



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless**

**Case No. D2002-0605**

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

The Complainant is AT&T Corp., a corporation of the State of New York, United States of America, having a principal place of business at 32 Avenue of the Americas, New York, New York 10013, United States of America.

The Respondent is Roman Abreu d/b/a Smartalk Wireless located at 560 Melrose Avenue, Bronx, New York 10455, United States of America.

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

The Contested Domain Name is <smartalkwireless.com>.

The Registrar is Register.com located at 575 8th Avenue, 11th Floor, New York, New York 10018, United States of America.

#### **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 ICANN 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 July 3, 2002, and in hard-copy form on June 28, 2002 along with Annexes 1-9 and the appropriate payment.

The Complainant's attorney stated that, on June 24, 2002, he served a copy of the Complaint itself together with a copy of the cover sheet, on the Respondent and the Registrar by postal mail, and on the Registrar by email.

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 person 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 June 28, 2002, the Center requested confirmation from the Registrar 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 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 contested domain name, (b) the current status of that domain name, and (c) 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.

Subsequently, on July 3, 2002, the Registrar provided its response to the Center through which the Registrar provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that Register.com is the registrar of that name, stated that the language of the registration agreement is English, and stated that the domain name was then in an "active" status. The Registrar also informed the Center that the Respondent, through its registration agreement, submitted to the jurisdiction at the location of the principal office of the Registrar and also at location of the residence of the domain name holder for court adjudication of disputes concerning or arising from the use of the domain name. The Registrar also informed the Center that, as of July 3, 2002, it had not received a copy of the Complaint from the Complainant.

Also, on July 3, 2002, the Center notified the Complainant that the Center had not received an electronic version of the Complaint and cover sheet, along with any annexes then available in electronic form. Later that day, the Complainant forwarded a copy of the Complaint in electronic form to the Center by email attachment.

On July 5, 2002, 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 (with the latter method forwarding a copy of all the annexes as well). In addition, the Center forwarded a copy, without annexes, of the Complaint by email and in hard-copy form, with 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 July 5, 2002, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint 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 July 25, 2002 to file its Response with the Center and serve a copy of the Response on the Complainant.

As of July 25, 2002, the Center had not received a substantive response to the Complaint from the Respondent; hence, the Center, in an email letter dated July 29, 2002, notified the Complainant and the Respondent of the Respondent's default.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated August 27, 2002, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. Later that day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated August 28, 2002, notified the parties of the appointment of Mr. Michaelson as sole panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before September 11, 2002.

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

The language of this proceeding is English.

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

A copy of the WHOIS registration record for the contested domain name appears in Annex 1 to the Complaint. As indicated on this record, the Respondent registered this name with the Registrar on October 18, 2000.

##### **A. SMARTALK Marks**

The Complainant filed two applications with the United States Patent and Trademark Office (PTO) to register the mark "SMARTALK". Copies of the records for these marks, as publicly available on the web-accessible Trademark Electronic Search System (TESS) from the PTO, are provided in hard-copy form in Annex 5 to the Complaint. Both applications are still pending, with the details and status of each as follows.

- a) SMARTALK (stylized)  
US application serial no.: 75/535,830; filed: August 13, 1998

This mark was filed for use in connection with: "Pre-paid transaction based telecommunication services, namely telephone communication, radio communication, electronic mail services, personal communication services, cellular communication services" in international class 38. This mark claims first use and first use in inter-state commerce of April 30, 1998. The Panel takes judicial notice from TESS that this mark has been published for opposition by the PTO on August 6, 2002.

- b) SMARTALK (stylized)

This mark was filed for use in connection with: "Pre-paid telephone cards not magnetically encoded" in international class 16. This mark also claims first use and first use in inter-state commerce of April 30, 1998. The Panel takes judicial notice from TESS that this mark has been published for opposition by the PTO on August 13, 2002.

**B. The Parties' Activities**

The Complainant states that it is one of the largest and best known telecommunications companies in the world, providing a myriad of telecommunications products and services. The Complainant holds the exclusive right to use the SMARTALK Marks in the United States in connection with numerous telecommunications products and services by virtue of its acquisition of Smarttalk Teleservices, Inc. of Boulder, Colorado ("Smarttalk") and its exclusive license with Smarttalk. In that regard, the Complainant states that it recently assigned both applications to its licensor, SmartTalk, but remains as an exclusive licensee of these marks for the goods and services listed in the applications. To corroborate this, the Complainant has provided, in Annex 4 to the Complaint, a copy of a declaration of Mr. Mark Nass, Chief Executive Officer of SmartTalk, through which Mr. Nass declares that Smarttalk is currently the exclusive owner of the SMARTALK Marks and the Complainant is the exclusive US licensee of these marks. Further, through that declaration, Mr. Nass declares that Smarttalk has never licensed or otherwise assigned any right in either of these marks to the Respondent.

The Complainant states that it and its predecessor-in-interest, Smarttalk, have continuously used the SMARTALK Marks in connection with telecommunications products and services since at least as early as 1995.

The Complainant further states that it has invested and continues to invest substantial amounts on advertising and promoting the SMARTALK Marks. Further, the Complainant notes that by virtue of its extensive use, advertising and promotion of the SMARTALK Marks, these marks have achieved a significant degree of consumer recognition, and serve as an exclusive designation of origin of the Complainant for its telecommunications products and services, and as a symbol of the goodwill and excellent reputation represented by the Complainant.

In addition, the Complainant and its predecessor in interest have been the registrant of the domain name <smarttalk.com> since May 9, 1997 (a copy of the WhoIs record for that domain name appears in Annex 6 to the Complaint).

On October 18, 2000, the Respondent registered the contested domain name.

The Respondent currently uses the contested domain name as an address of its website <www.smarttalk.com> through which it offers Internet users telecommunications products and services competitive with those provided by the Complainant. A hard-copy printout of the home page of the Respondent's site appears in Annex 7 to the Complaint.

By letter dated September 24, 2001 (a copy of which appears in Annex 8 to the Complaint), the Complainant's counsel formally notified the Respondent of the Complainant's exclusive rights in the SMARTALK Marks, protested the Respondent's unauthorized use of the term SMARTALK in the contested domain name and

demanded that the Respondent cease such use immediately and transfer that domain name to the Complainant.

The Respondent's counsel responded by letter dated October 9, 2001. Shortly thereafter, the Complainant's counsel attempted to negotiate a settlement of the matter with the Respondent's counsel; however, a settlement was never reached.

During or about October/November 2001, the Respondent ceased use of the contested domain name. Specifically, see search result print-outs that appear in Annex 9 to the Complaint which show non-use of contested domain name in December 2001 and January 2002.

In a January 8, 2002 telephone conversation, the Respondent's counsel advised the Complainant's counsel that the chances of settlement were good and that the Respondent would probably be willing to abandon the contested domain name. Thereafter, the Respondent's counsel failed to return telephone calls from the Complainant's counsel.

Thereafter, the Respondent did not use the contested domain name for several months. However, in May of 2002, the Complainant discovered that the Respondent was again using the contested domain name for the same website through which the Respondent was then offering competitive telecommunications products and services to those offered by the Complainant.

## **5. Parties' Contentions**

### **A. Complainant**

#### **i. Similarity**

The Complainant contends that the contested domain name is identical or confusingly similar to the Complainant's "SMARTALK" Marks.

Specifically, the Complainant takes the position that numerous panel decisions have consistently held that the coupling of a generic or descriptive term with a trademark to form a domain name does not distinguish the domain name from the trademark.

For example, in *Altavista Company v. Brunosousa, aka Bruno Sousa*, WIPO Case No. D2002-0109 (April 3, 2002), the panel held, in a case involving <altavistasoftware.com>, that "the addition of a descriptive term [software] to a famous trademark [altavista] does little to alter the inherent trademark nature of the term" and held that the resulting domain name was "extremely similar" to the mark." Further, the panel found that the resulting domain name was confusingly similar to ALTAVISTA, particularly given the complainant's close association with software.

Hence, the Complainant argues that the disputed domain name <smartalkwireless.com> is confusingly similar to the Complainant's SMARTALK Marks, particularly given the Complainant's close association with wireless telecommunications services.

Furthermore, the Complainant points to *AT&T Corp. v. CME Inc.*, WIPO Case No. D2001-1060 (October 17, 2001), a case involving the domain name <attbusinessinternetservices.com> where the panel there held that the addition of descriptive terms to a trademark does not create new rights in the registrant thereof:

"By adding the terms "business internet services" following 'AT&T', Respondent does not create a new or different mark in which it has rights or legitimate interests, nor does it alter the underlying mark held by Complainant....

'[B]usiness internet services' are common descriptive terms that refer to a type of services that a telecommunications services provider would offer on the Internet. When these terms are used with Complainant's 'AT&T' mark in a domain name and Internet address, consumers and Internet users are likely to assume that Complainant is associated with the identified website and/or goods or services offered on that website."

In the present case, the Complainant contends that the term "wireless" is a common descriptive term that refers to a "type of services that a telecommunications services provider would offer on the Internet."

Accordingly, given the fame of the Complainant and its SMARTALK Marks for telecommunications services, the Complainant contends that Internet users are likely to believe that a domain name incorporating the Complainant mark SMARTALK and the descriptive term "wireless" is owned, sponsored or in some way related to the Complainant -- when in fact it is not. Accordingly, the addition of the term "wireless" fails to distinguish the domain name from the Complainant's marks.

Therefore, the Complainant concludes that it has met the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

## **ii. Legitimacy**

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

First, the Complainant contends that the Respondent has not used or prepared to use the contested domain name in connection with any bona fide offering of goods or services, as contemplated under Paragraph 4(c)(i) of the Policy.

Moreover, the Respondent can not legitimately use that name in connection with any bona fide offering in the telecommunications field inasmuch as the Complainant and its licensor, SmartTalk, hold the exclusive rights to use the SMARTALK Marks in the United States for telecommunications products and services and neither has licensed nor authorized the Respondent to use either of those marks in any way (as is evident from the Nass declaration in Annex 4 to the Complaint). Hence, the Complainant contends that the Respondent is attempting to gain credibility, attract consumers and trade off of the Complainant's reputation by falsely representing itself as an authorized affiliate of the Complainant through the use of the mark SMARTALK in the contested domain name.

Second, the Complainant alleges that the Respondent is not commonly known by the disputed domain name, as contemplated under Paragraph 4(c)(ii) of the Policy.

In that regard, the Complainant states that: (a) there is no evidence that the Respondent is known commonly by the name "Smartalkwireless" and (b) the Respondent does not appear to have registered a corporate or other trade name containing the term. Furthermore, the Complainant states that, since neither it nor SmartTalk has authorized the Respondent to use either of the SMARTALK Marks, any such use would infringe the Complainant's rights in those marks.

Lastly, the Complainant avers that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue, as contemplated under Paragraph 4(c)(iii) of the Policy. Specifically, the Complainant points to the Respondent's use of the disputed domain name to create consumer confusion through which Internet users, specifically potential customers of the Complainant's services, will be diverted from the Complainant's website to that of Respondent for the Respondent's own commercial gain.

Thus, the Complainant concludes that the Respondent has no 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, also for various reasons, the Respondent has registered and is now using the contested domain name in bad faith.

As to bad faith registration, the Complainant contends that "Of all the innumerable marks Respondent could have selected for its website offering telecommunications products and services, Respondent selected a mark already in use by AT&T for telecommunications products and services. Respondent's clear intent was to attain instant legitimacy for its website by falsely associating itself with AT&T."

As to bad faith use, the Complainant contends that the Respondent's use of the term SMARTALK in the contested domain name for a website offering telecommunications products and services -- offerings which directly compete with those provided by the Complainant -- is likely to confuse Internet users into believing that the Respondent is affiliated with, sponsored, endorsed or licensed by the Complainant, when in fact no such affiliation, sponsorship, endorsement or relationship exists. By virtue of the ensuing confusion, the Respondent intentionally diverts those users from the Complainant's website to the Respondent's site for the latter's own commercial gain.

The Complainant contends that bad faith use is also shown by the Respondent's refusal to cease its infringing acts after the Complainant gave notice to the Respondent of the Complainant's rights in the SMARTALK Marks. In that regard, the Complainant points to the Respondent's actions of having resumed use of the disputed domain name, subsequent to its having received that notice and having conducted settlement discussions with the Complainant, as an address of the Respondent's website through which the Respondent then offered products and services competitive with those then offered by the Complainant under its SMARTALK Marks.

Therefore, the Complainant concludes that the Respondent's conduct constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence,

under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

**i. Similarity**

Even though the Complainant's SMARTALK Marks have not yet been registered by the PTO, the Complainant owns common law rights in those marks since 1995 in connection with the product and services with which those marks were used, namely telecommunications services. This use predates the Respondent's registration of the disputed domain name in October 2000 by some five years. The Policy clearly recognizes and protects these common law rights.

Regarding any distinction in coverage between registered and unregistered marks, paragraph 4(a) of the Policy simply recites: "You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that ... (i) your domain name is identical or confusingly similar to a *trademark or service mark in which the complainant has rights*" [emphasis added]. Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce *any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.*" [emphasis added].

Numerous panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, FA 95560 (Nat. Arb. Forum, November 2, 2000) held: "ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy". See, e.g., *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Mike Larson*, FA 95746 (Nat. Arb. Forum, November 15, 2000); *CMG Worldwide Inc. v. Naughtya Page*, FA 95641 (Nat. Arb. Forum, November 8, 2000); *Home Properties v. SMSOnline*, FA 95639 (Nat. Arb. Forum, November 2, 2000); and *Bridal Rings Company v. Yemenian*, FA 95608 (Nat. Arb. Forum, October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, FA 95757 (Nat. Arb. Forum, November 27, 2000) held: "The UDRP does not discriminate between registered and unregistered marks." In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, AF-0536,

(eResolution, December 11, 2000), the panel recognized: "It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark." In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, FA 95970 (Nat. Arb. Forum, December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum, November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and 2000-0015 (March 11, 2000).

The Panel finds that confusion unquestionably and inevitably arises -- and in fact is so intended -- as a result of the Respondent's use of the contested domain name as an address of its website. Further, the Panel can conceive of no situation where confusion would not likely arise when and if any third-party not affiliated with the Complainant, to which the Respondent were to transfer the contested domain name, were to use that name with a website offering telecommunications services identical and/or similar to that provided by the Complainant under its SMARTALK Marks.

There can be no doubt that the Respondent in appending the word "wireless" to the mark SMARTALK to form the contested domain name did so with an intent to cause and opportunistically exploit inevitable user confusion. Otherwise, why would the Respondent have chosen a domain name that verbatim incorporates the Complainant's SMARTALK mark? The Panel can think of no plausible reason.

Such confusion would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website resolvable 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., *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 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).

Further, in the context of telecommunications services, the Panel clearly agrees with the Complainant's assertion that the term "wireless" is a generic term which adds absolutely no distinctive element to the disputed domain name that sufficiently distinguishes that name from the Complainant's SMARTALK Marks to preclude confusion. In fact, the use allegation made by the Complainant indicates that it has been using these Marks in connection with offering cellular, i.e., wireless, services to its customers since April 30, 1998 -- at least two years prior to the October 18, 2000 date on which the Respondent registered the contested domain name. Since this term generically describes the services offered by the Complainant under its marks, concatenation of this

term with the mark "SMARTALK" only exacerbates user confusion rather than ameliorating it.

In view of the Complainant's substantial and widespread use of its SMARTALK mark in connection with its telecommunications and specifically wireless services, that mark has become distinctive and acquired sufficient secondary meaning to the point where potential customers and Internet users are likely to recognize that mark as signifying telecommunication services offered by the Complainant and not by the Respondent.

It is utterly inconceivable that, given this recognition, the Respondent was completely unaware of that mark and its reputation when it registered the contested domain name. In fact, it is clearly evident to this Panel that not only was the Respondent aware of this mark, but moreover it intentionally chose to continue to use the disputed domain name to avail itself of the inevitable confusion that would result.

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

## **ii. Illegitimacy**

Certainly given its common law rights, the Complainant has acquired exclusive rights to use its "SMARTALK" Marks in conjunction with the telecommunication services which the Complainant has been providing under those marks. Furthermore, by virtue of the PTO having published these marks for opposition, the US PTO has implicitly recognized that each of these marks has 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 contains the Complainant's mark "SMARTALK" under which the Complainant provides its services. Furthermore, neither the Complainant nor its licensor, Smartalk, has ever authorized the Respondent to utilize the mark "SMARTALK", or a mark confusingly similar thereto, in conjunction with the specific services which the Complainant provides under those marks, nor does the Complainant or Smartalk have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "SMARTALK" or a mark confusingly similar thereto, in connection with telecommunication services as presently provided by the Complainant would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., 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 completely incorporates the Complainant's "SMARTALK" mark and appending to it the generic term "wireless", is intentionally seeking to create a confusingly similar name that opportunistically exploits Internet user confusion by diverting, through re-direction and diversion, Internet users away from the

Complainant's site to the Respondent's website for the latter's own pecuniary benefit. Specifically, those users would think they are purchasing the Complainant's services through the Respondent's website and, by doing so, generate profit to the Respondent from those sales -- to the Complainant's ultimate detriment.

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 *Peter Frampton v. Frampton Enterprises, Inc.*, cited *supra*.

Moreover, the Panel is cognizant of the heavy burden that would be placed on complainants if in support of their cases on illegitimacy each of those complainants were to be impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their respondents. The Panel believes that where allegations of illegitimacy are made, particularly as here, when coupled with conduct of a respondent that evidences bad faith, it is quite reasonable to shift the burden of proof to that respondent to adequately show that its use of the contested domain name is legitimate, such as by showing that, in conjunction with the contested domain name, it is making a bona fide commercial offering of goods or services or preparations for such offerings, or non-commercial or fair use. Given the situation now facing the Panel, it is beyond question that the Respondent's conduct here falls far short of meeting this burden -- particularly given that no facts have been proven to support such usage. See *Peter Frampton v. Frampton Enterprises, Inc.*, cited *supra*; *American Home Products Corp. v. Malgioglio*, cited *supra*; *Surface Protection Industries, Inc. v. The Webposters*, cited *supra*; *College Summit, Inc. v. Yarmouth Educational Consultants, Inc.*, WIPO Case Nos: D2000-1575 (January 17, 2001); *MSNBC Cable, LLC v. Tsys.com*, D2000-1204 (December 8, 2000) and *Playboy Enterprises International, Inc.*, D2000-1016 (November 7, 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 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.

### **iii. Bad Faith**

The Panel firmly believes that the Respondent's actions constitute bad faith registration and use of the contested domain name.

It is absolutely inconceivable to this Panel that the Respondent was unaware of the Complainant's mark SMARTALK when the former registered the contested domain name on October 18, 2000. In fact, by virtue of having initially offered competitive services to those then being offered by the Complainant and through a website resolvable through the contested domain name, the Panel infers that not only was the Respondent very much aware of that mark but moreover it deliberately decided to utilize that mark, without authorization, in an attempt to cause user confusion and, by doing so, misappropriate to itself the goodwill inherent in that mark. This intention is strikingly evident when the Respondent, in spite of and after having been notified of the Complainant's rights in the mark SMARTALK, intentionally resumed its use of the disputed domain name in conjunction with offering its competitive telecommunications services.

Given this and particularly since the Respondent formed the contested domain name by simply appending the generic term "wireless" to the Complainant's well-known mark "SMARTALK", the Panel infers, from the lack of any Response, that the Respondent's motivation in doing so was rather simple: to exploit inevitable user confusion as to source, sponsorship, affiliation or endorsement of any "SMARTALK" branded service, obtainable through the Respondent's website in conjunction with the contested domain name, as emanating from or associated with the Respondent rather than the Complainant.

Hence, the Panel views these actions as constituting bad faith registration and use in violation of paragraph 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant 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**

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 <smartalkwireless.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson, Esq.  
Sole Panelist

Dated: September 11, 2002