



NATIONAL
ARBITRATION
FORUM

COMPLAINT NOTIFICATION INSTRUCTIONS

- 1. Notification.** You are hereby notified that an administrative proceeding has been commenced against you pursuant to the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999 (the *Policy*) (<http://www.icann.org/udrp/udrp-policy-24oct99.htm>). It concerns domain names that are currently registered and being used by you. The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s). When you registered your domain name(s) you also agreed to submit to and participate in a mandatory administrative proceeding in the event that a third party (the *Complainant*) submits a Complaint to an ICANN-approved dispute resolution service provider (<http://www.icann.org/udrp/approved-providers.htm>) concerning a domain name registered and being used by you.
- 2. Date Complaint Received.** The Complaint was submitted by **Savin Corporation** and was received on **January 22, 2002** by the National Arbitration Forum (*The Forum*). A copy of the Complaint accompanies this notification.
- 3. Formal Requirements Compliance Review.** In accordance with Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*) (<http://www.icann.org/udrp/udrp-rules-24oct99.htm>) and Paragraph 4 of the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the *Supplemental Rules*) (<http://www.arb-forum.com/domains/domain-rules.html>) The Forum has verified that the Complaint satisfies the formal requirements of the Policy, Rules and Supplemental Rules. Payment in the required amount to The Forum has been made by the Complainant.
- 4. Commencement of Administrative Proceeding.** In accordance with Rules, Paragraph 4(c), the formal date of the commencement of the administrative proceeding is **January 24, 2002**.
- 5. Deadlines.** Within 20 calendar days from the commencement date, The Forum must receive, a Response and all exhibits according to the requirements that are described in The Rules, Paragraph 5 and the Supplemental Rules. You must also serve these on the Complainant. Your Response and exhibits must be received by the Forum by **February 13, 2002**. In the event the Complainant elects to have the dispute heard before a single-member Administrative Panel, and you elect to proceed with a three-member

Administrative Panel, this is also the date by which you must make the required additional payment

6. **Default.** If your Response and/or required payment is not received by the above date, you will be considered in default. We will still appoint an Administrative Panel to review the facts of the dispute and to decide the case. The Administrative Panel will not be required to consider a late-filed Response, but will have the discretion to decide whether to do so and, as provided for by Rules, Paragraph 14, may draw such inferences from your default as it considers appropriate. There are other consequences of a default, including no obligation on our part to consider any designations you have made concerning the appointment of the Administrative Panel or to observe any guidelines you have provided concerning case-related communications.

7. Administrative Panel. The dispute between you and the Complainant will be decided by an Administrative Panel consisting of either one or three impartial and independent decision makers who will be appointed by The Forum. The Complainant in this administrative proceeding has elected an Administrative Panel consisting of:
[] A single Panelist [X] Three Panelists See below:

A Single Panelist. If the Complainant has selected the single panelist option as indicated above, then the appointment of that Panelist will be made by The Forum from our published list of Panelists (<http://www.arbitration-forum.com/domains/domain-rules.html>). We will appoint the single Panelist within 5 calendar days of when your Response was received or the date your Response was due. The fees for this administrative proceeding have been paid in their entirety by the Complainant.

Despite the Complainant's election of a Single Panelist, you can still choose to have the case decided by an Administrative Panel consisting of three-persons. If you choose this option, you will be required to pay half of the applicable fees for the administrative proceeding. The payment must be made at the time you submit your Response. Failure to submit the required payment at that time may, along with other considerations, may be taken as grounds for proceeding with a single Panelist.

If you choose a three-person Administrative Panel and make the required payment when you submit your timely Response, you should indicate the names and contact details of three persons in your Response. These three persons can be selected from our published list or that of any other ICANN-accredited dispute resolution service provider <http://www.icann.org/udrp/approved-providers.htm>. We will try to appoint one of the three persons you have recommended to the Administrative Panel. If we are unsuccessful, we shall make an appropriate appointment from our published list. If you choose a three-person Administrative Panel, but do not provide us with the names and contact details of any candidates, we shall make the appointment from our published list.

Please note that if you choose a three-person Administrative Panel, the Complainant will also be requested to provide the names of three candidates who can be taken from our published list or that of any other ICANN-accredited dispute resolution service provider.

We will try to appoint one of these three persons to the Administrative Panel. If we are unsuccessful, we shall make an appropriate appointment from our published list. If the Complainant does not provide us with the names of its candidates, we shall make the appointment from our published list. Both you and the Complainant will be contacted concerning the procedures for the appointment of the Presiding Panelist (i.e., the third Panelist).

Three-Person Administrative Panel. If the Complainant has selected the three-person Administrative Panel option as indicated above, then the Complainant has provided us with the names and contact details of three candidates to serve on the three-person Administrative Panel. We will try to appoint one of these three candidates. If we are unsuccessful, we shall make the appointment from our published list of Panelists.

You are kindly requested to provide the names and contact details of three persons in your Response. These three persons can be taken from our published list or that of any other ICANN-accredited dispute resolution service provider (<http://www.icann.org/udrp/approved-providers.htm>). We will try to appoint one of the three persons you have recommended to serve on the Administrative Panel. If we are unsuccessful, we shall make an appropriate appointment from our published list. If you do not provide us with the names and contact details of any candidates, we shall make the appointment from our published list. Please note that the fees for the administrative proceeding have been paid in their entirety by the Complainant. Both you and the Complainant will be contacted concerning the procedures for the appointment of the Presiding Panelist (i.e., the third Panelist).

8. **Communications.** Your Response must be communicated to us according to the requirements of Rules, Paragraph 5(b) and Supplemental Rules, Paragraph 5 (i.e., three or five sets of hardcopy by e-mail, fax, or mail). All case-related filings or submissions to The Forum after the submission of your Response must be made according to Supplemental Rules, Paragraph 7. In your Response you must indicate where and how you would like us to send case-related communications to you. Please provide only a single postal address, fax number and e-mail address for you and, if applicable, your authorized representative for the dispute, otherwise we will use our discretion as to which contact details we will use.

All communications that are required to be made to the Complainant under the Rules and Supplemental Rules, including your Response, should be made according to the contact details and method(s) specified in the Complaint.

9. **Fees.** Payment of the required fee for a three-person Administrative Panel, an extension request or the submission of additional documents, must be submitted with your Response. Payment methods and other relevant details about fees can be found in Paragraph 6, 7 and 16 of the Supplemental Rules.
10. **The Administrative Proceeding.** If this case is to be decided by a single-member Administrative Panel, we shall appoint the Administrative Panel within 5 calendar days of

when your Response was received or the date your Response was due. If the case is to be decided by a three-person Administrative Panel, we shall send to you and to the Complainant a list of five candidates for the Presiding Panelist. You will each be offered the opportunity to strike two from that list. We shall make the appointment of the Presiding Panelist and take into consideration the preferences indicated by you and the Complainant.

The Administrative Panel will have 14 days from the date of its appointment to issue a decision in the case. Under normal circumstances, we will forward the decision to you, the Complainant, the concerned Registrar(s) and ICANN within three calendar days of receiving it from the Administrative Panel. The Registrar(s) will notify all parties concerned of the date that the decision will be implemented if the Registrar(s) does not receive notification and the required documentation from you in accordance with Paragraph 4(k) of the Policy. We will then post the decision on a publicly accessible web site, unless we have been directed not to by the Administrative Panel.

11. **Case Coordinators.** The Forum has appointed a Case Coordinator to be in charge of administering your case. Please note that, while the Case Coordinator is available to answer questions relating to such matters as filing requirements and to help you to understand the Policy, Rules and Supplemental Rules, the Coordinator cannot provide you with any legal advice or make any representations on your behalf.

Case Coordinator:	Michelle Hultman
Regular Mailing Address:	National Arbitration Forum P.O. Box 50191 Minneapolis, MN 55405 USA
Fed-Ex Mailing Address:	National Arbitration Forum 500 Rosedale Towers 1700 West Highway 36 Roseville, MN 55113 USA
Telephone:	(800) 474-2371
Fax No.:	(651) 604-6778
E-Mail Address:	mhultman@arb-forum.com

12. **Additional Information.** Additional information about the ICANN administrative procedure is available at <http://www.icann.org> and about the National Arbitration Forum at <http://www.arbitration-forum.com>.

NETWORK SOLUTIONS, INC. ("NSI") VERIFICATION RESPONSE

1. VeriSign-Network Solutions is in receipt of the Verification Request sent to us by the National Arbitration Forum

2. On behalf of VeriSign and its subsidiary registrars, VeriSign-Network Solutions confirms that the current registrant(s) of the domain name registration(s) is/are:

3. Registrant:

savinsucks.com (SAVINSUCKS-DOM)

76 Hawley Avenue

Milford, CT 06460

US

Domain Name: SAVINSUCKS.COM

Administrative Contact, Billing Contact:

Sachs, Peter (PS503) psachs@ICONN.NET

i-conn, LLC

129 Church Street Suite 508

New Haven, CT 06510-1805

(203) 821-2575

Technical Contact:

Becker, Bill (BB53) sysadmin@ICONN.NET

i-conn, LLC

205 Church Street, Suite 409

New Haven, CT 06510-1805

(203) 821-2575

4. The status of the domain name registration(s) is/are: Active.

5. The language of the Service Agreement is: English.

6. The domain name registrant has submitted in its Registration Agreement to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use of the domain name(s).

Dispute Administration/fc

Complaint Transmittal Cover Sheet

To: savinsucks.com, Respondent
From: Savin Corporation, Complainant
Cc: National Arbitration Forum
Date: January 24, 2002
Re: savinsucks.com

The attached Complaint is being filed against you with the National Arbitration Forum (the "Forum") pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999 and incorporated in your Registration Agreement with the Registrar of your domain name(s). By submitting this Complaint to the Forum, the Complainant agrees to abide and be bound by the provisions of the Policy, the ICANN Rules, and the Forum's Supplemental Rules.

Until you are notified by the Forum that a proceeding has commenced, you have no duty to act with regard to this Complaint.

- The Forum will examine the Complaint to determine whether it conforms to the ICANN Policy, Rules, and the Supplemental Rules.
- If the Complaint conforms to those standards, the Forum will forward an official copy of the Complaint to you.
- *Once the official Complaint is forwarded to you, you will have **twenty (20)** calendar days to submit a Response to both the Forum and the Complainant in accordance with the Policy, Rules, and Supplemental Rules.*
- You may seek legal assistance to represent you in this administrative proceeding.

The Policy and Rules governing this proceeding can be found at:

ICANN Policy	http://www.icann.org/udrp/udrp-policy-24oct99.htm
ICANN Rules	http://www.icann.org/udrp/udrp-rules-24oct99.htm
Forum Supplemental Rules	http://www.arb-forum.com/domains/domain-rules.html

Alternatively, you may contact the Forum to obtain any of the above documents.

Telephone: (800) 474-2371 or (651) 631-3700
E-mail: info@arb-forum.com



NATIONAL
ARBITRATION
FORUM

Savin Corporation)
333 Ludlow Street)
Stamford, CT 06902)
)
(Complainant))
)
v.)
)
savinsucks.com)
76 Hawley Avenue)
Milford, CT 06460)
)
(Respondent))
_____)

Domain Names In Dispute:
savinsucks.com

**COMPLAINT IN ACCORDANCE WITH
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

1. This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (ICANN Policy), and the Rules for Uniform Domain Name Dispute Resolution Policy (ICANN Rules), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 3(b)(i).

2. COMPLAINANT INFORMATION

- a. Name: Savin Corporation
- b. Address: 333 Ludlow Street, Stamford, CT 06902
- c. Telephone: 203-967-5000
- d. Fax: 203-967-5167
- e. E-Mail: pheinsohn@savin.com

Complainant's authorized representative

- f. Name: David A. Einhorn, Esq.
- g. Address: Anderson Kill & Olick, P.C., 1251 Ave. of the Americas
New York, NY 10020-1182
- h. Telephone: 212-278-1000
- i. Fax: 212-278-1733
- j. E-Mail: deinhorn@andersonkill.com

The Complainant's preferred method for communications directed to the Complainant in the administrative proceeding: ICANN Rule 3(b)(iii).

Electronic-Only Material

- a. Method: e-mail
- b. Address: deinhorn@andersonkill.com
- c. Contact: David A. Einhorn, Esq.

Material Including Hard Copy

- a. Method: fax
- b. Address/Fax: 212-278-1733
- c. Contact: David A. Einhorn, Esq.

The Complainant chooses to have this dispute heard before a three member administrative panel. ICANN Rule 3(b)(iv). Complainant selects as its candidates for panelist:

- Honorable Carolyn Marks Johnson
- Honorable Theodore R. Kupferman
- David H. Bernstein, Esq.

3. RESPONDENT INFORMATION

- a. Name: savinsucks.com
- b. Address: 76 Hawley Avenue, Milford, CT 06460
- c. Telephone: 203-821-2575
- d. Fax: 203-821-2574
- e. E-Mail: psachs@iconn.net

4. DISPUTED DOMAIN NAME(S)

- a. The following domain name is the subject of this Complaint:

savinsucks.com

- b. Registrar Information: ICANN Rule 3(b)(vii).

- (i.) Registrar's Name: VeriSign
- (ii.) Registrar Address: 487 East Middlefield Road
Mountain View, CA 94043
- (iii.) Telephone Number: 877-699-3243

(iv.) E-Mail Address:

c. Trademark/Service Mark Information:

1. Domestic Trademarks

SAVIN: Registration No. 2,230,303 for facsimile machines

SAVIN: Registration No. 1,500,782 for maintenance and repair services for photocopiers and word processors

SAVIN: Registration No. 1,174,900 for photocopying machines and parts thereof

SAVIN: Registration No. 836,540 for developing liquid for office copiers; photocopy machines and copy paper for photocopy machines

Certified copies of the Certificates of Registration for the above-listed marks are attached hereto as Exhibit 1.

2. Foreign Trademarks

A list of foreign registrations of the SAVIN trademarks is attached hereto as Exhibit 2.

5. **FACTUAL AND LEGAL GROUNDS**

This Complaint is based on the following factual and legal grounds:

- a. Although the formal registrant of the domain name is "savinsucks.com," based on letters Complainant has received from Peter Sachs wherein he admits registering "savinsucks.com," Complainant refers to Peter Sachs as "Respondent" in this complaint.

The domain name "savinsucks.com" is confusingly similar to Complainant's registered trademark. Savin holds four valid and subsisting federal trademark registrations for the mark SAVIN (Reg. Nos. 2,230,303; 1,174,900; 1,500,782 and 836,540) (the "Savin Marks") in the United States alone. Savin first registered its SAVIN mark in 1968. All of these trademarks are used in connection with, among other things, business machinery and parts and services used in connection therewith, including photocopier, printer and facsimile machines and parts therefor. Savin also has registered its mark SAVIN as a domain name ("savin.com") with Network Solutions, Inc. and is using that domain in connection with a Web site. Moreover, Savin has spent considerable time and money in advertising and marketing its products bearing its well-known marks. See letter from David A. Einhorn (hereinafter "D. Einhorn") to Peter Sachs (hereinafter "P. Sachs") dated December 21, 1999 attached hereto as Exhibit 3.

Two marks need not be identical to be likely to be confusing. See *General Electric Co. v. Pars Int'l Computer, Inc.*, Case No. D2000-0368 (WIPO July 25, 2000)(finding "1-800-ge.com" to be confusingly similar to GE). There is a likelihood of confusion where a complainant's mark is contained in a respondent's domain name because only "essential" or "virtual" identity is needed to establish confusing similarity under the Policy. See *Cellular One Group v. the Design Factory*, Case No. D2000-1670 (WIPO Jan. 29, 2001)(holding cellularoneltd.com confusingly

similar to CELLULARONE and CELLONE); *see also Heineken Brouwerijen B.V. v. Lott*, Case No. D2000-1487 (WIPO Jan. 30, 2001)(holding *planetheineken.com* confusingly similar to HEINEKEN).

In general, the use of a complainant's trademark in connection with a generic term does not avoid the confusing similarity created by the use of complainant's trademark. *See Trump, et al. v. Rafeli*, Claim No. FA0110000100238 (Nat. Arb Forum Nov. 6, 2001)(finding a likelihood of confusion between TRUMP and *trumpinternational.net*, *trumphouse.net*, *trumpland.net*, *trumpskys.com*, *trumppalace.com*, *trumpair.com* and *trumptown.com*); *Trump v. Graham*, Claim No. FA0110000100177 (Nat. Arb. Forum Nov. 2, 2001)(finding a likelihood of confusion between TRUMP and *trumptrade.com* and *trumpbarter.com*); *Marriott Int'l, Inc. v. Nicewarner*, Claim No. FA0109000099692 (Nat. Arb. Forum Nov. 1, 2001)(finding likelihood of confusion between MARRIOTT and *marriottcorp.com* and *marriottcorps.com*); *State Farm Mut. Auto. Ins. Co. v. All Phase Builders*, Claim No. FA0108000099608 (Nat. Arb. Forum Oct. 11, 2001)(finding likelihood of confusion between STATE FARM and *statefarm-claims.com*); *Park 'N Fly Services Corp. v. Level Propane*, Claim No. FA0109000099656 (Nat. Arb. Forum Oct. 29, 2001)(finding likelihood of confusion between PARK 'N FLY and *parknflyfree.com* and *parkandflyfree.com*).

Specifically, other UDRP panels have found that domain names that simply combine a trademark and the word "sucks", are not immune from scrutiny for likelihood of confusion. In fact, the majority of panel decisions addressing the issue of whether a domain name containing complainant's trademark next to "sucks.com" have found the subject domain name confusingly similar to the complainant's trademark. *See e.g. Cabela's Inc. v. Cupcake Patrol*, Claim No. FA 0006000095080 (Nat. Arb. Forum Aug. 29, 2000) ("Respondent's domain name is sufficiently similar to Complainant's marks that the search engine results will confusingly list the Respondent's domain name when searching for Complainant's mark"); *Wal-Mart Stores Inc. v. McLeod*, Case No. D2000-0662, (WIPO Sept 19, 2000) ("the Panel concludes that a domain name is 'identical or confusingly similar' to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name"); *Diageo PLC v. Zuccarini*, Case No. D2000-0996, (WIPO Oct. 22, 2000) ("Internet users with search engine results listing Respondent's domains are likely to be puzzled or surprised by the coupling of Complainant's mark with the pejorative verb 'sucks'"); *Direct Line Group Ltd. V. Purge I.T.*, Case No. 2000-0583. (WIPO Aug. 13, 2000) (stating that as to the similarity between DIRECT LINE and "directlinesucks.com", "[s]ome will treat the additional 'sucks' as a pejorative exclamation and therefore dissociate it after all from the Complainants; but equally others may be unable to give it any very definite meaning and will be confused about the potential association with the Complainants").

However, Respondent need not completely confuse Web users in order to damage complainant. The damage to Complainant occurs by causing Web users to go to Respondent's Web site. *See Diageo PLC v. Zuccarini*, WIPO Case No. D2000-0996, Oct. 22, 2000 *Diageo PLC v. Zuccarini*, WIPO Case No. D2000-0996, Oct. 22, 2000 ("Such users, including potential customers of Complainant, are not likely to conclude that Complainant is the sponsor of the identified websites...it is likely (given the relative ease by which websites can be entered) that such users will choose to visit the sites, if only to satisfy their curiosity. Respondent will have accomplished his objective of diverting potential customers of Complainant to his websites by the use of domain names that are similar to Complainant's trademark"). Even those users who would

understand that there is no association, might choose to visit the site, if only to satisfy their curiosity. This effect would damage Complainant, to the extent Respondent would intentionally disrupt Complainant's business.

Courts and other UDRP Panels have recognized that the intentional registration of a domain name in which the second-level domain contains another's valuable trademark weighs in favor of a likelihood of confusion. *See Minnesota Min. and Mfg. Co. v. Taylor*, 21 F.Supp.2d 1003, 1005 (D.Minn. 1998); *Intermatic Inc. v. Toeppen*, 947 F.Supp. 1227, 1235-1236 (N.D.Ill. 1996); *Cabela's Inc. v. Cupcake Patrol*, Claim No. FA 0006000095080 (Nat. Arb. Forum Aug. 29, 2000).

Respondent has stated that consumers cannot be confused between "savin.com" and "savinsucks.com", since consumers looking for SAVIN will not type "savinsucks.com" in their Web server. *See* letter from P. Sachs to D. Einhorn dated April 8, 2000, attached hereto as Exhibit 4. Based on the above decisions, Respondent's argument must be disregarded.

Respondent's domain name contains Complainant's exact mark SAVIN. Respondent uses Complainant's SAVIN mark with a generic term, sucks, which does not indicate the use to which Complainant's domain name has been, is or will be put. The registration and use of savinsucks.com is likely to cause confusion among consumers familiar with the Savin Marks.

At this time, Respondent only "uses" the domain name "savinsucks.com" passively. Other than passive use, the only use Respondent could make of the domain name would be as a host name. Complainant intended to avoid any dispute if Respondent agreed not to use the domain name as a host name for a Web site at any time in the future, *see* letter from D. Einhorn to P. Sachs dated April 27, 2000 attached hereto as Exhibit 5, however, Respondent refused to do so. *See* letter from P. Sachs to D. Einhorn dated April 28, 2000 attached hereto as Exhibit 6. Any such use of savinsucks.com would likely cause confusion among the Web users. Web users would be drawn to the Web site, which would appear whenever a consumer typed in the search name Savin while looking for Complainant's products on the Internet. Those consumers would be puzzled by the association of Complainant with the site.

Respondent does not conceal the fact that he has specifically appropriated Complainant's mark for his domain name registration savinsucks.com. *See* Exhibit 4. Therefore, based on Respondent's own admissions and statements the domain name does create, as it is intended to, confusion with Complainant's SAVIN marks.

b. Registering a domain name with knowledge that it contains or is confusingly similar to another's trademark is a factor evidencing lack of a bona fide use. *See McNeil Consumer Brands, Inc. v. Meriweb Solutions*, Case No. D2000-0612 (WIPO Aug. 3, 2000)(listing factors to be evaluated in determining bad faith and stating that registrant's knowing use of a domain name similar to complainant's trademark evidences bad faith rather than bona fide use).

(i.) Merely using a domain name containing complainant's mark in competition with Complainant does not establish a bona fide commercial use. *See Backstage Fashion, Inc. v. Back Stage, Inc.*, Claim No. FA0109000100135 (Nat. Arb. Forum Nov. 5, 2001)("[u]sing a domain name identical to Complainant's service mark with the result of diverting potential customers from Complainant to Respondent is not a bona fide offering of goods"); *Park 'N Fly Services Corp. v. Level Propane*, Claim No. FA0109000099656 (Nat. Arb. Forum Oct. 29,

2001)(holding that use of domain names confusingly similar to complainant's mark to attract users to respondent's Web site is not a bona fide use).

Outside of Respondent's registration of the domain name savinsucks.com, Respondent has never used the term or mark SAVIN or SAVINSUCKS. Respondent holds no trademark registration and has claimed no common law trademark rights to the term SAVINSUCKS or the terms SAVIN SUCKS. See Exhibit 4. Other than its registration of the domain name savinsucks.com, Respondent has never used nor made any claim to the term SAVINSUCKS or the terms SAVIN SUCKS as a mark or indicator of Respondent's business. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶ 4(a)(ii).

(ii.) Respondent has not used the domain name in connection with a business. Respondent refuses to withdraw the domain name, despite the fact that the domain name contains Complainant's registered trademark. Respondent's refusal to "enter into any agreement regarding any possible use of the domain name", see Exhibit 6, strongly suggests that Respondent will be using the domain name savinsucks.com as a host name, and such usage would in fact harm Complainant.

"Free speech", does not grant a registrant the right to use a domain name that is confusingly similar to complainant's trademark. Specifically, in cases where a Web site was operated under the domain name, panels distinguished "between the domain name itself and the contents of the site which is reached through the domain name". See *Estee Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, Case No. D2000-0869 (WIPO Sept. 25, 2000). Although a right to free speech was found "to provide a platform to criticize Complainant," see *id.*, and "the contents of Respondent's websites may also be a perfectly legitimate use of those rights", the panel found that "Respondent could well have chosen to use a domain name that was not confusingly similar to Complainant's and/or in which Complainant had no rights." "Respondent's free expression rights do not here give it a right or legitimate interest in the domain name at issue." See *id.* Respondent never claimed any bona fide use in the domain name. Respondent only has made a nonspecific assertion of First Amendment Right, and a general "right to opine", see Exhibit 4.

(iii.) Using a domain name containing Complainant's mark to divert customers away from Complainant does not establish a bona fide fair use. See *Backstage Fashion, Inc. v. Back Stage, Inc.*, Claim No. FA0109000100135 (Nat. Arb. Forum Nov. 5, 2001)(finding no fair use where respondent's site used complainant's mark to attract customers and, thus, divert them away from complainant). As stated above, Respondent has stated his intention to attract Web users' attention to his domain name via the consumer recognition of the SAVIN mark.

- c. The circumstances listed under § 4(b) are a non-exclusive list of examples of circumstances evidencing bad faith. See *Fabricas Agrupadas de Munecas de Onil S.A. (FAMOSAS) v. Gord Palameta*, Case No. D2000-1689 (WIPO March 14, 2001)("The examples of bad faith set forth in [section 4(b) of] the Policy have at least one element in common: All of them effectively require that the respondent, at the time the domain name was registered, harbored an intent that related in some manner to the complainant or its trademark. This intent may, of course, be inferred from the respondent's subsequent conduct or other surrounding circumstances, but it must have existed when the domain name was registered in order for that registration to have occurred in bad faith"); *Koninklijke Phillips Electronics v. Kurapa C. Kang*, Case No. D2000-

0163 (WIPO March 27, 2001) (stating that “circumstances of bad faith are not limited to those listed under paragraph 4(b) of the policy”).

Failure to make any bona fide use of a registered domain name, that contains another’s trademark, is evidence of bad faith registration and use of that domain name. See *McNeil Consumer Brands*, Case No. D2000-0612 (WIPO Aug. 3, 2000)(listing failure to use domain name as factor evidencing bad faith).

Passive holding of a domain name has been held to be evidence of bad faith registration and bad faith use of that domain name. See *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0265 (WIPO Feb. 18, 2000)(stating the concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within the concept and holding that bad faith was shown by passive holding of a domain name); see also *Trump v. Rafaeli*, Claim No. FA0110000100238 (Nat. Arb. Forum Nov. 6, 2001)(stating that registration and passive holding support finding of bad faith); *Mariott Int’l, Inc. v. Nicewarner*, Claim No. FA0109000099692 (Nat. Arb. Forum Nov. 1, 2001)(holding that failure to use a domain name with “a Website or in any other way” is bad faith use); *Cabela's Inc. v. Cupcake Patrol*, Claim No. FA000600009508 (Nat. Arb. Forum Aug. 29, 2000)(finding passive holding of cabelassucks.com to constitute bad faith); *Solomon R. Guggenheim Found. v. Zuzazu*, Claim No. FA0008000095319 (Nat. Arb. Forum Oct. 5, 2000); *Marubeni Corp. v. Eagle Data Ltd.*, Claim No. FA0008000095418 (Nat. Arb. Forum Oct. 2, 2000).

Respondent currently is making no Web or Internet based use of the domain name savinsucks.com and has stated that he intends to use it to harass Complainant. See Exhibit 4. Such passive use of the domain name is evidence of Respondent’s bad faith.

Other than passive use, the only use Respondent could make of the domain name would be as a host name. When Complainant attempted to negotiate a settlement of the matter, Respondent refused to “enter into any agreement regarding any possible use of the domain name”. See Exhibit 6. Complainant is left to assume that Respondent intends to use his domain name as a host name.

Respondent is perfectly aware of the fact that using the domain name as a host name would divert consumers from Complainant, to Respondent’s Web site. As stated above, the majority of panel decisions addressing the issue of whether a domain name containing complainant’s trademark next to “sucks.com,” have found, against Respondent’s opinion, that the subject domain name was confusingly similar to the complainant’s trademark.

Respondent has stated his intent to express his negative opinion about Complainant “whether it be through verbal, written or electronic means.” See Exhibit 4. Respondent’s purpose in using the domain name, passively or otherwise, is to attract would be Savin consumers. By attracting consumers away from Complainant, Respondent intentionally damages Complainant’s business. Such use by Respondent does not constitute a legitimate or bona fide use of the domain name. Respondent has no right to use Complainant’s mark in order to attract Web users even if his intentions are to criticize. By diverting consumers away from Complainant into Respondent’s Web site, Complainant would, through Respondent’s bad faith use of the domain name, be damaged.

(i.) On December 21, 1999, March 23, 2000 and April 27, 2000 respectively, in an attempt to settle this dispute and to alleviate the confusion caused by Respondent's registration of the domain name savinsucks.com, Complainant wrote three letters to Respondent. Complainant intended to avoid any dispute if Respondent simply withdrew the domain name savinsucks.com, or if Respondent agreed not to use the domain name as a host name for a Web site at any time in the future. See Exhibit 5.

Respondent has refused to withdraw the domain name. Respondent believes he can use the domain name registration system as a tool for harassing Complainant, by manipulating Complainant's own trademark. See Exhibits 3 and 4. His continued holding of the domain name is his way of harming Complainant, as stated by him. See Exhibit 4.

(ii.) Respondent has not used the domain name savinsucks.com for any legitimate business purpose and has never made a legitimate non-commercial use of that domain name. See Exhibit 4. It appears, based on Respondent's actions, that Respondent is now merely using the domain name savinsucks.com in order to harass Complainant, tarnish the Savin Marks and harm Complainant's business. Thus, it is clear that Respondent's actions constitute bad faith use of that domain name under the UDRP § 4(b).

(iii.) Respondent's only purpose in registering the domain name savinsucks.com was to harass Complainant and to harm Complainant's business. Other than his passive use, the only use Respondent could make of the domain name would be to use it as a host name. Respondent refused to agree not to use the domain name savinsucks.com as a host name in the future. Usage of the domain name as a host name would cause consumers to be drawn away from Complainant's Web site to another Web site, which would damage Complainant.

First, such use by Respondent would cause Complainant money damages. Complainant's Web site contains information about all of Complainant's goods and services, and includes also a list of all of Complainant's dealers to make it easy for the consumers to find a dealer near them to purchase Complainant's goods. Also, since Complainant's Web site contains substantial promotion and advertisement material, it is apparent that Complainant's Web site, at savin.com, is an essential tool for Complainant's trade. Any active use by Respondent would cost Complainant sales and the real dollar value of those sales and created a likelihood of confusion with Complainant's SAVIN MARKS. Each diversion of consumers by Respondent, and a loss of clientele due to such diversion, would cause Complainant substantial damages.

Second, Respondent's use of the domain name is disrupting to Complainant in that Complainant, having a duty to protect its trademarks under U.S. Trademark Law, see *Electro-Coatings, Inc. v. Precision Nat'l Corp.*, 204 U.S.P.Q. 410, 421 (TTAB 1979), has been forced to bring this proceeding against Respondent in order to enforce its trademark right in the Savin Marks and protect itself from infringement and consumers from confusion.

(iv.) Registering and using a domain name that is known to contain another's trademark evidences bad faith registration of that mark. See *Umbers & Toltec Scenic Railroad Commission v. Ravin*, Claim No. FA0108000099599 (Nat. Arb. Forum Oct. 30, 2001)(holding respondents' knowledge of complainant's mark to evidence registrants' bad faith use of the mark for a domain name offering railroad services); see also *Trump v. Graham*, Claim No. FA0110000100177 (Nat. Arb. Forum No. 2, 2001)(holding respondent's likely knowledge of the TRUMP mark to

evidence bad faith). Respondent, is undoubtedly aware of the goodwill and reputation of the SAVIN MARKS. Respondent nonetheless registered the domain name savinsucks.com, incorporating Complainant's registered and well-known trademark. Any possible use by Respondent will harass Complainant and harm Complainant's business, using its own marks for that purpose.

Respondent has intentionally caused confusion with the SAVIN MARKS and continues to intentionally use the domain name in bad faith. Respondent, with the intent to harass Complainant and harm Complainant's business, registered a domain name that incorporates the Savin Marks next to a generic term, "sucks."

In his reply to the cease and desist letters sent to Respondent on December 21, 1999 and March 23,2000, Respondent has expressed his general intent to harass Complainant and to tarnish Complainant's trademark. See Exhibit 4 ("..does Savin suck? ... That is my opinion and I may express it in any legal way I see fit, whether it be through verbal, written or electronic means").

Further evidencing Respondent's bad faith, he has registered the domain name "andersonkillsucks.com" after corresponding with Complainant's counsel regarding "savinsucks.com". Anderson Kill & Olick is the firm serving as Complainant's counsel and andersonkill.com is the domain name used by the firm. By that, Respondent has clearly showed his intent to harass Complainant, and registration of "andersonkillsucks.com" was made to "prove" to Complainant that Respondent does not believe he can be stopped from manipulating business names with the sole purpose of harassment. See Exhibit 6 ("I have just registered the domain name andersonkillsucks.com").

Respondent is aware of the fact that Anderson Kill & Olick is a famous mark. Respondent is a former attorney with Anderson Kill & Olick and is therefore aware of the long use that the firm has made of this name to identify its legal services. Before registering andersonkillsucks.com, Respondent undoubtedly visited andersonkill.com, which Anderson Kill & Olick is using as its host name for a Web site that promotes its legal services. As is evidenced in the Web site, Anderson Kill & Olick is a very established firm, with branches in many locations in the U.S., and enjoys a good reputation. Further, at the time Respondent was an attorney employed by Anderson Kill & Olick, Complainant was a client of the firm. Thus, Respondent's malicious intent in registering both savinsucks.com and andersonkillsucks.com is clear.*

Such pattern of conduct has been viewed by other UDRP panels as an additional evidence of bad faith. See *Sony Kabushiki Kaisha v. Inja, Kil*, Case No. D2000-1409 (WIPO Dec. 9, 2000) (viewing the registration of other domain names incorporating well known marks as a pattern of conduct indicating bad faith); *Koninklijke Phillips Electronics v. Kurapa C. Kang*, Case No. D2000-0163 (WIPO March 27, 2001).

This registration, together with Respondent's stated intentions to tarnish the Savin Marks and disrupt the business of Complainant is evidence of Respondent's bad faith in registering and using the domain name savinsucks.com. ICANN Policy 4(a)(iii).

* Respondent has apparently allowed the registration of andersonkillsucks.com to lapse. This fact does not, however, rescind his expressly stated bad faith intent in registering that domain name.

6. REMEDY SOUGHT

The Complainant requests that the Panel issue a decision that the domain-name registration be transferred to Complainant. ICANN Rule 3(b)(x); ICANN Policy ¶ 4(i).

7. OTHER LEGAL PROCEEDINGS

Complainant is not aware of any other proceedings commenced in connection with the domain name savinsucks.com. ICANN Rule 3(b)(xi).

8. COMPLAINT TRANSMISSION

The Complainant asserts that a copy of this Complaint, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent Peter Sachs, at the address listed above for Respondent, in accordance with ICANN Rule 2(b). ICANN Rule 3(b)(xii); NAF Supp. Rule 4(c).

9. MUTUAL JURISDICTION

The Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction in the State of Connecticut where the Respondent is located. ICANN Rule 3(b)(xiii).

10. CERTIFICATION

Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the National Arbitration Forum and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,

By: David A. Einhorn, Esq.
Daniel J. Healy, Esq.

Anderson Kill & Olick, P.C.
1251 Avenue of the Americas
New York, New York 10020
Attorneys for Complainant

Dated: _____



Uniform Domain Name Dispute Resolution Policy

Policy Adopted: August 26, 1999
Implementation Documents Approved: October 24, 1999

Notes:

1. This policy is now in effect. See www.icann.org/udrp/udrp-schedule.htm for the implementation schedule.
2. This policy has been adopted by all accredited domain-name registrars for domain names ending in .com, .net, and .org. It has also been adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).
3. The policy is between the registrar (or other registration authority in the case of a country-code top-level domain) and its customer (the domain-name holder or registrant). **Thus, the policy uses "we" and "our" to refer to the registrar and it uses "you" and "your" to refer to the domain-name holder.**

Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

1. Purpose. This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under [Paragraph 4](#) of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and the selected administrative-dispute-resolution service provider's supplemental rules.

2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement

are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. Cancellations, Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- a. subject to the provisions of [Paragraph 8](#), our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See [Paragraph 4\(i\)](#) and [\(k\)](#) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of

[Paragraph 4\(a\)\(iii\)](#), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) 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; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) 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.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to [Paragraph 5](#) of the Rules of Procedure in determining how your response should be prepared. 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that

Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in [Paragraph 4\(f\)](#).

e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

f. Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

g. Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in [Paragraph 5\(b\)\(iv\)](#) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

h. Our Involvement in Administrative Proceedings. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

i. Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

j. Notification and Publication. The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

k. Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in [Paragraph 4](#) shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from

you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under [Paragraph 3\(b\)\(xiii\)](#) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See [Paragraphs 1](#) and [3\(b\)\(xiii\)](#) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

5. All Other Disputes and Litigation. All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of [Paragraph 4](#) shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. Our Involvement in Disputes. We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. Maintaining the Status Quo. We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in [Paragraph 3](#) above.

8. Transfers During a Dispute.

a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days

(as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. Policy Modifications. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

Comments concerning the layout, construction and functionality of this site should be sent to webmaster@icann.org.

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