's vehicle rental and leasing business. The Complainant states that National has established and maintains high standards of quality for its services. As such, the Complainant states that a result of decades of use, the National Marks have become well and favorably known throughout the United States, Canada and internationally.

The Complainant further states that the National Marks have been advertised to the purchasing public and to the trade throughout the United States and internationally on an extensive and frequent basis by a variety of advertising media, including

newspapers, magazines, television, radio, trade publications, the Internet, through the naming and promotion of a major sports arena, and through signs and counters in virtually every major airport. As a result of these efforts, the Complainant believes that the National Marks are easily recognizable to the trade and public as originating from National. As such, the Complainant states that the National Marks and the goodwill associated therewith are of inestimable value to Complainant. By virtue of the wide renown of the National Marks, and the wide geographic availability and extensive sale of National's services, the Complainant believes that the National Marks have become famous and distinctive in the minds of the purchasing public.

The Complainant states that it intends to continue to use the National Marks in connection with vehicle rental and leasing services, as well as other related services and promotional activities. In that regard, it states that the National Marks have been continuously and widely used by National since the inception of these marks and are currently used throughout the United States and worldwide.

The Complainant further states that National operates its official Internet web site at <nationalcar.com> (the "National web site"). Through this site, consumers can access information about National and its products and services, and even book reservations on-line via the National Web Site. The Complainant states that this site is a vital and integral part of its worldwide vehicle rental and leasing business.

ii) Complainant's interactions with the Respondent

The Complainant states that National first learned of the Respondent on October 12, 1999, when National received its first customer complaint about the web site located at the contested domain name, <nationalrentalcar.com> – an inversion of the domain name which National then used, <nationalcarrental.com>, to address the National web site. The customer was confused by the contested domain name and mistakenly believed that the site and the aggressive advertising at the site were operated and controlled by National. The customer stated: "I don't appreciate all the advertising pop-ups that come up when I visit your site. I was trying to create a link on our intranet to your site for our employees – however your domain is now banned from our network due to this. 7 extra windows opened up every time I went to your home page." A copy of this e-mail is attached in Annex D to the Complaint.

The Complainant next states that National and its trademark counsel investigated the nature of the site operated through the contested domain name and determined that the contested domain name was linked to the National web site, framed the National web site and then launched a series of persistent commercial advertisements over the backdrop of the National web site. Printouts of the National web site linked to the contested domain name and covered with Respondent's advertisements are attached in Annex E to the Complaint. A printout of the source code located at the contested domain name showing the command to frame the National web site is provided in Annex F to the Complaint.

The Complainant states that National, shortly after receiving this first complaint from one of its web site users, commissioned a private investigator to determine the background and identity of the owner of the contested domain name and the "pop-up" advertising. The investigator's report disclosed that the registrant of the contested domain name, "Cupcake City", is a fictitious business name filed by John Zuccarini -- who is the present Respondent, who also does business and registers domain names

under various other aliases including Cupcake Movies, Cupcake Party, Cupcake Shows, and JZ Design. The investigator's report indicates that the software technique used by the Respondent in connection with the contested domain name and its link to the National web site automatically links customers to other sites (containing the advertisements) when an Internet user attempts to exit that site. Thus, the advertisements are persistent and "lock-in" the user at the site; this practice is also referred to as "mousetrapping". The investigator also searched the NSI WHOIS database and found that John Zuccarini has registered numerous domain names under the alias "Cupcake City" and others. Many of these domain names are misspellings of famous company names and trademarks. A copy of the investigator's report is attached in Annex G to the Complaint. The Panel notes that this list contains domain names which are the result of misspelling of, e.g., the singer Brittany Spears, i.e. <britneyspeares.com> and <brittneyspears.com>, and Elvis Presley, i.e. <elvispresely> and <elvispresly.com>, and others that simply incorporate famous marks of entertainers, such as, e.g., for the music group Back Street Boys <backstreetboypictures.com> and <backstreetboylyrics.com>. In addition, a printout of the WHOIS registration record for the contested domain name appears in Annex A to the Complaint.

On November 3, 1999, National's trademark counsel sent a letter to the Respondent demanding that the Respondent cease linking to the National web site through the contested domain name as described above. A copy of this letter has been provided in Annex H to the Complaint.

The Complainant states that the Respondent replied to the November 3, 1999 demand letter with voicemail and e-mail directed to National's trademark counsel. Through that response, the Respondent apparently refused to cease using the contested domain name to link to the National web site in the manner described above and, instead, claimed that his use of the contested domain name was legitimate because it involved no pornography.

On November 16, 1999, National's trademark counsel reasserted its demand for the Respondent to cease using the contested domain name to link to the National web site. A copy of National's second demand letter to Respondent has been provided in Annex I to the Complaint.

The Respondent replied to the November 16, 1999 letter by e-mail dated November 18, 1999 (a copy of which appears in Annex J to the Complaint) through which the Respondent again refused to cease his use of the contested domain name in connection with the National web site.

By letter dated December 6, 1999 (a copy of which appears in Annex K to the Complaint), National's trademark counsel reasserted its demand for Respondent to cease using the contested domain name to link to the National web site.

On December 7, 1999, Respondent replied by e-mail to the December 6th, 2000, letter through which the Respondent refused to cease his use of the contested domain name, claiming that "IT IS A TOTAL BUNCH OF LIES YOU ARE MAKING UP!!!!!" and insisting that his linking to the National web site and displaying lock-in pop-up advertisements has "DONE NOTHING TO HARM national rental car." A copy of this e-mail appears in Annex L to the Complaint.

National's trademark counsel then discontinued its efforts to resolve this matter amicably with the Respondent. The Complainant also states that, meanwhile, National continued to receive customer complaints about the <nationalrentalcar.com> site and about e-mail spam that was received after visiting the <nationalrentalcar.com> site (mistakenly thinking that they had visited the National web site). Examples of such customer complaints appear in Annex M to the Complaint.

On February 11, 2000, National received a letter from James Markarian, an attorney for Joe Shields, who was then in the middle of a legal battle with the current Respondent over his use of domain names confusingly similar to the trademark JOE CARTOON. Mr. Markarian contacted National because he noted that the Respondent had registered a domain name confusingly similar to one of National's marks. Mr. Markarian also forwarded a then-comprehensive listing of the thousands of domain names registered by Respondent (and his aliases) with NSI. A copy of this listing has been provided in Annex N to the Complaint.

The Complainant further states that owing to the consumer confusion caused by the Respondent in conjunction with its use of the domain name <nationalcarrental.com> as the address of the National web site, National changed the address of its current site to the domain name <nationalcar.com>. However, the Complainant noted that quickly after it made this change, the Respondent noticed this change and also now links and frames ("mousetraps") to this new address.

5. Parties' Contentions

A. Complainant

1. Similarity

The Complainant takes the position that the contested domain name <nationalrentalcar.com>, by merely inverting the terms "CAR" and "RENTAL", is confusingly similar to its registered mark NATIONAL CAR RENTAL mark as to likely confuse Internet users who may believe they are doing business with Complainant or with an entity whose services are endorsed by, sponsored by, or affiliated with Complainant; hence, satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

In that regard, the Complainant also takes the position that the contested domain name is also a common misspelling of the domain name <nationalcarrental.com> which originally hosted the National web site.

Accordingly, the Complainant concludes that the contested domain name is confusingly similar to the Complainant's marks, inter alia, NATIONAL and NATIONAL CAR RENTAL, under paragraph 4(a) of the Policy.

2. Legitimacy

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

Specifically, the Complainant contends that the Respondent's only use of the contested

domain name is linking to and framing the National web site in order to mislead consumers and lock them into viewing Respondent's pop-up advertisements.

Moreover, because National owns the worldwide exclusive rights in the name and mark NATIONAL CAR RENTAL, the Respondent cannot establish legitimate rights in the contested domain name.

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

3. Bad Faith

The Complainant contends that the Respondent has registered and is now using the contested domain name in bad faith.

Specifically, the Complainant takes the position that the Respondent's use of the contested domain name <nationalrentalcar.com> is intentionally causing confusion among National's customers.

In that regard, the Complainant contends that it is clear from Respondent's mass domain name registrations of misspelled trademarks and its repeated course of bad faith conduct in connection with those domain names, that the Respondent is intentionally attempting, by virtue of causing actual confusion of Internet users, to attract those users, for Respondent's own commercial gain, to the Respondent's on-line advertisements. In that regard, the Complainant contends that the Respondent's actions have created actual confusion as to the affiliation between National and the pop-up ads displayed in connection with the contested domain name. National's customers are being misled to believe that National is responsible for Respondent's aggressive advertising tactics. Respondent benefits, at National's and its customers' expense, and, by so doing, is disrupting National's business operations.

Therefore, the Complainant concludes that the Respondent's conduct in registering and using the contested domain name amounts to bad faith under paragraph 4(a) of the Policy.

B. Respondent

The Respondent has not filed any substantive response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

1. Similarity

No doubt exists whatsoever in the Panel's mind that the contested domain name, <nationalrentalcar.com> is confusingly similar to the Complainant's registered marks, particularly NATIONAL CAR RENTAL.

In fact, the Panel believes that the Respondent intentionally chose the contested domain name because it is likely to be a common misspelling of that mark. By choosing such a domain name, the Respondent is counting on confusion of Internet users who seek the Complainant's site but who understandably misspell the Complainant's domain name <nationalcarrental.com> as <nationalrentalcar.com>. Such confusion also occurs under current Internet naming conventions, where Internet users who, in seeking to visit a site for a desired service, form a URL for an expected web site by concatenating a mark associated with that service followed by, e.g., a one or two word generic description of the service to form a secondary level domain (SLD) succeeded by an appropriate top level domain, such as ".com" (such as here "NATIONAL" followed by "RENTAL CAR"), but in doing so, reach the Respondent's site instead. Web site owners, recognizing a need to simplify and facilitate user navigation to their sites increasingly reflect their marks in their domain names. See *Playboy Enterprises International, Inc. v. Hector Rodriguez* D2000-1016 (WIPO November 8, 2000).

The evidence adduced by the Complainant clearly shows that such confusion has indeed arisen as the Respondent undoubtedly planned.

This confusion, as the evidence before the Panel unquestionably shows, caused Internet users intending to access the Complainant's website, but who actually reached the Respondent's "mousetrapping" web site addressed through the contested domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent when, in fact, no such relationship exists at all.

The Panel is very mindful of not imposing unreasonable, excessive and unfair burdens on Internet users. The Panel believes that such a burden would arise if such a user, in seeking to reach a desired website, were required to correctly remember the order of two generic words in a domain name that also included a mark, at the risk of that user being transported to an unrelated website that engenders source confusion, let alone causes "mousetrapping".

With respect to a test for "confusing similarity", § 5.01[3], page 5-15 of J. Gilson, et al, Trademark Protection and Practice (© 1996, Matthew Bender & Co., Inc.) states:

"When one trademark is said to be 'confusingly similar to another', it is so similar to the other that, when it is used on products the purchasing public is likely to be confused. The term [confusingly similar] is simply another way to express the fact that confusion is likely. "

In assessing whether sufficient similarity exists between two marks, Gilson, at § 5.02[1], states: "If a word trademark sounds similar to the plaintiff's mark courts often find likelihood of confusion, especially if the associated product is typically ordered orally. Visual similarity frequently causes confusion if there is sufficient resemblance in overall appearance." In its seminal decision on the issue, *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the U.S. Court of Customs and Patent Appeals (predecessor to the U.S. Court of Appeals for the Federal Circuit), in its definitive listing of factors to assess in determining whether likelihood of

confusion exists or not, enumerated as its first factor: "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."

The Panel believes that merely inverting the terms of a mark, by the Respondent in forming a domain name, is quite insufficient to dispel consumer confusion; the mark and the resulting domain name are simply too similar to each other. In fact, such a domain name, rather than ameliorating confusion, exacerbates it, particularly when Internet users seeking to reach a site associated with the mark actually, by virtue of their innocent mistakes, reach a totally unrelated site after having entered the domain name.

Furthermore, the Panel's views are further supported by the Respondent having admitted, under oath, both in deposition and trial testimony, as reported by the Court in *Joseph C. Shields, individually and t/a The Joe Cartoon Co., v. John Zuccarini, individually and t/a Cupcake City*, 89 F. Supp.2d 634, 639 (US Dist. Ct. E.D. Pennsylvania 2000) that he registered variations on "Joe Cartoon" as well as thousands of other domain names *because they are confusingly similar to others' famous marks or personal names* -- and thus are likely misspellings of these names -- in an effort to divert Internet traffic to his sites." [emphasis added]. To this Panel, the Respondent's motivation certainly encompasses the contested domain name as well. A copy of the Court's decisions (including an opinion dated March 22, 2000 and amended March 29, 2000; an order dated June 5, 2000; and an order and judgment dated July 18, 2000) all appear in Annex O to the Complaint.

Therefore, the Panel finds that the contested domain name "nationalrentalcar" sufficiently resembles the Complainant's marks, inter alia, NATIONAL and NATIONAL CAR RENTAL, as to cause confusion.

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

2. Illegitimacy

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its NATIONAL marks, including the marks NATIONAL and NATIONAL CAR RENTAL. Furthermore, by virtue of the registration of these marks, the US Patent and Trademark Office has implicitly recognized that each such mark has acquired appropriate secondary meaning in the marketplace.

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

The simple reason is that the contested domain name includes the Complainant's mark NATIONAL under which the Complainant renders its services and has been doing so for some time. The Complainant has apparently never authorized the Respondent to utilize any of its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent was to put of any of the NATIONAL marks, including the mark NATIONAL in connection with the services listed in the corresponding registration would directly violate the exclusive trademark rights now residing in the Complainant. Consequently, inasmuch as the

Respondent is not now and has never been known by the mark NATIONAL, the Respondent's actions in using the contested domain name are in direct contravention of paragraph 4(c)(ii) of the Policy.

Furthermore, it is abundantly clear from the record before this Panel that the Respondent's "mousetrapping" action, automatically caused whenever an Internet user happens to access the contested domain name, has as its sole goal to mislead Internet users to the Respondent's site solely for the Respondent's commercial gain and nothing else. This use of the contested domain name is clearly illegitimate and plainly violates paragraph 4(c)(iii) of the Policy.

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

3. Bad Faith

The Panel is not persuaded that the Respondent chose the contested domain name, which contains the Complainant's registered mark NATIONAL, for any reason other than as an attempt to intentionally attract Internet users, for commercial gain, to the Respondent's site by creating a likelihood of confusion with the Complainant's marks NATIONAL or NATIONAL CAR RENTAL as to source, sponsorship, affiliation or endorsement of the Respondent's web site with the Complainant; when, in fact, no such relationship exists. If this was not the case, then what reason would the Respondent have to choose domain names that incorporated the Complainant's registered mark and is a common misspelling of another one of the Complainant's registered marks? In view of the overwhelming and clearly persuasive evidence in the record, the Panel believes none. This conduct directly contravenes paragraph 4(b)(iv) of the Policy.

In that regard, the purely commercial motivation underlying the Respondent's mousetrapping actions is unquestionably borne out by the *Shields* case, where the Court noted just how much revenue the Respondent received, i.e. "his click-based revenue now approaches \$ 1 million per year." *Id* at 639.

Moreover, in the *Shields* case, cited supra, Judge Dalzell, under the Anticybersquatting Consumer Protection Act (ACPA) provisions (see 15 USC § 1125(d)(1)) of the Lanham Act, granted relief against this very same Respondent for the same conduct it perpetrated in the present case though involving the domain names <joescartoon.com>, <joescarton.com>, <joescartons.com>, <joescartoons.com> and <cartoonjoe.com> in view of the plaintiff, Shield's, domain name <joecartoon.com>. Specifically, the Court granted a preliminary injunction and a permanent injunction against the Respondent, and awarded to Plaintiff Shields statutory damages in the amount of US \$ 50,000 and attorneys' fees and costs of approximately US \$ 40,000. In its final order, the Court described Defendant Zuccarini's (this Respondent's) conduct as "utterly parasitic and in complete bad faith." Further, the Court stated: "Zuccarini has engaged in exactly the type of conduct that the ACPA is designed to prevent, and Shields will suffer irreparable harm unless we enjoin this flagrant violation of his rights".

Given the identical nature of the Respondent's conduct in question here to that in the *Shields* case, the Panel takes the same view of this conduct as did the Court.

Furthermore, various administrative proceedings have considered the conduct of this same Respondent in registering domain names that included well-known or famous

trademarks or common misspellings thereof, as well as in some instances also linking to those domain name(s) to the Respondent's web site, trapping users to that site and then displaying multiple frames to the user's browser (that collectively cause "mousetrapping" as in the present case). In each such instance, the panel ordered the corresponding contested domain(s) names transferred to the complainant. As those cases indicate, the Respondent's repetitive conduct in each instance clearly constituted bad faith under the Policy. In that regard, see *WebMD Corporation v. Cupcake Patrol* FA96106 (Nat. Arb. Forum January 2, 2001), *United Feature Syndicate, Inc. v. Mr. John Zuccarini* D2000-1449 (WIPO December 29, 2000), *Microsoft Corporation v. Cupcake Patrol* D2000-1344 (WIPO December 10, 2000), *FAO Schwartz v. John Zuccarini* FA95828 (Nat. Arb. Forum December 1, 2000), *Hewlett-Packard Company v. Cupcake Patrol* FA95822 (Nat. Arb. Forum November 20, 2000), *Victoria's Secret et al v. John Zuccarini dba Cupcake Patrol, Cupcake Party and Country Walk* FA95762 (Nat. Arb. Forum November 18, 2000), *Musicmatch, Inc. v. Cupcake Patrol* FA95733 (Nat. Arb. Forum November 18, 2000), *American Airlines, Inc. v. John Zuccarini* FA95695 (Nat. Arb. Forum November 6, 2000), *Gamesville.com, Inc. v. John Zuccarini* FA95294 (Nat. Arb. Forum August 30, 2000), *Abercrombie & Fitch Stores, Inc. and A & F Trademark, Inc. v. John Zuccarini d/b/a Cupcake Patrol* D2000-1004 (WIPO November 1, 2000), *Diageo plc v. John Zuccarini, Individually and t/a Cupcake Patrol* D2000-0996 (WIPO October 22, 2000), *Microsoft Corporation v. Cupcake City* D2000-0818 (WIPO October 22, 2000), *Budget Rent a Car Corporation v. Cupcake City* D2000-1020 (WIPO October 19, 2000), *Yahoo! Inc. and GeoCities v. Cupcakes, Cupcake city, Cupcake Confidential, Cupcake-Party, Cupcake Parade, and John Zuccarini* D2000-0777 (WIPO October 2, 2000), *Yahoo!, Inc. v. Cupcake Patrol and John Zuccarini* D2000-0928 (WIPO September 29, 2000), *Cabela's Incorporated v. Cupcake Patrol* FA95080 (Nat. Arb. Forum August 29, 2000), *Cabela's Incorporated v. John Zuccarini* FA95233 (Nat. Arb. Forum August 28, 2000), *Dow Jones & Company, Inc. and Dow Jones LP v. John Zuccarini* D2000-0578 (WIPO August 28, 2000), *Diageo p.l.c. v. John Zuccarini* D2000-0541 (WIPO August 22, 2000), *L.L. Bean, Inc. v. Cupcake Patrol* FA95105 (Nat. Arb. Forum August 4, 2000), *Spiegel Catalog, Inc. v. John Zuccarini* AF0237a-d (eResolution July 28, 2000), and *James Squires v. John Zuccarini* AF-0218 (eResolution July 18, 2000). The Panel sees every reason to join this chorus in holding the Respondent's actions here clearly evidence "bad faith" and absolutely no reason to deviate therefrom.

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of the contested domain name under paragraph 4(a)(iii) of the Policy.

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

7. Decision

In accordance with principles of common law jurisprudence, the Panel strenuously adheres to a policy of predicating each of its decisions on very narrowly focused grounds particularly those minimally sufficient to decide an instant dispute then before it, with its ultimate award being duly constrained by the confines of the law, regulation and/or contractual agreement that initially conferred power on the Panel.

It is indeed unfortunate, given the rampant, repetitive and pernicious conduct in which this particular Respondent has engaged and the remaining cumulative cost to the affected trademark owners to ultimately remediate the remnants of that conduct, that the Panel is unable to render a single, global and economically-efficient decision that rectifies this situation once and for all. The Panel, though clearly desirous of doing so, simply does not have the requisite power to do so. Consequently, remediation must be left to other complainants, as had occurred and will likely so continue, collectively proceeding on a piecemeal basis against this Respondent through other legal proceedings, whether in the courts or through administrative bodies, to seek transfer of the particular domain name(s) of interest to them.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel, in view of its very limited power, now grants the relief sought by the Complainant.

The contested domain name, specifically <nationalrentalcar.com>, is ordered transferred to the Complainant.

Peter L. Michaelson,
Sole Panelist

Dated: February 26, 2001