WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The NASDAQ Stock Market, Inc. v. Steve Grewal

Case No. DTV2001-0001

1. The Parties

1.1 The Complainant is The NASDAQ Stock Market, Inc., a corporation organized and existing under the laws of the State of Delaware, United States of America, having its place of business at 1735 K Street, N.W., Washington, D.C., United States of America.

1.2 The Respondent is Steve Grewal, an individual having an address at 15105 Swiss Stone Court, Burtonsville, Maryland, United States of America.

2. The Domain Name(s) and Registrar(s)

The domain name at issue is <nasdaq.tv>, which domain name is registered with dotTV Corporation International ("dotTV"), in Los Angeles, California, United States of America. dotTV has voluntarily adopted the Uniform Domain Name Dispute Resolution Policy (the "Policy" or the "UDRP") and has selected the World Intellectual Property Organization Arbitration and Mediation Center (the "WIPO Center") as a dispute resolution services provider.

3. Procedural History

3.1 A Complaint was submitted electronically to the World Intellectual Property Organization Arbitration and Mediation Center (the "WIPO Center") on January 17, 2001, and the signed original together with four copies forwarded by express courier was received on January 18, 2001. An Acknowledgment of Receipt was sent by the WIPO Center to the Complainant, dated January 23, 2001.

3.2 On January 20, 2001, dotTV confirmed by e-mail that the domain name at issue is registered with dotTV, is currently in active status, and that the Respondent is the current registrant of the name. The registrar also forwarded the requested Whois details, and confirmed that the Policy is in effect.

3.3 The WIPO Center determined that the Complaint satisfies the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Uniform Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"). The Panel has independently determined and agrees with the assessment of the WIPO Center that the Complaint is in formal compliance with the requirements of the Policy, the Uniform Rules, and the Supplemental Rules. The required fees for a single-member Panel were paid on time and in the required amount by the Complainant.

3.4 No formal deficiencies having been recorded, on January 23, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent (with copies to the Complainant and dotTV), setting a deadline of February 11, 2001, by which the Respondent could file a Response to the Complaint. The Commencement Notification was transmitted to the Respondent by courier and by e-mail to the e-mail addresses indicated in the Complaint. In any event, evidence of proper notice is provided by the evidence in the record of the Respondent's participation in these proceedings.

3.5 No Response having been received, on February 12, 2001, the WIPO Center transmitted a Notification of Respondent Default on the same day.

3.6 A Response was received on February 22, 2001. The WIPO Center acknowledged that it had received a response, that the Panel would be appointed pursuant to the Uniform Rules, and that it was within the discretion of the Panel whether to consider the late filed Response.

3.7 On February 27, 2001, having received M. Scott Donahey's Statement of Acceptance and Declaration of Impartiality and Independence, the WIPO Center transmitted to the parties a Notification of Appointment of Administrative Panel and Projected Decision Date, in which M. Scott Donahey was formally appointed as the Sole Panelist. The Projected Decision Date was March 12, 2001. The Sole Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Uniform Rules and the WIPO Supplemental Rules.

3.8 On February 28, 2001, the WIPO center received and forwarded to the Panel for its discretionary consideration Complainant's Reply and Supplemental Comments to the Response to the Complaint.

3.9 On March 7, 2001, the WIPO Center received and forwarded to the Panel Response to Complainant's Second Submission in Accordance With the Uniform Domain Name Dispute Resolution Policy.

4. Factual Background

4.1 Complainant registered the mark NASDAQ in connection with the listing of securities for quotation for sale or information purposes with the United States Patent Office ("USPTO") on October 26, 1971. Complaint, Annex E.

4.2 Complainant has used the NASDAQ mark continuously since 1968. Complainant has established a web site at www.nasdaq.com which receives approximately 50 million hits per day.

4.3 The NASDAQ mark is registered in connection with a variety of financial services with the USPTO and in 40 other countries. In addition, Complainant has registered numerous domain names incorporating the NASDAQ mark. Complaint, Annex D.

4.4 NASDAQ is a fanciful term and as such is inherently distinctive. Through its continuous and extensive use and the expenditure by the Complainant of hundreds of millions of dollars in the promotion of the mark, the term NASDAQ has become a famous mark.

4.5 Respondent registered the domain name at issue on May 16, 2000. Complaint, Annex A.

4.6 Complainant's counsel contacted Respondent by letter dated December 12, 2000 and by email transmitted that same date and requested that the Respondent cease and desist from all use of the domain name at issue. Complaint, Annex I.

4.7 Respondent's counsel responded in a letter dated December 14, 2000, and denied any wrongdoing by Respondent.

4.8 Respondent's submission of his Response was untimely. Pursuant to Uniform Rules, Rule 10, the Panel has the discretion to accept or reject pleadings that have not been submitted in compliance with the Uniform Rules. In this case, since the Response was received prior to the appointment of the Panel, the Panel, in the interest of fairness, has determined that it will accept and consider the Response.

4.9 Respondent submitted several affidavits under oath all to the effect that since 1995 Respondent has been involved in causes having to do with the Sikh religion, that Respondent "has been developing" an organization known as the North American Sikhs Demanding Answers to their Questions or "NASDAQ."

4.10 Respondent has been preparing a website to which the domain name at issue is to resolve to provide answers to the questions that North American Sikhs have been posing.

5. Parties' Contentions

5.1 Complainant contends that Respondent has registered as a domain name a mark which is identical to the mark registered and used by Complainant, that Respondent

has no rights or legitimate interests in respect of the domain name at issue, and that Respondent has registered and is using the domain name at issue in bad faith.

5.2 Respondent contends that Respondent has rights or legitimate interests in respect of the domain name at issue and that the domain name at issue was not registered in nor is it being used in bad faith.

6. Discussion and Findings

6.1 The Uniform Rules provide only for the submission of a Complaint and a Response. Uniform Rules, Rule 12, provides: "In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from wither of the Parties." The Panel made no such request of Complainant. Neither did Complainant request permission from the Panel to submit Complainant's Reply and Supplemental Comments to the Response to the Complaint. Accordingly, the Panel will not consider for any purpose the additional submission made by the Complainant. As the Panel has not considered Claimant's Reply, neither will it consider Respondent's response thereto.

6.2 Paragraph 15(a) of the Uniform Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

6.3 Since both the Complainant and Respondent are domiciled in the United States, and since United States' courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.

6.4 Paragraph 4(a) of the Policy directs that the Complainant must prove **each** of the following:

(1) that 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**,

(2) that the Respondent has no legitimate interests in respect of the domain name; **and**,

(3) that the domain name has been registered and used in bad faith.

6.5 Respondent does not dispute that <nasdaq.tv> is identical or confusingly similar to the mark in which the Complainant has rights.

6.6 Respondent contends that it has rights or legitimate interests in respect of the domain name at issue as an acronym for the organization that Respondent "has been developing, the North American Sikhs Demanding Answers to Questions.

6.7 Even assuming that Respondent had offered evidence sufficient to establish the existence of the organization claimed, while Respondent may be able to establish rights or legitimate interests in respect of the name of the organization, this does not mean that Respondent has any rights or legitimate interest in respect of the acronym. Acronyms can be readily changed. Moreover, the acronym selected by Respondent is not suggestive of the purpose of the organization, such as CARE, or of a common word, such as MADD. Rather, the acronym chosen corresponds directly to Complainant's famous mark. *Hewlett-Packard Company v. Cupcake City*, ICANN Case No. FA93562. Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name at issue.

Respondent has registered as a second level domain (SLD) name the famous and fanciful mark of another. This fact, in and of itself, does not come within any of the four examples of bad faith set out in Paragraph 4(b) of the Policy.

However, the examples given in Paragraph 4(b) are not exclusive, and it has long been established that in given factual situations, non-use and inaction can constitute bad faith registration and use. One of the earliest Panel decisions, *Telstra Corporation Limited v. Nuclear Marshmallows,* WIPO Case No. D2000-0003, established that "the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith." *Telstra*, 7.9. Perhaps the most cited of all UDRP decisions to be handed down to date, the *Telstra* decision and its rationale have been followed by numerous subsequent panel decisions. By now the rule is well established that in performing the *Telstra* analysis a Panel must "give close attention to all the circumstances of the Respondent's behaviour." [SIC]. *Id.*, ¶ 7.11. It is important to note that the focus is to be placed on the Respondent's behavior, rather than on his words.

In the present case Respondent registered the domain name with at least constructive knowledge of the existence of the famous mark. He registered the domain name not to conform to the name of the organization that Respondent has been developing, but to an acronym that is conveniently identical to Complainant's famous mark.

Given these actions (and inaction), a paraphrase of the *Telstra* decision seems especially appropriate."[T]he trademark [NASDAQ] is one of the best known trademarks in [America], and it is inconceivable that the person or persons behind the Respondent would not be aware of this fact.[B]y virtue of the wide spread use and reputation of the trademark [NASDAQ], members of the public in [America] would believe that the entity owning the domain name [<nasdaq.tv>] was the Complainant or in some way associated with the Complainant. [A]ny realistic use of the domain name must misrepresent an association with the Complainant and its goodwill, resulting in passing off, breaches of [American] consumer protection legislation, and trademark infringements." *Telstra*, ¶ 6.3. Granted, in this case, unlike *Telstra*,

Respondent made no attempt to hide his identity. However, in this case, unlike *Telstra*, Respondent created an organizational name whose acronym is identical to a mark which is recognized world wide, and then registered the acronym, rather than the organizational name as the mark.

Accordingly, the Panel finds that the domain name at issue has been registered and is being used in bad faith.

7. Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical to the mark in which the Complainant has rights, that the Respondent has no rights to or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4(i) of the Policy, the Panel requires that the registration of the domain name <nasdaq.tv> be transferred to the Complainant.

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Mr. Scott Donahey
Panelist

Dated: March 12, 2001