

ADMINISTRATIVE PANEL DECISION

National Association of Realtors v. Hammerberg & Associates, Inc.
Case No. D2012-0075

1. The Parties

The Complainant is National Association of Realtors of Chicago, Illinois, United States of America (“U.S.”) represented by Michael Thiel, U.S.

The Respondent is Hammerberg & Associates, Inc. of Denver, Colorado, U.S., represented by Law Office of Curt Handley, U.S.

2. The Domain Name and Registrar

The disputed domain name <gayrealtor.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 30, 2009 and the World Intellectual Property Organization (“WIPO”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the “Supplemental Rules”).

The Complaint (with accompanying Exhibits A to H) was filed with the WIPO Arbitration and Mediation Center (the “Center”) by e-mail on January 17, 2012.

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 UDRP administrative proceeding. Through the Complaint, the Complainant requested a single-member panel.

On January 18, 2012, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in that Complaint relative to the disputed domain name, and whether the disputed domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify: (a) the dates on which the registrant registered that disputed domain name (or acquired the registration) and when the registration will expire, (b) whether the Policy applies to the disputed domain name, (c) the language of the registration agreement, and (d) for confirmation that the disputed domain name will remain “locked” during the

proceeding.

Subsequently, on January 18, 2012, the Registrar responded to the Center through which the former stated that it had received a copy of the Complaint, confirmed it is the registrar for the disputed domain name, confirmed that the named respondent on the Complaint, as filed, was the actual registrant of the disputed domain name, and provided contact information pertinent to the disputed domain name to the extent, as it then existed, in its Whois database. The Registrar's response further indicated that: (a) the disputed domain name was registered on May 26, 1997, (b) the registration will expire on May 25, 2012, (c) the Policy applies to the disputed domain name, (d) the registration agreement is in English, and (e) the disputed domain name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On January 19, 2012, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by e-mail together with the Center's "Written Notice of the Commencement of Administrative Proceeding", the notice also being sent by both courier and facsimile. The Complaint and its accompanying documents were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on January 19, 2012, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondences, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on February 8, 2012 to file its Response with the Center and the Complainant.

On February 7, 2012, the Respondent filed its Response, via e-mail to the Center. Later the same day, the Center acknowledged, by e-mail letter to the parties, its receipt of the Response.

Pursuant to the Rules and Supplemental Rules, by e-mail letter dated February 14, 2012, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. On February 15, 2012, Mr. Michaelson accepted and, pursuant to the requirements of paragraph 7 of the Rules, returned by e-mail attachment to the Center a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter on February 16, 2012 notified the Parties of the appointment of Mr. Michaelson as sole Panelist. The Panel finds that it was properly constituted.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before March 1, 2012.

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

4. Factual Background

According to the public Whois database appearing in Exhibit A to the Complaint, confirmed by the Registrar as well as by Exhibit A to the Response, the disputed domain name was registered to the Respondent on May 26, 1997 and is set to expire on May 25, 2012.

A. Complainant's REALTOR Marks

The Complainant owns numerous U.S. trademark registrations for the term "REALTOR", including some in stylized form, some in block letters with or without other textual portions, and others with a design element and with or without additional textual portions. The Complainant has provided, in the Complaint, a list of its registrations. Pertinent details of a small sample of these registrations are as follows:

1. REALTORS (block letters)
United States Registration No. 515,200
registered: September 13, 1949; filed: July 17, 1947
renewed: September 15, 2009

This mark is registered for use in connection with: "brokerage of real estate, industrial brokerage, farm brokerage, mortgage brokerage, in the appraisal of real estate, management of real estate, in the building of structures on real estate, in the subdivision of real estate properties, and in community planning for the development of raw land and slum clearance areas", all in international class 36. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of March 31, 1916.

2. REALTOR (block letters)
United States Registration No. 519,789
registered: January 10, 1950; filed: July 17, 1947
renewed: January 10, 2010

This mark is registered for use in connection with: "brokerage of real estate, industrial brokerage, farm brokerage, mortgage brokerage, in the appraisal of real estate, management of real estate, in the building of structures on real estate, in the subdivision of real estate properties, and in community planning for the development of raw land and slum clearance areas", all in international class 36. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of March 31, 1916.

3. REALTOR and design
United States Registration No. 1,009,745
registered: April 29, 1975; filed: May 21, 1973
renewed: June 2, 2005

This collective mark is registered for use in connection with: "indicating membership in applicant", in international class 200. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of April 16, 1973.

B. Complainant

The Complainant ("NAR"), as indicated in Exhibit C to the Complaint and specifically through a hard-copy printout of various pages from its web site, was founded as the National Association of Real Estate Exchanges on May 12, 1908 at the YMCA Auditorium in Chicago, IL with 120 founding members, 19 Boards, and one State Association. Its original purpose, as stated on its website, was to "unite the real estate men of America to effectively exert a combined influence upon matters affecting real estate interests".

In 1916, the Complainant coined and then adopted the term "REALTOR" to identify real estate professionals who are members of its National Association and subscribers to the NAR's strict Code of Ethics.

By the early 1970s, the Complainant became the largest trade association in the U.S. with over 400,000 members. Currently, it has over one million members, 54 state associations (including Washington D.C., Guam, Puerto Rico, and the Virgin Islands) and more than 1,350 local associations.

To become a member of NAR, individuals must agree to be bound by the Complainant's Constitution and By-laws. All the rules and guidelines relating to proper use of the REALTOR Marks are available on NAR's website. This limited license granted by NAR is subject to the members' compliance with NAR's rules governing proper use of the REALTOR Marks.

Pursuant to the By-laws, NAR members enjoy a limited license to use the REALTOR Marks in accordance with governing NAR rules and guidelines. In particular, the REALTOR Marks can only be used in connection with a member's name or the legal name of his real estate firm to identify himself as member. Members are given notice of this obligation upon obtaining membership in the organization. NAR has adopted a rule permitting use of the mark REALTOR in a domain name or advertisement, but only in connection with the member's name or his firm's name. For example, John Doe, the owner of a brokerage called ABC Realty, may use the domain names <JohnDoeRealtor.com> or <ABCRealtyRealtors.com> but may not include any other non-identifying terms in connection with the REALTOR Marks.

The Complainant goes to considerable lengths to enforce the limited license and, by so doing, promote proper use of the REALTOR Marks by its members. Individuals who are not members of the Complainant are not authorized to use any of the REALTOR Marks.

C. Respondent

Since 1994, the Respondent has been a member of NAR. From that date, it has had notice of the limitations surrounding its approved use of the Complainant's REALTOR Marks.

The Respondent's web site, resolvable through the disputed domain name, contains a user-accessible, searchable database through which users can identify and obtain contact information of gay real estate agents who are members of NAR and also to gay agents who are not NAR members.

D. The Parties' Activities

The Respondent started using disputed domain name sometime in 2005 as a forwarding mechanism to his web site at <gayrealtorguide.com>.

On February 16, 2006, the Complainant sent an e-mail message to the Respondent requesting that the latter cease use of the domain name <gayrealtorguide.com> (a copy of the message appears in Exhibit B to the Response) as that use did not comply with NAR's rules and guidelines. In response and over the ensuing year, the Respondent removed its <gayrealtorguide.com> website, but continued use of the disputed domain name.

On February 14, 2007, the Complainant sent another email message (a copy of which appears in Exhibit F to the Complaint) to the Respondent. The message requested the Respondent to cease using the disputed domain name because that name did not comply with the Complainant's rules and guidelines regarding trademark use of the REALTOR Marks.

Prior to the February 14, 2007 message, the Respondent had already registered and, at the Complainant's request, agreed to cancel four other domain names that, from the Complainant's perspective, violated its trademark rules: <stapletonrealtor.com>, <glbtrealors.com>, <ftlauderdale Realtors.com> and <gayrealtorguide.com>. Since 2007, the Respondent has registered and complied with the Complainant's request to cancel two additional domains that also, from the Complainant's perspective violated its trademark rules: <omahasrealors.com> and <denverrelocationrealtor.com>. To the Complainant's knowledge and belief, the Respondent ceased using all of these domain names with the exception of disputed domain name.

In August 2007, the Complainant sent another email to the Respondent regarding use of the disputed domain name to which the Respondent replied (a copy of both messages appears in Exhibit C to the Response). The Respondent stated, in pertinent part, that "GayRealtor.com is being used by me personally,

for my personal use as a "Gay REALTOR".

On April 7, 2009, the Complainant sent another e-mail message to the Respondent to which the Respondent replied on the same day (copies of these messages appear in Exhibit D to the Response). The Complainant, through its message, again stated that the Respondent's use of its mark REALTOR in the disputed domain name violated NAR's rules and guidelines, and thus again requested that the Respondent cease use of that name. In its reply, the Respondent stated, in pertinent part: "'I' as a 'Gay Realtor' have every right to use the word 'Gay Realtor' as a gay man and member of the National Association of REALTORS."

On December 6, 2011, the Complainant sent a letter, by facsimile, to the Respondent again requesting that the Respondent cease use of the disputed domain name for essentially the same reasons stated in its prior messages to which the Respondent replied in a similar fashion as it did to the Complainant's prior messages. A copy of these latest messages appears in Exhibit E to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark REALTOR because the name contains the formative term "REALTOR" to which the term generic word "gay" has been prepended. Addition of the word "gay" fails to provide any distinctiveness to the disputed domain name that would sufficiently abate confusion of Internet users.

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

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant states that the Respondent, being a member of NAR since 1994 and despite having had repeated notice of the Complainant's rules and guidelines for use of the REALTOR Marks, violated its limited license governing the use of the REALTOR Marks by using the name in a manner not sanctioned by the license.

Second, apart from any consideration of the license, the Respondent is not using the name in connection with a *bona fide* offering of goods or services associated with the Complainant. Specifically, in order for a respondent to legitimately use a complainant's mark on or in conjunction with branded goods or services it is providing which originate with or associated with the complainant, the respondent must satisfy four criteria set forth in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. Two of those criteria are: (a) the respondent must use the site to sell only the trademarked services; otherwise it could be using the trademark to bait other Internet users and then switch them to other services, and (b) the site must accurately disclose the respondent's relationship with the trademark owner.

Specifically, under the first noted *Oki Data* criteria, the Respondent's site must not operate to bait and switch users. Here, the Respondent's site uses the mark REALTOR but does so in identifying real estate agents who are NAR members as well as agents who are not.

As to the second noted *Oki Data* criteria, the Respondent's site does not accurately disclose the Respondent's relationship with NAR. The Respondent's use of the disputed domain name <gayrealtor.com>

falsely suggests to Internet users that his site is officially sanctioned by NAR as a site for gay members of the Complainant simply because that site mimics a function found in various websites that the Complainant has sanctioned. Specifically, the Complainant maintains, at its own websites resolvable through <realtor.org> and <realtor.com>, membership directories -- at no cost to its members, called "Find a REALTOR". Through this directory, Internet users can search for and identify real estate agents who are members of NAR, and, as such, can legitimately identify themselves as "REALTORS". These directories include all REALTORS except for NAR members who have specifically requested that their names not be included. No one who is not a REALTOR is included. The Respondent registered and uses the mark REALTOR in a similar manner to confuse and mislead Internet users who are also seeking to find REALTORS. Internet users drawn to the Respondent's site are offered an opportunity, much like they are on the Complainant's websites, to search for and identify a real estate agent, but only from among those real estate practitioners willing to pay a fee to the Respondent for being included in the Respondent's directory and regardless of whether or not those individuals are in fact REALTORS, *i.e.*, members of NAR, or not. All individuals who are not members of NAR are not authorized to be identified by the mark REALTOR.

Lastly, though the following disclaimer appears on the homepage of the Respondent's website, the disclaimer is false, confusing and does not accurately disclose the Respondent's relationship with the Complainant by failing to acknowledge the Complainant's trademark rights and inform Internet users that the site is not affiliated with, endorsed or supported by the Complainant:

"Not all Realtor Agents are REALTORS, only realtor agents who are members of NAR (NATIONAL ASSOCIATION OF GAYREALTORS) are authorized to use the name. REALTORS subscribe to a strict code of ethics and are expected to maintain a high level of knowledge of the process of buying and selling real estate. The vast majority of our agents are REALTORS and may be recognized by the REALTOR symbol appearing on their profile. For more information on the National Association of REALTORS visit www.Realtor.org."

(iii) Registered and Used in Bad Faith

The Complainant contends that, for various reasons, the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

First, the Respondent, in using the name which incorporates Complainant's mark REALTOR, is diverting Internet users, who seek services of real estate professionals who are members of NAR and thus licensed to use the Complainant's mark, to its own website which offers services not only provided by such individuals but also by those who are not NAR members. In doing so, the Respondent, is intentionally causing confusion through which it profits, namely through fees it charges for individuals, regardless of being NAR members or not, to be listed on a user-accessible search directory accessible on its website.

For some time, Respondent, even though it has been a member of NAR since 1994, has known that its use of the Complainant's REALTOR mark, within the disputed domain name, violates Complainant's licensing rules governing use of its REALTOR Marks by its members -- and to which Respondent had agreed to abide. Yet, in spite of this knowledge, the Respondent continues to deliberately misuse the mark for its own commercial benefit. The ensuing misuse and confusion injure the Complainant's reputation.

Second, the Respondent's bad faith is also reflected in its subsequent registration of several other domain names, after it received a cease and desist letter from the Complainant in 2004 regarding <stapletonrealtor.com> (a copy of which appears in Exhibit G to the Complaint), that also included the Complainant's REALTOR Mark but which all violated the Complainant's licensing rules, specifically <glbtrealtors.com>, <fortlauderdalerealtor.com>, <gayrealtorguide.com>, <omahasrealtors.com>, <gayrealtor.com>, and <denverrelocationrealtor.com>.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent contends that the disputed domain name is not confusingly similar to the Complainant's mark REALTOR.

Further, the Respondent contends that its use of the name does not violate any license granted to it by the Complainant regarding use of the REALTOR Marks.

Specifically, the Respondent's use of the name is not for the actual practice of real estate brokerage (which is one of the services set forth in the Complainant's 515,200 and 519,789 trademark registrations) but rather to direct certain Internet uses in their search for gay real estate agents. Therefore, the Respondent's use of the name does not infringe upon the Complainant's mark REALTOR. While the name and mark are similar, the very generic nature of the entire name "precludes any use of 'realtor' in a domain name, thereby requiring assignment of literally the thousands of domain names using 'realtor' in them to Complainant. Such decision would have a chilling effect on registrars and applicants alike and thereby must not be allowed as a matter of public policy."

(ii) Rights or Legitimate Interests

Contrary to the Complainant's allegations, the Respondent contends that, for either of two reasons, it has rights and legitimate interests in the disputed domain name.

First, the Respondent states that its use of the name as an address of a website that provides Internet users with local gay real estate agents is itself legitimate and, as such, does not implicate the Complainant's licensing rules.

Second, as evidenced by the Whois entries in Exhibit F to the Response, various third-party websites exist which incorporate the words "gay" and "REALTOR". These names, ostensibly used with actual real estate agents, contravene the Complainant's trademark rules and yet remain unchallenged -- even though these names have been in existence nearly as long as has the disputed domain name.

(iii) Registered and Used in Bad Faith

The Respondent contends that it neither registered nor used the disputed domain name in bad faith.

Specifically, the Respondent alleges no evidence exists that it engaged in any conduct as enumerated in paragraphs 4(b)(i) through 4(b)(iv) of the Policy.

Furthermore, the name was registered nearly 10 years before any dispute arose between the Complainant and the Respondent over the name. The Complainant had ample time within this period to challenge the Respondent, but it failed to do so. The lack of any response from the Complainant until 2009 would "lead a reasonable person to believe that the matter was resolved" and, even apart from that, "a *bona fide* dispute was in existence between the parties which negates bad faith, as a matter of common law."

6. Discussion and Findings

A. Identical or Confusingly Similar

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

From a simple comparison of the disputed domain name to the Complainant's mark REALTOR, no doubt exists that the disputed domain name is confusingly similar to the Complainant's marks.

The primary difference between the disputed domain name and the mark REALTOR is the prepending of the generic term "gay", which is commonly understood to refer to a member of the gay, lesbian, bisexual and transvestite communities, to form a separate corresponding composite term "gayrealtor" along with, secondarily, appending the gTLD (generic top level domain) ".com" to that term to form the name, with the

last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding such a generic word, that being the term “gay”, in the manner which the Respondent specifically did, to the mark REALTOR clearly resulted in such a minor variation. See, particularly *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876.

Moreover, by including the generic term “gay” with the Complainant’s mark REALTOR to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. It is quite conceivable, given current common naming conventions and patterns in use on the Internet, that an Internet user, who seeks information on gay members of the Complainant, but is uncertain of its associated domain name for use in accessing its website, would form a domain name by prepending the term “gay” to the term “REALTOR” to form a composite name and then add the common gTLD “.com” to yield a resulting domain name <gayrealtor.com>. The user would then insert that domain name into his/her browser with a reasonable expectation that doing so would direct that browser to either the Complainant’s website or a site authorized by the Complaint from which that user could obtain information identifying local gay REALTORS. However, here the Respondent registered that domain name. The result is that the user’s action would cause that person not to be taken to the Complainant’s website, but rather, and without that user realizing the diversion, to the Respondent’s site instead. The user, as the Respondent intends, would then use the search facility provided on the Respondent’s site to locate desired gay real estate professionals. Thus, the user would very likely be deceived into thinking that all such individuals identified through that site are members of NAR when, in fact, some are not. Hence, adding the term “gay” to the disputed domain name only heightens the likelihood of the Respondent causing user deception and ensuing confusion to the Respondent’s ultimate benefit and the detriment of Complainant. See *Space Needle*, *Burberry*, *Krispy Kreme*, *Dreamworks* and *MySpace*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s REALTOR Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

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

The Respondent is a member of the Complainant and hence a licensee of its REALTOR Marks. However, the Respondent's use of the Complainant's marks are not within the bounds of its licensed rights. While it is not for this Panel to assess the language of the license grant itself for any ambiguity or any other legal deficiency, it is sufficient here that the Complainant, as the holder of exclusive trademark rights, set forth the extent and breadth to which all its members were authorized to utilize its marks, and to enforce its exclusive rights against those whose use violates those bounds to the detriment of the Complainant. The Complainant, on repeated occasions, notified the Respondent to that effect and to which the Respondent specifically replied. Hence, the Respondent was well aware of the limited use to which it could make of the Complainant's marks and that its continued use of the disputed domain name exceeded those bounds and hence was not authorized. Consequently, any such use, including that which the Respondent engages here, that extend beyond the bounds of what is licensed likely infringes on the exclusive trademark rights residing in the Complainant and thus is illegitimate.

While the Respondent argues that the services it renders of locating real estate agents is not real estate brokerage *per se* and thus are not subsumed within the Complainant's exclusive trademark rights and thus not impacted by the Complainant's licensing strictures, the difference is *de minimus* and of no practical consequence. The Respondent, by providing a user-accessible, searchable database through which Internet users could identify REALTORS (members of the Complainant) but which contained listings of both members and non-members of NAR, either likely facilitated (*i.e.*, contributed to) direct infringement of the Complainant's registered marks by those third-party non-members, who were clearly not authorized to use any of the Complainant's REALTOR Marks, or, given the significant similarity of identifying a REALTOR to the actual rendition of real estate brokerage services by a REALTOR, caused user confusion himself and thus directly infringed the Complainant's marks. In either instance, whether as a contributory or direct infringer, the Respondent has likely violated the exclusive trademark rights residing in the Complainant and thus is equally culpable for his actions.

Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between himself and any of the REALTOR Marks or even any mark similar theretofor the services of identifying gay members of the Complainant, *i.e.*, gay REALTORS, as the Respondent purports to do through use of the disputed domain name as an address of its website.

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

Lastly, the Respondent's unauthorized action, in using the disputed domain name to resolve to a commercial website that provides information on non-members of the Complainant in a manner through which Internet users can reasonably infer and hence are deceived into believing that such members are affiliated with NAR when in fact they are not, is nothing more than an intentional scheme to opportunistically and illicitly exploit the goodwill inherent in the Complainant's REALTOR Marks to the Complainant's detriment. Such a use does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute. Nor does such use constitute either a legitimate noncommercial or fair use of the name, without intent of the Respondent for commercial gain, to misleadingly divert consumer or tarnish any of the Complainant's relator Marks. Consequently, the Respondent's conduct does not fall within either paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

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

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Respondent was well aware of the Complainant's REALTOR mark well before the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent proceeded to register the domain name and then intentionally use that name as an instrumentality to divert Internet users to the Respondent's website through which those users were presented with a searchable database containing entries for both members and non-members of the Complainant, NAR.

The Panel infers that the likely purpose in doing so was its potential to cause inevitable user confusion and for the Respondent to then opportunistically exploit that confusion by increasing the likelihood that such an Internet user would transact business with one of the third-party non-NAR members under the mistaken belief that any such third-party was a member of the Complainant and thus entitled to the benefits, reputation and recognition flowing therefrom -- when, in fact, that party was not.

The Respondent, by providing such a search vehicle -- even though it was entirely unauthorized -- enabled non-NAR members to avail themselves of the Complainant's reputation and, by so doing, enhance their own sales, revenues and profits at the expense of the Complainant and its members and to the detriment of and potential injury to the Complainant's marks, and thus unjustly benefit from those actions. Moreover, the Respondent itself apparently derived revenue from charging each such non-member a fee for inclusion in its database and thus also unjustly benefited from exploiting the Complainant's marks.

In doing so, the Respondent also deprived the Complainant and its members of legitimate business opportunities and the associated revenue.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(iii) and 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <gayrealtor.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Dated: February 28, 2012