



NATIONAL
ARBITRATION
FORUM

NATIONAL ARBITRATION FORUM

DECISION

IntelliTrack Inc. v manager, admin
Claim Number: FA0411000362178

PARTIES

Complainant is **IntelliTrack Inc.** (“Complainant”), represented by **Michael D Oliver**, of **Bowie & Jensen LLC**, 29 W. Susquehanna Ave., Suite 600, Towson, MD 21204.
Respondent is **manager, admin** (“Respondent”), P.O. Box 906, El Segundo, CA 90245-0906.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<intellitrack.com>**, registered with **Network Solutions**.

PANEL

The undersigned certifies that she has acted independently and impartially and to the best of her knowledge has no known conflict in serving as Panelist in this proceeding.

Linda M. Byrne as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 9, 2004; the National Arbitration Forum received a hard copy of the Complaint on November 12, 2004.

On November 12, 2004, Network Solutions confirmed by e-mail to the National Arbitration Forum that the domain name **<intellitrack.com>** is registered with Network Solutions and that the Respondent is the current registrant of the name. Network Solutions has verified that Respondent is bound by the Network Solutions registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On November 16, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of

December 6, 2004, by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax. The Commencement Notification was transmitted to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@intellitrack.com by e-mail.

A Response was received on December 7, 2004; and exhibits for the Response were received on December 9, 2004.

On December 15, 2004, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Linda M. Byrne as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant contends that Respondent's <intellitrack.com> domain name is confusingly similar to its INTELLITRACK trademark; that Respondent does not have any rights or legitimate interest with respect to the domain name; and that the infringing domain name was registered and being used by Respondent in bad faith.

B. Respondent

Rule 5(a) of the Uniform Domain Name Dispute Resolution Policy requires a response to be submitted within 20 days of the date of commencement of the proceeding. The Response was received on the day after the deadline for response. In this type of situation, the Panel is under no obligation to accept the late Response. *See Telstra Corp. v. Chu*, D2000-0423 (WIPO June 21, 2000) (finding that any weight to be given to the lateness of the Response is solely in the discretion of the Panelist); *but see Univ. of Alberta v. Katz*, D2000-0378 (WIPO June 22, 2000) (finding that a Panel may consider a response which was one day late, and received before a Panelist was appointed and any consideration made). Because Respondent e-mailed its Response only a few hours into the 21st day, the Panel has chosen in its discretion to consider the late Response.

Furthermore, Respondent submitted additional appendices three days after the formal deadline set forth pursuant to ICANN Rule 5(a). It is within the Panel's discretion whether or not to consider Respondent's late appendices in deciding this case. The Panel has determined that Respondent's exhibits were not filed on a timely basis, and the Panel has therefore not considered Respondent's exhibits.

In its Response, Respondent does not dispute that <intellitrack.com> is confusingly similar to Complainant's INTELLITRACK mark. Respondent contends, however, that it registered the <intellitrack.com> domain name in connection with a *bona fide* business, and that Respondent did not register and use the domain name in bad faith.

C. Additional Submissions

A timely Additional Submission was received from Complainant on December 13, 2004. This Additional Submission was considered by the Panel.

The panel received Respondent's Supplemental Response on December 20, 2004. With respect to Respondent's request to strike Complainant's Supplemental Submission, this request is denied as the Supplemental Submission was timely. With respect to Respondent's opposition to Complainant's Request to strike Respondent's Response, this issue is moot as the Respondent's Response was considered. The remainder of the Respondent's Supplemental Response is found to be unpersuasive in view of the below Findings and Discussion.

FINDINGS

The Complainant owns a U.S. trademark registration for INTELLITRACK (U.S. Reg. No. 1,938,760). This registration covers a "bar code data collection system, namely bar code computer hardware and software with instruction manuals for collecting and managing data." The date of first use is October 1989. Complainant has expended over \$600,000 in marketing and other costs to promote the INTELLITRACK brand, has licensed over 12,000 copies of its INTELLITRACK software, and distributes the software throughout the world.

When an Internet user accesses the <**intellitrack.com**> domain name, the screen features the headline "intellitrack.com What you need, when you need it." The screen features a list of links to third party websites, such as HDTV programming, refinancing services, long distance learning services, etc. The left side of the screen shows the word "Intellitrack" under the headings "Popular Links" and "Related Links."

The <**intellitrack.com**> domain name had been owned by a third party who failed to renew the domain name. The registrar placed the domain name for sale in a public auction, and Respondent secured the domain name with the highest bid on or about November 10, 2004.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "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."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Respondent does not argue that there is no confusing similarity between Complainant's INTELLITRACK mark, as compared to the <intellitrack.com> domain name, but Respondent argues that its business is distinct from Complainant's business.

Complainant's INTELLITRACK mark is the subject of a U.S. trademark registration and is therefore presumed to be valid. *See Men's Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning."); *see also Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (finding that Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive, such that Respondent has the burden of refuting this presumption).

The domain name incorporates Complainant's mark in its entirety. The mere addition of a generic top-level identifier is insufficient to distinguish the domain name from Complainant's mark. *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

This panel concludes that the domain name <intellitrack.com> is confusingly similar to Complainant's INTELLITRACK mark.

Rights or Legitimate Interests

Since it securing the disputed domain name on or around November 10, 2004, Respondent states that it has used the <intellitrack.com> domain name in connection with "its people search and location business site." The Respondent states that its use of <intellitrack.com> is consistent with the Respondent's other websites located at the <www.intelisearch.com>, <www.intelifind.com> and <www.inteliseek.com> domain names.

However, the domain name appears to direct users to other unconnected commercial websites, which does not constitute a legitimate business for purposes of this proceeding. *AltaVista v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000). Respondent's website links to non-competing web pages where third parties offer a variety of products and services such as mortgage services. It appears that Respondent is charging a fee for providing links to these commercial sites of third parties. In *UGG Holdings, Inc. v. WebQuest.com, Inc.*, FA 335456 (Nat. Arb. Forum Dec. 8, 2004), the Panel stated:

Commercial use of domain names that are confusingly similar to another's mark does not constitute a bona fide offering of goods or services pursuant to Policy 4c(i) or a legitimate noncommercial or fair use pursuant to Policy 4c(iii). See *Black & Decker Corp. v. Clinical Evaluations*, FA 112629 (Nat. Arb. Forum June 24, 2002) holding that Respondent's use of the disputed domain name to redirect Internet users to commercial websites, unrelated to Complainant and presumably with the purpose of earning a commission or pay-per-click referral fee did not evidence rights or legitimate interests in the domain name.

Moreover, the Respondent is not commonly known by the domain name, and the Respondent lacks rights and legitimate interests in the domain name pursuant to Policy ¶4(c)(ii). See *Tercent Inc. v. Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating "nothing in Respondent's WHOIS information implies that Respondent is 'commonly known by' the disputed domain name" as one factor in determining that Policy ¶ 4(c)(ii) does not apply); see also *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) Respondent is not a licensee of Complainant; (2) Complainant's prior rights in the mark precede Respondent's registration; (3) Respondent is not commonly known by the domain name in question).

Registration and Use in Bad Faith

Respondent registered and used the <intellitrack.com> domain name in bad faith pursuant to Policy ¶ 4(a)(iii) because Respondent had actual or constructive knowledge of Complainant's mark when the domain name was registered. Registration of a domain name confusingly similar to another's mark, despite knowledge of the mark holder's rights, is evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii). See *Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) ("there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively"); see also *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration).

Respondent's bad faith is further evidenced by the fraudulent nature of the original WHOIS record, which contains erroneous telephone, ownership and physical address information. It contains no human or entity information as the registrant, it lists the phone number as a zip code, and the PO is owned by a company known as "BMC<" which is unrelated to this proceeding. This false contact information obscures the Respondent's activities and evidences bad faith. See *Mattel, Inc. v. KPF, Inc.*, FA 244073 (Nat. Arb. Forum Apr. 2, 2004).

Complainant asserts that Respondent has appropriated Complainant's mark in the <intellitrack.com> domain name to compete with Complainant. The Panel does not

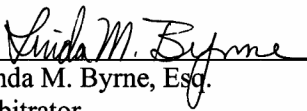
render an opinion on this issue because it is unnecessary to do so in reaching a decision in this case.

The Panel concludes that Respondent's commercial use of the confusingly similar domain name constitutes bad faith registration and use under Policy ¶ 4(b)(iv). *See State Fair of Texas v. Granbury.com*, FA 95288 (Nat. Arb. Forum Sept. 12, 2000) (finding bad faith where Respondent registered the domain name <bigtex.net> to infringe on Complainant's goodwill and attract Internet users to Respondent's website); *see also G.D. Searle & Co. v. Celebrix Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that Respondent registered and used the domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because Respondent was using the confusingly similar domain name to attract Internet users to its commercial website).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**intellitrack.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Linda M. Byrne, Esq.
Arbitrator

Linda M. Byrne, Panelist
Dated: December 28, 2004

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