



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Dial-A-Mattress Operating Corp. v. Christopher E. Moakely**

**Case No. D2005-0471**

### **1. The Parties**

The Complainant is Dial-A-Mattress Operating Corp., Long Island City, New York, United States of America, represented by Sarah E. Greenless, Esq., Dial-A-Mattress Operating Corp., United States of America.

The Respondent is Christopher E. Moakely, Coplay, Pennsylvania, United States of America.

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

The disputed domain name <1-800mattress.com> is registered with Melbourne IT trading as Internet Name Worldwide.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 28, 2005. On April 29, 2005, the Center transmitted by email to Melbourne IT trading as Internet Name Worldwide a request for registrar verification in connection with the domain name at issue. On May 12, 2005, Melbourne IT trading as Internet Name Worldwide transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on May 25, 2005. The Center verified that the Complaint together with

the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, Paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 26, 2005. In accordance with the Rules, Paragraph 5(a), the due date for Response was June 15, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 17, 2005.

The Center appointed William R. Towns as the sole panelist in this matter on June 20, 2005. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, Paragraph 7.

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

The Complainant is a retailer in the field of mattresses and bedding products. Best known since 1988, as a telemarketer selling mattresses using the toll free number 1-800-MATTRESS, the Complainant also operates retail stores and sells mattresses and bedding products over the internet at "www.mattress.com". The Complainant has used the trade name "1-800-MATTRESS" since 1994, in connection with these activities.

The Complainant is the owner of the service marks 1-800-MATTRES, AND LEAVE OFF THE LAST S THAT'S THE S FOR SAVINGS, and 1-800-MATTRESS. The first mark was registered with the United States Patent and Trademark Office (PTO) on December 22, 1990, and the second mark obtained PTO registration on January 4, 2005. The PTO registration for 1-800-MATTRESS reflects that the mark was first used in commerce on December 31, 1995.

The Respondent, a former employee of the Complainant, registered the disputed domain name <1-800mattress.com> on February 7, 2000. The disputed domain name currently resolves to temporary website apparently maintained not by the Respondent but by the web host, and there is no indication in the record that the Respondent has ever made any commercial or noncommercial use of the domain name. On or about March 17, 2005, the Complainant contacted the Respondent, requesting that the Respondent cease and desist using the disputed domain name and transfer the domain name to the Complainant. The Respondent chose not to honor this request.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name <1-800mattress.com> is confusingly similar to its federally registered service marks, 1-800-MATTRES, AND LEAVE OFF THE LAST S THAT'S THE S FOR SAVINGS, and 1-800-MATTRESS. The Complainant also maintains that the Respondent has no rights or legitimate interests

with respect to the disputed domain name, because (1) the Complainant has not authorized the Respondent to use the domain name, (2) the Respondent has never been commonly known by the domain name, and (3) there is no evidence that the Respondent has used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or for any legitimate noncommercial purpose. Further, the Complainant avers that the Respondent, a former employee of the Complainant, registered and is using the disputed domain name in bad faith. Accordingly, the Complainant seeks the transfer of the disputed domain name.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **A. Scope of the Policy**

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, [WIPO Case No. D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, [WIPO Case No. D2000-0187](#). See Report of the WIPO Internet Domain Name Process, Paragraphs 169 & 170. Paragraph 15(a) of the Rules provides that the Panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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

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

Cancellation or transfer of the domain name are the sole remedies provided to the Complainant under the Policy, as set forth in Paragraph 4(i).

Paragraph 4(b) sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) in turn identifies three means through which a respondent may establish

rights or legitimate interests in the domain name. Although the complainant bears the ultimate burden of establishing all three elements of Paragraph 4(a), a number of panels have concluded that Paragraph 4(c) shifts the burden to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a prima facie showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#).

## **B. Identical or Confusingly Similar**

The Panel finds that the disputed domain name <1-800mattress.com> is confusingly similar to the Complainant's registered service marks 1-800-MATTRES, AND LEAVE OFF THE LAST S THAT'S THE S FOR SAVINGS, and 1-800-MATTRESS. For purposes of Paragraph 4(a)(i), a domain name incorporating a complainant's mark generally will be considered confusingly similar unless accompanied by other terms that effectively disclaim any association. See *Lockheed Martin Corporation. v. Dan Parisi*, [WIPO Case No. D2000-1015](#); *The Salvation Army v. Info-Bahn, Inc.*, [WIPO Case No. D2001-0463](#).<sup>1</sup> The disputed domain name contains no additional terms that would distinguish it from the Complainant's service marks, and for this reason the Panel concludes that persons viewing the disputed domain name likely would think that the domain name is in some way connected to the Complainant. This is known as "initial interest confusion", which occurs when a member of the public sees the disputed domain name and thinks that it may lead to a website associated with the Complainant. See *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, [WIPO Case No. D2004-0206](#).

The Complainant has established rights in the two service marks through registration and use. The Panel notes that the Complainant did not obtain registration of the 1-800-MATTRESS mark until January 4, 2005, some five years after the Respondent registered the disputed domain name, but the federal registration indicates that the mark had been used in commerce since December 1995.<sup>2</sup> Even had there been no use of this mark prior to the registration of the disputed domain name, a majority of Panels have held for purposes of Paragraph 4(a)(i) that a complainant can have rights in a trademark or service mark corresponding to the domain name even where those rights first arise after the registration of the domain name. See, e.g., *Digital Vision, Ltd. v. Advanced Chemill Systems*, [WIPO Case No. D2001-0827](#); *Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc)*, [WIPO Case No. D2003-0320](#); *AB Svenska Spel v. Andrey Zacharov*, [WIPO Case No. D2003-0527](#); *Iogen Corporation v. Iogen*, [WIPO Case No. D2003-0544](#);

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<sup>1</sup> Most panels consider a domain name incorporating the complainant's mark to be confusingly similar to the mark without regard to the inclusion of other terms in the domain name. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, [WIPO Case No. D2004-0230](#); *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, [WIPO Case No. D2000-0662](#); *Lockheed Martin Corporation v. Dan Parisi*, [WIPO Case No. D2000-1015](#); *The Salvation Army v. Info-Bahn, Inc.*, [WIPO Case No. D2001-0463](#).

<sup>2</sup> The term "trademark or service mark" as used in Paragraph 4(a)(i) encompasses both registered marks and common law marks. See e.g., *The British Broadcasting Corporation v. Jaime Renteria*, [WIPO Case No. D2000-0050](#); *United Artists Theatre Circuit, Inc. v. Domains for Sale Inc.* [WIPO Case No. D2002-0005](#), *The Professional Golfers' Association of America v. Golf Fitness Inc., a/k/a Golf Fitness Association*, [WIPO Case No. D2001-0218](#).

*Madrid 2012, S.A. v. Scott Martin-MadridMan Websites*, [WIPO Case No. D2003-0598](#). See *PC Mall, Inc. v. Pygmy Computer Systems, Inc.*, [WIPO Case No. D2004-0437](#).

### **C. Rights or Legitimate Interests**

The Complainant has not authorized the Respondent to use its service marks or to register domain names reflecting these marks. There is no evidence that the Respondent has never been commonly known by the domain name. The record is not indicative of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with any offering of goods or services. Nor is there any indication that the Respondent is making any noncommercial use of the domain name.

Given the foregoing, the Panel finds that the Complainant has made a *prima facie* showing under Paragraph 4(a)(ii). The circumstances set forth in the Complaint are sufficiently evocative of cybersquatting to require the Respondent to come forward with evidence under Paragraph 4(c) of the Policy demonstrating rights to or legitimate interests in the disputed domain name. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#); *Compagnie de Saint Gobain v. Com-Union Corp.*, [WIPO Case No. D2000-0020](#).

Pursuant to Paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has not submitted a formal response to the Complaint, and in the absence of any such submission this Panel may accept all reasonable inferences and allegations included in the Complaint as true. See, *Talk City, Inc. v. Robertson*, [WIPO Case No. D2000-0009](#).<sup>3</sup> Nevertheless, the ultimate burden of proof on the legitimacy issue remains with the Complainant. *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#). Accordingly, the Panel considers it appropriate to examine the record in its entirety to determine whether any evidence exists to support a claim by Respondent of rights or legitimate interests in the

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<sup>3</sup> Some panels have held that a respondent's lack of response can be construed as an admission that the respondent has no rights or legitimate interests in a disputed domain name. See, *Do the Hustle, LLC v. Tropic Web*, [WIPO Case No. D2000-0624](#). Other panel decisions note that adverse inferences may be drawn from a respondent's failure to reply. See, *Charles Jourdan Holding AG v. AAIM*, [WIPO Case No. D2000-0403](#).

disputed domain name.

The record as a whole discloses nothing even remotely suggesting that the Respondent has been commonly known by the disputed domain name, nor any indication of any legitimate noncommercial or fair use of the domain name. The domain name currently resolves to a “temporary” website, apparently maintained by the website host to advertise its services, but there is no indication that the Respondent is using or has made demonstrable preparations to use the disputed domain name in connection with any offering of goods or services. In fact, the record reveals no plausible basis upon which the Respondent could claim any rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has met its burden under Paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant (the owner of the trademark or service mark) or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the Respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the Respondent intentionally is using the domain name in an attempt to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on its website or location.

The overriding objective of the Policy is to prevent abusive domain name registration and use for the benefit of legitimate trademark owners, and the Panel notes that the examples of bad faith registration and use set forth in Paragraph 4(b) are not meant to be exhaustive of all circumstances from which such bad faith may be found. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#). Under *Telstra*, passive holding of a domain name can be considered as bad faith where it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name that would not be illegitimate. See, also *Salomon Smith Barney, Inc. v. Salomon Internet*

Services, [WIPO Case No. D2000-0668](#).

The *Telstra* requirements are met where “the Complainant proves that the registration was undertaken in bad faith *and* that the circumstances of the case are such that Respondent is continuing to act in bad faith.” *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#) (emphasis in original). A finding that the domain name “has been registered in bad faith” can be reached under *Telstra* where the totality of the circumstances persuades the panel that the primary motive for the respondent’s acquisition of the disputed domain name was cybersquatting.

This Panel is persuaded from the circumstances of this case that the Respondent’s primary motive in registering the disputed domain name was cybersquatting. The Respondent was employed by the Complainant during 1994 and 1995, and his wife also worked for the Complainant until her job position was eliminated in 2003. Clearly, the Respondent would have been aware of the Complainant’s service marks at the time he registered the disputed domain name in February 2000.<sup>4</sup> Moreover, the Respondent has failed to make any active use of the domain name, and the Panel cannot conceive of any plausible actual or contemplated active use for which the Respondent could have registered the domain name that “would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.” *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#). The Panel therefore concludes that the Respondent’s registration of the disputed domain name “was undertaken in bad faith *and* that the circumstances of the case are such that Respondent is continuing to act in bad faith.” *Id.* (emphasis in original). Accordingly, the Panel finds that the Complainant has met its burden under Paragraph 4(a)(iii).

## 7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <1-800mattress.com> be transferred to the Complainant.

William R. Towns Sole Panelist

Dated: July 1, 2005

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<sup>4</sup> Although the Complainant’s 1-800-MATTRESS mark was not registered until 2005, common law rights in a trademark or service mark may be established by extensive or continuous use sufficient to identify particular goods or services as those of the trademark owner. See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918). The record reflects the Complainant’s use of this mark in commerce as far back as 1995.