



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**NetWizards, Inc. v. Spectrum Enterprises**

**Case No. D2000-1768**

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

The Complainant is NetWizards, Inc., 90 South Spruce Avenue, Suite S, South San Francisco, California 94080, USA.

The Respondent is Spectrum Enterprises 233 West Loretta Ave., St. Louis, Missouri 63125 USA.

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

Contested Domain Name: “netwizard.net”

The Registrar is Network Solutions, Inc. (NSI), 505 Huntmar Drive, Herndon, Virginia 20170, USA.

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“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 (“Rules”) as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (“Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) by e-mail on December 19, 2000, and in hard copy, with Annexes A-E, as well as the appropriate payment on December 21, 2000. The Complainant's attorneys, stated that on December 19, 2000, they served a copy of the Complaint on the Respondent, by mail and email; and, on the same date, also provided a copy of the Complaint to the Registrar, NSI.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on December 21, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to the contested domain name; specifically, contact and registrant information for that domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of that domain name. On December 27, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the Policy is in effect (through Network Solutions' version 5.0 registration agreement) for the contested domain name, and that the contested domain name was then in an "active" status.

On December 28, 2000, 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, both in email and hard copy form, to the Respondent.

Hence, the notification to the Respondent having occurred on December 28, 2000, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

The Respondent was then provided with a 20-calendar day period, expiring on January 17, 2001, to file its response with the Center and serve a copy of the response on the Complainant.

As of January 17, 2001, the Center had not received any response to the Complaint from the Respondent; hence, the Center, in an email letter dated January 23, 2001, notified the Complainant and Respondent of the default of the Respondent. The file contains a copy of the transmission report for this email communication, again with no indication that this communication was not delivered to the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on February 16, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. 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 e-mail letter dated February 21, 2001, notified the parties of the appointment of Mr. Michaelson as the panelist.

Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before March 7, 2001. The Panel did so.

During the course of reviewing the decision from the Panel in conjunction with the case file, the Center, on March 13, 2001, informed the Panel of a possible defect in service of the Complaint. Specifically, the Center, in consultation with the Panel, concluded that it could not determine whether, on December 28, 2000, a complete hard copy of

the Complaint, including all the annexes, was forwarded to the Respondent. The case file contained a copy of an email, along with its transmission record, dated December 28, 2000, from the Center, which provided a soft copy of both the Complaint (without its annexes) and the Notification of Complaint. The case file did not contain a copy of a courier air bill or postal receipt evidencing shipment to the Respondent of the hard copy of the Complaint and its Notification. Accordingly, to remedy this possible defect, the Panel withdrew its prior decision and through issuance of Procedural Order No. 1 dated March 14, 2001, directed the Center to, inter alia: (a) re-serve the Complaint, including all its annexes, on the Respondent using all measures delineated in paragraph 2(a) of the Rules, and (b) re-start the response period commensurate with the date on which the Complaint was re-served. As directed, the Center re-served the Complaint on March 15, 2001, and re-started the 20-calendar day response period on that date. The new response period then expired on April 3, 2001. In accordance with this procedural order, the Panel was to have issued its revised decision on or before April 10, 2001, to the Center.

With the Complaint having been re-served, the Panel concludes that all documents, including the Complaint and its accompanying annexes, and all subsequent communications associated therewith have been properly served on the Respondent and handled as required under the Rules, particularly paragraphs 2(a), 2(b) and 4(a) thereof, and the Supplemental Rules.

After the Complaint was re-served, the Respondent, through an e-mail dated March 19, 2001, to the Center, informally submitted various comments to the Center. The Center, in a subsequent email of the same date to the Respondent, viewed these comments as constituting an “unofficial” response. Later on the same date, the Complainant, through its counsel, requested, via an email to the Center, that the Complainant be allowed to amend its Complaint to respond to those comments by setting forth additional allegations.

The Panel reviewed the “unofficial” response and the nature of the allegations, as noted in the email message of March 19, 2001, from the Complainant's counsel, which the Complainant intended to add to its Complaint. As set forth in Procedural Order No. 2 dated March 23, 2001, the Panel, under paragraphs 10(a) and 12 of the Rules, concluded that those allegations would simply be cumulative to those already made of record and that it needed no further statements from the Complainant, and consequently denied the request to amend the Complaint.

Inasmuch as the Center has received no further communications from the Respondent by the close of the re-started response period of April 3, 2001, the Center, in an e-mail and an accompanying e-mail letter both dated April 4, 2001, acknowledged to the parties and the Panel, that the Response constituted all the correspondence submitted to the Center since the start of the re-started response period.

This dispute concerns one domain name, specifically “netwizard.net”.

The language of this proceeding is English.

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

Inasmuch as the Respondent, Spectrum Enterprises, has failed to provide a response, which rebuts the factual representations alleged by the Complainant, NetWizards, Inc., said representations shall be accepted as undisputed. For convenience of the reader, factual allegations from the Complaint are reproduced below.

A copy of the WHOIS registration record for the contested domain name appears in Annex A to the Complaint. As indicated on that record, the Respondent registered the contested domain name with NSI on February 24, 1998.

The Complainant currently owns the following valid and subsisting U.S. trademark registration on which this dispute is based. The Complainant has provided a copy of this registration, as issued by the United States Patent and Trademark Office (PTO), in Annex B to the Complaint.

NET WIZARDS (block letters)

US registration 2,369,904; registered July 25, 2000

This trademark was registered, for use in connection with: “Telecommunication services, namely switched networking and global computer network access services”, in international class 42. This mark claims first use and first use in inter-state commerce of August 1, 1995.

The Complainant is an Internet service provider, domain name registrar and web page designer. The Complainant states that it has been using its mark “NET WIZARDS” for providing Internet services, domain name registration and professional web page design services since at least as early as 1995. The Complainant also owns the domain names “netwizards.com” and “netwizards.net”, registered on February 5, 1997, and October 26, 1995, respectively. A copy of the WHOIS registration records for these two domain names appears as Annex C to the Complaint.

The Complainant states that since 1995, it has been in the business of offering a full range of Internet services, including web site design services, DSL (Digital Subscriber Lines), domain name registration, e-commerce solutions and dial-up Internet access.

The Complainant states that its mark and domain names have been and are recognized by the public and the industry as originating from a single source, namely the Complainant, and serve to distinguish the Complainant’s services from the services of others.

The Complainant states that, through its significant efforts, skills and experience, it has acquired and enjoys substantial goodwill and a valuable reputation in conjunction with its mark. In that regard, the Complainant states that its maintenance of high standards of quality and excellence for its services has contributed to its valuable goodwill and reputation.

Further, the Complainant states that it has expended and continues to expend a significant amount of time and money to advertise and promote its services through its mark NET WIZARDS.

Upon visiting the Respondent's web site at "www.netwizard.net", the Complainant found that site to be a technical pointer to the web site "www.bestnet.net" for Bestnet, Inc. Bestnet, Inc. is owned by Hyson International Company. A printout of the home page for the Bestnet, Inc. corporate website, i.e. accessible at "www.bestnet.net", describes its products and services. A copy of that home page appears in Annex D to the Complaint. Hyson International Company owns the domain name "bestnet.net". A copy of the WHOIS information for the domain name "bestnet.net" is attached hereto as Exhibit E.

As indicated on its home page, Bestnet, Inc. appears to offer e-commerce solutions, web site design, programming and hosting and Internet access. These services appear to be identical or very similar to, i.e. competitive with those that the Complainant offers under its mark NET WIZARDS.

The contested domain name was registered more than one year after the Complainant registered its domain name "netwizards.com" and two and a half years after the Complainant both began using its now registered mark "NET WIZARDS" and registered its domain name "netwizards.net".

## **5. Parties' Contentions**

### **A. Complainant**

#### **i. Similarity**

The Complainant takes the position that the contested domain name is identical or confusingly similar to its registered mark as to likely confuse Internet users who may believe they are doing business with the Complainant or with an entity whose services are endorsed by, sponsored by, or affiliated with the Complainant; hence, satisfying the confusing similarity requirement in paragraph 4(a)(iii) of the Policy.

In that regard, the Complainant asserts that the contested domain name, "netwizard.net", is a singular form of the Complainant's registered mark NET WIZARDS and is used in the same industry as Complainant uses its registered mark. By virtue of its registered mark, the Complainant has exclusivity to use the mark NET WIZARDS in connection with the services set forth in its US registration.

#### **ii. Legitimacy**

The Complainant contends that the Respondent has no rights or legitimate interests in the contested domain name.

Specifically, the Complainant contends that, rather than using the contested domain name for its own business purposes, the Respondent instead uses that name solely as a technical pointer (i.e. a link that simply redirects Internet users) to a web site that provides service offerings that directly compete with those offered by the Complainant. In view of using the contested domain name solely to implement such redirection, the Complainant implicitly contends that the Respondent does not conduct any legitimate bona fide commercial or non-commercial business activity under

the contested domain name, without any intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Further, the Complainant notes that Bestnet, Inc. already owns the domain name "bestnet.net" which it uses as an address of its web site (also being the site to which re-direction, through the contested domain name, occurs). A copy of the registration record for this domain name appears in Annex E to the Complaint. As a result of owning and using that particular domain name, the Complainant contends that Bestnet, Inc. is not commonly known by the contested domain name.

Accordingly, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the contested domain name pursuant to paragraph 4(a)(ii) of the Policy.

### **iii. Bad Faith**

The Complainant contends that the Respondent has registered and is now using the contested domain name in bad faith.

In that regard, the Complainant contends that the Respondent's registration and continued use of the contested domain name for the purpose of re-directing Internet users intent on visiting the Complainant's web site to a web site that describes service offerings directly competitive with those of the Complainant constitutes bad faith registration and use.

Specifically, the Complainant contends that the Respondent intentionally choose, as the contested domain name, a domain name which so closely resembles the Complainant's registered mark which, when coupled with re-direction of those users to the Bestnet, Inc. web site, would cause and is now causing a likelihood of user confusion regarding source, sponsorship, affiliation, or endorsement of those services offered on the Bestnet, Inc. site vis-à-vis those services being offered under the Complainant's domain names and its registered mark; hence, violating paragraph 4(b)(iv) of the Policy.

Furthermore, the Complainant notes that Bestnet, Inc. already owns the domain name "bestnet.net" through which it is commonly known. However, not only is the Bestnet, Inc. web site accessed through this domain name but also this very same site, having service offerings being directly competitive with those of the Complainant, is reached as a result of the Respondent's re-direction through use of the contested domain name; hence, constituting further evidence of bad faith use of the contested domain name in contravention of paragraph 4(a)(iii) of the Policy.

Therefore, the Complainant concludes that the Respondent's conduct in registering and using the contested domain name constitutes bad faith registration and use under paragraph 4(a) of the Policy.

## B. Respondent

The Respondent has not filed any substantive response to the specific allegations raised in the Complaint.

## 6. Discussion and Findings

### i. Similarity

The Panel finds that confusion would likely arise as a result of the Respondent's current use of the contested domain name in connection with re-directing Internet users to a site that offers services that directly compete with those currently offered by the Complainant.

The only differences between the contested domain name, “netwizard.net”, and the Complainant's mark NET WIZARDS are that the former is the singular form of the latter and also includes “.net” as a top-level domain. Both of these differences are so de minimus and immaterial as to be inadequate to preclude any confusion from occurring. For all practical purposes, the domain name in question is identical to the Complainant's NET WIZARDS mark. See, e.g., MSNBC Cable, LLC v. Tvsys.com D2000-1204 (WIPO December 8, 2000), Wine.com, Inc. v. Zvieli Fisher D2000-0614 (WIPO September 11, 2000), and Lana Marks, Ltd., Inc. v. SYP Web D2000-0304 (WIPO June 23, 2000).

Such confusion would undoubtedly cause those users intending to access the Complainant's website, but who reach, through re-direction invoked by entry of the contested domain name, the Bestnet, Inc. web site, to think that an affiliation of some sort exists between the Complainant and Bestnet, Inc., when, in fact, no such relationship exists at all. See, e.g., Dollar Financial Group, Inc. v VOM NET FA 96101 (Nat. Arb. Forum January 25, 2000); eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd. D2000-1463 (WIPO January 10, 2001); Treeforms, Inc. v. Cayne Industrial 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 “netwizard.net” sufficiently resembles the Complainant's registered mark as to cause confusion.

Accordingly, the Panel also finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy for the contested domain name “netwizard.net”.

### ii. Illegitimacy

Based on its federal trademark registrations, the Complainant has acquired exclusive rights to use its NET WIZARDS mark. Furthermore, by virtue of the registration of this mark, the US PTO has implicitly recognized that this mark has acquired appropriate secondary meaning in the marketplace.

The Respondent has not proven any basis that would legitimize any claim it has to the contested domain name. In fact, the Panel believes that, under the present facts, it is extremely unlikely that the Respondent can even make such a claim.

As noted above, the contested domain name is, for all practical purposes, identical to the Complainant's mark NET WIZARDS under which the Complainant provides its services. As indicated in Annex D, the contested domain name does not resolve to a home page that utilizes the mark NET WIZARDS or offers any products or services under that mark. The Respondent uses the contested domain name simply to re-direct Internet users to the web site of Bestnet, Inc. which is a direct competitor of the Complainant.

In the Panel's mind, use of the contested domain name as an instrumentality for re-directing Internet users, who as a result of inadvertently and slightly misspelling the domain name of the Complainant, here from either "netwizards.com" or "netwizards.net" to the contested domain name "netwizard.net", away from the Complainant's web site to a commercial web site of its direct competitor clearly does not constitute legitimate use.

In that regard, such use, at its core, generates commercial gain for the Respondent and/or its associate and third-party beneficiary, Bestnet, Inc., by intentionally and misleadingly diverting users (both customers and potential customers) away from patronizing the Complainant's site to patronizing the Bestnet, Inc. web site. Confusion is likely to result from a consumer perception of an apparent relationship, affiliation or connection between the Complainant and the Respondent and/or Bestnet, Inc. when in fact no such relationship, affiliation or connection exists. This, in turn, clearly tarnishes the Complainant's mark. Such use, while commercial in nature, is certainly not bona fide within the meaning of paragraph 4(c)(i) of the Policy and hence is illegitimate. See, e.g., Hollywood Casino Corporation v. Go Call Inc. FA 95741 (Nat. Arb. Forum October 30, 2000), Marriott International, Inc. v. Vladimir Kyznetsov FA 95648 (Nat. Arb. Forum October 24, 2000), Bank of America Corporation v. Micah Abrams FA 95479 (Nat. Arb. Forum October 11, 2000), ESPN, Inc. v. Danny Ballerini FA 95410 (Nat. Arb. Forum September 15, 2000), and Anne of Green Gables Licensing Authority, Inc. v. Internetworks AF-00109 (eResolution June 12, 2000).

Furthermore, given a lack of any substantive response from the Respondent and pursuant to paragraph 14(b) of the Rules, the Panel infers that the Complainant has never authorized either the Respondent or its associate, Bestnet, Inc., to utilize the mark NET WIZARDS in any manner, nor does the Complainant appear to have any relationship, affiliation or association whatsoever with the Respondent or Bestnet, Inc. Hence, any use to which either the Respondent or Bestnet, Inc. were to put of the term NET WIZARD, in connection with services identical or similar to those with which the Complainant is using its mark, would directly violate the exclusive trademark rights now residing in the Complainant -- rights which began accruing to the Complainant some 2 1/2 years prior to the date on which the contested domain name was registered. As such, neither the Respondent nor its associate, Bestnet, Inc. is now commonly known by the mark NET WIZARD. Thus, their continued use of the contested domain name violates paragraph 4(c)(ii) of the Policy. See, e.g., Cabletron Systems, Inc. v. DSL Enterprises D2000-0571 (WIPO August 18, 2000).

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 legitimate interests in the contested domain name, whether on a commercial or non-commercial basis.

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.

### iii. **Bad Faith**

The Panel is easily persuaded that the Respondent's registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant's web site to the web site of Bestnet, Inc., a company which directly competes with the Complainant, constitutes bad faith registration and use.

In that regard, the Panel, again pursuant to Rule 14(b), infers from the lack of any substantive response, that the Respondent intentionally choose the contested domain name for its close, nearly identical, resemblance to the Complainant's mark. Moreover, the Panel also infers, though the record before the Panel is silent, that the Respondent is either financially affiliated with the Bestnet, Inc. in some capacity or receives some form of compensation from Bestnet, Inc. for every user that is re-directed, through the Respondent's site (which provides the actual re-direction), to the Bestnet, Inc. web site. Otherwise, if this was not the case, then one could readily ask why would the Respondent undertake such redirection. Given the lack of any substantive response here, the Panel believes there is no other reason.

Other panels have found that registration and use of a domain name to re-direct Internet users to web sites of competing organizations constituted bad faith use and registration. In that regard, see, e.g., Cisco Systems, Inc. v. Mike Haag AF-0585a-b (eResolution December 29, 2000), Zwack Unicum Rt. v. Erica J. Duna D2000-0037 (WIPO March 10, 2000), Oly Holigan, L.P. v. Private FA 95940 (Nat. Arb. Forum December 4, 2000), and, as cited infra, the Hollywood Casino Corp., Marriott International, Inc., Bank of America Corp., ESPN, Inc. and Anne of Green Gables Licensing Authority, Inc. decisions. The Panel sees no reason in the present case to diverge from the reasoning in these decisions and every reason to abide by it.

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)(iv) of the Policy.

In this connection the Panel notes that in its opinion, the Respondent's actions in registering and now retaining the contested domain name also evince bad faith in violation of the Anti-Cybersquatting provisions of the US Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

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

**7. Decision**

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

The contested domain name, specifically “netwizard.net”, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: April 4, 2001