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ADMINISTRATIVE PANEL DECISION

Under the ICANN Uniform Domain Name Dispute Resolution

Complainant:	THOMAS & BETTS INTERNATIONAL, INC.
Respondent:	POWER CABLING CORP., INC. (REGISTRANT'S EMPLOYER)
Case Number:	AF-0274
Contested Domain Name:	russellstoll.com
Panel Member:	Daniel J. Greenwood, Esq.

1. Parties and Contested Domain Name

The Complainant, Thomas & Betts International, Inc, is owner of the registered trademark "Russellstoll" and Respondent, Power Cabling Corp., Inc., is owner of the registered domain name "Russellstoll.com". The domain name "Russellstoll.com" is contested.

2. Procedural History

The electronic version of the Complaint form was filed on-line through eResolution's Website on June 30, 2000. The hardcopy of the Complaint Form was received on July 4, 2000. Confirmation of the payment was received on July 13, 2000. The choice of jurisdiction was received on July 5, 2000.

Upon receiving all the required information, eResolution's clerk proceeded to:

- Confirm the identity of the Registrar for the contested Domain Name;
- Verify the Registrar's Whois Database and confirm all the required contact information for Respondent;
- Verify if the contested Domain Name resolved to an active Web page;
- Verify if the Complaint was administratively compliant.

The inquiry led the Clerk's Office of eResolution to the following conclusions: the Registrar is Network Solutions, Inc., the Whois database contains all the required contact information, the contested Domain Name resolves to an active Web page and the Complaint is administratively compliant.

An email was sent to the Registrar by eResolution Clerk's Office to obtain a copy of the Registration Agreement on July 3, 2000. The requested information was received July 6, 2000.

The Clerk's Office then proceeded to send a copy of the Complaint Form and the required Cover Sheet in accordance with paragraph 2 (a) of the ICANN's Rules for Uniform Domain Name Dispute Resolution Policy.

The Clerk's Office fulfilled all its responsibilities under Paragraph 2(a) in connection with forwarding the Complaint to the Respondent on July 14, 2000. That date is the commencement date of the administrative proceeding.

On July 14, 2000, the Clerk's Office notified the Complainant, the Respondent, the concerned Registrar, and ICANN of the date of commencement of the administrative proceeding.

On August 2, 2000, the Respondent submitted, via email, the Response form. The signed copy was received on August 8, 2000.

On August 8, 2000, the Complainant requested the right to file a rebuttal. On August 9, 2000, the Complainant was informed that the panelist would decide whether or not a rebuttal was allowed.

On August 11, 2000, the Clerk's Office contacted a first panelist, and requested that he acts as panelist in this case. He did not answer.

On August 16, 2000, the Clerk's Office contacted a second panelist, and requested that he acts as panelist in this case. He was recused by the Respondent on August 21, 2000.

On August 22, 2000, the Clerk's Office contacted a M. Daniel Greenwood, and requested that he acts as panelist in this case.

On August 22, 2000, M. Daniel Greenwood, accepted to act as panelist in this case and filed the necessary Declaration of Independence and Impartiality.

On August 23, 2000, the Clerk's Office forwarded a user name and a password to M. Daniel Greenwood, allowing him to access the Complaint Form, the Response Form, and the evidence through eResolution's Automated Docket Management System.

On August 23, 2000, the parties were notified that Mr. Daniel Greenwood had been appointed.

On September 6, 2000, the parties were notified that, in response to the request on record, Daniel Greenwood had granted a right to file a rebuttal to each party.

On September 29, 2000, the parties were asked to reply to questions, posed by Panelist Daniel Greenwood, regarding their allegations. The request to each party read, in pertinent part, as follows:

-----Original Message-----

From: Eresolution Admin E-mail

Sent: September 29, 2000 4:47 PM

To: Respondent; Complainant

Subject: AF0274/russellstoll.com/Important message Importance: High

To both Parties,

Important message from the Panelist

The Panelist would like both of you to answer to those questions:

"1. Please indicate any evidence of bad faith, the lack of bad faith or of good faith by the Respondent at the time of registration. Not to the exclusion of any other evidence, please indicate any conversations or correspondence that may have occurred between Respondent and Complainant prior to registration pertaining to registration.

2. There are conflicting claims with respect to the nature and content of the initial contacts between Respondent and Complainant after registration. It is claimed by the Complainant that the initial contact was to "investigate [Respondent's] illegal activity with respect to the domain name" and a second contact was "relating to the Respondent's inquiry and to investigate further its illegal activity." It is claimed by Respondent that these representations are "downright wrong" and that Complainant's agents had visited for the purpose of discussing pricing, sales literature and suggesting improvements to the web site. It is further asserted by Respondent that Complainant's agents stated their approval of the web site and visited with more frequency than asserted by Complainant. Finally, Respondent offers to have its version of events between itself and the Complainant's agents corroborated by 'independent, third party distributors.' Please provide more evidence of any kind relating to the nature and content of initial contacts between Complainant and Respondent regarding Respondent's use of the registered domain name in question, including contemporaneous or near-contemporaneous notes of meetings, signed statements by individuals present at such contacts or otherwise competent to shed light upon such contacts, any internal memorandum or other evidence that would tend to support or defeat contentions in this regard."

On October 11, 2000, the parties replied to the questions posed by Daniel Greenwood, and awaited final decision.

3. Factual Background

Complainant is a large company with owns rights to the trademark Russellstoll. Russellstoll is associated with electrical interconnection systems and other industrial parts. On June 1, 1999, Respondent registered the domain name "russellstoll.com". On June 24, 1999, Respondent e-mailed Complainant, informing Complainant of the domain name registration and proposing a business relationship. After multiple additional unanswered requests by Respondent for a distributorship or other business relationship over the subsequent weeks, on July 16, 1999 Complainant replies to Respondent indicating that Complainant intends to continue using its trademark and wants the domain name handed over. Complainant's sales employees, in the meanwhile and until last month, periodically visit Respondent to render tentative assistance even while officials of Complainant's company form and maintain a hard line against use of the domain name by Respondent. In the months and weeks preceding this Arbitration process, counsel for Complainant and Respondent interacted and discussed the pending matter. It is uncontested that Respondent has made significant sales through its web

site.

4. Parties' Contentions

Complainant contends that Respondent registered russellstoll.com without authorization and continues to use it in violation of Complainant's trademark rights to the mark Russellstoll and in violation of the Uniform Domain Name Dispute Resolution Policy. It is further alleged that Respondent has attempted to extort a dealership and other valuable consideration in exchange for the domain name or for control of the site correlating with the domain name. The Respondent contends that Complainant's employees had encouraged the development of the web site and that Respondent is a legitimate after-market purveyor of Russellstoll goods. As such, Respondent alleges, it has legitimate rights or interests in the domain name. Further, Respondent alleges it did not attempt to exchange the domain name or control of the site for a distributorship and that it has acted in good faith.

5. Discussion and Finding

This arbitration decision shall apply the Uniform Domain Name Dispute Resolution Policy (UDRP) and the Rules, both approved by the Internet Corporation for Assigned Names and Number (ICANN) on October 24, 1999, as well as the eResolution Supplemental Rules. In applying the cited policy and rules to the facts presented, the Panel shall take care, according to Section 15 of the ICANN Rules, to make legal conclusions "in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable" - including principles of equity.

This Panel shall also apply, as needed, the Code of Ethics for Arbitrators in Commercial Disputes, which was prepared in 1977 by a joint committee consisting of a special committee of the American Arbitration Association and a special committee of the American Bar Association. It has been approved and recommended by both organizations. Section F. of the Code provides:

"When an arbitrator's authority is derived from an agreement of the parties, the arbitrator should neither exceed that authority nor do less than is required to exercise that authority completely. Where the agreement of the parties sets forth procedures to be followed in conducting the arbitration or refers to rules to be followed, it is the obligation of the arbitrator to comply with such procedures or rules." (see: <http://www.adr.org/roster/arbitrators/code.html>)

The framework of this decision shall mirror the requirements for transfer of a domain name under the ICANN UDRP and Rules. Accordingly, in order to grant the domain name transfer requested by the complainant, it must be determined whether complainant has shown:

- A. That the Russellstoll.com domain name is identical or confusingly similar to its trademark or service mark;
- B. That Respondent has no rights or legitimate interests in respect of the russellstoll.com domain name; and
- C. That Respondent has registered and used the domain name russellstoll.com in bad faith.

A. Similarity of Domain Name to Mark:

The trademark upon which the complaint is based is Russellstoll. It is the subject of U.S. Trademark Registration No. 1,510,780, which was registered November 1, 1988 and has been in active use at least as early as 1976. The goods on which the trademark is used in the United States are: International Class 9: ELECTRICAL PLUGS, RECEPTACLES AND CONNECTORS FOR HEAVY SERVICE INDUSTRIAL ELECTRICAL CONNECTIONS; AND ELECTRICAL SWITCHES, ELECTRICAL PILOT INDICATOR LIGHTS AND ELECTRICAL MOTOR CONTROLS FOR INDUSTRIAL USE; International Class 11: LIGHTING FIXTURES FOR INCANDESCENT LIGHTS, HIGH AND LOW BAY MERCURY VAPOR LIGHTS, HIGH-PRESSURE SODIUM LIGHTS AND METAL HALIDE LIGHTS. The mark is also used in other countries on similar goods. The trademark is registered in the United States and a certified copy of such registration was included in the paper annexed evidence which was submitted with the Complaint. In addition, the trademark is also registered in Chile and pending in Brazil. Database printouts showing detailed registration information for the non-U.S. trademarks were also included as an annex. The trademark has been assigned to Thomas & Betts International, Inc. shown by the annexed assignment form.

It is acknowledged by all parties that the Complainant has the federally registered trademark "Russellstoll" and that the domain name in question is "russellstoll.com". It is hereby found that there is sufficient evidence of similarity of the contested domain name and the trademark of the Complainant.

B. Respondent's Rights or Legitimate Interests in the Domain Name:

The second element of the UDRP requires that, in order to transfer a domain name from a respondent to a complainant, the respondent have no rights or legitimate interests in the domain name. The UDRP provides examples of situations wherein it can be concluded that a respondent does have a right or legitimate interest in the disputed domain name. The UDRP reads, in relevant part, as follows:

"4 (a) Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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"

While use of the russellstoll.com for the bona fide offering of goods or services is only one exemplary manner of showing a legitimate right or interest in the domain name, this Panel shall apply this standard. Based upon the facts of this dispute, the Respondent has the best chance of meeting the requirements of this test. If the Respondent fails to meet this test, then no other exemplary standard presented in the applicable rules would suffice for Respondent to demonstrate a legitimate right or interest in the domain name. In addition, the Panel shall consider, as a general matter, whether the Respondent has acquired and "right or legitimate interest" in the domain name russellstoll.com.

i. Use of, or Demonstrable Preparations to Use the Domain Name Before Notice of Dispute

The Panel finds that the business e-mail to the Complainant, and other measures taken by the Respondent to investigate and initiate the russellstoll.com site occurred before this dispute.

ii. Inconsistent Applications of ICANN Policy to Facts

This element of the Arbitration, in the end, boils down to whether the Respondent used, or demonstrably prepared to use, the name in connection with a bona fide offering of goods. The panel notes that there are conflicting holdings by arbitrators of domain name disputes involving facts similar to the russellstoll.com controversy. While the Panel is not bound by prior decisions of arbitrators, it is instructive to review the reasoning that others have used when attempting to apply the ICANN policy and rules to facts similar to those before the Panel.

a. Hewlett Packard

In one notable case, NAF FA0093564, an arbitrator found, inter alia, that a Respondent who had registered the domain name HewlettPackard.com had no rights or legitimate interests in the domain name because Respondent was not an authorized distributor of Hewlett Packard. It was recognized that the Respondent was affiliated with the bookstore of his daughter, which was an authorized distributor location. While the Respondent claimed that he had registered the name for his daughter's use in relation to her distributorship, apparently the majority found a lack adequate authorization necessary to create a legitimate interest in the domain name. The formidable Michael Froomkin dissented from the majority in this case, but his dissent focused upon the "bad faith" and not the "legitimate interest" elements.

b. Kittinger

In another notable case, DeC/AF-107, DeC/AF-108, a re-seller of Kittinger furniture had registered Kittinger.com and was later obliged to defend his rights to the domain name against The Kittinger Company Inc, the company that manufactures Kittinger furniture. In this case, as with the Russellstoll dispute, the Respondent was engaged in the legal selling of goods that are commonly known by reference to a trademark. In that arbitration, the Panel said:

"The panel finds that Complainant has failed to meet its burden with respect to establishing that the Respondent has no rights or legitimate interests in the domain names at issue. Respondent has used its domains in connection with a business based on the acquisition, re-conditioning and re-sale of used Kittinger furniture. This is a legitimate business that Respondent has operated for many years. The Respondent is entitled to use the name Kittinger in a fair, nominative sense to describe the furniture is sells and has made accommodations at the request of Complainant to prevent possible confusion. Moreover, this panel is bound by the UDRP paragraph 4(c) [quotation of ICANN Policy redacted]. The panel finds that the evidence submitted demonstrates that: the Respondent used the domain names at issue in connection with a bona fide offering of goods and services before notice of this dispute; the Respondent is commonly known by the name Kittinger Collector; and, the Respondent's use of the domains at issue is fair-use and not intended to divert customers or tarnish the trademark rights of the Complainant. Accordingly, the panel finds the Complainant has

not met its burden with respect to this element."

Each of these holdings is relevant to the present dispute. First, the Panel will consider whether Respondent enjoyed any license or other right to use the trademark, such as a distributor or other authorized seller might possess. This was the dispositive issue in the Hewlett Packard dispute. Next, the Panel will consider whether the Respondent possessed any other legal right to use the trademark, whether or not Respondent was authorized by Complainant to do so.

iii. "Rights or Legitimate Interests"

a. License or Other Authorization By Complainant to Use Trademark or Domain Name

The Respondent claims that it was authorized by Complainant to use the domain name in question and was encouraged by Complainant's support staff to "sell as much as you can" through Respondent's web site. After reviewing all the evidence, including replies to a special question on the nature and content of initial contacts between the disputants, this Panel has determined that Respondent did not receive actual (explicit or implied) or apparent authority to use the trademark in question from the Complainant. The signed affidavit by one of the employee's of Complainant, stating that he had never "encouraged" Respondent's web business directly conflicts with the Respondent's assertions regarding the conduct of that named employee. In fact, the Respondent, in its first Response to this dispute, indicated that it was Respondent's understanding that this named employee of the Complainant would corroborate Respondent's version of the facts. The later affidavit of the employee of Complainant contradicted the most relevant portion of Respondent's assertions.

While assertions on this point by each party in the record are frequently either inconsistent or directly conflicting, it appears that the Respondent was aware that Complainant refused to permit the use of its trademark as a domain name by Respondent. It also appears likely that one or more agents of Complainant did, in fact, give mixed messages on this point. For example, the Respondent claims that Complainant's employee had brought sales materials to Respondent to "aid us in our sales efforts." Respondent also admits that the employee of the Complainant refused to enter the building of the Respondent, "stating that 'if it ever comes up, he can say he never actually came in'". These types of encounters should put a reasonably alert person on notice that Complainant's employee is not offering a formal or enforceable grant of authority to Respondent. Obviously, no actual or explicit authority to use the trademark was granted by Complainant. Even apparent authority requires a reasonable expectation that the other party had authorized the use, and such does not appear to have been the case here. More to the point, the correspondence from Complainant demanding that Respondent cease and desist use of the domain name would tend to indicate that Respondent derived no official or dependable support, legitimization or transfer of rights from the Complainant.

The record overall tends to support the Complainant's version of the facts. Several early, negative and documented sources of feedback by Complainant in response to Respondent's web initiatives are uncontested by Respondent.

While Respondent did not enjoy the Complainant's license or other actual or apparent authority to use the Russellstoll trademark, it is still possible that Respondent may have been legally permitted to use the trademark based upon other standards. The Panel shall consider

whether the First Sale Doctrine provides a source of legality that may legitimize Respondent's right to use the domain name russellstoll.com.

b. Use of Trademark to Describe After-Market Sales of Goods Under the First Sale Doctrine

In *Sebastian International Inc. v. Longs Drug Stores Corp.*, the Ninth Circuit held that nothing in the Lanham Act exempts articles sold under collective marks from the "first sale" doctrine. According to the court, this doctrine holds that "with certain well-defined exceptions, the right of a producer to control distribution of its trademarked product does not extend beyond the first sale of the product." Naturally, this holding applies equally well to other marks. Resale of a trademarked product under the producer's trademark does not necessarily constitute trademark infringement or unfair competition when sold in an "after market". An unauthorized retailer may sell trademarked products without the trademark holder's consent, and this principle is "not rendered inapplicable merely because consumers erroneously believe the reseller is affiliated with or authorized by the producer" according to the court. The United States Supreme Court denied Sebastian's petition for review of this decision.

It is agreed by both disputants that the Respondent purchased Russellstoll equipment from distributors. In fact, the Complainant viewed Respondent as an "end user" of Russellstoll products. The Panel rejects the theory of the Complainant that the absence of any trademark license, assignment or other authorization constitutes a failure to create a legitimate right or interest in use of the mark. This Panel's view is that there is nothing per se illegal or illegitimate about the selling of Russellstoll equipment under the Russellstoll trademark after the first sale.

c. Exceeding the Fair Scope of Authority for After Market Use of Trademark

Respondent asserts that it has a legitimate right and interest in the domain name because it has been legally selling Russellstoll equipment through its web site at the domain name. Clearly under U.S. law it is possible to use the name Russellstoll as part of a legitimate, bona fide offer for sale of Russellstoll equipment. This includes using the name Russellstoll to identify used or other after-market sales of Russellstoll equipment. However, the usage of the name Russellstoll as part of the sale of Russellstoll equipment must be limited to the permitted sales activity. The fact that a person may use the Russellstoll mark to identify Russellstoll equipment for sale at eBay - or even through a physical or digital store front - does not mean that person is at liberty to use the trademark in violation of other rules. Using the name Russellstoll to describe goods may be fair. One might expect to see such use of a trademark in the text of a web page. Arguably, one may even use the trademark as the name of a sub-directory (to the right of the top level domain, appearing after the first "/" in the Uniform Resource Locator). However, using the trademark as a domain name crosses a line. This is beyond what is necessary or fair under the circumstances. The selling of exactly the same goods as Complainant under a domain name that is identical to the Complainant's federally registered trademark puts the Respondent beyond the protection of the first sale doctrine. While Respondent may have a legitimate right or interest in using the trademark to name the goods it is re-selling, Respondent should not be permitted to arrogate the domain name corresponding to the trademark solely to itself, to the exclusion of the holder of the trademark.

iv. Applicability of the Definition of "Bona Fide" to the Offerings of Goods at

russellstoll.com

There is evidence that Complainant's offer of goods under Respondent's trademark was less than bona fide. The content of the Respondent's web site includes a trademark notice reading as follows:

Russellstoll.com® is a registered trademark of Russellstoll.com

Complainant asserts that it is untrue that Respondent holds the federally registered trademark "Russellstoll.com" and assures the Panel that "certainly Thomas & Betts will oppose any attempt at registering such an infringing trademark. The respondent also falsely uses the trademark registration symbol to give the appearance that it has registered Russellstoll.com with the U.S. Trademark Office." The Respondent failed to deny these allegations in its rebuttal and also in its second rebuttal. The Panel notes that a quick search of the trademark database offered on the web by the U.S. Patent and Trademark Office indicates that russellstoll.com is not a federally registered mark. The Panel also notes that the use of the letter "R" within a circle has been statutorily reserved to designate federally registered trademarks (<http://www.uspto.gov/web/offices/tac/tmlaw2.html>).

The "Black's Law Dictionary, Abridged Fifth Edition" definition of "bona fide" reads as follows:

"In or with good faith, honestly, openly, and sincerely; without deceit or fraud. Truly; actually; without simulation or pretense. Innocently; in the attitude of trust and confidence; without notice of fraud, etc. Real, actual, genuine, and not feigned."

The Panel shall apply the above definition of "bona fide" to this dispute. This Panel finds that the offering of goods on the Respondent's site in connection with the misuse of the federally registered trademark symbol demonstrates a lack of truth. This particular deceit cuts to the core of the current dispute - namely: who has legally recognized rights to the domain name russellstoll.com. The fact that the Respondent has neither redacted this information nor disputed its untruthfulness creates a strong inference of dishonesty. As such, the Panel hereby holds that the Respondent did not make a bona fide offer of Russellstoll goods on its web site. Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the russellstoll.com domain name, under the UDRP.

C. Bad Faith Registration and Use:

i. "Likelihood of Confusion"

Under Section 4(b)(iv) of the UDRP, the following rule applies to determine whether there is evidence of registration and use in bad faith:

"by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location."

The Panel finds that the Respondent has intentionally used the domain name in question to attract Internet users who are looking for sources of Russellstoll equipment - including users

who are searching for Russellstoll directly. The purpose of using the domain name Russellstoll.com is obviously to associate and affiliate the Respondent's site with Russellstoll. The Respondent has acted responsibly by including a disclaimer at the bottom of its web pages, indicating that "This website is in no way associated or endorsed by the Thomas and Betts Corporation or any of its affiliates or associates" and providing a link directly to the Thomas and Betts website. Nonetheless, the very act of using the Complainant's trademark as the domain name of this site creates an "initial interest confusion". Initial interest confusion occurs when information may attract users who are looking for a different web site, organization or product. While those users may rapidly realize that the site is different from the one they were originally looking for, it is possible that some users may simply remain at the site and never reach the initially sought after site.

With respect to Brookfield's trademark "MovieBuff" and West Coast's domain name "moviebuff.com", the Court of Appeals for the Ninth Circuit in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.* held that there was trademark infringement based on the use of Brookfield's trademark in the domain name, and also that use of Brookfield's trademark in metatags created initial interest confusion. Although the court did not think it likely that a consumer would be confused about whose site it had reached or think that Brookfield sponsored the West Coast site, it instead based its finding of infringement on "initial interest confusion." The court stated that "by using "moviebuff.com or "MovieBuff" to divert people looking for "MovieBuff" to its Web site, West Coast improperly benefit[ed] from the goodwill that Brookfield developed in its mark."

This Panel hereby finds that the use of the domain name "russellstoll.com" creates initial interest confusion and that the Respondent has intentionally created this confusion. Under the ICANN domain name dispute policy, this conduct of the Respondent constitutes "bad faith".

ii. Leveraging Domain Name Registration Against Trademark Owner

Under Section 4(b)(i) of the UDRP, the following rule applies to determine whether there is evidence of registration and use in bad faith:

"circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name"

In pertinent part, the Complainant asserted the following:

"Further evidence of bad faith by the respondent is evidenced by the fact that it has tried to use Russellstoll.com that it has sought to use the domain name to obtain a lucrative Thomas & Betts distributorship for RUSSELLSTOLL products and/or to run a sales website for Thomas & Betts. . . The respondent has further learned that the proprietor of a distributorship near its local as passed away and, through its lawyer Michael Molinaro, has sought to obtain this valuable distributorship for transfer of the domain name."

Respondent's counsel asserts strongly that Respondent never sought a distributorship in return for the domain name russellstoll.com. Respondent's counsel claims that the Respondent sought only "distributor pricing" and not a distributorship. The Responds reads,

in pertinent part, as follows:

"Contrary to the T&B's contention, neither the Respondent nor PCC were desirous of obtaining a distributorship (sic) from T&B. The request was for distributor pricing. A distributorship would have no value without the web site. This was not the request of a cyberpirate, rather it was part of the overall business plan to obtain the most favorable pricing for Russellstoll parts, an ultimate benefit to the internet consumer."

This statement is not supported by the bulk of evidence presented to this Panel. In fact, the initial letter dated June 25, 1999 by Respondent to Complainant contained the statement

"I performed an internet (sic) domain search and subsequently obtained the name Russellstoll.com . . . [w]e are currently purchasing our Russellstoll from local electrical supply houses. *I would like to become a distributor myself or better yet, develop and run a Russellstoll direct catalog sales website for T&B.*" [emphasis added]

This letter is included in annexes proffered by both the Complainant and the Respondent. The content of the letter is uncontested - other than the statement by counsel for the Respondent that Respondent never sought a distributorship. There are several additional proffers by Complainant, including an e-mail from Respondent to Complainant inquiring whether "you have received any response regarding my distributorship inquiry" and also multiple affidavits corroborating assertions that Respondent's counsel had contacted Complainant to negotiate a transfer of control over the site at issue in return for a distributorship. One affidavit indicates that the Respondent's counsel had called to request an exchange of the russellstoll.com domain name for a distributorship because he "did not 'want to put it in writing'".

It is possible that Complainant's version of events is incorrect, and that Respondent genuinely did seek only "distributor pricing" from the Complainant. As a business matter, this would be quite understandable, as lower pricing would create a further competitive advantage. However, under this domain name dispute policy, the relevant question is whether the value requested in return for rights or control of a domain name was "in excess of your documented out-of-pocket costs directly related to the domain name." Distributorship pricing is presumably of a greater value than the out of pocket costs directly related to the domain name. Similarly, using the domain name to leverage a direct business relationship with Complainant would generate significant market value, including such things as co-branding, better pricing support, deletion of "affiliation disclaimers" and a broader access to business partners of Complainant. The fact that the Respondent communicated its desire for a distributorship or other value to Complainant merely a few days after registering the name indicates that Respondent's primary purpose was to use the domain name as leverage over the Complainant.

Based upon all the evidence presented, it is the finding of this Panel that Respondent did seek to leverage its savvy decision to register the trademark of the Complainant in return for things of non-trivial value from Complainant, including a distributorship, distributor pricing and other sources of value. These sources of value are in excess of the costs of the domain name, and therefore the conduct of the Respondent constituted "bad faith" under the ICANN policy.

6. Conclusions

It is clear to this Panel, from a reading of correspondence by the Respondent himself, that he exercised foresight and business agility by registering the domain name at issue. Similarly, it

seems obvious that the Respondent has engendered goodwill with sales staff of the Complainant and others in the business process and buying chain related to the Russellstoll lines. In other words, Respondent appears to be a good businessperson. However, good business - in the narrowest sense - does not necessarily equal legal business. Trademark laws and dispute policies like the one applied herein embody broader values of fairness to all parties and of public policies necessary to assure the continued creation of new and better intellectual property. Under the applicable policies, it is clear that Respondent can not keep the domain name. In the future, Respondent would be wise to check first with the holder of a trademark before registering it as a domain name associated with a site that sells the products of the trademark holder. Checking several days after registration can create problems. Using the registered domain name to pressure the trademark holder into granting concessions, whether explicitly or implicitly, is against public policy. That policy is supported and reflected in the UDRP.

For the reasons, findings and holdings set forth herein, this Panel determines that transfer of the domain name russellstoll.com from the Respondent to the Complainant is required under the applicable policy and rules.

7. Signature

This decision of the Panel in Case No. AF-00274 was rendered on the 23rd day of October 2000 and duly signed by Daniel J. Greenwood.

Cambridge, Massachusetts, United States of America

(s) **Daniel J. Greenwood**

Presiding Panelist