



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

WalMart Stores, Inc. v. Anthony Hardy

Case No. D20070255

1. The Parties

The Complainant is WalMart Stores, Inc. of Bentonville, Arkansas, United States of America, represented by Haynes and Boone, LLP United States of America.

The Respondent is Anthony Hardy, of Largo, Maryland, United States of America; Admin, Domain of Menlo Park, California, United States of America.

2. The Domain Names and Registrar

The disputed domain names <walmarttoy.com> and <walmarttoy.com> are registered with Tucows.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 20, 2007. On February 23, 2007, the Center transmitted by email to Tucows a request for registrar verification in connection with the domain names at issue. On February 23, 2007, Tucows transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative and technical contact.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 2, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was March 22, 2007. The Respondent did not submit any response. Accordingly, the Center notified the Respondent of its default on March 22, 2007.

The Center appointed Justin Hughes as the sole panelist in this matter on April 13, 2007. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Because the Respondent has defaulted in these proceedings, the Panel accepts the assertions in the Complaint as true, at least as to factual matters necessary to resolution of the dispute. Those matters are discussed individually under 6.AC below.

5. Parties' Contentions

A. Complainant

The Complainant's contentions, as they bear on resolution of this dispute, are discussed individually under 6.AC below.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To prevail in a UDRP action, Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following:

- (i) The domain name in issue is identical or confusingly similar to the Website in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

The Complainant has properly made its case under each requirement.

A. Identical or Confusingly Similar

The Complainant has a variety of registered trademarks in the United States of America for WALMART (Complaint ¶ 14 and Annex 5); through the WALMART family of trademarks it carries out one of, if not the, world's largest retail operations. The Complaint (Complaint ¶ 15) avers and the Panel has independently established that as part of these retail activities the Complainant sells toys. (The "www.walmart.com" homepage features "toys" as one of the primary choices.)

In this context, there is no question that the disputed domain names <walmarttoy.com> and <walmarttoy.com> are confusingly similar to the Complainant's WALMART trademark.

This Panel does not, however, endorse the blanket statements cited by the Complainant that "the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar" (Complaint ¶ 35, citing *WalMart Stores, inc. v. Milchen*, WIPO Case No. D20050130 [April 10, 2005]) or that "a domain name is 'identical or confusingly similar' to a trademark for purposes of the Policy when a domain name includes the trademark . . . regardless of the other terms in the domain name". (Complaint ¶33, citing *WalMart Store, Inc. v. Maclead d/b/a For Sale*, WIPO Case No. D20000662 [September 19, 2000]).

Incorporation of the entirety of a trademark in a domain name does not *per se* establish confusing similarity, particularly where the trademark may have descriptive uses. See *Yellow Corporation v. MIC*, WIPO Case No. D20030748 (December 6, 2003) (domain name <yellowroadway.com> which combined YELLOW trademark with competitor's ROADWAY trademark was confusingly similar to trademark, but "yellowsubmarine", "yellowalert", or "yellowdog", would not be). If the "other terms" incorporated into a domain name signal harsh criticism or opposition to the trademark holder, this too could defeat confusing similarity in a domain name which contains the entirety of the trademark. *America Online, Inc. v. Johuathan Investments, Inc., and AOLNEWS.COM*, WIPO Case No. D20010918 (September 14, 2001) (domain name <fucknetscape.com> not confusingly similar to NETSCAPE trademark); *Lockheed Martin Corporation v. Dan Parisi*, WIPO Case No. D20001015 (January 26, 2001) (domain name <lockheedmartinsucks.com> not confusingly similar to trademark). See also *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D.Cal. 1998).

But the Domain Names here combine the Complainant's widely known trademark with the name of a class of products for which the Complaint is known, immediately creating the impression for consumers that the domain name belongs to the Complainant.

In short, when a domain name is registered which is a widely known trademark in combination with another word(s), the nature of the other word(s) will largely determine the confusing similarity. Here, the other word ("toy") points toward, not away from, the services offered by WalMart.

Therefore, the Panel finds that confusing similarity is established on that basis.

B. Rights or Legitimate Interests

The Panel is satisfied that the Respondent has no rights or legitimate interests in respect of the Domain Name. The consensus view of WIPO panelists concerning the burden of

establishing no rights or legitimate interests in respect of the domain name is as follows:

“While the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore a complainant is required to make out an initial *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.”

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Section 2.1.

In the present case, the Complainant has alleged that the Respondent has no rights or legitimate interests in the domain name at issue in that the Respondent is not engaged in the *bona fide* offering of goods or services (Complaint ¶¶ 3944), that the Complainant has not consented to the use of the WALMART trademarks (Complaint ¶¶ 4143), and that the Respondent is not commonly known by the name “walmart” (Complaint ¶ 44). The Complainant alleges that the Respondent is a participant in WalMart’s “affiliate program” (Complaint ¶ 19), the agreement of which provides that the Respondent agreed not to engage in any:

“use of the name Walmart, or any variation thereof, in any manner not expressly authorized by this Agreement. In particular, you may NOT use Walmart.com’s name or any variation thereof, in metatags, hidden text or source code, in your domain name or any other part of your URL” (Annex 9)

No party would accept such an agreement to participate in WalMart’s affiliate program if that party believed that it independently had rights or legitimate interests in the WALMART name. Taken as a whole, this establishes a *prima facie* case and shifts the burden to Respondent to demonstrate rights or legitimate interests in the domain name. This Respondent has failed to do.

Therefore, the Panel finds the second element established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a set of circumstances that evince bad faith in the registration and use of domain names; these “circumstances” are described “in particular but without limitation”. Paragraph 4(b)(iv) of the Policy provides that bad faith is shown where:

“by using the domain name, you [the Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation,

or endorsement of your website or location or of a product or service on your website or location.”

The Panel finds that bad faith is established in this dispute on this ground. Annex 15 of the Complaint demonstrates that the Respondent used the domain names in question to resolve to web page(s) that provided links to competitors of the Complainant in the retail toy market.

This clearly constitutes use of the domain names in contravention of paragraph 4(b)(iv) of the Policy. For example, in *Société Air France v. Alvaro Collazo*, WIPO Case No. D20030417 (July 22, 2003) the Respondent’s website at a confusingly similar domain name “contain[ed] a number of hyperlinks to websites offering *inter alia* travel services”. The panel concluded that such links “clearly show[ed] that the domain name is used to attract for commercial gain Internet users to other online locations by creating a likelihood of confusion with the trademark AIR FRANCE”. Generally speaking, use of a confusingly similar domain name to offer directly competing commercial products or services constitutes bad faith. See also *Wachovia Corporation v. American Consumers First*, WIPO Case No. D20040150 (June 10, 2004) (bad faith found where domain names that were variations on WACHOVIA trademarks resolved to website with hyperlinks to nonWachovia financial services); *Curtis Jackson v. WhoisGuard*, WIPO Case No. D20060070 (March 21, 2006) (bad faith found where domain name resolved to commercial “fan site” selling competing, unauthorized products).

In addition, the Respondent has previously registered domain names associated with wellknown trademarks in the retail industry in which the Respondent has or had no legitimate interests. *Target Brands, Inc. v. N/A c/o Anthony Hardy*, National Arbitration Forum Claim Number: FA0506000505367 (August 2, 2005) (domain name <targetoutlet.net>). This also suggests bad faith under the criteria established in paragraph 4(b) of the Policy.

For these reasons, the Panel finds that the third element is established.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names <walmarttoy.com> and <walmarttoy.com> be transferred to the Complainant.

Justin Hughes
Sole Panelist

Dated: April 27, 2007