



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Sybase, Inc. v. Analytical Systems

Case No. D2004-0360

1. The Parties

The Complainant is Sybase, Inc., Concord, Massachusetts, United States of America, represented by Foley Hoag, LLP, United States of America.

The Respondent is Analytical Systems, Raleigh, NC, United States of America, represented by Phil Kramer.

2. The Domain Name and Registrar

The contested domain name is <datawindow.net> and is registered with Register.com ("Registrar").

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 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 May 14, 2004, and in hard-copy form on May 17, 2004, along with Annexes 1-16 and the appropriate payment.

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 May 17, 2004, 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) 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, (c) the language of the registration agreement, and (d) whether the domain name will remain "locked" during the pendency of this proceeding.

Subsequently, on May 17, 2004, the Registrar provided its response to the Center through which the Registrar provided contact information pertinent to the contested domain name to the extent present in its WhoIS database, confirmed that Register.com is the registrar of the domain name, confirmed that it had received a copy of the Complaint and that the Policy applied to the domain name, stated that the language of the registration agreement is English and that the domain name was then in a "Registrar-lock" 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 for court adjudication of disputes concerning or arising from the use of the domain name.

On May 18, 2004, 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, by postal mail and e-mail (the latter without the annexes), to the Respondent. Specifically, the Center separately provided its notice along with the Complaint, by e-mail, to the Respondent's domain name registrant, technical, administrative and zone contacts as set forth in the WhoIS record for the contested domain name. In addition and also on May 18, 2004, the Center forwarded a copy of the Complaint (without the 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 May 18, 2004, 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 June 7, 2004, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent sent its Response, together with Annexes 1-2, to the Center on June 7, 2004, of which the Center acknowledged its receipt by e-mail letter dated June 8, 2004.

Accordingly, pursuant to the Rules and Supplemental Rules, by e-mail letter dated June 9, 2004, 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 and, to ensure compliance with paragraph 7 of the Rules, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated June 10, 2004, 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 June 24, 2004.

This dispute concerns one domain name, specifically <datawindow.net>.

The language of this proceeding is English.

4. Factual Background

A copy of the WhoIS registration records for the contested domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered that domain name with the Registrar on February 9, 2002.

A. The Complainant's "DATAWINDOW" Mark

The Complainant owns a United States trademark registration for the mark "DATAWINDOW" and has provided, in Annex 3 to the Complaint, a hard-copy printout of its registration certificate. The pertinent details for this mark are as follows:

DATAWINDOW (block letter)
US registration 2,138,302; registered February 24, 1998

This mark was registered for use in connection with: "Computer software for use in the field of applications development and user manuals sold as a unit therewith" in international class 9. This mark claims a first use and first use in inter-state commerce dating February 28, 1991.

The Complainant also claims common law rights in this mark through its use in commerce, as an indicator of the source or origin of the Complainant's goods and services, dating from February 1991.

B. The Complainant's Activities

The Complainant, one of the largest independent software vendors in the world, was founded in 1984. The Complainant offers technology solutions in four major areas: information management, development and integration, business solutions and mobile solutions. Further, the Complainant serves more than 40,000 corporate customers in 60 countries and also partners with a number of industry leaders, such as HP, Intel, NEC, IBM, Apple, PeopleSoft, SAP and Sun..

The Complainant is also the registered owner of the domain name <datawindow.com> (a hard-copy printout of the WhoIS registration record for that name appears in Annex 4 to the Complaint). This name redirects Internet traffic to the Complainant's primary website at "www.sybase.com" through which the Complainant offers its products and

services, including products that employ the Complainant's "DataWindow" technology.

The Complainant obtained its federal trademark registration and its related domain name in connection with its business as a software vendor. In that regard, the Complainant's "DataWindow" technology is a proprietary patented technology that simplifies the creation of databases and the manipulation of information contained in databases. This technology has been an integral part of the Complainant's database products since 1991 and is incorporated in the Complainant's PowerBuilder® database building product.

The Complainant publicly and previously announced that its PowerBuilder product (including the "DataWindow" component) would be extended to operate closely with Microsoft's .NET framework, the latter providing a high degree of integration between traditional software and web services over the Internet. A press release issued by the Complainant described a four-phased approach to integrating its products with Microsoft's .NET framework, the second phase of which would involve making the Complainant's "DataWindow" product interoperable with Microsoft's .NET technologies. A copy of this press release appears in Annex 5 to the Complaint and states in pertinent part:

"The second phase will include DataWindow.NET and DataStore.NET features. Taking advantage of PowerBuilder's unrivaled patent on objects for data access, DataWindow.NET and DataStore.NET will be accessible from non-PowerBuilder applications and may be used by any .NET language. Experienced PowerBuilder developers working in .NET shops will not have to learn new long, tedious and complex methods to achieve what they can do easily with the DataWindow and DataStore."

The Complainant offers its goods and services at retail to its corporate customers through local sales offices and its websites, primarily that located at "www.sybase.com" (a hard-copy printout of the home page located at that site, which is also reached through "www.datawindow.com", appears in Annex 6 to the Complaint).

The Complainant has invested significant time, money and effort developing and promoting the DATAWINDOW Mark and the retail and online software business associated with that mark. In that regard, the Complainant offers courses and on-line articles (an example of which appears in Annex 7 to the Complaint) focused specifically on the use of the Complainant's "DataWindow" technology.

Moreover, various books have been written that are devoted entirely to the Complainant's "DataWindow" technology. See, e.g., Richard Brooks, *The Definitive DataWindow: Your Key to PowerBuilder Success* (published 2000), and Richard Brooks, *Powerbuilder Datawindow* (published 2001) (hard-copy printouts of the entries for these books, and as appearing on the Amazon.com website, appear in Annex 8 to the Complaint).

Furthermore, a Google search of the term "DATAWINDOW" yields approximately 38,000 results, a significant majority of which appears to pertain to the Complainant's DataWindow technology (a small excerpt of the search results appears in hard-copy form in Annex 9 to the Complaint). A Google search of the term "Datawindow.net" yields approximately 8,040 results, a significant majority of which pertains to the Complainant's "DataWindow .NET" technology (a small excerpt of the results of this search appears in Annex 10 to the Complaint).

On March 12, 2004, Complainant's counsel sent a letter, a copy of which appears in Annex 13 to the Complaint, to the Respondent demanding that the latter cease and desist from infringing Complainant's trademarks. In an effort to resolve the dispute short of a UDRP proceeding, the Complainant, through that letter, offered to purchase the contested domain name from the Respondent for US \$1,000. On March 19, 2004, the Respondent sent the Complainant's counsel an e-mail (a copy of which appears in Annex 14 to the Complaint) which stated:

"Regarding the domain "datawindow.net": This name is currently not for sale since it is a key component of my business strategy between now and 2010. The present value to be generated by this domain in my business model is approximately \$ 25,400. If you are interested in making an offer at this level, it will be considered."

On March 31, 2004, in a further effort to resolve the dispute, Complainant's counsel sent an e-mail (a copy of which appears in Annex 15 to the Complaint) to the Respondent requesting information about Respondents' purported business plans such that counsel could further evaluate the matter. Counsel also stated, in the e-mail, that the Complainant was willing to reimburse the Respondent for its out-of-pocket costs associated with registering the contested domain name.

Through an e-mail response to the Complainant's counsel and dated April 5, 2004 (a copy of which appears in Annex 16 to the Complaint), the Respondent refused to provide that counsel with any confidential information about its business and its strategy.

C. The Respondent's Activities

The Respondent registered the contested domain name on February 9, 2002. Presently, the contested domain name resolves to a generic notice provided by the Registrar which simply states that "Coming Soon! This name was recently registered at Register.com.". (a hard-copy of the resulting page appears in Annex 12 to the Complaint.)

The Respondent is a computer consultant specializing in "decision support" and "business intelligence" systems. The Respondent has worked and consulted on the development of such systems since 1984 for various companies including Hardee's Restaurants, Burger King Corporation, Philips Magnavox, Sunglass Hut, and Harley Davidson. The Respondent has provided a copy of his curricula vitae in Annex 1 to the Response.

As stated in the Response, the Respondent purchased the contested domain name to "expand the level of goods and services that I offer my clients" and specifically to "demonstrate the degree to which corporate business intelligence can be distributed to client organizations over the Internet". The Respondent states that various components of its planned business include: "the domain name, proprietary business intelligence software, canned reporting and graphics, website development and various security elements".

Further and as indicated in the Response, the Respondent valued its planned business at US \$ 25,400 and stated that the domain name itself is not for sale. Further, the Respondent stated that it spent approximately 2000 hours in 2002, 1080 hours in 2003 and 240 hours in 2004 in developing this business.

5. Parties' Contentions

A. Complainant

i. Similarity

The Complainant contends that the contested domain name is virtually identical or confusingly similar to the Complainant's DATAWINDOW Mark; hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

In that regard, the Complainant contends that the addition of a top-level domain such as ".net" to a trademark, as occurred here, results in a domain name that still remains identical to the trademark.

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.

Specifically, the Complainant states that it has exclusive rights to the use of the term "DATAWINDOW" in a domain name inasmuch as the Complainant has registered a trademark and domain name incorporating the DATAWINDOW Mark.

The Complainant also states that the Respondent is neither an agent nor a licensee of Complainant and therefore has no right to the use of the DATAWINDOW Mark in its domain name.

Further, the Respondent registered the contested domain name approximately eleven years after the Complainant first used the mark "DATAWINDOW" in commerce, five years after the mark "DATAWINDOW" was published for opposition and four years after the mark "DATAWINDOW" was registered.

The Complainant alleges that the Respondent's registration of the domain name prevents valid use of the domain name by the Complainant, and therefore wastefully restrains the legitimate and proper use of the domain name and unlawfully tarnishes the Complainant's marks. The Complaint states that "This is particularly disruptive to Complainant's business in light of the recent public beta-testing of Complainant's DataWindow .NET technology. (See Annex 11 [to the Complaint]). Respondent's registration of the domain prevents Complainant from using the domain that most consumers are likely to believe will lead them to information about the DataWindow .NET technology".

Moreover, the Complainant contends that, in view of the identical/similar nature of the contested domain name to the Complainant's DATAWINDOW Mark and the fact that the Complainant has not authorized Respondent to use the mark, the burden shifts to the Respondent to establish its right or legitimate interest in that domain name (citing to, *Auto-C, LLC v. MustNeed.com*, WIPO Case No. D2004-0025 (March 30, 2004) and *Sony Kabushiki Kaisha v. sony.net*, WIPO Case No. D2000-1074 (November 28, 2000)). Given this approach, the Complainant contends that the Respondent cannot meet its burden to demonstrate any legitimate rights to the domain name. In particular, the Respondent is not able to show that, before any notice of the dispute, it used the contested domain name in connection with a *bona fide* offering of goods or services

(paragraph 4(c)(i) of the Policy). Specifically, the Complainant alleges that, despite the fact that the Respondent registered the contested domain name more than two years ago, the Respondent has done nothing to develop any business associated with that domain name, and the name remains “parked” at Register.com and resolves only to the generic notice provided by the domain registrar (as shown in Annex 12 to the Complaint). The Complainant takes the position that “parking” does not reflect a *bona fide* use of the domain name and as such the Respondent has not demonstrated any legitimate right to the domain name.

In addition, the Complainant contends that, to the extent that the Respondent may claim that it intends to use the domain name at some future date as part of its business, such use is not in connection with a *bona fide* offering of goods or services. This is because “[t]he offering of goods and services in association with an infringing trademark use does not constitute a ‘bona fide’ offering of goods and services within the meaning of *Policy* paragraph 4(c)(i)” citing to *Cable News Network LP, LLLP v. Ahmed Latif*, NAF Case No. 100709 (December 31, 2001).

Additionally, the Complainant alleges that the Respondent is not commonly known by the domain name <datawindow.net> (paragraph 4(c)(ii) of the Policy) and, from the corresponding WhoIS record for this name, apparently conducts its business under the name “Analytical Systems.”

Lastly, the Complainant contends that the Respondent cannot demonstrate legitimate rights in the domain name because the Respondent is not making a legitimate, non-commercial use of the domain name (paragraph 4(c)(iii) of the Policy).

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.

First, the Complainant states that the contested domain is identical or confusingly similar to the DATAWINDOW Mark in which the Complainant has exclusive rights. The Respondent’s addition of the generic term “net” to the Complainant’s registered mark does not differentiate the contested domain name from that mark. Hence, the Complainant alleges that there is a high likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent’s website with the Complainant’s mark.

Moreover, the Complainant contends that it is highly unlikely that the Respondent was unaware of the Complainant and the nature of the Complainant’s business when the Respondent registered the contested domain name in February 2002. Specifically, according to the registration information which the Respondent provided for the contested domain name, the Respondent’s business is known as “Analytical Systems”, which appears to be in a computer-related field. The Complainant’s business was established in 1984, and the mark DATAWINDOW was first used in 1991. By the time the Respondent registered the contested domain name in February 2002, the Complainant had become one of the largest independent software vendors in the world, and the mark DATAWINDOW was well known, and the Complainant’s DataWindow technology had been the subject of at least two books and tens of thousands of Internet websites. Given that the Respondent is apparently in a computer-related business, the

Complainant contends that the Respondent must have known about the Complainant at the time the Respondent registered the contested domain name.

Further, the Complainant contends that even if the Respondent did not have actual knowledge of Complainant's DATAWINDOW Mark and the association between the term "DataWindow" and the Complainant, the Respondent certainly had constructive knowledge of that mark inasmuch as information regarding that mark was then accessible on-line from the public web server of the United States Patent and Trademark Office. Had the Respondent just undertaken a simple trademark search on that site -- which it was obligated to do --, it would have readily learned about the Complainant's mark. In that regard, the Complainant points to a duty imposed by the Respondent's registration agreement (see paragraph 2 of the agreement provided in Annex 2 to the Complaint) to investigate third-party trademark rights:

"By applying to register a domain name . . . you hereby represent and warrant to us that . . . (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party . . . ; and (d) you will not knowingly use the domain name in violation of any applicable laws. . . . It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights."

Given this duty, the Complainant contends that inasmuch as the Respondent had to have had prior knowledge of the Complainant's activities surrounding its DATAWINDOW Mark, the Respondent, acting, in spite of that knowledge, by having registered the contested domain name, exhibited bad faith registration.

Furthermore, the Complainant alleges that the arbitrary and fanciful qualities of Complainant's DATAWINDOW Mark strongly suggest that the Respondent did not independently arrive at the conclusion that <datawindow.net> would form a strong foundation for a domain name for an online business (even assuming that Respondent was using the domain name in commerce as opposed to simply "parking" it), because that domain name is not an obvious choice of name, apart from its obvious association with Complainant's long-established and famous business. This association is clearly reflected in the results of the Google searches which appear in Annexes 9 and 10 to the Complaint and could have easily been revealed by the Respondent had it undertaken such a simple search.

Hence, the Complainant concludes that the Respondent, in having registered the contested domain name with actual and/or constructive knowledge that it was identical to Complainant's registered trademark, registered and then used that name in bad faith.

Moreover, the fact that Respondent has simply "parked" the domain name and is not using it for any legitimate business purpose at all further evidences bad faith registration and use.

Lastly, the Complainant contends that, in response to Complainant's good faith effort to resolve the dispute short of arbitration, the Respondent made extortionate payment demands to the Complainant, in the amount of \$25,400 -- far in excess of the Respondent's out-of-pocket costs of registration, which in and of itself reflects further evidence of bad faith.

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 did not address, let alone contest, the issue as to whether the contested domain name was identical or confusingly similar to the Complainant's DATAWINDOW Mark.

As to the legitimacy and bad faith, the Respondent stated, as discussed above, that it purchased and intended to use the contested domain name to develop a commercial business segment. Furthermore, the Respondent stated that: it did not purchase the domain name to resell it, the name was not "parked" in the Internet and the Respondent had never offered the name for sale to anyone.

6. Discussion and Findings

A. Similarity

Without any hesitation whatsoever, the Panel finds that confusion is likely to arise as a result of the Respondent's use of the contested domain name.

No doubt exists that the contested domain name is identical to the Complainant's DATAWINDOW mark. The difference between the domain name and the corresponding mark is simply the inclusion of the generic top level domain ".net" within the name. This difference is utterly *de minimus* and certainly does not add sufficient distinguishing characteristics to the domain name to ameliorate any user confusion that will inevitably arise when the Respondent starts using the name with an operational website. See, e.g., *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Such confusion would undoubtedly cause Internet users intending to access Complainant's website, but who reach a website 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 would exist at all. See, e.g., *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA173362 (September 16, 2003); *Am. Family Life Assurance Company of Columbus v. defaultdata.com*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (September 11, 2002); *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 2002); *L.F.P., Inc. v. B and J Props.*, NAF Case No. FA 109697 (May 30, 2002); *Frampton v. Frampton Enters, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Servs. to Families and Children v. Wynman*, NAF Case No. FA 100492 (December 10, 2001); *MPL Communications v. LOVEARTH.net*, NAF Case No. FA 97086 (June 4, 2001); *Meijer, Inc. v. Porksandwich Web Servs.*, NAF Case No. FA 97186 (July 6, 2001); *MPL Communications v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Prot. Indus., Inc. v. The Webposters*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (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.*, NAF Case No. FA 95856 (December 18, 2000); and *The Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, eResolution Case No. AF-0145 (May 3, 2000).

Therefore, the Panel finds that the contested domain name <datawindow.net> sufficiently resembles the Complainant's DATAWINDOW Mark as to cause confusion;

hence, the Complainant has shown sufficient similarity between its registered mark and the contested domain name under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel believes that not only has the Respondent not provided any basis that would legitimize any claim it has to the contested domain name, but also it is extremely unlikely that the Respondent could ever make such a claim.

The simple reason is that the contested domain name contains the Complainant's DATAWINDOW Mark under which the Complainant provides its goods and services. Furthermore, the Complainant has never authorized the Respondent to utilize that mark or a mark confusingly similar thereto in conjunction with the specific goods and services which the Complainant provides under its DATAWINDOW Mark, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "DATAWINDOW" or a mark confusingly similar thereto, in connection with computer software or related goods and services would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, cited *supra*; *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *MPL Communications*, FA 97086 and FA 97092, cited *supra*; *Am. Online, Inc. v. Fu*, WIPO Case No. D2000-1374 (December 11, 2000); *Treeforms, Inc.*, cited *supra*.

Furthermore, given that the Respondent was actively involved as a consultant in the computer field, specifically by its own admission, in developing "decision support" and "business intelligence" systems, generally viewed as business applications, since 1984 -- which was the same year that the Complainant was founded --, and in view of the wide and expanding notoriety of the Complainant's activities since then, including developing and marketing its DataWindow technology, it simply stands to reason, and the Panel so believes, that the Respondent indeed had prior knowledge both of the Complainant's "DATAWINDOW" technology and the Complainant's use of that term as its mark well prior to having registered the contested domain name. This belief is heightened by two factors.

(a) The Complainant's technology could well serve as a platform or tool which the Respondent might very well advantageously employ in implementing one or more of its business applications. Consequently, in this Panel's mind, it seems eminently likely that the Respondent specifically investigated the Complainant's DATAWINDOW product and service offerings for such use at some point between its introduction in 1991 and before February 2002. Nevertheless, even if the Respondent did not do so, it still may well have gained prior knowledge of those offerings through various trade and other journals available to and directed at software development professionals -- which carried articles and/or advertisements for the Complainant's DATAWINDOW offerings (particularly since the latter was available for 11 years preceding registration of the contested domain name), or through professional conferences attended by those professionals sometime between 1991-2002 -- the latter would likely encompass both the Complainant as a potential exhibitor/supplier and the Respondent as a purchaser/developer. In either case, the Respondent likely gained prior knowledge of the term DATAWINDOW as used by the Complainant.

(b) Additionally, in its Response, the Respondent simply failed to address, let alone deny and persuasively rebut, the Complainant's allegation of its having possessed such prior knowledge.

Therefore, while the Complainant strenuously argues that the Respondent must have had either constructive or actual knowledge of the Complainant's registered mark when it registered the contested domain name, such knowledge is immaterial. The reason is simple: by February 2002, the Respondent was more than likely already familiar at least generally, if not more so, with the Complainant and its DATAWINDOW offerings.

Hence, it is clear to this Panel that the Respondent's actions in choosing the contested domain name, given its prior knowledge of the Complainant and its DATAWINDOW products and related services, reflects nothing more than exploitation of the Complainant's DATAWINDOW Mark for the Respondent's own pecuniary benefit that would very likely arise from inevitable Internet user confusion starting when the Respondent actually implements an operational website resolvable through that name. Such use by a respondent can never reflect rights or legitimate interests in a domain name.

Moreover, though the Respondent has clearly expended considerable time and effort since 2002 in developing its business segment, developing a business does not meet the requirement under paragraph 4(c)(i) of the Policy. What is required is that the Respondent show that, before it received notice of this dispute, it has engaged in "demonstrable preparations to use the domain name ... in connection with a bona fide offering of goods or services" [emphasis added]. The record is entirely devoid of any evidence that the Respondent made any such preparations to use the name. Hence, the Panel infers that the Respondent has simply not used the name at all and thus has passively held it since the date of its registration.

In light of the above findings, the Panel is not persuaded that the Respondent has any rights or legitimate interests or, based on current facts provided to the Panel, is ever 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.

C. Registered and Used in Bad Faith

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

As stated above and based on the record, it is established that the Respondent had prior knowledge of the Complainant's trademark. Furthermore, the Respondent has not used the domain name at all since its registration -- now approximately two and a half years ago -- but continues to retain it.

The lack of any operational website resolvable through that name constitutes passive holding. Quite a few panels, including this one, have held that, under appropriate circumstances, passive holding evidences bad faith use. Such circumstances, when viewed in their totality, exist here. See, e.g., *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 2002); *Am. Home Products Corporation vs. Malgioglio*, cited *supra*; *JVC Americas Corp. v. Damian Macafee*, CPR Case No.

CPR007 (November 10, 2000); *Pacific Investment Management Co. LLC v. Alex Szabo* NAF Case No. FA95614 (October 18, 2000); *National Australia Bank Limited v. Quality Systems Consulting -- QSC Pty Ltd.*, WIPO Case No. D2000-0765 (August 31, 2000); *Gonvarri Industrial, S.A. v. Gon Varr I An Sexo a Domicilio*, WIPO Case No. D2000-0637 (August 28, 2000); *Garage Records. Inc. v. Garage Records*, NAF Case No. FA95071 (August 17, 2000); *Dollar Financial Group, Inc. v. RXW Management*, NAF Case No. FA 95108 (August 4, 2000); *Lusomundo - Sociadada Gestora de Parcipacoes Sociais, S.A. and Lusomundo Audiovisuais, S.A. v. Inmo Soria and Andres Ceballos Moscoso*, WIPO Case No. D2000-0523 (August 2, 2000); *Valigene Corp. v. MIC*, NAF Case No. FA94860 (August 1, 2000); *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, NAF Case No. FA95095 (July 31, 2000); *Hewlett-Packard Co. v. High Performance Networks, Inc.*, NAF Case No. FA95083 (July 31, 2000); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. D2000-0400 (July 6, 2000); *August Storck KG v. Tony Mohamed*, WIPO Case No. D2000-0196 (May 3, 2000); *Recordati S.P.A. v. Domain Name Clearing Co.*, WIPO Case No. D2000-0194 (July 21, 2000); *Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau*, WIPO Case No. D2000-0172 (April 20, 2000); and *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (February 18, 2000).

Since the specific grounds set forth in paragraph 4(b) of the Policy are illustrative and non-exclusive and the Panel having found bad faith under the general prohibition of paragraph 4(a)(iii), the Panel sees no need to address any of the other grounds put forth by the Complainant and thus declines to do so.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a 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 <datawindow.net>, is ordered to be transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: June 24, 2004