



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0624

Entscheidung vom 16. Oktober 2003

1. The Parties

The Complainant is Toyota ..., California,

The Respondent is J. A. Productions, ... California,

2. The Domain Name and Registrar

The disputed domain name is <lexusmichaels.com>, registered with Network Solutions, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 7, 2003. On August 8, 2003, the Center transmitted by email to Network Solutions, Inc. as Registrar a request for registrar verification in connection with the domain name at issue. On August 13, 2003, Network Solutions, Inc. verified that the Respondent is listed as the registrant, verified Respondent's address and provided details for the administrative, billing, and technical contacts. On August 15, 2003 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 15, 2003. The Center forwarded the notification to the addresses identified and verified by the Registrar. In accordance with the Rules, paragraph 5(a), the due date for Response was September 4, 2003. The Respondent did not submit any response. Accordingly, the Center sent a notice of the Respondent's default on September 8, 2003.

The Center appointed Barbara Solomon as the sole panelist in this matter on October 7, 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.

4. Factual Background

Complainant is a wholly-owned subsidiary of Toyota Motor Corporation ("TMC"), a Japanese corporation that is the owner of the trademark LEXUS. Complainant is party to a Lexus importer agreement with TMC pursuant to which TMC granted to Complainant a non-exclusive right to use the trademarks and service marks of TMC on or relating to Lexus vehicles, Lexus parts and Lexus accessories for distribution, sale and service in the continental United States, Alaska, Puerto Rico and the U.S. Virgin Islands.

Complainant has been using the LEXUS mark in connection with automobiles, structural parts and accessories therefor and in connection with automotive repair, maintenance, financing and leasing services in the United States since 1989. Since 1989, sales of LEXUS automobiles, structural parts and accessories in the U.S. have exceeded fifty billion dollars (U.S.).

The domain name at issue, <lexusmichaels.com>, was originally registered on March 6, 1998, and has been renewed through March 5, 2004. The domain name was procured for Respondent by Jessika Alexis. According to a letter from counsel for Respondent dated March 18, 1999, the domain name <lexusmichaels.com> is a variation of Jessika Alexis's surname. In addition, counsel for Respondent, in response to demand letters sent by Complainant, advised that Ms. Alexis's stage name was Lexus Michaels which has been Ms. Alexis's stage name for a long while. Counsel for Respondent further confirmed that the domain name Registrant was misspelled by the domain name Registrar and that the domain name Registrant in fact is J. Alexis Productions as opposed to J. Alexis Productions.

Although Respondent, through counsel, took the position that the domain name did not violate Complainant's rights, Respondent did state that she would close down the domain name

<lexusmichaels.com>. By letter dated June 24, 1999, Respondent, through counsel, agreed to cease and desist using the domain name <lexusmichaels.com> effective June 25, 1999. Notwithstanding that statement, the <lexusmichaels.com> domain name continued to be used. As of January 17, 2003, Respondent noted on its website that she was opening a new website at "www.alexusmichaels.com" and further advised that effective March 6, 2003, the domain name <lexusmichaels.com> would be removed and no longer be available. Currently the domain name <lexusmichaels.com> takes Internet users to a blank page.

5. Parties' Contentions

A. Complainant

Complainant contends that the LEXUS mark is recognized as a well-known and famous trademark in the United States and that Respondent adopted the domain name <lexusmichaels.com> in order to benefit commercially from an association with Complainant. Complainant further states that "it is inescapable that Respondent's motive in registering and renewing the domain name could be anything other than to divert customers and capitalize on the goodwill associated with Complainant's famous mark."

As to the similarity of the domain name to the LEXUS mark, Complainant states that the domain name is simply a combination of the LEXUS mark with a fictitious surname. Complainant further notes that authorized dealerships often adopt as a name a personal name together with the mark LEXUS.

On the issue of lack of legitimate rights or interest, Complainant states that Respondent cannot have any legitimate interest in using the domain name other than to capitalize on Complainant's reputation and other than to draw to her website Internet users looking for the official website of Complainant.

Finally, Complainant contends that Respondent has registered and is using the domain name in bad faith by creating a likelihood of confusion with Complainant's LEXUS mark, by providing false contact information and by renewing the registration for the domain name with notice of Complainant's objection. Complainant further contends that the domain name was used in connection with a transsexual pornographic website. However, the Panel notes that there is no representation in the record of the content at <lexusmichaels.com>.

B. Respondent

Although the Respondent did not reply to Complainant's complaint, it did respond to demand letters which are included as part of the record. Rule 15(a) requires the Panel to render its decision "on the basis of the statements and documents submitted." The Complaint includes correspondence written on behalf of the Respondent by her counsel. In that correspondence, Respondent stated that the domain name was not registered to cause confusion or pass off her website as being associated with Complainant, that there is no intent to divert customers looking for Complainant, and that Lexus Michaels is a stage name used by Jessika Alexis.

6. Discussion and Findings

Notwithstanding the fact that the Respondent defaulted in these proceedings, Complainant may only prevail if, on the basis of the statements and documents submitted in accordance with the Policy, Complainant establishes each of the following: (i) that it has enforceable or protectable rights in the mark LEXUS; (ii) that the Domain Names are identical or confusingly similar to the LEXUS trademark in which the Complainant has rights; (iii) that the Respondent has no legitimate rights or interest in the Domain Names; and (iv) that the Domain Names have been registered and are being used in bad faith.

A. Complainant's Rights

In previous UDRP decisions, Panelists have found that Complainant has protectable rights in the mark LEXUS. See *Toyota Motor Sales U.S.A., Inc. v. Rafi Hamid d/b/a ABC Automobile Buyer*, WIPO Case No. D2001-0032 (March 28, 2001); *Toyota Motor Sales U.S.A., Inc. v. Indian Spring Motor*, NAF Case No. FA0305000157289 (June 23, 2003). The evidence submitted by Complainant supports these findings. Although Complainant is not the owner of any trademark registrations for the mark LEXUS, Complainant has established that its corporate parent Toyota Motor Corporation owns numerous U.S. federal trademark registrations for the mark LEXUS. Complainant has also established that Complainant has the right under license to use the LEXUS trademark throughout the United States except the State of Hawaii. As a matter of U.S. law, which governs these proceedings, even a non-exclusive licensee has the right to assert trademark rights in a licensed mark and to take action to protect the licensed mark. Accordingly, Complainant has satisfied the first element of the Policy.

B. Identical or Confusingly Similar

Complainant contends that the domain name is confusingly similar to the LEXUS trademark since it consists merely of the LEXUS mark combined with a surname. Complainant notes that car dealerships often consist of a combination of the car name, LEXUS, with a surname identifying the individual who owns the dealership. The examples given by Complainant all show use of the person's surname followed by the LEXUS mark, not the use of the LEXUS mark followed by the person's name as in the case here. While admittedly the domain name does incorporate LEXUS, the manner in which it is used suggests that LEXUS is a personal name and not the name of a car. As such, the domain name has a different connotation and commercial impression than the LEXUS mark. The issue of whether the domain name is confusingly similar to the LEXUS mark is a close one but need not be reached in light of the findings below.

C. Rights or Legitimate Interests

Legitimate interests in a domain name can be demonstrated by showing that Respondent has been commonly known by the domain name. Policy paragraph 4(c)(ii). In a letter dated April 13, 1999, counsel for the Respondent advised that Respondent had been using LEXUS MICHAELS as a stage name "for quite a long time and she is very well known in the adult entertainment industry." These facts are un-rebutted by Complainant.

As noted in *WebVan Group, Inc. v. Stan Atwood*, WIPO Case No. D2000-1512 (February 20, 2001), a Respondent need only show "a plausible, non-infringing explanation for selecting the disputed domain name." From the uncontradicted evidence submitted by Complainant, Respondent has shown a legitimate interest in the domain name. As such, the Panel finds that the Complainant has not met its burden on this element. See *AST Sportswear, Inc. v. Steven R. Hyken*, WIPO Case No. D2001-1324 (March 26, 2002); *Penguin Books Limited v. The Katz Family*, WIPO Case No. D2000-0204 (May 20, 2000).

D. Registered and Used in Bad Faith

Because the Panel finds that the Complainant has not met its burden in showing that the Respondent lacked legitimate rights or interests in the domain name, there is no need for reaching the issue of whether the domain name was registered and is being used in bad faith.

Notwithstanding the fact that a decision on the issue of bad faith need not be reached, the record fails to support such a showing. There is no evidence that Respondent registered the name with the intent of selling it for profit. The domain name does not prevent Complainant from using LEXUS in a domain name. The domain name does not disrupt Complainant's business and was not intentionally selected to create any confusion.

Complainant asserts that bad faith exists because Respondent failed to live up to a promise to cease use of the domain name. In fact, there is no use being made of the domain name and an Internet user who types in the domain name is brought to an empty page. The evidence submitted by Complainant shows that the Respondent lived up to her agreement to cease using the domain name. Respondent never agreed to transfer the domain name and thus did not violate any promises or undertakings that were made. In addition, Complainant suggests that the domain name <lexusmichaels.com> is listed by search engines in response to searches for Lexus vehicles. There is no evidence of such and clearly, to the extent <lexusmichaels.com> does show up in a search, it would be sufficiently far down in the list of search results such that the domain name would not be likely to draw customers away from Complainant's official websites.

7. Decision

Because the Complainant has failed to show that the Respondent lacks a legitimate right or interest in the domain name, the Complainant's request for transfer of the domain name is denied.