



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Deveraux Deloitte v. Bao Shui Chen**

**Case No. D2007-1160**

#### **1. The Parties**

Complainant is Deveraux Deloitte, Nottingham, United Kingdom of Great Britain and Northern Ireland, represented internally.

Respondent is Bao Shui Chen, Shanghai, China.

#### **2. The Disputed Domain Name and Registrar**

The disputed domain name <deverauxdeloitte.com> is registered with DROPHUB.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 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”) on-line on August 3, 2007, and in hard copy form, along with accompanying Annexes 1-8, on August 14, 2007.

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-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on August 7, 2007, the Center requested confirmation from the Registrar *inter alia* as to the contact and registrant information as well as information on the domain name registration.

Subsequently, through separate messages provided on August 8 and 17, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIS database and confirmed that the Respondent is listed as the registrant for the name. The Registrar also indicated that the domain name will remain locked during the pendency of this proceeding.

In response to a Complaint Deficiency Notification issued by the Center on August 20, 2007, the Complainant filed an amendment to the complaint on August 24, 2007. Henceforth, the term "Complaint" will refer to the complaint, as amended.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On August 28, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Annexes, by both courier and, without the Annexes, by email. 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 August 28, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, 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 September 17, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of September 17, 2007, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter dated September 18, 2007, notified the Respondent of his default.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated October 5, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on October 8, 2007, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated October 10, 2007, 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 October 24, 2007.

This dispute concerns one domain name, specifically: <deverauxdeloitte.com>.

The language of this proceeding is English.

#### **4. Factual Background**

A copy of the WhoIS registration record for the disputed domain name appears in Annex A to the Complaint. As indicated on this record, the disputed domain name was registered on June 14, 2007.

The Complainant does not have a registered trademark for the term “Deveraux Deloitte”. However, the Complainant, having used the trade name “Deveraux and Deloitte” as its mark over the past 4 years in connection with its service offerings, claims common law trademark rights in that name.

Specifically, for the past 4 years, the Complainant has sold and continues to sell research-based goods and services to the general public under its trade name “Deveraux and Deloitte” and via its Internet website at “www.deverauxdeloitte.co.uk”. A hard-copy print out of the Complainant’s home page at that site appears in Annex 3 to the Complaint. Further, in Annex 4 to the Complaint and as evidence of the Complainant’s use of its mark, the Complainant has provided a copy of a screen shot of the results of a Google search which the Complainant performed on the name “Deveraux and Deloitte” which include, amongst those results, an entry for the Complainant under that trade name.

According to the Complainant, through negligence of its prior registrar, the disputed domain name, apparently originally belonging to the Complainant, was ultimately acquired by the Respondent.

Through a series of e-mail messages (a copy of all of which appears in Annex 7 to the Complaint) between Mr. Barclay Littlewood, Director of the Complainant, and the Respondent on July 11, 2007, the Complainant initially demanded transfer of the disputed domain name as it included the Complainant’s mark and offered to reimburse the Respondent’s costs of registration; to which the Respondent countered with an offer to sell the name to the Complainant for US \$ 5,000,- which the Complainant rejected. Through further messages on that date, eventually, the Respondent reduced its offer to \$ 500,- which the Complainant also rejected. There is no evidence in the record that the Respondent made any use of the disputed domain name until after this exchange of messages ended when the Respondent apparently established a website to which the name resolved, on which he posted, at his home page, the textual message “Sorry company filed for bankruptcy and has no money” together with an obscene image (a hard-copy screen-shot of this page appears in Annex 8 to the Response).

#### **5. Parties’ Contentions**

##### **A. Complainant**

**(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name, <deverauxdeloitte.com>, is confusingly similar to the Complainant's DEVERAUX AND DELOITTE mark.

The Complainant, though without explicitly stating, ostensibly contends that the only differences between the name and the mark is that the former does not contain the conjunction "and" but does include a generic top level domain (".com"), both of which are insufficient to adequately distinguish the name from the mark and thus preclude confusion of Internet users.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

**(ii) Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, there is no evidence that the Respondent ever operated a service under the name "Deveraux Deloitte" or similar. Second, the Respondent is not commonly known by that name, and is not making any legitimate or fair use of that name.

**(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, the Complainant states that the Respondent, being a well known "domain squatter" (see *SmithKline Beecham PLC v. Chen Bao Shui*, NAF Case No. FA989685 (June 28, 2007) and *Dillard's, Inc., Dillard's International, Inc. v. Chen Bao Shui*, WIPO Case No. D2007-0520 (May 31, 2007)), has registered the name to blackmail the Complainant. This is evidenced by the Respondent's admission that he registered the name (as indicated in the e-mail exchange in Annex 7 to the Complaint) because he liked it and then, in response to the Complainant's request to transfer it, offered to sell it for as much as US \$ 5,000, – a sum exceeding his cost of registration. Moreover, the Respondent, once the Complainant rebuffed his offers, acted to intentionally disrupt the Complainant's business by posting a false textual message together with an obscene image to the home page of the Respondent's website to which the disputed domain name then resolved.

**B. Respondent**

The Respondent failed to file any Response to the allegations raised in the Complaint.

**6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

## A. Identical or Confusingly Similar

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

From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, confusingly similar to that mark. The only differences between the name and that mark are the deletion of the conjunctive word "and" 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 adding a short letter or number groups or even 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 confusion. The same is correlatively true for minor deletions. In this case, deleting the word "and" from the mark to form the domain name is clearly such a minor variation. See, e.g., *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA155896 (July 1, 2003).

Furthermore, as a general matter, the Policy does not contain any restriction whatsoever that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with applicable national trademark law. Inasmuch as use of the disputed domain name reaches and affects US commerce, then the Panel will apply US law here. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

Consequently, numerous panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and*

*Sciences v. Fantastic Sites, Inc.*, NAF Case No. FA95560 (November 2, 2000) held: “ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy.” See, e.g., *Utada Hikaru v. Leonard Meng Lee*, WIPO Case No. D2007-0366 (May 25, 2007); *Utada Hikaru v. Taylor Domains*, WIPO Case No. D2007-0367 (May 25, 2007); *Maria Bartiromo v. “Maria Bartiromo” and Dave Walton*, WIPO Case No. D2007-0242 (April 11, 2007); *Animals for Advertising, Inc. v. Cathryn Long*, WIPO Case No. D2007-0049 (March 30, 2007); *William M. Krings v. Hugo Hernandez*, WIPO Case No. D2006-0237 (April 18, 2006); *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a “Nelly” v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, NAF Case No. FA96795 (May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, NAF Case No. FA95825 (November 20, 2000); *Mike Warner 2001 v. Mike Larson*, NAF Case No. FA95746 (November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, NAF Case No. FA95641 (November 8, 2000); *Home Properties v. SMSOnline*, NAF Case No. FA95639 (November 2, 2000); and *Bridal Rings Company v. Yemenian*, NAF Case No. FA95608 (October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, NAF Case No. FA95757 (November 27, 2000), held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, eResolution Case No. AF-0536 (December 11, 2000), the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, NAF Case No. FA95970 (December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, NAF Case No. FA95832 (November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

Given that common law trademark rights in the United States suffice for purposes of invoking paragraph 4(a)(i) of the Policy, the inquiry shifts to whether the Complainant had acquired common law trademark rights in its trade name “Deveraux and Deloitte”.

Though the record is devoid of evidence that independently corroborates the Complainant’s claim that it has used its trade name for the prior 4 years in conjunction with its goods and services -- the Google search results in this case being inadequate to do so, and, as a result, acquired common law trademark rights in that name, nevertheless, the Panel, by virtue of the Respondent’s failure to file any response, accepts this claim as undisputed and thus infers that such rights do in fact exist.

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

## **B. Rights or Legitimate Interests**

By virtue of its default, the 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.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name, or is using the name in any legitimate non-commercial or fair use basis.

Further, no evidence exists of record that the Complainant has ever authorized the Respondent to utilize its DEVERAUX AND DELOITTE mark or any mark confusingly similar thereto in conjunction with research-based goods and services which the Complainant provides under its mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark or one confusingly similar thereto, in connection with the goods or services identical or similar to those currently provided by the Complainant would violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Toilets.com, Inc. and Associated Bank*, both cited *supra*; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *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*, NAF Case No. FA173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA97092 (June 4, 2001); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000). Consequently, the Respondent could not legally acquire any public association between it and the mark DEVERAUX AND DELOITTE or one similar thereto, at least for the goods or services rendered by the Complainant or those similar thereto. Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and specifically any applicable provisions of paragraph 4(c) 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 disputed domain name.

First, the Respondent offered to sell the disputed domain name to the Complainant for a sum, here being as much as US \$ 5,000,— which is certainly well in excess of the Respondent's costs of registration.

Second, once Complainant rejected the Respondent's offers, the Respondent posted a knowingly false message, to the effect that the Complainant has filed for bankruptcy, together with an obscene image on the home page of his website. The Panel infers that

the Respondent's primary intent in doing so was to strongly and unquestionably deter Internet users, who through use of the disputed domain name sought to reach the Complainant's website, from contacting and/or further transacting with the Complainant. Clearly, the Respondent's conduct was designed to intentionally disrupt the Complainant's business. From the lack of any response, the Panel infers that the Respondent, from the time he registered the name, had intended to eventually engage in such conduct when and if all his offers of sale were ultimately refused – as indeed they were here.

These acts undeniably constitute bad faith in violation of paragraphs 4(b)(i) and 4(b)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, 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 grants the relief sought by the Complainant.

The disputed domain name, <deverauxdeloitte.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: October 24, 2007