



NATIONAL
ARBITRATION
FORUM

NATIONAL ARBITRATION FORUM

DECISION

Dell Inc. v. Innervision Web Solutions c/o Domain Registrar
Claim Number: FA0503000445601

PARTIES

Complainant is **Dell Inc.** (“Complainant”), represented by **Nathan J. Hole** of **Loeb & Loeb LLP**, 321 North Clark Street, Suite 2300, Chicago, IL 60610. Respondent is **Innervision Web Solutions c/o Domain Registrar** (“Respondent”), Old Bridge, NJ 08879.

REGISTRAR AND DISPUTED DOMAIN NAME

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

PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Carolyn M. Johnson, Peter L. Michaelson, and Tyrus R. Atkinson, Jr., as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on March 24, 2005; the National Arbitration Forum received a hard copy of the Complaint on March 28, 2005.

On March 25, 2005, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the domain name <**dellcomputerssuck.com**> is registered with Enom, Inc. and that the Respondent is the current registrant of the name. Enom, Inc. 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 ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On April 6, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of April 26, 2005 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@dellcomputerssuck.com by e-mail.

A timely Response was received and determined to be complete on April 26, 2005.

A timely Additional Submission was received from Complainant on April 29, 2005.

On May 9, 2005, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Carolyn M. Johnson, Peter L. Michaelson, and Tyrus R. Atkinson, Jr., as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

For over 20 years, Complainant Dell, Inc., f/k/a Dell Computer Corporation ("Dell") has marketed and sold computer systems and related products and services. In 1987, Dell adopted the corporate name "Dell Computer Corporation" and began using the DELL trademark. Over the years, Dell has invested heavily in marketing under its DELL marks, devoting hundreds of millions of dollars to advertising and promoting its products and services through many media in many countries. Because of Dell's marketing and sales success, Dell and its DELL marks have become famous in the United States and in other countries.

Dell owns, uses and has registered hundreds of domain names that contain Dell's DELL mark and/or its current and former trade names, including <dell.com>, <dellcomputer.com>, and <dellcomputers.com>. Complainant holds registered trademarks with the United States Patent and Trademark Office for the DELL trademark in various combinations dating back to 1987.

In February 2005, Dell learned that Respondent had registered and was using <dellcomputerssuck.com> ("Domain") to redirect Internet users to its website at <innervisionpc.com>. At its <innervisionpc.com> website, Respondent markets computer systems and related products and services, all in direct competition with Dell.

On March 11, 2005, Dell's outside counsel sent Respondent a letter objecting to its registration and use of the domain name and requesting that Respondent transfer the Domain to Dell. On March 14, 2005, Edward Ziejka, a representative of Respondent, called Dell's outside counsel and left a voicemail. In his voicemail, Ziejka stated, "if they want the domain, they can buy it from me." The following day Dell discovered that

Respondent had altered its use of the Domain. Respondent had made the Domain anew, clearly making it an artificial “gripe site” about “major computer manufacturers.”

The Domain is clearly confusingly similar to Dell’s Marks and names. The Domain completely subsumes Dell’s famous DELL and DELL.COM trademarks.

Respondent competes directly with Dell in the market of computer systems. Respondent registered the Domain on April 1, 2004 and, until recently, used the Domain to solely redirect Internet users to its own, competing website. Respondent did not, at any time before it received notice of this dispute, use the Domain in connection with a bona fide offering of goods or services. Respondent is not currently known, and has not been known by the Domain name. Respondent has not made a legitimate noncommercial or fair use of the Domain. Respondent’s use of the Domain was commercial and Respondent’s conversion to a purportedly non-commercial “gripe site” after being contacted by Complainant’s counsel is an implicit admission of its previous wrongful conduct. Respondent has no rights and legitimate interests in the Domain name.

Respondent had actual knowledge of Complainant’s Marks and names when it registered the Domain. In addition, Respondent used the Domain in bad faith, redirecting users to its own, competing website.

B. Respondent

The domain name registered by Respondent, **<dellcomputerssuck.com>**, is not identical and/or confusingly similar to Complainant’s trademarks. Respondent takes the position that the addition of the term “sucks” in the domain name eliminates the possibility of confusion. Respondent further contends that if his domain name were confusingly similar to Complainant’s mark then his domain name would be ranked near or above Complainant’s trademarked domain names on the most popular Internet search engines, but actually, it is not.

Respondent claims that he has rights and legitimate interests to the domain name **<dellcomputerssuck.com>**. Respondent claims that he is making legitimate, noncommercial, and fair use of the domain name to express criticism and commentary pursuant to his First Amendment rights, primarily the right of free speech. Respondent claims the domain was temporarily pointed towards **<innervisionpc.com>** for testing purposes only from the day it was registered on 2004-04-01 as Complainant allegedly claims as bad faith. Therefore it was not registered to solely redirect Internet users to its own site or it would have been in place from the day its was registered. Respondent claims that his protest site is in no way a sham.

Respondent is not a competitor of Complainant. Respondent operates a very small home-based business whose primary function is computer repair of all brand computers. The website that promotes computer sales has never in its existence made a single sale of a computer system. Respondent claims that the domain name is not used for commercial gain nor has it generated any kind of commercial or personal gain. Respondent is not

using the domain or protest site to divert business from Complainant's business. Respondent claims that <dellcomputerssuck.com> was not registered in bad faith and is not being used in bad faith. Respondent claims that he did not register the domain name with the intent to profit therefrom.

C. Additional Submissions

Complainant's Additional Submission.

Whether Respondent is a competitor of Dell's is to be determined not by sales volume, but by the types of goods and services he offers for sale. Respondent does not deny that he offers computer systems for sale or that his computer systems compete with Dell's.

Respondent's contention that the domain was directed for testing purposes is untrue. The Internet Archive Wayback Machine, demonstrates that on several dates from registration until notification of this dispute, Respondent redirected the domain to Respondent's website <innervisionpc.com>.

After filing this Complaint, Dell learned that Respondent has registered other domain names containing Dell's trademarks. Respondent registered <dudedellsucks.com> and <mydellsucks.com>. Moreover, the evidence suggests that Respondent also used <dudesellsucks.com> to direct consumers to the commercial and competing <innervisionpc.com>.

Respondent's Additional Submission.

Respondent does not own the infrastructure required to compete with Complainant and offers different services. The website at <dellcomputerssuck.com> was directed to <innervisionpc.com> for testing purposes but Respondent forgot it and continued to direct itself there until the Respondent was notified by a threatening letter from Complainant.

The domain name, <mydellsucks.com>, was never pointed at any competing commercial website. The domain <dudedellsucks.com> was registered to be used for the gripe site long before Complainant filed its Complaint. The remaining allegations contained in Respondent's Additional Submission are irrelevant to any issue in this proceeding.

Respondent's Letter to the Forum

Respondent states that his business is to buy and sell domains. Respondent claims that his business is being damaged by this proceeding and states, "(W)hen someone wants something someone else owns he or she purchases it, not try's and strong arm them to get it."

FINDINGS

1. Complainant is a major seller of computer systems and related products and has held trademark registrations with the United States Patent and Trademark Office for the trademarks and service marks for DELL (registered in 1990) and DELL.COM (registered in 2000).
2. Respondent is an individual who operates a home-based business engaged primarily in the repair of computer systems. Respondent also advertises computer systems for sale on the Internet, designs web sites, and buys and sells domain names.
3. On April 1, 2004, Respondent registered the domain name, **<dellcomputerssuck.com>**.
4. In February 2005, Complainant learned that Respondent had registered **<dellcomputerssuck.com>**.
5. On March 11, 2005, Complainant sent a cease and desist letter to Respondent.
6. Respondent responded to the cease and desist letter by voice mail stating that Complainant could buy the domain name. No further communications were had between the parties.
7. From the date of registration until the date of the cease and desist letter, the domain name directed Internet traffic to Respondent's web site at <innervisionpc.com> which offered computer systems for sale.
8. After receipt of the cease and desist letter, Respondent changed the content of the web site to one that featured commentary on Complainant and other computer companies. Respondent's contention that he is making a legitimate, noncommercial, and fair use of the domain name to express criticism and commentary pursuant to his rights of free speech is an insufficient defense in this case.
9. Respondent's domain name, **<dellcomputerssuck.com>** is confusingly similar to Complainant's mark, DELL.
10. Respondent has no rights to or legitimate interests in respect to the domain name **<dellcomputerssuck.com>**.
11. Respondent registered and used the domain name in bad faith.
12. The **<dellcomputerssuck.com>** domain name should be transferred to Complainant.

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

Complainant must prove that it has rights in a trademark or service mark to which the disputed domain name is identical or confusingly similar. Complainant proves that it has rights in the trademark and service mark, DELL, as a result of Complainant's registrations with the United States Patent and Trademark Office, which predate the registration of the disputed domain name. *See Men's Wearhouse, Inc. v. Wick*, FA117861 (Nat. Arb. Forum Sept. 16, 2002) (holding that under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning); *see also Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (finding that Panel decisions have held that registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting the presumption).

Complainant argues that the domain name registered by Respondent is confusingly similar to Complainant's DELL mark, because the domain name contains Complainant's mark in its entirety, adding only the generic or descriptive terms "computers" and "suck." Respondent argues that adding the term "suck" to the domain name eliminates the possibility of confusion.

Respondent is correct in stating that Panels have decided that the addition of the word "sucks" to another's mark eliminates the possibility of confusion. *See Lockheed Martin Corp. v. Parisi*, D2000-1050 (WIPO Jan. 26, 2001); *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, D2000-1104 (WIPO Nov. 23, 2000). Other Panels have reached the opposite result. *See Vivendi Universal v. Sallen*, D2001-1121 (WIPO Nov. 7, 2001); *Direct Line Group Ltd & Ors v. Purge LT, Ltd.* D2000-0583 (WIPO Aug. 13, 2000). The conflict in decisions was recognized in *ADT Services-AF v. ADT Sucks.com*, D2001-0213 (WIPO Apr. 23, 2001), wherein it was stated that since no appellate tribunal exists, the division will endure under the Policy. The Panel suggested that the "sucks" addition might be viewed more often by panels as not confusingly similar when used as a domain name in a fair use and noncommercial context as opposed to a domain name used in a commercial context. The *ADT Services* case involved a domain name containing the word "sucks" used to direct Internet users to a web site utilized for commercial gain. The Panel adopted the reasoning contained in *Direct Line Group Ltd & Ors v. Purge LT*, in which case the Panel compared *Direct Line* with <directlinesucks.com>. The Panel observed,

The first and immediately striking element to the Domain Name is the Complainants' name and adoption of it in the Domain Name is inherently likely to lead some people to believe that the Complainants are connected with it. Some will treat the additional "sucks" as a pejorative exclamation and therefore dissociate it after all from the Complainants; but equally, others may be unable to give it any very definite meaning and will be confused about the potential association with the Complainants. The

Complainants have accordingly made out the first element in its Complaint.

Based upon this reasoning, the Panel in the *ADT Services* case found that ADT and <adtsucks.com> were confusingly similar.

The majority of domain name decisions favor finding that the “sucks” addition does not defeat a finding of confusing similarity. In a minority of decisions, Panelists have deemed a “sucks” addition to a well-known trademark to be an obvious indication that the domain name is not affiliated with the trademark owner. Each case should be considered on its merits and not automatically accept any prior rule. See *Wachovia Corporation v. Alton Flanders*, D2003-0556 (WIPO Sept. 19, 2003) (finding <wachoviasucks.com>, <wachovia-sucks.com>, and <wachoviabanksucks.com> domain names confusingly similar to the trademark Wachovia).

Both parties in this case agree that the domain name, <dellcomputerssuck.com>, was directed to a commercial web site at <innervisionpc.com>. This web site advertised computer systems for sale by Respondent. Under the facts and circumstances of this case the Panel rejects Respondent’s contention that the addition of the word “sucks” prevents a finding of confusing similarity.

The disputed domain name in this case consists of Complainant’s mark, DELL, to which have been added the word “computers” and the word “sucks”. Adding a generic term such as “computers” to a mark does not justify not finding confusing similarity, particularly when the added term has an obvious relationship with Complainant’s business. See *Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000). Here, the addition of the word “sucks” constitutes nothing more than the addition of a generic word to the mark that does not prohibit a finding of confusing similarity. See *Arthur Guinness Son & Co (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001); see also *Vivendi Universal v. Sallen*, D2001-1121 (WIPO Nov 7, 2001).

The addition of the generic top-level domain “.com” is irrelevant to determining the element of confusing similarity. See *Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000).

Under the facts and circumstances present in this case, the Panel finds that <dellcomputerssuck.com> is confusingly similar to the Complainant’s DELL mark. Finding confusing similarity in “sucks” cases does not abridge the rights of legitimate protest sites because such sites are adequately protected by the second and third elements of the Policy. See *Wachovia Corporation v. Alton Flanders*, supra; See also *Koninklijke Philips Electronics N.V. v. In Seo Kim*, D2001-1195 (WIPO Nov. 12,2001).

Complainant prevails under Policy ¶ 4(a)(i).

Rights or Legitimate Interests

When a complainant alleges and puts forth proof that respondent has no rights or legitimate interests in the disputed domain name, the Policy invites the respondent to demonstrate his rights to and legitimate interests in the domain name. *See Policy* ¶ 4(c). Panels have taken this invitation as a burden shifting provision which requires a respondent to establish rights or legitimate interests in the domain name by coming forward with concrete evidence rebutting Complainant's assertions because the information is uniquely within the knowledge and control of the respondent. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002); *see also Do The Hustle LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000).

Respondent contends that he has rights to and legitimate interests in the domain name because "he is making legitimate, noncommercial, and fair use of the domain name to express criticism and commentary pursuant to his First Amendment Rights, primarily the Right of Free Speech. It is not uncommon for citizens to make use of protest sites to express their displeasure with a particular entity." Both parties agree that the site at <**dellcomputerssuck.com**> presently contains material that could be considered a commentary site used in a noncommercial and fair use of the domain name. Respondent's difficulty is that the domain name was directed to his commercial web site from the time of registration until after receiving the cease and desist letter from Complainant's legal counsel.

Prior to notice of the dispute, Respondent was not making a bona fide offering of goods or services. The <**dellcomputerssuck.com**> domain name diverted Internet users to Respondent's website at the <innervisionpc.com> domain name where Respondent markets computer systems and related products and services that are in direct competition with Complainant. Respondent's use of the disputed domain name to redirect Internet users searching for Complainant to Respondent's competing web site is not a use in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use pursuant to Policy, ¶ 4(c)(i) or ¶ 4 (c)(iii). *See Computerized Sec. Sys, Inc. v. Hu*, FA157321 (Nat. Arb. Forum June 23, 2003) (holding that Respondent's appropriation of Complainant's mark to market products that compete with Complainant's goods does not constitute a bona fide offering of goods and services); *see also Clear Channel Communications, Inc. v. Beaty Enders*, FA135008 (Nat. Arb. Forum Jan. 2, 2003) (finding that Respondent, as a competitor of Complainant, had no rights or legitimate interests in a domain name that utilized Complainant's mark for its competing website); *see also Avery Dennison Corp. v. Steele*, FA133626 (Nat. Arb. Forum Jan. 10, 2003) (finding that Respondent had no rights or legitimate interests in the disputed domain name where it used Complainant's mark, without authorization, to attract Internet users to its business, which competed with Complainant).

Respondent's contention that he was making a legitimate noncommercial or fair use of the domain name without intent for commercial gain, as a "protest site" is untenable. Respondent directed Internet users to his commercial website until the cease and desist

letter was served upon him. Respondent must have operated the website “without intent for commercial gain” to qualify under Policy ¶ 4(c)(iii). Respondent operated the website at <innervisionpc.com> for commercial gain. Directing Internet users to that site from <dellcomputerssuck.com> was a commercial exercise.

The recent decision in *Wachovia Corp. v. Flanders*, D2003-0596 (WIPO Sept. 19, 2003) dealt with a similar factual situation. The Panel stated as follows:

“The domain names at issue here do not point to a protest site. In the previous UDRP cases which have found legitimate interests based on the right of free speech and the fair use doctrine, the domain name has been linked to a ‘complaint’ web site...Such is not the case here, Here Respondent’s <wachoviasucks.com> <wachovia-sucks.com> and <wachoviabanksucks.com> domain names point to competitive financial products and services. Simply having a domain name with “-sucks” in the name cannot, by itself, establish fair use; one must look to the content of the website to determine if there is an exercise of free speech which allows the Respondent to rely on the fair use exception. To do otherwise would legitimize cybersquatters, who intentionally redirect traffic from a famous mark simply through the use of a derogatory term.”

The Panel finds that Respondent has no rights to or legitimate interests in the domain name <dellcomputerssuck.com>.

There is no evidence to suggest that Respondent is commonly known by the <dellcomputerssuck.com> domain name pursuant to Policy ¶ 4(c)(ii). *See RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (requiring a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail).

Complainant prevails under Policy ¶ 4 (a)(ii).

Registration and Use in Bad Faith

Complainant was fully aware of Complainant’s famous DELL mark at the time of registering the disputed domain name. That is precisely why Respondent chose the domain name. Respondent is in the computer business and buys and sells domain names. Respondent knew, or should have known, of the deception and confusion that would inevitably follow if Respondent used the domain name. This factual situation constitutes bad faith registration. *See Reuters Ltd. v. Teletrust IPR Ltd.* D2000-0471 (WIPO Sept. 8, 2000); *see also Samsonite Corp. v. Colony Holding*, FA94313 (Nat. Arb. Forum Apr. 177, 2000) (holding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration); *see also Orange Glo Int’l v. Blume*, FA 118313 (Nat. Arb. Forum Oct. 4, 2002); *see also Lifetouch, Inc. v. Fox Photographics*, FA 414667 (Nat. Arb. Forum Mar. 21, 2005).

The Panel could easily infer that Respondent registered the disputed domain for the purpose of selling the domain name to Complainant. Respondent states that he is a buyer and seller of domain names. His answer to the cease and desist letter was to state “if they want the domain, they can buy it from me.” The Respondent’s actions in registering the disputed domain name with an intent to then sell it at a profit to the Complainant is specifically condemned in the Policy. *See Policy* ¶ 4(b)(i).

There is a pattern to Respondent’s conduct. In addition to <**dellcomputerssuck.com**>, Respondent registered <mydellsucks.com> and <dudedellsucks.com>. In *ADT Services AG v. ADT Sucks.com*, D2001-0213 (WIPO Apr. 23, 2001) the panel held: “The Panel has no difficulty in finding bad faith registration... Respondent has shown a cynical pattern of dealing in domain names with apparent attempt to embarrass the owners of internationally known marks.”

As to the use made of the disputed domain name, Respondent has used the <**dellcomputerssuck.com**> domain name to divert Internet users searching for Complainant’s DELL products and services to Respondent’s website that offers competing computer products and services. Under Policy ¶ 4(b)(iv), this is evidence that Respondent registered and used the domain name in bad faith to attempt to divert Internet users for commercial gain by attracting users to Respondent’s website through a likelihood of confusion with Complainant’s DELL mark. *See Computerized Sec., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) (finding respondent’s use of the <saflock.com> domain name to offer goods competing with Complainant’s illustrates Respondent’s bad faith registration and use of the domain name); *see also Busy Body, Inc. v. Fitness Outlet, Inc.* D2000-0127 (WIPO Apr. 22, 2000) (finding bad faith where Respondent attempted to attract customers to its website and created confusion by offering similar products for sale as Complainant).

The registration and use of “sucks” domain names, when operated for commercial gain, is evidence that the domain name was registered and used in bad faith. In *Caixa d’ Estalvis y Pensions de Barcelona (La Caixa) v. Namezero.com*, D2001-0360 (WIPO May 3, 2001), the panel stated: “The general principle taught by precedents seems to be that, when a –SUCKS domain name has been registered for the main purpose of making money, it has been registered in bad faith.” *See also Wal-Mart Stores, Inc. v. Walsucks*, D2000-0477 (WIPO July 20, 2000) (finding bad faith where respondent was intentionally using <walmartcanadasucks.com>, <walmartuksucks.com>, and <walmartpuertoricosucks.com> domain names to attract Internet users to his website).

The Panel finds that under the facts and circumstances of this case, Complainant must prevail under Policy ¶ 4(a)(iii).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**dellcomputerssuck.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Carolyn M. Johnson, Peter L. Michaelson and Tyrus R. Atkinson, Jr., Panelists.
Tyrus R. Atkinson, Jr. Panel Chair, for the Panel
Dated: May 23, 2005

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