



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

AutoNation Holding Corp. v. Rabea Alawneh

Case No. D2002-0058

1. The Parties

The Complainant is AutoNation Holding Corp., a Corporation of the State of Florida, having its principal place of business at 110 Southeast Sixth Street, 20th Floor, Fort Lauderdale, Florida, 33301 United States of America.

The Respondent is Rabea Alawneh located at 3987 S. Gessner # 137, Houston, Texas 77063, United States of America.

2. The Domain Name and Registrar

The Contested Domain Name is <autoway.com>.

The Registrar is Network Solutions, Inc. (NSI), located at 505 Huntmar Drive, Herndon, Virginia 20170, USA.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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 (the “Rules”) as approved on October 24, 1999 and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the “Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in e-mail form on January 25, 2002, and in hard-copy form on January 21, 2002 with Annexes A-H and the appropriate payment.

The Complainant's attorney stated that on January 17, 2002, he served a copy of the Complaint itself together with a copy of the cover sheet, on the Respondent by certified, first class mail.

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 24, 2002, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the contested domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the ICANN Policy applies to the contested domain name, (b) the current status of that domain name, and (c) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name.

On January 30, 2002, the Registrar provided its Response to the Center through which the Registrar provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of that name, stated that the language of the registration agreement is English, and stated that the domain name was then in an "active" status. The Registrar also informed the Center that the Respondent, through its registration agreement, submitted to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name.

On January 30, 2002, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, both in e-mail and hard-copy form, to the Respondent (with the latter method forwarding a copy of all the annexes as well). 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), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on January 30, 2002, 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 the Registrar, 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 February 19, 2002 to file its Response with the Center and serve a copy of the Response on the Complainant.

On February 18, 2002, the Center received an e-mail message from the Respondent's counsel stating that it had just be engaged by the Respondent to represent him in this proceeding and requested an additional 20 days to file a Response.

In an e-mail message dated February 18, 2002, the Center denied the Respondent's request for an additional 20 day extension but did grant the Respondent an extension of seven days, to February 26, 2002, to file its Response.

The Respondent submitted its Response, together with Annexes A-V, to the Center, via e-mail, on February 26, 2002, the receipt of which the Center acknowledged to the parties in an e-mail letter of the same date. Though the Complainant elected a single-member panel, the Respondent, in accordance with the Rules, elected a three-member panel, including listing its candidate panelists, and remitted the additional payment due the Center for such a panel. Consequently, the Center, through an e-mail letter dated February 27, 2002 requested the Complainant to submit, to the Center and no later than March 4, 2002, its list of candidate panelists. Through an e-mail message sent on March 4, 2002, the Complainant submitted its list of candidate panelists to the Center.

Accordingly, pursuant to the Rules and Supplemental Rules, the Center separately contacted Ms. Sally Abel, Esq. and Mr. G. Gervaise Davis, III, Esq. requesting their service as co-panelists. Each of these individuals accepted and returned, by facsimile, to the Center a suitably executed Statement of Acceptance and Declaration of Impartiality and Independence. Through an e-mail letter dated March 13, 2002, the Center notified the parties of the appointment of these individuals as co-panelists. Subsequently, the Center contacted Mr. Peter L. Michaelson, Esq., requesting his service as presiding panelist. Mr. Michaelson accepted and returned, by facsimile to the Center, his fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated April 9, 2002, notified the parties of the appointment of the entire panel.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before April 23, 2002.

On April 9, 2002, the Center received an additional submission filed by the Complainant followed on April 17, 2002 by an additional submission filed by the Respondent.

Due to various serious time conflicts which constitute extraordinary circumstances, the Panel extended the due date of its decision two weeks to May 7, 2002, and, by an e-mail message dated April 18, 2002, the Center so notified the parties.

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

The language of this proceeding is English.

4. Factual Background

A copy of the WHOIS registration record for the contested domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered this name with NSI on November 17, 1999.

A. The Complainant's "Autoway" marks

The Complainant owns various registrations, as indicated in a table in Annex C to the Complaint, for the mark "AUTOWAY": three in the United States and three in Mexico. Pertinent details of the US registrations, as obtained from the publicly web-accessible Trademark Electronic Search System (TESS) and Trademark Application and Registrations Retrieval (TARR) databases maintained by the United States Patent and Trademark Office (PTO) are as follows:

1) AUTOWAY (block letters)

US registration 2,396,111; registered October 17, 2000.

This service mark was registered for use in connection with: "Automobile dealership services" in international class 42. This mark claims first use and first use in inter-state commerce of December 31, 1999.

2) AUTOWAY (block letters)

US registration 2,396,110; registered October 17, 2000.

This trademark was registered for use in connection with: "Automotive parts and accessories, namely, aerodynamic fairings, axles, axle bearings, axle boots, bearings, belts, brake blocks for land vehicles, brake cylinders, brake hardware, brake linings, brake pads, brakes, burglar alarms for vehicles, bumpers, chassis, car-top luggage carriers, clutches, connecting rods not engine parts, fitted vehicle covers, semi-fitted covers for vehicles, directional signals, drive belts, drive gears, engines, fenders, glass windows for vehicles, horns, hub caps, liners for the cargo areas of vehicles, mirrors, mud guards, racks for vehicles, seat belts, seat covers, seat cushions, spoilers, steering boots, structural parts for automobiles, sunshades, sunroofs, suspension systems, tires, tire chains, tire patches, tire retreading caps, tire valves, torque converters, transmissions, vehicle trim insignias, valves, van conversions, wheel bearings, windshield sunshades and windshield wiper blades", all in international class 12. This mark claims first use and first use in inter-state commerce of December 31, 1999.

3) AUTOWAY (block letters)

US registration 1,860,002; registered December 14, 1994.

This service mark was registered for use in connection with: "Tune-up and automobile repair services" in international class 37. This mark claims first use and first use in inter-state commerce of July 31, 1993.

B. The Complainant's activities

The Complainant's rights in its "AUTOWAY" mark began as early as July 31, 1993, when its predecessor in interest began using the mark "AUTOWAY" in connection with its automobile repair services. Since that time, the Complainant has continuously used its "AUTOWAY" mark in connection with its goods and services in numerous markets and worldwide, by way of the Internet. The Complainant's "AUTOWAY" automobile dealerships are well-known and heavily advertised in relevant market areas.

On April 3, 2001, the Complainant sent a letter (a copy of which appears in Annex H to the Complaint) to the Respondent stating that the former owns the mark "AUTOWAY" and informed the Respondent that its use of the name "AUTOWAY" and the domain name <autoway.com> in connection with automobile-related services infringes the Complainant's trademark rights. The letter further demanded that the Respondent cease its allegedly infringing actions and assign the contested domain name to the Complainant. The Complainant received no response from the Respondent to its letter.

C. The Respondent's activities

The Respondent is using the contested domain name in connection with a web site offering automotive-related services, specifically a database for new and used car information and related service offerings. In that regard, the home page of the site, a hard-copy printout of which and related pages linked there through, appears in Annex E to the Complaint, states:

"AutoWay.com will help you to find great deals on both NEW & USED CARS. We do not stop there, but we will help to find you a free INSURANCE QUOTE, and LOW INTEREST FINANCE for your car."

Since June of 1999, the Respondent has been engaged in various business activities to implement his plan to develop a web site designed to provide a database to permit buyers and sellers of automobiles to find each other. He conceived the plan from his own frustrations in attempting to locate used automobiles to purchase. Specifically, the Respondent began to think about an appropriate name for the web site. He first thought about using, as a domain name, <toot-toot.com>. He purchased that domain name, talked with prospective business associates about the business with the domain name <toot-toot.com> but later decided not to use that particular domain name because of the slang meaning of the words. See affidavits of various individuals provided in Annexes B, C, D, E, F, G, H, T and U to the Response.

The Respondent knew an owner of a local grocery store with the name of Lucky Way Food Store. Consequently, the Respondent considered using the domain name <luckywaycars.com>. The Respondent discussed this possible name with his associates. See copies of affidavits from the owner and the manager of that store in Annexes D & E to the Response. However, the Respondent thought that the domain name would be too long, so he decided to use the contested domain name, <autoway.com>, instead. Neither the Respondent nor his associates had ever heard of any business by the name of "AutoWay". This name sounded like a new name to them. In that regard, see copies of the affidavits provided in Annexes B, C, D, E, F, G & H to the Response.

The Respondent hired a web site design company, Trinicom Communications, to design and create a web site for his business. A fully-functional web site was prepared and published on the domain name. Annex C to the Response contains a copy of an affidavit of the web site designer. Publication of the web site can be confirmed by searching the domain name on the "WayBack Machine" located at <www.archive.org>. The functional web site is currently undergoing modification and enhancement. It has, however, been published on the temporary location <www.trinicom.com/corp/rdemo>. The web site permits dealers to place inventory on the site and for consumers to search and locate the automobiles of interest. Copies of invoices, checks, payment summaries and other documents indicative of web site development appear in Annexes M, N, O, P, Q, R & S to the Response, along with an "Agreement for Building a Web Site" signed by the Respondent and Trinicom Communications and dated June 8, 1999. This

agreement includes various proposed layouts of portions of the site along with a contract price of \$ 1840.25 plus tax. The Respondent has also provided, as part of its annexes, copies of several invoices it received from Trinicom Communications dated from June 7, 1999 until January 1, 2002 for on-going services it rendered to the Respondent for, inter alia, web site design, site modification and subsequent hosting of the site.

The Respondent talked with owners of used car lots about marketing their inventory on his web site. Consequently, numerous used car dealers did, in fact, place their inventory on his web site. See Annexes B, C, D, E, F, G & H of the Response. Annexes I, J, K & L to the Response contain copies of affidavits from automobile dealers who purchased the Respondent's web site services accessible through the contested domain name.

As indicated by copies of affidavits provided in Annexes B, C, D, E, F, G and H to the Response, the Respondent states that neither he, his company nor any of his associates has:

- (a) registered or acquired the domain name in question for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is alleged to be the owner of a trademark or service mark in the words in question or to a competitor of the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name;
- (b) registered the domain name in question in order to prevent the owner of any trademark or service mark from reflecting the mark in a corresponding domain name; furthermore, neither Respondent nor any of her associates have engaged in a pattern of such conduct.
- (c) registered the domain name for the purpose of disrupting the business of the Complainant or any competitor;
- (d) attempted, through use of the contested domain name, to attract, for commercial gain, Internet users to a web site or other on-line location, by creating a likelihood of confusion with the Complainant's alleged mark as to the source, sponsorship, affiliation, or endorsement of a web site or location or of a product or service on a web site or location; or
- (e) had any intent for commercial gain to misleadingly divert consumers or to tarnish any alleged trademark/service mark.

5. Parties' Contentions

A. Complainant

i. Similarity

The Complainant contends that the contested domain name is identical to the Complainant's "AUTOWAY" marks.

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

ii. Legitimacy

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

Specifically, the Complainant takes the position that the Respondent is using the contested domain name in connection with a web site offering services substantially identical to the automobile related services provided by Complainant in connection with its "AUTOWAY" mark. In that regard, the Complainant points to the home page of the Respondent's web site which purports to describe the services available through the Respondent's web site as:

"AutoWay.com will help you to find great deals on both NEW & USED CARS. We do not stop there, but we will help to find you a free INSURANCE QUOTE, and LOW INTEREST FINANCE for your car."

Given this, the Complainant contends that the Respondent's use of the contested domain name clearly infringes the Complainant's nationwide, exclusive service mark rights in the "AUTOWAY" mark for use in conjunction with automobile dealership services and related goods and services. Hence, the Complainant concludes that, it is "beyond dispute" that, as a result of this infringement, the Respondent "can not have established any legitimate right or interest" in the contested domain name. In arguing its position, the Complainant cites to *The Chase Manhattan Corporation et al. v. John Whitely* WIPO Case No. D2000-0346 (June 12, 2000) ("An infringing use of Complainant's trademark can not give rise to a legitimate right or interest on the part of Respondent."), and *Hewlett-Packard Company v. Cupcake City* FA 93562 (Nat. Arb. Forum March 31, 2000, amended April 7, 2000) ("Respondent can have no rights in the phonetically identical domain name <hewlittpackard.com> because the trademark HEWLETT PACKARD is already owned worldwide by HEWLETT-PACKARD COMPANY.").

iii. Bad Faith

The Complainant contends that, also for various reasons, the Respondent has registered and is now using the contested domain name in bad faith.

First, the Complainant contends that, as a result of its federal trademark registrations having occurred in 1994 -- five years prior to the Respondent's registration of the contested domain name on November 1999, the Respondent has constructive notice of the Complainant's "AUTOWAY" mark. In that regard, the Complainant cites to Section 22 of the Lanham Act (15 U.S.C. § 1072) which states that "(r)egistration of a mark on the principal register ... shall be constructive notice of the registrant's claim of ownership thereof."

Second, the Complainant contends that the Respondent registered the contested domain name in order to confuse consumers. Specifically, the Complainant states that the Respondent currently uses the contested domain name in connection with a web site that provides information and links regarding automobile related services. Recognizing this, the Complainant contends that "[s]uch usage leads consumers to a service nearly identical to that of the automobile dealerships services offered by Complainant. Thus, Respondent clearly intends to benefit from Complainant's goodwill in its well-known mark, "AUTOWAY". Such intentional infringement designed to 'parasitiz[e] the goodwill of Complainant's trademark' is compelling evidence of bad faith in the

registration and use of the disputed domain name.” citing to *The Chase Manhattan Corporation et al. v. John Whitely*, cited *supra*.

Lastly, the Complainant contends that the Respondent’s actions in not responding to the Complainant’s letter of April 3, 2001, constitute further evidence of bad faith use and registration. In that regard, the Complainant states that “[i]f Respondent had any good faith basis for believing its use was not infringing, it would be reasonable to expect a return letter setting forth such basis. To the contrary, however, Responded has issued no response whatsoever.”

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

B. Respondent

Response

The Panel views the following, from the Response, as being the Respondent's salient contentions.

As matter of general principle, the Respondent argues, citing to the dissenting opinion in *America Online, Inc. v John Deep d/b/a Buddy USA Inc.* FA 96795 (Nat. Arb. Forum May 14, 2001), that the instant dispute falls outside the purview of the Policy for the simple reason that Policy is directed to simple, clear abusive registrations -- which this case is not -- and not to complex trademark disputes.

As to each element required under the Policy, the Respondent advances the following specific contentions.

i. Similarity

First, the Respondent contends that the only trademark registration which the Complainant has obtained prior to the Respondent’s registration of the contested domain name is the 1,860,002 registration. This registration was directed to use of the “AUTOWAY” mark in conjunction with “tune-up and automobile repair services” -- which are sufficiently different services from the Respondent’s services with which he uses the contested domain name, i.e., providing a database for individuals and dealers to locate automobiles for purchase along with related services.

Second, the Respondent contends that the Complainant has not proven that, apart from its federal registration of its “AUTOWAY” mark, that it has any common law trademark rights in that mark -- whether by adequate proof of secondary meaning or distinctiveness of the mark.

ii. Legitimacy

Here, the Respondent first contends that the Complainant’s very limited use of its “AUTOWAY” mark, pursuant to its 1,860,002 registration -- the only registration of relevance, inasmuch as the other two registrations issued subsequent to the date on which the contested domain name was registered -- is sufficiently different from the Respondent’s service and hence should not serve as a basis to “entitle Complainant to take away all domain names for all goods and services which may utilize the word.”

Furthermore, the Respondent states that its activities, all occurring prior to having notice of this dispute, aimed at developing and implementing its web site accessible through the contested domain name evidence demonstrable preparations to use the contested domain name in connection with a bona fide offering of goods or services, which under paragraph 4(c)(i) of the Policy suffices to show that the Respondent has legitimate rights and interests in the contested domain name.

iii. Bad Faith

The Respondent contends that, inasmuch as it had a legitimate interest in the contested domain name, it did not register that name in bad faith. Moreover, the Respondent's use of the contested domain name was not in bad faith.

First, as to having constructive notice of the Complainant's mark, the Respondent contends that it had no such notice inasmuch as the Complainant had not use its mark extensively and further that the Complainant's registration was for a service that "was much different from the database services" provided by Respondent's web site.

Second, as to the Complainant's contention that the Respondent having registered the contested domain name in order to confuse consumers, the Respondent contends that the Complainant has submitted no proof in support this contention, and the Respondent has submitted requisite proof to the effect that he had never heard of the name "AUTOWAY" and hence thought he could use it.

Third, regarding the Complainant's assertion that the Respondent's failure to respond to the Complainant's letter of April 3, 2001 evidences bad faith use, the Respondent contends that it had no obligation to respond to that letter -- particularly one it felt to be harassment.

Lastly, the Respondent points to the averments made in the affidavits, submitted in Annexes B, C, D, E, F, G and H to the Response, as to his actions and those of his company and his associates not constituting bad faith.

C. Complainant's additional submission dated April 9, 2002

In its additional submission of April 9, 2002, the Complainant:

- (a) specifies its prior use of its "AUTOWAY" marks, including the extent of its advertising along with the services for which those marks were used;
- (b) re-iterates its claim that the Respondent has infringed the Complainant's trademark rights, hence negating any legitimate rights and interests that the Respondent claims to have in the contested domain name;
- (c) states that the Respondent did not put forth any evidence that it performed a trademark or other investigation, which had it been performed, would have uncovered the Complainant's marks prior to having registered the contested domain name, hence indicating bad faith registration; and
- (d) points to various instances which it believes exemplify confusion and misdirection of Internet users arising out of the Respondent's continued use of the contested domain name, which serve to illustrate that the Respondent, through its actions, is creating a likelihood of confusion with Complainant's AUTOWAY mark, as to the source, sponsorship, affiliation, or endorsement of

Respondent's web site, and the automobile dealership services contained on Respondent's <autoway.com> web site, hence also signifying bad faith use.

D. Respondent's additional submission dated April 17, 2002

In essence, the Respondent, through its additional submission, argues that the Rules do not permit any party to make any additional unsolicited filings, and, as such, the Panel should refuse to consider the additional filing made by the Complainant.

The Respondent also argues that the Complainant has failed to include an appropriate certification in its additional filing and that the Complainant does not have requisite trademark rights prior to the date the Respondent registered the contested domain name that would encompass the services offered by the Respondent under that name.

6. Discussion and Findings

A. Additional submissions

The Panel categorically rejects that Respondent's contention that the Panel does not have the power to consider non-solicited additional submissions by any party.

While the Rules clearly delineate a procedure, for resolving disputes under the Policy, that, for the sake of expediency, relies on a single complaint and response, there is no prohibition -- contrary to the Respondent's view -- in either the Policy or the Rules which circumscribes a panel's authority to consider any additional material submitted by any party on its own initiative. In that regard, the Rules specify recognize, in the context of Rule 12, that situations may arise where a panel needs further information from the parties and hence authorizes the panel, acting in its sole discretion, to so request it via further statements from the parties. In a parallel fashion, under Rule 13, where a panel feels the written record then before it is inadequate and that the deficiency can be cured through an in-person hearing, the panel has the authority, acting in its sole discretion though limited to sufficiently exceptional circumstances, to order an in-person hearing.

It stands to reason that panels have a correlative authority, acting, in their sole discretion, under their general power specified under Rule 10(a) to "conduct the administrative proceeding in such manner as it considers appropriate", to decide whether or not to consider any additional statement which the panel receives, on a non-solicited basis, from any party. Of course, in making such a decision, any panel must ensure, consistent with Rule 10(b), that the parties are treated with equality and that each party is given a fair opportunity to present its case. To this Panel, it simply makes no sense to differentiate the panel's power simply based on whether the panel requested a submission or not; i.e., a panel can consider such a submission if and only if that panel specifically requested it but must automatically refuse to do so if a party, rather than the panel, initiated it.

That being said, panels generally frown on receiving additional submissions -- particularly after a panel has been fully appointed and the case provided to it for decision -- for the simple reason that such submissions tend to complicate the process, delay decision of the underlying dispute and run counter to the goals, embodied in the Policy, of providing a dispute resolution mechanism that is relatively simple, expeditious and cost-effective to the parties. Nevertheless, situations may well arise where either party believes it needs such a filing to adequately present its case and

presents sufficient justification for that filing. It is in those instances, as here, that a panel in assessing the underlying circumstances of a case will determine, in its sole discretion and on a case-by-case basis, whether to accept such a submission or not.

Here, this Panel has accepted and considered the additional submissions filed by the parties.

i. Similarity

No doubt exists whatsoever that the contested domain name is identical to the Complainant's "AUTOWAY" marks. The difference between the domain name and the registered mark is simply the inclusion of the generic top level domain ".com" to the domain name. This difference is utterly de minimus.

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

ii. Illegitimacy

The Policy, under paragraph 4(c), provides a non-exclusive list of factors, any one of which if proven by a respondent demonstrates that respondent's legitimate rights and interests in a contested domain name. Of particular relevance here is the factor recited in paragraph 4(c)(i) which states: "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services".

The Respondent has clearly proven by substantial, overwhelming and undisputed evidence that prior to his having received notice of this dispute, via the Complainant's April 3, 2001 letter, he made demonstrable preparations to use the contested domain name, <autoway.com>, in connection with offering an on-line database and related services in connection with new and used automobiles. In fact, not only did the Respondent engage in demonstrable preparations commencing approximately two years prior to receiving such notice, i.e., starting on June 8, 1999 -- which is actually prior to his having registered the contested domain name, but also the Respondent engaged a continuous stream of activity from that date to the present culminating in an operational site resolvable through the contested domain name through which the Respondent offers its services to Internet users. In that regard, the Respondent contracted for the construction of his web site, and, through his web site designer, had the web site designed, placed on-line, repeatedly modified and actually offered his services through that site -- service offerings which continue to this date.

It is simply beyond question that the Respondent's activities directly fall within the purview of paragraph 4(c)(i) of the Policy. As such, the Panel finds that the Respondent has legitimate rights and interests in the contested domain name.

While the Complainant has repeatedly asserted issues of trademark infringement, those assertions are entirely misplaced and totally inappropriate for resolution through an ICANN proceeding. The scope of an ICANN proceeding is extremely narrow: it only targets abusive cybersquatting, nothing else. ICANN proceedings, which by their very nature are highly abbreviated with very limited fact finding, are not designed to nor should they be used as a substitute for trademark infringement actions. ICANN panels, such as this one, simply have no authority to consider issues of trademark infringement. Such issues must be left for judicial review.

iii. Bad Faith

Given that the Respondent has clearly proven that he has legitimate rights and interests in the contested domain name, the issue of whether the Respondent registered and used the domain name in bad faith is moot. Hence, the Panel sees no need to address that issue and declines to do so.

7. Decision

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant, namely transfer of the contested domain name, is hereby **DENIED**.

Peter L. Michaelson, Esq.
Presiding Panelist

Sally M. Abel, Esq
Panelist

G. Gervaise Davis, III, Esq.
Panelist

Dated: May 1, 2002