

ADMINISTRATIVE PANEL DECISION

Amy Stran v. EzDomainSearch.com, Juan Curtis
Case No. D2011-1710

1. The Parties

The Complainant is Amy Stran of West Chester, Pennsylvania, United States of America, represented by Cowan, Liebowitz & Latman, PC, United States.

The Respondent is EzDomainSearch.com, Juan Curtis of San Diego, California, United States.

2. The Domain Name and Registrar

The disputed domain name <amystran.com> is registered with GoDaddy.com, Inc. (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 Annexes 1 to 12) was filed with the WIPO Arbitration and Mediation Center (the "Center") by e-mail on October 7, 2011.

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 October 10, 2011, 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 October 14, 2011, 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 will expire on June 6, 2012, (b) the Policy applies to the disputed domain name, (c) the registration agreement is in English, and (d) 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 October 18, 2011, 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 Annexes, by e-mail together with the Center's "Written Notice of the Commencement of Administrative Proceeding" being sent to the Respondent by courier. 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 October 18, 2011, 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 November 7, 2011 to file its Response with the Center and the Complainant.

On November 7, 2011, the Respondent sent an informal communication, via e-mail to the Center, for which, later the same day, the Center acknowledged, to the parties, its receipt of the communication. The Panel will view this communication as the Response.

Pursuant to the Rules and Supplemental Rules, by e-mail letter dated November 18, 2011, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. On the same date, 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 November 18, 2011 had 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 December 2, 2011. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, notified the Parties of extension of the decision due date to December 16, 2011.

This dispute concerns one domain name, specifically <amystran.com> (the "disputed domain name").

4. Factual Background

According to the public Whois database appearing in Annex 1 to the Complaint, confirmed by the Registrar as well as by the Respondent's email communication to the Center of November 7, 2011, the disputed domain name was registered to the Respondent on June 6, 2009 and is set to expire on June 6, 2012.

A. Complainant's AMY STRAN Mark

As delineated below, the Complainant claims common law trademark rights in her personal name "Amy Stran", based on her continuous prior use, since at least as early as February 2009, of that name as a mark used in conjunction with her services as a stage and television celebrity, and subsequently as a television host. The Complainant has no trademark registrations for this mark.

B. Complainant's Activities

The Complainant is an individual named "Amy Stran". Currently, she is as a television program host for QVC, Inc., which is headquartered in the United States, is one of the largest at-home, television-network based shopping retailers in the world. QVC, Inc. and its affiliated companies (collectively "QVC") broadcast their shopping programs throughout the United States 24 hours a day, 7 days a week and are live 364 days a year.

At present, QVC's television broadcasts annually reach more than 98 million homes in the United States. Further, since 1996 QVC has also offered home shopping services via its websites located at "www.qvc.com" and "www.idvc.com". These websites attract more than 6 million unique visitors each month. Copies of hardcopy printouts of home pages of these websites appear in Annex 4 to the Complaint. QVC's broadcasts utilize twenty six program hosts including the Complainant. These hosts are the "face" of QVC's programs.

Ms. Stran joined QVC, Inc. in February 2009. Prior to joining QVC, Inc., Ms. Stran appeared in plays and on television, including speaking parts on *All My Children* and *One Life to Live*, two popular soap operas in the United States. As a host for QVC programming, Ms. Stran presents product information, conducts demonstrations, and interacts with on-air guests, celebrities, and viewers. Annex 5 to the Complaint contains a copy of a hardcopy printout, from QVC's website "www.qvc.com", which provides information about Ms. Stran along with her picture.

From the time she joined QVC to the present, Ms. Stran has become widely recognized as one of the more popular hosts on QVC. An Internet (Google) search for the name "Amy Stran" has revealed numerous entries, all relating to Ms. Stran. (Annex 6 to the Complaint contains a copy of a printout of results of that search, with some of the entries discussing Ms. Stran's career and popularity as a QVC program host.)

C. Respondent's Activities

The Respondent purchases domain names "online to resell" and specifically purchased the disputed domain name on June 6, 2009 and had renewed it yearly ever since.

Presently, the disputed domain name resolves to a parked page which provides advertisements for various services provided by the Registrar - as indicated, in Annex 8 to the Complaint, by a copy of a printout of that web page.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant asserts that, as a consequence of her continuous prior use of her name "Amy Stran" since at least as early as February 2009 as a mark for her services as an actress and ultimately television program host coupled with the ensuing popularity and recognition that name has attained over the ensuing years, her name has acquired distinctiveness in her industry. As such the Complainant contends that she has acquired common law trademark rights in her name sufficient to invoke paragraph 4(a)(i) of the Policy.

Given these rights, the Complainant contends that the disputed domain name identically incorporates her mark AMY STRAN with the addition of the generic top level domain (gTLD), “.com”, to the mark being immaterial.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in accordance with 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 name “Amy Stran” is not part of Respondent's personal name. The Respondent is known as “EzDomainSearch.com” which has no obvious relationship to the disputed domain name. Further the Respondent does not actually engage in any business or commerce under the Complainant's name nor is the Respondent commonly known by that name.

Second, the Respondent is not a licensee of Complainant, nor has the Respondent ever been authorized by Complainant to register or use the disputed domain name. In that regard, the Respondent has no relationship whatsoever to the Complainant.

Third, the website to which the disputed domain name currently resolves only provides content related to various services offered by the Registrar not the Respondent. None of that content indicates that the Respondent itself is using the disputed domain name in connection with a *bona fide* offering of its own goods or services. Further, the Respondent has not made any preparations to use the domain name with respect to such an offering.

(iii) Registered and Used in Bad Faith

The Complainant contends that, for two 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 is attempting to auction the disputed domain name at “www.lebay.com” auction website as indicated in Annex 12 to the Complaint by a copy of a printout of the pertinent page from that site. This indicates that the Respondent registered the disputed domain name primarily to sell it, presumably to the Complainant or a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs, thus violating paragraph 4(b)(i) of the Policy.

Second, the disputed domain name resolves to a parked page and has likely been doing so since it was registered in 2009, thus implying that the disputed domain name is being passively held. This further reflects bad faith use.

B. Respondent

The Response, though an informal communication, did not contain any substantive responses to any of the specific allegations raised by the Complainant. However, the Respondent stated, in its communication, that it purchases domain names “online to resell” and specifically purchased the disputed domain name on June 6, 2009 and had renewed it yearly ever since.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's AMY STRAN mark.

As a general matter, the Policy does not contain any restriction whatsoever that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence standing under the Policy, can lie with national trademark law. For a more general discussion of UDRP-relevant rights in a personal name, and for what typically needs to be shown for a complainant to successfully assert common law or unregistered trademark rights under the Policy, see paragraph 1.6 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition. In any event, in the present case, the Panel also finds it relevant to have regard to United States trademark law in particular. Under United States law which applies here, rights accrue in unregistered, so-called “common law”, marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: “Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”

Consequently, numerous UDRP panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, NAF Claim No. FA 95560 held: “ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy.” See, e.g., *Maria Bartiromo v. “Maria Bartiromo” and Dave Walton*, WIPO Case No. D2007-0242; *Animals for Advertising, Inc. v. Cathryn Long*, WIPO Case No. D2007-0049; *William M. Krings v. Hugo Hernandez*, WIPO Case No. D2006-0237; *Sound Unseen, Ltd.*; *Apple Bottoms, LLC*; and *Cornell Haynes p/k/a “Nelly” v. Patrick Vanderhorst*, WIPO Case No. D2005-0636; *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930; *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605; *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141; *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, NAF Claim No. FA 96795; *Missing Children Minnesota v. Run Yell Tell, Ltd.*, NAF Claim No. FA 95825 (November 20, 2000); *Mark Warner 2001 v. Mike Larson*, NAF Claim No. FA 95746; *CMG Worldwide Inc. v. Naughty Page*, NAF Claim No. FA 95641; *Home Properties v. SMS Online*, NAF Claim No. FA 95639; and *Bridal Rings Company v. Abert Yemenian/Albert Yemenian*, NAF Claim No. FA 95608. Furthermore, the panel in *United States Postal Service v. Consumer Information Organization*, NAF Claim No. FA 95757 held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, eResolution Case No. AF-0536, the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Chris Hatton d/b/a Sand Hill Wholesale Ceder Lod Furniture*, NAF Claim No. FA 95970, and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, NAF Claim No. FA 95832. Similarly, see *American Home Products Corporation v. Healthy Futures*, WIPO Case No. D2000-0454; *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229; *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131; and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015.

Given that common law trademark rights in the United States suffice for purposes of invoking paragraph 4(a)(i) of the Policy, the inquiry shifts to whether the Complainant had acquired common law trademark rights in her name Amy Stran. The Complainant’s use of her name as a mark in connection with her stage and television acting and hosting services dates back to at least February 2009 when she joined QVC and began appearing as a host on its programming. In actuality, those rights commenced even earlier due to her prior stage and television acting roles though the Complainant has not provided specific dates thereof.

At the very least, her common law rights precede by some four (4) months (and certainly more, given her roles prior to QVC) June 6 2009 on which the disputed domain name was registered and continue to the

present. As such, her common law rights not only have requisite priority over the Respondent's rights but also are continuing. Her name has also attained sufficient distinctiveness in her industry in connection with her acting and hosting services and more specifically her persona and thus has acquired requisite secondary meaning.

Since, as a predicate, the Panel has found that the Complainant has common law rights in the mark AMY STRAN, then no doubt exists that the disputed domain name is, for all practical purposes, identical to that mark. The difference between the name and that mark is merely the appending of a gTLD ".com" to the mark and the omission of spaces between the individual words in the mark. Well-established UDRP precedent holds that the addition of a gTLD, the deletion of spaces or other such trifling changes are utterly *de minimus*, if not completely irrelevant, in assessing identity/confusing similarity and thus is totally ignored. See, e.g., *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; and *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.

Therefore, the Panel finds that the disputed domain name <amystran.com> is identical to and sufficiently resembles the Complainant's mark AMY STRAN as to cause confusion; hence, the Complainant has shown identity between that mark and the disputed domain name 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 appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize her AMY STRAN mark in conjunction with any of the services with which she uses her mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark AMY STRAN or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Space Needle*, *Oakley*, *Burberry*, *HRB Innovations Inc.*, *Dreamworks*, *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *National Football League*, *Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com*, *Clark Signs*, *Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc.*, *Napster* and

Caesars Entertainment, Inc., supra; Pelmorex Communications Inc. v. weathernetwork, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between it and the AMY STRAND mark or even any mark similar thereto, at least for the services provided by the Complainant under her mark.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark AMY STRAN. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back prior to when the Respondent registered the disputed domain name, and the widespread and substantial reputation, notoriety and evident fame which the Complainant has gained in her mark ever since. See, e.g., *Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations Inc., MySpace and Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy. Moreover, the facts of record do not indicate that the Respondent's actions qualify under paragraphs 4(c)(i) or 4(c)(iii) of the Policy either.

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.

Obviously, in light of the Respondent's admission that it purchases domain names "online to resell", it clearly was well aware of the Complainant and her popularity either contemporaneously with or more likely well before it registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally proceeded to register the disputed domain name for the express purpose of reselling it and then passively held it ever since, now amounting to some two and half years, with the initial and continuing expectation of eventually exploiting the Complainant's goodwill in her name and mark to the Respondent's own pecuniary benefit.

The Respondent likely expected and the record certainly does not reflect otherwise that either the Complainant or one of her competitors would eventually purchase the disputed domain name from the Respondent at a sufficient profit. In one scenario, the Complainant might directly purchase the disputed domain name from the Respondent to prevent a third party from owning the disputed domain name and injuring the Complainant and her goodwill. Alternatively, in another scenario, the third party itself could purchase the disputed domain name from the Respondent through which that party could itself exploit the name and goodwill of the Complainant which, in turn, would very likely force the Complainant, in an effort to prevent further injury to her name and goodwill, to purchase the disputed domain name from that party at an even higher price, possibly significantly so, than what the Respondent had by then accepted. Either case would be detrimental to the Complainant and her goodwill and cause her financial injury. Accordingly, the Respondent's conduct in registering and using the disputed name as it did contravenes paragraph 4(b)(i) of the Policy.

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

Thus, the Panel concludes that the Complainant has provided sufficient proof of her allegations, with respect to the disputed domain name, to establish a *prima facie* case under paragraph 4(a) of the Policy upon which the relief she 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 <amystran.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Dated: December 11, 2011