

Before the:

NATIONAL ARBITRATION FORUM

Director's Choice, LLP)
10701 Upland Ave.)
Lubbock, Texas 79424)

Complainant,

HELP.org Domain Administrator)
HELP.org, LLC)
PO Box 1860)
Ocean City, New Jersey 08226)

Respondent.

Disputed Domain Name:

directorschoice.com
NAF Case No. FA1411001590433

**ADDITIONAL SUBMISSION IN ACCORDANCE WITH THE
UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

I. Introduction

1. This Additional Submission is hereby submitted in support of Complainant’s Complaint for decision in accordance with the UDRP Rules and the National Arbitration Forum’s Supplemental Rule 7.

II. Respondent’s Arguments

2. On or about November 19, 2014 Respondent, HELP.org Domain Administrator (hereinafter “Respondent”), submitted its Response to the Complaint which instituted the instant proceeding.
3. Respondent essentially attempts to construct a nine-pronged defense as to why the domain name should not be transferred to the Complainant. First, Respondent contends that Complainant is estopped from pursuing this claim under the laches doctrine. Second, Respondent contends that the domain name is not confusingly similar to Complainant’s

Marks, for which Complainant has rights. Third, Respondent contends that it has rights in the domain name. Fourth, Respondent contends that its registration and continued use of the domain name is not in bad faith. Fifth, Respondent contends it is not using the domain name in bad faith. Sixth, Respondent claims that placing the domain name for sale is not in bad faith. Eighth, Respondent claims that its inactive holding of the domain is not in bad faith in this case. Ninth, Respondent claims that it did not adopt Complainant's mark with the intention of capitalizing on Complainant's goodwill. For the following reasons, all of Respondent's arguments are without merit.

a) Respondent Contends Complainant is Estopped From Pursuing This Claim Under the Doctrine of Laches

4. In Paragraph 2 of Respondent's Response to the Domain Complaint the Respondent states: "This complaint should be dismissed based on the doctrine of laches. The Complainant in this case repeatedly contacted Respondent over a 12 year period asking to buy the domain without raising any intellectual property issues." (See Respondent's Response at pg. 1, p. 2).

Respondent has not shown that it suffered any prejudice by Complainant's delay in bringing this UDRP Complaint or that the time frame within which the Complainant brought the proceeding was of no consequential value. *See Drown Corp. v. Premier Wine & Spirits*, FA 616805 (Nat. Arb. Forum Feb. 13, 2006). Moreover, Laches is an equitable remedy, routinely found to be out of place in UDRP proceedings. *See Disney Enters. Inc. v. Meyers*, FA 697818 (Nat. Arb. Forum June 26, 2006) ("Respondent's efforts at arguing related equitable defenses such as estoppel and acquiescence are equally misplaced as these legal arguments are not contemplated by the Policy. *See also Hebrew Univ. of Jerusalem v. Alberta Hot Rods*, D2002-0616 (WIPO Oct. 7, 2002) ("The remedy available in an Administrative Proceeding under the Policy is not equitable. Accordingly, the defense of laches has no application.")). Based on the foregoing, Complainant respectfully submits Respondent's contention that Complainant is barred from seeking the relief requested in the initial complaint to be without merit.

b) Respondent Contends that the Domain is Not Confusingly Similar to a Trademark for which the Complainant Has Rights

5. In Paragraph 3 of Respondent's Response to the Complaint the Respondent brings into question Complainant's rights to Complainant's Marks. (See: Respondent's Response at pg. 2, p. 3). It has been well established that pending trademark or service mark applications can be used to help establish rights in a mark in a domain name dispute proceeding. See: *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. D2000-0743 (quoting *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. D2000-0050, March 23, 2000, "This Administrative Panel acknowledges that the Uniform Policy in paragraph 4(a)(i) refers merely to a 'trademark or service mark' in which the Complainant has rights, and in particular does not expressly limit the application of the Uniform Policy to a registered trademark or service mark of the Complainant. Further, this Administrative Panel recognizes that the WIPO Final Report on the Internet Domain Name Process (the Management of Internet Names and Addresses: Intellectual Property Issues, April 1999), from which the Uniform Policy is derived, does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names. It is therefore open to conclude that the Uniform Policy is applicable to unregistered trademarks and service marks."). Moreover, Complainant began using Complaint's Marks in commerce prior to the date of registration of the domain name by Respondent on March 7, 2000 as evidenced by the business invoice dated January 31, 1998 and business marketing material distributed in 1998 attached to the initial complaint as Exhibits 10 and 11 (See Complainant's Complaint, Exhibit No.'s 3, 10, and 11). Because trademark rights are acquired and maintained by actual use of the mark in commerce, unregistered marks are also protected under common-law principles. Complainant's use of its mark long before Respondent's registration, accordingly, establishes Complainant's right to its mark, and allows it to stop infringement.

Assuming Respondent is setting forth an argument that its use of the domain name at issue is not confusingly similar to Complainant's Marks, Complainant notes that Respondent incorporates the identical terms found in its mark, namely: "DIRECTORS" and "CHOICE" in the domain name at issue. See *Nikon, Inc. v. Technilab, Inc.*, D2000-1774 (WIPO Feb. 26, 2000) (holding that confusing similarity under the Policy is decided

upon the inclusion of a trademark in the domain name); *See Also Magnum Piering, Inc. v. Mudjacks & Wilson*, D2000-1525 (WIPO Jan. 29, 2001) (holding that confusing similarity under the Policy is decided upon the inclusion of a trademark in the domain name). Complainant respectfully submit

c) Respondent Contends to Have Rights in the Domain

6. In Paragraph 4 of Respondent's Response to the Complaint, Respondent claims that it has rights in the domain as Respondent initially registered the domains "directorschoice.com" and "dinerschoice.com" for the purposes of providing movie and restaurant websites (See Response at pg. 3, p. 4) Complainant notes that Respondent fails to provide any evidence that the domain was registered to offer these services. Based on the foregoing, Respondent cannot show that it has used the Domain Name for a bona fide offering of goods or services, or for a legitimate noncommercial or fair use. Complainant respectfully submits that the Respondent's insinuated allegations of legitimate use are insufficient to satisfy the requirements of Paragraph 4(c)(ii) of the Policy. (See Also: *Royal Bank of Canada*, (WIPO Case No. D2002-0672).

d) The Respondent Contends that Respondent Did Not Register the Domain in Bad Faith and that Respondent is Not Using the Domain in Bad Faith

7. In Paragraph 5 of Respondent's Response to the Complaint, Respondent states "As previously discussed Complainant has failed to show trademark rights prior to the registration of the domain name in 2000. Exhibits 10 and 11 show the term "Director's Choice, LLC" being used as a company name, not a trademark;" (See Respondent's Response pg. 4, p. 5). As stated in paragraph 5 above, Complainant began using Complainant's Marks in commerce prior to the date of registration of the domain name by Respondent on March 7, 2000 as evidenced by the business invoice dated January 31, 1998 and business marketing material distributed in 1998 attached to the initial complaint as Exhibits 10 and 11 (See Complainant's Complaint, Exhibit No.'s 3, 10, and 11). Moreover, Complainant's Services under Complainant's Marks were available to consumers, throughout the United States, prior to the date of registration of the domain name. Because trademark rights are acquired and maintained by actual use of the mark in

commerce, unregistered marks are also protected under common-law principles. Complainant's use of its mark long before Respondent's registration, accordingly, establishes Complainant's right to its mark, and allows it to stop infringement.

In Paragraph 6 of Respondent's Response to the Complaint, Respondent sets forth an argument that it is not using the domain name in bad faith because HELP.Org does not offer services similar to the services of Complainant. See Respondent's Response pg. 4, p. 6) Despite the foregoing, screenshots of the homepage posted to the domain name shows a third-party advertisements for travel services (see attached Exhibit 1). Respondent's use of the disputed domain name for a pay-per-click advertising site featuring third-party links for entities offer similar services as the services provided by Complainant under Complainant's Marks is evidence of its continued use of the domain in bad faith. Moreover, Respondent's bad faith is further shown by Respondent's use of the domain as a website to generate revenue as a click-through website. It is also important to note that Organic search results on the part of the Complainant's web site are simply not relevant to the factors involved in the instant determination. Irrespective of whether Complainant's website appears higher in organic search engine rankings than does the Respondent's website at the disputed domain name is of no moment. Nothing in said rankings removes or acts to alleviate the bad faith in the instant matter by the Respondent.

Because Internet users are likely to be confused by a domain name incorporating Complainant's identical trademark in its entirety and attracted to the resolving website, thereby generating profit, Respondent registered and uses the domain name in bad faith under Policy ¶ 4(b)(iv). (See *Univ. of Houston Sys. v. Salvia Corp.*, FA 637920, Nat. Arb. Forum Mar. 21, 2006) ("Respondent is using the disputed domain name to operate a website which features links to competing and non-competing commercial websites from which Respondent presumably receives referral fees. Such use for Respondent's own commercial gain is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iv).").

In sum, proof of intention in registering a domain is almost always based on circumstantial evidence. Here, there is such evidence in exact replication of the Marks in the domain name, the absence of promotional development of the domain name, the offer to sell the domain name for \$45,000, and the third-party advertisements posted to the

homepage of the disputed domain for third-parties offering similar services as the services provided under Complainant's Service Marks. Together, these indicate an intention to register the domain name primarily for purposes of selling it in excess of out-of-pocket costs. Section 4(b) of the Rules provides that such evidence is evidence of both bad faith registration and use. As such it is clear that Respondent registered and used the domain name in bad faith as evidenced by the Respondent's pattern of conduct and the excessive price demanded.

e) The Respondent Contends Placing the Domain for Sale is Not Bad Faith in this Case

8. In paragraph 7 of the Respondent's Response to the Complaint, Respondent presents the argument that offering the disputed domain for sale is not evidence of bad faith. See Respondent's Response pg. 5, p. 7) According to Policy 4(b)(i) Respondent exhibits bad faith if circumstances indicate that it has registered the disputed domain name primarily for the purpose of selling or renting. Respondent attempted to sell the domain name to Complainant for consideration that was in excess of its out-of-pocket expenses, namely, \$45,000 and therefore exhibited bad faith. (See America Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd., FA 93679 (Nat. Arb. Forum Mar. 15, 2000); See also Universal City Studios, Inc. v. Metting Point Co., D2000-1245 (WIPO Dec. 7, 2000) (finding bad faith where Respondent made no use of the domain names except to offer them to sale to Complainant); see also Dynojet Research, Inc. v. Norman, AF-0316 (eResolution Sept. 26, 2000) (finding that Respondent demonstrated bad faith when he requested monetary compensation beyond out of pocket costs in exchange for the registered domain name).

f) The Respondent Contends Inactive Holding the Domain is Not Bad Faith in this Case

9. In paragraph 8 of the Respondent's Response to the Complaint, Respondent contends that its inactive holding of the disputed domain should not be considered in bad faith because the inactive holding of a large number of domains covering various topics of interest is a

part of Respondent's routine and necessary business practice. (See Respondent's Response pg. 6, p. 8) Respondent's passive holding of the domain name demonstrates a lack of rights and legitimate interests. (See Ziegenfelder Co. v. VMH Enter., Inc., D2000-0039 (WIPO Mar. 14, 2000) (finding that failure to provide a product or service or develop the site demonstrates that Respondents have not established any rights or legitimate interests in the domain name); (see also Bloomberg L.P. v. Sandhu, FA 96261 (Nat. Arb. Forum Feb. 12, 2001) (finding that no rights or legitimate interest can be found when Respondent fails to use disputed domain names in any way). Although Respondent claims that it used the domain for restaurant and movie review services, Respondent fails to provide any evidence showing its use of the domain for this purpose. As such, it can only be concluded the Respondent has made no use of the domain name at issue. Passive holding of a domain name for a period of time is evidence of bad faith. See Telstra Corp. v. Nuclear Marshmallows, D2000-0003 (WIPO Feb. 18, 2000) ("[I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith"). As such, Respondent's active holding of the disputed domain in the instant proceeding should be considered in bad faith.

g) The Respondent Contends that Respondent Did Not Adopt Complainant's Mark With the Intention of capitalizing on Goodwill

10. In paragraph 9 of the Respondent's Response to the Complaint, Respondent contends that it did not adopt Complainant Mark in its domain name with the intention of capitalizing on goodwill (See Respondent's Response pg. 6, p. 9). As stated hereinabove, because Internet users are likely to be confused by a domain name incorporating Complainant's identical trademark in its entirety and attracted to the resolving website, thereby generating profit. See Univ. of Houston Sys. v. Salvia Corp., FA 637920 (Nat. Arb. Forum Mar. 21, 2006) ("Respondent is using the disputed domain name to operate a website which features links to competing and non-competing commercial websites from which Respondent presumably receives referral fees. Such use for Respondent's own commercial gain is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iv)."). As such, Respondent registered and uses the domain name in bad faith under Policy ¶ 4(b)(iv). As evidenced by the attached Exhibit 1, Respondent is capitalizing on Complainant's business goodwill by deceiving internet users into visiting the disputed

domain and receiving profit for referrals to third-parties offering similar services as the services provided by Complainant under Complainant's Service Marks.

III. Respondent's Request for Reverse Hijacking (RDNH) Ruling

Complainant respectfully requests the Panel deny Respondent's request for a Reverse Hijacking (RDNH) Ruling as Complainant is not using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name

IV. Summary

As set forth before, Respondent has knowingly infringed upon Complainant's service marks by registering and using the disputed domain name which encompasses Complainant's Service Marks for the purpose of Respondent's own commercial gain. Respondent deceives Internet users who intend to access Complainant's site into believing that the services offered by third-parties on the disputed domain are in some manner associated, sponsored, or affiliated with those related services offered by the Complainant. Moreover, to the extent that Internet users realize after viewing the homepage posted to the disputed domain that the website is not affiliated with Complainant, injury in the form of initial interest confusion has already occurred. Respondent has effectively conceded the majority of the allegations herein and has not set forth, with any sufficiency, any basis as to why the *prima facie* case set forth by Complainant should be deemed inadequate. For these reasons the Domain Name should be transferred to the Complainant.

V. Remedies Requested

11. In accordance with Paragraph 40(b) of the Policy, for the reasons described above, the Complainant requests the Administrative Panel appointed in this administrative proceeding issue a decision that the domain name directorschoice.com transferred to Complainant.

VI. Communications

12. In accordance with Paragraph 3(b)(xii) of the Rules a copy of this Additional Submission has been sent or transmitted to the Respondent on November 21, 2014 via email.
13. Pursuant to Supp. Rule 4(e)(i) Complainant certifies that a copy of this Additional Submission has been sent or transmitted to the concerned registrar[s] on November 21, 2014 via email.

VII. Payment

14. As required by the Rules and Supplemental Rules, payment in the amount of \$400.00 (United States Dollars) has been made by credit card by and through the National Arbitration Forum's online payment gateway and/or via email.

VII. Certification

15. The Complainant agrees that its claim and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain names holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing (b) the concerned registrar, (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.
14. The Complainant certifies that the information contained in the Complaint and this Additional Submission is to the best of the Complainant's knowledge, complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in the Complaint and Additional Submission are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

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