



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **Vonage Holdings Corp. v. Michael Hodge**

**Case No. D2007-0336**

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

The Complainant is Vonage Holdings Corp., Holmdel, New Jersey, United States of America, represented by Duane Morris LLP, United States of America.

The Respondent is Michael Hodge, Ashton, Maryland United States of America, represented by himself.

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

The disputed domain name <vonage.mobi> is registered with DomainPro, Inc.

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on March 7, 2007, and in hard copy form, along with accompanying Exhibits A-C, on March 12, 2007.

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 Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 9, 2007, 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 March 20, 2007, the Registrar provided its response to the Center through which the Registrar confirmed it received a copy of the Complaint. The response also specified name and contact information pertinent to the disputed domain name, to the extent present in the Registrar's WhoIs database, and confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative and technical contacts. The response also confirmed that DomainPro is the registrar of that name and stated that: the Policy applied to the disputed domain name, and the name was then held in a “locked” status. The Registrar also indicated, through the response, that: the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the Registrar; and the registration agreement is in English.

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

On March 22, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by courier and without the Exhibits by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, inasmuch as the notification to the Respondent occurred on March 22, 2007, then, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence 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 April 11, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Respondent timely filed his Response, in email form on April 3, 2007, and subsequently in hard copy form together with accompanying Exhibits A-F.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated April 11, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated April 24, 2007, 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 May 8, 2007. However, due to time conflicts then being experienced by the Panel – which constituted unforeseen circumstances, the Center, upon the Panel’s request, extended the due date to May 21, 2007.

This dispute concerns one domain name, specifically: <vonage.mobi>.

The language of this proceeding is English.

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

As indicated in the WhoIs registration record provided in Exhibit 1 to the Complaint, the Respondent registered the disputed domain name on September 26, 2006.

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

The Complainant owns numerous foreign trademark registrations for the term “VONAGE”, in block letters, either by itself or with other terms. The Complainant has provided, in Exhibit B to the Complaint, a listing of its foreign registrations. As revealed by the Trademark Electronic Search System (TESS) database which is publicly accessible through the website of the United States Patent and Trademark Office, the Complainant also has various US registrations, its foreign registrations being counterpart thereto. Illustratively, pertinent details of a small sampling of the Complainant’s US registrations are as follows:

- (1) VONAGE DIGITAL VOICE (block letters)  
United States registration 2,848,258; registered: June 1, 2004  
filed: February 4, 2002

This mark was registered for use in connection with “telephony communication services” in international class 38. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these services, commenced as of March 31, 2002.

- (2) VONAGE THE BROADBAND PHONE COMPANY (block letters)  
United States registration 2,804,958; registered: January 13, 2004  
filed: February 12, 2003

This mark was registered for use in connection with “telephony communication services” in international class 38. The entry states that both first use and first use in commerce of

this mark, when used in conjunction with these services, commenced as of February 5, 2003.

- (3) VONAGE (block letters)  
United States registration 2,614,773; registered: September 3, 2002  
filed: May 3, 2001

This mark was registered for use in connection with “telephony communication services” in international class 38. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these services, commenced as of April 30, 2001.

## **B. The Parties and their Interactions**

Since April 2001, the Complainant provides, under its VONAGE Marks, broadband telephone and telecommunications services throughout the world.

Over the years, the volume of sales of goods and services in the United States sold under the VONAGE Marks has been significant, with sales in 2005 alone exceeding US \$269 million.

The Complainant continuously and extensively advertises and promotes its VONAGE Marks and the services sold there under. In that regard, the Complainant has and continues to advertise and promote the VONAGE brand in a wide variety of media including newspapers, magazines, television, radio and the internet, and also through billboards, banner ads, store displays, publications, sponsorship events such as concerts and entertainment performances, and tradeshow, marketing fairs and/or tours.

The Complainant maintains a presence on the Internet through its operation of various authorized websites located at “www.vonage.com”, “www.vonage.co.uk” and “www.vonage.ca” which are collectively used to advertise and promote the Complainant's VONAGE branded services and provide information and support to consumers of those services (copies of printouts from these particular websites appear in Exhibit C to the Complaint.).

Starting on June 12, 2006 and extending thereafter for a period of 70 days, the Mobile Top Level Domain (mTLD) Registry (“.mobi registry” began accepting registrations for the “.mobi” gTLD (generic top level domain) under a “Sunrise period”. This registry is the global registry for the “.mobi” top level domains which are primarily available to mobile operators, network device manufacturers and Internet content providers. During that period, trademark owners had an exclusive opportunity to register “.mobi” domain names prior to general public doing so. In early August 2006, the “.mobi” registry extended the Sunrise period for another 30 days, thus postponing the start of general (public) registration of “.mobi” domain names until September 26, 2007. The Complainant did not register the disputed domain name during the Sunrise period, so the Respondent did.

On December 12, 2006, the Complainant filed a Sunrise challenge, with WIPO and under the Sunrise Challenge Policy and Rules, to dispute the Respondent's registration. The challenge was not processed by WIPO because the Respondent registered the disputed domain name outside the Sunrise Challenge period and during the subsequent general registration period, hence necessitating that the Complainant, should it still wish to pursue its dispute, do so

under the UDRP instead. See, in Exhibit D to the Response, a copy of an email dated December 13, 2006 sent by WIPO to both the Complainant and Respondent.

The Respondent, before committing any additional resources to develop a website resolvable through the disputed domain name, contacted counsel for the Complainant on December 29, 2006 and inquired whether the Complainant was then interested in acquiring the disputed domain name (see the email message in Exhibit D to the Response). Counsel responded by stating that the Complainant was willing to offer US \$1,500, which equaled the filing fee for an ICANN proceeding, in exchange for a transfer of the name. The Respondent declined and demanded US \$18,000 to transfer the name -- apparently seeking reimbursement of costs he incurred up to that date in developing his website. The Respondent indicated to Counsel that it had acquired the name for the specific purpose of becoming an agent of the Complainant and promoting the Complainant's services, as it does for other carriers and as apparently the Complainant allows others to do. In response, the Complainant refused the Respondent's demand and then filed the present Complaint.

For reasons unknown - at least none is reflected in the record before the Panel, the Respondent never received permission, whether from the Complainant or any organization authorized to act on its behalf, either to serve as an affiliate of the Complainant or to resell its services.

Since the date on which disputed domain name has been registered, no website has existed to which that name resolves.

## **5. Parties' Contentions**

### **A. Complainant**

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

The Complainant contends that the disputed domain name, <vonage.mobi>, by virtue of its use of the term "VONAGE" as an entire second level domain, is confusingly similar to the Complainant's VONAGE 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, for any of 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, in light of the Complainant's prior substantial worldwide use of its VONAGE Marks for the preceding five years, and consequently the significant public recognition which the Complainant has attained, there is no conceivable *bona fide* legitimate use to which the Respondent can make of the disputed domain name. In that regard, the Complainant notes that ever since the Respondent registered the name on September 26, 2006, he has not established a website to which that name resolves.

Second, the Complainant states that it never licensed, permitted or authorized the Respondent to use the VONAGE Marks or a domain name which incorporates any of those marks.

Third, the Complainant alleges that the Respondent is not using the name in connection with a *bona fide* offering of goods or services, nor is it making a legitimate noncommercial or fair-use of that name.

(iii) Registered and Used in Bad Faith

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

First, the Complainant alleges that bad faith is evidenced by the Respondent's failure to use the name in conjunction with any offering of goods or services.

Second, the Complainant seems to be alleging that since the disputed domain name incorporates the term "VONAGE" which is identical to the Complainant's mark, then the Respondent, were he to ultimately use the name to resolve to a website, would most likely do so in a manner that would create a likelihood of confusion in the minds of Internet users as to whether some connection existed between the Respondent (and his website) and the Complainant -- where, in actuality, no such connection would exist.

Third, the Complainant alleges that, given the notoriety of the Complainant's VONAGE Marks in the United States, the Respondent had to have direct knowledge of those marks prior to the date he registered the disputed domain name. Yet, in spite of that knowledge and consequently knowing that he had no right to register the name, nevertheless he did so anyway, thus evidencing bad faith registration. Since the Respondent registered the name with an intent to exploit it in some fashion in spite of and to the detriment of the Complainant's rights, the Respondent's actions constituted opportunistic bad faith.

Lastly, the Complainant points to the Respondent's offer to sell the disputed domain name for US \$18,000 as also constituting bad faith.

**B. Respondent**

(i) Identical or Confusingly Similar

The Respondent does not contest the Complainant's contention that the disputed domain name is identical to the Complainant's VONAGE Marks.

(ii) Rights or Legitimate Interests

In contrast to the Complainant's contention, the Respondent claims that he does have rights or legitimate interests in the disputed domain name.

The Respondent points to the fact that the Complainant maintains various agents and affiliates which use the mark VONAGE in promoting and advertising their own commission-based service of reselling the Complainant's telecommunications VoIP (voice

over IP) services. The Complainant has sought and continues to seek out such affiliations with others through which its services could be marketed and resold.

The Respondent believed that "Interwebgroup", a limited liability corporation based in Ashton, Maryland, owns and operates a number of websites including those which resell or act as agents for residential VoIP providers, such as the Complainant.

When the Respondent registered the disputed domain name, he decided to develop a website, resolvable through that name, to compare VoIP service offerings and particularly feature those provided by the Complainant, and as such be compensated by the Complainant in the same fashion as other online affiliate agents have -- which manifests his intent to use the name in conjunction with a *bona fide*, legitimate commercial offering of services in much the same way as various agents of the Complainant use domain names that include the mark VONAGE.

In December 2006, the Respondent applied, through Interwebgroup, to be an affiliate of the Complainant via an affiliate aggregation firm called "Commission Junction" through which the Complainant seeks out and compensates, on a commission-basis, web-based affiliates which market the Complainant's services -- many of which use the term "VONAGE" in their own domain names.

The Respondent owns a business that markets telecommunications services, on a commission-basis, similar to those currently offered by the Complainant. Hence, the Respondent contends that, since he has applied to the Complainant to become one of its agents and further that the Complainant currently allows other agents to use the Complainant's name VONAGE in their own domain names, he had a legitimate commercial reason for having registered the disputed domain name, <vonage.mobi>.

(iii) Registered and Used in Bad Faith

Contrary to the Complainant's contention, the Respondent claims that he neither registered nor used the disputed domain name in bad faith.

First, the Respondent contends that his good faith is shown by the fact that as soon as he became aware of the Complainant's initial challenge to the name, the Respondent ceased incurring any further costs or expending any further effort in developing his VoIP comparison site, pending resolution of the dispute with the Complainant over the name.

Second, the Respondent contends that, although he offered to sell the name to the Complainant for costs then incurred in developing his site, his over-arching intention, as communicated to the Complainant was not to sell the name but rather to use it in re-selling the Complainant's services.

## **6. Discussion and Findings**

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

Inasmuch as the Respondent does not contest that the disputed domain name is identical to the Complainant's VONAGE Marks, then the Panel so finds.

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

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

The Panel believes that the Respondent has not provided any basis that would in the circumstances here legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Respondent was well aware of the Complainant and its mark VONAGE at the time the name was registered - particularly since Respondent sought to become an authorized reseller. Yet, in spite of the knowledge of that mark and obviously with knowledge that it was not an authorized by the Complainant to resell its services, the Respondent still proceeded to intentionally register the name. It stands to reason that until the Respondent actually became an authorized reseller - which never occurred, the Respondent knew or should have known that whatever rights he acquired in that name through its registration were illegitimate. Further, any use he would put to the name in connection with offering the Complainant's services would, as a result of infringing on the Complainant's marks, be similarly illegitimate. Thus, in the absence of ever gaining authorization from the Complainant to use its marks, the Respondent was precluded from ever having acquired rights and legitimate interests in the disputed domain name on the basis claimed. *Cf. Shaw Industries Group Inc. and Columbia Insurance Company v. Arcadia Publishing Inc.*, WIPO Case No. D2007-0090 (March 20, 2007) where a respondent, then having been an authorized dealer of a complainant, was found by this Panel, by virtue of its having used, at a sufficiently early time, a domain name that included the complainant's mark and in connection with *bona fide* commercial offerings of the complainant's carpeting products, to have rights and legitimate interests in that name.

In striking contrast to the fact pattern in *Shaw*, here, the Respondent was never authorized to resell the Complainant's services or use its VONAGE Marks, and has neither used the disputed domain name in connection with any *bona fide* offering of goods or services nor has he made any demonstrable preparations to so use the name prior to receiving notice of the dispute. Rather, the name, since its registration and to date, does not resolve to any operable web page.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under 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.

As discussed above, the Respondent clearly knew that when he registered the name and throughout the ensuing period to this day while he held it, he was not authorized to use the Complainant's VONAGE Marks, whether in a domain name or other form, in conjunction with reselling the Complainant's services.

Thus, even though the Respondent's desire to create a website which would provide comparison information regarding VoIP services, and feature those services provided by the Complainant may itself have been well-intentioned, the Respondent acted rather

precipitiously in registering the domain name, which mirrored the Complainant's VONAGE mark, in the absence of ever have received prior authorization from the Complainant, thus in the Panel's view evidencing bad faith registration. The Respondent's subsequent action in offering to sell the name for US \$18,000 (a sum clearly in excess of his costs of registration) - a name for which he had no legitimate claim to register and thereafter no legitimate basis to hold - merely compounded the bad faith nature of his conduct.

Hence, the Panel views the Respondent's actions as constituting bad faith registration and use of the disputed domain name <vonage.mobi> in violation of paragraph 4(a)(iii) 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 grants the relief sought by the Complainant.

The disputed domain name, <vonage.mobi>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: May 14, 2007