



**NATIONAL
ARBITRATION
FORUM**

NATIONAL ARBITRATION FORUM

DECISION

Michael Machat v. Jaden Thompson a/k/a Vaden Vampes
a/k/a Vampes Domains by Proxy
Claim Number: FA0508000542036

PARTIES

Complainant is **Michael Machat** (“Complainant”), represented by **Susan L. Pollyea** of **Law Office of Michael Machat**, 9107 Wilshire Blvd., Suite 425, Beverly Hills, CA 90210. Respondent is **Jaden Thompson a/k/a Vaden Vampes a/k/a Vampes Domains by Proxy** (“Respondent”), Gothicastle, London, SW1, GB.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**vampiredrinks.com**>, <**vampirevodka.com**>, <**vampyrevodka.com**> and <**vampes.com**>, registered with **Enom, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum ("Forum") electronically on August 17, 2005; the National Arbitration Forum received a hard copy of the Complaint together with Exhibits A-M on August 18, 2005. In response to a request in a letter dated August 26, 2005 from the Forum setting forth various deficiencies in the Complaint, the Complainant filed an Amended Complaint with the Forum on August 30, 2005 together with additional Exhibits N-P.

On August 17, 2005, Enom, Inc. ("Registrar") confirmed by e-mail to the National Arbitration Forum that the <**vampiredrinks.com**>, <**vampirevodka.com**>, <**vampyrevodka.com**> and <**vampes.com**> domain names are registered with Enom, Inc. and that Respondent is the current registrant of all the names. Enom, Inc. has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy, and that the disputed domain names will remain in a locked status.

On August 31, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of September 20, 2005 by which Respondent could file a Response to the Complaint, was transmitted by the Forum to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@vampiredrinks.com, postmaster@vampirevodka.com, postmaster@vampyrevodka.com and postmaster@vampes.com by e-mail.

A timely Response was received and determined to be complete on September 6, 2005.

Between August 17, 2005 and September 27, 2005, Respondent sent a considerable amount of e-mail correspondence to Complainant and also copied it to the Forum. None of this correspondence complied with Supplemental Rule 7 of the Forum.

On September 12, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a deadline of September 26, 2005 to receive the decision from the Panel.

In light of unexpected time conflicts experienced by the Panel which amounted to exceptional circumstances, the Forum, at the Panel's request, extended the deadline for the decision to October 10, 2005.

RELIEF SOUGHT

Complainant requests that all the disputed domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant contends that the disputed domain names are identical or confusingly similar to Complainant's VAMPIRE marks.

Specifically, Complainant notes that, once the gTLD (generic top level domain) ".com" is ignored, the remaining portions of each of the disputed domain names <**vampiredrinks.com**> , <**vampirevodka.com**> and <**vampyre vodka.com**> incorporate Complainant's VAMPIRE or VAMPYRE mark, followed by the generic word "drinks" or "vodka". Such generic words are simply insufficient in themselves to add requisite distinctiveness to those domain names in order to adequately prevent user confusion from occurring.

Given this, Complainant believes that Internet users who see these names will likely think that these names are variations of Complainant's VAMPIRE marks, particularly when these names are used in connection with vodka and other drinks.

As to the disputed <**vampes.com**> domain name, Complainant contends that this name incorporates a variation of Complainant's VAMP mark, through which Internet users would likely think that the domain name is a plural form of the mark, hence causing confusion. Complainant points to an audio recording on Respondent's web site that announces, "welcome to the companies of Vampes," pronouncing "vampes" with a silent "e". The change from the mark VAMP to a plural form in the disputed domain name <**vampes.com**> is a form of typosquatting, through which Respondent is attempting to capitalize on typographical errors made by Internet users who attempt to reach Complainant's web site.

Furthermore, Complainant contends that confusion with the VAMPIRE marks is all the more likely inasmuch as Respondent, through its web site, is offering for sale beverages, namely a "VAMP Vodka Energy Drink", "Vampes Drinks", "Vampes Wine and Beer," and "Vampes Red Vodka" (Complainant's VAMPYRE vodka is a red colored beverage), clothing and other merchandise. Complainant further contends that Respondent, in its web site (hard-copies of various pages of which are annexed to the Complaint), has adopted the same web site color scheme as Complainant of red print and images on black backgrounds, and also displays bottles and cans of beverages that have the same trade dress as Complainant's products.

In addition, Complainant contends that an online third-party review of Complainant's VAMP drink followed by comments posted by other third parties (a copy of the review and comments is annexed to the Complaint) illustrate actual confusion. In that regard,

several of the comments mistakenly refer to Complainant's products as being packaged in a "bloodbag", which is apparently how Respondent's products are advertised on its web sites.

Hence, Complainant submits that Respondent's use of identical or confusingly similar domain names and web sites with highly similar visual elements is intended to mislead and confuse Internet users into believing that there is some affiliation, connection, sponsorship, approval or association between Respondent and Complainant, when, in fact, none exists. Respondent is neither a licensee nor is it affiliated with Complainant in any manner.

Lastly, Complainant states that he is particularly concerned inasmuch as links on Respondent's web sites lead to web pages (hard-copies of selected pages are annexed to the Complaint) containing gory, pornographic images depicting semi-nude women and men dripping with blood, covered with blood, licking blood, sucking dead "human" body parts and pointing a blood covered gun at the viewer. "FETISH GORE HORROR EROTICA" boasts one of Respondent's web pages. In contrast, Complainant's customers seek classy, upscale, fashionable, fine quality products and appreciate the fanciful, tongue-in-cheek humor of the VAMPIRE marks and marketing of Complainant's products. The VAMP mark connotes a beautiful, desirable and seductive young woman. In fact, Complainant's surveys of his customers indicate that a majority of consumers of Complainant's VAMPIRE, VAMP, and VAMPYRE branded beverages are young, economically upscale women. Complainant's consumers are certain to find Respondent's gory pictures repellant and disturbing, completely negating the pleasant associations which Complainant seeks to create in promoting the pairing of VAMPIRE wine with food and providing recipes for mixed drinks using VAMPYRE vodka.

The confusion of Respondent's images with Complainant's products on the part of consumers seeking to access Complainant's web sites, but finding Respondent's sites instead, injures the goodwill established by the VAMPIRE marks and potentially results in lost revenue for Complainant.

Therefore, Complainant concludes that, for each of the disputed domain names, it has met the requirements of paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

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

First, Complainant points to the fact that Respondent registered the disputed domain names (in 2003 and 2004) long after Complainant commenced use in commerce of its VAMPIRE mark in 1988, its VAMP mark in February 2002 and its VAMPYRE mark in September 2002.

Second, the Complaint contends that Respondent is not commonly known by the names “vampiredrinks”, “vampirevodka”, “vampyrevodka”, or “vampes”, and does not do business under any of these names. Furthermore, Respondent is not associated in any way with Complainant, nor has ever been authorized or licensed to use Complainant’s VAMPIRE marks or any domain name incorporating any of those marks or a variation thereof.

3. Bad faith use and registration

Complainant contends that Respondent has registered and is using all the disputed domain names in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy, and specifically in violations of paragraphs 4(b)(ii) and 4(b)(iv).

Specifically, Complainant asserts that Respondent had constructive notice of Complainant’s rights in the VAMPIRE marks prior to registering the <vampes.com> domain name, and both constructive and actual notice of Complainant’s marks prior to registering the remaining three disputed domain names. Specifically, Respondent registered these three domain names after corresponding with Complainant in a series of e-mails (copies of which are provided with the Complaint), which are dated and summarized as follows:

(1) March 13, 2004: Respondent enclosed pictures of Complainant’s VAMP, VAMPIRE, and VAMPYRE products and a model wearing a shirt bearing the word “VAMPES”, and asked if Complainant would like to open a chain of nightclubs with Respondent in London, New York and Paris, to be called “Vampes”. The nightclubs were to feature Complainant's drinks and Respondent's models.

(2) March 15, 2004: Respondent referenced a telephone call with Complainant in which Complainant declined Respondent’s offer and advised Respondent of Complainant’s rights in the VAMP, VAMPIRE and VAMPYRE marks. Respondent offered to “cancel” his “idea to do Vampes.com wine,” saying he would just “stick to the Vodka” and launch a “Vampes.com” perfume. He acknowledged that the VAMPIRE mark in connection with wine belongs to Complainant and indicated that a third party’s <vamps.com> web site and another entity’s plans to open a “Vamps” club in England were both “a direct violation” of Complainant’s trademark rights. Respondent urged Complainant to “merge” with him in his plan to develop a hair studio, models, accessories, television series, movies and distribution of Complainant’s wines, so that together they could control the entire field.

(3) March 18, 2005: Respondent complained that he had not received a response from Complainant to his March 15 e-mail, but reassured Complainant that “we are not going to bother with wines but stick to the Vampes Vodka range.”

(4) March 26, 2004: Respondent stated that since Complainant is apparently not going to reply or work with him, Respondent will now be selling “Vampe beer”

and vodka in the U.K. He concluded that a copy of the e-mail had been sent to his legal representatives, “should anything untoward happen to the safety of myself and the people who work for me. I am sure i could recruit as many mafia contacts here in the UK as you do in the USA, so please dont believe that i will be intimidated . . .[D]ont set foot on my island with your products”

(5) June 7, 2004: Respondent wrote: “If youre vampire vodka ever comes to my island ENGLAND, I will have the lot of you sorted. youve been warned. now we will continue with vampire wine, 2 can play at this game.”

As indicated in the e-mails, Respondent was aware of Complainant’s VAMPIRE marks, but in spite of that knowledge registered and used the disputed domain names; hence indicative of bad faith. Complainant is aware of no plausible explanation as to why Respondent selected the disputed domain names, other than to trade on Complainant’s goodwill built up in his marks, and it is difficult to infer or imagine a legitimate use to which Respondent could put the names. Motivated by commercial gain, Respondent has intentionally attempted to attract Internet users to his web sites by creating a likelihood of confusion with Complainant’s VAMPIRE marks as to the source, sponsorship, affiliation, or endorsement of his web sites and of products offered on the web sites, evidencing bad faith registration and use in contravention of paragraph 4(b)(iv) of the Policy.

As to paragraph 4(b)(ii), Complainant contends that Respondent registered the disputed names in order to prevent Complainant from reflecting its VAMPIRE marks in other domain names and, by having engaged in a pattern of such conduct, demonstrated bad faith registration and use. In that regard, Respondent registered over 140 domain names, some of which copy or incorporate well-known names and marks of other entities (*e.g.*, LenWiseman.com and LenWiseman.info (Len Wiseman is a film director and writer, best known for the movie *Underworld*), MarciaShulman.com (Marcia Shulman is a casting director for *Buffy the Vampire Slayer*), DavidGreenwalt.com and DavidGreenwalt.info (David Greenwalt is a television series writer, director and executive producer of *Buffy the Vampire Slayer* and *Angel*), and JoelSchumacher.com (Joel Schumacher is a director and screenwriter of *Phantom of the Opera*)). A reverse WHOIS print-out of 95 domain names that are or have been registered to Respondent appears with the Complaint. A list of 45 additional domain names that Respondent posted on his web site for sale or lease also appears with the Complaint.

B. Respondent

While not specifically responding to each of the allegations made by Complainant, Respondent raised several points in its defense, which to the extent pertinent are listed as follows.

First, Complainant has been aware of Respondent's sites for many years now as those sites have been registered for a long time. In light of that, Respondent states, "And we

now are wondering why he is now attempting to steal our domains from us with absolutely no right whatsoever in our business."

Second, Respondent states, with respect to his having sold vodka under the VAMPIRE and VAMPYRE marks prior to Complainant having done so and the manner through which his vodka was sold, and his sales of wine branded under the VAMPIRE and VAMPYRE marks:

We also notice that we had the vodka range BEFORE Mr Machat. This is why we registered the domains BEFORE HIM

So he is in fact stealing our idea for vodka which can be proved from the archive at **WebArchive.org** web site yet we do not find this a threat in any way as our products are entirely 2 different types. His vodka is in a bottle and ours in a bag. If this went to court Mr Michat, knows as well as we do, we can prove we had Vampire/Vampyre Vodka range idea before him. When we spoke on the phone nearly 3 years ago we stopped selling wine as a courtesy to his request and only re-started it again when we realised you had copied our vodka idea (emphasis in original).

Third, Respondent asserts that Complainant previously instituted legal proceedings against others, now including Respondent, who refused to sell domain names including the term VAMPIRE or VAMPYRE to Complainant:

We have since found out that Mr Machat has also attempted this recently with the owner of **VAMPIRES.com** who had to employ a lawyer to get rid of him. He was hassling the owner because he wouldn't sell the domain for \$500 so instead tried a legal complaint/lawsuit. He is also currently doing this now with us AND the owner of **VAMPYRE.com**.

. . . [A]pproximately 2 and a half years ago when he [Complainant] telephoned me [Respondent] and told me that if my VAMPES company would be interested in selling his products in England, then we may be able to work something out. Nothing ever came of that, so we presumed he had changed his mind.

He also spoke of his unhappiness that we had the domain **VampireDrinks.com** which has been registered for a long time also and asked if he could purchase it from us. We refused!

. . . [D]espite the fact he owns VampireWine.com and never at the time had the initiative or foresight to register **VAMPIREDRINKS.com** is not our fault. It is his fault (emphasis in original).

Fourth, various bottled drinks, including some from Respondent, that bore the VAMPIRE mark existed as early as the 1980's, of which Complainant was well aware.

And Mr Machat was not even the original owner of **Vampire.com**, he purchased it himself from a 3rd party. There have also been several makers of Vampire drinks well before Mr Machat bought his company. Please see **DRACULA.de** to see a full list of other manufacturers and Vampire / Dracula drinks.

For example



DRINKS FROM THE 1980's

More and different products pre-dating Mr Machats or VAMPES products can be viewed at ebay.com on the following links . . . Please view them here

EBAY ITEM NUMBER **5609081541** AND ITEM NUMBER **5609902621** (emphasis in original).

In that regard, Respondent also points to a VAMPIRE branded wine imported in 1991 by "Tri-Vin Imports" of Mount Vernon, New York. An empty bottle of which was recently offered for sale on eBay as item number 6210049531.

Fifth, as to the other domain names which Respondent registered and some of those specifically referenced by Complainant, Respondent states:

Our **Feinds.com** department DOES register available domains as does many other companies with a view to providing an internet service to a relevant company so I am not sure what his point is in that argument. It is a perfectly legal action and is in no way infringing on intellectual property laws as long as the site is not being used for a similar field of business. As a lawyer Mr Machat, should also know this and really should read up on cyber-piracy laws as he evidently knows very little. The sites he has listed are mainly clients such as **TheNightShadeclub.com**, former client **ANZA-LEISURE.com** (cigarette card company now at AnzaCards)

ArmWars.com, for a close friend of ours Mr Neil Pickup who is the world champion arm wrestler, **buzzbombs** from the brandyciderwine company (who make our drinks for us) or former models of ours such as **RebekkaRaynor.com** so this is now slander from him too. Most of these domains have since expired (emphasis in original).

C. Additional Submissions

Between August 17, 2005 through September 27, 2005, Respondent sent a considerable number of e-mails to Complainant which he also copied to the Forum. Although the vast majority of this correspondence was threatening to Complainant, insulting, comical or just utterly irrelevant to the dispute, this Panel, as it is inclined to do particularly in situations as here where the submitter is not represented by counsel, has nevertheless reviewed and considered all of it.

Given the amount and nature of this correspondence, the Panel will not summarize any of it here. For simplicity, the relevant points raised in that correspondence appear, as appropriate, in the contentions above and/or the findings below.

FINDINGS

A copy of the WHOIS registration records for the disputed domain names is annexed to the Complaint. This record indicates that Respondent registered <**vampes.com**> on October 11, 2003, <**vampiredrinks.com**> and <**vampirevodka.com**> on June 9, 2004, and <**vampyrevodka.com**> on June 12, 2004.

A. Complainant's VAMPIRE Marks

Complainant currently owns various U.S. and foreign counterpart trademark registrations for the terms VAMPIRE and VAMP and has provided a hard-copy printout of the records of his U.S. marks from the publicly accessible Trademark Electronic Search System (TESS) provided by the U.S. Patent and Trademark Office and a copy of the registration certificates for the counterpart foreign marks. The pertinent details for the U.S. marks are as follows:

1. VAMPIRE (block letters)
Registration Number: 2,263,907; registered: July 17, 1999

This mark was registered for use in connection with "wines" in international class 33. In conjunction with these goods, this mark claims a date of first use of February 10, 1988 and a date of first use in commerce of October 31, 1989.

2. VAMP (block letters)
Registration Number: 2,681,906; registered: January 28, 2003

This mark was registered for use in connection with "soft drink colas; fruit drinks; fruit flavored soft drinks; pop soft drinks; energy drinks, namely, sports drinks" in international class 32. In conjunction with these goods, this mark claims a date of first use and a date of first use in commerce of February 5, 2002.

B. The parties

Complainant, through his exclusive licensee, Cupid Wines, Inc., has sold in excess of 1,000,000 units yearly of Complainant's VAMPIRE, VAMP and VAMPYRE branded products in North America alone, with additional quantities worldwide. These products have been featured in the DVD movie *Blade Trinity*, starring the actor Wesley Snipes, on an episode of the television series *Viva La Bam*, on the MTV web site and on *CNN Headline News*. In addition, these branded products have been featured in articles and reviews in numerous newspapers and magazines, including *USA Today*, *Rolling Stone*, *Spin*, *Maxim*, *Elle* and *InStyle*. Copies of a representative sampling of articles in newspapers, magazines, and books, as well as beverage advertisements that all feature the VAMPIRE marks appear with the Complaint.

Complainant owns various domain names that incorporate the VAMPIRE marks, including: <vampirewine.com>, <vampire.com>, <vampirevineyards.com>, <vampirevinyards.com>, <vampirewines.co.uk>, <vampirewine.co.uk>, <vampfest.com>, <vampgear.com>, <vampirevodka.co.uk.>, and <vamp-nrg.com>. Complainant has been conducting business at his web site at <vampirewine.com> since April 1996, and his web site at <vampire.com> since August 2000, which serve as Complainant's online contact with consumers in the U.S. and worldwide, through which customers can purchase VAMPIRE wines, VAMPYRE vodka, VAMP energy drinks, VAMPIRE wine club memberships, posters, corkscrews, decals, shirts, hats, and DVDs, participate in contests and promotions, and obtain information and recipes featuring the drinks. Hard-copy printouts of various pages from the Complainant's web site appear with the Complaint.

Complainant states he has invested considerable time, effort and resources to develop goodwill in his VAMPIRE marks. He advertises and markets his products under the marks in a variety of channels worldwide, such as printed publications, radio, the Internet and billboards. He has expended significant resources in advertising and promoting the products under those marks and diligently policing those marks and their reputation.

As best understood, Respondent has some connection—though the extent of which is not apparent from the record and hence unknown to the Panel—to an organization called "VAMPES" which itself is a Christian-based organization rooted in the history of an individual who lived some 500 years ago named Vlad Tepes.

Respondent was selling its VAMPIRE branded bottled drinks back as early as the 1980s and continues to do so. Currently, Respondent maintains web sites resolvable through

the disputed domain names through which he sells various bottled and packaged drinks. Hard-copy printouts of various pages from its web sites, which show these drinks, are provided with the Complaint. These drinks, branded under the marks VAMPIRE, VAMP or VAMPE, now include, as best as can be determined from the record, vodka, a vodka-based liquor (called "buss bomb"), beer and tea.

C. Interactions between the parties

During early to mid 2004, the parties apparently negotiated with each other about forming a business venture through which, as indicated by the e-mail correspondence delineated above, a series of nightclubs called "VAMPES" was to be jointly opened across London, New York and Paris by the parties and feature Complainant's products and Respondent's models. Though Respondent apparently proposed this venture, Complainant refused Respondent's proposal and terminated the negotiations.

During this time, and as best understood by the Panel—though the record on this matter is anything but clear—the parties apparently also discussed, or perhaps just the Respondent proposed to Complainant, the concept of a broader business relationship between them, possibly involving the use of the VAMPIRE marks by one of the parties on certain products and/or services, and the use of the same marks by the other party on other products and/or services, but no agreement was reached and those discussions just collapsed.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
- and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The Panel finds that confusion is likely to arise as a result of Respondent's use of the disputed domain names.

Two of the disputed domain names <**vampiredrinks.com**> and <**vampirevodka.com**>, are formed by appending a generic term, specifically “drinks” or “vodka,” to Complainant’s VAMPIRE mark, and then following the result with the generic top-level domain (gTLD) “.com”. The third name, <**vampyrevodka.com**>, incorporates a phonetically equivalent term, vampyre, to Complainant’s mark VAMPIRE, followed by the generic word “vodka” and the “.com” gTLD. The fourth name, <**vampes.com**>, appears to be a plural form of Complainant’s VAMP mark, followed again by the gTLD “.com”. The addition of any gTLD is completely ignored in assessing identity/similarity under paragraph 4(a)(i) of the Policy.

Inasmuch as the modifications made to the corresponding marks to form all of these names are rather minor, the Panel will treat all these names collectively, i.e., all four names will either rise or fall together.

It is now very well-established in UDRP precedent, including numerous 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 insufficient in and of themselves, 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. “Vodka” and “drinks” are certainly such generic words. *See, e.g., The Cheesecake Factory Inc. v. Say Cheesecake*, D2005-0766 (WIPO Sept. 12, 2005); *Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *Caesars Entm’t, Inc. v. Nova Internet Inc.*, D2005-0411 (WIPO June 22, 2005); *Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005); *Lockheed Martin Corp. v. Teramani*, D2004-0836 (WIPO Dec. 1, 2004); *Nat’l Collegiate Athletic Ass’n v. Brown*, D2004-0491 (WIPO Aug. 30, 2004). This result follows from a simple comparison of the disputed domain names against Complainant’s marks.

Further, with respect to <**vampyrevodka.com**>, a change in the spelling of the formative portion of the domain name from “vampire” to its phonetic equivalent “vampyre” amounts to a *de minimus* variation that simply fails to avoid causing user confusion. *See, e.g., Pfizer Inc., A Delaware Corp. v. Phizer’s Antiques*, D2002-0410 (WIPO July 3, 2002); *Pfizer Inc., A Delaware Corp. v. RE THIS DOMAIN FOR SALE - EMAIL*, D2002-0409 (WIPO July 3, 2002). Adding the generic word “vodka” to the phonetic equivalent term “vampyre” to yield the disputed domain name <**vampyrevodka.com**> still fails to impart distinctiveness to that name sufficient to dispel user confusion. A similarly *de minimus* variation results by modifying the mark “vamp”, by the addition of the letters “es”, into the plural form “vampes”.

User confusion, should it occur, would undoubtedly cause Internet users intending to access Complainant’s web site, but who were to reach Respondent’s site resolvable through any of the disputed domain names, to think that an affiliation of some sort exists between Complainant and Respondent or its third-party transferee (to the extent

Respondent were to transfer any of the names), when, in fact, no such relationship would exist at all. *See also, e.g., Cheesecake Factory, Napster, Caesars Entm't, Lockheed v. Skunkworx, and Lockheed v. Teramani, supra; Register.com, Inc. v. Reile*, FA 208576 (Nat. Arb. Forum Jan. 27, 2004); *Caesars World, Inc. v. Japan Nippon*, D2003-0615 (WIPO Sept. 30, 2003); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); *Am. Family Life Assurance Co. of Columbus v. defaultdata.com*, FA 123896 (Nat. Arb. Forum Oct. 14, 2002); *AT&T Corp. v. Abreu*, D2002-0605 (WIPO Sept. 11, 2002); *L.F.P., Inc. v. B and J Props.*, FA 109697 (NAF May 30, 2002); *Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002); *Spence-Chapin Servs. to Families and Children v. Wynman*, FA 100492 (Nat. Arb. Forum Dec. 10, 2001); *Meijer, Inc. v. Porksandwich Web Servs.*, FA 97186 (Nat. Arb. Forum July 6, 2001); *MPL Commc'ns, Ltd. v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001); *Surface Prot. Indus., Inc. v. The Webposters*, D2000-1613 (WIPO Feb. 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.*, D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that each of the disputed domain names sufficiently resembles Complainant's VAMPIRE marks as to cause confusion; hence, Complainant has shown sufficient similarity between all the disputed domain names and Complainant's marks under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

The Panel finds that Respondent has rights and legitimate interests in all the disputed domain names and specifically under paragraph 4(c)(i) of the Policy.

Proving similarity is not sufficient in and of itself to establish a *prima facie* case under paragraph 4(a) of the Policy. Apart from proving bad faith use and registration under paragraph 4(a)(iii), Complainant must also prove, under paragraph 4(a)(ii) and for each of the disputed domain names, that Respondent lacks rights and legitimate interests in that name. Given that the underlying facts, e.g., salient documents and other evidence, are more often than not within the exclusive control and possession of a respondent, an extremely heavy and perhaps impossible burden may well be placed on a complainant if he is required to provide detailed proof of illegitimacy on behalf of his respondent. Recognizing this and as a reasonable alternative, numerous decisions, including by this Panel, have simply shifted the burden of proof to the respondent, particularly as here where allegations of bad faith have also been made, to adequately prove that its use of the name is legitimate. In the absence of such a showing, the panel may then infer that the respondent's use lacks legitimacy and possibly evinces bad faith. *See, e.g.,* in an analogous context of shifting a burden to a respondent to show that no reasonable

alternatives exist to it for its use of a challenged domain name as an address of a complaint site, *Spence-Chapin; Meijer*, both cited *supra*; *Universal City Studios, Inc. v. Burns*, D2001-0784 (WIPO Oct. 1, 2001). See generally *Dollar Fin. Group, eBay Inc., v. G L Liadis Computing, Ltd.*, *supra*; *Playboy Enters. Int'l, Inc. v. Rodriguez*, D2000-1016 (WIPO Nov. 7, 2000); *MSNBC Cable, LLC v. Tsysys.com*, D2000-1204 (WIPO Dec. 8, 2000). Here, Respondent has met its burden.

Complainant points to fact that Respondent registered the disputed names after Complainant commenced use of its marks in commerce. This is totally unavailing. The operative time point referenced in paragraph 4(c)(i) of the Policy is not the date on which a complainant commenced use of its mark but rather the date on which a respondent received notice of the dispute. In that regard, paragraph 4(c)(i) states that a respondent can show it has rights or legitimate interests in a domain name if "*before any notice to you of the dispute*, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services" (emphasis added).

While trademark rights for a federal registration start accruing from the date the mark was first used in commerce (whether, in the case of use-based marks filed under section 1(a) of the Lanham Act, the actual date of first use in commerce, or, in the case of intent to file marks filed under section 1(b) of the Lanham Act, the constructive use date, i.e., the filing date of the underlying trademark application), this date precedes, sometimes significantly so, the date on which a respondent received notice of a dispute involving that mark. The Policy recognizes that a mark and an arguably identical/confusingly similar domain name can concurrently exist throughout a relevant marketplace and the Internet without the name constituting actionable cybersquatting of the mark. It is only after a dispute arises over use of the name by a respondent and, most importantly, the respondent continues to use the name in spite of having received notice of the dispute that actionable cybersquatting arises under the Policy and to which the Policy is targeted and provides a remedy. The respondent's actions in merely recognizing or even admitting that another party owns a mark does not rise to the level of a dispute. To do so, the owner of the mark must take affirmative action to inform the respondent of the owner's rights in the mark, must object to continued use by the respondent of that mark and communicate such objection to the respondent, i.e., put the respondent on "actual" notice of the dispute. Obviously, what will constitute affirmative action, sufficient communication and, generally speaking, actual notice in any given situation is best left to a factual determination on a case-by-case basis. See, e.g., *CafePress.com v. Fragomele*, FA 428848 (Nat. Arb. Forum Apr. 27, 2005).

Therefore, the fact that Respondent registered the disputed domain names in the 2003-2004 timeframe which is some 15 years after Complainant asserts he started using the VAMPIRE mark both in intra-state and inter-state commerce (1988 and 1989, respectively) is irrelevant. Unfortunately, the record appears sorely remiss in clearly delineating the date on which Complainant first voiced its objections to Respondent over

Respondent's continued use of the disputed domain names that incorporated Complainant's VAMPIRE mark. However, as a worst case (earliest) date, this Panel can safely assume, from the record before it, that date to have been in early 2004 when the parties first began direct negotiations with each other, negotiations that ultimately collapsed.

When viewed in the context of Respondent having been notified as early as 2004 of the dispute, Respondent has provided credible and convincing evidence, which Complainant has neither denied nor even attempted to refute, showing that Respondent used the VAMPIRE mark in *bona fide* sales of branded wines back as early as the 1980's and continued to do so with respect to wine and other beverages. Given this, it simply stands to reason that Respondent's use of the mark commencing at such an early date and continuing to the present well predates any notice he had of the dispute with Complainant and evinces Respondent's rights and legitimate interests to all the disputed names, thus satisfying Respondent's burden under paragraph 4(c)(i) of the Policy.

Accordingly, Respondent has met the requirements of paragraph 4(c) of the Policy.

Registration and Use in Bad Faith

In light of the Panel's finding that Respondent has rights and legitimate interests in all the disputed domain names, then all issues as to whether, under paragraph 4(a)(iii) of the Policy, Respondent's actions amounted to bad faith use and registration of the names are now moot and hence will not be considered any further.

DECISION

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist

Dated: October 6, 2005