



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

MasterCard International Incorporated v. Global Prepaid

Case No. D2008-2008

1. The Parties

The Complainant is MasterCard International Incorporated of Purchase, New York, United States of America represented by Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, LLP of United States of America.

The Respondent is Global Prepaid of Miami, Florida, United States of America, represented by Barry Wernick of United States of America.

2. The Domain Names and Registrars

The disputed domain names <mastercardelectronic.com>, <mastercardforsale.com>, <mastercardsforsale.com> and <mastercardsonline.com> are all registered with GoDaddy.com, Inc.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), 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 ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint, with accompanying Exhibits A-I, was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on December 31, 2008 and by hardcopy on January 6, 2009. Subsequently, in response to a request from the Center dated January 16, 2009, an amendment to the Complaint was filed with the Center by email on January 16, 2009 and by hardcopy on January 20, 2009.

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 January 5, 2009, the Center requested confirmation from the Registrar as to whether the registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to each of the disputed domain names. The Center also requested the registrar to specify for each of the disputed domain names: (a) whether the Policy applies to that domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the name will remain "locked" during the proceeding.

Subsequently, on January 5, 2009, the Registrar provided its response to the Center through which it specified name and contact information pertinent to each of the disputed domain names to the extent, as it then existed, in its WhoIs database. Further, the Registrar stated that it had received a copy of the Complaint and that the Respondent was listed as the registrant for each of the names. The Registrar's response further indicated that, for each of the names: (a) the Policy applies to the name, (b) GoDaddy.com is the registrar, (c) the Registrant submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (d) the registration agreement is in English, and (e) the name will remain locked during the proceeding.

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

On January 21, 2009, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to that Respondent, together with all its exhibits, by courier and, without the exhibits, 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 January 21, 2009, 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 February 10, 2009, to file its Response with the Center and the Complainant.

The Response, together with Exhibits A-D, was timely filed by the Respondent on February 10, 2009 with the Center and was subsequently acknowledged by the Center through an email letter dated February 16, 2009.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated February 20, 2009, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as sole Panel for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated February 25, 2009, 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 March 11, 2009. Owing to unexpected time conflicts issues experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, subsequently notified the Parties extending this due date to March 30, 2009.

In the meantime, the Complainant filed a supplemental filing, in the form of a Reply to the Response, on February 26, 2009 with the Center.

This dispute concerns four domain names, specifically names: <mastercardelectronic.com>, <mastercardforsale.com>, <mastercardsforsale.com> and <mastercardsonline.com>.

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration records provided in Exhibit A to the Complaint, the disputed domain names were registered as follows: <mastercardelectronic.com> on December 17, 2003; and <mastercardforsale.com>, <mastercardsforsale.com> and <mastercardsonline.com> all on December 19, 2004.

A. Complainant's MASTERCARD Marks

The Complainant owns numerous US and counterpart foreign trademark registrations for the term "Mastercard" either alone in block letters or in various stylized patterns, and with or without accompanying logos, as well as with other terms either in block letters or stylized form. Listings of those marks which include the term "Mastercard" (or variants) alone and with other terms respectively appear in Exhibits F and G to the Complaint. Pertinent details of a few of those registrations are as follows:

1. MasterCard
United States registration 1,186,117; registered: January 12, 1982

This mark is registered for use in connection with "Financial services - namely providing bank card services".

2. MasterCard with logo
United States registration 1,257,853; registered: November 15, 1983

This mark is registered for use in connection with “Financial services - namely providing bank card services”.

3. MasterCard
United States registration 1,292,519; registered: August 28, 1984

This mark is registered for use in connection with “Financial services - namely assisting its members in the sale of travelers’ cheques, integrated funds management programs, and money order services”.

4. MASTERCARD (block letters)
United States registration 2,212,783; registered: December 22, 1998

This mark is registered for use in connection with “Magnetic encoded cards; magnetic encoded card readers; telecommunications equipment, namely point of transaction terminals; and computer software for transmitting, displaying and storing transaction, identification and financial information for use in the financial services, banking and telecommunications industries”.

B. Complainant

The Complainant is a global payments solutions company that provides a variety of services in terms of credit, deposit access, electronic cash, business-to-business and related payment programs for its members throughout the world.

The Complainant, through its predecessors in interest, has been in the payment card business since 1966 and has operated under the MASTERCARD name and mark since at least as early as 1980. The Complainant manages a family of payment card brands including MASTERCARD, MAESTRO and CIRRUS and serves financial institutions, consumers and businesses in over 210 countries and territories. Print-outs of various pages, provided in Exhibit D to the Complaint, from the Complainant’s website at <mastercard.com> describe the history of the Complainant’s business, with a printout of the home page of that site appearing in Exhibit E to the Complaint.

In addition to its trademark registrations, the Complainant registered numerous domain names containing the mark MASTERCARD or variants thereof, including, e.g., <mastercard.com>, <mastercard.net>, <mastercard.org>, <mastercardonline.com>, <mastercardonline.net>, and <mastercardonline.org>. The earliest of these names, <mastercard.com>, was registered on July 27, 1994.

As a result of the activities undertaken by the Complainant in the sale and promotion of its MASTERCARD-branded services and products, the supervision and control it exercised over the nature and quality of these services and products, and the extensive advertising, sale and public acceptance thereof of the brand, the MASTERCARD mark has garnered an extensive reputation and a concomitant amount of goodwill both domestically and internationally to the point where that mark has become one of the most widely recognized trademarks in the world.

The MASTERCARD mark and variants thereof have become exclusively associated with the financial services and related goods and services offered by the Complainant.

C. Respondent

On April 16, 2004, the Complainant, through one of its members, Bankfirst, registered the Respondent as an affiliate (also referred to, in an agreement between the parties, as a “MSP” with the agreement itself also being referred to as the “MSP agreement”).

The Respondent’s use of the Complainant’s marks was governed by an affiliate MSP agreement between the Complainant and the Respondent. A copy of the agreement, as executed by the parties on April 16, 2004 appears in Exhibit H to the Complaint. Three sections of the Agreement control the Respondent’s use of the Complainant’s marks. These sections do not authorize Respondent to register any domain names incorporating the MASTERCARD mark. Additionally, these sections require the Respondent to cease all use of any of the Complainant’s marks should the Complainant de-register the Respondent as an affiliate MSP. Those clauses state:

“WHEREAS, (i) Agent [the Respondent] and Member [Bankfirst] each desire that Agent perform services on behalf of Member relating to Member’s use of MasterCard marks and services (“Services”),...

THEREFORE, the parties agree as follows: . . . 4. If Agent is at any time de-registered as an MSP by MasterCard, whether at MasterCard’s discretion or pursuant to request of Member, Agent and Member will each use best and extreme effort to ensure that Agent forthwith ceases performing Services

7. . . . Agent shall forthwith terminate Services and cease all functioning as an MSP on behalf of Member upon receipt of written notice from either Member or MasterCard that Agent may no longer perform Services and/or function as an MSP.”

On May 26, 2005, purportedly in response to complaints from consumers regarding an entity connected to the Respondent (though the Respondent disputes the validity of the complaints – the nature of the complaints and their validity being aspects which are irrelevant to the present dispute and hence which this Panel need not consider), the Complainant de-registered the Respondent as an affiliate.

The disputed domain names redirect users to the <mastercardelectronic.com> website and specifically a single web page thereof; a hardcopy of that page appears in Exhibit I to the Complaint. That page provides comments about the Complainant and requests that users submit information for inclusion in a lawsuit against several financial companies, including the Complainant. Specifically, the page states, in its first box of text:

“If you are a distributor and believe that you or your business has experienced undue harm and irreparable damage due to the actions of Bankfirst, The Marshall Group, Marshall Bankfirst Corp., Mastercard International, Personix (a division of Fiserv, Inc.), and/or due to the willful and malicious actions of other distributors who have committed acts of slander, libel, commercial bribery and extortion, and/or tortuous interference of business relations with respect to Global VCS, Global Ventures and its distributors’ businesses, you may be eligible to participate in multiple plaintiff lawsuits against these individuals, entities, and

their affiliates, representatives and assigns.

If you are interested in learning about your rights, potential claims, and eligibility to participate please click here to take action now [link not reproduced]!”

Since the Respondent was de-registered in 2005, the Respondent has yet to file any lawsuit against the Complainant or any of the other parties listed on its web page.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that each of the disputed domain names is confusingly similar to the Complainant's mark MASTERCARD.

Specifically, the Complainant states that each such name merely includes that mark along with a descriptive or generic term(s), specifically “electronic”, “on line” and “for sale”, none of which adds any distinctiveness to the resulting name.

Furthermore, for one name, the Respondent has simply added the letter “s” to the mark MASTERCARD to form a plural version thereof and then appended the words “for sale” thereto. Here too, these changes do not provide sufficient distinctiveness to the resulting name to ameliorate resulting user confusion with that mark.

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 any of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant states that the Respondent is not affiliated or related to the Complainant in any way, licensed by the Complainant or otherwise authorized to use the mark MASTERCARD.

Second, the Complainant alleges that the Respondent is not generally known by any of the disputed domain names, and did not acquire any trademark or service mark rights in the MASTERCARD name or marks under its Agreement with the Complainant.

Third, the Complainant alleges that the Respondent is not offering the goods or services at issue, but is merely using the disputed names to solicit personal information for a non-existent lawsuit against several parties, with that use being illegitimate. In that regard, none of those names resolves to a bulletin board site allowing postings from users in the manner of a complaint site, nor seek solutions to problems from other users in the manner of an informational site. Instead, they resolve to a solicitation page, with solicitation being the primary purpose of the Respondent's site.

Lastly, under the Agreement, the Complainant's de-registration of the Respondent proves, rather strongly, that the Respondent lacks rights or legitimate interests in any of

the disputed names. Specifically, the Agreement states that, upon its termination, the Respondent will cease use of any of the Complainant's marks. Moreover, the Agreement required the Respondent to "terminate Services", which were defined in part in the Agreement as use of MASTERCARD marks. Hence, the incorporation of the mark MASTERCARD into each of the disputed domain names does not constitute *bona fide* use of that mark.

(iii) Registered and Used in Bad Faith

Lastly, the Complainant contends, for various reasons, that the Respondent registered and is now using each of the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complaint alleges that the Respondent's registration and use of the name <mastercardelectronic.com>, without authorization and prior to the Respondent became an affiliate of the Complainant, constitutes bad faith. Moreover, subsequent registration and use of <mastercardsonline.com>, <mastercardforsale.com> and <mastercardsforsale.com> violated the MSP agreement then in force between the parties and, as such, constitutes bad faith. Once the Respondent was de-registered, its continued use of the names also constitutes bad faith.

Second, the Complainant alleges that the Respondent is using the disputed domain names for commercial gain which results from confusion of Internet users between those names and the Complainant's mark MASTERCARD which is contained within each of the names.

Lastly, the Complainant alleges that the Respondent is primarily using the names to deliberately disrupt the Complainant's business. Specifically, the Respondent uses its website, resolvable through the names, to denigrate and disparage the Complainant by soliciting Internet users to participate in a non-existent lawsuit.

B. Respondent

(i) Identical or Confusingly Similar

The Respondent takes the position, contrary to the Complainant's contention, that each of the disputed domain names is not confusingly similar to the Complainant's mark MASTERCARD.

Specifically, the Respondent claims that the Complainant's spelling of its mark, pursuant to its own guidelines, is "MasterCard" having upper case letters "M" and "C" and the remaining letters in lower case and that the Complainant never uses that mark in any other fashion. In contrast, all four names sufficiently differ from that mark by incorporating "the two words 'master' and 'card' together, plus a minimum of one more word never combining less than three words."

Further, the Respondent claims that the Complainant has not provided any proof that it has a state or federal trademark registration through which the Complainant has rights in the two word term, "master card", or in any of the terms "mastercardelectronic," "mastercardsonline," "mastercardforsale," or "mastercardforsale", or has established common law trademark rights in any of those terms.

(ii) Rights or Legitimate Interests

The Respondent takes the position, also contrary to the Complainant's contention, that for any of various reasons, that it possesses rights and legitimate interests in each of the disputed domain names.

First, the Respondent claims that it made demonstrable preparations to use the names prior to receiving notice of the present dispute. Specifically, while the Respondent was in the process of becoming an affiliate, it registered, on behalf of its distribution network, the name <mastercardelectronic.com> and, after having become an affiliate, it then registered the remaining three names. Its sole purpose in doing so was to offer goods and services, including the "Global VCS Prepaid MasterCard" credit card issued by Bankfirst under license from the Complainant. Respondent expended hundreds of thousands of dollars in the form of advertising, marketing, design and creation of its own Global VCS Prepaid MasterCard Card, as well as millions of pamphlets, applications, point of purchase displays, mailers, window decals, restaurant and bar menus, distributed and ready for distribution in thousands of locations throughout the US.

Second, the Respondent claims that it became commonly known by the disputed domain names, as well as others, as those names served as addresses of websites for its distribution network to assist in efforts to saturate the marketplace with the Global VCS Prepaid MasterCard Card. Respondent states that the Complainant approved all of those sites before each became operational. After Respondent's de-registration, the Respondent intended that some of those sites, including that to which the disputed names resolve, were to be solely for use by the Respondent's distribution network and its small business owners (of about 100 distributor business owners) as a way to contact the Respondent and provide any information that may be deemed useful for the Respondent to become re-registered as an affiliate and to be made whole by various parties who wronged the Respondent and its distributors.

Lastly, the Respondent is using the disputed domain names in a manner that is either a noncommercial or fair use and which does not tarnish the Complainant's marks. In that regard, the Respondent's website does not contain any comments that disparage the Complainant. The site simply asks questions but does not claim anywhere that the Complainant or any other party has actually done anything unethical or illegal.

(iii) Registered and Used in Bad Faith

The Respondent also disputes the Complainant's contentions regarding bad faith by asserting that the Respondent did not register or use any of the disputed domain names in bad faith.

The Respondent claims that the MSP agreement contained no provision which specifically prevented it from registering a domain name that included the Complainant's mark MASTERCARD. Moreover, the Respondent, upon having been de-registered and in accordance with the agreement, ceased performing "Services" and ceased all functioning as an affiliate.

While the Respondent acknowledges having registered the name <mastercardelectronic.com> prior to the effective date of the MSP agreement, the

application process for becoming an affiliate could consume at least six months. Its website resolvable through that name did not become operational until after the Respondent became an affiliate.

Further, the Respondent did not register any of the names in an intentional attempt to attract, for commercial gain, Internet users to its site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement. The Respondent's site was originally set up to promote the sale of MasterCard-branded credit cards on the Complainant's behalf as per the terms of the MSP Agreement. There is no confusion among Respondent's distribution network regarding Respondent's ownership of the domain names and the Complainant's role. However, since its de-registration, the Respondent has not spent any money in increasing traffic to its site. Currently, the Respondent and its distributors (approximately numbering 100) do not use that site for solicitation but rather as a distribution network for sharing information regarding their experiences resulting from actions taken by, inter alia, the Complainant. In that regard, the Respondent's distributors are familiar with and associate the disputed domain names with the Respondent, thus facilitating use of that site for communication.

Lastly, the Respondent claims it never registered any of the names to disrupt the Complainant's business. Respondent was a registered affiliate and its business was to saturate the US marketplace with its own Global VCS Prepaid MasterCard on behalf of the Complainant and its member, Bankfirst.

C. Complainant's Reply

No provision specifically exists in the Rules or Supplemental Rules for the submission of an unsolicited supplemental filing, here being the Reply. Nevertheless, the Panel, acting in its sole discretion under paragraphs 10 and 12 of the Rules, has considered the Reply.

Through the Reply, the Complainant re-iterates that it never approved the Respondent's registration and use of any of the disputed domain names or the Respondent's website(s). Moreover, while the Respondent was an affiliate of the Complainant, it was authorized to use the Complainant's marks but that relationship terminated after which the Respondent had no such further right. As such, the Complainant contends that the Respondent's further use of the mark MASTERCARD, whether in a domain name or other form, contravened an express surviving provision of the agreement to which the Respondent had agreed – and which Respondent admitted – and thus was not *bona fide*.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that each of the disputed domain names is confusingly similar to the Complainant's MASTERCARD Marks.

From a simple comparison of each of the disputed domain names to the Complainant's mark MASTERCARD, no doubt exists that each such name is confusingly similar to the Complainant's marks.

The primary differences between each of the disputed domain names and the mark MASTERCARD are the addition of each one of the descriptive or generic words specifically “electronic”, “on line” and “for sale”, as a suffix to the mark (or a plural version thereof) to form a separate corresponding composite term along with appending the gTLD (generic top level domain) “.com” to each such term to form the name – with the last addition 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 a minor variation, such as adding short letter or number groups or even generic or highly descriptive words to a mark, is usually 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. Here, adding such words, in the manners which the Respondent specifically did, to the mark MASTERCARD clearly resulted in such minor variations. Further, as was the case here, changing the mark to a plural form by adding an “s” to the former prior to appending a generic or descriptive term similarly fails, by virtue of being a de minimus modification, to avoid user confusion. See, e.g., *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265 (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *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 Corporation v. Hevun Diversified Corporation*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (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. Giovanni 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 Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 (December 16, 2002).

Therefore, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant’s marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to any of the disputed domain names under paragraph 4(c) of the Policy.

For approximately one year, from April 16, 2004 through May 26, 2005, the Respondent was an affiliate of the Complainant and, as such, was permitted to utilize the Complainant's marks but only in the specific manner authorized by the Complainant. This did not extend to registering a domain name which included any of those marks. It is undisputed that once the MSP agreement terminated on May 26, 2005 upon the Complainant's de-registration of the Respondent as an affiliate, all permission previously granted to the Respondent to use any of those marks simultaneously terminated as well.

Consequently, any use after May 26, 2005 to which the Respondent were to put the Complainant's mark MASTERCARD or one confusingly similar thereto in connection with identical or even similar services to those currently provided by the Complainant, as recited in its trademark registrations, would violate the exclusive trademark rights then and now residing with the Complainant. See, e.g., *HRB Innovations Inc.*, *Dreamworks*, *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *National Football League*, *Toilets.com, Inc.*, and *Associated Bank*, all 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. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000).

In spite of the Complainant's exclusive rights in its marks, the Respondent claims that its distributors recognize that the Respondent is known by each of the disputed domain names which, in turn, would provide a basis for legitimacy under paragraph 4(c)(ii) of the Policy. However, there is no indication whatsoever in the record before this Panel that access to the Respondent's website is so limited. In fact, the Panel infers that the Respondent's site, like the vast majority of Internet sites, is publicly accessible to any Internet user who enters any of the disputed domain names into his(her) browser. Given that, the pertinent question in the Panel's view under paragraph 4(c)(ii) of the Policy in assessing whether a respondent is "commonly known" by a disputed domain name is not whether the Respondent here is known by one or more of the disputed domain names to just one or even all of its distributors (which number, by the Respondent's own admission, approximately 100), but rather whether such knowledge extends outward into the general Internet community, i.e., is public, and, if so, just how far. Obviously, the boundaries of what can reasonably be said to constitute public "common knowledge" are highly factually dependent and thus realistically determined

only on a case-by-case basis. Nevertheless, the Respondent readily admits that whatever recognition it has attained through use of the names is limited to its 100 distributors and does not extend to the public at large, i.e., the Internet community.

Due to the substantial goodwill, fame and worldwide reputation and market recognition which the Complainant has attained through its extensive continuous use of its MASTERCARD Marks since at least as early as January 1982 -- now some 27 years, and the exclusive global trademark rights it possesses in those marks, the Respondent could never legitimately acquire any public association between it and the mark MASTERCARD or one similar thereto, at least for the services rendered by the Complainant, or, broadly speaking, any service likely perceived by Internet users to be so similar and/or to emanate from or be related, in any fashion, to those then offered by the Complainant. Thus, contrary to the Respondent's view, the Respondent could never qualify under paragraph 4(c)(ii) of the Policy.

Further, as to paragraph 4(c)(i), the Respondent was well aware that at no time was it authorized by the Complainant to register any domain name that incorporated any of the MASTERCARD Marks.

Specifically, on April 16, 2004, the Respondent and Bankfirst entered in the MSP agreement through which the Respondent became an affiliate of the Complainant. Prior to that date, the Respondent had no authorization whatsoever to use any of the Complainant's MASTERCARD Marks in any fashion. That included registering the <mastercardelectronic.com> name on December 17, 2003 which incorporated the Complainant's mark MASTERCARD. Starting on April 16, 2004 and continuing for approximately one year later until May 26, 2005, the Respondent's use of the MASTERCARD Marks was strictly governed by the provisions of that agreement. In spite of the express knowledge that the Respondent possessed as to the exclusive trademark rights of the Complainant and the very limited and nuanced nature of the authorization it had to use those marks -- which did not include registering any domain name that incorporated any of those marks, the Respondent registered all three remaining names <mastercardforsale.com>, <mastercardforsale.com> and <mastercardsonline.com> on December 19, 2004. Respondent's intentional registration of these three domain names, which included the Complainant's mark MASTERCARD, directly contravenes the limited authority conveyed to it through its MSP agreement. Inasmuch as such use is illegitimate, then any subsequent offering of goods or services, through a website resolvable through any of those names, would not be *bona fide*. See *UVA Solar GmbH & Co K.G. v. Mads Kragh*, WIPO Case No. D2001-0373 (May 7, 2001). As such, the Respondent cannot satisfy paragraph 4(c)(i) of the Policy either.

Lastly, as to paragraph 4(c)(iii), the Panel is not persuaded by the Respondent's assertion that its website, through which all the disputed domain names resolve, does not tarnish the Complainant's MASTERCARD Marks. Specifically, the first page of the site contains the following wording:

“If you are a distributor and believe that you or your business has experienced undue harm and irreparable damages due to the actions of ... MasterCard International ... you may be eligible to participate in multiple plaintiff lawsuits against these entities.

If you or your business has experienced undue harm and irreparable damage due to the actions of MasterCard International, and would like to voice your complaint or grievance click her to take action now!"

Such wording clearly solicits potential participants to either join a lawsuit or at least provide a complaint or grievance against the Complainant. Even though the wording of the text specifically targets distributors, the site, by virtue of its public accessibility, readily reaches others in the Internet community. Thus, those individuals who have no knowledge of the dealings that occurred between the Complainant, the Respondent and the Respondent's distributors may very well infer or even conclude from the wording that the Complainant has engaged in questionable conduct of one form or another regardless of the veracity of the underlying allegations which, in turn, will inevitably cast a negative pall over the Complainant and particularly its MASTERCARD Marks and corresponding branded services, and thus tarnish those marks.

While domain names which incorporate a registered mark can legitimately serve as addresses for gripe sites or sites that provide other critical commentary regarding the owner of the mark and regardless of the severity of that criticism, those names must contain some additional distinguishing component which, in combination with the mark, clearly conveys the function of the website in the minds of ordinary Internet users. Such is clearly not the case here as none of the additional wording which the Respondent appended to the mark MASTERCARD to form the domain names, i.e., "electronic", "on line" and "for sale", would, in conjunction with the mark, reflect any such function. Hence, none of the names here are so protected. See *322 West 57th Owner LLC v. Administrator, Domain*, WIPO Case No. D2008-0736 (August 6, 2008).

Consequently, the Respondent fails to satisfy paragraph 4(c)(iii) of the Policy as well.

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

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to each of the disputed domain names, constitutes bad faith registration and use.

From the discussion in the preceding section, it is clear that the Respondent, in spite of having prior knowledge of the Complainant's exclusive rights in the mark MASTERCARD, nevertheless intentionally registered and used the names each of which incorporated that mark. For three of these names, this action occurred even though the Respondent was prohibited, by virtue of contractual provisions to which by then it had specifically agreed, from using the mark in any domain name. Such actions clearly reflect bad faith under paragraph 4(a)(iii).

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to each of the disputed domain names, 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.

All the disputed domain names, namely <mastercardelectronic.com>, <mastercardforsale.com>, <mastercardsforsale.com> and <mastercardsonline.com> are ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: March 25, 2009