



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fear Factory, Inc. v. 1 2 3 Speed

Case No. D2000-0626

1. The Parties

Complainant:
Fear Factory, Inc.
9169 Sunset Boulevard
Los Angeles, California 90069
United States of America

Respondent:
1 2 3 Speed
4403 Reach Road East
Tacoma, Washington 98467
United States of America

2. The Domain Name(s) and Registrar(s)

Contested Domain Name: fearfactory.net

Registrar:
Network Solutions, Inc. (NSI)
505 Huntmar Drive
Herndon, Virginia 20170
United States of America

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <<http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain

Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed both by e-mail form on June 22, 2000 and, with Exhibits A-F and the appropriate payment, in hard-copy form on June 19, 2000 with the Arbitration and Mediation Center of the World Intellectual Property Organization (the "Center"). The Complainant states that on June 12, 2000, its attorneys served a copy of the Complaint, by courier (specifically Express Mail) and e-mail, on the Respondent and provided a copy of the Complaint, by e-mail, to the Registrar, NSI. The Center acknowledged receipt of the Complaint by e-mail dated June 21, 2000 to both the Complainant and the Respondent.

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 complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined that the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on June 21, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to the domain name; specifically, contact and registrant information for the contested domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of the domain name. On June 25, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the Policy is in effect (through Network Solutions 5.0 Service Agreement), and that the domain name, as of June 25, 2000, was "active".

On June 26, 2000, the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, by e-mail, facsimile and in hardcopy form by 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, with the notification to the Respondent having occurred on June 26, 2000, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on June 26, 2000.

Having reviewed the complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on July 15, 2000, to file its response with the Center and serve a copy of the response on the Respondent.

As of July 17, 2000, the Center has received no such response from the Respondent. Hence, on that date, the Center so notified the Complainant by e-mail, and the Respondent, by e-mail and facsimile, that the administrative proceeding would proceed by way of default.

Accordingly, pursuant to the Rules and Supplemental Rules, on July 20, 2000, the Center contacted the undersigned requesting his service as a sole panelist to consider and decide this dispute. On the same date, the undersigned accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. On July 24, 2000, the Center appointed the undersigned as the sole panelist to consider this dispute, and so notified both parties by e-mail. Based on deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the undersigned to the Center on or before August 6, 2000.

This dispute concerns one domain name alone, specifically "fearfactory.net". The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, 1 2 3 Speed, has failed to respond to the Complaint, all the facts alleged by the Complainant, Fear Factory, Inc., will be accepted as true. For convenience of the reader, factual allegations, to the extent needed, from the Complaint are reproduced below.

The dispute is based on the following trademarks and their usage by the Complainant:

A) **FEAR FACTORY** (block letters)

This word mark is the subject of three separate US trademark registrations, each for different goods or services, as follows:

i) US registration 2,303,251 issued December 28, 1999

This trademark was registered by the Complainant for use in connection with: a series of musical sound recordings. This mark claims first use and first use in inter-state commerce on March 31, 1991.

ii) US registration 2,212,521 issued December 22, 1998

This trademark was registered by the Complainant for use in connection with: T-shirts, sweat shirts, long sleeve shirts, ski hats, baseball caps, and hockey jerseys. This mark claims first use and first use in inter-state commerce on February 28, 1992.

iii) US registration 1,849,630 issued August 9, 1994

This trademark was registered by the Complainant for use in connection with: entertainment services in the nature of

a musical group. This mark claims first use on October 1990 and in inter-state commerce on January, 1991.

B) FF (stylized)

US registration 2,276,040 issued September 7, 1999

This trademark is used by the Complainant in connection with: t-shirts, sweat shirts, long sleeve shirts, ski hats, baseball caps and hockey jerseys. This mark claims first use and first use in inter-state commerce on February 28, 1992.

The Complainant has supplied, in Exhibit C to the Complaint, hard-copy print-outs of registration records (which contain depictions of the marks), as provided in the Trademark Text and Image Database publicly accessible through the US PTO web server, for these four registered trademarks. According to these records, all four federal trademarks are currently owned by the Complainant.

As indicated on the PTO record for the 1,849,630 registration, an affidavit/declaration of continued use has been filed in and accepted by the US PTO in conjunction with this mark. As such, this registration is currently active. Given the relatively recent dates on which the 2,303,251; 2,212,521 and 2,276,040 registrations issued, such a declaration/affidavit of continued use, as required under § 8 of the Lanham Act (15 USC § 1058) for each of these three trademark registrations to continue in force, is not yet due. As such, these three registrations are also currently active.

As discussed below, the Panel finds that, for all intents and purposes, the three word mark registrations are identical to the contested domain name and as such provide an adequate basis for the findings herein. Inasmuch as the "FF" mark clearly differs from the contested domain name, the Panel finds that mark to be of far lessened importance and hence immaterial to the issues raised by the Complainant. Hence, for the sake of simplicity, the Panel will simply ignore the stylized "FF" mark. Consequently, all references hereinafter to the Complainant's "mark" will simply and collectively refer to its three word mark registrations.

The Complainant states that it is a popular rock group, with the mark being the name of the group. The Complainant states that it has provided goods and services under its mark since as early as 1990. The Complainant also states that since that time it has performed in major venues throughout the world, including the United States, and has released recordings which has been distributed worldwide.

The Complainant further states that it has expended substantial time, money and resources in advertising, marketing and promoting its music and merchandise under the its mark, such that its name and mark have become widely known and recognized as its source identifier of its goods and services. In that regard, the Complainant states that its concerts and sales of musical sound recordings and band-related merchandise have generated many millions of dollars in revenue.

Furthermore, the Complainant states that it currently maintains a web site under the domain name "FEARFACTORY.COM" which is dedicated to promoting and marketing the Complainant's musical group; this domain name having been registered by the Complainant on July 23, 1997. In Exhibit D to the Complaint, the Complainant

has provided a copy of a domain name registration from the WHOIS database for the domain name FEARFACTORY.COM (accessed through www.networksolutions.com/cgi-bin/whois/whois?STRING=fearfactory.com) .

The Complainant alleges that on or about March 21, 2000, the Respondent registered the contested domain name with the Registrar.

The Complainant provides, in Exhibit E, a WHOIS print-out of various domain names which the Respondent has registered, some of which the Complainant allege are the names of well-known musicians.

Lastly, the Complaint includes, in Exhibit F, a copy of a cease and desist letter which Complainant's Counsel sent on May 16, 2000 to the Respondent (at its contact address and to the administrative contact listed in its contact information in the Registrar's WHOIS database -- as shown in Exhibit A to the Complaint), but which was subsequently returned to Counsel by the US postal service marked "not deliverable as addressed". Counsel states that it then attempted on May 31, 2000 to telephonically contact the administrative contact of the Respondent but was unsuccessful in doing so.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) the domain name in question is similar, specifically identical, to its registered trademarks;
 - (b) any rights the Respondent has in the domain name in contention are illegitimate; and
 - (c) the Respondent has registered this domain name in bad faith.
- i) similarity

As to similarity of the contested domain name to its registered trademark, the Complainant has provided print-outs, as noted above, of US PTO registration records for its marks.

The Complainant alleges that, essentially for all practical purposes, the domain name in question is identical to the Complainant's FEAR FACTORY trademark. The exceptions are omission of a space between the two words as shown in the registered trademark with respect to those words being appended together in the domain name and the inclusion of a top level domain (.net) in the domain name not included in the trademarks, both of which are de minimis and immaterial.

ii) illegitimate use

The Complainant has been known by, and has been continuously using, the term FEAR FACTORY as its trademark and name of its musical group since 1990.

As a result of this use and repeated and significant advertising, marketing and promotional activities undertaken by the Complainant since that date, the Complainant, specifically its musical group, has become widely and globally known with the mark being a source identifier for the services and branded products provided by the Complainant.

The Complainant states that, given the fact that the domain name incorporates the name of the Complainant, the Respondent has no reason for registering the complaint's trade name, Fear Factory, as a domain name. In that regard, the Complainant alleges that since the Respondent is not known by the name Fear Factory, the contested domain name has no meaning or significance to the Respondent .

Hence, the Complainant concludes that the Respondent could not claim any legitimate interests in the contested domain name, comprised of the FEAR FACTORY trademark (plus the top level domain '.net' but without a space between the words).

iii) bad faith

The Complainant alleges that the Respondent registered the trademark as a domain name primarily for precluding the Complainant from reflecting its registered trademark in a corresponding domain name or for the purpose of renting, selling or otherwise transferring the domain name registration to the Complainant or a competitor thereof for payment above and beyond the costs incurred by the Respondent in securing its domain name registration.

According to the WHOIS database of NSI -- copies of the salient records have been provided in Exhibit E of the Complaint, the Complainant points to various domain names that identify widely-known musicians, other than the Complainant, which the Respondent has registered. For example, these include the following domain names and their associated musical groups "olddirtybastard.com" (Old Dirty Bastard), and "droctagon.net" (Droctagon).

B. Respondent

To date, the Respondent has not filed any response to the Complaint.

6. Discussion and Findings

In view of the lack of any response filed by the Respondent, 1 2 3 Speed, this proceeding has proceeded by way of default. Hence, in the absence of any refuting

evidence, all the facts and allegations submitted by the Complainant, Fear Factory, Inc., are accepted as true.

Apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings:

A. Similarity

No doubt exists whatsoever that the domain name in question, while not absolutely identical to the Complainant's mark (FEAR FACTORY), is clearly sufficiently similar to it as to cause a likelihood of confusion to arise between the relevant consumers of the Complainant and those who were to view the disputed domain name -- when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer the contested domain name, were to start using the domain name in conjunction with goods or services similar to those of the Complainant. Such confusion, should it occur, would undoubtedly cause consumers to think that a relationship of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all.

The differences between the contested domain name and the Complainant's mark, being the deletion of a space between the words "FEAR" and "FACTORY" (as they appear in the block letter registrations), along with appending of a top-level domain (.net) are so de minimis as to be utterly inadequate to preclude any such confusion from occurring.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy.

In fact, for the reasons set forth below with respect to Illegitimacy and Bad Faith, given the conduct of 1 2 3 Speed, as evidenced by its registrations of various domain names bearing very high degrees of similarity to the names of other contemporary well-known rock musicians -- the Complainant also being such a musical rock group, the Panel concludes that:

- (i) 1 2 3 Speed intentionally chose the contested domain name for its high and nearly identical degree of similarity with the mark under which the Complainant undertakes its business, and
- (ii) with the principal reason of causing consumer confusion to eventually occur in order to injure the Complainant's business and reputation should the domain name become active in an attempt to induce the Complainant to purchase the domain name from the Respondent (or from a third party to which the Respondent would transfer the domain name).

B. Illegitimacy

Based on the evidence submitted by the Complainant, the Panel makes the following findings regarding illegitimacy.

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its trademarks in conjunction with the goods and services listed in its various registrations.

Furthermore, each of the Complainant's trademarks is highly distinctive and not descriptive of any goods or services with which that trademark is registered.

The Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name in connection with any goods or services which it might be providing. In fact, it is extremely unlikely that Respondent can even make such a claim. The simple reason is that the mark, which forms the basis of the contested domain name, incorporates the well known name of the Complainant, i.e. the name of its musical rock group, and, as the Panel infers from the Complaint, the Complainant has absolutely no relationship whatsoever with the Respondent.

This finding is particularly compelling inasmuch as the Complainant has registered and is using the domain name FEARFACTORY.COM (which incorporates the Complainant's name) in conjunction with its own web site. The only difference between the Complainant's registered domain name and the contested domain name is its top level domain; specifically .com in one, .net in the other. In the absence of any evidence to the contrary, the Panel can only assume, as noted in the section 6(C) below, that the Respondent intentionally exploited this minor and insignificant difference in what could become a concerted effort to divert Internet users to its web site who would otherwise be seeking the Complainant's site, therefore creating a likelihood of consumer confusion.

Hence, any use to which the Respondent were to put any of the Complainant's trademark in connection with the goods or services listed in any of the registrations would directly violate the exclusive trademark rights now residing in the Complainant, and would clearly cause confusion as to origin of the relevant purchasers of Complainant's goods and services and dilute the goodwill which the Complainant has acquired by virtue of the extensive and continuous use, since at least 1992, of its mark.

In light of the above findings, the Panel is unpersuaded that the Respondent has any rights in the contested domain name, whether on a commercial or non-commercial basis.

Thus, the Panel finds that any use of the contested domain name by the Respondent is illegitimate within paragraph 4(a)(ii) of the Policy.

C. Bad Faith

The Respondent's repetitive conduct in registering various domain names, that included the names of well-known contemporary musicians, the Complainant being just one of them, appears to the Panel to evidence, at least inferentially,

an intent by the Respondent, rather than to legitimize the use of the contested domain name, to:

- (a) eventually sell the contested domain name to the Complainant for an amount in excess of the costs of its registration, or to a third-party unrelated to the Complainant,
- (b) prevent the Complainant, as lawful owner of the registered trademarks "FEAR FACTORY", from reflecting its trademark in a corresponding domain name (here being FEARFACTORY.NET), and/or
- (c) use a domain name to intentionally attract, for commercial gain, Internet users to the Respondent's site or other on-line location by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation or endorsement of the goods and services provided by the Complainant.

The Panel infers, based on a lack of any response from the Respondent, that the Respondent has no reasonable grounds to believe that any use which it has or will make of contested domain name constitutes fair or otherwise lawful use.

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith under paragraphs 4(a)(iii) of the Policy.

In this connection, the Panel additionally notes that, in the Panel's view, the Respondent's actions in registering the present domain name clearly evince bad faith in violation of the Anti-Cybersquatting provisions of the Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

Thus, the Panel concludes that the Complainant, apart from default of the Respondent, has provided sufficient proof of its allegations to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

In accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the relief sought by the Complainant is hereby granted. The domain name is ordered transferred to the Complainant. The Center is authorized to publish this entire decision in its discretion on a publicly accessible web site.

Peter L. Michaelson
Panelist

Dated: July 28, 2000