



**WIPO Arbitration and Mediation Center**

**ADMINISTRATIVE PANEL DECISION**

Fall Nummer: D2003-0642

Entscheidung vom 8. Oktober 2003

1. The Parties

The Complainant is SBC Knowledge Ventures LP... United States of America.

The Respondent is J. H. aka J. J. of New York, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sbclaboratories.com> is registered with Go Daddy Software.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 15, 2003. On August 15, 2003, the Center transmitted by email to Go Daddy Software a request for registrar verification

in connection with the domain name(s) at issue. Also on August 15, 2003, Go Daddy Software transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 20, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was September 9, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 10, 2003.

The Center appointed Andrew Mansfield as the sole panelist in this matter on September 22, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

Respondent sent an e-mail message to the Center on September 22, 2003. The Panel has reviewed and considered that e-mail message in reaching this decision.

#### 4. Factual Background

Complainant is the owner of all intellectual property assets of SBC Communications, Inc., including its subsidiaries and affiliates. SBC Communications, Inc. is one of the largest providers of telecommunications products and services in the United States. Complainant holds numerous trademarks in the SBC word and logo marks. Complainant provided the following non-exclusive list of United States trademark registrations to the Panel:

Mark

Registration

Date

Description

SBC

1,864,391

11/22/1994

Installing and maintaining telecommunications systems and equipment for others (Class 37); first use anywhere 10/27/1993

SBC

1,864,396

11/22/1994

Communications services; namely, telephone, paging, cellular, voice messaging, portable analog and digital communications services, transmission of data communications and cable television broadcasting services (Class 38); first use anywhere 10/27/1993

SBC

2,191,869

09/29/1 998

Telecommunications equipment, namely, telephones (Class 9); first use anywhere 1 2/30/1 996

SBC EXPRESS

2,515,595

12/4/01

Computer software which enables multiple-user access to a global computer network and/or the Internet for the transfer and dissemination of information (Class 9); first use anywhere 12/4/01

SBC TELECOM

2,520,904

12/11 8/01

Telephone communication services; cellular telephone services; telephone voice messaging services; electronic voice messaging, namely, the recording, storage and subsequent transmission of voice messages by telephone; audio teleconferencing, video teleconferencing, providing telecommunications connections to a global computer network; first use anywhere 12/4/01

## 5. Parties' Contentions

### A. Complainant

On May 27, 2003, the "technology arm" of the SBC Companies officially changed its name from SBC Technology Resources, Inc. to SBC Laboratories, Inc. On June 16, 2003, the SBC Companies issued a press release, published on the SBC website, announcing that the name of their research and development arm was changed to "SBC Laboratories." Complainant brings to the attention of the Panel the fact that Respondent registered the domain name on the same date that the name change was made public ? June 16, 2003.

Complainant alleges that the domain name is identical or confusingly similar to its United States' marks. Further, Complainant states that Respondent has no rights or legitimate interests to the domain name or the words "SBC Laboratories" and relies on the date of the registration of the domain name as evidence of Respondent's bad faith registration and use of the domain name.

Complainant notes that the domain name resolved at the website of a telecommunications competitor. A website visitor who typed in "http://www.sbclaboratories.com" into a web browser was taken to "http://www.att.com."

### B. Respondent

The Respondent did not timely reply to the Complainant's contentions. Respondent did send a short e-mail communication to the Center on September 22, 2003, which was then forwarded to the Panel. The Panel has reviewed that e-mail communication.

Respondent asserts only that Complainant does not have a trademark in the domain name and has "no legal right" to "own" the domain name. Respondent states that it offered to transfer the domain name for a small payment but that Complainant refused to pay any amount for the transfer.

## 6. Discussion and Findings

Complainant must establish all of the elements required for obtaining the requested domain name transfer under paragraph 4(a) of the Policy. Those elements are:

- (a) The domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (b) The Respondent has no rights or legitimate interests in respect of the domain name; and
- (c) The domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The domain name is not identical to any one of Complainant's trademarks. Because Complainant has not obtained a registration of the alleged mark "SBC Laboratories," it must demonstrate that its use in commerce gives it common law trademark rights to the phrase and that its common law trademark is superior to that of Respondent. The Panel does not find that Complainant yet has a fully matured common law trademark in "SBC Laboratories." It only began using that mark on June 16, 2003. Respondent registered the domain name on the same day.

Complainant need not, however, demonstrate that the domain name is identical to one of its trademarks. The domain name need only be confusingly similar to a mark held by Complainant. Two lines of authority provide support for this finding in the present case.

First, it is well-established by previous UDRP Panel decisions that a domain name incorporating a distinctive trademark in its entirety creates sufficient similarity between the mark and the domain name as to render it confusingly similar (See, e.g., *Minnesota Mining & Manufacturing v. JonLR*, WIPO Case No. D2001-0428, and *Microsoft Corporation v. S.L., Mediaweb*, WIPO Case No. D2003-0538, <msnporno.com>).

Second, prior Panels have addressed the issue of the combination of a generic term with a distinctive trademark, as occurred here. The determinative factor in such cases is an analysis of whether an average

Internet user might expect the holder of the distinctive mark to offer the goods or goods suggested by the generic term. See, e.g., Microsoft Corporation v. Momm Amed Ia, WIPO Case No. D2001-1454, <msnmember.com>, or Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil, WIPO Case No. D2000-1409. In this case there is no doubt that the combination of the word "laboratories" with the distinctive trademark "SBC" leads to confusion among Internet users.

The domain name is held by the Panel to be confusingly similar to the trademarks of the Complainant. The Complainant has thus met the burden of proof as established by subparagraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Complainant alleges that Respondent has no rights or legitimate interests in the domain name. Respondent, even its late-filed e-mail communication, offers no rights or legitimate interests it might have in the domain name. The Panel finds that Respondent has no such rights or legitimate interests.

## C. Registered and Used in Bad Faith

Paragraph 4(b) of the UDRP Policy provides the following non-exclusive examples of registration and use in bad faith:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 your website or location or of a product or service on your website or location."

The facts presented in this case paint a simple picture. Respondent learned, through the press release issued by Complainant, that Complainant had renamed one of its divisions "SBC Laboratories." Respondent must have shortly thereafter run a search and discovered that the domain name <sbclaboratories.com> was available. Sensing an opportunity to profit from Complainant's tardiness in registering such a simple but important domain name, Respondent registered it. When contacted by Complainant, Respondent demanded compensation in excess of his out-of-pocket expenses.

Other cases have addressed this fact pattern. See, e.g., *The Body Shop International PLC v. CPIC NET and Syed Hussain*, WIPO Case No. D2000-1214; *Magna International Inc. and Donnelly Corporation v. Brian Evans*, WIPO Case No. D2002-0898; *Cingular Wireless LLC v. Israel Aceves*, WIPO Case No. D2003-0154. In these cases, Panels find registration and use in bad faith.

Respondent's case is further undermined by the redirection of website visitors to a competitor of Respondent. Such redirection clearly indicates bad faith use.

## 7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name be transferred to the Complainant.

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Sole Panelist