



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0567

Entscheidung vom 13. Oktober 2003

1. The Parties

The Complainant is Advanced Relational Technology. Inc., Coeur d'Alene, Idaho, United States of America, represented by Scott Harris.

The Respondent is Domain Deluxe, GPO 7628, Central, Hong Kong, China. The Respondent is represented by Ari Goldberger, Esq. of ESQwire Law Firm, Cherry Hill, New Jersey 08003, U.S.A.

2. The Domain Name and Registrar

The disputed domain name, <homedesigner.com> is registered with the registrar Domain People of Vancouver, BC, Canada.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 19, 2003. On July 21, 2003, the Center transmitted by email to DomainPeople a request for registrar verification in connection with the domain name at issue. On July 25, 2003, DomainPeople 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 this proceeding began on July 28, 2003. In accordance with the Rules, paragraph 5(a), the

due date for Response was August 17, 2003. The Response was filed with the Center on August 17, 2003.

The Center appointed Messrs. Dimitris Oekonomidis, David E. Sorkin and Dennis A. Foster as panelists in this matter on September 29, 2003. The Panel finds that it was properly constituted. Each member of 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.

On August 25, 2003, the Complainant submitted a supplemental filing. Having examined this filing, the Panel has decided to invoke paragraph 12 of the Rules to exclude it. The Panel does not believe there is any pertinent information in the supplemental filing that the Complainant could not have put in its original filing.

4. F a c t u a l B a c k g r o u n d

The Complainant attempted to register the disputed domain name around April 9, 2003. However, apparently because the previous owner of the disputed domain name had not paid the required fees, the domain name was canceled.

The Respondent registered the disputed domain name on July 7, 2003. The Complainant has tried to negotiate a sale of the disputed domain name from the Respondent but the parties have not been able to reach an agreement.

5. P a r t i e s ' C o n t e n t i o n s

A. Complainant

- The Complainant registered the disputed domain name on April 9, 2003, for three years.

- The Complainant has used the disputed domain name, <homedesigner.com>, as its web site since April 12, 2003, the date the product was announced at a public press conference to sell the Complainant's products (Complaint Annex B).

- "Home designer" is the Complainant's trademark. The disputed domain name is used by the Complainant to market and sell its software products for home design, under the product name "Better Homes and Gardens Home Designer."

- The Respondent registered the disputed domain name, <homedesigner.com>, with the intent to resell it. This was possible due to an error that the registrar Network Solutions made in removing the Complainant's domain name from its data base.

- In accordance with the Rules, paragraph 3(b)(ix)(2), the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint.

- The Respondent is using the disputed domain name with the intent to resell it.

- The Respondent has not been known by the disputed domain name. The Respondent is clearly purchasing domain names for the purpose of resale as its website advertises.

- The Respondent is not making a legitimate commercial or fair use of the disputed domain name. It is using the domain name with the intent to re-sell it, as the web site currently advertises (Annex D). The Complainant sold and shipped products to customers that prompted the customers to register the Home Designer software at the disputed domain name. A screen print of this registration process is at Complaint Annex F.

- The Respondent is using the disputed domain name with the intent to re-sell it. Contained in Annex D is a printout of the web site that lists the disputed domain name as "for sale". From the Complainant's negotiations with the Respondent, it is apparent that the Respondent is holding this domain name for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name.

- The Respondent has engaged in a pattern of such conduct showing it regularly purchases and re-sells domain names. It has clearly disrupted the Complainant's business.

- The Respondent may have intentionally attempted to attract Internet users for commercial gain by registering the disputed domain name, and not transferring it back when notified of the mistake by the Complainant's registrar, Network Solutions.

- The disputed domain name should be transferred to the Complainant.

B. Respondent

- At the outset, the Complaint must be dismissed because the Respondent has no trademark rights to the term "home designer". It has no trademark but relies only on common law trademark rights for this generic or, at best, descriptive term. A Complainant must produce evidence of secondary meaning in order to establish common law trademark rights under the Policy, and no such evidence has been presented here nor could there be as the Complainant admits it only recently began promoting the term.

6. Discussion and Findings

In order for the Complainant to prevail and have the disputed domain name, <homedesigner.com>, transferred to it, the Complainant must prove the following (the Policy, paragraphs 4(a)(i-iii):

- the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- the Respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name was registered and is being used in bad faith

A. Identical or Confusingly Similar

The Complainant does not have a registered trademark for the name home designer. However, in an attempt to show trademark rights through use, the Respondent states it has been using the home designer name since April 2003, in connection with software for home design.

As the Respondent objects, the disputed domain name is certainly descriptive and probably generic. As for common law trademark rights, the Complainant has not shown that the public has nonetheless come to identify its software as the only, one or even one of the few, for home design. The Panel finds the Complainant has failed to meet its burden of proof under the Policy at paragraph 4(a)(i), ie, the Complainant has failed to show it has trademark or service mark rights in the disputed domain name.

As the Policy requires the Complainant to prevail on Policy paragraphs 4(a)(i-iii) inclusively, the Panel does not need to reach the issues of Legitimate Rights and Interests or Bad Faith.

Reverse Domain Hijacking

The Respondent has requested that the Panel issue a finding of Reverse Domain Name Hijacking per paragraph 15 (e) of the Rules, i.e., that the Complainant brought this proceeding in bad faith or to harass the Respondent.

The Complainant in fact brought this proceeding because it thought it had registered the disputed domain but, owing to a clerical error, the Complainant lost the registration. The Respondent snapped it up. Under the premises, not only does the Panel not believe a finding of Reverse Domain Name Hijacking is warranted, but the Panel finds the Respondent's request uncharitable. The Complainant apparently did not realize the Policy does not offer ways to redress the contractual harm it may have suffered.

7. Decision

For all the foregoing reasons, the Complaint is denied.

(Panelists)