



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark**

**Case No. D2007-0303**

#### **1. The Parties**

The Complainant is GoDaddy.com, Inc. of Scottsdale, Arizona, United States of America.

The Respondents are GoDaddysDomain.com of Conroe, Texas, United States of America; Clark Signs of Mableton, Georgia, United States of America; and Graham Clark (Yoursodomain.com) of Del Mar, California, United States of America.

#### **2. The Domain Names and Registrar**

The disputed domain names, <godaddyebay.com>, <godaddysebay.com>, <godaddysreseller.com>, <godaddythat.com>, <godaddythatdomain.com>, <godaddythis.com>, <gotgodaddy.com>, <gotpimpdaddy.com>, <pimpdaddydomain.com> and <yomygodaddy.com>, are all registered with Wild West Domains, Inc. (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 February 23, 2007, and in hard copy form, along with accompanying Annexes 1-9, on February 28, 2007. In response to a Notice of Deficiency sent by the Center and dated March 12, 2007, the Complainant filed an Amended Complaint with the Center on March 22, 2007. For simplicity, the term

“Complaint” will hereinafter refer to the Amended Complaint, except where specific reference is made to the original Complaint.

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, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 6, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and of information set forth in the Complaint relative to each of the disputed domain names: specifically, contact and registrant information. The Center also requested the Registrar to specify, for each such 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 March 6, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to each of the disputed domain names to the extent present in its WhoIS database, and confirmed that the Respondent is listed as the registrant for each name and provided the contact details for the administrative and technical contacts. The response also confirmed that Wild West Domains, Inc. is the registrar of each of the disputed domain names and stated that: the Registrar received a copy of the Complaint, the Policy applied to all of the disputed domain names, and all the domain names were then held in a “locked” status. The Registrar also indicated, through the response, that, for all the names: the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the Registrar; and all the registration agreements are in English.

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

On March 22, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Annexes, by courier and without the Annexes by email. The Center, upon realizing that it had not attached an electronic copy of the original Complaint with its March 22, 2007 email letter, separately forwarded such a copy to the Respondent by email on March 26, 2007. 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 March 22, 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 preceding and succeeding correspondence

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 April 11, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of April 11, 2007, the Center had not received a Response to the Complaint from the Respondent; hence, the Center, in an email letter April 12, 2007, notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated April 17, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated April 19, 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 May 3, 2007. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to May 17, 2007.

This dispute concerns ten domain names, specifically: <godaddyebay.com>, <godaddysebay.com>, <godaddysreseller.com>, <godaddythat.com>, <godaddythatdomain.com>, <godaddythis.com>, <gotgodaddy.com>, <gotpimpdaddy.com>, <pimpdaddydomain.com> and <yomygodaddy.com>.

The language of this proceeding is English.

#### **4. Factual Background**

A copy of the WhoIs registration records for all the disputed domain names appears in Annex 1 to the Complaint. As indicated on these records, the Respondent registered the following names on August 1, 2005: <godaddyebay.com>, <godaddysebay.com>, <godaddythat.com>, <godaddythatdomain.com>, <godaddythis.com>, <gotgodaddy.com> and <yomygodaddy.com>; the following name on August 3, 2005: <godaddysreseller.com>; and the following names on August 15, 2005: <gotpimpdaddy.com> and <pimpdaddydomain.com>.

##### **A. Complainant's DADDY Marks**

The Complainant owns numerous US trademark registrations for the term "DADDY", by itself or with other terms, such as "GO", in either block letters or stylized form and with or without an accompanying design element. The Complainant has provided, in Annex 3 to the Complaint, hard-copy printouts of the registration records for these marks from the publicly and web accessible Trademark Electronic Search System (TESS) furnished by the US Patent and Trademark Office. Details of pertinent ones of those registrations are as follows:

(1) Daddy

United States registration 3,156,369; registered: October 17, 2006  
filed: January 20, 2005

This mark was registered for use in connection with “registration, transfer and account management of services for domain names for identification of users on a global computer network; computer services, namely, managing and registering the domain names for use on a global computer network; hosting websites for others on a global computer network” in international class 42. This record states that both first use and first use in commerce of the mark in conjunction with these services commenced as of December 1, 2001.

(2) GO DADDY (block letters)

United States registration 2,593,111; registered: July 9, 2002  
filed: August 14, 2001

This mark was registered for use in connection with “providing income tax preparation and electronic filing services via a global computer network” in international class 35.

This record states that both first use and first use in commerce of the mark in conjunction with these services commenced as of December 1, 2001.

(3) GO DADDY (block letters)

United States registration 2,558,989; registered: April 9, 2002  
filed: August 14, 2001

This mark was registered for use in connection with “computer programs, namely programs for creating, posting and maintaining websites on the global computer network; computer graphics software, computer authoring software, and digitized graphics modules for designing and developing websites on a global computer network; and computer software provided by means of a global computer network which assists a user in creating customized forms” in international class 9; and for “registration, transfer and account management services of domain names for identification of users on a global computer network; registration and account management services of email accounts for identification of users on a global computer network” in international class 42. This record states that both first use and first use in commerce of the mark in conjunction with the goods in class 9 commenced as of April 19, 1999; and in conjunction with the services in class 42 as of November 3, 2000.

(4) GO DADDY SOFTWARE (stylized with logo)

United States registration 2,464,969; registered: July 3, 2001  
filed: May 6, 1999

This mark was registered for use in connection with “computer programs, namely computer graphics software, computer authoring software, and digitized graphics modules for designing and developing web sites on a global computer network” in international class 9. This record states that both first use and first use in commerce of the mark in conjunction with these goods commenced as of April 19, 1999.

**B. The Parties’ Activities**

The Complainant, in addition to being a domain name registrar and owning the

Registrar here, Wild West Domains, Inc., also offers a domain auction site through “The Domain Name Aftermarket” through which customers can buy and sell domain names.

The Respondent was a customer of the Complainant as early as November 2003, as the Respondent then registered a domain name, unrelated to any of the disputed names, through the Complainant’s automated domain name registration services.

In July of 2005, the Respondent registered three domain names, <godaddysdomains.com>, <godaddyswebsites.com> and <thegodaddygirls.com> (the “first set of domain names”), all of which the Complainant then considered to infringe on the DADDY Marks. Upon notification of the infringement, the Respondent requested an offer from the Complainant to purchase those domains. On July 21, 2005, the Complainant and the Respondent entered into an agreement to transfer the first set of domain names for US \$ 1500 per name to be paid by the Complainant for a total of US \$ 4500 (as evidenced by a copy of email correspondence between the parties which appears in Annex 5 to the Complaint). The Complainant subsequently paid US \$ 4500 to the Respondent. The Respondent then transferred those domain names to the Complainant (see copies of email correspondence between the parties, payment details and domain name transfer confirmation emails, all appearing in Annex 6 to the Complaint).

Between August 1-15, 2005, the Respondent then registered all the disputed domain names.

On November 10, 2005, the Complainant notified the Respondent, via email, that all the disputed domain names were infringing on its DADDY Marks. The Complainant offered to refund the purchase price of the disputed domain names to the Respondent in exchange for the Respondent then transferring those names to the Complainant (see copy of email appearing in Annex 8 to the Complaint). On November 17, 2005, the Respondent replied, via email (a copy of which also appears in Annex 8) through which it demanded a payment of \$1000 per name in exchange for each name. The Complainant rejected the offer.

After registering the disputed domain names, the Respondent began utilizing those names to offer the service of a domain name auction site, Sedo. See copies of web pages for the Sedo web site, sedo.com, appearing in Annex 9 to the Complaint. Sedo allows its customers to sell domain names in an auction environment -- services which directly compete with domain name auction services offered by the Complainant. Sedo’s customers earn a commission by setting up their own websites to offer Sedo’s auction services. Here, the Respondent initially set up each of the disputed domain names to re-direct Internet users to Sedo’s website. Currently, re-direction to the Sedo web site occurs through seven of the ten disputed domain names.

## **5. Parties’ Contentions**

### **A. Complainant**

(i) Identical or Confusingly Similar

The Complainant appears to contend that each of disputed domain names, by virtue of its inclusion of the mark DADDY or GO DADDY, is confusingly similar to the Complainant's DADDY Marks.

Specifically, the Complainant alleges that each such name includes the term "Go Daddy" or "Daddy", which are the dominant portions of the DADDY Marks, along with other simple generic or well-known terms, e.g., "this", "ebay", "that", "got" and "yomy", or a term that describes a component of the Complainant's services, e.g., "reseller" and "domains".

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

(ii) Rights or Legitimate Interests

The Complainant contends that, for either of two reasons, the Respondent has no rights or legitimate interests in any of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant contends that the Respondent neither has any business associated with nor is it identified by any of the disputed domain names. Specifically, the Respondent is not currently or has ever been legitimately known either professionally or privately as "Go Daddy".

Second, the Complainant contends that the Respondent's repeated registrations and offers to sell the disputed domain names to the Complainant establish that the Respondent was aware that it did not possess rights to or legitimate interests in any of the disputed domain names.

(iii) Registered and Used in Bad Faith

The Complainant contends that, for any of various reasons, the Respondent registered and is now using each of the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant alleges that, since the Respondent had already sold its first set of domain names to the Complainant for a considerable profit, the Respondent's registration of the disputed domain names is but another intentional attempt to simply force the Complainant to purchase these latter names for an amount far in excess of their costs of registration, thus violating paragraph 4(b)(i) of the Policy. This action reflects a pattern of the Respondent's intent on trading on the goodwill of the Complainant for the Respondent's own pecuniary reward, thus evidencing bad faith under paragraph 4(b)(ii) of the Policy.

Second, the Complainant contends that bad faith is shown under paragraph 4(b)(iv) of the Policy, by the Respondent's actions, in using the names as a vehicle of re-direction, to resell Sedo's domain name auction services which directly compete with those of the Complainant. As best understood, the Complainant appears to be alleging that such use establishes a false connection, as would be perceived by Internet users who seek the Complainant's services, between the Complainant and the Sedo web site when, in fact, no such connection actually exists.

Third, since the disputed domain names represent the second time that Respondent registered and then offered to sell domain names that infringe the DADDY Marks, this indicated that the Respondent had actual knowledge of the DADDY Marks when it registered the second set of names. This knowledge is reinforced by the Respondent then having used those names as a vehicle through which it offered domain name auction services directly competitive with those then offered by the Complainant. This conduct, in turn, amounts to bad faith registration of each of these names.

## **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 confusion is likely to arise as a result of the Respondent's use of each of the disputed domain names.

Specifically, each disputed domain name is simply formed by combining either simple or generic term(s) to Complainant's mark DADDY or GO DADDY and then appending a generic top level domain (gTLD) ".com" thereto to form the name, the latter being ignored in assessing identity/confusing similarity under paragraph 4(a)(i) of the Policy.

It is now very well-established in UDRP precedent, including various decisions rendered by this Panel, that minor variations, such as adding short letter or number groups or even a generic word to a mark are each grossly 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. See, e.g., *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 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. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entm't, Inc. v. Nova Internet Inc*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corp. 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 *Nat'l Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004). This result follows from a simple comparison of each of the disputed domain names against the Complainant's DADDY Marks.

While a sufficient number of variations or even one such significant variation itself

made to a mark may suffice, under a specific factual situation, to impart requisite distinctiveness to a resulting domain name and there through dispel user confusion (see *CP Films, Inc. v. Solar Lunar Performance Film*, NAF Case No. FA861127 (February 6, 2007), such is clearly not the case here with respect to any of the disputed names.

With this in mind, each of the disputed domain names is confusingly similar to the Complainant's DADDY Marks.

Hence, the Complainant has met 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, would under the present circumstances, legitimize a claim to any of the disputed domain names under paragraph 4(c) of the Policy.

Here, no evidence exists of record that leads this Panel to conclude that, through any of these names, the Respondent:

- (a) prior to receiving notice of the Complaint, made any demonstrable preparations to use the name in conjunction with a *bona fide* offering of goods or services,
- (b) has been commonly known that name, or
- (c) is using that name in conjunction with any legitimate noncommercial or fair use manner not intended to misleadingly divert consumers or tarnish the Complainant's DADDY Marks.

Further, no evidence exists of record that the Complainant has ever authorized the Respondent to utilize any of its DADDY Marks or any mark confusingly similar thereto in conjunction with the specific goods and services which the Complainant provides under its DADDY 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 marks DADDY or GO DADDY or one confusingly similar thereto, in connection with the goods or services provided by the Complainant or those similar thereto, would violate the exclusive rights now residing in the Complainant. See, e.g., *Citgo and Krings v. Hernandez*, both cited *supra*; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *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. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc*, WIPO Case No. D2005-0411 (June 22, 2005); *Pelmorex Communications Inc. v. weathernetwork*, 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. IWebAddress.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, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000). Consequently,

the Respondent could not legally acquire any public association between it and the marks DADDY or GO DADDY or one similar thereto, at least for the branded goods and services rendered by the Complainant or similar branded goods and services. Hence, based on the evidence before the Panel, the Respondent is not commonly known or recognized by that mark or any of the disputed domain names, and thus does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, as noted above, the Respondent was obviously fully aware of the Complainant and its marks when the Respondent registered all the disputed domain names and, in spite of that knowledge, did so in a blatant attempt to use each of those names as a vehicle to opportunistically exploit the Complainant's goodwill and extract pecuniary income from the Complainant. Hence, any claim which the Respondent may make to any of these names is simply baseless and illegitimate.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in any of the disputed domain names 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 all the disputed domain names.

Specifically the Panel finds that not only was the Respondent well aware of the Complainant and its marks when the former registered the disputed domain names, but also that very likely the Respondent intentionally choose each of these names for its potential to generate user confusion, tarnish the Complainant's marks and, through doing so, injure the Complainant's goodwill. Clearly, the Respondent, having succeeded in previously coercing the Complainant to purchase a set of confusingly similar domain names which the Respondent has registered, intended to repeat its past success by coercing the Complainant to purchase a second set of domain names, i.e., the disputed domain names, again for an amount (US \$ 1000 each) well in excess of their cost of registration in order to avoid such injury. This time, the Complainant refused. In response, the Respondent applied heightened coercive pressure on the Complainant to purchase these names by actually using most of the disputed domain names as an instrumentality to direct user traffic to the Sedo website through which auction services were offered that directly competed with those then offered by the Complainant. Such actions completely negate any view that the Respondent intended, in good faith, to create and register any name, from amongst the disputed domain names, which it expected would be sufficiently distinctive from the Complainant's DADDY Marks, rather than instead solely having intended to register and use those names -- as it did -- to opportunistically exploit the Complainant's goodwill and its marks for the Respondent's own pecuniary advantage. See *Citgo, cited supra*.

Hence, the Panel finds that the Respondent's conduct in registering and using each of the disputed domain names violates paragraphs 4(b)(i) and 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to each of the disputed domain names, 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.

All the disputed domain names, <godaddyebay.com>, <godaddysebay.com>, <godaddysreseller.com>, <godaddythat.com>, <godaddythatdomain.com>, <godaddythis.com>, <gotgodaddy.com>, <gotpimpdaddy.com>, <pimpdaddydomain.com> and <yomygodaddy.com>, are ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: May 7, 2007