



NATIONAL ARBITRATION FORUM

DECISION

DAVIS VISION, Inc. v. Demand Domains, Inc.
Claim Number: FA0802001142731

PARTIES

Complainant is **DAVIS VISION, Inc.** (“Complainant”), represented by **Bryce J. Maynard**, of **Buchanan Ingersoll & Rooney PC**, Virginia, USA. Respondent is **Demand Domains, Inc.** (“Respondent”), represented by **Christina G. Radocha**, of **Demand Domains, Inc.**, Washington, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**davisvison.com**>, registered with **Enom, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, 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 (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum (“Forum”) electronically on February 6, 2008; the Forum received a hard copy of the Complaint on February 7, 2008.

On February 7, 2008, Enom, Inc. confirmed by e-mail to the Forum that the <**davisvison.com**> domain name is registered with the Registrar and that Respondent is the current registrant of the name. The Registrar has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On February 14, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of March 5, 2008 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@davisvison.com by e-mail.

A timely Response was received by the Forum and determined to be complete on March 5, 2008. However, the Response was deemed deficient pursuant to ICANN Rule 5(b) since a hard copy of the Response was not received prior to the Response deadline. Nevertheless, since the electronic copy was timely received by the Forum, the Panel fully considered the Response.

On March 12, 2008, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a due date of March 26, 2008 to receive the decision from the Panel.

RELIEF SOUGHT

Complainant requests that the disputed domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant contends that the disputed domain name is not only confusingly similar but also virtually identical to its DAVISVISION mark inasmuch as the name merely omits the second letter "i" from that mark, thus constituting so-called typosquatting.

Hence, Complainant concludes that it has met the requirements of paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

Complainant contends, for any of various reasons, that Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

First, Complainant states that Respondent's use of the name in conjunction with its website, specifically resolved through that name, is not a *bona fide* use. In that regard, the site (a hard-copy printout of the home page of which appears in Exhibit 5 to the Complaint) depicts a series of links for categories such as "Laser Surgery," "Optometrists," and "Vision Insurance." These links direct Internet users to sub-pages (copies of which appear in Exhibits 6 and 7 to the Complaint) within the site which, in

turn, provide click-through links to third-party websites which advertise and sell optometry and vision insurance services. These links, when accessed by a consumer through that site, generate financial gain for Respondent and present vision insurance and related services which directly compete with those offered by Complainant under its DAVISVISION mark. Such offerings predicated on deceiving Internet users through typosquatting do not constitute a *bona fide* offering of goods or services, or a legitimate non-commercial or fair use of the disputed domain name.

Second, Complainant and its predecessors-in-interest have used its the DAVISVISION mark for over 15 years, thus precluding Respondent from becoming commonly known by that or a similar mark. Further, Complainant has neither authorized nor licensed Respondent to use or exploit Complainant's mark, to register the disputed name, or to otherwise associate itself with Complainant.

3. Bad faith use and registration

Complainant contends that Respondent has registered and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

Specifically, Complainant alleges that Respondent's purpose in registering the name, given that it is an intentional misspelling of Complainant's mark, is to create a likelihood of confusion with that mark and, by doing so, mislead and divert consumers, who otherwise seek Complainant's website, to Respondent's site instead and to Respondent's ultimate pecuniary benefit. In that regard, Respondent's site provides links to third-party vision insurance services which directly compete with vision insurance services that Complainant offers at its site and under its DAVISVISION mark. Respondent receives click-through income as a result of any visitor having clicked on any of those links.

B. Respondent

Respondent does not contest Complainant's allegations regarding: confusing similarity of the name to the mark, and Respondent's lack of rights and legitimate interests in the name.

As to bad faith, Respondent states that it had no knowledge of Complainant's registered mark when it assumed ownership of the name and continuously thereafter until the date it received the present Complaint. Further, Respondent has implemented its own policy through which it will return all domain names, which violate trademark rights, to their legitimate owners. In accordance with that policy, Respondent, through its corporate counsel repeatedly tried to contact Complainant's counsel, from February 13, 2008 through March 4, 2008, to arrange for the disputed domain name to be transferred to Complainant. Yet, in spite of these attempts, Respondent's counsel never received a response from Complainant's counsel. As a result, the transfer never occurred.

As such, Respondent contends that it did not register the name in bad faith, and its conduct in attempting, though ultimately unsuccessfully, to contact Complainant for purposes of arranging transfer of the name to Complainant actually manifested good faith.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit 4 to the Complaint. As indicated, the domain name was registered on June 5, 2002.

A. Complainant's DAVISVISION Mark

Complainant owns a United States trademark registration for the term "DAVISVISION," in stylized form and on which this dispute is based. Complainant has provided in Exhibit 1 a copy of its registration certificate for this mark, the pertinent details of which are as follows:

DAVISVISION (stylized)
United States registration 2,410,099; registered: December 5, 2000
filed: May 10, 1999

This mark is currently registered for use in connection with "administration of pre-paid health care plans namely vision care benefits programs provided to members of group and individual health care programs" in international class 36, and "optician and optometric services" in class 42. The registration certificate states that both first use and first use in commerce of the mark for the services in both of these classes commenced as of January 7, 1991.

B. Complainant and its activities

Complainant and its predecessors-in-interest have used its DAVISVISION mark without interruption since at least as early as 1991. Complainant prominently displays its DAVISVISION mark in its advertising and promotional materials and uses that mark to identify Complainant as the source of its vision insurance and related services. Complainant spends significant resources developing consumer awareness and goodwill by promoting its services under its mark.

Complainant currently owns the domain name <davisvision.com> and uses the website to which that name resolves to promote its various vision-related services. (a hard-copy printout of the home page to which that name resolves appears in Exhibit 2 to the Complaint).

C. Respondent and its activities

Respondent's website resolvable through the disputed domain name, <**davisvision.com**>, depicts a series of links for categories such as "Laser Surgery," "Optometrists," and "Vision Insurance." These links direct Internet users to sub-pages within that website, which provide click-through links to third-party websites through optometry and vision insurance services are advertised and sold that directly compete with Complainant's offerings made under its mark.

Respondent, being a domain name registrar, did not itself register the name but rather assumed ownership over it. Respondent has a policy in effect through which it will not hold domain names in derogation of rights then held by their legitimate holders.

Once Respondent received a copy on February 13, 2008 of the present Complaint which detailed Complainant's rights in its DAVISVISION mark -- of which rights Respondent had no prior knowledge, Respondent's counsel attempted to contact Complainant's counsel by e-mail in order to arrange for an immediate transfer of the name to Complainant. It received no response from Complainant's counsel. Subsequently, Respondent's counsel sent further e-mails on February 29 and March 4 to Complainant's counsel and left a voice mail message on February 29 for Complainant's counsel -- each seeking a reply in order to effectuate the transfer. No such reply ever occurred.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to Complainant's DAVISVISION mark.

The proper analysis under paragraph 4(a)(i) of the Policy simply focuses on comparing the disputed domain name, <**davisvison.com**>, to Complainant's DAVISVISION mark to assess the degree of similarity between the two and its likely potential to cause confusion of Internet users. *See AOL LLC v. Loto LLC*, FA 1075473 (Nat. Arb. Forum November 2, 2007).

From a simple comparison of the disputed domain name and the mark DAVISVISION, no doubt exists that the name is confusingly similar to that mark. The only differences between the name and that mark are the deletion of the second letter "I" from the mark and the appending of a gTLD (generic top-level domain) ".com" to the mark -- with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as illustratively adding or deletion or short letter or number groups or even addition of generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Deleting the letter "I" such that the term "DAVISVISION" becomes in the domain name "DAVISVISION" is clearly such a minor variation. *See AOL LLC, cited supra; F. Hoffmann-La Roche AG v. Transliner Consultants*, D2007-1359 (WIPO Nov. 14, 2007); *Nat'l Football League v. Blucher*, D2007-1064 (WIPO Sept. 24, 2007); *Tetris Holding, LLC v. Smashing Conceptions*, FA 1030720 (Nat. Arb. Forum Sept. 11, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, D2007-0952 (WIPO Aug. 27, 2007); *Associated Bank Corp. v. Tex. Int'l Prop. Assocs.*, D2007-0334 (WIPO June 28, 2007); *Gerber Childrenswear Inc. v. Webb*, D2007-0317 (WIPO Apr. 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, FA 791657 (Nat. Arb. Forum Nov. 13, 2006); *Google Inc. v. Burns*, FA 726096 (Nat. Arb. Forum Aug. 16, 2006); *Cheesecake Factory Inc. & The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, D2005-0766 (WIPO Sept. 12, 2005); *Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *Caesars Entm't Inc. v. Nova Internet Inc.*, D2005-0411 (WIPO June 22, 2005); *Lockheed Martin Corp. v. Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005); *Lockheed Martin Corp. v. Teramani*, D2004-0836 (WIPO Dec. 1, 2004); *Nat'l Collegiate Athletic Assoc. v. Brown*, D2004-0491 (WIPO Aug. 30, 2004); and *Lane-Labs USA, Inc. v. Powell Prods.*, FA 155896 (Nat. Arb. Forum July 1, 2003).

Therefore, the Panel finds that the disputed domain name <**davisvison.com**> is confusingly similar to Complainant's DAVISVISION mark as to cause confusion; hence, Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

Respondent has not provided any basis that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

No evidence exists of record that Complainant has ever authorized Respondent to utilize Complainant's DAVISVISION mark or any mark confusingly similar thereto, nor does Complainant have any relationship or association whatsoever with Respondent.

Consequently, any use to which Respondent were to put the DAVISVISION mark or one confusingly similar thereto in connection with identical or similar services to those currently provided by Complainant under its DAVISVISION mark -- as Respondent has in fact done so here -- would violate the exclusive federal trademark rights now residing in Complainant. In that regard, given the consumer recognition and goodwill which Complainant has acquired, through continuous use of its DAVISVISION mark for the past 17 years in conjunction with its vision insurance and related services sold under that mark and hence for the mark itself, the Panel believes that Internet users, who seek Complainant's website but encounter the disputed domain name and possibly through it reach Respondent's site instead, would reasonably think that a relationship or affiliation of some sort exists between Complainant and Respondent, when, in actuality, none exists at all. *See Nat'l Football League, Toilets.com, Inc., Associated Bank, Napster and Caesar's Entm't*, all cited *supra*; and *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, D2007-0303 (WIPO May 7, 2007); *Citgo Petroleum Corp. v. Antinore*, D2006-1576 (WIPO Mar. 14, 2007); *New Destiny Internet Group, LLC v. SouthNetworks*, D2005-0884 (WIPO Oct. 14, 2005); *Pelmorex Commc'ns Inc. v. weathernetwork*, D2004-0898 (WIPO Dec. 28, 2004); *Sybase, Inc. v. Analytical Sys.*, D2004-0360 (WIPO June 24, 2004); *Caesars World, Inc. & Park Place Entm't Corp. v. Japan Nippon*, D2003-0615 (WIPO Sept. 30, 2003); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); *MPL Commc'ns, Ltd. v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); and *Am. Online, Inc. v. Xianfeng Fu*, D2000-1374 (WIPO Dec. 11, 2000). Consequently, Respondent could not legally acquire any public association between it and the DAVISVISION mark or one similar thereto for the services rendered by Complainant or those that might be similar thereto. Hence, based on the evidence before the Panel, Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Further, there is absolutely no evidence of record that Respondent has ever been commonly known by the disputed domain name.

Moreover, since Respondent's use of the name is clearly commercial in nature, that use does not constitute either a legitimate noncommercial or fair use, and hence does not fall within paragraph 4(c)(iii) of the Policy. Further, since Respondent's use of the name

infringes Complainant's trademark rights, that use is not *bona fide* within paragraph 4(c)(i) of the Policy.

Accordingly, the Panel concludes that Respondent has no rights or legitimate interests in the disputed domain name within paragraphs 4(a)(ii) and 4(c) of the Policy.

Registration and Use in Bad Faith

Notwithstanding Respondent's beseeching to the contrary, the Panel finds that Respondent's actions constitute bad faith registration and use of the disputed domain name.

Though Respondent would like the Panel to narrowly focus its assessment as to whether Respondent's conduct amounted to bad faith solely from the perspective of its repeated offers to transfer the name, at no cost, to Complainant, those actions are not the only guidepost here by any means. This is not the conduct which provoked Complainant into filing its Complaint. Rather, that conduct -- which Complainant emphatically and clearly states in its Complaint but which Respondent completely ignores in its Response -- is Respondent's use of the name, which contains a confusingly similar version of Complainant's DAVISVISION mark, as an instrumentality to point Internet users to a website that itself provides links to third-party services directly competitive with Complainant's offerings made under its mark. This, in turn, causes confusion of Internet users from which Respondent benefits -- apparently through click-through revenue, while Complainant suffers by incurring injury to its mark and reputation.

Whereas the Panel notes that Respondent and Registrar have the same mailing address, the Panel infers that that Respondent, Demand Domains, Inc., is related to Registrar, eNom, Inc. -- though the exact nature of the relationship is not stated in the record. Hence, for purposes of analyzing bad faith, the Panel will treat both Respondent and the Registrar as a single entity and will collectively refer to both hereinafter simply as "Respondent-registrar eNom." Therefore, as a threshold matter, the question arises as to whether, under the Policy, registrars in general can be respondents and more specifically whether here Respondent Demand Domains, Inc. is a proper respondent.

Though the Policy, Rules and Supplemental Rules make no specific mention of encompassing registrars within their reach, one need only look at the registrar's conduct in any given situation.

Specifically, to begin, Supplemental Rule 1(d) defines a "Holder of a Domain Name Registration" as "the single person or entity listed in the WHOIS registration information at the time of the filing of the Complaint with the Forum; and once the registrar has verified registration, is limited to the single person or entity as verified by the registrar". This is the respondent against whom a complaint is filed by a complainant, the latter being defined in Supplemental Rule 1(e) as "the single person or entity claiming to have

rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint." Consequently, under Supplemental Rule 1(d), a respondent is the entity identified in the WHOIS registration information as the registrant of the name in question and is then so verified by the registrar.

If a registrar were solely acting as an agent of a third-party registrant in registering a domain name, then the registrar would not be the registrant of that name and hence would not a "Holder of a Domain Name Registration" and thus could not under Supplemental Rule 1(d) be a respondent in a UDRP action. Hence, an ICANN administrative panel would have no jurisdiction over alleged improprieties associated merely with its acts in registering names for others.

However, where a registrar's conduct with respect to a domain name expands beyond performing mere ministerial duties in accepting and implementing name registration for another into use by itself of the name, then its role changes from that of a mere registrar to that of an owner-user. Such a change, which in fact occurred here, exposes the registrar to the full force and effect of the Policy by virtue of the registrar having then become a "Holder of a Domain Name Registration" and then verified as such. Here, Registrar Enom satisfies both prongs of Supplemental Rule 1(d) and thus is a proper respondent. Importantly, see *Paxar Americas, Inc. v. eNom, Inc.*, FA 980114 (Nat. Arb. Forum June 22, 2007) which involved, before this very same Panel, the very same registrar, as here, Enom, Inc. There, the registrar-respondent eNom acquired a domain name <monarchmarking.com> previously registered by another which contained a complainant's registered mark, MONARCH. That name resolved to an operational website through which products were offered that directly competed with those then offered by complainant through its own web site. Even though registrar-respondent eNom, upon receipt of the complaint -- as here, unilaterally offered to transfer the domain name to complainant, as legitimate rights holder, it nevertheless -- as in the present case -- kept the website in operation. This Panelist found that conduct pierced whatever immunity registrar-respondent eNom would otherwise have enjoyed had it not taken on aspects of a domain name owner-user. Ultimately, this Panel found bad faith and ordered the name transferred to complainant. Also, see *Solutia, Inc. v. Sur Hosting*, FA 716391 (Nat. Arb. Forum Aug. 30, 2006) (finding that Sur Hosting is a proper respondent under Supplemental Rule 1(d)).

In spite of the earlier *Paxar Americas* decision which castigated the respondent-registrar's conduct -- of which its present conduct complained of here is for all intents and purposes no different, Respondent-registrar eNom continued exploiting domain names it has acquired as owner-user to the detriment of legitimate rights holders. Consequently, this Panel, rather than simply citing to its analysis in that decision, will, for the purpose of emphasizing its sharp disdain for the rather egregious conduct involved both here and there will repeat, verbatim, pertinent portions of that analysis which apply with equal vigor here, as follows, with the hope and expectation that Respondent-registrar

eNom, as well as all others similarly situated, will now finally and wisely heed the dictates of that decision and, avoid the cost, scrutiny and other potentially adverse consequences associated with repeatedly defending their actions in ICANN proceedings, by implementing appropriate and sufficient steps to immediately cease this conduct with respect to other domain names each of them currently owns and prevent its occurrence with respect to names each may acquire in the future.

In such instances where a registrar becomes an owner-user, no deference whatsoever is attributed to a registrar's coordinate role as being the actual registrar of the disputed name itself. The registrar faces the exact same scrutiny and liability under the Policy for its conduct as would any domain name registrant. If this were not the case, then domain name registrars could, with impunity under the Policy, register and use domain names in a manner that inflicts harm on legitimate rights holders. Such a result would lie directly contrary to the very goals of the Policy -- recognition and preference to the legitimate rights of trademark holders as against abusive domain name registration.

Even in situations, as here, where a registrar has laudably made and implemented policies and practices ostensibly, at least in theory, to protect the legitimate rights of those holders by returning, on demand and at no cost, to those holders names that infringe their rights, those policies and practices could be unilaterally ignored by the registrar whenever it desires, thus, in practice, frustrating their intent and rendering both a complete nullity to the ultimate detriment of those rights holders. Such a result would simply be indefensible and intolerable.

Respondent Enom argues that once the Complaint was filed, it was precluded from taking any action to transfer the disputed domain name to Complainant. While, under paragraph 8(a) of the Policy, this was indeed true, what existed to prevent it from taking suitable action to protect the rights of Complainant prior to that filing? As the record is completely silent on this point, the Panel infers that the answer is nothing. Specifically and illustratively, what prevented Respondent from immediately terminating the use of the name, once the initial registrant defaulted or shortly thereafter but in either case before the Complaint was filed, as an operative address to a web site through which ultimately products were offered that were competitive with those of Complainant, thus preventing any further user confusion and user direction to third-party sites? Again, the record is silent. Alternatively, what prevented Respondent, once the initial registrant defaulted, from simply canceling the registration and casting the disputed name back into the public domain rather than using it at all, let alone as it actually did? Here too, the record is silent. Again, the answer must be inferred as being nothing.

Thus, it stands to reason that Respondent Enom could have chosen not to exploit the name, but here, in furtherance of its own benefit whether pecuniary or otherwise, it did not do so and since it did not then it must fully accept all the risks associated with what it actually did -- one of those risks being exposure to the Policy. Therefore, Respondent Enom's actions, in using the name as it did to both cause user confusion and exploit that confusion for its own benefit, were both intentional and continuing, clearly evidencing bad faith under paragraph 4(b)(iv) of the Policy.

See also Nicholas V. Perricone, M.D. & N.V. Perricone LLC v. Compana LLC, NAF Case No. FA 825260 (Nat. Arb. Forum Dec. 16, 2006) for a similar situation involving a respondent-registrar though not involving Respondent-registrar Enom.

Hence, the Panel views Respondent-registrar Enom's actions, with respect to the disputed domain name, as constituting bad faith registration and use in violation of general paragraph 4(a)(iii) of the Policy and moreover paragraph 4(b)(iv) thereof.

Accordingly, the Panel concludes that 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.

Thus, the Panel concludes that 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.

DECISION

In accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the relief sought by Complainant is hereby **GRANTED**.

Accordingly, the Panel orders that the disputed domain name, <**davisvison.com**>, is to be **TRANSFERRED** from Respondent to Complainant.

Peter L. Michaelson, Esq., Panelist
Dated: March 26, 2008