



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Eldorado Stone Operations, LLC v. Abadaba S.A., Domain Admin

Case No. D2007-1580

1. The Parties

The Complainant is Eldorado Stone Operations, LLC, South Jordan, Utah, United States of America, represented by Dorsey & Whitney, LLP, United States of America.

The Respondent is Abadaba S.A., Domain Admin, Panama.

2. The Domain Name and Registrar

The disputed domain name <elderadostone.com> is registered with Fabulous.com Pty Ltd. (the “Registrar”).

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 Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and 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 email form on October 24, 2007, and in hard copy form, along with accompanying Exhibits 1-8, on October 26, 2007. An amended Complaint was received by e-mail on November 2, 2007 and in hard copy form on November 6, 2007. For simplicity and unless context dictates otherwise, all references hereinafter to the Complaint will be to the amended version.

The Panel notes that the initial Complaint was filed against an entity named 'Domain Privacy LTD'. Sometime around the filing of the Complaint, the Respondent appeared in the Whois record as the domain name holder. The Complainant amended its Complaint to refer to both entities. For the purposes of this proceeding, the Panel finds that the proper Respondent is the current registrant of record as confirmed by the Whois and the registrar in this matter.

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, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on October 25, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to that name, (b) 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 that name, (c) the language of the registration agreement, and (d) whether that name will remain “locked” during the proceeding.

Subsequently, on October 26, 2007, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIs database and confirmed that the Respondent is listed as the registrant for that name. The response also confirmed that: (a) it received a copy of the Complaint, (b) Fabulous.com Pty Ltd is the registrar, (c) the Respondent submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (d) the registration agreement is in English; and (e) indicated that the name will remain locked during the proceeding.

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

On November 8, 2007, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by courier, and, without those Exhibits, by both facsimile and email. 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 November 8, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

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

The Respondent was then provided with a 20 calendar day period, expiring on November 28, 2007, to file its Response with the Center and the Complainant.

As of November 28, 2007, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter dated November 30, 2007, notified the Respondent of its default.

Accordingly, pursuant to the Rules and Supplemental Rules, by an email letter dated December 6, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on that same day, Mr. Michaelson accepted and returned, by e-mail to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated December 7, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

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 December 21, 2007. However, owing to unexpected time conflicts experienced by the Panel which constituted unforeseen circumstances, the Center, at the Panel's request, extended the due date to January 4, 2008.

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

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration record provided in Exhibit 1 to the Complaint, the disputed domain name was first created on September 26, 2005.

A. The Complainant's ELDORADO Marks

The Complainant owns three US trademark registrations for the marks ELDORADO and ELDORADO STONE, either in block letters or in a stylized pattern. The Complainant has provided, in Exhibit 3 to the Complaint, copies of its registration certificates for these marks. Pertinent details of those registrations are as follows:

1. ELDORADO (block letters)
United States registration 2,901,565; registered: November 9, 2004

This mark is registered for use in connection with "custom manufacture of molds for producing artificial building stones for others" in international class 40. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with this service commenced as of December 31, 1968.

2. ELDORADO STONE (stylized)
United States registration 2,498,513; registered: October 16, 2001

This mark is registered for use in connection with "non-metallic building materials, namely synthetic, artificial and reformed stones, bricks, blocks and sheets" in international

class 19. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these goods commenced as of September 1, 1997.

3. ELDORADO (block letters)
United States registration 1,182,120; registered: December 15, 1981
renewed: February 12, 2002

This mark is registered for use in connection with “cast artificial stones, bricks, tree rounds, simulated slate, fireplace hearths and flagstones” in international class 19. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these goods commenced as of December 31, 1968.

B. The Complainant

The Complainant manufactures building materials and specializes in manufactured stone veneer. The Complainant sells its veneer products and associated manufacturing services worldwide and has been doing so under its ELDORADO Marks continuously since at least 1968.

The Complainant has spent considerable amounts of time, effort and money for research and development of its products and services that are associated with its ELDORADO Marks and has incurred considerable expense in promoting and marketing those products and services throughout the world.

The Complainant registered its own domain name, <eldoradostone.com>, on July 18, 1997, as evidenced by a WhoIs registration record appearing in Exhibit 4 to the Complaint. A hard-copy printout of the Complainant’s current home page to which that name resolves appears in Exhibit 5 to the Complaint.

C. The Respondent

The Respondent uses the disputed domain name to redirect Internet users to a website located at the address “www.malkm.com/?pid=1PDXNIEYX&dn=elderadostone.com” and to simultaneously open a “pop under” window which displays a list of “Other Popular Searches.” A hard-copy printout of a screen shot of the home page to which that address resolves appears in Exhibit 6 to the Complaint. That page prominently displays the title “eldoradostone.com” along with the following text:

“Welcome to Elderadostone.Com. If you are looking for Eldorado Stone, Cast Stone, Stone Veneer or anything similar, go ahead and browse our comprehensive resource directory. You ought to find something interesting!”

A search box also appears on that page through which an Internet user can enter a term to be searched. Also, the “pop under” window first appears immediately after an Internet user enters the disputed domain name into a browser.

Both the Respondent’s site and the “pop under” window contain references to various categories of searches which, when any of them is selected, leads an Internet visitor to lists

of sponsored links. Some of these links are to the Complainant's competitors. A hard-copy screen shot of a page of the Respondent's sponsored links appears in Exhibit 7 to the Complaint. The "pop under" window contains references to other marks owned by the Complainant, namely CLIFFSTONE and CYPRESS RIDGE.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's ELDORADO Marks.

Specifically, the Complainant states that the only difference between its mark ELDORADO STONE and the disputed domain name is that the latter substitutes the letter "e" for the first letter "o" in the term "eldorado" to form "elderado stone". Thus, the Complainant concludes that the disputed domain name is not only confusingly similar but it is virtually identical to its mark.

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

(ii) Rights or Legitimate Interests

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

First, Complainant states that it has never authorized the Respondent to use any of the Complainant's ELDORADO Marks or to register the disputed domain name.

Second, Complainant contends that the Respondent can not show that it is using the name in either a legitimate noncommercial or fair use manner. Specifically, the Respondent's site and the "pop under" window ultimately lead Internet users to lists of sponsored links, including links to the Complainant's competitors. Inasmuch as the Respondent likely derives revenue from both its sponsors and the number of times an Internet user clicks on any such link, the Complainant contends that the Respondent's use of the disputed domain name is purely commercial and does not constitute either a legitimate noncommercial or fair use.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

In particular, the Complainant contends that the Respondent likely knew of the reputation of the Complainant and its ELDORADO STONE Marks when the Respondent registered the name - otherwise why, so posits the Complainant, would the Respondent have chosen a name which is confusing similar and, with exception of a single letter difference, identical

to the Complainant's marks. As such, the Respondent intended through registering the name to exploit, for its own financial gain, the Complainant's goodwill by causing consumer confusion and then, through its subsequent use of the name, actually did so.

In that regard, the Respondent, in registering and subsequently using the disputed domain name which differed by only one letter from the Complainant's mark ELDORADO STONE, intended to and did take advantage of a common misspelling, by Internet users, of that mark, which constitutes "typosquatting", to direct those users who sought the Complainant's website but, as a result of entering a misspelled version of that mark as a domain name, were directed to the Respondent's site instead and ultimately exposed to the Respondent's sponsored links - some of which included competitors of the Complainant - through which the Respondent ultimately derived pecuniary gain through click-through and associated revenue.

Furthermore, the Respondent exacerbated the confusion caused by its typosquatting by prominently displaying the Complainant's mark ELDORADO STONE on the Respondent's website and other marks of the Complainant in the "pop under" window that immediately preceded display of the home page of that site.

B. Respondent

The Respondent failed to file any Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

A. Identical or Confusingly Similar

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

From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, nearly identical to the Complainant's mark ELDORADO STONE. The only difference between the name and that mark is the substitution of a letter "o" in the mark with the letter "e" in the name and the appending of a gTLD (generic top level domain) ".com" to the mark - with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations are each usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Substituting one single letter for another such that the term "eldorado" becomes in the domain name the term "elderado" is clearly such a minor and rather trifling variation. See,

e.g., *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinsciani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <elderadostone.com> is confusingly similar to the Complainant's ELDORADO STONE Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel believes that the Respondent has not provided any basis that, in the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light the Complainant's continuous use of its mark well prior to the date on which the Respondent registered the name without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (Nat. Arb. Forum December 18, 2000).

Further, no evidence exists of record that the Complainant has ever authorized the Respondent to utilize its ELDORADO STONE Marks or any mark confusingly similar thereto in conjunction with products and services which the Complainant provides under its marks, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark ELDORADO STONE or one confusingly similar thereto - such as "elderadostone", in connection with those goods and services provided by the Complainant or those similar thereto, would violate the exclusive rights now residing in the Complainant. See, e.g., *Associated Bank*, cited *supra*; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetnetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services*

Corp. v. ESJ Nutritional Products, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the ELDORADO STONE Marks or one similar thereto, at least for the goods and services, or even similar goods and services, rendered by the Complainant under those marks. Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, the Panel accepts Complainant's argument, particularly in light of no statement to the contrary from the Respondent, that the disputed domain name contains a common misspelling of the term "eldorado" and thus, in this Panel's mind, bears an extremely high degree of similarity to the Complainant's ELDORADO STONE Marks. Consequently, it strains reason to think that the Respondent was totally unaware of the Complainant's marks when the former registered the disputed domain name. Moreover, the Panel believes that not only was the Respondent fully aware of the Complainant's mark when it registered the disputed domain name but also, in spite of that knowledge, it subsequently used that name as a vehicle to confuse Internet users and, through such confusion, opportunistically exploited the Complainant's goodwill for its own pecuniary benefit. Hence, any claim which the Respondent may make to the disputed domain name is simply baseless and illegitimate.

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

C. Registered and Used in Bad Faith

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As discussed above, the Panel finds that the Respondent was well aware of the Complainant and its ELDORADO STONE Marks when it registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the disputed domain name to opportunistically exploit its potential to generate user confusion for the Respondent's eventual pecuniary benefit and the Complainant's ultimate detriment.

In that regard, the Panel can think of no plausible reason why the Respondent would register a domain name that is a very common misspelling of the Complainant's mark if, in fact, the former had absolutely no intention of causing user confusion and then benefiting from it in some manner. Given well-known and now nearly universal website naming conventions, Internet users who seek to reach a particular website of an organization are very likely to form a domain name which includes the name of that organization followed by a common gTLD, often ".com". However, in doing so, those users may inadvertently and slightly mistype the name by entering into their browser an erroneous letter or number not in the mark, or omitting a letter or number from the mark or changing such a letter or number, such as here substituting an "e" for an "o".

Therefore, particularly in light of a lack of any response from the Respondent, the Panel

can only conclude that the Respondent's intention not only in registering but also in using the disputed domain name, as it did, was in fact to cause and then financially exploit the likely confusion that would inevitably arise through spelling errors inadvertently entered by any Internet user who then sought the Complainant's website but, through entry of such an inadvertent error, reached the Respondent's site instead. See *Associated Bank and Gerber Childrenswear*, both cited *supra*; and *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007).

Moreover, once the user reached that site, nothing existed there - particularly since its home page prominently displayed the Complainant's mark ELDORADO STONE - which would lead that user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant - when, in actuality, none exists. Similarly, a "pop under" window associated with the Respondent's site also displayed two other marks owned by the Complainant thus strengthening that user's perception that the Respondent and the Complainant were somehow related, affiliated or connected.

The Panel's view that such confusion was intended is unmistakably and further supported by the facts and its findings that: (a) the Respondent's site presented sponsored links, including links to the Complainant's competitors, to those, of the Respondent's Internet visitors, who were intent on reaching the Complainant's site but were redirected to the Respondent's site, and (b) the Respondent likely derived revenue from doing so. Given the lack of any response, the Panel infers that generating click-through and other associated revenue predicated on such confusion was the Respondent's ultimate goal when it registered and subsequently used the name.

Hence, when viewed in their entirety, the Respondent's actions completely negate any possible finding by this Panel that it acted in good faith to register and use the disputed domain name, and in fact undeniably show that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

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

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <elderadostone.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: January 4, 2008