



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol

Case No. D2001-0489

1. The Parties

The Complainant is Disney Enterprises, Inc. of 500 South Buena Vista Street, Burbank, California 91521, USA, represented by its Corporate Counsel, Christopher S. Ruhland, Esq.

The Respondents are John Zuccarini, Cupcake City and Cupcake Patrol a/k/a John Zuccarini, formerly of 957 Bristol Pike, Suite D-6, Andalusia, Pennsylvania 19020, USA, and of Atlanta, Georgia, U.S.A and currently of Music Wave Investments Ltd., Saffrey Square, Suite 106, P.O.Box N-4140, Nassau, N.P., Bahamas, represented by Christopher A. Grillo Esq. Law Office of Fort Lauderdale, Florida, U.S.A.

2. The Domain Names and Registrars

This dispute concerns the domain names listed below alongside the current registrant and registrar:

<u>Domain Name</u>	<u>Registrant</u>	<u>Registrar</u>
<disneychanel.com>	John Zuccarini	CSL GmbH
<disneywallpaper.com>	Cupcake City	Network Solutions, Inc.
<disneywold.com>	John Zuccarini	CSL GmbH
<disneywolrd.com>	Cupcake Patrol	CORE Internet Council
<disneyword.com>	John Zuccarini	CSL GmbH
<disneyworl.com>	John Zuccarini	CSL GmbH
<walddisney.com>	Cupcake Patrol	CORE Internet Council

3. Procedural History

This is an administrative proceeding pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, in accordance with the Rules for

the Policy, approved by ICANN on October 24, 1999, (“the Rules”) and the Supplemental Rules for the Policy (“the Supplemental Rules”) of the WIPO Arbitration and Mediation Center (“the Center”).

The Complaint was filed with the Center by e-mail on April 3, 2001 and in hard copy on April 6, 2001. The Center acknowledged receipt on April 9, 2001 and next day sought confirmation of registration details from the registrars.

CSL GmbH responded on April 10, 2001. It confirmed that the current registrant of the domain name <disneychanel.com> is Mr Zuccarini of “Atlanta, Georgia, 30350, US”, with no street address. The name was registered with CSL GmbH on April 10, 2000.

Network Solutions responded on April 12, 2001. It confirmed that the current registrant of the Disputed Domain Name <disneywallpaper.com> is Cupcake City, with Mr. Zuccarini being the Administrative and Billing contact (at his Pennsylvania address); and that the registrar’s #4 Service Agreement [which incorporates the Policy] is in effect.

CORE Internet Council of Registrars (“CORE”) responded on April 10, 2001. It confirmed that the current registrant of the Disputed Domain Names <disneywold.com> and <walddisney.com> is Cupcake Patrol and that Mr. Zuccarini is the Administrative, Technical and Zone contact, at his Nassau address. Mr. Zuccarini is recorded as the owner of Cupcake Patrol. The record was created on May 13, 2000. The Policy has applied since December 1, 1999.

The Complaint, as filed, alleged the domain names <disneywold.com>, <disneyword.com> and <disneyworl.com> were registered (in the name Cupcake Patrol) with CORE but, in response to the Center’s enquiry, CORE stated that this was not so. On April 12, 2001 the Center notified the complainant of this deficiency in the Complaint and that day the complainant responded, saying that Exhibit 1 to the Complaint showed CORE as the registrar when the Complaint was filed and it therefore appeared that after the Complaint was filed and a copy was sent to the Respondent by the Complainant as required by Rule 3(b)(xii), there had been a change of registrar to CSL GmbH and a change of registrant to Mr. Zuccarini.

The Complainant noted that CSL GmbH is a member of CORE; it registers domain names through CORE; it is the registrar of one of the other Disputed Domain Names and had received a copy of the Complaint (which, of course, specifies all the Disputed Domain Names). The Complainant submitted the deficiencies should be deemed cured and the Complaint deemed compliant.

On April 16, 2001 the Center sought from CSL GmbH confirmation of the registration details in relation to the domain names <disneywold.com>, <disneyword.com> and <disneyworl.com>. On April 20, 2001 CSL GmbH confirmed it is the current registrar of those names and that the current registrant is Mr. Zuccarini at his Nassau address. Following inquiries by the Center at the behest of the panel, CSL GmbH stated on June 13, 2000 that these domain names were transferred from CORE to CSL GmbH on April 8, 2001.

Through the Complaint, the Complainant requested a single member Panel.

The Center completed its formality review of the Complaint on April 23, 2001. This included noting that the Complaint identified the registrars with whom the domain

names were registered at the time the Complaint was filed and noting that, in accordance with paragraph 3(b)(xiii) of the Rules, the Complainant had agreed, with respect to any challenge to a decision by the Panel to transfer or cancel the Disputed Domain Names, to submit to the jurisdiction of the courts where the Respondents are located, as shown by the address given for the Respondents in the concerned registrars' Whois database at the time of the submission of the Complaint to the Center.

On April 23, 2001 the Center notified the Respondents of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondents, by e-mail and in hardcopy by post/courier (the latter including a copy of the Exhibits supplied by the Complainant). The Complaint and its accompanying documents and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on April 23, 2001, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and the three registrars 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 last day specified in the notice for a Response to be filed with the Center was May 12, 2001.

On April 23, 2001 Mr. Zuccarini sent an email to the Center stating that he no longer lives in Pennsylvania or Atlanta and that it would be against U.S. Federal law for him to file a lawsuit in "the proposed districts of jurisdiction by the Complainant", stating the appropriate places of jurisdiction would be either his current address in Nassau, Bahamas, or Geneva, Switzerland (the location of the Registrar CORE). He considered the entire domain name dispute process invalid and said that, "should the subject domains be taken away from me I will immediately file a lawsuit in Geneva Switzerland against ICANN and the WIPO".

The Center responded the next day, noting that a copy of the Complaint and Notification was also being sent to the Respondents' Nassau address.

On May 8, 2001 a Response was filed at the Center in hardcopy. Its receipt was acknowledged that day and an electronic copy was requested, in accordance with Rule 5(b). The electronic copy was received by the Center on May 10, 2001.

The Respondents requested a three-member panel and the applicable fee was paid.

On June 1, 2001 the Center notified the parties of the appointment of the undersigned panelists, in accordance with the procedure specified in Rule 6(e) and Supplemental Rule 7, the three panelists having submitted to the Center Statements of Acceptance and Declarations of Impartiality and Independence. The notice nominated June 15, 2001 as the projected date on which the decision is to be forwarded to the Center.

The language of this proceeding is English.

4. Factual Background

In 1923, Walter E. Disney founded the predecessor to the Complainant, which is the owner of a family of trademarks incorporating the famous DISNEY mark. Since 1923, the Complainant or its wholly owned subsidiaries or affiliated companies have engaged in a wide variety of entertainment businesses under the DISNEY mark or a DISNEY-formative mark.

The Complainant and the goods and services sold to the public under these marks have been enormously successful and popular. For example, The Walt Disney Company (the holding company for the complainant) reported revenues of over \$25,000,000,000.00 for the year 2000. Surveys consistently indicate that the DISNEY brand is one of the most well-known and valuable brands in the world.

Certain of the Complainant's businesses are particularly relevant to the present dispute because of the variations on the DISNEY mark which the Respondents have registered as domain names.

- a. Since 1971, one of the Complainant's affiliated companies has operated the WALT DISNEY WORLD Resort in Orlando, Florida. This resort complex, sometimes referred to simply as DISNEY WORLD, contains several theme parks, as well as numerous hotels, restaurants, and retail stores. The WALT DISNEY WORLD Resort is one of the most popular tourist destinations in the world. In 1998, the WALT DISNEY WORLD Resort welcomed its 600,000,000th guest.
- b. Since 1983, one of the Complainant's affiliated companies has operated the DISNEY CHANNEL cable television network. The DISNEY CHANNEL broadcasts a variety of family programming and has become immensely popular. The DISNEY CHANNEL network now reaches almost 70,000,000 homes in the United States and approximately 13,000,000 subscribers in other countries. DISNEY CHANNEL programming has won numerous awards from organizations such as the Academy of Television Arts & Sciences, the Directors Guild of America, and the Writers Guild of America.
- c. Since 1996, one of the Complainant's affiliated companies has operated a website at <disney.com> and has used the <disney.com> mark in connection with that site. <disney.com> offers entertainment, shopping, downloads (including computer wallpaper themes), vacation planning, news and information about the Complainant and other features. <disney.com> is consistently ranked as one of the most popular entertainment websites in the world (measured in terms of the number of unique visitors).

The Complainant's substantial trademark portfolio includes:

- ? over 50 United States trademark registrations for marks that include the DISNEY mark, such as DISNEY (for books and other printed matter), DISNEY CHANNEL (for television broadcasting and production services), <disney.com> (for various online services), DISNEY ONLINE (for various online services), WALT DISNEY (for video cassettes, books, and

other printed matter), and WALT DISNEY WORLD (for various types of entertainment services and various types of merchandise);

- ? hundreds of registrations for DISNEY and DISNEY-formative marks outside the United States for many different goods and services, and particularly for those described above, including almost 400 foreign trademark registrations for the DISNEY and WALT DISNEY marks alone, i.e., excluding other DISNEY-formative marks.

The Complainant also owns scores of domain names that include the DISNEY mark, including <disney.com>, <disneychannel.com>, <disneyworld.com>, <waltdisney.com>, and <waltdisneyworld.com>. These domain names were registered and used long before Respondents registered the Disputed Domain Names.

The DISNEY mark and the DISNEY family of marks are distinctive and famous. As one court stated more than 30 years ago, “the association of the name ‘DISNEY’ with the business enterprises, goods, services and activities of [the Complainant and its affiliated companies] is so widely accepted in the mind of the general public . . . that said name has become and is distinctive . . . and has acquired and now has a secondary meaning and distinctiveness throughout the United States . . .” *Walt Disney World Co. v. Disney Area Acreage, Inc.*, 316 F. Supp. 285, 286-87 (S.D. Fla. 1970).

The Disputed Domain Names were registered by the Respondents as follows:

<disneychanel.com>	February 10, 2000
<disneywallpaper.com>	July 12, 1999
<disneywold.com>	April 11 2000
<disneywolrd.com>	June 4, 2000
<disneyword.com>	April 11, 2000
<disneyworl.com>	April 11, 2000
<walddisney.com>	May 13, 2000

All uses by the Complainant of the DISNEY mark and the DISNEY family of marks commenced prior to the Respondents’ unauthorized registration and use of the Disputed Domain Names.

5. Parties’ Contentions

A. Complainant

Respondent’s Infringing Conduct

John Zuccarini is in the business of registering domain names containing famous trademarks (or slight misspellings of those trademarks), then using these domain names to redirect unwitting Internet users to advertisements and commercial websites. He has been quite prolific in this regard. His registration and use of the Disputed Domain Names constitutes the same conduct that courts and administrative panels repeatedly have condemned.

Zuccarini’s History of Infringing Conduct

Either in his own name or in the name of one of his “Cupcake” entities, Mr. Zuccarini has registered numerous infringing domain names. Often, the domain names contain slight misspellings of famous trademarks. Internet users who accidentally enter one of Mr. Zuccarini’s domain names in their browsers generally are bombarded with multiple “pop-up” windows for advertisements or commercial websites. According to one federal court, Mr. Zuccarini admitted that he makes almost \$1,000,000.00 per year in revenue generated from Internet users clicking on these domain names. See *Shields v. Zuccarini*, 89 F. Supp. 2d 634, 639 n.7 (E.D. Pa. 2000). Obviously, “the profitability of Mr. Zuccarini’s enterprise is completely dependent on his ability to create and register domain names that are confusingly similar to famous names”: *Electronics Boutique Holdings Corp. v. Zuccarini*, 56 U.S.P.Q.2d 1705, 1710 (E.D. Pa. 2000).

Courts and administrative panels consistently have held that Mr. Zuccarini’s conduct violates the Policy and the Anticybersquatting Consumer Protection Act. By last count, Mr. Zuccarini has lost more than thirty Policy decisions, including the following: *NCRAS Management, LP v. Cupcake City*, WIPO Case No. D2000-1803; *Twentieth Century Fox Film Corp. v. Cupcake Confidential*, NAF Case No. FA96118; *WebMD Corp. v. Cupcake Patrol*, NAF Case No. FA96106; *At Home Corp. v. John Zuccarini*, WIPO Case No. D2000-1524; *American Online, Inc. v. John Zuccarini*, WIPO Case No. D2000-1495; *United Feature Syndicate v. John Zuccarini*, WIPO Case No. D2000-1449; *Nicole Kidman v. John Zuccarini*, WIPO Case No. D2000-1415; *Microsoft Corp v. Cupcake Patrol*, WIPO Case No. D2000-1344; *Minolta Co. v. Cupcake City*, WIPO Case No. D2000-1291; *FAO Schwartz v. John Zuccarini*, NAF Case No. FA95828; *Hewlett-Packard Co. v. Cupcake Patrol*, NAF Case No. FA95822; *Victoria’s Secret v. John Zuccarini*, NAF Case No. FA95762; *Musicmatch, Inc. v. Cupcake Patrol*, NAF Case No. FA95733; *American Airlines, Inc. v. John Zuccarini*, NAF Case No. FA95695; *Gamesville.com, Inc. v. John Zuccarini*, NAF Case No. FA95294; *Abercrombie & Fitch Stores, Inc. v. John Zuccarini*, WIPO Case No. D2000-1004; *Diageo plc v. John Zuccarini*, WIPO Case No. D2000-0996; *Microsoft Corp. v. Cupcake City*, WIPO Case No. D2000-0818; *Budget Rent a Car Corp. v. Cupcake City*, WIPO Case No. D2000-1020; *Blackboard Inc. v. Cupcake Patrol*, WIPO Case No. D2000-0811; *Yahoo! Inc. v. Cupcakes*, WIPO Case No. D2000-0777; *Yahoo! Inc. v. Cupcake Patrol*, WIPO Case No. D2000-0928; *Cabela’s Inc. v. Cupcake Patrol*, NAF Case No. FA95080; *Cabela’s Inc. v. John Zuccarini*, NAF Case No. FA95233; *Dow Jones & Co. v. John Zuccarini*, WIPO Case No. D2000-0578; *Diageo plc v. John Zuccarini*, WIPO Case No. D2000-0541; *Encyclopedia Britannica, Inc. v. John Zuccarini*, WIPO Case No. D2000-0330; *L.L. Bean, Inc. v. Cupcake Patrol*, NAF Case No. FA95105; *Spiegel Catalog, Inc. v. John Zuccarini*, eResolution Case No. AF-0237a-d; *James Squires v. John Zuccarini*, eResolution Case No. AF-0218. In addition, in two federal court cases (which have generated five reported decisions), trademark owners have been awarded injunctions and monetary judgments that total over \$600,000.00. See *Electronics Boutique Holdings Corp. v. Zuccarini*, 56 U.S.P.Q.2d 1705 (E.D. Pa. 2000), and further order in 2001 WL 83388 (E.D. Pa. Jan. 25, 1991); *Shields v. Zuccarini*, 89 F. Supp. 2d 634 (E.D. Pa. 2000), and further order in 2000 WL 1056400 (E.D. Pa. June 5, 2000), and further order in 2000 WL 1053884 (E.D. Pa. July 18, 2000).

It is evident that these adverse decisions have had little or no impact on Mr. Zuccarini’s business model. As the court noted in Shields, even after the entry of a preliminary injunction against him, Mr. Zuccarini “registered hundreds of misspellings of the names of celebrities . . . [and also] registered variations on [third parties’ trademarks]. Clearly, he has not gotten the crystalline message in [the court’s] March 22 opinion and June 5 order.” Shields, 2000 WL 1053884 at *1. As of the filing of this complaint, Mr.

Zuccarini still owns a large number of domain names that are either identical or very similar to trademarks or celebrities' names. These include <usatodaysports.com>, sportillstrated.com, <nikoncameras.com>, <playboy-mag.com>, <backstretboys.com>, <jeneferlopez.com>, <elizabethhurly.com>, <michealjordan.com>, and <brittnayspears.com>.

This state of affairs recently prompted one WIPO panel to lament:

It is indeed unfortunate, given the rampant, repetitive and pernicious conduct in which this particular Respondent has engaged and the remaining cumulative cost to affected trademark owners to ultimately remediate the remnants of that conduct, that the Panel is unable to render a single global and economically-efficient decision that rectifies this situation once and for all. The Panel, though clearly desirous of doing so, simply does not have the requisite power to do so. Consequently, remediation must be left to other complainants, as had occurred and will likely so continue, collectively proceeding on a piecemeal basis against this Respondent through other legal proceedings, whether in the courts or through administrative bodies, to seek transfer of the particular domain name(s) of interest to them: *NCRAS Management, LP v. Cupcake City*, WIPO Case No. D2000-1803.

The Complainant's complaint in this proceeding is yet another in a long line of individual actions that trademark holders have had to take against Mr. Zuccarini.

As described below, the Respondent has registered and used the Disputed Domain Names in the same manner as the domain names that were the subject of the Policy proceedings and federal lawsuits discussed above. Accordingly, the result in this proceeding should be the same, namely, the Respondents should be ordered to transfer the Disputed Domain Names to Disney.

Respondents' Unauthorized Registration and Use of the Disputed Domain Names

Among the hundreds of domain names registered by the Respondents are the seven Disputed Domain Names. All of these incorporate the famous DISNEY mark and also contain other references to Disney and its goods or services or slight misspellings of other marks within the DISNEY family of marks, as follows:

- a. <Disneychanel.com> – a misspelling of DISNEY CHANNEL.
- b. <Disneywallpaper.com> – a reference to the fact that Internet users can download DISNEY wallpaper for their computers at DISNEY.COM.
- c. <Disneywold.com> – a misspelling of DISNEY WORLD.
- d. <Disneywolrd.com> – another misspelling of DISNEY WORLD.
- e. <Disneyword.com> – another misspelling of DISNEY WORLD.
- f. <Disneyworl.com> – another misspelling of DISNEY WORLD.
- g. <Walddisney.com> – a misspelling of WALT DISNEY.

When Internet users mistakenly enter <Disneywold.com>, <Disneywolrd.com>, <Disneyworl.com>, <Disneyworl.com>, or <Walddisney.com> into their web browsers, at least nine “pop up” windows appear. These “pop up” windows contain third-party websites and advertisements for goods and services such as music, games, credit approval, and casinos. After an Internet user closes these windows, additional “pop up” windows appear, which contain more third party advertisements or websites for MP3 downloads and lotteries. This tactic of continuously opening new browser windows, even as an Internet user tries to close them, is known as “mousetrapping.” Disney is not affiliated with, and has not given any permission to use its trademarks to, any of the websites that appear in the “pop up” windows.

<Disneywallpaper.com> directs Internet users to a black screen. <Disneychanel.com> directs to an error message.

Disney has never licensed or authorized the Respondents to register or use any of Disney’s marks.

The Disputed Domain Names Are Confusingly Similar To the Complainant’s Marks

As described above, all of the Disputed Domain Names fully incorporate the famous DISNEY mark. Most of the names also either fully incorporate or contain slight misspellings of other DISNEY-formative marks, including DISNEYCHANNEL, DISNEY.COM, WALT DISNEY, and WALT DISNEY WORLD. Thus, there is no question that all of the Disputed Domain Names are confusingly similar to the DISNEY mark and many of the names are also confusingly similar to other DISNEY-formative marks. See, e.g., *EAuto, L.L.C. v. Triple S. Auto Parts*, WIPO Case No. D2000-0047 (“When a domain name incorporates, in its entirety, a distinctive mark, that creates sufficient similarity between the mark and the domain name to render it confusingly similar.”); *Yahoo! Inc. v. Cupcake Patrol*, WIPO Case No. D2000-0928 (finding that Mr. Zuccarini’s domain names, all of which misspelled Yahoo!’s trademarks, were confusingly similar “because Complainant’s famous trademark forms the nongeneric part of each and every one of the disputed domain names”).

The Respondents Have No Rights Or Legitimate Interests In The Disputed Domain Names

The Respondents will not be able to demonstrate that their conduct satisfies any of the conditions in paragraph 4(c) of the Policy. Specifically, (i) the Respondents are not using and have not demonstrated an intent to use the Disputed Domain Names or names corresponding to the Disputed Domain Names in connection with a bona fide offering of goods or services; (ii) the Respondents are not and have not been commonly known by the Disputed Domain Names; and (iii) the Respondents are not making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent to misleadingly divert consumers or to tarnish the Complainant’s marks for commercial gain. To the contrary, the Respondents are using the Disputed Domain Names to profit by deceiving consumers. What one WIPO panel noted in a proceeding initiated by another famous trademark owner is equally true in this proceeding: “[I]n the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent”: *Guerlain S.A. v. Peikang*, WIPO Case No. D2000-0055. Furthermore, Panels have found repeatedly that Mr. Zuccarini had no rights or legitimate interests in

domain names in similar contexts. As one panel noted, “the sheer volume of arbitral and judicial opinions against” Mr. Zuccarini is sufficient to establish a prima facie case that he does not have rights or legitimate interests in confusingly similar domain names: *Nicole Kidman v. John Zuccarini*, WIPO Case No. D2000-1415.

The Respondents Registered And Are Using The Disputed Domain Names In Bad Faith

As set forth below, the Respondents’ bad faith is established under paragraphs 4(b)(ii) and 4(b)(iv) of the Policy, as well as by the other circumstances surrounding the Respondents’ registration and use of the Disputed Domain Names.

Pursuant to paragraph 4(b)(ii) of the Policy, the Respondents’ bad faith is established by their pattern of conduct over several months in registering seven domain names containing the DISNEY mark and DISNEY-formative marks. These registrations prevent the Complainant from using its own mark in corresponding domain names. Numerous WIPO decisions have held that the registration of multiple domain names containing a complainant’s mark or marks is alone sufficient for a finding of bad faith. See, e.g., *General Electric Co. v. Normina Ansalt*, WIPO Case No. D2000-0452 (“The registration of several names corresponding to Complainant’s trademarks is sufficient to constitute a pattern of such conduct, and thus to constitute bad faith within the meaning of paragraph 4(b)(ii) of the Policy.”); *The Price Co. v. Price Club*, WIPO Case No. D2000-0664 (“The selection of three domain names that are virtually identical to complainant’s famous mark demonstrates that these were abusive registrations contrary to the Policy.”); *Yahoo! Inc. v. Strynk, Inc.*, WIPO Case No. D2000-1675 (registration of only two YAHOO!-formative domain names constituted a “pattern of conduct” within the meaning of paragraph 4(b)(ii)). Moreover, the Respondents’ pattern of registering domain names containing other well-known trademarks owned by third parties, as discussed above, is strong evidence that the Respondents have acted in bad faith pursuant to paragraph 4(b)(ii). See *America Online v. John Zuccarini*, WIPO Case No. D2000-1495; *Diageo p.l.c. v. John Zuccarini*, WIPO Case No. D2000-0541.

The Respondents’ bad faith also is established under paragraph 4(b)(iv) of the Policy. The Respondents use misleading domain names to redirect to numerous third-party sites unwitting Internet users who try to reach one of the Complainant’s websites. Some of these websites compete with the Complainant in the offering of, for example, games and music. This intentional effort to attract users to non-Disney websites for commercial gain depends upon the Respondents’ creation of consumer confusion. Paragraph 4(b)(iv) expressly recognizes this type of conduct as bad faith. Once again, Mr. Zuccarini’s use of other trademark owners’ domain names in this very manner has been described as “directly contravene[ing] paragraph 4(b)(iv) of the Policy”: *NCRAS Management, LP v. Cupcake City*, WIPO Case No. D2000-1803.

The Respondents’ use of the Disputed Domain Names is particularly harmful because it consists largely of “typosquatting,” i.e., registering and using slight misspellings of the Complainant’s trademarks. After noting that “typosquatting” is “a practice that has been condemned,” one WIPO panel explained why the registration and use of misspelled trademarks as domain names constitutes bad faith:

“Respondent is trading on the value established by Complainant in its marks to attract users who misspell or mistype Complainant's mark when entering the URL, which includes Complainant's domain name. Clearly, Respondent is deriving economic benefit from this practice, either by attracting users to Respondent's website, where goods and services are offered, or by the

receipt of compensation from the owners of other websites for delivering users to those sites. This constitutes bad faith registration and use as defined by paragraph 4(b)(iv) of the Policy”: *Yahoo! Inc. v. Data Art Corp.*, WIPO Case No. D2000-0587.

The same is true in this case. For example, an Internet user who accidentally types <Disneyworld.com> into a web browser will not access the Complainant’s <disneyworld.com> website, as the user had intended. Instead, the user will reach several unauthorized commercial websites. The Respondents’ pattern of deliberately misleading users plainly constitutes bad faith under the Policy.

Finally, the Respondents have committed bad faith under the “catch all” provision of paragraph 4(b). Given the distinctiveness and fame of the DISNEY mark and DISNEY-formative marks, there is no plausible explanation for the Respondents’ registration of the Disputed Domain Names other than to trade upon the goodwill the Complainant has developed in its marks. See *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (finding bad faith where “[g]iven the Complainants numerous trademark registrations for, and its wide reputation in, [Complainant’s mark], . . . it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name [at issue].”

B. Respondent

Preliminary matter

The Respondent(s) are [sic] no longer located at 957 Bristol Pike, Suite D-6, Analusia, Pennsylvania 19020. Respondents have attempted to change its [sic] registration address to reflect its [sic] current address. However, ICANN’s policy precludes Respondent Zuccarini to change his registration address and does not permit a change of address while proceedings have commenced.

Respondent [sic] submits that this portion of ICANN’s policy is arbitrary and capricious where it fails to recognize that the denial of the change of address of the Registrant of the domain materially affects the jurisdiction and venue of any court action required under WIPO’s Policy and pursuant to Paragraph 3(b)(xiii). In the instant case, even though the Complainant is aware of the Respondent’s correct address it still attempts to stipulate to a jurisdiction, which cannot be achieved.

The Administrative Panel is requested to rule that the Jurisdiction and Venue of any cause challenging a decision of this WIPO panel be subject to the Courts of Justice located in Geneva, Switzerland.

STANDARD OF REVIEW

This panel reviews the Complaint to determine whether the following factors are proven:

1. the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. the Respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name was registered and is being used in bad faith.

The Respondent submits that his conduct does not infringe on any of the Complainant's marks, since:

1. The domain names are not identical or confusingly similar to the trademark, or service mark(s).

It is well settled that a domain name is simply an Internet Protocol (IP) address. In essence, a numerical code that can alternatively be used with a name to reach the same place on the Internet, See *Thomas v Network Solutions, Inc.*, 176 F.3d 500, 503 (D.C. Cir. 1999). In the instant case, as in all cases of domain name misspellings, Zuccarini purchased a particular numerical IP address that in no way can be confused with any of the Complainant's domain IP addresses.

In fact, recent Federal Courts have determined that similarity of domain names cannot be construed as confusing simply because a visitor may inadvertently visit the challenged Internet site.

In a recent Court decision, *Interstellar Starship Services V. Epix Incorporated*, 125 F.Supp.2d 1269, 2001 WL 10885 (D.Or. 2001), the Court found that "The fact that some of defendant's potential customers go to <epix.com> by mistake because they hazard a guess that defendant owns the site also does not demonstrate actual confusion. Today's Internet user knows that search engines, such as "Hotbot," "Lycos," and "Google," provide a quick, free and reliable way to locate a business' website when its exact Internet address is not known. Nevertheless, many users will still try "[company name].com" before using a search engine because there is little effort and no cost to anyone in making a guess."

In legislating trademark infringement, Congress has determined that its legislation will not apply to *all commercial uses of a trademarked phrase* in a domain name. Instead of a simple showing of "visual similarity", a plaintiff must show three elements, including: (1) a sufficiency of similarity of marks present to place in the minds of consumers the mental association, (2) that causes, (3) any actual harm to the senior mark's economic value in identifying a given product. *This threshold allows for a domain to be partly composed of a trademark phrase, yet no dilution of a trademarked phrase is caused by its use.* For instance, a trademarked term such as <hardrock.com> will not be diluted by a domain entitled <therock.com>. No dilution has occurred here because the law does not per se prohibit the use of a trademark or service owner's mark. *Rather the law only prohibits uses that actually infringe or dilute a trademark or service owner's mark*, see H.R. Rep. No. 104-374, at 4, reprinted in 1995 U.S.C.C.A.N. 1029, 1031. Habro, at 133.

The Courts, in determining whether there has been any confusion (of domain names), will take into account whether the defendant's use of the disputed mark has prevented another from obtaining the services the plaintiff has to offer, or whether the plaintiff's reputation has been damaged in any way: *I.P. Lund Trading v Kohler Co.*, 163 F.3d 27, 36-27 (1st Cir. 1998). The Lund Court further held that not just any similarity between two marks will be enough to justify a finding of trademark infringement. There must be a showing of a substantial likelihood of confusion: *Id.* at 43.

In *Hasbro v Clue Computing, Inc.*, 66 F.Supp 117 (D. Mass 1999), the Court ruled in favor of the defendant after a thorough traditional trademark analysis. It found that the marks of both parties were essentially the same. However, it focused on other factors to render its judgment. It found that there was virtually no similarity between the products

that the parties offered. It found that those who visited the website “were sophisticated enough to know the difference between a game and a computer consulting service.... The court held “There was no reasonable likelihood of confusion because any visitor who mistakenly traveled to the site would instantly realize that he or she was in the wrong site and would then use other methods to find the place he or she wished to view.....”

Here, the Complainant’s argument that Zuccarini’s domain names are confusing is flawed. It fails to note that Zuccarini’s domain name sites are bereft of any content reflecting any similarity or visualization, which would mislead a visitor to the site into believing it has anything at all to do with an association with Complainant’s mark(s). For example, there is no title page describing the site’s name, no content containing Disney, Walt Disney, Disney Enterprises, or any of their products, advertisements, sponsorships, amusement centers or other products, services or offerings. Instead, Zuccarini’s visitors are introduced to various advertisements that have absolutely nothing to do with the Complainant’s business.

The Complainant’s suggestion that Zuccarini’s domain name(s) dilute its mark(s) is flawed.

In a recent District Court ACPA case, *Hartog & Co. AS v. Swix.Com and Swix.Net*, 2001 WL 300382 (E.D.Va.), the Court found that “Dilution occurs when a defendant's "junior mark," adopted after a plaintiff's mark became famous, dilutes the famous mark either by "tarnishment" or by "blurring." *Ringling Bros. Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 955 F.Supp. 605, 613 (E.D.Va.1997), aff'd, 170 F.3d 449 (4th Cir.1999). Dilution through blurring occurs where "consumers mistakenly associate the famous mark with goods and services of the junior mark ." *Ringling Bros.*, 955 F.Supp. at 616. In order to establish blurring, a plaintiff must prove that "(1) a defendant has made use of a junior mark sufficiently similar to the famous mark to evoke in a relevant universe of consumers a mental association of the two that (2) has caused (3) actual economic harm to the famous mark's economic value by lessening its former selling power as an advertising agent for its goods or services." *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 170 F.3d 449 (4th Cir.1999). Plaintiff's "evidence" of blurring is limited, however, to an opinion by plaintiff's employee witness that American outdoor or ski enthusiasts who use the Internet and seek a site for plaintiff at <swix.com> may be frustrated when they find SID's site instead, and look no further. This hypothesis is speculative at best. And, even if it were proven true on occasion, which plaintiff has not done, that would not establish actionable dilution under the Lanham Act where two legitimate businesses use similar names in dissimilar ventures. The legislative history of the ACPA demonstrates that Congress recognized and expected this. See House Report No. 106-412, supra (comparing the potential customer for Delta faucets who finds an airline's website at "Delta.com"). Because plaintiff has failed to prove that the defendant domain names have lessened the capacity of the SWIX mark to identify and distinguish plaintiff's ski wax, plaintiff has not established dilution by blurring. Therefore, plaintiff is not entitled to in rem relief on that basis under Paragraph 2 of the ACPA, even on a showing of bad faith”.

Therefore, it is clear that in the instant case Zuccarini’s domain name(s) cannot be construed as identical or confusingly similar to those of the Complainants nor can it be proven that Zuccarini’s domain names dilute or tarnish the image of the Complainant’s mark.

ZUCCARINI HAS A LEGITIMATE RIGHT PROTECTED BY FREE SPEECH, FREE ENTERPRISE AND PROPERTY INTEREST IN THE SUBJECT DOMAIN NAMES.

Zuccarini purchased the subject domain names through a legitimate registration process on the Internet and Zuccarini has legitimate business interests in these domain name(s). While misunderstood by most, Zuccarini's business operation is in essence a proactive search-engine portal for various advertising and freeware website sponsors.

Applied to this specific case, Zuccarini receives no income or economic benefit whatsoever for any web traffic visiting the subject domains and therefore does not cipher [scil. siphon] any revenues from the Complainant. Instead, Zuccarini obtains legitimate business revenues from the various advertisements offered on his domains only after the visitor has decided to visit one of those websites, e.g. click-through. No visitor is forced to click into one of the advertiser's sites, to register with or to purchase any product or service from these providers.

Zuccarini's practice of misspelling and typo squatting services the unique market on the internet where a large number of "web surfers" specifically type misspelling of words and phrases in order to search for unusual information, advertising and products. Here, the Complainant has suggested that since Zuccarini has been the subject of a number of complaints in the domain name dispute proceedings and in federal court- he must not have a legitimate interest in the domains. However, the reverse is true. The potential number of available domain names diminishes daily with the active registration processes throughout the world. Mr. Zuccarini simply participates in an active and thriving business on the internet of purchasing unused and available Internet Protocol Addresses. The Respondents assert there are many players on the Internet who engage in the same or similar business as Zuccarini. In that regard, the Respondents assert that Zuccarini has been targeted in a number of these cases simply because he has chosen to advocate free expression on the Internet

In a recent circuit court, *Virtual Works, Inc. v. Volkswagen of America, Inc.*, 2001 WL 50988 (4th Cir. 2001), the Fourth Circuit Court rejected a finding that *typosquatting* was synonymous with *Cybersquatting*. In fact, in this case of first impression before a United States Court of Appeals on the question relating to typosquatting, that Court held, "The ACPA was not enacted to give companies the right to fence off every possible combination of letters that bears any similarity to a protected mark. Rather, it was enacted to prevent the expropriation of protected marks in cyberspace and to abate the consumer confusion resulting therefrom."

Furthermore, the Courts have expressed concern of overbroad determinations of infringement since that kind of interpretation will lead to monopolization of the use of terms, *Hasbro v Clue Computing, Inc.*, 66 F. Supp 2d 117 (D. Mass 1999).

ZUCCARINI DOES NOT REGISTER THE DOMAINS IN BAD FAITH OR INTENT.

The Complainant is misled in its suggestion that Zuccarini registered the domain names in bad faith simply because he has been subject of a number of WIPO cases.

The mere listing of some of the cases allegedly brought against Respondent is designed for no purpose other than to prejudice the panel. No discussion of any of the facts in these other cases is presented. No discussion of the ultimate disposition of these other

cases is provided. One is reminded of the Salem witch trials where if someone was accused of being a witch frequently enough, the person was burned. Accusation is not equivalent to proof. See, also *Knight Ridder, Inc. v Zuccarini, et al*, FA0101000096551 (March 2001) (“we agree with Respondent that, whatever he may or may not have done in other cases is irrelevant to this case”). This same principle militates against and, Respondent suggests, successfully confounds all of Complainant’s other vague, general and conclusory statements.

In *Hartog & Co. AS v. Swix.Com and Swix.Net*, supra., the Court rejected a bad faith intent argument where it found that “Through SID, Burgin runs an Internet services business that is entirely different from plaintiff’s ski products business. Burgin never had any intent to divert plaintiff’s customers from plaintiff’s own website, and plaintiff does not contend that he did. Because Burgin’s business is so different from plaintiff’s, the court has found no likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of either plaintiff’s site or those operated by SID.”

The fact is that Respondent Zuccarini’s domain name sites do not even depict a title page or html page containing the domain’s name relating to Disney. Instead, a visitor to any of the subject domains will be directed to Respondent Cupcake Party’s site containing the advertising programs.

Additionally, the Respondent does not sell music, product records, videos or any entertainment products pertaining to or remotely similar to Disney. In fact, as cited in the Complaint, the Respondent operates a business of registering generic terms on the Internet for the purpose of providing click thru traffic to his customers. The Respondent does not infer or mislead his visitors into believing that they have visited the Disney site(s) or that he is in any way affiliated with Complainant.

More importantly and what is consistent in the Respondent’s business activities is that he does not offer or sell his domain names to anyone. A claim of Cybersquatting in this case must, therefore, be rejected as a matter of law. See, *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1233-34 (N.D. Ill. 1996). “A cybersquatter is an individual who attempts "to profit from the Internet by reserving and later reselling or licensing domain names back to the companies that spent millions of dollars developing the goodwill of the trademark."

Respondent(s) requests that the panel reject this form of Reverse Domain Name Hijacking by the Complainant and adopt Respondent’s contention that the Internet was formed and developed as a free market enterprise with unlimited usage of generic terms and urls in order to facilitate a free and open business marketplace. See, *Rollerblade, Inc. v. CBNO and Ray Redican Jr.*, WIPO Case No. D2000-0427 (August 24, 2000) (finding that "genericness, if established, will defeat a claim of trademark rights, even in a mark which is the subject of an incontestable registration"); *see also* *SOCCKERPLEX, INC. v. NBA Inc.*, FA 94361 (Nat. Arb. Forum May 25, 2000) (finding that the Complainant failed to show that it should be granted exclusive use of the domain name <soccerzone.com>, as it contains two generic terms and is not exclusively associated with its business). Here, the Respondent has persuasively shown that the domain name is comprised of generic and/or descriptive terms, and, in any event, is not exclusively associated with Complainant’s business.

**AT LEAST TWO OF THE DOMAIN NAMES ARE NOT “IN USE”
AND THEREFORE DO NOT CONDUCT ANY TRADE OR
BUSINESS. IT IS WELL-SETTLED THAT AS A MATTER OF LAW**

THERE CAN BE NO FINDING OF INFRINGEMENT, DILUTION,
OR BAD FAITH WHERE THE DOMAINS ARE NOT "IN USE".

The Complainant admits that Respondent Zuccarini does not have any content on the domain names <Disneywallpaper.com> and <Disneychannel.com>. A visit to those two domains reveal that visitors are not directed anywhere and the domain sites are bereft of any content or use.

A recent Court, *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F.Supp.2d 176, 185, 186 (D. WDNY 2000), has held that "The Lanham Act defines the term "use in commerce" as, inter alia, use of a trademark "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." 15 U.S.C. § 1127." There, the Court found the defendant's mark was "in use" since "First, defendants' use of plaintiffs' trademark as the domain name for the Tortora website constitutes "use in commerce" because that website contains a hyperlink that connects users to defendants' other website, the online version of Apartment Spotlight Magazine, which they operate for commercial purposes, i.e., advertising apartments for rent." See also *Northland Ins. Companies v. Blaylock*, 115 F.Supp.2d 1108, *1123 (D. Minn. 2000)((On the basis of the present record, defendant's use is for noncommercial commentary purposes. Defendant correctly contends that his use is exempt because it constitutes noncommercial speech. Therefore, the court finds that plaintiff is unlikely to prevail on the merits of the FTDA claim. Since the Federal and State anti-dilution statutes are construed on similar grounds, the court concludes for the same reasons that plaintiff's claim under Minnesota state anti-dilution statute are also unlikely to succeed on the merits at this preliminary stage. See Minn.Stat. § 333.285(c)(2)(1998) (providing that noncommercial use is not actionable).)

Here, where there is absolutely no content, hyperlinks at the IP address of the disneychannel or Disneywallpaper, these subject sites are not in use and therefore cannot be found to violate or cause trademark infringement or confusion.

THEREFORE, based on the foregoing, Respondent respectfully requests that this Panel deny the Complaint and grant any and all relief it deems appropriate and just.

6. Discussion and Findings

Preliminary matter

The Panel is not empowered to make any ruling as to the jurisdiction in which its decision may properly be challenged.

"Cyberflying"

Under of the Policy, which forms part of the registration agreement, a registrant may not transfer a domain name registration to another holder [par. 8(a)] or another registrar [paragraph 8(b)] during a pending proceeding under the Policy or for 15 business days after its conclusion.

A complaint is initiated by the trademark owner sending a properly constituted complaint to any Provider approved by ICANN - Rule 3(a). A copy must already have

been sent to the respondent by the complainant– Rule 3(xii). The date of commencement of the proceeding is the date on which the Provider completes its responsibilities in connection with forwarding a copy of the complaint to the respondent (after checking all the formalities, which can take several days) – Rule 4(c).

Thus a quick-witted respondent might seek to escape the jurisdiction of the panel by transferring the domain name to a new holder or to a new registrar after receipt of the copy of the complaint but before the formal commencement of the proceeding. Both situations arose in *British Broadcasting Corporation v. Data Art Corporation / Stoneybrook* (WIPO Case D2000-0683) [<bbcnews.com>], in which the panel said:

“To interpret section 8(a) of the Policy in such a way as to permit transfers of registration after notice of the complaint to the respondent but before official commencement of the proceedings by way of notification from the provider would not do justice to complainants who have initiated complaints in accordance with the Policy and the Rules. Moreover such an interpretation would appear to permit, if not encourage the phenomenon cyberflying, where a registrant of a domain name, when named as the respondent in a domain name dispute case, systematically transfers the domain name to a different registrant to disrupt the proceeding”.

In that case, the transferee of the domain name was an associate of the respondent who had knowledge of the complaint before the transfer took place. The panel held that neither the change of registrant nor of registrar affected the proceedings. In the event, the new registrar was directed to transfer the domain name <bbcnews.com> to the BBC.

In this case, after receiving the complaint, Mr. Zuccarini transferred three of the Disputed Domain Names to a different registrar and into his own name. The panel finds these circumstances identical to those in the BBC case and that neither the change of registrant nor of registrar affects these proceedings.

Identity/confusing similarity

The Respondents do not contest that the Complainant has rights in the trademark DISNEY and that it is a famous mark worldwide.

The Respondents argue that a domain name is an Internet Protocol (“IP”) address. It is not. An IP address is a series of four one-to-three digit numbers separated by periods¹, e.g., 203.123.3.5. A domain name, by contrast, is a textual (or conceivably graphical) construct, such as <zuccarini.com>, which is translated by the domain name system (DNS) into a numerical IP address². The Respondents did not purchase or obtain IP addresses, they registered domain names. As textual constructs, domain names that incorporate well-known trademarks can be readily confused with those marks.

Each of the Disputed Domain Names incorporates the whole of the famous mark DISNEY. Six of the seven have DISNEY at the beginning of the name. The other

¹ Each separately addressable device, whether it is a PC, server, printer, etc., attached to the Internet is assigned a unique IP address.

² Upon entering a URL into a browser, the browser locates a DNS server (through a "DNS request" or similar message) and then queries the located DNS server with a domain name. In response, the DNS server that has that domain name listed in its translation tables returns the IP address associated with that domain to the browser. The browser, in turn, issues a page download request to a device assigned that IP address.

precedes the mark DISNEY with the word WALD, a slight mis-spelling of the well-known abbreviation of the Complainant's founder's first name WALT, as in the Complainant's registered trademark WALT DISNEY.

Of the six beginning with the trademark DISNEY, four include slight mis-spellings of the word WORLD, a generic word famously associated with the Complainant's mark in the expression WALT DISNEY WORLD, sometimes referred to simply as DISNEY WORLD. The fifth follows the word DISNEY with the word CHANEL, a slight misspelling of the word CHANNEL, as in the Complainant's registered trademark DISNEY CHANNEL. The sixth follows the trademark DISNEY with the generic word WALLPAPER. All seven, of course, end in <.com>.

It has been decided in many cases under the Policy that "essential" or "virtual" identity is sufficient for the purposes of the Policy: *see The Stanley Works and Stanley Logistics, Inc v. Cam Creek. Co., Inc.*, (WIPO case No. D2000-0113) and *Nokia Corporation v. Nokiagirls.com* (WIPO case No. D2000-0102), holding disputed domain names confusingly similar to the trademark of the complainant, despite the addition of generic words. In *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.* (WIPO case No. D2000-0802) the suffix ".com" was found not to detract from the overall impression of the dominant part of the well known trademark TOYOTA, instantly recognizable around the world.

For US cases see *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 497-98 (2d Cir. 2000) (the differences between the trademark "sporty's" and the domain name "sportys.com" – specifically, an apostrophe in the trademark and the addition of <.com> in the domain name – are "inconsequential", such that the domain name is "indistinguishable" from and "certainly 'confusingly similar' to the protected mark"); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (differences between the domain name <moviebuff.com> and the mark "MovieBuff" are "inconsequential"). See also *Public Serv. Co. v. Nexus Energy Software, Inc.*, 36 F.Supp.2d 436 (D. Mass. 1999) (<energyplace.com> and "Energy Place" are virtually identical); *Minnesota Mining & Mfg. Co. v. Taylor*, 21 F.Supp.2d 1003, 1005 (D.Minn. 1998) (<post-it.com> and "Post-It" are the same); *Interstellar Starship Services Ltd. v. EPIX, Inc.*, 983 F.Supp. 1331, 1335 (D.Or. 1997)(<epix.com> "is the same mark" as EPIX); *Planned Parenthood Federation of America, Inc. v. Bucci*, No. 97-0629, 1997 WL 133313, at *8 (S.D.N.Y. Mar. 24, 1997) (<planned-parenthood.com> and "Planned Parenthood" are essentially identical), *aff'd*, 152 F.3d 920 (2d Cir. 1998), *cert. denied*, 525 U.S. 834, 119 S.Ct. 90, 142 L.Ed.2d 71 (1998).

The test of confusing similarity under the Policy, unlike trademark infringement or unfair competition cases, is confined to a consideration of the Disputed Domain Name and the trademark: *AltaVista Company v. S.M.A., Inc.*, (WIPO Case No. D2000-0927); *Gateway, Inc. v. Pixelera.com, Inc. (formerly Gateway Media Productions, Inc.)* (WIPO Case No. D2000-0109). See also *General Mills, Inc. v. John Zuccarini* (NAF Case FA0104000097050 , May 30, 2001). In *Microsoft Corporation v. Microsof.com a.k.a. Tarek Ahmed* (WIPO case No. D2000-0548) contributing factors to the likelihood of confusion were held to be the visual similarity between the domain name and the complainant's mark and the mark being strong and immediately recognizable.

Here the mark DISNEY is indisputably strong and immediately recognizable around the world and the Panel has no hesitation in finding that each of the Disputed Domain Names is confusingly similar to the Complainant's famous mark DISNEY. In addition, the domain name <walddisney.com> is confusingly similar to the Complainant's

registered trademark WALT DISNEY and the domain name <disneychanel.com> is confusingly similar to the Complainant's registered trademark DISNEY CHANNEL.

In seeking to respond to the Complainant's contention that the Disputed Domain Names are confusing, the Respondents argue that Mr. Zuccarini's domain name sites are bereft of any content which would mislead visitors into believing the site has anything to do with the Complainant's marks [emphasis added]. In fact, some of the sites (e.g. the music lyrics site, see web page copy in Ex. 8 to the Complaint) are competitive with the Complainant's business. Be that as it may, the Respondents' argument is directed to the sites, rather than to the names. It is the confusing similarity between the domain names and the trademarks which enables the Respondents to exploit the inadvertent mistakes of Internet users. Thus do the sites at the Disputed Domain Names attract visitors who falsely believe they will find a site associated with the Complainant. Once there, it may or may not be apparent that they are mistaken. But by then the mousetrap has sprung and the Respondent's purpose is achieved. It is therefore disingenuous to assert in the Response that "Zuccarini's visitors are introduced to various advertisements that have absolutely nothing to do with the Complainant's business".

The Respondents concede that Mr. Zuccarini has a "practice of misspelling and typo squatting" directed at the large number of "web surfers" who "specifically type misspelling of words and phrases". It is thus apparent that the Disputed Domain Names were selected by Mr. Zuccarini because their value to him lies in their confusing similarity to the Complainant's famous mark.

Mr. Zuccarini has admitted, under oath, both in deposition and trial testimony, as reported by the Court in *Joseph C. Shields, individually and t/a The Joe Cartoon Co., v. John Zuccarini, individually and t/a Cupcake City*, 89 F. Supp.2d 634, 639 (US Dist. Ct. E.D. Pennsylvania 2000) that he registered variations of thousands of domain names because they are confusingly similar to others' famous marks or personal names -- and thus are likely misspellings of these names -- in an effort to divert Internet traffic to his sites. [emphasis added].

Although the domain name <disneywallpaper.com> has no misspelling, it includes a generic word likely to be typed by Internet users expecting, by so doing, to download the Complainant's "wallpaper" for their computers, as they can from the Complainant's website at <disney.com>.

The Complainant has established this element.

Illegitimacy

Having argued in relation to the issue of identity/confusing similarity that Mr. Zuccarini purchased "a particular numerical IP address", the Respondents argue in relation to the issue of legitimacy that Mr. Zuccarini purchased "the subject domain names" through a legitimate registration process. That registration process required the Respondents to agree, as a condition of registration, to be bound by the Policy for the resolution of disputes such as the present. Accordingly, the fact of registration is no evidence of legitimacy.

The Complainant has never authorized the Respondents to utilize any of its marks, nor does the Complainant have any relationship or association with the Respondents. Any use to which the Respondents might put of any of the DISNEY marks, including in

connection with the services listed in the corresponding registrations, would violate the Complainant's trademark rights. The Respondents are not now and have never been known by the mark DISNEY nor by any of the Disputed Domain Names.

The Respondents' mousetrap, automatically springs upon Internet users who gain access to five of the seven Disputed Domain Names³, and from which there is virtually no escape without generating "click through" revenue for the Respondents⁴, depends for its success upon misleadingly attracting Internet users to the Respondents' sites for the Respondents' commercial gain. This use of these five Disputed Domain Names cannot constitute legitimate noncommercial or fair use within paragraph 4(c)(iii) of the Policy.

With respect to the two domain names <disneywallpaper.com> and <disneychannel.com>, which the Response says are not being used, cases under the Policy have found absence of rights or legitimate interests in domain names which have not been used. In *State Farm Mutual Automobile Insurance Company v. Rocky E. Faw* (NAF case FA94971) the respondent was found to have no legitimate interests in respect of the domain name where he had not used nor developed the domain name for a legitimate non-commercial or fair purpose and was not using the domain name in connection with a bona fide offering of goods or services. See also *Leland Stanford Junior University v. Zedlar Transcription & Translation* (NAF case FA94970). The same considerations apply in this case and lead the Panel to the same conclusion.

The Panel finds that the Respondents have no rights or legitimate interests in any of the Disputed Domain Names within paragraph 4(a)(ii) of the Policy.

Bad Faith

The Complainant contends that the Respondents' bad faith is established under paragraphs 4(b)(ii) and 4(b)(iv) of the Policy, citing in relation to 4(b)(ii) (inter alia) cases brought against Mr. Zuccarini in which such a finding was made but in which he did not file a response. The learned Panelists in those cases were, in the absence of a response, entitled to accept the uncontradicted contentions of the Complainants: *Reuters Limited v. Global Net 2000, Inc.* (WIPO Case No. D2000-0441). See also *Hewlett-Packard Company v. Full System* (Case FA 0094637); *David G. Cook v. This Domain is For Sale* (Case FA0094957) and *Gorstew Jamaica and Unique Vacations, Inc. v. Travel Concierge* (Case FA0094925).

The Response filed in this case states that the Respondent [sic] operates "a business of registering 'generic' terms on the Internet for the purpose of providing click thru traffic to his customers." Leaving aside for a moment the reference to generic names, the Panel accepts that the Respondents' purpose in registering domain names which incorporate the well-known trademarks of others, including five of the Disputed Domain Names, is to generate click-thru traffic revenue.

As to paragraph 4(b)(iv) of the Policy, the Response states: "a visitor to any of the subject domains will be directed to Respondent Cupcake Party's site containing advertising programs". The Panel is satisfied that the Respondents chose and have been using the Disputed Domain Names (other than <disneychannel.com> and

³ (i.e. those other than <disneywallpaper.com> and <disneychannel.com>)

⁴ Users thus trapped could escape by the inconvenience of switching off the power to their computers and rebooting. This is likely to be more inconvenient than clicking through unwanted advertisements.

<walddisney.com>) in an attempt intentionally to attract Internet users, for commercial gain, to the Respondents' Cupcake Party site, where they are introduced to various advertisements, some of which have nothing to do with the Complainant's business and some of which promote music lyrics, very much a part of the Complainant's business.

To the extent to which the Respondents' site promotes music lyrics and other activities associated with the Complainant, it would be likely to confuse Internet visitors as to the source, sponsorship, affiliation or endorsement of the Respondent's website and thus constitute evidence of bad faith registration and use within the scope of paragraph 4(b)(iv) of the Policy.

To the extent to which the Respondents' site does not promote activities, goods or services associated with the Complainant, some Internet visitors may not be confused in this way, since the Respondents' business depends on trapping for commercial gain unsuspecting and inadvertent visitors, the more astute of whom may realize immediately upon their arrival at the Respondents' site that they are not at their intended destination.

Less astute visitors however, believing that they are about to visit a site associated with the Complainant, may continue for some time in that belief even though the products and services advertised to them are wholly different from those of the Complainant. In relation to these visitors the Respondents' conduct constitutes evidence of bad faith registration and use within paragraph 4(b)(iv) of the Policy.

In any event, *"the fallacy in respondent's contention is that while under traditional trademark law the similarity or nonsimilarity of the products may be considered, this is not a factor under the Policy"*: *General Mills, Inc. v. John Zuccarini* (supra).

The Panel notes that the circumstances specified in paragraph 4(b) of the Policy are not exhaustive. It is open to a complainant to establish and for a Panel to find bad faith registration and use within paragraph 4(a)(iii) in other circumstances. The Complainant has contended that such findings should be made in this case.

As to registration, in *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport* (NAF case FA94956) a finding of bad faith was made where the respondent "knew or should have known" of the registration and use of the trademark prior to registering the domain name. Likewise *Marriott International, Inc. v. John Marriot* (NAF case FA94737); *Canada Inc. v. Sandro Ursino* (eResolution case AF-0211) and *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com* (NAF case FA95037).

Here the Respondents undoubtedly knew of the famous DISNEY mark before registering the Disputed Domain Names, all of which wholly incorporate that mark. For this reason the Panel unhesitatingly finds all the Disputed Domain Names were registered in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

As to use, the Complainant's DISNEY mark is not generic, as the Respondents appear to assert. It is highly distinctive and unquestionably famous. It is the goodwill of the DISNEY mark ("the attractive force that brings in custom"⁵) which Mr. Zuccarini misappropriates when he attracts into his mousetrap Internet users who, in relation to five of the seven Disputed Domain Names, spell the mark correctly but inadvertently

⁵ per Lord Macnaghten in Commissioners of Inland Revenue v Muller & Companies Margarine Limited 1901 A.C. 217.

misspell words commonly associated with it. The success of the Respondent's mousetrap is borne out by the Shields case, in which the Court noted "[Mr. Zuccarini's] click-based revenue now approaches \$ 1 million per year." *Id* at 639. The Panel finds the Respondents are using these five domain names in bad faith.

As to the remaining domain names, <disneywallpaper.com> and <disneychanel.com>, the Respondents say these are not in use. They submit that, for this reason, no finding of bad faith can be made, citing *OBH, Inc., v. Spotlight Magazine, INC.*, 86 F.Supp.2d 176, 185, 186 (D.WDNY 2000), which involved the expression "use in commerce", defined in the Lanham Act as, inter alia, use of a trademark "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...". No such requirement in relation to the concept of "use" is contained in the Policy.

In many cases under the Policy, inaction (passive holding) has been found to be within the concept of "use": *Telstra Corporation Limited v. Nuclear Marshmallows*, (WIPO case No. D2000-0003); *Barney's, Inc. v. BNY Bulletin Board* (WIPO case No. D2000-0059); *CBS Broadcasting, Inc. v. Dennis Toeppen* (WIPO case No. D2000-0400); *Video Networks Limited v. Larry Joe King* (WIPO case No. D2000-0487); *Recordati S.P.A. v. Domain Name Clearing Company* (WIPO case No. D2000-0194); *Revlon Consumer Products Corporation v. Yoram Yosef aka Joe Goldman* (WIPO case No. D2000-0468) and *William Hill Organization Limited v. Fulfillment Management Services Limited* (WIPO case No. D2000- 0826).

Here the Panel takes into account the nature of the Respondents' business as described in the Response and as found by the Panel; the absence of any explanation from the Respondents as to why these domain names have not been used and the significant periods of time during which they have remained inactive. The Panel finds both are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

Thus the Panel finds that all the Disputed Domain Names were registered and are being used in bad faith.

Reverse Domain Name Hijacking

Rule 1 defines reverse domain name hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name." See also Rule 15(e). To prevail on such a claim, a Respondent must show that the Complainant knew of the Respondent's unassailable right or legitimate interest in the Disputed Domain Name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith. See, e.g., *Sydney Opera House Trust v. Trilynx Pty. Ltd.*, (WIPO Case No. D2000-1224) and *Goldline International, Inc. v. Gold Line* (WIPO Case No. D2000-1151).

The Complainant having succeeded in establishing all the elements necessary to entitle it to relief under the Policy, the Respondents' assertion of Reverse Domain Name Hijacking is rejected.

7. Decision

Pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the following domain names be transferred to the Complainant:

<disneychanel.com>
<disneywallpaper.com>
<disneywold.com>
<disneywolrd.com>
<disneyword.com>
<disneyworl.com>
<walddisney.com>

Alan L Limbury, Esq.,
Presiding Panelist

Peter L. Michaelson, Esq.
Panelist

Gordon Harris, Esq.
Panelist

Dated June 19, 2001