



CPR Institute for Dispute Resolution

COMPLAINANT

Grolier Incorporated
90 Old Sherman Turnpike
Danbury, Connecticut 06816
Tel: (212)-343-6560
Fax: (212) 343-6538
E-mail: tm&c@scholastic.com

File Number: CPR0313

Date of Commencement: May 6, 2003

Domain Name: groler.com

Registrar: CSL Computer Services
Langenbach GmbH
d/b/a Joker.com

vs.

Arbitrators: Peter L. Michaelson, Esq. (presiding),
Harold D. Field, Esq. and
James P. O'Shaughnessy, Esq.

RESPONDENT

John Zuccarini
Cupcake Patrol
Saffrey Square
P. O. Box N-4149
Nassau, N.P. BS
Tel: n/a
Fax: n/a
E-mail: blastout@cyberdude.com#0

Before Peter L. Michaelson, Esq., Harold. D. Field, Esq., James P. O'Shaughnessy, Esq. Arbitrators

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") as approved on October 24, 1999 and the CPR Institute for Dispute Resolution Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("the Supplemental Rules").

The Complaint was filed with CPR on May 2, 2003 and, after review for administrative compliance, served on the Respondent on May 6, 2003. Though a response was due on May 26, 2003, the Respondent did not file any Response. On June 9, 2003, we were appointed Arbitrators pursuant to the Policy and the Rules.

Upon the written submitted record including the Complaint and its attached Exhibits A-E, we find as follows.

FINDINGS

The contested domain name, GROLER.COM, was registered by the Respondent with the Registrar on February 24, 2000. In registering the name, the Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP, and is now so bound.

Paragraph 4(a) of the Policy provides that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

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.

IDENTICALITY/CONFUSING SIMILARITY:

The Complainant alleges that the contested domain name, GROLER.COM, is identical or confusingly similar to Complainant's trademark, GROLIER, which applies, *inter alia*, to encyclopedias featuring articles on various subjects of educational, business, health and entertainment interest, atlases; biographies; and information cards.

In particular, the Complainant owns at least eight United States registrations for or including the term "GROLIER" (collectively the "GROLIER Marks") on which this dispute is based. The Complainant has provided, in Exhibit A to the Complaint, a list of the GROLIER Marks, illustratively including:

- a) GROLIER (block letters)
US registration 2,141,672; registered March 10, 1998
This mark was registered for use in connection with "full line of pre-recorded CD ROMs and optical discs feature interactive multimedia works on various subjects of educational and business interest" in international class 9.
- b) GROLIER (block letters)
US registration 2,110,255; registered November 4, 1997
This mark was registered for use in connection with "full line of books and publications on a variety of topics, namely, encyclopaedias featuring articles on various subjects of educational, business, health and entertainment interest, children's books, reference books on various subjects of educational, business and entertainment interest; educational and factual information materials, namely, atlases, biographies, informational cards, books on how to conduct research, learn reading, writing and math skills, learn languages, make arts and crafts and play sports; cookbooks; trading cards; instructional books and manuals for CD-ROM and optical discs products; series of fiction books" in international class 16.

c) GROLIER MULTIMEDIA ENCYCLOPEDIA (block letters)
US registration 1,975,416; registered May 21, 1996

This mark was registered for use in connection with "computer programs and instructional manuals sold as a unit in the nature of reference works and educational materials for adults and children" in international class 9.

The Complainant is a global publishing and media company which produces and distributes children's books, reference and encyclopedia volumes and multimedia products. It is among the leading direct-to-home distributors of children's books and other educational materials and sells these and other products through its popular Internet web site accessible at www.grolier.com.

Since at least as early as 1895, the Complainant has been using its mark GROLIER and other marks featuring the term GROLIER preceded or followed by other word(s) in connection with a wide variety of goods and services.

Among its many activities, the Complainant uses the GROLIER Marks in connection with its publication of nonfiction reference materials for schools and libraries, the publication and sale of educational software and multimedia products to school administrators, teachers, parents and students, and in connection with the Complainant's various continuity programs for children, such as book-of-the-month clubs.

The Complainant has continuously, exclusively and extensively used the GROLIER Marks in connection with the promotion and sale of products and services throughout the United States and other countries.

Since 1995, the Complainant has used the GROLIER Marks on and in connection with information and services offered through online services and on the Internet. Specifically, in 1995, the Complainant registered the domain name GROLIER.COM with Network Solutions, Inc. Since April of 1995, the Complainant has used the GROLIER Marks in connection with its Internet web sites, including <www.grolier.com>.

Among other things, the Complainant uses its web sites to promote its goods and services. The Complainant provides visitors to its web site at <www.grolier.com> with immediate online access to its many and varied educational resources, reference books, and merchandise.

The Complainant has expended millions of dollars to promote its GROLIER Marks and the goods and services which bear those marks. As a result of these expenditures and efforts, the Complainant possesses proprietary rights in the GROLIER Marks and the public has come to strongly associate the goods and services provided by the Complainant with those marks.

The Complainant first became aware of the Respondent's domain name, GROLER.COM, in July 2002, at which time it informed the Respondent that the use of that domain name infringed upon the Complainant's rights. The Complainant sent follow-up correspondence on three subsequent occasions to the Respondent. The Respondent never responded to any of this correspondence. A copy of all this correspondence appears in Exhibit C to the Complaint.

The Complainant contends that the contested domain name is confusingly similar to the GROLIER Marks and the Complainant's domain name, GROLIER.COM, because the contested name is identical to

both the mark GROLIER and the Complainant's domain name with exception of omitting the letter "I" -- which, the Complainant asserts, amounts to a common typographical error. This similarity tends falsely to suggest that the Respondent's web site GROLER.COM is an online source of information from the Complainant and a URL through which customers can access the Complainant's products. Consumers, who are highly familiar with the Complainant and its products, are likely to be confused by the similarity between the contested domain name, GROLER.COM, and the Complainant's domain name, GROLIER.COM, and will think that the web site accessible at GROLER.COM is authorized or associated with the Complainant and its goods and services -- when, in fact, it is not. Moreover, if a consumer trying to access Grolier's website mistypes the URL, omitting the "i", that consumer doubtlessly will fail to appreciate that (s)he has accessed Respondent's website, erroneously believing it in fact to be that of the Complainant. Under those circumstances, such an unsuspecting consumer would be confused and, indeed, perplexed by what (s)he viewed, as described in more detail below.

Furthermore, the Complainant points to the Respondent's past and repeated illicit activities, particularly typosquatting, which were the subject of: *Electronics Boutique Holdings Corp., v. Zuccarini*, No. 00-4055, 2000 U.S. Dist. LEXIS 15719 (E.D. Pa. Oct. 30, 2000) (holding the same Respondent liable for "cybersquatting" under 15 U.S.C. § 1125(d) for registering domain names that varied by one letter from complainant's registered mark); *Shields v. Zuccarini*, 254 F.3d 476, 483 (3d Cir. 2000) ("To divert Internet traffic to his sites, Zuccarini admits that he registers domain names . . . because they are likely misspellings of famous marks or personal names."); and recently *National Ass'n of Prof. Baseball Leagues, Inc., v. Zuccarini*, D2002-1011 (Jan. 21, 2003) (WIPO decision finding Zuccarini to be a self-proclaimed "typosquatter").

The Panel finds that confusion would unquestionably arise -- and in fact is so intended -- as a result of the Respondent's current use of the contested domain name which is a common misspelled variant of the Complainant's mark "GROLIER".

Specifically, in view of the Complainant's extensive, prolonged and continuing activities in promoting its various products and services under its GROLIER Marks for over the past 100 years, those marks have become clearly distinctive and, accordingly, have acquired considerable secondary meaning as a source identifier of the Complainant's goods and services. As such, the Complainant has developed a substantial, widespread reputation through those marks. It is utterly inconceivable, given this reputation, that the Respondent was completely unaware of it when he registered the contested domain name, let alone when the Respondent subsequently utilized that name as an instrumentality to re-direct Internet users to the Respondent's web site at which such users were exposed to a series of windowed advertisements for a variety of products and obstructed from exiting the Internet, i.e. mouse-trapped.

Merely deleting the letter "I" from the mark "GROLIER" to yield the contested domain name, GROLER.COM, is a change that is so de minimus that it utterly fails to dispel user confusion. The only purpose which the Panel envisions behind the Respondent having made such a minor change over the Complainant's mark GROLIER is to cause and opportunistically exploit inevitable user confusion. There can be no question that this is the Respondent's goal and is borne out by the Respondent's own actions. Otherwise, why would the Respondent have chosen a domain name that, given its very slight alteration, remains, for all intents and purposes, equivalent to the Complainant's mark "GROLIER"? The Panel fails to see any credible reason. See *Grolier Incorporated v. Research Center* CPR0220 (CPR September 30, 2002) which similarly addressed a different de minimus change there in the context of adding an "S" to the GROLIER mark to obtain a contested domain name "GROLIERS.COM".

Such confusion would undoubtedly cause Internet users intending to access the Complainant's web site,

but who reach the Respondent's web site through the contested domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship exists at all. See, e.g., *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.* FA117876 (Nat. Arb. Forum, December 16, 2002); *Southwest Airlines Co. v. TRN* WIPO Case No. D2002-0893 (Nov. 18, 2002) ; *Pfizer Inc., A Delaware Corporation v. Phizer's Antiques and Robert Phizer* WIPO Case No. D2002-0410 (July 3, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *MPL Communications, Limited and MPL Communications, Inc. v. LOVEARTH.net*, FA 97086 (Nat. Arb. Forum June 4, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *American Home Products Corp. v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Indus., Inc. v. The Webposters*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum December 18, 2000); and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that the contested domain name <groler.com> sufficiently resembles the Complainant's mark "GROLIER" as to cause confusion; hence, the Complainant has shown sufficient similarity between that mark and the contested domain name under paragraph 4(a)(i) of the Policy.

RIGHTS AND LEGITIMATE INTERESTS:

The Complainant alleges that the Respondent has no rights or legitimate interests with respect to the domain name at issue.

Paragraph 4(c) of the Policy provides that the Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that: (i) before notice to the Respondent of the dispute, the Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) the Respondent has been commonly known by the domain name; or (iii) the Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Specifically, in support of this allegation, Complainant states that the Respondent has not been authorized by the Complainant to use the GROLIER Marks and is not affiliated with the Complainant in any way. The Complainant also contends that the Respondent has not been commonly known as GROLER.COM or GROLER as an individual, business or other organization.

Furthermore, the Complainant contends that the Respondent registered or acquired the contested domain name primarily for the purpose of luring Grolier's customers to sites that offer, among other things, pornography, gambling and sexual enhancement drugs.

Specifically, as of the filing date of the Complaint, the Complainant states that a user who enters <www.groler.com> in a browser, while perhaps mistakenly trying to access the Complainant's web site <www.grolier.com>, is first directed to a website called "Hanky-Panky-College." This site touts "sexually-oriented adult content" including "visual images and verbal descriptions of nude adults [and] adults engaging in sexual acts." Simultaneously, another website entitled "YES YES YES" opens, which offers links to "popular topics" such as online gambling. Further, when that user closes the "Hanky-Panky-College" website, (s)he is then immediately transferred to the "YES YES YES" website.

If that user realizes his or her mistake and types in the Complainant's URL <www.grolier.com> in the browser, that user is then "page-jacked" or "mousetrapped". In particular, that user is brought to another site and obstructed from exiting the Internet. Instead of reaching the Complainant's website, another screen pops up called "www.mp3messenger.com", which connects the user to a website that offers MP3 products and services. Thereafter, should that user, while still trying to access the Complainant's web site <www.grolier.com>, attempt to close the browser, (s)he is "page-jacked" to another screen entitled "Prescription-Drugs.Org," which features a prominent advertisement for "penis enlargement pills." The sole link on this page leads to another website that offers further information about penis-enlargement pills. It is not until after the user closes the "Prescription-Drugs.Org" screen that the user is finally taken to the Complainant's website. Copies of all these web pages appear in Exhibit D to the Complaint. Put simply, a user must view several successively displayed screens, which contain links to pornography, gambling and sexual enhancement drugs, before reaching the Complainant's website.

The Complainant contends that this unauthorized use reflects the Respondent's intent to take advantage of the Complainant's renowned and substantial goodwill, which has been built up over many years. This misuse is apparently designed to purposefully deceive and confuse consumers into falsely believing they are reaching a website sanctioned by the Complainant, only to be redirected to websites, including pornographic and gambling websites, that solicit their business and ostensibly are totally unrelated to the Complainant.

This Panel views that the Complainant, given its federal trademark registrations, has acquired exclusive rights to use its "GROLIER" Marks in conjunction with the goods and services which the Complainant has been providing under the mark "GROLIER" for more than 100 years. Furthermore, by virtue of having registered the mark "GROLIER" along with the others that include that term, the US Patent and Trademark Office has long ago recognized that the "GROLIER" Marks have acquired requisite secondary meaning in the marketplace.

The Panel believes that the Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name. In fact, it is extremely unlikely that the Respondent can even make such a claim.

The simple reason is that the contested domain name, for all intents and purposes, is equivalent to the Complainant's mark "GROLIER" under which the Complainant provides its goods and has been doing so for over 100 years. Furthermore, the Complainant has never authorized the Respondent to utilize the mark "GROLIER", or a mark confusingly similar thereto, in conjunction with the specific goods and services which the Complainant provides under that the GROLIER Marks, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "GROLIER" or a mark confusingly similar thereto, such as "GROLER", in connection with the goods and service presently provided by the Complainant as well as those set forth in any of the Complainant's registrations would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Pfizer Inc., A Delaware Corporation v. Phizer's Antiques and Robert Phizer*, cited *supra*, the *MPL Communications*, FA 97086 and FA 97092 decisions, cited *supra*; *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000), and *Treeforms, Inc. v. Cayne Ind. Sales Corp.*, cited *supra*.

It is eminently clear to this Panel that the Respondent, in choosing a domain name that, at its essence, is identical and hence confusingly similar to the Complainant's mark "GROLIER", is intentionally seeking to opportunistically exploit user confusion (and is in fact doing so) by diverting, through re-direction and

subsequent entrapment, Internet users away from the Complainant's site to the Respondent's web site for the latter's own pecuniary benefit, i.e., exposing those users to a succession of advertising pages promulgated by the Respondent for the sole purpose of generating click-through revenue for the Respondent -- revenue which the Respondent would not have received but for the diversion.

The Respondent is accomplishing this by simply relying on typosquatting, i.e. registering domain names that contain common misspelling of trademarks. Through doing so, the Respondent takes advantage of what has recently become a marked tendency of Internet users to form a domain name for a given source by appending a gTLD (generic top level domain, e.g. ".com") to a corresponding well known mark associated with that source but then, in actually doing so, type the mark with an inadvertent misspelling, such as here by simply deleting the letter "I" from the Complainant's mark "GROLIER" to form "GROLER.COM". Through such action, the Respondent directly capitalizes on the reputation and fame of that mark -- to the Complainant's ultimate detriment and the Respondent's ultimate financial gain.

Such parasitic use, which at its essence relies on instigating and exacerbating user confusion, can not and does not constitute bona fide commercial or fair use sufficient to legitimize any rights and interests the Respondent might have in the contested domain name. See *Pfizer Inc., A Delaware Corporation v. Phizer's Antiques and Robert Phizer*, cited *supra*, and *Peter Frampton v. Frampton Enterprises, Inc.*, cited *supra*.

In light of the above findings, the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in the contested domain name under any provision of paragraph 4(c) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the contested domain name within paragraph 4(a)(ii) of the Policy.

BAD FAITH:

The Complainant contends that the Respondent's actions amount to bad faith registration and use under the Policy.

Paragraph 4(b) of the Policy provides various examples of a respondent's conduct that signify bad faith including, without limitation: (i) registration for the purposes of selling, renting or transferring the domain name to the complainant for value in excess of the respondent's cost; (ii) a pattern of registration in order to prevent the complainant from reflecting the mark in a corresponding domain name; (iii) registration for the primary purpose of disrupting the business of a competitor; or (iv) an intentional attempt to attract, for commercial gain, Internet users to the respondent's web site by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's web site or location, or of a product or service on the respondent's web site or location.

The Complainant contends that the Respondent registered and uses the contested domain name to purposefully deceive and confuse Internet users who intend to reach the Complainant web site into falsely believing they are reaching a web site sanctioned by the Complainant, only to be redirected and lured to websites that solicit their business by offering, among other things, pornography, gambling and sexual enhancement drugs.

Furthermore, the Complainant contends that the Respondent's practice of "page-jacking" or

“mousetrapping” users, including obstructing them from exiting web pages they may have reached in error, also constitutes bad faith. Among other things, the Respondent is intentionally attempting to attract the Complainant's customers (actual or potential) for commercial gain and to entice them to his websites by creating a likelihood of confusion with the GROLIER Marks and Grolier websites. *See Electronics Boutique*, 2000 U.S. Dist. LEXIS 15719, at *25 (“Advertisers pay Mr. Zuccarini between ten and twenty-five cents each time an Internet user clicks on one of their ads posted on Mr. Zuccarini’s websites. Many of the domain names . . . infringe on the marks of others.”).

In addition, the Complainant contends that the Respondent’s use of the GROLIER Marks in connection with pornography, gambling and sexual enhancement drugs dilutes and tarnishes those marks, which are uniquely associated with children and children’s education material, and thus constitutes additional evidence of the Respondent’s bad faith.

Moreover, the Complainant alleges that the Respondent’s failure to provide accurate and complete name and contact information to the Registrar is further evidence that Respondent registered the contested domain name in bad faith and has no legitimate rights in the domain name. In that regard, the Respondent lists his street address as simply “Atlanta, Georgia 30350.” The Respondent provides no additional contact information except for e-mail addresses.

The Complainant also states that this is not the first time that this Respondent has sought to take advantage of the renowned reputation and goodwill of others. The Respondent has demonstrated an unremitting pattern of registering domain names in order to prevent trademark owners from registering their marks as corresponding domain names. Indeed, on more than fifty past occasions Respondent was ordered to transfer domain names to the appropriate complainants. *See Primedia Specialty Group Inc. v. Zuccarini*, D2002-1017 (Jan. 21, 2003) (“Zuccarini’s conduct in this case is no different in quality from that in over 50 ICANN cases in which he has been found to have violated the [Uniform Domain Name Dispute Resolution] Policy”); *National Ass’n of Prof. Baseball Leagues, Inc., v. Zuccarini*, D2002-1011 (Jan. 21, 2003) (listing twenty-five ICANN decisions in which respondent was found to have violated the Uniform Domain Name Dispute Resolution Policy); *see also Electronics Boutique*, 2000 LEXIS 15719, at *15 n.11 (“Mr. Zuccarini is a notorious cybersquatter.”).

Further, the Complainant states that, after finding that the Respondent engaged in unfair and deceptive acts in violation of Section 5 of the Federal Trade Commission Act, the U.S. District Court for the Eastern District of Pennsylvania permanently enjoined Respondent from continuing his business as a cybersquatter. *See FTC v. Zuccarini*, No. 01-CV-4854 (E.D. Pa. April 9, 2002). According to the Court’s order, Respondent may no longer conduct “page-jacking” or “mousetrapping” by redirecting or obstructing consumers on the Internet.

It is inconceivable to this Panel that, when the Respondent chose and registered the contested domain name in February 2000, that the Respondent had not been fully aware of the Complainant's mark “GROLIER” and particularly the widespread reputation which that mark (and by extension others than included the term "GROLIER") had attained as a result of the Complainant's long-term and on-going marketing and other efforts in its various fields of endeavor now stretching back over 100 years. In fact, not only was this Respondent aware of this mark but the Respondent, who had absolutely no association, relationship or affiliation whatsoever with the Complainant, nevertheless intentionally choose to opportunistically exploit the goodwill in that mark by creating a likelihood of user confusion by suggesting to Internet users that such an association, relationship or affiliation exists -- when, in fact, it clearly does not, and by doing so create opportunities, to commercially benefit himself, that would invariably arise out of that confusion. Again, if this was not the case, then what reason would the

Respondent have in choosing a domain name that is a common misspelling of the Complainant's mark (a mark which is in no way descriptive or suggestive of any product)? In view of the overwhelming and clearly persuasive evidence in the record, the Panel believes none. This conduct directly contravenes paragraph 4(b)(iv) of the Policy.

Such exploitation is clearly evident through the Respondent's actions in using the contested domain name to divert those users, who enter the contested domain name into their browsers expecting to reach the Complainant's web site, to the Respondent's site and then mousetrap those individuals as a potential source of click-through revenue.

In that regard, the purely commercial motivation underlying the Respondent's mousetrapping actions is unquestionably borne out by the lower court ruling in the *Shields* case, see *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 (US Dist. Ct. E.D. Pennsylvania 2000) (aff'd on appeal), where the Court noted just how much revenue the Respondent received, i.e. "his click-based revenue now approaches \$ 1 million per year." *Id* at 639. There, Judge Dalzell, under the Anticybersquatting Consumer Protection Act (ACPA) provisions (see 15 USC § 1125(d)(1)) of the Lanham Act, granted relief against this very same Respondent for the same conduct it perpetrated in the present case though involving the domain names <joescartoon.com>, <joescarton.com>, <joescartons.com>, <joescartoons.com> and <cartoonjoe.com> in view of the plaintiff, Shield's, domain name <joecartoon.com>. Specifically, the Court granted a preliminary injunction and a permanent injunction against the Respondent, and awarded to Plaintiff Shields statutory damages in the amount of US \$ 50,000 and attorneys' fees and costs of approximately US \$ 40,000. In its final order, the Court described Defendant Zuccarini's (this Respondent's) conduct as "utterly parasitic and in complete bad faith." Further, the Court stated: "Zuccarini has engaged in exactly the type of conduct that the ACPA is designed to prevent, and Shields will suffer irreparable harm unless we enjoin this flagrant violation of his rights".

Given the identical nature of the Respondent's conduct in question here to that in the *Shields* case, the Panel takes the same view of this conduct as did the Court.

Furthermore, various administrative proceedings against the very same Respondent have considered the same conduct of the Respondent in registering domain names that included well-known or famous trademarks or common misspellings thereof, as well as in some instances also linking to those domain name(s) to the Respondent's web site, trapping users to that site and then displaying multiple frames to the user's browser (that collectively cause "mousetrapping" as in the present case). In each such instance, the panel ordered the corresponding contested domain(s) names transferred to the complainant. As the decisions indicate (and the Panel does not represent the following list to be exhaustive), the Respondent's repetitive conduct in each instance clearly constituted bad faith under the Policy. Viewed together, the following decisions, just by their sheer numbers alone, clearly illustrate the egregious and recidivist nature of the Respondent's conduct and just how incorrigible this Respondent is in his recurring and continued efforts to violate the Policy. See, e.g., *AT&T Corp. v. Zuccarini*, WIPO Case No. D2002-0666, (September 5, 2002); *Williams-Sonoma, Inc. v. Zuccarini*, WIPO Case No. D2002-0582 (August 9, 2002); *OfficeMax, Inc. v. Zuccarini*, WIPO Case No. D2002-0354 (July 18, 2002); *State of Florida Dept. of the Lottery v. Zuccarini*, WIPO Case No. D2002-0307 (May 25, 2002); *Sierra Trading Post, Inc. v. Zuccarini*, WIPO Case No. D2002-0263 (May 24, 2002); *CareerBuilder, Inc. v. Zuccarini*, WIPO Case No. D2002-0282 (May 21, 2002); *VoiceStream Wireless Corp. v. Zuccarini*, WIPO Case No. D2002-0146 (May 16, 2002); *NIHC, Inc. v. Zuccarini*, WIPO Case No. D2002-1260 (January 15, 2002); *Backstreet Productions, Inc. v. Zuccarini*, WIPO Case No. D20021-0654 (August 24, 2001); *TPI Holdings, Inc. v. Zuccarini*, WIPO Case No. D2001-0797

(August 22, 2001); *The Sportsman's Guide, Inc. v. Zuccarini*, WIPO Case No. D2001-0617 (July 19, 2001); *Disney Enterprises, Inc. v. Zuccarini*, WIPO Case No. D2001-0489 (June 19, 2001); *Cimcities, LLC v. Zuccarini*, WIPO Case No. D2001-0491 (May 31, 2001); *Dow Jones & Co., Inc. v. Zuccarini*, WIPO Case No. D2001-0302 (May 18, 2001); *Eddie Bauer, Inc. v. Zuccarini*, WIPO Case No. D2001-0224 (April 26, 2001); *Time Warner Entertainment Co., L.P. v. Zuccarini*, WIPO Case No. D2001-0184 (April 11, 2001); *Autosales Inc. v. Zuccarini*, WIPO Case No. D2001-0230 (March 30, 2001); *NCRAS Management, LP v. Zuccarini*, WIPO Case No. D2000-1803 (February 26, 2001); *At Home Corp. v. Zuccarini*, WIPO Case No. D2000-1524 (January 30, 2001); *Nicole Kidman v. Zuccarini*, WIPO Case No. D2000-1415 (January 23, 2001); *United Feature Syndicate, Inc. v. Zuccarini*, WIPO Case No. D2000-1449 (December 29, 2000); *WebMD Corporation v. Cupcake Patrol* FA96106 (Nat. Arb. Forum January 2, 2001); *United Feature Syndicate, Inc. v. Mr. John Zuccarini* WIPO Case No. D2000-1449 (December 29, 2000); *Microsoft Corporation v. Cupcake Patrol* WIPO Case No. D2000-1344 (December 10, 2000); *FAO Schwartz v. John Zuccarini* FA95828 (Nat. Arb. Forum December 1, 2000); *PRIMEDIA Magazine Finance Inc. v. Zuccarini*, WIPO Case No. D2000-1186 (November 20, 2000); *Hewlett-Packard Company v. Cupcake Patrol* FA95822 (Nat. Arb. Forum November 20, 2000); *Victoria's Secret et al v. John Zuccarini d/b/a Cupcake Patrol, Cupcake Party and Country Walk* FA95762 (Nat. Arb. Forum November 18, 2000), *Musicmatch, Inc. v. Cupcake Patrol* FA95733 (Nat. Arb. Forum November 18, 2000); *American Airlines, Inc. v. John Zuccarini* FA95695 (Nat. Arb. Forum November 6, 2000); *Abercrombie & Fitch Stores, Inc. et al v. Zuccarini et al*, WIPO Case No. D2000-1004 (November 1, 2000); *Diageo plc v. John Zuccarini, Individually and t/a Cupcake Patrol* WIPO Case No. D2000-0996 (October 22, 2000); *Microsoft Corporation v. Cupcake City* WIPO Case No. D2000-0818 (October 22, 2000); *Budget Rent a Car Corporation v. Cupcake City* WIPO Case No. D2000-1020 (October 19, 2000); *Yahoo! Inc. and GeoCities v. Cupcakes, Cupcake city, Cupcake Confidential, Cupcake-Party, Cupcake Parade, and John Zuccarini* WIPO Case No. D2000-0777 (October 2, 2000); *Yahoo!, Inc. v. Cupcake Patrol and John Zuccarini* WIPO Case No. D2000-0928 (September 29, 2000); *Gamesville.com, Inc. v. John Zuccarini* FA95294 (Nat. Arb. Forum August 30, 2000); *Cabela's Incorporated v. Cupcake Patrol* FA95080 (Nat. Arb. Forum August 29, 2000); *Cabela's Incorporated v. John Zuccarini* FA95233 (Nat. Arb. Forum August 28, 2000); *Dow Jones & Company, Inc. and Dow Jones LP v. John Zuccarini* WIPO Case No. D2000-0578 (August 28, 2000); *Diageo p.l.c. v. John Zuccarini* WIPO Case No. D2000-0541 (August 22, 2000); *L.L. Bean, Inc. v. Cupcake Patrol* FA95105 (Nat. Arb. Forum August 4, 2000); *Spiegel Catalog, Inc. v. John Zuccarini* AF0237a-d (eResolution July 28, 2000); *James Squires v. John Zuccarini* AF-0218 (eResolution July 18, 2000); and *Encyclopedia Britannica, Inc. v. Zuccarini*, WIPO Case No. D2000-0330 (June 7, 2000).

The Panel sees every reason to join this chorus in holding the Respondent's actions here clearly evidence "bad faith" and absolutely no reason to deviate therefrom.

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of the contested domain name under paragraph 4(a)(iii) of the Policy.

Moreover, the Panel's finding of bad faith use and registration is buttressed by the fact that the Respondent also failed to: (a) provide the Registrar with his complete contact information, and (b) update that information.

We therefore conclude that Respondent registered and used the domain name in bad faith, under paragraph 4(a)(iii) of the Policy.

CONCLUSION

In light of our findings above that: (a) the contested domain name is identical or confusingly similar to the Complainant's protected mark; (b) the Respondent does not have any rights or legitimate interests in the contested domain name; and (c) the Respondent registered and used the contested domain name in bad faith, we conclude that the Complainant, through its Complaint, has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy. Hence, we find in favor of the Complainant.

REMEDY

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

The contested domain name, specifically <GROLER.COM>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq., Presiding Panelist

June ____, 2003

Harold. D. Field, Esq., Panelist

June ____, 2003

James P. O'Shaughnessy, Esq., Panelist

June ____, 2003