



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Verizon Directories Corp. v. Tamra Hartley and Domains by Proxy, Inc.**

**Case No. D2006-0176**

### **1. The Parties**

The Complainant is Verizon Directories Corp., Arlington, Virginia, United States of America, represented by Covington & Burling, United States of America.

The Respondents are Tamra Hartley, Auburn, Maine, United States of America; and Domains by Proxy, Inc., Scottsdale, Arizona, United States of America. Though two respondents are named, Domains by Proxy is a nominal respondent. Thus, for simplicity, the term Respondent, as used hereinafter, will just refer to Ms. Hartley in her capacity as the actual registrant and current owner of the disputed domain name.

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

The disputed domain name <superepages.com> is registered with Go Daddy Software.

### **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 by 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 February 8, 2006, and in hard copy form on February 14, 2006, along with Annexes A-N.

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 Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on February 9, 2006, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed 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 domain name will remain “locked” during the proceeding.

Subsequently, on February 9, 2006, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in its WhoIS database, confirmed that GoDaddy Software is the registrar of that name and stated that: it had not received a copy of the Complaint, the Policy applied to the disputed domain name and the name was then held in a “register hold or lock” status pending the resolution of this proceeding, specified that the registration agreement is in English and that the Registrant, through the registration agreement, submitted to jurisdiction, for court adjudication, at the location of the principal office of the Registrar.

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

On February 16, 2006, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier and email (the latter being without the annexes), to the Respondent. 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.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, in detail, 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 March 8, 2006, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Center received a Response in email form on February 16, 2006. In an email letter dated February 17, 2006, the Center notified the parties that it received the Response.

Thereafter, the both parties filed a series of supplemental submissions. The Respondent filed separate supplemental submissions on February 20, 2006; February 21, 2006; February 22, 2006; and February 23, 2006. The Respondent also filed a further supplemental submission on February 24, 2006 which forwarded a final and supplemented version of the Response. Thereafter, on February 27, 2006, the Respondent filed a response to the Complainant’s Reply; and on March 7, 2006, the Respondent filed two separate filings in response to the Complainant’s March 7th

filing. The Complainant filed separate supplemental submissions on February 17, 2006, along with a slightly amended Complaint, and on February 25, 2006, the latter forwarded a “Request to file a Reply to the Complainant’s Multiple Responses” along with the Reply itself together with Annexes O and P. The Complainant also filed a supplemental submission on March 7, 2006.

The Center, after the last supplemental submission had been filed and through an e-mail letter dated March 10, 2006, 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 24, 2006. However, due to time conflicts experienced by the Panel, the Center, upon the Panel’s request, extended the due date.

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

A copy of the most recent WhoIS registration record for the disputed domain name appears in Annex A to the Complaint. As indicated on this record, the Respondent registered the disputed domain name on June 25, 2002.

##### **A. Complainant’s SUPERPAGES Marks**

The Complainant owns two federal trademark registrations and one pending federal trademark application for its marks that contain the term “Superpages” and on which this dispute is based. The Complainant has provided, in Annex E to the Complaint, hard-copy printouts of the corresponding entries in the USPTO (United States Patent and Trademark Office) Trademark Electronic Search System (TESS) and Trademark Applications and Registrations Retrieval (TARR) databases for these marks. These registrations and the application are as follows:

- (a) SUPERPAGES.COM (block letters)  
United States registration 2,765,993; registered: September 23, 2003

This mark was registered for use in connection with “electronic telephone directory services, and dissemination of advertising for others via an online communications network” in international class 35. The Complainant claims that first use and first use in commerce of the mark in conjunction with these services commenced as of April 15, 1996.

- (b) SUPERPAGES (block letters)  
United States registration 2,022,484; registered: December 10, 1996

This mark was registered for use in connection with “electronic telephone directory services” in international class 35. The Complainant claims that first use and first use in commerce of the mark in conjunction with this service commenced as of April 15, 1996.

- (c) SUPERPAGES (block letters)  
United States pending application serial number 78/195,699  
filed: December 18, 2002 (intent to use; statement of use filed January 6, 2006)

This mark applied for use in connection with “telephone directories” in international

class 16 and “advertising services, namely promoting the goods and services of others by means of telephone directories; and dissemination of advertising for others via an online communications network” in international class 35. The Complainant claims that first use and first use in commerce of the mark in conjunction with the goods in class 16 commenced on February 10, 2003 and in conjunction with the services in class 35 commenced as of April 15, 1996.

The Complainant also claims ownership of common law rights in the marks SUPERPAGES for yellow-pages print and online directories and SUPERPAGES.COM for a variety of services, including online yellow-pages directory and advertising services, online shopping resources, web design and hosting services, domain name registration services, domain name leasing services, online bookstore services, maps and driving directions, electronic postcard services and Internet tutorials.

For ease of reference, all these marks will be collectively referred to hereinafter as simply the SUPERPAGES Marks.

## **B. The Parties**

The Complainant is Verizon Directories Corp., a corporation organized under the laws of the state of Delaware, with its principal place of business located outside of Dallas, specifically at 2200 W. Airfield Drive, DFW Airport, Texas. The Complainant’s predecessor in interest was GTE Directories Corporation, a Delaware corporation, which changed its name to Verizon Directories Corp. on July 31, 2000, and subsequently merged with and into Verizon New Media Services Inc. under the name of Verizon Directories Corp. on January 31, 2002, (“Predecessor Companies”). The Complainant is a subsidiary of Verizon Information Services Inc., a corporation organized under the laws of Delaware with its principal place of business in Dallas, Texas. Verizon Information Services Inc. is a subsidiary of Verizon Communications Inc., a corporation organized under the laws of Delaware and headquartered in New York, New York.

Since 1996, the Complainant and its Predecessor Companies have maintained an Internet presence via a website located at “www.superpages.com”. One of the Complainant’s Predecessor Companies registered the <superpages.com> domain name on January 31, 1996 and began actively using the SUPERPAGES Marks in commerce and on the Internet since at least as early as April 1996.

The Complainant and its Predecessor Companies have advertised and promoted many services offered under the SUPERPAGES Marks extensively throughout the United States and internationally through advertisements on the Internet, in print directories, and in magazines, newspapers and promotional materials, and on billboards. The Complainant and its Predecessor Companies have spent millions of dollars advertising and promoting its products and services under the SUPERPAGES Marks. In Annex F to the Complaint, the Complainant has provided hard-copy printouts of a small sample of web pages that bear these Marks.

The Respondent, an individual, resells children’s books, scrap-book supplies, papermaking supplies, stationary and other similar items. She registered the disputed domain name in June 2002 intending, at the time, to use it in conjunction with an e-commerce shopping site that offered “super deals” on a wide variety of items. The Respondent states that she never intended to sell or promote phones, cell phones, phone plans, phone directories etc. through that name. Apparently, the Respondent currently uses the term “superEpages” to resolve to a site affiliated with Ebay (specifically

stores.ebay.com/superEpages) i.e., part of the Ebay web site itself, through which the Complainant offers various products for sale.

### C. Interactions between the Parties

The Complainant became aware of the Respondent's registration of the disputed domain name in September 2003. At that time, the Complainant sent the Respondent a letter (a copy of which appears in Annex D to the Complaint) requesting transfer of the name. A series of communications then occurred between the parties, both through e-mail and postal mail.

During the course of this communication (copies of at least some of which appear in Annex D to the Complaint), the Respondent listed the disputed domain name for sale through a public auction web site for US \$ 25,000.00, and, through an e-mail dated November 18, 2005, so notified the Complainant. A copy of this e-mail appears in Annex D-6 to the Complaint and states in pertinent part:

"I wanted to let you know that I have listed the domain superepages.com for sale in the Domain Marketplace. I do have a current offer of \$ 17,500.00 ... I have not responded to the bid. I have other offers but this one is the highest so far. I wanted to hear from you first before moving forward with the current bid. I would greatly appreciate a return note."

This Annex also contains a hard-copy printout, made on November 21, 2005, of the "Domain Name Aftermarket" web site, "www.tdnam.com", through which the domain name was offered, via an auction sale, at a then current bid price of US \$ 25,000.00. Apparently, during that time, the Respondent and her family were, for several reasons, experiencing financial difficulties which precipitated her decision to sell the domain name. The Respondent set the auction price as a result of a consultation she had with an attorney and a discussion she held with a "web domain representative".

Thereafter, on November 22, 2005, the Respondent telephoned the Complainant's attorney and left the following voice message, the transcript of which, prepared by that attorney's staff, appears in Annex D-7 to the Complaint:

"I'm calling in regards to superepages.com. I sent a couple of emails, but haven't heard back. Um, just wondering what ... you know ... your position was on that, because I ... I would like to get the sale done. Um, and, just wondering if this is something that you all were able ... or in a ... able to purchase, or if you wanted to, before I sold it to someone else."

The Complainant's attorney responded, by letter dated December 5, 2005, (a copy of which appears in Annex D-8 to the Complaint) to the Respondent, through which the attorney again demanded transfer of the domain name but only offered to reimburse the Respondent for her reasonable out-of-pocket costs associated with registering the name.

The Respondent, through an e-mail dated December 5, 2005, (a copy of which appears in Annex D-9 to the Complaint) to the Complainant's attorney, refused the demanded transfer by stating in pertinent part:

"I have spoken with an attorney regarding this situation. There is a legal market of the selling of domain names. <superepages.com> is not <superpages.com> they are two different domains. If they are not selling in the same market (phones and everything that goes with that as Verizon is) then both can exist separately

and legally. I have had offers as much as \$ 17,000.00 for this domain and have disclosed to then that Verizon is having an issue. ... The courts have ruled over and again that the company, just because they did not think of the domain first, does not have the right to just take it and have had to pay fair market value, which is significantly higher than the out-of-pocket expenses for the domain rights. ... I have not been malicious in this what so ever. I have my families best interests at heart and as anyone else, money does help. I have not accepted any of the offers to date. I wanted to hear from you regarding your position, I am not trying to solicit money from Verizon. I am only trying to reach an agreement that suits both of us. I see that this is not going to work, I am left with the decision to accept one of the offers leaving you to have to battle the next person which is a large company, or to go ahead and keep it for the purpose and plan I originally purchased the domain for.”

Then, on February 8, 2006, the Complainant electronically filed the Complaint with the Center to initiate this proceeding.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's SUPERPAGES Marks.

Specifically, the Complainant alleges that the only difference between the disputed name and those Marks is the inclusion of the letter “E” between the words “SUPER” and “PAGES” within the name -- a difference which is imperceptible. Along those lines, the Complainant opines that Internet users, who attempt to access the Complainant's site but inadvertently misspell or mistype the Complainant's domain name by adding an “E” to it and thus enter the disputed domain name instead, will be intentionally directed to the Respondent's web site, thus leading to initial interest confusion and evidencing Respondent's actions as a typosquatter.

Furthermore, the Complainant alleges that the Respondent's initial use of the name was in relation to a sex shop website, located at “www.loverscatalog.com”, which was unrelated to the Complainant, with a subsequent use being in conjunction with an online store administration service provided by Amazon.com which again had no relation whatsoever to the Complainant. Through such uses and with specific reference to the latter use, the Complainant believes that Internet users will mistakenly believe that Respondent's affiliated “superepages.com” online store service is somehow affiliated or endorsed by the Complainant, when it is not; thus causing confusion among those users who visit the Respondent's site.

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, for several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant alleges that no evidence exists that the Respondent has ever used, or made any demonstrable preparations to use the disputed domain name in connection with any *bona fide* offering of goods or services, or has ever been commonly known by that name. The Complainant notes that, ever since the domain name was registered in June 2002, the Respondent has either parked the name at the Registrar, used the name to re-direct Internet users to a sex shop web site or parked the name at an inactive Amazon store link (see hard-copy printouts dated August 18, 2003; April 11, 2004; September 21, 2004; July 21, 2005; December 7, 2005, and February 8, 2006, in Annexes H, I, J, K, L, and M, respectively, to the Complaint).

Second, the Complainant alleges that since June 2002, the Respondent has yet to make any demonstrable preparation to use the name in connection with any *bona fide* offering of goods or services. In that regard, the Complainant states that the Respondent's only use of the name was as mechanism to re-direct Internet users to a sex shop web site at "www.loverscatalog.com", through which the Respondent presumably profited from sex toys and other adult products which Internet users purchased through that site. Such conduct not only does not constitute a *bona fide* offering of goods or services, but also reflects bad faith. Moreover, the Complainant notes that although the Respondent repeatedly expressed an interest to establish a shopping site through the disputed domain name, the Respondent admits, as reflected in the e-mails in Annex D to the Complaint, that she has not yet established such a site because, as the Respondent stated, she has "a young family ... time is not plentiful to take on the store quite yet". This, in turn, shows a lack by the Respondent of any demonstrable preparations to use the name.

Third, the Complainant states that the Respondent has not provided any evidence indicating that the Respondent is commonly known by the disputed domain name, with overwhelming evidence being to the contrary.

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

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

First and as noted above, the Complainant contends that the Respondent evidenced bad faith in using the name to re-direct Internet users to a sex shop web site through which the Respondent presumably profited from sales made through that site.

Second, the Complainant contends that bad faith is also shown by the Respondent not having used the name, i.e., passively held it, for over three year since she registered it.

Third, the Complainant contends that the Respondent, after having been placed on notice of this dispute and particularly of the Complainant's SUPERPAGES Marks, offered to sell the name for an amount which far exceeds her reasonable out-of-pocket costs for registering the name. Specifically, the Respondent persistently attempted to elicit a lucrative bid, ultimately of US \$ 25,000.00 from the Complainant after having previously received several bids from others, each of which considerably exceeded

those costs. Ultimately dissatisfied with the Complainant's refusal to pay the requested price, the Respondent threatened the Complainant that she might accept one of the other bids.

## B. Respondent

The Respondent states that, in registering the disputed domain name, she originally intended to use it for an affiliate shopping site, specifically one that offered "super" deals on a wide variety of items. Apparently sometime later, she changed her plans somewhat and then intended to use the name in conjunction with an e-commerce site that made the same offerings. However, in spite of her intentions, other demands existed for her time, including that of her family, thus forcing her to set aside her plans to implement an operative web site. The Respondent never intended to use the name to sell or promote telephony-related products or services.

Further, though the Respondent was initially contacted by the Complainant, she refused its demand to transfer the domain name on the ground that she thought that the Complainant should purchase the name for a "fair amount", not merely just the reimbursement offered by the Complainant.

A few years later, the Complainant again contacted the Respondent and demanded transfer of the name. At that time, the Respondent and her family were experiencing financial difficulties and her husband underwent emergency back surgery. Accordingly, she was then dissolving various assets, including the disputed domain name, to "keep things afloat". In that regard, the Respondent states:

"Well superEpages seemed to be an asset because not only was Ms. Hamilton [Complainant's attorney] telling me to hand over the domain but I was receiving offers to sell the site to someone else. I consulted a lawyer and spoke with a web domain representative regarding its worth and I did list the site for sale."

The Respondent states that she based her asking price, US \$ 25,000.00, on discussions she held with a lawyer who handles domain name sales. She then notified the Complainant, though the Respondent states that she never solicited any money from Complainant or Complainant's attorney. In that regard, the Complainant states:

"I did contact a lawyer who deals with the selling of domains and he suggested the amount of \$25,000.00 for a start list price. I felt this was a lot of money but he assured me that it was fair value. So I listed it and did notify Hope Hamilton of the listing. I NEVER EVER solicited ANY money from Mrs. Hamilton or Verizon. I NEVER TOLD HER THAT I WANTED TO SELL THE DOMAIN NAME FOR THIS AMOUNT TO VERIZON. I notified them of the sale and that I had offers from others. She informed me that I would need to let the potential buyers know that Verizon was having an issue with the domain. Which I did, and they still wanted it. In the end I did not sell the domain and have had many offers but have not sold it. I am not an extortionist, I believe that Verizon and Mrs. Hamilton are trying to use their big corporations and money to push me around and gain something for nothing at my expense."

The Respondent, in summarizing her position, states:

"I do not feel that it is okay for a large corporation to try to walk all over a lay person just because someone may have a domain name that they are interested in. The domain is not being used in any way and will never be used to hurt or divert

traffic from Verizon. There are many big corporations whose names are used in many ways all over this internet. The domain name does not divert traffic in the search engines, it is the meta-tags and content that pulls the searches.”

According to the Respondent, her affiliated shopping site can now be found at “www.stores.ebay.com/superEpages” with “many, many new items coming” presumably to be offered for sale through that site.

### C. Supplemental Submissions

While the Rules are silent on supplemental submissions and thus do not expressly permit such submissions, conversely the Rules do not expressly prohibit them either. Consequently, the Panel has the discretion to consider such submissions or not. This Panel, in exercise of its discretion, has fully considered each of these submissions.

Given the number of such submissions filed by both parties, the Panel has not summarized each of these submissions. Instead, the Panel has simply incorporated the pertinent points raised in these submissions into either the factual background or contentions sections of this decision, as appropriate, above.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that confusion is indeed very likely to arise as a result of the Respondent’s use of the disputed domain name.

Apart from the existence of the generic top level domain “.com” in the domain name -- which is completely ignored in assessing similarity, the disputed domain name <superepages.com> simply contains the Complainant’s mark SUPERPAGES with the letter “E” situated between the terms “SUPER” and “PAGES”. This addition, being as *de minimus* as it is, is patently insufficient to convey sufficient distinctiveness to the domain name so as to avoid confusion of Internet users when the disputed domain name <superepages.com> is compared, in its entirety, with the mark SUPERPAGES.

It is now very well-established in UDRP precedent, including various decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. See, e.g., *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) and *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004). This result follows from a simple comparison of the disputed domain name against the mark.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant’s web site, but who reach a web site through the disputed domain name, 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., *Lockheed v. Skunkworx and Lockheed v. Teramani*, both cited *supra*; *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al*, FA208576 (National Arbitration Forum, January 27, 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*, FA 173362 (National Arbitration Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (National Arbitration Forum, October 14, 2002); *AT&T Corp. v. Roman Abreu*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (National Arbitration Forum, 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*, FA 100492 (National Arbitration Forum, December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (National Arbitration Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *American Home Products Corporation v. Ben 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*, FA 96101 (National Arbitration Forum, 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.*, FA 95856 (National Arbitration Forum, December 18, 2000); see also *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution, May 3, 2000).

Therefore, the Panel finds that the disputed domain name sufficiently resembles the Complainant's SUPERPAGES Marks as to cause confusion; hence, the Complainant has shown sufficient similarity between those Marks and the disputed domain name under paragraph 4(a)(i) of the Policy.

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

The Panel believes that not only has the Respondent not provided any basis that would legitimize any claim she has to the disputed domain name, but also it is extremely unlikely that the Respondent could ever make such a claim.

The simple reason is that the disputed domain name contains the Complainant's mark SUPERPAGES under which the Complainant provides its services and has continuously done so since at least as early as April 1996 – which predates, by nearly six years, the date, June 25, 2002, on which the Respondent registered the disputed domain name.

Furthermore, the Complainant has never authorized the Respondent to utilize any of its SUPERPAGES Marks or any mark confusingly similar thereto in conjunction with the specific services which the Complainant provides under its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the SUPERPAGES Marks or one confusingly similar thereto, which here includes the term Superepages, in connection with those or similar services, the latter including the promotion or goods and/or services of others -- which the Respondent is currently doing through her affiliate web site and intends to do through her own site if and when her own site were ever to become operational -- would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Cheesecake Factory*, *Napster* and *Caesars Entertainment*, cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 18, 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); *MPL Communications, Limited and MPL Communications, Inc. v. LOVEARTH.net*, FA 97086 (National Arbitration Forum, June 4, 2001); *Leiner Health Services Corp., AT&T Corp. and MPL Communications*, all cited *supra*; *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 12, 2000); and *Treeforms, Inc.*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the SUPERPAGES Marks and hence could never be commonly known or recognized by any of those marks or a term confusingly similar thereto and thus could never fall within paragraph 4(c)(ii) of the Policy.

With respect to paragraph 4(c)(i) of the Policy, nothing in the record indicates that the Respondent began using the disputed domain name or made demonstrable preparations to use the name in connection with offering any goods and services, on a *bona fide* basis, before she was initially contacted during September 2003 by the Complainant and then placed on notice of this dispute. While this paragraph of the Policy merely requires that a respondent show that it has made such “demonstrable preparations”, this paragraph does not specify any specific minimum *quanta* of effort which would qualify as being sufficient across all factual instances to constitute demonstrable preparations, hence leaving the decision to each administrative panel to be made on a case-by-case basis. However, it is certainly fair to say that doing nothing more than having or even expressing an intention to use a domain name in a particular fashion -- as is apparently the situation here prior to September 2003, will never rise to any such minima. Hence, the Respondent’s efforts here fail to meet paragraph 4(c)(i) of the Policy.

Lastly, nothing in the record indicates that the Respondent ever used the disputed domain name on a non-commercial or fair use basis, as would be required, as a threshold matter, should the Respondent seek protection under paragraph 4(c)(iii) of the Policy. On the contrary, the evidence adduced points to the fact that the Respondent’s use of the name, thus far on her affiliate site, was strictly to generate profit.

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.

### C. Registered and Used in Bad Faith

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

While the Panel is sympathetic to the Respondent’s financial plight during November 2005 and her necessity to offer the name for sale in order to raise sufficient funds to meet her family’s needs at the time, her rationale for doing so -- however financially justified it may have been, does not excuse her actions under the Policy.

Specifically, after a three-year period of non-use, i.e., passive holding, and in spite of repeated demands from the Complainant to transfer the name in exchange for reimbursement of her costs of registration, the Respondent offered the name for sale through an auction site for US \$ 25,000.00. When the Complainant spurned her offer, the Respondent expressly stated to the Complainant that if the latter did not purchase the name she would sell it to a third-party -- a threat which the Complainant had every right to view with serious apprehension. The fact that the Respondent never carried out its threat is irrelevant.

Moreover, the Panel does not view the Respondent's use of the term "superEpages" as an address of its "affiliated web site" (specifically at stores.ebay.com/superEpages) as being equivalent to domain name usage inasmuch as that term, when used with a different domain name, ebay.com, merely resolves to a specific page on the site associated with that particular domain name, and not to a home page of a separate and distinct web site. Since this is the only use set forth in the record to which the Respondent has made of term "superepages", the Panel can only conclude that the Respondent has yet to use the disputed domain name as such since she registered it on June 25, 2002.

When viewed in its entirety, her conduct clearly constitutes bad faith registration and use in violation of the general provisions of paragraph 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations 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 now grants the relief sought by the Complainant.

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

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Peter L. Michaelson  
Sole Panelist

Date: April 10, 2006