



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

LAERDAL MEDICAL CORPORATION v. V. Lee

Case No. D2007-1672

1. The Parties

The Complainant is LAERDAL MEDICAL CORPORATION, Wappingers Falls, New York, of United States of America, represented by Davis & Gilbert LLP, United States of America.

The Respondent is V. Lee, Road Town, Tortola, British Virgin Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by Rivkin Radler LLP, United States of America.

2. The Domain Name and Registrar

The Disputed Domain Name <leardal.com> is registered with Network Solutions, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 14, 2007. On November 14, 2007, the Center transmitted by email to Network Solutions, LLC a request for registrar verification in

connection with the domain name at issue. On November 15, 2007, Network Solutions, LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that 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 November 21, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2007. The Response was filed with the Center on December 13, 2007.

The Center appointed Alistair Payne as the sole panelist in this matter on January 7, 2008. 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.

The initial date for a Response was December 11, 2007. Due to extenuating circumstances an extension of three days was granted to the Respondent.

4. Factual Background

The Complainant holds a US trademark registration for LAERDAL since March 25, 2003 in the field of medical equipment. The trademark application was filed on October 16, 2000. The Disputed Domain Name was registered by the Respondent on October 11, 2001. The Respondent is a representative of the company New Ventures Services Corp. which operates in the British Virgin Islands.

The Complainant is seeking the transfer of the Disputed Domain Name.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Disputed Domain Name is confusingly similar to its registered trademark for LAERDAL. The Complainant contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the hosting of a site containing sponsored links to competing products is evidence of a use of the Disputed Domain Name in bad faith.

B. Respondent

In response to the Complainant's contentions, the Respondent states that the Disputed Domain Name was registered by an automated process and that the Respondent was not aware of the Complainant's business or rights and had no intention of infringing such rights. The Respondent also claims that the sponsored links arise as a result of a third party process and they exercise no control over the content of the website at <leardal.com>. Finally, the Respondent notes that it offered to transfer the Disputed Domain Name to the Complainant as soon as they

discovered that the Complainant had rights in the Disputed Domain Name.

6. Discussion and Findings

If the Complainant is to succeed, it must prove each of the three elements referred to in Paragraph 4(a) of the Policy, namely that:

- i. the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights;
- ii. the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- iii. the Disputed Domain Name has been registered and is being used in bad faith.

The Panel will proceed to establish whether the Complainant has discharged the burden proof in respect of each of the three elements referred to in Paragraph 4(a) of the Policy.

A. Identical or Confusingly Similar

The Panel accepts evidence that the Complainant had an application for a US trademark for LAERDAL prior to the registration of the Disputed Domain Name. The Panel also accepts that the Complainant built up considerable common law rights and reputation in the LAERDAL trademark in relation to the supply of medical equipment and apparatus over the past number of years. The Panel is satisfied that the Complainant is an organization with a substantial commercial presence in both Europe and the US among other places. The Panel finds that the Disputed Domain Name is confusingly similar to the mark in which the Complainant has rights. The misspelling of the word "LAERDAL" in the domain name <keardal.com> does not eliminate confusion with the Complainant's mark and as such, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

As noted above, the Panel accepts that the Complainant has rights in the LAERDAL trademark. The Complainant must, therefore, establish a *prima facie* case that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

The Panel accepts that the Complainant has not authorized or licensed the Respondent to use the Disputed Domain Name. The Panel also accepts that the Respondent is not commonly known by the name "Leardal" and it was using <leardal.com> to provide sponsored links to information on products that are similar if not identical to those provided by the Complainant. As this is not a *bona fide* offering of goods and it is not a legitimate non-commercial fair use, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Respondent claims that the Disputed Domain Name was registered by automated process and it had no prior knowledge of the Complainant's rights. Collecting domain names in this manner may in itself be permissible, provided the domain names are either generic or do not infringe the existing rights of another. The Respondent relies on the UDRP decision in *Mariah Media Inc. v First Place(r) Internet Inc.*, [WIPO Case No. D2006-1275](#). However, a distinction can be drawn between that case and the present dispute on the basis that the domain name in question in the *Mariah* case was generic and the evidence was that a lot of random links at the domain name

existed with only some similar advertising links to that of the complainant's business. In this case the Disputed Domain Name is a distinctive word that is confusingly similar to the Complainant's trademark and the use of the Disputed Domain Name to provide sponsored links to competing goods and services, in these circumstances, is not a legitimate use. The Respondent has provided no evidence of any preparations to make a fair non-commercial use of the Disputed Domain Name. Consequently, the Panel finds that Respondent has failed to rebut the Complainant's *prima facie* case and as such, the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel notes that the Respondent registered the Disputed Domain Name well after the Complainant applied for trademark rights in LAERDAL. Accordingly, the Complainant contends that the Respondent registered the Disputed Domain Name in bad faith. Paragraph 4(b) of the Policy provides that if any one of four particular circumstances apply then this shall be evidence that a domain name was registered and used in bad faith. The Complainant asserts that the Respondent used the Disputed Domain Name to intentionally attract and encourage Internet users to click on the sponsored links at <leardal.com> for commercial gain, by creating a likelihood of confusion with the Complainant's trademark in the manner set out in Paragraph 4(b)(iv) of the Policy. The Panel accepts the evidence that the Respondent displayed sponsored links on <leardal.com> for websites that advertised products that were very similar to those products sold by the Complainant and in doing so was using the website for commercial gain.

The Respondent attempts to rely on the case of *Mariah Media Inc. v First Place(r) Internet Inc.*, [WIPO Case No. D2006-1275](#) in its defense. However, the Panel notes that in that case the domain name in dispute was a generic word that could have been registered accidentally. In the current case the Panel is satisfied that there was, on the balance of probabilities, a deliberate mis-spelling of the Complainant's quite distinctive word mark. Accordingly, the Panel infers that registration of the Disputed Domain Name was an act of typo squatting and was calculated to confuse Internet users as to the source of <leardal.com> and to take commercial advantage of the Complainant's rights in the LAERDAL trademark.

The Panel is not persuaded by the Respondent's argument that the choice of content at the Disputed Domain Name was made entirely by automated machine; or even if it had been, that this would necessarily have freed the Respondent from responsibility for content posted on the Respondent's own domain name. There are a great number of similarities between the products advertised on <leardal.com> and the products advertised at the Complainant's website <laerdal.com>. The Panel finds it difficult to accept that the Respondent was not aware of these similarities. On this basis the Panel is satisfied that the Respondent intended to confuse Internet users as to the source, sponsorship, affiliation or endorsement of the web content at <leardal.com> and the Panel finds that the Complainant has fulfilled the requirements of Paragraph 4(b)(iv) of the Policy. As such, the Complainant has also satisfied Paragraph 4(a)(iii) of the Policy.

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 <leardal.com> be transferred to the Complainant.

8. Unnecessary Use of Administrative Proceedings

The Panel notes that the Respondent was apparently not made aware of the Complainant's allegations prior to the

Complainant's initiation of these proceedings and was, therefore, not given an opportunity by the Complainant to respond or to transfer the Disputed Domain Name prior to the latter's filing of the Complaint. After the initiation of these UDRP proceedings the Respondent promptly offered to transfer the Disputed Domain Name to the Complainant in return for the costs of the transfer and the cessation of the present action, and again after formal commencement of the proceedings. The Complainant refused this offer on two occasions on the basis that it required transfer of the Disputed Domain Name and reimbursement of its legal fees (\$7,500).

The Panel accepts that there will be circumstances in which an offer from a respondent to a complainant to settle a UDRP dispute prior to formal commencement, or indeed prior to panel appointment, could justifiably not be entertained. This might include circumstances in which for example:

- 1) a privacy service is in use by a respondent and the true underlying registrant of the disputed domain name may have chosen not to identify itself; or
- 2) a respondent has a history of abusive domain name registration; or
- 3) the terms of a respondent's transfer offer are manifestly unreasonable; or
- 4) a respondent's offer appears to be disingenuous, for example, is clearly being made in an attempt to unduly delay proceedings; or
- 5) where a respondent has been shown to have ignored previously sent communications from a complainant asserting its claimed rights and requesting transfer of the disputed domain name; or
- 6) where there is a *bona fide* interest in the publication of a decision.

Likewise, though more exceptionally, there may be circumstances, principally to avoid a reasonable risk of cyberflight, when a complainant cannot be reasonably held to engage in correspondence with a party most likely to be acting in bad faith. However, none of these factors appear to be present in the instant dispute. Although a privacy registration service was apparently (at least partially) in use, masking the contact details of the listed registrant, at the time that the Complaint was made by the Complainant, the underlying contact details were provided by the registrar and the Center brought them to the Complainant's attention. Indeed, the Center formally notified the Complainant of the correct registrant details. The Respondent does not appear to have a history of abusive domain name registration, and the Respondent's offer to transfer the Disputed Domain Name to the Complainant appears to have created a reasonable basis on which to settle the matter. In as much as no circumstances appear present that would justify a lack of a cease and desist communication effort, the Complainant's subsequent claim for legal costs covering also the cost of preparing the UDRP complaint would appear excessive.

On the basis of these facts the Panel finds that the Complainant has acted in a manner which is contrary at least to the spirit of Paragraph 15(e) of the Rules. While the Complaint itself (as is evident from the Panel's above decision ordering transfer) is found to have merit, the manner in which the Complainant has conducted itself during the course of the proceedings leaves something to be desired. The Complainant, however much of its own time and money may initially have gone into the preparation of its Complaint, has by forcing a decision, without the presence of the above-mentioned justifying factors, in effect proceeded to lay claim to not only more of its own time, but that of the Respondent and Panel. Despite opportunities to obtain transfer early in the proceedings the Complainant refused to settle the matter unless it received substantial costs. Taking into account all circumstances of this case, the Panel finds that the Complainant's conduct pursuing the proceedings regardless of the settlement offers to transfer the domain name constitutes, if not actual abuse (in the sense of a Complaint filed in bad faith to harass a respondent), then at least an unnecessary insistence on use of these administrative proceedings.

Alistair Payne
Sole Panelist

Dated: January 21, 2008