



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Varian Medical Systems Inc. v. Private**

**Case No. D2010-0815**

#### **1. The Parties**

The Complainant is Varian Medical Systems Inc. of Palo Alto, California, United States of America, represented by Sideman & Bancroft LLP, United States of America.

The Respondent is Private of Chicago, Illinois, United States of America.

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

The disputed domain name <varianmedicalsistemas.net> is registered with Tucows Inc. (the “Registrar”).

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization (“WIPO”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the “Supplemental Rules”).

The Complaint, with accompanying Annexes 1-5 (with sub-annexes), was filed with the WIPO Arbitration and Mediation Center (the “Center”) by email on May 21, 2010.

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, verified that the original Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 21, 2010, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in that Complaint relative to the disputed domain name, and whether the disputed domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify for the disputed domain name: (a) the dates on which the registrant registered the disputed domain name (or acquired the registration) and when the registration will expire, (b) whether the Policy applies to that disputed domain name, (c) the language of the registration agreement, and (d) whether that disputed domain name will remain “locked” during the proceeding.

Subsequently, on May 21, 2010, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIs database. Further, the Registrar stated that it had not received a copy of the Complaint. The Registrar’s response further indicated that: (a) the registration for the name was created on April 30, 2010 and will expire on April 30, 2011, (b) the Policy applies to the disputed domain name, (c) the registration agreement for the disputed domain name is in English, and (d) the disputed domain name will remain locked during the proceeding.

The Complaint specified an incorrect location for the Registrar. Accordingly, the Center indicated the same to the Complainant on May 27, 2010 and provided the Complainant with the proper location of the Registrar and invited the Complainant to submit an amendment to the Complaint to correct the corresponding information specified in the Complaint. The Complainant subsequently did so, by email to the Center, later the same day. Accordingly, for simplicity, all subsequent references to the “Complaint”, unless the context specifically indicates otherwise, will be to the amended Complaint.

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

On May 28, 2010, 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 annexes, by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on May 28, 2010, 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 June 17, 2010, to file its Response with the Center and the Complainant.

As of June 17, 2010, the Center had not received a formal Response to the Complaint from the Respondent. Hence, the Center, in an email letter dated June 19, 2010,

notified the Respondent of his default.

Pursuant to the Rules and Supplemental Rules, by email letter dated June 24, 2010, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and, pursuant to the requirements of paragraph 7 of the Rules, returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated June 28, 2010, notified the Parties of the appointment of Mr. Michaelson as sole Panelist. The Panel finds that it was properly constituted.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before July 12, 2010. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to July 26, 2010.

This dispute concerns one domain name, specifically <varianmedicalsyste.ms.net>.

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

As indicated in the WhoIs registration record appearing in Annex 1 to the Complaint, the disputed domain name was registered on April 30, 2010 and will expire on April 30, 2011.

##### **A. Complainant's Marks**

The Complainant owns various United States registrations for the marks VARIAN in block letters, and VARIAN MEDICAL SYSTEMS in a stylized pattern. The Complainant has provided, in Annex 4 to the Complaint, a copy of the registration certificates for these marks. Pertinent details of several of these registrations are as follows:

1. VARIAN MEDICAL SYSTEMS (stylized)  
United States Registration No. 2,976,435; registered July 26, 2005

This mark is registered for use in connection with: "Industrial linear accelerators used in industrial imaging" in international class 9; and "Medical linear accelerators used in radiotherapy and computer software embedded therein for use in the field of radiotherapy, sold as a unit" in international class 10. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of April 2, 1999.

2. VARIAN MEDICAL SYSTEMS (stylized)  
United States Registration No. 2,485,786; registered September 4, 2001

This mark is registered for use in connection with: "Computer software for use in forming medical diagnoses, developing treatment plans, monitoring, controlling and simulating patient treatment, managing and transmitting patient data, information and radiographic images, x-ray imaging, and controlling medical apparatus; computer programs on computer-readable media for use in forming medical diagnoses, developing treatment plans, monitoring, controlling and simulating patient treatment, managing and transmitting patient data, information and radiographic images, x-ray imaging, and controlling medical apparatus" in international class 9; "Medical

apparatus and systems, used for diagnostic, therapeutic and radiographic purposes, consisting of x-ray tubes and housing therefore; medical charged particle accelerators used in radiotherapy and computer software embedded therein for use in the field of radiotherapy, sold as a unit; patient positioning tools; radiation beam collimation apparatus for conformal beam radiotherapy; imaging and treatment simulation apparatus for treatment planning and simulation; x-ray radiographic and fluoroscopic imaging systems comprised of a receiver and transmitter panel and a display; x-ray imaging systems that convert radiation into digital signals comprised of receiver/transmitter panels, user interface computers, displays, and embedded software for use in the field of x-ray imaging, sold as a unit; and medical devices for delivery of radiation from within the patient, namely, remote afterloaders for brachytherapy and brachytherapy wire and needle positioning apparatus and computer software embedded therein, sold as a unit, for use therewith” in international class 10; “Installation, maintenance and repair services for computer systems used to formulate medical diagnoses and develop plans of medical treatment; installation, maintenance and repair services for medical apparatus” in international class 37; and “Consultation and technical support services in the field of computer systems used to formulate medical diagnoses, maintain patient treatment information and develop plans of medical treatment; consultation and technical support services in the fields of medical apparatus and medical systems” in international class 42. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with the goods and services in all these classes, commenced at least as of August 31, 1999.

3. VARIAN (block letters)  
United States Registration No. 836,706; registered October 10, 1967  
renewed: November 9, 2007

Pursuant to the renewal, this mark is registered for use with: “Measuring and scientific appliances -- namely, particle accelerators, and x-ray equipment; gas chromatographs, spectrometers, spectrophotometers, and fluxmeters; electrometers, vacuum discharge and ionization gauges; digital indicators, plotters and graphic recorders, leak detectors, and computers” all in international class 9. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of November 25, 1949.

4. VARIAN (block letters)  
United States Registration No. 828,848; registered May 16, 1967  
renewed: April 11, 2007

Pursuant to the renewal, this mark is registered for use in connection with: “x-ray equipment, spectrometers, and linear accelerators” in international class 10. The registration indicates that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced at least as of February 28, 1962.

## **B. The parties and their activities**

The Complainant, a publicly traded company, is a large manufacturer of medical devices and software for treating cancer and other medical conditions with radiotherapy, radiosurgery, proton therapy and brachytherapy.

The Complainant first learned of the Respondent’s use of the disputed domain name when the Complainant’s general counsel received a telephone call from a third party (Paylocity) “following up” on “Varian’s request” for a rate quote for the third party’s

services. The Complainant had not requested any such rate quote. After further investigation, the Complainant learned that an unknown party using the email address “howard@varianmedicalsyste.ms.net” contacted Paylocity on May 4, 2010 for a quote request and listed the Complainant’s corporate vice president and general counsel as the contact person and provided the Complainant’s physical address (a copy of the May 4, 2010 email appears in Annex 5 to the Complaint). Neither the website <varianmedicalsyste.ms.net> nor the unknown person using the address “howard@varianmedicalsyste.ms.net” is affiliated with the Complainant. When Paylocity responded to the Respondent’s email request, but did not get a reply from the Respondent, Paylocity then sought a response from the Complainant’s corporate vice president at Varian directly, whereupon the Complainant discovered that the original inquiry to Paylocity was a sham. Thereafter, the Respondent could not be found or located at the telephone number or email address identified with the Registrar. The Complainant requested the Registrar remove the website associated with the disputed domain name; the Registrar obliged. In the interim and despite searches using Google cache, Bing search, “www.ask.com”, “www.wayback.com” and “www.webcite.com” conducted by the Complainant, the Complainant could not locate any identifying information concerning the Respondent.

## **5. Parties’ Contentions**

### **A. Complainant**

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

The Complainant contends that the disputed domain name is identical to the Complainant’s Marks simply because that name incorporated certain of those marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii). Rights or Legitimate Interests**

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

Specifically, the Respondent has not been authorized to use any of the Complainant’s marks in a domain name or in any fashion. In spite of that, the Respondent is using and/or has used the name to solicit information allegedly on behalf of the Complainant. By identifying itself as an agent of the Complainant, the Respondent attempted to trade on the Complainant’s marks and hence its goodwill; thus, implying that it has a relationship with the Complainant, when, in fact, no such relationship exists.

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

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

Specifically, the Respondent is using and/or has used the name to suggest an affiliation with or endorsement by the Complainant of a non-existent enterprise in order to attract Internet users and to solicit information by suggesting that it is affiliated with or endorsed by the Complainant, when in fact no such affiliation or endorsement exists.

Further, the Respondent's use of an email address which incorporates the Complainant's name has caused actual confusion with the Complainant marks.

## **B. Respondent**

The Respondent failed to file any Response to the contentions raised in the Complaint.

## **6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as permitted under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel may in its discretion decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

### **A. Identical or Confusingly Similar**

The Panel finds that the disputed domain name <varianmedicalsystems.net> is identical to the Complainant's VARIAN MEDICAL SYSTEMS marks.

By simply comparing the disputed domain name to those marks, no doubt exists that the name, apart from having the generic top level domain (gTLD) “.net” appended to the term “varianmedicalsystems”, is identical to those marks. The addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

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

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

The Complainant has never authorized the Respondent to utilize its VARIAN or VARIAN MEDICAL SYSTEMS marks in conjunction with any of the products or services with which the Complainant uses those marks, nor does the Complainant apparently have any relationship, affiliation or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's marks or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, as recited in any of its trademark registrations, might likely violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Gulf Craft Inc. Co. (LLC) v. PrivacyProtect.org / Domain, Stocker*, WIPO Case No. D2010-0504; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF

Claim No. 173362; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Claim No. 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in the Panel's view, the Respondent could not legitimately acquire any public association between it and either of the Complainant's VARIAN or VARIAN MEDICAL SYSTEMS marks or one similar thereto, and certainly not for the goods and services provided by the Complainant under those marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent in the Panel's view likely ever become commonly known by the name without likely infringing on the exclusive trademark rights of the Complainant. See, e.g., *Gulf Craft*, *Clearwire*, *Starline Publications* and *Treeforms, Inc.*, all cited *supra*.

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

Moreover, it is beyond any credible doubt that the Respondent had actual knowledge of the Complainant's marks and the Complainant's exclusive rights in those marks at the time it registered the disputed domain name. Yet, in spite of that knowledge, it proceeded to register the name anyway. This is particularly evident in that, just a few days after the Respondent registered the name, it not only submitted a spurious inquiry to a third-party (Paylocity) under the Complainant's name but even more tellingly under the name of the Complainant's own General Counsel -- possibly to the point of impersonating that individual which the Panel infers from the lack of any Response. Hence, the Respondent likely intended that it would be perceived as being associated with or related to the Complainant in some fashion -- when in actuality it was not. The Panel also infers, again from the lack of any Response, that the Respondent's primary motivation in doing so was to create and then opportunistically exploit inevitable user confusion for the Respondent's own pecuniary benefit -- very possibly by eventually convincing the Complainant to purchase the disputed domain name from the Respondent at a substantial price in order to halt any further confusion and injury to the Complainant's marks and reputation. Inasmuch as such use is likely to directly infringe the Complainant's marks, it does not constitute a *bona fide* offering of goods or services, let alone one that occurred prior to receiving any notice of this dispute.

Consequently, the Respondent's conduct does not fall within paragraph 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 the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

### **C. Registered and Used in Bad Faith**

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

As noted above, the Panel infers that the Respondent was well aware of the Complainant's VARIAN and VARIAN MEDICAL SYSTEMS marks before the Respondent registered the name. Yet, in spite of that knowledge, the Respondent intentionally registered the name in an effort to opportunistically exploit the Complainant's reputation and goodwill in those marks to what most likely would have been the Complainant's detriment. This is rather evident in the Respondent having made a false inquiry in the name of the Complainant and its General Counsel and sent,

through an email message from an address at the disputed domain name, to a third-party -- when the Respondent had no authorization from the Complainant to make any such inquiry. The Respondent, having effectively misappropriated the Complainant's goodwill and reputation in its marks, caused confusion in the mind of that party by falsely suggesting the Respondent had some type of an affiliation or relationship with the Complainant -- when in fact the Respondent did not. It stands to reason that the Respondent did so to ultimately cause injury to the Complainant through which the Respondent eventually stood to financially benefit. Most likely, after the Respondent had used the name to cause sufficient confusion, it would have offered the name to the Complainant for sale at a price substantially in excess of its cost of registration -- a price which the Respondent then would have believed the Complainant might have been willing to pay if only to halt further injury to its marks and reputation. What effectively prevented the Respondent from pursuing its presumed intentions any further than the initial steps it had taken was simply that the Complainant discovered the Respondent's ruse sufficiently early and immediately took appropriate action to gain possession of the name, including filing its Complaint to initiate this proceeding. That decisive action precluded the Respondent from exploiting the name any further.

The fact that the Respondent frustrated all attempts by the Complainant to contact it once the Complainant discovered the ruse further supports the Panel's inferences as to the Respondent's true intentions.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(i), and 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, 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 name, <varianmedicalsystems.net>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: July 19, 2010