



L.F.P., Inc v. B and J Properties
Claim Number: FA0204000109697

PARTIES

The Complainant is **L.F.P., Inc.**, Beverly Hills, CA (“Complainant”) represented by **Paul J. Cambria, of Lipsitz, Green, Fahringer, Roll, Salisbury & Cambria, LLP.** The Respondent is **B and J Properties**, Las Vegas, NV (“Respondent”).

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**hustlerstore.com**>, registered with **Melbourne IT**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his 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 <http://www.icann.org/services/udrp/udrp-policy-24oct99.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”).

The Complainant submitted a Complaint, together with Exhibits A-I, to the National Arbitration Forum (“the Forum”) electronically on April 12, 2002; the Forum received a hard copy of the Complaint on April 15, 2002.

On April 15, 2002, Melbourne IT confirmed by e-mail to the Forum that the domain name <**hustlerstore.com**> is registered with Melbourne IT and that the Respondent is the current registrant of the name. Melbourne IT has verified that Respondent is bound by the Melbourne IT 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 16, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 6, 2002 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@hustlerstore.com by e-mail.

A timely Response was received and determined to be complete on May 6, 2002.

In accordance with paragraph 7 of the Supplemental Rules, the Complainant timely filed an additional submission, specifically a Reply, on May 13, 2002 with the Forum.

On May 16, 2002, pursuant to the 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 May 30, 2002 to receive the decision from the Panel.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identicality

The Complainant contends that the disputed domain name is confusingly similar to Complainant's "HUSTLER" marks. Specifically, the Complainant states that the disputed domain name incorporates the Complainant's mark "HUSTLER" in its entirety combined with a generic word "store".

Hence, the Complainant concludes that the requirements of paragraph 4(a)(i) of the Policy are satisfied.

2. Rights and legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

In that regard, the Complainant states that the Respondent has no connection or affiliation with Complainant, and has not received any license, authorization or consent, express or implied, to use the Complainant's "HUSTLER" mark in a domain name or in any other manner. Hence, the Complainant concludes that there is no plausible circumstance under

which the Respondent could legitimately use Complainant's "HUSTLER" mark, ostensibly even as part of the disputed domain name

Further, the Complainant states that there is no operational web site resolvable through the disputed domain name and, in that regard, the Respondent has not made any preparations to use the domain name for any legitimate purpose, or made a *bona fide* offering of goods or services through that name.

In addition, the Complainant contends that the Respondent is not commonly known by the disputed domain name, and that the Respondent is not making any legitimate non-commercial or fair use (or, indeed, any use at all) of the disputed domain name.

Thus, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

3. Bad faith use and registration

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith.

First, the Complainant states that since the date, February 11, 2000, on which the Respondent registered the disputed domain name, there is no indication, now for more than two years hence, that the Respondent made any actual use or contemplates making any use of the disputed domain name.

Further, the Complainant contends that the Respondent registered the disputed domain name in the speculative hope that the Complainant -- as the owner of the mark "HUSTLER", or a third party, would seek to purchase that name from the Respondent for an amount that exceeds the Complainant's out-of-pocket costs for having registered that name. In that regard, the Complainant takes the position that there is no plausible situation in which the Respondent would have been unaware of Complainant's "HUSTLER" marks at the time the Respondent registered the disputed domain name.

Consequently, the Complainant concludes that the Respondent's activities demonstrate bad faith use and registration of the disputed domain name pursuant to paragraph 4(a)(iii) of the Policy.

B. Respondent

1. Confusing similarity/identicality

The Respondent takes the position that the disputed domain name is not confusingly similar to the Complainant's "HUSTLER" mark because the Respondent will not market or sell goods similar to those marketed and sold by the Complainant under its mark.

Specifically, the Respondent, as indicated by apparently a letter signed by a third party, Robert Hiegel, intended to market a furniture line, on-line through the disputed domain name, "that caters to those who live a twenty-four hour lifestyle".

Further, the Respondent states that she has registered the disputed domain name on February 11, 2000 which is before the February 15, 2000 date on which the Complainant's mark "HUSTLERHOLLYWOOD" was itself registered (by the United States Patent and Trademark Office -- PTO).

Additionally, the Respondent states that the mark "HUSTLER" is "owned by a variety of people marketing a variety of retail goods, from lawn mowers to machine propellers, etc. There are also trademarks with a combination of words which include the term 'hustler'. Others have registered the HUSTLER trademark long before L.F.P., INC."

The Respondent further states that "[t]he term hustler is a generic word having its own definition in the English language and does not necessarily have to stand for L.F.P., INC."

Hence, the Respondent appears to contend that the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

The Respondent contends that she has a legitimate interest in the disputed domain name, hence negating the Complainant's assertion that she has no rights or legitimate interest under paragraph 4(a)(ii) of the Policy.

In particular, the Respondent states that there has not been an operational web site accessible through the disputed domain name because of "circumstances beyond the Respondent's control". In that regard, the Respondent states that on July 25, 2000 -- shortly after she registered the disputed domain name, she was injured in a motor vehicle accident. As a result of the accident, the Respondent states that she suffered significant spinal injury which rendered her unable to work from that date forward to the filing date of the Response.

She also states that she is "known by some" by the disputed domain name.

3. Bad Faith

The Respondent contends that her activities do not amount to bad faith use and registration.

Specifically, the Respondent states that she is not causing damage to the Complainant's "HUSTLER" mark and to the Complainant. Further, she states that she did not register the disputed domain name with any intention of "waiting for Complainant, or third party"

to purchase it. She also states that she had not solicited either the Complainant or any third party to purchase the disputed domain name from her.

Further, the Respondent states that she initially registered the disputed domain name on February 11, 2000 and then re-registered it (renewed it) during February, 2002 because she has a "legitimate purpose" in doing so. That purpose, so the Respondent states, is to sell "home furnishings" as the Respondent has "a college education in interior architecture". In that regard, the Respondent states that "the English definition of the word hustler is what the Respondent had in mind when developing her home store theme." Hence, the Respondent states that her idea of providing a "home store" was the reason underlying her registration of the disputed domain name.

Consequently, the Respondent apparently concludes that the Complainant has failed to show bad faith use and registration as required by paragraph 4(a)(iii) of the Policy.

C. Complainant's Reply

Inasmuch as the Reply was timely filed, the Panel has considered it.

1. Confusing similarity/identicality

As to the Respondent's contention that the disputed domain name is not confusingly similar to the Complainant's "HUSTLER" marks, the Complainant states that:

- (a) although its federal registration for its mark "HUSTLER HOLLYWOOD" issued slightly after the Respondent's registration of the disputed domain name, the Complainant's trademark rights, based on its intent-to-use filing date of July 23, 1998 (first use having been shown), in that mark and for that matter its trademark rights in its registered mark "HUSTLER", dating back to 1975, all well predate February 11, 2000 -- the date on which the Respondent registered the disputed domain name; and
- (b) the Complainant began use of its domain names <hustler.com> on or about December 31, 1993 and <shophustler.com> on March 4, 1998 -- again preceding the February 11, 2000 registration date of the disputed domain name.

Further, the Complainant contends that the Respondent's expressed intentions of not marketing or selling similar goods were not given under oath and merely relate to a "purported current intent with respect to future acts" and as such "does not and can not relate to Respondent's plans for the domain name at issue from time to time in the future".

In addition, in view of the Respondent's contentions that the term "hustler" is generic, the Complainant points to its trademark registration for that term and states that if that term were generic then the PTO would not have registered it to the Complainant.

Lastly, the Complainant notes that the mere addition of a suffix or generic term, such as "store", to a disputed domain name does not suffice to overcome a likelihood of confusion between that name and a registered mark.

2. Rights and legitimate interests

As to the Respondent's contention that it has legitimate rights and interests in the disputed domain name, the Complainant responds, by way of its Reply:

- (a) the Respondent admits that she has "no affiliation or connection with" Complainant; and
- (b) the Respondent has not refuted the Complainant's assertion in its Complaint that the Respondent has received no license, authorization or consent, express or implied, to use Complainant's "HUSTLER" mark in a domain name or in any other manner.

In addition, the Complainant states that the Respondent fails to dispute the Complaint's statement that the Respondent registered the disputed domain name <**hustlerstore.com**> long after the Complainant's adoption of its "HUSTLER" mark, and subsequent to the Complainant's adoption and registration of its domain names <hustler.com> and <shophustler.com>, and subsequent to the adoption by the Complainant of its "HUSTLER HOLLYWOOD" mark in connection with the operation of retail stores.

Further, the Complainant, in responding to the Respondent's reason (her continuing disability resulting from a motor vehicle accident) for not having posted an operational web site accessible through the disputed domain name, notes that the accident in July 2000 occurred some 5 1/2 months after the February 11, 2000 date on which that name was registered. Further, the Complainant states that the listed registrant of the disputed domain name, B and J Properties, not being a natural person, "can not sustain injuries in a car accident". In that regard, the Complainant states that it has no information regarding the registrant, B and J Properties, or the relationship between it and Ms. Hiegel, except that the latter is named as Administrative Contact for the disputed domain name but is not the listed registrant of that name.

In addition, though the Respondent contends that it is "known by some as <**hustlerstore.com**>, the Complainant states that the Respondent has offered no evidence to support its contention.

As to the Respondent's assertion that it is not causing any damage to the Complainant's "HUSTLER" mark, the Complainant takes the position that trademark infringement constitutes damage in and of itself (*per se*).

3. Bad Faith

With respect to the Respondent's contention that her acts do not evince bad faith use and registration, the Complainant states even if the Respondent initially had, as asserted, a legitimate purpose at the time the disputed domain name was registered to sell home furnishings through a web site accessible through that name, the Respondent, some two years later, offers no evidence of its purpose other than an unsworn statement.

Further, as to the Respondent's contention that "[t]he English definition of the word hustler is what the Respondent had in mind when developing her home store theme", the

Complainant is not aware of any such definition relating the word "hustler" to a "home store theme" in any respect whatsoever.

Lastly, as to the Respondent's assertion that the Complainant "is one of many companies who share the same trademark word HUSTLER offering different goods and services, some of whom carried the mark long before L.F.P., Inc.", the Complainant states that its review of the PTO's records indicates that the only United States trademark registrations issued for the term "HUSTLER" for use with an internet web site are those owned by the Complainant.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit H to the Complaint. As indicated on that record, the Respondent registered that name with Melbourne IT on February 11, 2000.

A. The Complainant's "HUSTLER" marks

The Complainant owns the following federal registrations for various marks that include the term "HUSTLER" as a formative, and has provided copies of the registration certificates, as issued by the United States Patent and Trademark Office (PTO), in Exhibits A-C of the Complaint.

- 1) HUSTLER HOLLYWOOD (block letters)

US registration 2,318,186; registered February 15, 2000.

This service mark was registered for use in connection with: "Retail store services relating to books and prerecorded video cassettes" in international class 35. This mark claims first use and first use in inter-state commerce of December 3, 1998.

- 2) HUSTLER (block letters)

US registration 2,001,594; registered September 17, 1996.

This service mark was registered for use in connection with: "Providing a computer on-line magazine relating to adult entertainment and adult subject matter" in international class 42. This mark claims first use and first use in inter-state commerce of December 31, 1993.

- 3) HUSTLER (block letters)

US registration 1,011,001; registered May 20, 1975 (renewed May 20, 1995)

This trademark was registered for use in connection with: "Entertainment magazine" in international class 16. This mark claims first use and first use in inter-state commerce of January 1, 1972. Though this mark was registered to HG Publications, Inc., the

Complainant has provided, in Exhibit D to the Complaint, a copy of an notice of recordation issued by the PTO stating that this mark has been assigned on April 12, 1995, to L.F.P. Inc., which is the present Complainant, through a written assignment recorded in the PTO and starting at frame 0856 of reel 002320.

B. The Complainant and its activities

The Complainant is a worldwide provider of "adult" entertainment goods and services under its mark "HUSTLER". Those goods and services include adult products, specifically videotapes, magazines, merchandise and DVDs, and online entertainment. The Complainant uses its mark "HUSTLER" in association with promotion, advertisement and sale of a wide variety of goods and services, including those in the entertainment and computer industries. The Complainant also uses the mark "HUSTLER" on apparel, accessories and other products sold throughout the world, in stores, through catalogs, and on-line via the Internet.

Since 1972, the Complainant has used the mark "HUSTLER" in interstate and international commerce to designate its "Hustler Magazine" for adult entertainment.

On or about 31 December 1993, the Complainant adopted and commenced use of the mark "HUSTLER" in interstate and international commerce for the purpose of designating an on-line version of its "HUSTLER" magazine (the Complainant has provided a hard-copy print-out of the home page of that web site in Exhibit E of the Complaint).

Further, in connection with its mark "HUSTLER", the Complainant has established various web sites, including <hustler.com>, for which it registered that domain name on 12 April 1997 and <shophustler.com> for which it registered the latter domain name on 4 March 1998. The Complainant currently sells goods through both web sites. A hard-copy print-out of the home page of the <hustler.com> web site and its associated WHOIS registration information appears in Exhibits E and F to the Complaint, and collectively in Exhibit G for the <shophustler.com> web site.

On December 3, 1998, the Complainant commenced use of its mark "HUSTLER HOLLYWOOD" in connection with providing retail store services.

C. The Respondent and its activities

Ms. Sandra Hiegel is listed as the administrative contact for the disputed domain name for the Respondent registrant, B and J Properties. While the record before this Panel does not indicate any other relationship between Ms. Hiegel and the Respondent, particularly any ownership interest of the former in the latter, the Response filed in this proceeding by Ms. Hiegel specifies her as the Respondent. Therefore, this Panel will assume, consistent with the Response, that Ms. Hiegel owns the Respondent, hence making her and B and J Properties the same entity for purposes of this proceeding.

The Respondent has no connection or affiliation with the Complainant. The Respondent has not made any offers to sell the disputed domain name whether to the Complainant or a third party.

Since the disputed domain name was registered on February 11, 2000, the Respondent has yet to establish an operational web site resolvable through the disputed domain name. The Respondent renewed the registration for this name during February 2002. At the time she first registered the name in February 2000, the Respondent intended to sell home furnishings through such a site inasmuch as she has academic training in that field. There is no indication in the record before this Panel as to if and when the Respondent will ever establish such a site.

Ms. Hiegel was injured in a motor vehicle accident on July 25, 2000. As a result of the accident, she has sustained significant spinal injuries which, to the date of the Response, have rendered her unable to work. The Respondent has included, with the Response, copies of a letter dated October 6, 2000 from her insurance company, Allstate Insurance Company, documenting its receipt of a medical bill which was submitted in behalf of Ms. Hiegel for medical treatment she received, a second page ostensibly from a letter or memo dated June 25, 2001 from Dr. Mark B. Kabins as to an estimate of likely charges for a possible surgical procedure to be performed on Ms. Hiegel, and what appears to be a consultation summary from Dr. James R. Hazel (of Tri-City Orthopaedic Clinic in Richland, Washington) dated January 3, 2002 regarding her medical condition at the time.

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 confusion would likely arise as a result of the Respondent's eventual use of the disputed domain name -- when and if that use were ever to occur.

In that regard, the disputed domain name includes the Complainant's registered mark "HUSTLER", which has clearly acquired requisite secondary meaning and

distinctiveness as a result of the Complainant's continuous use since 1972.

There can be no question here that the disputed domain name, by virtue of its inclusion of the term "HUSTLER", if used in the manner intended by the Respondent or by a third-party to which the Respondent might transfer that name, will likely cause user confusion.

Such confusion would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through the disputed domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See, e.g., *Spence-Chapin Services to Families and Children v. Wynman*, FA100492 (Nat. Arb. Forum Dec. 10, 2001); *MPL Communications v LOVEARTH.net*, FA 97086 (Nat. Arb. Forum June 4, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (Nat. Arb. Forum July 6, 2001); *MPL Communications v IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *American Home Products Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001); *Surface Protection Indus., Inc. v. The Webposters*, D2000-1613 (WIPO Feb. 5, 2001); *Dollar Financial Group, Inc. v VQM NET*, FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.*, D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

It is simply inconceivable to the Panel, given the long-term use by the Complainant of its "HUSTLER" mark and the resulting widespread public recognition attained by that mark both taken in view of the Complainant's activities in providing on-line services under its "HUSTLER" marks, that an Internet user familiar with the "HUSTLER" mark would think that a web site accessible by <hustlerstore.com> was not affiliated in some manner with the Complainant.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy between the disputed domain name and the Complainant's "HUSTLER" marks.

Rights or Legitimate Interests

Based on its federal trademark registrations, the Complainant has acquired exclusive rights to use its "HUSTLER" marks in connection with the goods and services recited in those registrations. Furthermore, by virtue of the registration of these marks, the PTO has implicitly recognized that each such mark is distinctive and has acquired appropriate secondary meaning in the marketplace. Therefore, the Panel rejects the Respondent's argument that the mark "HUSTLER" is generic when used in connection with the goods and services with which the Complainant has registered each of its "HUSTLER" marks.

The Respondent has yet to provide any basis that would legitimize any claim it has to the disputed domain name.

Though the Respondent claims to be known by the name "hustlerstore", she has not provided any independent, let alone sufficient, evidence to support that claim. Accordingly, the Panel can not give any credence to her uncorroborated claim. Hence, the Respondent's actions are in direct contravention of paragraph 4(c)(ii) of the Policy. See, e.g., *Keller Williams Realty, Inc. v. Advantage Realtor*, D2002-0123 (WIPO Mar. 29, 2002); *Viacom International, Inc. v. Matrix Management* cited *supra*; *Park Place Entertainment Corporation v. Bowno*, D2001-1442 (WIPO Mar. 11, 2002); *Jones Apparel Group, Inc. v. Sousa*, D2001-1308 (WIPO Dec. 21, 2001); *America Online, Inc. v. Wood*, D2001-0555 (WIPO June 13, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000); *MSNBC Cable, LLC v. Tysys.com*, D2000-1204 (WIPO Dec. 8, 2000); and *Cabletron Systems, Inc. v. DLS Enterprises*, D2000-0571 (WIPO Aug. 18, 2000).

Furthermore, the Respondent has not only not established any operational web site since she registered that name now more than two years ago but also has made no showing whatsoever that: (a) she has made any demonstrable preparations to use that name in connection with any bona fide offering of goods or services before she received notice of the dispute during April 2002, or (b) as to when such preparations are to occur in the future.

In that regard, the Panel is cognizant of the heavy burden that would be placed on complainants if in support of their cases on illegitimacy each of those complainants were to be impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their respondents. Such a burden is particularly problematic given that the underlying facts more than not are in exclusive or near exclusive possession and control of the respondents, particularly if they have not in fact made publicly discernible use -- as here. As such, the Panel believes that where allegations of illegitimacy are made, as is the case here, when coupled with conduct of respondents that evidences bad faith, it is quite reasonable to shift the burden of proof to each such respondent to adequately show that its use of the disputed domain name is legitimate, such as by showing that, in conjunction with the disputed domain name, it is making a bona fide commercial offering of goods or services or preparations for such offerings, or non-commercial or fair use. *See Treeforms* cited *supra*; and *Playboy Enterprises International, Inc. v. Rodriguez*, D2000-1016 (WIPO Nov. 7, 2000).

In instances as here, where a respondent has not yet used the disputed domain name, the burden becomes one of showing, consistent with paragraph 4(c)(i) of the Policy, that, prior to its receipt of any notice of a dispute concerning that name, the respondent has made or is making demonstrable preparations to construct a web site addressable by that name. *See Casual Corner Group Inc. v. Young*, FA 95112 (Nat. Arb. Forum Aug. 7, 2000) where a delay of 10 months in developing a site was viewed by the panel as being too short to signify a lack of bona fide intent to actually use the name. *Compare Wine Biscuits v. Brown*, D2000-0004 (WIPO Feb. 16, 2000) where the Panel held that a failure to develop a site in two years raised an inference of a lack of such an intent.

Granted, in instances where a respondent has not begun its use of a disputed domain name, the period of time that constitutes reasonable and excusable delay is highly factually dependent and will greatly depend on the nature of the actions actually undertaken by the respondent during that time aimed at effectuating use of the name for an operational web site and ultimately deploying that site. Delay in and of itself does not necessarily negate the existence of demonstrable preparations. However, as the period of delay lengthens, the duty of the respondent to engage in some type of affirmative action aimed at undertaking demonstrable preparations of one sort or another concomitantly increases.

Realistic practicalities, inherent in business planning and execution in general and web site development in particular, mandate against setting a single sharp, fixed period of time, such as, e.g., two months, six months and the like, that is applicable to each and every situation. What constitutes justifiable delay in any factual scenario is assessed against the nature of the exact actions which the respondent has taken during that time that are proffered as being "demonstrable preparations" as well as the length of the period of delay and any extenuating circumstances. See *Treeforms*, cited *supra*.

Given the present situation now facing this Panel, it is beyond question that the Respondent's conduct falls considerably short of meeting this burden. There simply is no proof whatsoever of any usage of the disputed domain name since it was registered on February 11, 2000 (now over two years ago) and no evidence whatsoever of any activities, at all, having been undertaken by the Respondent between that date and the present that, could be viewed as "demonstrable preparations", i.e., that are calculated to result in deployment of an operational web site addressed by that name.

The Panel certainly recognizes and appreciates that the Respondent has suffered significant injuries as a result of her accident -- though it occurred some five months after the disputed domain name was registered. However, the Respondent -- if she was as unable to actively work as she asserts -- could well have engaged another entity or individual to develop an operational web site, or undertaken some other affirmative effort aimed at having the web site developed through the assistance of another party. Even if such efforts were, when viewed in isolation, rather modest, nevertheless the adequacy of those efforts should be assessed, not with respect to another individual, but illuminated by the respondent's physical condition and concomitant abilities at the time.

But, for whatever reason -- and the record before the Panel is completely silent as to it, the present Respondent has chosen not to act at all and, hence, by doing so, is simply letting the disputed domain name lie totally fallow.

There is simply no evidence whatsoever in the record before this Panel that the Respondent's continuing physical impairments during the 2+ years she has held the name after her accident completely precluded (i.e., incapacitated) her from taking any such affirmative action at all and when, if ever, the Respondent, due to her medical condition, will be able to return to her active working endeavors. Given this, it is quite conceivable to the Panel that the Respondent's injury will either be permanent or long-term in

duration; hence significantly extending the delay period, during which the disputed domain name will still not be used, to some unknown date out into the future.

If the Panel were amenable to excusing the Respondent's inaction due to her injury, the Panel would not only need to excuse the Respondent's past 2+ year delay but also sanction that delay to extend for an indefinite amount of time into the future. This the Panel will not do.

While the Panel recognizes that in certain instances excusable delays will inevitably arise, those delays must be quantifiable and limited; they can not extend indefinitely -- as the Respondent is implicitly asking this Panel to do.

This Panel believes that, where a respondent encounters a lengthy delay in starting his(her) preparations to use a registered domain name, that respondent must nevertheless undertake some affirmative action during that time -- with the adequacy of those actions being measured by the abilities of the respondent during that time -- aimed at exploiting that name, whether it be simply engaging another who is ready, willing and able to actively undertake appropriate preparations or otherwise. A respondent can not simply do nothing and effectively "sit on his rights" for an extended period of time when that respondent might be capable of doing otherwise. Now, rather than drawing a fixed, bright line as to the acceptable bounds of such action, the Panel recognizes that the bounds and quanta of such action will clearly need to vary from one situation to another and be assessed against the relevant facts at hand.

Nevertheless, given the complete inactivity of the Respondent in undertaking any affirmative efforts whatsoever aimed at exploiting the disputed domain name for now over a two-year period and no reason underlying why the Respondent was incapable of doing anything more, the Respondent's conduct simply falls way short of complying with paragraph 4(c)(i) of the Policy.

Furthermore, in the absence of having used the domain name at all, the Respondent is simply unable to show that she has made any legitimate noncommercial or fair use of the disputed domain name sufficient to fall within paragraph 4(c)(iii) of the Policy.

In light of the above findings, the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any rights or legitimate interests in the disputed 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 disputed domain name within paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

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

While bad faith registration may not exist at the time the Respondent initially registered the disputed domain name -- given her expressed intentions to use the domain name at that time in connection with a future web site directed to home furnishings, it is eminently clear to this Panel that, at the time she renewed the registration during February 2002 and given the immediately preceding two-year period of continuous non-use by the Respondent and her likely expectation that this non-use would continue indefinitely into the future, the Respondent's renewal was made in bad faith.

Various panels have ordered transfer of a domain name after an extended period of non-use by its registrant, typically referred to as "passive holding". Passive holding is the antithesis of excused delay. In cases where passive holding was found, non-use was coupled with a complainant having valid trademark rights commencing prior to the date on which the offending domain name was registered coupled with the registrant having actual or imputed knowledge of those rights. See, e.g., *Spence-Chapin Services*, cited *supra*; *America Online, Inc. v. Woods*, D2001-0555 (WIPO June 13, 2001); *Chip Merchant Inc. v. Blue Star Electronics d/b/a Memory World*, D2000-0474 (WIPO Aug. 21, 2000); *Chernow Communications, Inc. v. Kimball*, D2000-0119 (WIPO May 18, 2000); *America.com Inc. v PSS InterNet Services, Inc.*, FA 96784 (Nat. Arb. Forum Apr. 19, 2001); *Awesome Kids LLC v. Selavy Communications*, D2001-0210 (WIPO Apr. 16, 2001) and *American Vintage Wine Biscuits, Inc v. Brown, d/b/a Big Daddy's Antiques*, D2000-0004 (WIPO Feb. 16, 2000); as well as *Northwest Racing Associates Limited Partnership v. Quantu Marketing*, FA 95506 (Nat. Arb. Forum Oct. 6, 2000); *Can't Stop Productions, Inc. v. Lussie*, FA 94966 (Nat. Arb. Forum July 27, 2000); *Liberty Public Limited Company v. Guarnera*, FA 95103 (Nat. Arb. Forum Aug. 17, 2000); *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev*, FA 95078 (Nat. Arb. Forum Aug. 9, 2000); *Leland Stanford Junior University v. Zedlar Transcription & Translation*, FA 94970 (Nat. Arb. Forum July 11, 2000); *Georgia Gulf Corporation v. The Ross Group*, D2000-0218 (WIPO June 14, 2000); *Sanrio Company, Ltd.. v. DLI*, D2000-0159 (WIPO Apr. 20, 2000); *America Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd.*, FA 93679 (Nat. Arb. Forum Mar. 16, 2000) and *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000). Here, in view of the widespread reputation of the Complainant's mark "HUSTLER" -- given its use began some 28 years prior to the initial registration of the disputed domain name, it would simply be preposterous to think that the Respondent was unaware of this mark at the time she initially registered (and certainly renewed) the disputed domain name. In each case cited immediately above, such passive holding, occurring in view of and in spite of the respondent's knowledge as to the mark in question, was seen as sufficient evidence of bad faith use and registration under the general provisions of paragraph 4(b) of the Policy. The Panel sees no plausible reason to divert from that view, with the passive holding here providing the basis for the Panel's finding that the Respondent's actions constitute bad faith use and registration in contravention of paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the 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 paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby **granted**.

The disputed domain name, namely <**hustlerstore.com**>, is ordered **transferred** to the Complainant.

Peter L. Michaelson, Esq., , Panelist
Dated: May 30, 2002