



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.

Case No. D2007-1878

1. The Parties

The Complainant is MySpace, Inc., Beverly Hills, California 90210, United States of America, represented by Cantor Colburn LLP, United States of America.

The Respondent is Edwin De Jesus, EDJ Associates Inc., Astoria, New York, United States of America, represented pro se.

2. The Disputed Domain Names and Registrar

The disputed domain names <myspaceforbusiness.com> and <myspacehispano.com> are both registered with Schlund + Partner (the "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") in email form on December 17, 2007, and in hard copy form, along with accompanying Exhibits A-Y, on December 19, 2007. In response to a Notice of Deficiency issued by the Center on December 31, 2007, the Complainant filed an Amended Complaint by email on January 7, 2008. For simplicity, the term "Complaint" will hereafter refer to the Complaint, as amended, unless the specific context of the discussion indicates otherwise.

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 December 21, 2007, 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 the disputed domain names. The Center also requested the Registrar to specify, for each of the domain names: (a) whether the Policy applies to that 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 that name, (c) the language of the registration agreement, and (d) whether that name will remain "locked" during the proceeding.

Subsequently, on December 21, 2007, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain names to the extent present in its WhoIs database and confirmed that the Respondent is listed as the registrant for each name. The response also indicated that: it had not received a copy of the Complaint, but confirmed that, for both names, (a) Schlund + Partner is the registrar, (b) the Respondent submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (c) the registration agreement is in English, and (d) each 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 8, 2008, 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 the Respondent, together with all its exhibits, by courier and email, and, without those exhibits, by facsimile. 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 8, 2008, 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 January 28, 2008, to file its Response with the Center and the Complainant.

Subsequently, on January 25, 2008, the Respondent filed its Response, together with Exhibits A-H, by email with the Center.

Pursuant to the Rules and Supplemental Rules, by an email letter dated February 12, 2008, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on that same day, Mr. Michaelson accepted and returned, by e-mail 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 February 13, 2008, 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 February 27, 2008. However, owing to unexpected time conflicts experienced by the Panel which constituted unforeseen circumstances, the Center, at the Panel's request, extended the due date to March 12, 2008.

This dispute concerns two domain names, specifically <myspaceforbusiness.com> and <myspacehispano.com>.

The language of this proceeding is English.

4. Factual Background

As collectively indicated in the WhoIs registration records provided in Exhibit A and B to the Complaint, the Respondent registered the disputed domain names <myspaceforbusiness.com> and <myspacehispano.com> on March 29, 2006 and April 21, 2006, respectively.

A. The Complainant's MYSPACE Marks

The Complainant owns four US trademark registrations and various foreign registrations for the term MYSPACE, either in block letters or stylized, and either by itself or with other words or a design. For its US registrations, the Complainant has provided, in Exhibits E, G, H and I to the Complaint, a hard-copy printout of its registration certificates as issued by the United States Patent and Trademark Office. Pertinent details of these registrations are as follows:

1. MYSPACE RECORDS (block letters)
United States registration 3,295,810; registered: September 18, 2007

This mark is registered for use in connection with "audio recordings featuring music; video recordings featuring music; downloadable audio and video recordings; prerecorded music on CD" in international class 9. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced as of November 30, 2005.

2. myspace a place for friends (stylized) and design
United States registration 3,183,162; registered: December 12, 2006

This mark is registered for use in connection with "computer services, namely hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information" in international class 42; and "Internet based dating, introduction and

social networking services” in international class 45. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these services in classes 42 and 45, commenced as of July 31, 2003.

3. MYSPACE (block letters)

United States registration 3,183,151; registered: December 12, 2006

This mark is registered for use in connection with: “audio recordings featuring music; video recordings featuring music; downloadable audio and video recordings; prerecorded music on CD, DVD and other media” in international class 9; “advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases featuring classified listings and want ads” in international class 35; “providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; providing email and instant messaging services” in international class 38; and “computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information” in international class 42. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these goods and services in classes 9, 35, 38 and 42 commenced as of June 30, 2004; November 30, 2003; July 31, 2003; and July 31, 2003, respectively.

4. MYSPACE (block letters)

United States registration 2,911,041; registered: December 14, 2004

This mark is registered for use in connection with “Internet based dating, introduction and social networking services” in international class 45. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these services, commenced as of July 31, 2003.

B. The Complainant

The Complainant maintains a web site at the domain name <myspace.com> (a copy of the home page of that website appears in Exhibit F to the Complaint).

In November 2006 and as reported in various news articles, the Complainant’s web site recorded 38.7 billion U.S. page views, surpassing the then leading web portal YAHOO (a copy of such an article from “www.cnn.com” appears in Exhibit P to the Complaint). *Time Magazine* named as its 2006 Person of the year “you” (the public, generally), based in large part on the public’s increased compilation and dissemination of information on-line. The Complainant’s MYSPACE services are specifically identified as a significant factor in *Time Magazine*’s decision (see a copy of the article from *Time Magazine* provided in Exhibit Q to the Complaint). Searches conducted through the GOOGLE, YAHOO and MSN search engines revealed the Complainant’s web site as the number one search result for the term “MYSPACE” (a copy of the abbreviated search results appear in Exhibit R to the Complaint). According to Alexa.com, a subsidiary of Amazon.com and which provides information on the web traffic to other websites, the Complainant’s web site is ranked sixth in overall global Internet web traffic and third in traffic among US users (copy of the associated results in Exhibits S and T, respectively, to the Complaint).

The Complainant's services rendered under its MYSPACE Marks have been featured in cover stories from periodicals such as *Fortune* (September 11, 2006), *Wired* (July 2006), and *Business Week* (December 12, 2005) (copies of the corresponding articles from these three publications appear in Exhibit U to the Complaint).

In July 2005, the Complainant was acquired by News Corporation.

C. The Respondent

The Respondent uses the disputed domain names in conjunction with its business and professional networking (portal) sites. Those sites currently have over 2000 members (Exhibit E to the Response) and recorded over 2.5 million page views for the year 2007 (Exhibit F to the Response).

Searches conducted on various well-known Internet search engines (with a copy of the abbreviated search results appearing in Exhibit G to the Response) for the term "my space for business" reveal that the Respondent's domain name is in the top ten results for that term.

The Respondent has invested a considerable deal of time, effort and money to develop its working websites, which in the case of <myspaceforbusiness.com> includes features such as: a member-generated content management and customizable multi page system that allow users the ability to submit business profiles to create a free web space; a large and growing collection of business content, which include useful links to additional related resources, relevant sponsored links and featured solutions from third-party partners; online office applications and e-mail capabilities; business matchmaking services; downloads and calculators; articles; blogs and forums.

The Respondent has just recently begun seeking capital by exploring whether it could enter into a business/investment partnership with another party. A solicitation was emailed to over two dozen potential investors, including News Corporation.

As indicated on the web site at <sedo.com>, the Respondent is apparently offering both of the disputed domain names for sale (a copy of the pertinent pages from that site appear in Exhibit X to the Complaint).

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 MYSPACE marks.

In essence, the Complainant states that each of the names incorporates its mark MYSPACE followed by a descriptive term which describes a corresponding target audience to which a web site resolved through that name is aimed (specifically business and Hispanics for the corresponding names <myspaceforbusiness.com> and <myspacehispano.com>).

Moreover, by the time when the Respondent registered the names during the March-April 2006 timeframe, the Complainant had long-since established substantial

worldwide consumer recognition in its mark MYSPACE, to the point where that mark had attained fame. This effectively precluded the Respondent from attaining any common law trademark rights in that mark then superior to the Complainant's rights.

Hence, the Complainant believes that, with respect to each name, 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 either of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant alleges, that given just how widely recognized its mark MYSPACE had become by the time the Respondent registered both names, then, by that time, the Respondent simply could not have legitimately used either name in connection with a networking web site or similar service without infringing on the Complainant's trademark rights.

In addition, the Complainant alleges that the Respondent is not commonly known by either name and is not making a legitimate noncommercial or fair use of that name. Moreover, there is no relationship of any sort between the Complainant and the Respondent would give rise to any license, permission or authorization through which the Respondent could legally own or use either of the disputed domain names.

(iii) Registered and Used in Bad Faith

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

First, the Complainant alleges that the Respondent's web sites, resolvable through the disputed domain names, not only compete with but also are visually similar to that of the Complainant (comparing a copy of the home page of <myspaceforbusiness.com> and <myspacehispano.com> appearing in Exhibits V and W of the Complaint with a copy of the home page of the Complainant's site appearing in Exhibit F to the Complaint). The similar web page format, combined with the misappropriation of the Complainant's mark on the web pages and in the names themselves, and particularly given the competitive and commercial nature of the Respondent's sites, collectively reflect bad faith.

Second, given the substantial worldwide recognition, i.e. fame, which the Complainant's MYSPACE Marks have attained by the time the Respondent registered the disputed domain names which would effectively have precluded the Respondent from any legitimate use of those marks for web site networking services, the Respondent's registration and subsequent use of those names — which include the Complainant's mark MYSPACE followed by a descriptive term — for similar services, and obviously with prior notice of those Marks, was done in bad faith.

Lastly, by now offering both names for sale, the Respondent's intent is to sell the names to the highest bidder — certainly for amount in excess of its costs of registration. This too evinces bad faith.

B. Respondent

(i) Identical or Confusingly Similar

At its kernel, the Respondent's rather extended arguments here distill down to the following. First, the Respondent observes that the Complainant's MYSPACE mark is formed of two generic words "MY" and "SPACE". The Respondent then extrapolates, as its core premise, that the composite term MYSPACE consisting of these two generic terms must itself, by extension, be generic and thus incapable of both acquiring any distinctiveness and consequently conveying any exclusivity and therethrough any valid protectable trademark rights to the Complainant.

Further, the Respondent also argues that the term "my space", when collectively viewed, is itself a generic term commonly used on the Internet which, when used in conjunction with various descriptive words, forms a widely understood reference to other web sites, thus additionally precluding the existence of any valid trademark rights in that specific term or similarly in the mark MYSPACE.

Ostensibly, in the absence of having valid trademark rights in the MYSPACE mark, the Complainant is unable, as a threshold matter, to satisfy the requirements of paragraph 4(a)(i) of the Policy, thus the Complaint must fail.

(ii) Rights or Legitimate Interests

The Respondent contends that it has rights and legitimate interests in the disputed domain names because it is currently using them as portal sites to which over 2000 members currently have access. Further, the Respondent claims that it is legitimately using these names to sell goods and services: "Advertising, product sales, business service sales, banner ads, affiliate programs, and the full spectrum of business activity is well within the right of the Respondent, and within the concept of legitimate rights and usage." The Respondent, without more, predicates its claim to its legitimacy under paragraph 4(c)(i) of the Policy.

(iii) Registered and Used in Bad Faith

The Respondent contends that since the domain names are constituted by common words in the English language, its registration of those names was undertaken in good faith and not for the purpose of selling or transferring the names to the Complainant or one of its competitors for a sum in excess of its costs of registration.

Further, given the widely understood generic meaning of each of the names, there is no basis for the Panel to conclude that the Respondent used either name as a vehicle for attempting to deceive potential customers into believing that its services were the same as those of the Complainant. In that regard, although, broadly speaking, both the Complainant and the Respondent each provides networking sites, the Respondent's site reachable through <myspaceforbusiness.com> is exclusively directed to business users rather than, as with the Complainant's web site, individuals, with the latter there seeking Internet based dating, introduction and social networking services.

Additionally, the Respondent states that it has invested considerable amounts of time, effort and money to develop working sites resolvable through the names. Further, the Respondent has just recently begun seeking capital by possibly entering into a business/investment partnership with a third-party and has approached the Complainant's owner, News Corporation, as one such party.

As further evidence of its good faith, the Respondent points to a disclaimer on the home page of its <myspaceforbusiness.com> web site, which reads in pertinent part: “Unlike social networking sites like MySpace, we focus exclusively on business networking, targeted towards small and medium size businesses (SMBs). MySpace Business Networking is for SMBs and for anyone who has an interest in business.”

Lastly, since the Respondent has a legitimate interest in the names, the Panel need not consider the question of bad faith as it is moot.

6. Discussion and Findings

A. Descriptiveness and validity of MYSPACE Marks

Though the Respondent zealously argues that the term MYSPACE is either generic or highly descriptive and thus not capable of serving as a trademark, such arguments, when submitted to an ICANN administrative panel, are misdirected.

Issues concerning trademark validity, which the Respondent here raises in the context of a lack of registerability owing to descriptiveness or genericness of the term MYSPACE, are clearly not within the purview of any UDRP proceeding and are best left for administrative and/or judicial adjudication. Not only is doing so outside the very limited and focused jurisdiction afforded to ICANN panels under the Policy, but also and moreover the summary and rather abbreviated nature of UDRP proceedings totally precludes the establishment of a fully developed factual record that underlies a proper inquiry into such issues.

As this Panel has repeatedly cautioned in a number of prior decisions, ICANN panels cannot and hence do not assess the validity of any federally registered trademark. Instead, such panels must, of necessity, accord significant deference to decisions of that government body, namely here the US Patent and Trademark Office (PTO), which, in the first instance not only possesses the requisite expertise to assess such issues but also the federal statutory mandate to do so. It is simply not within the purview of any ICANN panel to review and evaluate, let alone over-ride, the judgment of the US PTO on such questions. Moreover, even apart from those jurisdictional concerns but clearly in view of the rather summary and abbreviated nature of UDRP proceedings, an ICANN panel, as here, is too grossly ill-equipped to deal with an extensive factual inquiry that typically underlies an invalidity determination. See, e.g., *Tetris Holding, LLC v. Smashing Conceptions*, NAF Case No. FA1030720 (September 11, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle* WIPO Case No. D2004-0824 (January 18, 2005); *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet and Marketing Rightway Gate Inc., et al*, NAF Case No. FA 208576 (January 27, 2004); *United States Office of Personnel Mgmt. v. MS Tech. Inc.*, NAF Case No. FA 198898 (December 9, 2003), and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758 (October 4, 2002).

Hence, once the US PTO has made a determination that a mark is registerable, as it has here by issuing a registration to the Complainant for each of its MYSPACE Marks, an ICANN panel is not empowered to nor should it disturb that determination. By federal statute, a registered US trademark carries a presumption of validity, which this Panel will not question. In that regard, see 15 U.S.C. § 1115(a) which states in pertinent part: “Any registration [...] or a mark registered in the principal register [...] shall be prima

facie evidence of the validity of the [...] registration of the mark [...] and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration [...]"

To the extent the Respondent wishes to challenge the US PTO's determination that any of Complainant's MYSPACE Marks has acquired sufficient distinctiveness upon which its corresponding federal registration can be based, the Respondent may well have appropriate administrative and/or judicial avenues available to it to do so, such as by filing an action in the US PTO to cancel that registration or alternatively instituting federal litigation to invalidate it. Absent the Respondent having done so and attained a final ruling that any of the Complainant's federally registered MYSPACE Marks is indeed sufficiently descriptive or generic and thus not susceptible of registration, this Panel will simply defer, as it must, to the US PTO's determination implicit in its having granted a registration, i.e., that each of the Complainant's MYSPACE Marks has acquired sufficient distinctiveness and hence is not descriptive or generic, and thus qualifies for federal trademark protection and enjoys all the rights afforded thereby.

Therefore, the Panel declines the Respondent's earnest invitation to consider whether any of the MYSPACE Marks is sufficiently descriptive or generic and consequently not susceptible of federal registration. Inasmuch, as resolution of this issue does not lie with this or any ICANN Panel, this Panel, for lack of jurisdiction, must reject all the Respondent's arguments concerning this issue.

B. Identical or Confusingly Similar

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

From a simple comparison of each of the domain names to the marks, no doubt exists that both disputed domain names are, for all practical purposes, confusingly similar to the MYSPACE Marks. The only differences between the domain names and the mark MYSPACE are the addition, as a suffix to the mark, of the generic term "for business" for the name <myspaceforbusiness.com> and the geographically/ethnically descriptive term "hispano" for the other name <myspacehispano.com> to form corresponding composite terms, and the appending of a gTLD (generic top level domain) ".com" to each such composite term to form each 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 either of the generic and highly descriptive words "for business" and "hispano", respectively, to the mark MYSPACE is clearly one such minor variation. See, e.g., *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 Corp. v. Hevun Diversified Corp., NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. 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. 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); *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).

Further, such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's web site, but who instead were to reach the Respondent's site to which either name were to resolve, to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. See, e.g., *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (August 16, 2006); *Blackrock, Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx*, and *Lockheed v. Teramani*, all cited *supra*; see also *Register.com, Inc. v. Reile*, NAF Case No. FA 208576 (January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corp. 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); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (Sept. 11, 2002); *L.F.P., Inc. v. B and J Properties*, NAF Case No. FA 109697 (May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, NAF Case No. FA 100492 (December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, NAF Case No. FA 97186 (July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *American Home Products Corporation v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, NAF Case No. FA 95856 (December 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, e Resolution Case No. AF-0145 (May 3, 2000).

Moreover, by including the terms "for business" or "hispano" with the Complainant's mark MYSPACE to form the corresponding disputed domain names, the potential for user confusion is likely to be exacerbated, not reduced. In that regard, the services which the Complainant offers through its mark are social networking services. Consequently, those Internet users who seek information on the Complainant's services, but specifically for the business or the Hispanic communities, may well be quite likely, given current naming conventions on the Internet used in forming domain names, to enter, as a corresponding domain name, the Complainant's mark MYSPACE immediately followed by the specific user communities of interest, here being "for business" or "hispano", respectively, and concluding with ".com" (as a widely used

gTLD) for commercial web sites associated with business-oriented and Hispanic-oriented sites offering the Complainant's services specifically geared to those respective communities — thus yielding the disputed domain names. Rather than reaching the Complainant's web site, as expected from entry of either of those names into a browser, each of those users would instead be directed to the Respondent's corresponding web site through which that user would be offered Respondent's networking services. Hence, by appending what are in effect community descriptors to the Complainant's mark, those users would likely be deceived into thinking that the Respondent's site and the services offered there through for those user communities were somehow affiliated, related to or sponsored by the Complainant — when, in fact, they are not. Thus, the Panel finds that that the disputed domain names here, which contains the terms “for business” and “hispano”, along with the Complainant's mark MYSPACE tend to aggravate, rather than ameliorate, user confusion and do so to the Respondent's ultimate benefit — and that is very likely the reason why the Respondent chose those names.

Therefore, the Panel finds that the disputed domain names <myspaceforbusiness.com> and <myspacehispano.com> are confusingly similar to the Complainant's MYSPACE Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

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

The Complainant has never authorized the Respondent to utilize any of its MYSPACE Marks or any mark confusingly similar thereto in conjunction with the services with which the Complainant uses that mark or for similar services, 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 any of the MYSPACE Marks or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, those being social and individual networking services and others as recited in its trademark registrations, would violate the exclusive trademark rights now residing with the Complainant. See, e.g., *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*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark MYSPACE or one similar thereto, at least for the services rendered by

the Complainant, or, broadly speaking, any service likely perceived by its users to be so similar and/or to emanate from or be related, in any fashion, to those then offered by the Complainant.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by either of the disputed domain names. Nor could the Respondent in this case ever become so known, in light of the Complainant's exclusive trademark rights, dating back approximately 3 years prior to the dates during late March-late April, 2006 on which the Respondent registered the names, and the extensive worldwide reputation and notoriety which the Complainant has gained in its marks during that time, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc.*, cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, since the Respondent's use of the name, which in this Panel's view infringes the Complainant's trademark rights, can not constitute a *bona fide* offering of services and is unquestionably commercial in nature, the Respondent's conduct does not fall within paragraphs 4(c)(i) or 4(c)(iii) of the Policy either.

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

D. Registered and Used in Bad Faith

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

The Panel believes that the Respondent was well aware of the Complainant and its mark MYSPACE when the Respondent registered the disputed domain names. Yet, in spite of that knowledge, the Respondent intentionally chose and registered each of the names to opportunistically exploit its potential to generate user confusion for the Respondent's eventual benefit. Given the widespread worldwide notoriety and reputation which the Complainant's mark MYSPACE had garnered by then, it simply strains credibility to think that the Respondent had no such knowledge of those marks — nor does the Respondent, in arguing that the names are generic or highly descriptive, refute having such prior knowledge. The disclaimer which the Respondent placed on the home page of its site and which explicitly mentions the Complainant, by its name and mark MYSPACE, explicitly reflects the Respondent's prior knowledge of the Complainant's mark.

Moreover, though the Respondent points to the disclaimer on its "www.myspaceforbusiness.com" web site (no disclaimer at all appears on its "www.myspacehispano.com" web site) as an act of good faith, that disclaimer, contrary to the Respondent's view, markedly accentuates the potential for confusion. The disclaimer, as indicated above, reads in pertinent part: "Unlike social networking sites like MySpace, we focus exclusively on business networking, targeted towards small and me-size businesses (SMBs). MySpace Business Networking is for SMBs and for anyone who has an interest in business." It stands to reason that an Internet user who reads this disclaimer is rather likely to think that, although the Respondent's site does not offer the specific type of social networking geared to individuals as then typically offered by the Complainant, nevertheless the Complainant apparently authorized the

Respondent to extend the Complainant's networking services to the business community and to so offer those services accordingly — when in fact the Complainant did nothing of the sort.

The Respondent, in choosing to register and then use the disputed domain names, clearly anticipated and feared some form of legal retaliation from the Complainant — certainly enough to induce it to include the disclaimer. Yet, the very wording of this particular disclaimer likely deceived those Internet users by its utter failure to completely, clearly and explicitly refute the existence of any connection between the Respondent's site and the Complainant. Whether, generally speaking, appropriately-worded disclaimers are sufficient in and of themselves to counter user confusion is an issue this Panel need not reach, as the disclaimer here clearly did not suffice. The Panel believes that the Respondent, in carefully choosing the specific language it did for the disclaimer, did so for its specific potential to cause heightened confusion — even though, at first blush, one might think that a disclaimer invariably reduces confusion; it was not likely to do so here.

By attracting Internet users to its web sites under false pretenses, i.e., through the expectation that the Respondent's sites were a source for social or individual networking or related services either provided by the Complainant or in some fashion related to, sponsored by or affiliated with the Complainant, when, in fact, it was neither and could not be, the Respondent then proceeded to solicit its own networking services, through which the Respondent would undoubtedly receive some form of enhanced benefit, such as and stemming from increased membership and visitor/user traffic, than it otherwise would have attained had it used different domain names totally dissimilar to any of the Complainant's MYSPACE Marks.

Hence, it is clear to this Panel that the Respondent not only intentionally chose and registered the names to opportunistically exploit their potential to generate user confusion for the Respondent's eventual benefit, but also ultimately used the names to achieve just that end. See, e.g., *F. Hoffmann-La Roche AG*, cited *supra*.

Hence, the Panel concludes that the Respondent's actions are in line with paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to both 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.

The disputed domain names, <myspaceforbusiness.com> and <myspacehispano.com>, are ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: March 12, 2008