PARTIES
Complainant is Morris Publishing Group, LLC (“Complainant”), represented by Timothy E. Moses, 801 Broad Street, Suite 700, Augusta, GA 30901. Respondent is SK*RT and Gabby Blair (“Respondent”), represented by Enrico Schaefer, of Traverse Legal, PLC, 810 Cottageview Drive, Unit G-20, Traverse City, MI 49684.

REGISTRAR AND DISPUTED DOMAIN NAME
The domain name at issue is <sk-rt.com>, registered with Fastdomain, Inc.

PANEL
The undersigned, Daniel B. Banks, Jr., as panelist, certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

PROCEDURAL HISTORY
Complainant submitted a Complaint to the National Arbitration Forum electronically on November 16, 2007; the National Arbitration Forum received a hard copy of the Complaint on November 19, 2007.

On November 30, 2007, Fastdomain, Inc. confirmed by e-mail to the National Arbitration Forum that the <sk-rt.com> domain name is registered with Fastdomain, Inc. and that the Respondent is the current registrant of the name. Fastdomain, Inc. has verified that Respondent is bound by the Fastdomain, Inc. 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 December 14, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 3, 2008 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@sk-rt.com by e-mail.

On December 28, 2007, Respondent filed a “Request for Extension of Time to Respond to Complaint with Complainant’s Consent.” On January 2, 2008, Respondent’s Request was granted, and the new deadline by which Respondent could file a Response to the Complaint was set as January 17, 2008.

A timely Response was received and determined to be complete on January 17, 2008.

On January 24, 2008, pursuant to Complainant’s request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Daniel B. Banks, Jr., as Panelist.

RELIEF SOUGHT
Complainant requests that the domain name be transferred from Respondent to Complainant.
PARTIES’ CONTENTIONS
A. Complainant
The disputed domain name was registered by one or both Respondents on February 2, 2007. It is pronounced “skirt-dot-com”. The Complainant owns the trademarks SKIRT and SKIRT! which are registered with the United States Patent and Trademark Office. Copies of trademark information reports attached as Complainant’s Exhibits 2 & 3.

Respondents’ domain name, <sk-rt.com>, is virtually identical to Complainant’s registered trademarks. Additionally, Respondents’ own use and pronunciation of the domain, <sk-rt.com>, is identical to Complainant’s registered trademarks.

Complainant has published a monthly newspaper devoted to woman and women’s issues since April, 1994. This publication, skirt!, started in Charleston, South Carolina and is now distributed in Boston, MA, Knoxville TN, Memphis, TN, Atlanta, GA, Savannah, GA, Richmond, VA, Charlotte, NC, Columbia, SC, Charleston, SC, Jacksonville, FL, and Houston, TX. Complainant is negotiating agreements for distribution in eight additional markets.

This printed publication consists of a number of articles related to women’s issues, a collection of a myriad of goods and services for women and advertisements. Also, Complainant has provided this same entertainment and information related to women via a global computer network (i.e., the Internet) since 1998 utilizing the URL <skirtmag.com> which was registered and is owned by Complainant. Complainant is also the Registrant and owner of the domain name <skirt.com>. Copies of archived web pages and WHOIS reports attached as Complainant’s Exhibits 4, 5, & 6.

Respondents’ domain name, <sk-rt.com>, was not registered until February, 2007, and is virtually identical to Complainant’s registered trademarks and domain name. Copy of archived web pages for <sk-rt.com> attached as Complainant’s Exhibit 7. Respondents’ use of the domain name is related to issues of interest to women. Thus, there is a high likelihood of confusion in the marketplace that Respondents’ use is somehow approved by, related to or endorsed by Complainant.

Respondents should be considered as having no legitimate interests in respect of the disputed domain name which is a clever variation of Complainant’s <skirt.com> domain name. Respondents’ video, posted to their website, even pronounces the domain name as “skirt-dot-com”. Such a variation of the work “skirt” is one that is not commonly used and, presumably, would never have been registered had <skirt.com> been available.

Further, Respondents are using the domain name to provide services confusingly similar to services covered under one of Complainant’s federally registered trademarks. They are providing information and entertainment on women’s issues or content of interest to women to Internet users. This is exactly the type of information that Complainant provides via its websites.

Respondents have attempted to attract, for commercial gain, Internet users to their website by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation or endorsement of Respondents’ website. This clearly appears from the similarity of Respondents’ domain name. Further, Respondents make generous use of asterisks (*) as a design feature of their website. They have elected to utilize asterisks in place of the hyphen in the domain name and have branded their website as <sk*rt.com> and not <sk-rt.com>.

Complainant also utilizes asterisks on its website and its printed publication as part of its branding. Copies of editions of skirt! attached as Complainant’s Exhibits 8, 9, 10 & 11. Thus, it appears that Respondents are using the domain name in bad faith by copying Complainant’s use of the asterisk branding feature and by using a confusingly similar variation of the trademark SKIRT in order to misleadingly divert consumers. This diversion results in commercial gain to Respondents who, on information and belief, realize commercial gain tied to the amount of traffic that goes to their website.
B. Respondent

Respondent registered <sk-rt.com> on March 10, 2007. Respondent chose <sk-rt.com> because it was a short and easy to remember domain. Respondent recognized that there was tremendous third party use of the term “skirt” prior to registering the Disputed Domain. In fact, Respondent was able to identify numerous other blogs and websites that use “skirt” in a similar fashion, such as <skirtgoddess.com>, <2skirts.com>, <skirts.biz>, <skirts.us>, <denimskirts.com>, and others. See Annex D, printout of representative list of “skirt” domain names that host blogs and websites. Since registration, Respondent has used the Disputed Domain to house a social media ranking website which enables Internet users to exchange information via a blog, have discussions, post content from any source, and vote, or rank, the content they find to be most appealing. As such, content (which may include websites, videos, blogs, etc.) becomes prioritized based upon popularity, thereby incentivizing the producers of that content to be recognized on Respondent’s site. Ultimately, Respondent enables users to interact with other users and make connections that may otherwise be impossible.

Complainant is a newspaper magazine publisher. Complainant has provided no evidence that Respondent registered the Disputed Domain with Complainant’s trademark in mind. Instead, Complainant simply relies upon its trademark registrations. Its first registration, SKIRT, is a trademark which specifically represents a monthly newspaper. See Annex F, SKIRT Trademark Registration. Its second registration, SKIRT!, is used to represent a good on one hand, namely printed materials, and a service mark on the other, namely an online publication of a magazine. See Annex G, SKIRT! Trademark Registration. Despite these registrations, which represent goods and services different from those of Respondent, there is no evidence tending to show that Respondent could have or should have had knowledge of its trademark. In fact, Complainant admits in the Complaint that it did not distribute its monthly newspaper in Respondent’s home state of New York. Perhaps most importantly, Complainant fails to note that it did not become the registrant of <skirt.com>, where it publishes its information, until after Respondent registered and began using the Disputed Domain.

Respondent did not register the Disputed Domain with the intent to sell to Complainant, to disrupt Complainant’s business, or to confuse consumers seeking to find Complainant’s website nor to prevent Complainant from owning a domain name incorporating its trademark.

Despite Complainant owning registered trademarks, it must still show that its mark is distinctive as an indication of a single source in order to have rights. In fact, the following language succinctly sets forth that which Complainant has failed to show:

[T]he fact that [Complainant] has used the trade name for many years in itself is not sufficient. To serve as a trademark, the name must be used in a manner so that the public can come to recognize it as an indication of source. Since the name is descriptive, the Complainant must also show that the name has become distinctive as an indication of a single source, and is not simply viewed by the public as a description applicable to the goods or services from various sources.


As noted above, there is extensive third party use of the word “skirt.” It is clear from the rampant use of “skirt” on the Internet for blogs, among other things, that the public would not consider Complainant’s name to be an indicator of a single source. Rather, the public views it as a description applicable to the goods or services from various sources. In addition, Complainant’s mere use of the generic and oft-used word “skirt” as part of its apparent domain <skirtmag.com> (recall Complainant did not become the registrant of <skirt.com> until after Respondent registered their domain <sk-rt.com>) on the Internet for 9 years does not indicate ownership by or the offering of newspaper publishing by Complainant. The NAF itself has recognized, “[t]he
extensive use of a generic term … can never give it distinctive or non-descriptive secondary meaning indicating origin.” See Off Lease Only, Inc. v. Ford, FA 1023150 (Nat. Arb. Forum Sept. 5, 2007). As such, Complainant can not claim exclusive rights to the Disputed Domain.

The Disputed Domain is a creative substitution of an asterisk for a hyphen in light of the ASCII character limitations imposed by the domain name registry system. Moreover, it is consistent with the trend of misspelled everyday words (e.g. flickr, digg, and de.lico.us) that are used for social networking and blog sites similar to that of Respondent. As such, while it is clear that the Disputed Domain is not identical to Complainant’s alleged mark, it is also clear that a hyphen between two letters can avoid confusing similarity consistent with those listed above.

Ultimately, <sk-rt.com> is not identical or confusingly similar to Complainant’s trademark, especially in light of the fact that Complainant itself rarely uses SKIRT alone, but rather presents the mark as “Skirt Magazine.” See Annex H, printout of <skirt.com> website. As further evidence, the newspaper itself, as shown in page 1 of Complainant’s Exhibit 9 to the Complaint, shows that Complainant has not used “skirt” in and of itself as a trademark but rather in connection with “magazine.” Therefore, in light of Complainant’s own failure to maintain “skirt” as the distinctive identifier for its newspaper publishing, Complainant has failed to establish that the Disputed Domain, which is not even a word, is confusingly similar to the everyday word “skirt.”

Respondent’s interests in and use of a common word is a non-infringing, legitimate use. See Zero Int’l Holding GmbH & Co. v. Teyonet Servs. & Stephen Urich, D2000-0161 (WIPO May 12, 2000). In fact, the panel in Zero International noted the following:

So far as paragraphs 4(a)(ii) and (iii) of the Policy are concerned, the Panel concludes that the Respondent did have a legitimate interest in respect of the domain name and his registration was not affected in bad faith. The word “zero” is a common English word. Although any number of organizations (including the Complainant) may have trade mark rights in such a word (and indeed the Respondent has produced evidence of numerous US trade marks which include or comprise the word “zero”) that does not preclude the Respondent effecting registration of a common word on the “first come, first served” basis which was available. The Respondent’s reasons for doing so, namely that it was short, simple and easy to remember provide an entirely reasonable and proper explanation for the Respondent’s choice of this word.

Similarly, assuming arguendo that “sk-rt” is even the same as “skirt,” there are 78 trademarks with the USPTO that incorporate the word skirt. See Annex I, USPTO Results for “skirt.” While Respondent did not even register a word, it viewed its registration as a play upon a common dictionary term. Panels have “held that it is not bad faith to resell domain names that incorporate common dictionary terms if the respondent was unaware of complainant’s trademark rights at the time of registration.” See Mobile Commc’n Serv. Inc. v. WebReg, RN, D2005-1304 (WIPO Feb. 24, 2006) (citing Nat’l Trust for Historic Preservation v. Preston, D2005-0424 (WIPO Aug. 10, 2005); Landmark Group v. DigiMedia.com, L.P., FA 285459 (Nat. Arb. Forum Aug. 6, 2004); HQ Holdings, LLC v. EquiCorp, Inc., FA 256402 (Nat. Arb. Forum June 15, 2004)). As such, since Respondent was the first to register a domain name corresponding to a dictionary term and had a good faith belief that the domain name’s value derives from its generic qualities, Respondent has a legitimate interest in the domain. See Franklin Mint Federal Credit Union v. GNO, Inc., FA 860527 (Nat. Arb. Forum March 9, 2007) (“As Respondent appears to be a generic domain name reseller, the Panel finds that Respondent has legitimate interests in the <fmcu.com> domain name pursuant to Policy ¶ 4(a)(ii)”).

Not only is the Disputed Domain comprised of a generic term, as illustrated above by the extensive use of the term “skirt” by other entities for blogs, trademarks, and businesses,
Respondent has shown that the Dispute Domain is not exclusively associated with Complainant’s business. In fact, this matter is remarkably similar to a very recent NAF Panel decision where a request to transfer <noble.com> was denied because “‘noble’ is a generic or dictionary word that is not exclusively associated with Complainant.” See Barnesandnoble.com LLC v. John Frank Roseblum, FA 1089020 (Nat. Arb. Forum Nov. 15, 2007). Therefore, as in Barnesandnoble.com LLC, Respondent “has a right or legitimate interest in the domain name because it is a generic or common word and it is now well established that the registration of such a name creates a right or legitimate interest for the purposes of the Policy.” See id.

Besides the generic nature of the word “skirt,” Respondent’s interest in the Disputed Domain was legitimate. In fact, 3 women, including the named Respondent and domain name registrant Gabrielle Blair, Laura Mayes, and Laurie Smithwick, got together to start their business centered on offering a media ranking and social networking site. After having searched for domains and seeing that there were many other uses of the “skirt” all over the Internet, they selected the Disputed Domain. Not only was Respondent’s interest legitimate, but its current legitimate use strengthens its position. Respondent spent numerous hours and significant money to develop the site. Respondent has launched and maintains a functional website that allows users to rank various media content. It is not as if Respondent is claiming preparations to use the domain for a legitimate purpose, which is insufficient to establish rights and legitimate interests. See Canned Foods, Inc. v. Ult. Search, Inc., FA 96320 (Feb. 13, 2001) (finding rights and legitimate interests where respondent’s domain name was registered to be used for use in connection with its various Internet development projects); and Òorah, Inc. v. Simchat Torah Belt Midrash, DT2007-0003 (WIPO June 11, 2007) (finding rights and legitimate interest where steps were taken in preparation to use the <oorah.tv> domain). To the contrary, Respondent has been using the Disputed Domain since March 2007, thus eliminating any credibility issues regarding alleged preparations for use and proving its interests and uses are entirely legitimate. A simple review of Respondent’s website shows a clear and distinct legitimate business separate from Complainant.

In addition, Respondent is not trying to “pass itself off” as Complainant in order to defraud Complainant’s customers, and in fact, is doing something very different. Compare Nat’il Westminster Bank plc v. Olatunji c/o Agboola, FA 870327 (Nat. Arb. Forum Jan. 28, 2007). While Respondent and Complainant both offer material that is viewed by women, they are not competitors, just as the registrant of <lifewatch.com> was deemed not to be a competitor or cyber squatter despite the fact that both parties offered monitoring services and equipment since “Lifewatch” was generic and used in a variety of contexts including. See LifeWatch Holding Corp. d/b/a LifeWatch Inc. v. Network Earth, Inc., FA 96301 (Jan. 26, 2001). Once again, as shown above, “skirt” is used in a variety of contexts, including fashion, blogs, etc. Moreover, Respondent is not capitalizing off of Complainant’s goodwill by doing anything illegal at its website. See Vivendi Universal Games v. Ballard, FA 146621 (Nat. Arb. Forum Mar. 13, 2002) (noting that the Respondent’s “exploitation of the goodwill and consumer trust surrounding the Complainant’s mark to aid in its illegal activities is prima facie evidence of a lack of rights and legitimate interests in the disputed domain name”). Finally, Respondent did not register <sk-rt.com> with the intent to sell it to Complainant.

It is worth noting that Complainant itself did not offer a blog until after Respondent had registered the Disputed Domain and launched its website. This is evidenced by archived records of Complainant’s <skirtmag.com> website, which now redirects to the <skirt.com> website, that show no blogs as of July 7, 2007, well after Respondent’s launch of its website at <sk-rt.com> in March 2007. See Annex J, July 7, 2007 Archive of <skirtmag.com>. Thus, despite Complainant’s contentions in the Complaint that Respondent provides “the exact type of information” as Complainant, it is clear that Complainant’s own website now attempts to mirror some of the offerings that were entirely unique to Respondent with, at the very least, its offering of a blog. See Annex H, printout of <skirt.com> website. This is probably because Respondent’s web site, within several months of launch, is doing over 100,000 hits per month. There is no evidence that any of this traffic would have come as a result of confusion with <skirtmag.com> (the website in effect at the time Respondent registered its domain <sk-rt.com>). In fact, it is
likely that Complainant, having changed its domain to <skirt.com> after Respondent started business, is diverting traffic from Respondent’s web site.

Ultimately, Respondent’s interest in <sk-rt.com> was legitimate and its planned used was consistent with the same legitimate use it is executing today – to provide a social media ranking website and blog. Accordingly, because Respondent has legitimate rights and interests in the Disputed Domain, the Complaint should be denied.

Complainant fails to note that such confusion, if any, has been caused by Complainant itself due to the change from <skirtmag.com> as its primary website to <skirt.com>. Most importantly, this change to <skirt.com> did not occur until two months after Respondent had registered and began using <sk-rt.com>. In fact, an online search for each respective party proves that confusion is unlikely. More specifically, a Google search of the word “skirt” reveals only the Complainant. See Annex K, printout of Google results for “skirt.” Similarly, a Google search of the word “sk-rt” reveals only the Respondent. See Annex L, printout of Google results for “sk-rt.” Since a user would not type <sk-rt.com> for direct navigation purposes to find either party, the Google results prove that likelihood of confusion is merely conjecture. Therefore, since Complainant has failed to provide a shred of evidence to support any confusion, its argument must fail.

The fact remains that there is no evidence that Respondent had knowledge of Complainant’s mark when it registered the Disputed Domain. In fact, Respondent’s first notice of Complainant’s trademarks was the filing of the Complaint. Respondent’s due diligence suggested that there were no exclusive rights to the word “skirt,” let alone the registration of <sk-rt.com>. In fact, the numerous third party uses of a mark “evidences Respondent’s claim that it did not register the disputed domain names with the knowledge of any exclusive rights in the mark on the part of Complainant.” See BND Ent. v. RN Web Reg et al., FA 280502 (Nat. Arb. Forum July 28, 2004) (finding no bad faith or actual or constructive knowledge where numerous other parties used the same generic terms in marks at the time of respondent’s registration).

In addition, it is admitted that Respondent did not perform a trademark search prior to registration. However, failure to search the USPTO does not evidence bad faith. See DoubleJump Publishing, Inc. v. Guerilla-Studios, FA 811632 (Nat. Arb. Forum Nov. 22, 2006) (“However, Complainant does not provide any evidence to prove that Respondent performed a trademark search, and failure to perform such a search should not be considered to be bad faith behavior under the Policy”); see also Gusztav Ujfalusi Fogarassy v. Domain Deluxe, FA 296270 (Nat. Arb. Forum Sept. 8, 2004) (“But Respondent’s failure to verify the existence of Complainant’s trademark is not, on its own, evidence of bad faith.”).

Ultimately, if bad faith cannot be proven at the point of registration, no subsequent set of facts can render a good faith registration bad. See Motley Fool, Inc. v. Domain Works, Inc., D2006-1625 (WIPO Mar. 20, 2007) (held by a three-member panel). Therefore, there can be no bad faith registration and the Complaint must fail. See Substance Abuse Mgmt. v. Screen Actors Models Int’l, D2001-0782 (Aug. 14, 2001) (“a registration of a domain name that at inception did not breach 4(a)(iii) but is found later to be used in bad faith does not fall foul of Rule 4(a)(iii)”); see also Builder’s Best, Inc. v. Yoshihki Okada, D2004-0748 (WIPO Nov. 17, 2004) (denying the complaint due to lack of bad faith registration because the respondent “did not know that NNN corresponded to the specific trademark of the Complainant”); see also Futureworld Consultancy Pty Ltd. v. Online Advice, D2003-0297 (WIPO July 18, 2003) (finding that “there is no evidence to show that the disputed domain was registered with the Complainant in mind”); see also KCTS Television Inc. v. Get-on-the-Web Ltd., D2001-0154 (WIPO April 20, 2001) (noting that “the Panel finds it difficult to infer that Respondent knew of the Complainant at the date of registration of the name”).

Nonetheless, Respondent’s subsequent use of <sk-rt.com> only further evidences its good faith. Complainant tries to note that there is a likelihood of confusion between <skirt.com> and <sk-rt.com>, but Complainant fails to provide any support for this contention. Given the differences
between the parties’ businesses and offerings, there is no likelihood of confusion. As Complainant admits in its trademark registrations, its first trademark (note that Respondent does not deal in goods but rather only services) represents a monthly newspaper while its second registration, SKIRT!, is used to represent a good on one hand, namely printed materials, and a service mark on the other, namely an online publication of a magazine. See Annexes E and F, SKIRT and SKIRT! Trademark Registrations. Respondent’s use of <sk-rt.com> is not for a good, but rather for its social media ranking website. The USPTO itself would likely not oppose a registration by Respondent for “skirt” since it would be in an international class different from Complainant, namely IC045, or “Online social networking services.”

Finally, Complainant attempts in its Complaint to rely upon “asterisks as a branding feature” to show bad faith by Respondent. However, Complainant has never used an asterisk as part of its trademark, company name, or any other brand. In fact, Complainant’s exhibits 8 and 9 simply show what appears to be a flower rather than asterisk symbol in the background. Regardless, Respondent’s online users will not access Complainant’s printed newspaper materials just as Complainant’s customers will recognize the difference between a newspaper and a social media ranking site. Therefore, general allegations do not amount to evidence establishing bad faith. See Graman USA Inc. v. Shenzhen Graman Indus. Co., FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

Ultimately, Respondent did not register the Disputed Domain with the intent to sell to Complainant, to disrupt Complainant’s business, or to confuse consumers seeking to find Complainant’s web site. In addition, Respondent has not prevented Complainant from owning a domain name incorporating its trademark filing, as evidenced by the Complainant’s ownership of both <skirt.com> and <skirtmag.com>. Finally, Respondent has not disrupted Complainant’s business in any way.

Therefore, Respondent requests that the Administrative Panel deny Complainant’s claim. Respondent’s domain is not identical or confusingly similar to Complainant’s mark, Respondent has demonstrated rights and legitimate interests in the domain, and Respondent did not register or use the domain in bad faith.

Complainant in its Complaint fails to note that it did not become the registrant of <skirt.com> until after Respondent registered and began using the Disputed Domain. At the time of Respondent’s registration of the Disputed Domain, <skirt.com> was a website selling ladies apparel and specifically skirts over the Internet and in no way affiliated with Complainant. This fact in and of itself evidences a bad faith attempt to acquire the Disputed Domain.

Paragraph 15(e) of the Rules provides, *inter alia*:

> If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Furthermore, Paragraph 1 of the Rules defines reverse domain name hijacking as “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name.” Ultimately, Complainant’s actions meet the test this Panel should apply:

Initiating domain name dispute resolution proceedings necessarily involves putting the parties to a considerable expenditure of time and in many cases cost and the Policy must not be used unless the complainant has a reasonable and credible belief it is entitled to succeed. In particular, proceedings must not be commenced
in a brash and totally unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name . . .

See Proto Software, Inc. v. Vertical Axis, Inc/PROTO.CO, D2006-0905 (WIPO Oct. 10, 2006) (decided by a three-person panel). Therefore, in light of Complainant’s attempts to monopolize all rights inherent to the generic word “skirt,” Respondent’s legitimate interests in its creative play on the generic word, and Respondent’s good faith registration and use of the Disputed Domain for its media ranking website which in no way is confusingly similar to a newspaper magazine publisher, this Panel should deny Complainant’s Complaint and find reverse domain name hijacking.

FINDINGS
1 – The disputed domain name is confusingly similar to a trademark or service mark in which Complainant has rights.
2 – Respondents have rights and legitimate interests in respect of the domain name.
3 – The disputed domain name was not registered nor is it being used in bad faith.

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


The Panel also finds that the <sk-rt.com> domain name is confusingly similar to its SKIRT mark. The disputed domain name replaces the “i” in Complainant’s mark with a hyphen, and adds the generic top-level domain (“gTLD”) “.com.” The disputed domain name is also phonetically identical to its mark. These alterations render the <sk-rt.com> domain name confusingly similar to Complainant’s SKIRT mark pursuant to Policy ¶ 4(a)(i). See Vivendi Universal Games, Inc. v. Cupcake Patrol, FA 96245 (Nat. Arb. Forum Oct. 31, 2003) (“Respondent's <blizzerd.com> domain name is confusingly similar to Complainant's BLIZZARD mark. The replacement of the letter 'a' in Complainant's BLIZZARD mark with the letter 'e' creates a domain name that is phonetically identical and confusingly similar to Complainant's mark.”); see also Innomed Techs., Inc. v. DRP Servs., FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (finding that hyphens and top-level domains are irrelevant for purposes of the Policy).

Respondents contend that the <sk-rt.com> domain name is comprised of the generic and often-used word “skirt,” which can be used in many different capacities and therefore is not confusingly
similar to Complainant’s SKIRT mark. However, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i) as this portion of the Policy considers only whether Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to Complainant’s mark. See Vance Int’l, Inc. v. Abend, FA 970871 (Nat. Arb. Forum June 7, 2007) (finding that because the complainant had received a trademark registration for its VANCE mark, the respondent’s argument that the term was generic failed under Policy ¶ 4(a)(i)); see also David Hall Rare Coins v. Tex. Int’l Prop. Assocs., FA 915206 (Nat. Arb. Forum Apr. 9, 2007) (“Respondent’s argument that each individual word in the mark is unprotectable and therefore the overall mark is unprotectable is at odds with the anti-dissection principle of trademark law.”).

Rights or Legitimate Interests

The Panel finds that Complainant has not established a prima facie case in support of its argument that Respondents lack rights and legitimate interests under Policy ¶ 4(a)(ii). See Terminal Supply, Inc. v. HI-LINE ELECTRIC, FA 746752 (Nat. Arb. Forum Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); see also Workshop Way, Inc. v. Harnage, FA 739879 (Nat. Arb. Forum Aug. 9, 2006) (finding that the respondent overcame the complainant’s burden by showing it was making a bona fide offering of goods or services at the disputed domain name).

The WHOIS information for the <sk-rt.com> domain name identifies Respondents as “SK*RT,” which is the name of Respondents’ business. Respondents claim that they registered the disputed domain name since asterisks cannot be reflected in domain names. Respondents operate a social media ranking and networking website. Complainant’s business concerns the distribution of a monthly magazine and newspaper devoted to women and women’s issues. While some of the interests of these parties may overlap, they do not compete. The panel finds that Respondents are commonly known by the <sk-rt.com> domain name pursuant to Policy ¶ 4(c)(ii). See H & R Johnson Tiles Ltd. v. Cristal Ceramicas S.A., D2004-0432 (WIPO Dec. 21, 2004) (“The record clearly establishes that the Respondent is what it claims, a business operating under and commonly known by the name ‘Cristal Ceramicas.’”); see also Am. Online, Inc. v. Anytime Online Traffic Sch., FA 146930 (Nat. Arb. Forum Apr. 11, 2003) (holding that the respondent had rights or legitimate interests in the disputed domain name where its business name was “Anytime OnLine Traffic School” and that it was therefore not far-fetched to use <aoltrafficschool.com> as a domain name for its business).

The Panel also finds that Respondents maintain a functional website that allows users to rank various media content and to conduct social networking. Again, this does not compete with Complainant’s business. The Panel finds that Respondents are using the <sk-rt.com> domain name in connection with a bona fide offering of services pursuant to Policy ¶ 4(c)(i). See LifeWatch Holding Corp. v. Network Earth, Inc., FA 96301 (Nat. Arb. Forum Jan. 26, 2001) (finding that respondent could establish rights or legitimate interests in the <lifewatch.com> domain name where complainant’s identical LIFEWATCH mark was composed of generic and descriptive terms, respondent provided evidence that it was preparing to launch multiple websites providing a variety of “watch” services, and respondent’s domain name provided a service unrelated to complainant); see also Energy Source Inc. v. Your Energy Source, FA 96364 (Nat. Arb. Forum Feb. 19, 2001) (finding that the respondent had rights and legitimate interests in the domain name where “Respondent has persuasively shown that the domain name is comprised of generic and/or descriptive terms, and, in any event, is not exclusively associated with Complainant’s business.”).

Respondents also argue that the lone term in the <sk-rt.com> domain name is generic and of common use and therefore, Complainant does not have an exclusive monopoly on the term on the Internet. The Panel finds that the <sk-rt.com> domain name is comprised of a common term and Respondents can establish rights or legitimate interests in the disputed domain name pursuant to Policy ¶ 4(a)(ii). See Kaleidoscope Imaging, Inc. v. V Entm’t, FA 203207 (Nat. Arb. Forum Jan.
5, 2004) (finding that the respondent was using the <kaleidoscope.com> domain name for a bona fide offering of goods or services because the term was “generic” and respondent was using the disputed domain name as a search tool for Internet users interested in kaleidoscopes); see also Qwest Commc’ns Int’l v. QC Publ’g Grp., Inc., FA 286032 (Nat. Arb. Forum July 23, 2004) (stating that “Complainant’s rights in the QWEST mark are limited to its application to the telecommunications industry,” where a variety of other businesses used the mark in unrelated fields).

Registration and Use in Bad Faith

The Panel finds that Respondents have rights or legitimate interests in the <sk-rt.com> domain name pursuant to Policy ¶ 4(a)(ii), and did not register or use the disputed domain name in bad faith pursuant to Policy ¶ 4(a)(iii). See Lockheed Martin Corp. v. Skunkworx Custom Cycle, D2004-0824 (WIPO Jan. 18, 2005) (finding that the issue of bad faith registration and use was moot once the panel found the respondent had rights or legitimate interests in the disputed domain name); see also Vanguard Group Inc. v. Investors Fast Track, FA 863257 (Nat. Arb. Forum Jan. 18, 2007) (“Because Respondent has rights and legitimate interests in the disputed domain name, his registration is not in bad faith.”).

Complainant has not presented any evidence of bad faith registration and use. Complainant simply concludes that Respondents have attempted to attract, for commercial gain, Internet users to Respondents’ website by creating a likelihood of confusion with Complainant’s marks. Respondents reiterate that they are not competing with Complainant’s business, and therefore are not causing any likelihood of confusion. Respondents argue that if there is any likelihood of confusion between Complainant’s business and Respondents’ disputed domain name, it was caused by Complainant since Complainant registered the <skirt.com> domain name two months after Respondent registered the <sk-rt.com> domain name. Furthermore, Respondents state that Complainant copied some of the content off Respondents’ website that resolves from the disputed domain name, and placed it on its own website. Therefore, Respondents contend that they did not create any likelihood of confusion, and that the two businesses are not competing. It is the finding of the Panel that Respondent did not register or use the <sk-rt.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) or (iv). See Chestnutt v. Tumminelli, D2000-1758 (WIPO Feb. 2, 2001) (finding that the respondent did not register and use the <racegirl.com> domain name in bad faith because the complainant provided no evidence that the respondent intended to disrupt or divert business from the complainant); see also Schering AG v. Metagen GmbH, D2000-0728 (WIPO Sept. 11, 2000) (finding that the respondent did not register or use the domain name <metagen.com> in bad faith where the respondent registered the domain name in connection with a fair business interest and no likelihood of confusion was created).

The panel finds that the <sk-rt.com> domain name is comprised of the modified generic term “skirt,” which can be used in many different ways. Complainant does not have an exclusive right to the use of this term on the Internet. The Panel concludes that Respondents did not register or use the <sk-rt.com> domain name in bad faith pursuant to Policy ¶ 4(a)(iii). See Target Brands, Inc. v. Eastwind Group, FA 267475 (Nat. Arb. Forum July 9, 2004) (holding that the respondent’s registration and use of the <target.org> domain name was not in bad faith because the complainant’s TARGET mark is a generic term); see also Miller Brewing Co. v. Hong, FA 192732 (Nat. Arb. Forum Dec. 8, 2003) (finding that because the respondent was using the <highlife.com> domain name, a generic phrase, in connection with a search engine, the respondent did not register and was not using the disputed domain name in bad faith).

DECISION

Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be DENIED.
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