



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Mess Enterprises v. Scott Enterprises, Ltd.

Case No. D2004-0964

1. The Parties

The Complainant is Mess Enterprises, San Francisco, California, of United States of America, represented by Steve Clinton, United States of America.

The Respondent is Scott Enterprises, George Town, Grand Cayman, of United Kingdom of Great Britain and Northern Ireland, represented by ESQwire.com Law Firm, United States of America.

2. The Domain Name and Registrar

The disputed domain name <mess.com> is registered with Tucows.

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 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 with the WIPO Arbitration and Mediation Center (the "Center") in e-mail form on November 16, 2004, and in hard-copy form on November 15, 2004, along with Annexes 1-5.

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 whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on November 15, 2004, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain 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 the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on November 15, 2004, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in its WhoIS database, confirmed that Tucows is the registrar of that name, stated that: it had received a copy of the Complaint, the Policy applied to the disputed domain name, the language of the underlying registration agreement for the name is English and, pending the outcome of the administrative proceeding, the name will held in a “locked” status. The Registrar also informed the Center that the Respondent, through the registration agreements, had submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use the disputed domain name.

On November 17, 2004, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier, facsimile and e-mail (the latter two without the Annexes), to the Respondent. Specifically, the Center separately provided its notice along with the Complaint, by courier, facsimile and e-mail, to the Respondent’s domain name registrant, technical, administrative and zone contacts as set forth in the WhoIS record for the disputed domain name. In addition and also on November 17, 2004, the Center forwarded a copy of the Complaint (without the annexes) to the Registrar. 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 17, 2004, under Paragraph 4(c) of the Policy, 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, 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 December 7, 2004, to file its Response with the Center and serve a copy of the Response on the Complainant. Subsequently and pursuant to an agreement of the parties, the Center extended that due date to December 14, 2004.

Subsequently, the Respondent timely filed its Response with the Center by e-mail on December 14, 2004, though due to a six-hour time zone difference between the location

of the Respondent's authorized representative and that of the Center, the Center did not receive the response in e-mail form until December 15, 2004. The Center received a hard-copy version of the Response, along with Annexes 1-10, on December 22, 2004. Through its Response, the Respondent requested a three member panel.

Accordingly, pursuant to the Rules and Supplemental Rules, on January 4, 2005, the Center appointed the Panel consisting of Ms. Sally M. Abel, and Prof. David E. Sorkin, as Panelists; and Mr. Peter L. Michaelson, as Presiding Panelist, each of whom had previously accepted and returned, by facsimile to the Center and in accordance with Rule 7, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted.

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 January 18, 2005.

Owing principally to time conflicts of the Presiding Panelist, on January 18, 2005, the Center, at the Panel's request, extended the due date of the Panel's decision to February 1, 2005, so as to afford the Panel with sufficient time to thoroughly consider this matter and properly prepare its reasoned decision.

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

The language of this proceeding is English.

4. Factual Background

A copy of the WhoIS registration records for the disputed domain name appears in Annex 1 to the Complaint. As indicated on these records, the Respondent registered that name on March 14, 1998.

A. Complainant's "MESS.COM" Mark

The Complainant owns one United States trademark registration for the mark "MESS.COM", in stylized form and on which this dispute is based, and has provided, in Annex 3, a copy of the registration certificate for that mark. The Complainant has also provided, in this annex, a hard-copy printout of the corresponding record for this mark obtainable through the on-line Trademark Electronic Search System (TESS) provided by the US Patent and Trademark Office (PTO). The salient details for this mark are as follows:

MESS.COM (stylized)
US registration 2,572,201
filed August 29, 2000; registered May 21, 2002

This mark was registered for use in connection with "providing information in the field of entertainment services, namely, art and music via a global computer network" in international class 41 and "computer services, namely, designing, creating and implementing network web pages and web sites for others" in international class 42. This mark claims, for both classes, a first use date of December 10, 1996, and a first use in commerce date of December 10, 1999.

B. The Party's Activities

The Complainant states that it has been operating as “Mess” since 1996, and has been using <mess.net> as its main domain name since November 7, 1997.

On August 29, 2000, the same day on which the Complainant filed its trademark application (serial number 78/023,371) that ultimately issued as the ‘201 registration, the Complainant sent an e-mail to the Respondent inquiring as to whether the Respondent had any interest in selling the domain name. The text of that message is as follows:

“Hello Scott Enterprises,
Would you be willing to sell mess.com? Please let us know how much you would consider selling your domain name for.

Let me know either way if you will sell.

Thanks for your time.

Regards,

Mary Burk
Mess Enterprises
[e-mail address]@mess.net”

On August 30, 2000, the Respondent’s counsel replied to the Complainant’s e-mail and stated that he would present a minimum offer of \$ 25,000 to his client. Counsel’s e-mail specifically stated:

“This site is under development by my client. If you would like to purchase it I could present a minimum offer of \$ 25,000 to my client for consideration.”

A copy of this e-mail chain appears in Annex 5 to the Complaint.

The Complainant filed its 78/023,371 trademark application on an intent-to-use basis (a copy of the entire prosecution file history of that application appears in Annex 3 to the Response). On January 20, 2002, and in response to a Notice of Allowance having been previously issued by the US PTO on November 27, 2001, the Complainant filed its Statement of Use with the PTO. In its Statement, the Complainant alleged a first use date of December 10, 1996 and a first use in commerce date of December 10, 1999, and submitted, as its specimen of use, a single one-page press release dated December 10, 2001. No other specimens, including any that showed use of the mark on either December 10, 1996 or December 10, 1999, were submitted by the Respondent with its Statement of Use.

Ms. Bernadette Abouzakhm, Vice President of the Respondent, stated in her declaration dated December 14, 2004 (a copy of which appears in Annex 6 to the Response):

- (a) the Respondent registered the disputed domain name because “mess” is a common word in the dictionary;
- (b) the Respondent had no knowledge of the Complainant or its mark when it registered that name
- (c) the Respondent did not register that name to sell it to the Complainant or its competitor(s); to disrupt the Complainant’s business; or to prevent the Complainant from registering a domain name reflecting its mark; or to confuse users; and

- (d) the Respondent has used the name to post third-party pay-per-click advertising links in connection with an affiliate agreement with Overture Services, a division of Yahoo (“Overture”). Specifically, the Respondent receives a share of advertising revenue generated by Overture. In addition to general advertising links, there are also links for ads related to maid services and cleaning services which relate to the term “mess.” At one time, the Respondent hosted a link on the <mess.com> web site promoting adult content. However, that content could only be reached if the user first signified his (her) consent by clicking a link on a page that warned of the nature of the adult material. Once the link was clicked, the user was then automatically directed to the content. The adult link has not appeared in connection with the disputed domain name since February or March 2004, and was removed on the Respondent’s own initiative. Lastly, at no time did the Complainant raise any issue as to that link with the Respondent.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to the Complainant’s “MESS.COM” Mark.

The Complainant specifically alleges that the Respondent’s continued use of that domain name will cause confusion to the Complainant’s potential and current customers. In that regard, the Complainant alleges that its customers frequently assume that the Complainant’s website will be located at <mess.com> but are displeased and/or confused when, instead, they reach the Respondent’s web site.

(ii) Rights or Legitimate Interests

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

- (a) Before any notice to the Respondent of the dispute, the Respondent did not use the disputed domain name in connection with a bona fide offering of goods or services.
- (b) The Respondent has not been commonly known by the disputed domain name <mess.com>.
- (c) The Respondent holds the domain name with the intent for commercial gain, misleadingly to divert consumers and/or to tarnish the trademark or service mark at issue. In that regard, the Complainant contends that currently the Respondent only uses the disputed domain name to redirect Internet users to other web sites and particularly one which provides a page of advertisements and various links, and does not use the terms “Mess” or “Mess.com” in any offering of goods or services. Further, the Complainant contends that previously the Respondent used the disputed domain name to address as a pornographic website (and has provided, in Annex 4 to the Complaint, a hard-copy printout of the home page of that site).
- (d) The Respondent does not use the disputed domain name in any part of its business as a professional domain name investor, except to capitalize on

that name to either gain more traffic to other domains or to hold that name hostage in order to sell it to the Complainant or a competitor thereof.

(iii) Registered and Used in Bad Faith

The Complainant contends that, for various reasons, the Respondent registered and is now using the disputed domain name in bad faith.

Specifically, the Complainant first alleges that the disputed domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant, or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name.

In particular, the Complainant contends that the Respondent uses the disputed domain name as a "links" page and passively holds the domain in order to sell it to the Complainant or one of its competitors for a considerable amount of money. In support, the Complainant points to the August 30, 2000 e-mail sent by the Respondent's counsel to the Complainant as evidencing a demand for such a sum.

Second, the Complainant contends that the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's web site or other on-line location, 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.

Furthermore, the Complainant contends that any individuals or business entities that wish to find information about the Complainant's business by navigating to a web site at <mess.com> will not find such information there. Consequently, the Complainant must repeatedly remind its potential and continuing clients and associates that the Complainant cannot be found at <mess.com> but rather at <mess.net>. The ".net" domain extension is not as common or familiar to many Internet users as ".com". Hence, the Respondent's current use of <mess.com> detracts from the Complainant's ability to do business, reach its users and attract new clients.

Lastly, the Complainant states that its first use of the "MESS.COM" Mark was on December 10, 1996. Given that, the Complainant points to the fact that the Respondent registered the disputed domain name on March 14, 1998. Hence, the Complainant implicitly contends that its use of the mark predates the date on which the Respondent registered the name, therefore the Respondent must have registered the disputed domain name with prior knowledge of the Complainant's mark and hence in bad faith.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent argues that the disputed domain name contains nothing more than a common word ("mess") in the English language and hence is free for anyone to register as a domain name.

In particular, the Respondent points to several common definitions of that word including "a disorderly or dirty accumulation, heap, or jumble." (see various definitions provided from the Dictionary.com website, a hard-copy printout of those definitions appears in Annex 8 to the Response). Further, the Respondent points to

substantial third party uses on the Internet of the term “mess”, all of which are unrelated to the Complainant. A search, which the Respondent’s counsel performed on the Google.com web site for the term “mess,” but excluding “mess.net” to avoid any references to the Complainant, yielded over 6.4 million third party web pages containing this common term (a copy of the first page of the results of that search appears in Annex 9 to the Response). Moreover, a search, also performed by that Counsel, of the on-line records of the US PTO (a copy of the results of which appear in Annex 10 to the Response) yielded over 90 active and pending US trademark registrations that incorporate the term “mess”.

The Respondent opines that decisions under the Policy clearly hold that anyone has the right to register a domain name incorporating a common English language word, and the mere registration of such domain name establishes the Respondent’s legitimate interest.

Moreover, the Respondent contends that the Complainant fraudulently prosecuted its 78/023,371 trademark application inasmuch as the Complainant had no proof to support its claim to either the December 10, 1996 or December 10, 1999, first use dates when it knowingly and intentionally alleged those dates of first use to procure registration of the “MESS.COM” Mark. Moreover, the Respondent asserts that the Complainant has never used its “MESS.COM” Mark in commerce, let alone on the Internet where the mark is essentially an Internet address and hence would most likely see actual use.

In support of its assertion, the Respondent’s Counsel performed a search through the Google.com web site for any web pages that contained both the terms “mess.com” and “mess.net”. That search yielded no hits. Counsel then performed a second Google search for both the terms “Mess Enterprises” and “mess.com” which also yielded no hits. Copies of the results of both of these searches appear in Annex 4 to the Response. Furthermore, Counsel states that the Complainant’s web site, a hard-copy printout of which appears in Annex 5 to the Response, does not contain any references to the mark “MESS.COM”. Further, Counsel states that pages of the Complainant’s web site, as far back as November 11, 1998, and archived by and accessible at the Internet “Archive Wayback” Machine (located at <http://archive.org>), also lack any reference to the Complainant’s “MESS.COM” Mark.

Lastly, the Respondent contends that the Complainant knew it had no trademark rights in the term “MESS.COM” when it applied on August 29, 2000 to register that term as its mark given its prior knowledge that the Respondent had registered that term as its domain name on March 14, 1998, some 2 1/2 years earlier.

Hence, the Respondent concludes that the Complainant fraudulently procured its mark.

Therefore, the Respondent asserts that the Complainant does not have any enforceable trademark rights in the term “MESS.COM”, let alone to support a claim under the Policy.

(ii) Rights or Legitimate Interests

The Respondent states that the Complainant has failed to show that the Respondent lacks any legitimate interest in the disputed domain name.

Specifically, the Respondent states that the disputed domain name simply incorporates the common English word “mess.” Hence, on this fact alone, the Respondent has a legitimate interest inasmuch as registration of such a common word, in and of itself,

establishes the Respondent's legitimate interest.

As the panel recently explained in *HP Hood LLC v. Hood.com*, Case No. FA313566 (Nat. Arb. Forum November 9, 2004), where "a disputed domain incorporates a mere common word, the Respondent, ipso facto, has a legitimate interest in the Disputed Domain." See also *Target Brands, Inc. v. Eastwind Group*, Case No. FA267475 (Nat. Arb. Forum July 9, 2004) (where the panel explained that "where a domain name is generic, the first person to register it in good faith is entitled to the domain name and this is considered a legitimate interest); *CRS Technology Corporation v. CondeNet*, Case No. FA 93547 (Nat. Arb. Forum March 28, 2000); *Coming Attractions v. ComingAttractions.com*, FA 94341 (Nat. Arb. Forum May 11, 2000) and *Energy Source Inc. v. Your Energy Source*, Case No. 96364 (Nat. Arb. Forum February 19, 2001). Further, the *Hood.com* panel stated that "[t]he principal that the mere ownership of a common word domain should, in and of itself, establish the owner's rights and legitimate interest has been recognized by several ICANN panels." Referring to the *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* (October 24, 1999), that panel then explained that where the domain name "comprise[s] no more than a single, short, common word — the rights/interests inquiry is more likely to favor the domain name owner".

Based on the results of a search which the Respondent's counsel performed on the Google.com web site, the common word "mess" appears on approximately 6.4 million third party web pages wholly unrelated to the Complainant. Hence, the Respondent concludes that these results clearly show that the Complainant does not have any exclusive rights to that word.

Moreover, the Respondent concedes, that prior to the initiation of this dispute, it used the disputed domain name in connection with pay-per-click advertising links. The Respondent believes that the Complainant is suggesting that such use reflects a lack of rights or legitimate interests in the name because those links included one to an adult web site. In contrast, the Respondent contends that such use constitutes a bona fide offering of goods and services inasmuch as the online publication of pornographic material, while not illegal, is as bona fide an offering of services as any other. Further, the Respondent stated that it has since removed that link on its own initiative and no such link has appeared on its web site since February or March 2004. Moreover, the Respondent notes that at no time did the Complainant contact the Respondent over the Respondent's adult link.

(iii) Registered and Used in Bad Faith

The Respondent contends that it did not register or use the disputed domain name in bad faith.

First, the Respondent states that the date it registered the disputed domain name predates, by more than two years, the filing date of the Complainant's 78/023,371 application as well as the earliest date, December 10, 1999, on which the Complainant actually used its mark in interstate commerce. Furthermore, while the Complainant alleges a first use date of December 10, 1996, it is highly doubtful, given that the Complainant proffered no corresponding evidence, that the Complainant can support this date and hence claim of any trademark rights that predated the date on which the Respondent registered the disputed domain name.

Moreover, to prove bad faith registration under the Policy, it must be proven that a domain name was registered with a complainant's trademark in mind. Since the

Complainant here failed to demonstrate that the Respondent had any prior knowledge of the Complainant's mark "MESS.COM" or the Complainant's business operations in 1998, then the Respondent clearly did not register the name in bad faith. Further, since the Complainant filed its application to register its mark after the Respondent registered the disputed domain name, the Respondent could not have had any constructive notice of that mark when it registered the name.

As to the other allegations of bad faith, the Complainant has simply failed to provide any supporting evidence; hence, all those allegations must fail as well.

(iv) Reverse Domain Name Hijacking

The Respondent contends, and so requests the Panel to find, that the Complainant is guilty of reverse domain name hijacking.

Specifically, the Respondent views the Complainant's acts as a "nefarious scheme to plunder the Disputed Domain in order to upgrade Complainant's Mess.net URL to a 'dot com'."

In support of its view, the Respondent points to the following factors:

- (a) the Complainant does not appear to have made any genuine use of its "MESS.COM" Mark anywhere in commerce (whether on its web site or elsewhere), let alone prior to December 10, 2001; and
- (b) the Complainant sent its August 29, 2000 e-mail to the Respondent inquiring about purchasing the disputed domain name on the very same day that the Complainant filed its 78/023,371 trademark application to register that mark -- a mark that was identical to the name.

Hence, the lack of such early trademark use not only casts doubt on the Complainant's trademark rights but also renders it impossible for the Respondent to have registered or even used the disputed domain name with any foreknowledge of the Complainant's "MESS.COM" Mark.

Inasmuch as the Complainant knew that its earliest trademark rights (those constructively established by its August 29, 2000 filing date) were junior by at least 2 1/2 years to the date (March 14, 1998) on which the Respondent registered the domain name and, in spite of that knowledge, still filed its Complaint, the Panel should hold the Complainant guilty of reverse domain name hijacking.

6. Discussion and Findings

A. Identical or Confusingly Similar/ Rights or Legitimate Interests

In light of the Panel's finding below that the Respondent did not exhibit bad faith in registering its domain name, all issues regarding whether: (a) the domain name is either identical or confusingly similar to the Complainant's "MESS.COM" Mark, or (b) the Respondent has rights or legitimate interests in that name are now moot. Hence, the Panel will dispense with considering them any further.

B. Registered and Used in Bad Faith

The Panel finds that Respondent did not register the disputed domain name in bad faith

under paragraph 4(a)(iii) of the Policy.

Specifically, in light of the record before it, the Panel views the sequence of events that seems most plausible to it as being that the Respondent registered the disputed domain name before either the Complainant starting using its mark, whether in commerce or otherwise, or filed its 78/023,371 application to federally register that mark.

Hence, any scenario under that the Respondent actually had or could have had any prior knowledge of the Complainant's mark at the time it registered the disputed domain name would have been simply impossible.

Therefore, in the absence of having any such knowledge, the Respondent's registration clearly seems to have been made in good faith.

Hence, the Complainant has failed to meet its burden under paragraph 4(a) of the Policy.

C. Reverse Domain Name Hijacking

This case exhibits one of the most egregious examples of reverse domain name hijacking that any of the Panelists has thus far ever seen.

Here, the Complainant filed its 78/023,371 trademark application, on an intent-to-use basis, on August 20, 2000. This date was some 2 1/2 years after the Respondent registered the domain name on March 14, 1998, and with clear knowledge of the Respondent's prior registration (see e-mail from Complainant to Respondent dated August 20, 2000 - that date certainly being no mere coincidence with the exact same filing date of the Complainant's trademark application). While the Complainant claimed a first use date of December 10, 1996, for its class 41 services, the record, including the prosecution file history for the Complainant's "MESS.COM" Mark, is utterly devoid of any proof of use on that date. In fact, the only evidence of use which the Complainant has submitted is a December 10, 2001 press release. The Complainant also alleges a December 10, 1999 first use date for its class 42 services. This date too is after the date on which the Respondent registered the disputed domain name.

Accordingly, this Panel finds that the Complainant had no trademark rights at the time the Respondent registered the domain name, and knew it and, in spite of that knowledge, then proceeded to intentionally secure a trademark registration with an express purpose of fraudulently invoking the Policy as a means to wrest the disputed domain name from the Respondent, by an order of transfer from an administrative panel, if the Respondent's sales price was too high (which at \$25,000 it evidently was). To the Panel, this conduct constitutes a clear abuse of the Policy.

Hence, the Panel finds that the Complainant committed reverse domain name hijacking.

7. Decision

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby denied.

Peter L. Michaelson
Presiding Panelist

Sally M. Abel
Panelist

David E. Sorkin
Panelist

Dated: January 25, 2004