Decision for dispute CAC-UDRP-100464

Case number	CAC-UDRP-100464
Time of filing	2012-06-12 09:50:53
Domain names	anderocci.com, walteranderocci.com, walteranderocci.net

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Name	Walter E. Anderocci Esq.

Complainant representative

Name	James Philip Renken Esq.

Respondent

Organization	"Walter Anderocci"

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings that the Panel is aware of.

IDENTIFICATION OF RIGHTS

Complainant asserts common law trademark rights to the name “Walter E. Anderocci” under which he has advertised his legal services.

FACTUAL BACKGROUND

The Complainant, Walter E. Anderocci, is a lawyer of the law firm with the same name in Brooklyn, New York (U.S.A.). Mr. Anderocci has engaged in the professional practice of the law in New York State since 1977, according to the evidence filed in support of the Complaint. His law practice is known and identified by his personal name, under which he has advertised his legal services.

The Respondent has registered the Domain Names <anderocci.com> and <walteranderocci.com> on July 29, 2010 and the Domain Name <walteranderocci.net> on November 2, 2010.

At the date of filing, the Domain Names <anderocci.com> and <walteranderocci.com> do not appear to display substantive content, while the Domain Name <walteranderocci.net> displays advertisement links.

PARTIES CONTENTIONS

THE PARTIES' CONTENTIONS

A. Complainant principally makes the following assertions:

1. Complainant contends that the Domain Names <anderocci.com>, <walteranderocci.com> and <walteranderocci.net> are identical and confusingly similar to the name “Walter E. Anderocci” and the common law trademark rights which he asserts in his name pursuant to ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”) paragraph 4(a)(i).

2. Complainant contends that Respondent has no rights or legitimate interest in the Domain Names at issue pursuant to the Policy paragraph 4(a)(ii). Complainant argues that he is the only known "Walter Anderocci" in the United States and that the Domain Names at issue point to web sites with limited or no content, which does not illustrate any legitimate interest.

3. Complainant contends that Respondent registered and is using the Domain Names at issue in bad faith in violation of the Policy paragraph 4(a)(iii). The Complainant argues that by the use of the words "Brooklyn Divorce Lawyer", the Respondent demonstrates actual knowledge of the Complainant's rights. The Respondent offered the web sites for sale. The registrant of the Domain Names at issue was listed initially as "George Washington".

B. Respondent principally makes the following assertions:

1. Respondent contends that the Complainant does not have trademark rights in his name according to the Policy paragraph 4(a)(i). Respondent argues that Complainant does not have a copyright or a trademark right for the Domain Names at issue, neither as a registered right or under common law, and that here are hundreds if not thousands of people with the name Anderocci. The UDRP has been invoked to successfully protect personal names, typically where the complainant is a famous celebrity, but several recent complaints have failed because they did not specifically allege, or were unable to show, trademark rights in the names at issue.

2. Respondent contends to make legitimate non-commercial or fair use of the Domain Names at issue pursuant to the Policy paragraph 4(a)(ii). Respondent asserts that the Domain Names at issue are used as genuine "gripe sites" which vest the Respondent of a legitimate interest under paragraph 4(c)(iii). The exercise of free speech for criticism and commentary demonstrates a right or legitimate interest.

3. Respondent contends that the Domain Names at issue have not been registered and used in bad faith in violation of the Policy paragraph 4(a)(iii). The Respondent asserts that the registration of the domain names at issue was made anonymously for fear of harassment from the Complainant.

RIGHTS

Complainant has not registered the “Walter E. Anderocci” mark with a government authority or agency, but trademark registration is not necessary to establish rights under the Policy paragraph 4(a)(i). Registration is not required as long as the Complainant can establish common law rights through proof of sufficient secondary meaning associated with the mark. See SeekAmerica Networks Inc. v. Masood, WIPO Apr. 13, 2000, D2000-0131 (finding that the Policy does not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist).

Complainant has provided evidence of the use of the “Walter E. Anderocci” mark since the 1970s and its promotion in connection with the Complainant’s professional legal services. This Panel finds Complainant has established common law rights in the “Walter E. Anderocci” trademark through its decades of commercial use in the field of legal services to identify Walter E. Anderocci personally as a law practitioner. See Friedman & Feiger LLP v. Whois Watchdog, NAF June 2, 2010, Case No. 1319476 (recognising common law rights in the personal name of a law firm partner who had been practicing the law for 9 years).

The <anderocci.com>, <walteranderocci.com> and <walteranderocci.net> Domain Names registered by Respondent are confusingly similar to the common law trademark rights which Complainant holds in his name. The three Domain Names

consist of the word <anderocci> which is the most distinctive element of the trademark Walter E. Anderocci. Two of the three Domain Names also consist of the first name <Walter>. Only the abbreviation of the middle name "E." is missing in the domain names, but that does not imply that the Domain Names are not confusingly similar to the trademark Walter E. Anderocci.

At the time of filing, both the <anderocci.com>, and <walteranderocci.com> Domain Names display content prominently referring to “Walter Anderocci, Divorce Attorney in Brooklyn”, which confirms that the Domain Names are meant to be confusingly similar to the trademark of the Complainant. The Complainant provides evidence regarding the number of people with the last name “Anderocci” which makes it plausible that only a single person is known for providing professional legal services in relation with the name “Anderocci” in the state of New York. This also confirms that the Domain Names are confusingly similar to the trademark of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant contends that Respondent has no rights or legitimate interest in the Domain Names at issue pursuant to the Policy paragraph 4(a)(ii), while Respondent claims to make a legitimate non-commercial or fair use of the name in accordance with paragraph 4(c)(iii) of the Policy.

This panel finds that Respondent is not a licensee of the Complainant and is not otherwise authorized to use the Complainant’s trademark.

However, the Policy sets forth examples of circumstances whereby a domain name registrant may demonstrate a right or legitimate interest in a domain name, which includes making a legitimate non-commercial 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, according to paragraph 4(c)(iii) of the Policy.

In an earlier decision, Estée Lauder, Inc. v. Hanna, WIPO, September 25, 2000, Case No. D2000-0869, it was found that “the respondent may well, and likely does, have extensive rights of free speech to provide a platform to criticize Complainant and right to the fair use of the Complainant’s marks in so doing. The contents of Respondent’s websites may also be a perfectly legitimate use of those rights. But Respondent could well have chosen to use a domain name that was not confusingly similar to Complainants and/or in which Complainant has no rights; it intentionally chose not to do so. […] Respondent’s free expression rights do not here give it a right or legitimate interest in the domain names at issue.” Although the Estée Lauder case concerned the registration of intentional misspellings of the Estée Lauder trademark, the Panel finds the underlying reasoning to be applicable to the present case.

It is generally accepted that trademark law aims to protect both the public, which should not be misled about the origin of products and services, and the trademark owners, which must not accept misappropriations of the goodwill vested in their trademarks. Regarding the latter, it should be noted that as a solo professional services practitioner, one of the Complainant’s important business assets lies in the commercial use of his name.

This Panel finds that the Respondent’s Domain Names are not used as legitimate “gripe sites” to levy criticism of the Complainant and/or its products or services. Respondent’s web sites do not appear to have substantive content or to be used in the sincere pursuit of Respondent’s free speech rights. Some of the webpages only consist of advertising links, offered by a third party, while other pages have limited content that relates to the Complainant and further consist of hundreds of advertising links.

This Panel finds that the Respondent’s use of the Domain Names amounts to a case of cyber squatting, which the Policy was designed to address. Therefore, the use of the Domain Names at issue are not genuine “gripe sites” and do not vest Respondent with a legitimate interest under paragraph 4(c)(iii). See Proskauer Rose LLP v. Leslie Turner, WIPO, June 30, 2011, Case No. D2011-0675 (which found that the registration of a law firm’s name under a “.com” domain name did vest

the respondent a legitimate interest under paragraph 4(c)(iii) because the domain name was used solely in sincere pursuit of respondent's free speech rights, which is clearly not the case here).

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant contends that the Respondent registered and uses the Domain Names in bad faith in violation of the Policy paragraph 4(a)(iii).

The Panel finds that the Respondent knowingly chose domain names almost identical to the trademark of Complainant, while the Respondent could have chosen domain names not confusingly similar to the Complainant's name. The registration of the <anderocci.com>, <walteranderocci.com> and <walteranderocci.net> Domain Names could not have been bona fide. The registrations necessarily prevent Complainant from commercially using the most likely domain names in connection with his name as a solo practitioner.

The Respondent's intent to sell the Domain Names is evidenced by screen shots of the <walteranderocci.com> web site on June 10, 2012 submitted by the Complainant, which indicate "www.walteranderocci.com for sale. Please email walteranderocci@gmail.com with any offers". The Panel finds that the Respondent appears to be holding the Domain Names for no other purposes that to sell them to the Complainant and to make commercial use by publishing numerous advertising links.

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.
The non-standard communcation of the Respondent of 15 August 2012, a few hours before the final decision, is disregarded by the Panel because it did not comply with the Rules.

PRINCIPAL REASONS FOR THE DECISION

The Panel concludes that the Complainant has proved each of the three elements of paragraph 4 of the Policy. Accordingly, the Panel requires that the registrations of the Domain Names <anderocci.com>, <walteranderocci.com> and <walteranderocci.net> be transferred to the Complainant pursuant to paragraphs 4(i) of the Policy and 15 of the Rules.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ANDEROCCI.COM**: Transferred
2. **WALTERANDEROCCI.COM**: Transferred
3. **WALTERANDEROCCI.NET**: Transferred

PANELLISTS

Name	**Tom Heremans**

DATE OF PANEL DECISION 2012-08-15

Publish the Decision