CPR Institute for Dispute Resolution

CPR INSTITUTE FOR DISPUTE RESOLUTION

REED PUBLISHING (NEDERLAND) B.V. AND REED ELSEVIER INC. ) Complainants, ) v. ) 21ST CENTURY COMMUNICATIONS SCP, ) Respondent )

Domain Name Dispute Forum File No. CPR00 0318

Date of Commencement: July 21, 2003
Domain Name(s): whoswho-america.com, whoswho-world.com, whoswho.com, whoswho.net, whoswho.biz

Registrar: BulkRegister.com

Administrative Panel: Edward C. Chiasson, Q.C.

THE PARTIES

1. The Complainant, Reed Publishing (Nederland) B.V., is a limited liability company formed under the laws of the Netherlands having its principal place of business in Amsterdam, Netherlands. The Complainant Reed Elsevier Inc. is a corporation incorporated under the laws of the State of Massachusetts, United States of America having an office in New York, New York, United States of America. They are referred to herein collectively as the Complainants.

2. The Respondent, 21st Century Communications SCP, is a corporation or other entity having its principal place of business in Monte Carlo, Principality of Monaco.

PROCEDURAL HISTORY

3. The Complaint was filed with CPR on July 23, 2003 and, after review for administrative compliance, was served on the Respondent. The Respondent filed a Response and a Supplemental Response. The parties each filed additional material.
4. The Administrative Panel was appointed pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). The Administrative material has reviewed and considered all of the material filed by the parties.

5. The Respondent’s registered domain names, whoswho-america.com, whoswho-world.com, whoswho.com, whoswho.net, whoswho.biz, were registered with Bulkregister.com on. In registering the name, the Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

6. The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

i. the Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;

ii. the Respondent has no rights or legitimate interests in respect of the domain name; and

iii. the Respondent’s domain name has been registered and is being used in bad faith.

BACKGROUND

7. The following information derives from the material filed by the Complainant.

8. Reed Publishing is the owner, and Reed Elsevier is the exclusive licensee of a number of famous and incontestable registered trademarks specifically including, but not limited to:

<table>
<thead>
<tr>
<th>Trademark</th>
<th>Registration No(s)</th>
<th>Date of First Use</th>
</tr>
</thead>
<tbody>
<tr>
<td>WHO’S WHO IN AMERICA</td>
<td>378,389 and 2,275,121</td>
<td>06/20/1899</td>
</tr>
<tr>
<td>WHO’S WHO IN THE WORLD</td>
<td>931,159</td>
<td>12/28/1970</td>
</tr>
<tr>
<td>WHO’S WHO (Design)</td>
<td>991,399</td>
<td>08/31/1970</td>
</tr>
<tr>
<td>WHO WAS WHO IN AMERICA</td>
<td>509,921</td>
<td>02/10/1993</td>
</tr>
<tr>
<td>WHO’S WHO IN THE EAST</td>
<td>696,101</td>
<td>04/08/1948</td>
</tr>
<tr>
<td>WHO’S WHO IN THE WEST</td>
<td>696,100</td>
<td>07/26/1949</td>
</tr>
<tr>
<td>Trademark</td>
<td>Registration No(s)</td>
<td>Date of First Use</td>
</tr>
<tr>
<td>------------------------------------------</td>
<td>-------------------</td>
<td>-------------------</td>
</tr>
<tr>
<td>WHO'S WHO IN THE MIDWEST</td>
<td>696,099</td>
<td>11/01/1949</td>
</tr>
<tr>
<td>WHO'S WHO IN THE SOUTH and SOUTHWEST</td>
<td>696,098</td>
<td>07/31/1950</td>
</tr>
<tr>
<td>WHO'S WHO IN MEDICINE AND HEALTHCARE</td>
<td>2,242,351</td>
<td>05/31/1995</td>
</tr>
<tr>
<td>WHO'S WHO IN AMERICAN POLITICS</td>
<td>2,247,065</td>
<td>1967</td>
</tr>
<tr>
<td>WHO'S WHO IN AMERICAN LAW</td>
<td>1,529,670 and 2,245,379</td>
<td>1977</td>
</tr>
<tr>
<td>WHO'S WHO OF AMERICAN WOMEN</td>
<td>729,754 and 2,245,380</td>
<td>12/15/1958</td>
</tr>
<tr>
<td>WHO'S WHO IN AMERICAN EDUCATION</td>
<td>1,730,993 and 2,245,357</td>
<td>09/15/1988</td>
</tr>
<tr>
<td>WHO'S WHO IN SCIENCE AND ENGINEERING</td>
<td>1,805,247</td>
<td>03/15/1992</td>
</tr>
<tr>
<td>WHO'S WHO IN FINANCE AND INDUSTRY</td>
<td>1,106,632</td>
<td>1940</td>
</tr>
<tr>
<td>MARQUIS WHO'S WHO</td>
<td>1,959,899 and 2,241,435</td>
<td>1954</td>
</tr>
</tbody>
</table>

(hereinafter collectively referred to as the "Reed Marks")

9. Since 1899, the Complainants and their predecessors have used WHO’S WHO IN AMERICA® and subsequently the remaining Reed Marks and other trademarks incorporating the phrase WHO’S WHO continuously and extensively in commerce to identify the family of biographical directories that the Complainants publish and sell throughout the world.

10. The Reed Marks are widely recognized in numerous markets, including the worldwide library and reference community, in business and academic circles, and among biographies and individual purchasers or users of Reed’s Marquis Who’s Who biographical directories and databases which are available in print, electronic, and Internet online versions.

11. The great value and the strength of the Reed Marks is evidenced by the millions of dollars spent by the Complainants and their predecessors promoting and protecting the Reed Marks, and the tens of millions of dollars in sales of publications bearing the Reed Marks that have been consummated.

12. In addition to its historical roots in printed publications and biographical directories, for approximately twenty years the Complainants have offered their products in electronic and database
format, and since 1997 have promoted the Marquis Who's Who family of biographical directories on the Internet through their web site at "www.marquiswhoswho.com."

13. As a result of the efforts of the Complainants and through their continuous and extensive use for nearly one hundred years of a family of marks and titles built around the formative phrase WHO'S WHO, the Complainants have established substantial and valuable goodwill in the products, services and reputation which are represented by the Reed Marks.

14. The Respondent and its Partners, Who's Who Online, Who's Who Global Network and 21st Century were formed by Mr. McCabe in or about 1997 for the purpose of establishing an online membership organization. Subsequently Mr. McCabe formed MM Communications for the same purpose.

15. On or about April 16, 1997, the Respondent registered "whoswho.com"; on or about August 19, 1997, the Respondent registered "whoswho-world.com"; on or about August 27, 1997, the Respondent registered "whoswho-america.com"; on or about January 1, 1998, the Respondent registered "whoswho.net"; and on or about March 27, 2000, the Respondent registered "whoswho.biz."

16. As of July 10, 2003, the Respondent's domain names for "whoswho-america.com", "whoswho-world.com", "whoswho.net" and "whoswho.biz" were not active or linked to any existing web site. Searches for these addresses yield only the standard Internet message stating that the page is unavailable and cannot be displayed. The domain name "whoswho.com" is presently linked to Respondent's apparently dormant web site located at "whoswho-online.com."

17. The Respondent is not now using and has never used, the "whoswho-america.com," "whoswho-world.com," whoswho.net", or "whoswho.biz" domain names in connection with a bona fide offer of goods or services.

18. The remaining domain name at issue, "whoswho.com," is linked superficially to the Respondent's web site located at the "whoswho-online.com" address. That web site has not been updated in some time and seemingly is dormant. The "Nominations" and "Visitor" pages within the
web site expressly state that those pages are "inactive". The web site is no longer processing or accepting members.

19. The Respondent is not now and has never been commonly known by the domain names at issue.

20. The Respondent is and has been fully aware that Reed’s Marks exist and currently are in use.

21. Beginning in 1996, before the registration of any of the Internet addresses at issue here, Mr. McCabe, the Respondent's principal, contacted the Complainants in an attempt to obtain employment with or enter into a vaguely described Internet venture with them.

22. During his pursuit of some form of arrangement with the Complainants, Mr. McCabe acquired and then offered to contribute certain of the domain names at issue in exchange for the right to link to the Complainants biography database and the payment by the Complainants of a substantial sum of money.

23. The Complainants declined and invoked the then governing Network Solutions Inc.'s ("NSI") internet domain name cancellation policy with regard to "whoswho-america.com" and "whoswho-world.com."

24. NSI denied cancellation on the now obsolete and inapplicable ground that the domain names were not exactly identical to the Reed Marks because they included additional alpha or numeric characters.

25. The Complainants previously have succeeded in obtaining the transfer of substantially similar domain names to those at issue: see Reed Publishing (Nederland) B.V. v. Beverly, (No. CV9800105 AHS) (C.D. Cal. 1999). In the Beverly case, the Federal District Judge specifically enjoined the Defendant "from using the following domain names or any other domain names that incorporate the words 'whoswho,' 'whoswhtintheworld.com', 'whoswhoinbusiness.com,’ 'whoswhoin.com,’ 'whoswhoineducation.com,’ 'whoswhoinamerica.com,’ and 'whoswhoinhealth.com.’"
26. In addition, the Complainants brought an ICANN proceeding seeking transfer of several names including "whoiswhoinamerica.com" and "whoiswhointtheworld.com". Reed Publishing (Nederland) B.V. and Reed Elsevier Inc. v. Select Gourmet Foods Inc., CPR004 (August 29, 2000). In that proceeding bad faith registration was found, and transfer of the aforementioned domain names ordered, based upon the fact that Reed's WHO'S WHO IN AMERICA® and WHO'S WHO IN THE WORLD® were established, well known marks.

27. The following information derives from material filed by the Respondent.

28. The Respondent registered the subject domain names in 1994 after the Complainants disavowed any interest in the Internet network proposal Mr. McCabe and discussed with senior officials of the Complainant.

29. The Complainants’ marks primarily relate to print media publications in Class 38. The Respondent has its own “who’s who” trademarks. They relate solely to telecommunications services in Classes 100, 101, and 104 and not print media.

30. The Respondent has been successful in business for many years using its domain names and is well known for doing so.

31. The “who’s who” field is extremely crowded. Well over a hundred publishers offer literally thousands of who’s who directories. All of these directories use the term who’s who” in conjunction with other words, including words, such as, “America,” “World,” “International,” “France,” “Italy,” “Germany”.

32. In the United States alone, there are 251 present and former trademarks that include “who’s who” as part of their text. Companies all the over the world own these marks and many others that are registered outside the United States.

33. The Respondent owns trademarks that contain the term who’s who, as follows:

<table>
<thead>
<tr>
<th>Trademark</th>
<th>Registration No.</th>
<th>County</th>
<th>Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>WHO'S WHO ONLINE</td>
<td>2,028,029</td>
<td>USA</td>
<td>09-19-1995</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>2,056,445</td>
<td>USA</td>
<td>12-01-1996</td>
</tr>
</tbody>
</table>

Document: 1188833:01
<table>
<thead>
<tr>
<th>Trademark</th>
<th>Registration No.</th>
<th>County</th>
<th>Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>96.16996</td>
<td>Monaco</td>
<td>03-26-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>France</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Italy</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Korea</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Poland</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Portugal</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Czech Rep.</td>
<td>10-10-1996</td>
</tr>
<tr>
<td>WHO'S WHO GLOBAL NETWORK</td>
<td>660 070</td>
<td>Ukraine</td>
<td>10-10-1996</td>
</tr>
</tbody>
</table>

34. The Complainants’ core activities are print media, Class 38. The Respondent’s core activities are Internet services, Classes 100, 101, and 104.

35. The Complainants’ main business is the publishing of books and directories on paper, as its trademarks demonstrate. The Respondent is not involved in printing or publishing books, but is well-known for creating a searchable network of names on-line. The Respondent provides telecommunication services and searchable information in the field of biographical and professional data about individuals of accomplishment via global information networks. Its trademarks relate only to telecommunications services.

36. The aims and activities of WHO'S WHO ONLINE® are clearly stated on its homepage that can be found at www.whoswho.com:

   “Who's Who Online® is a searchable site on the World Wide Web which contains professional and biographical data about individuals of accomplishment who are part of the worldwide Internet community. Profiles are provided by the individuals themselves, who own the copyrights to their own pages.”

37. The purpose of the WHO'S WHO GLOBAL NETWORK® is also clearly stated on the Who's Who Online® homepage:
“Who's Who Global Net Work® offers value-added telecommunications specifically designed to serve individuals of accomplishment in the challenging and changing work environment that will accompany the dawn of the new millennium.”

38. The website includes a “Who’s Not” page linked from the top of the homepage, where the Respondent states the on-line services with which the site is not affiliated and that WHO'S WHO ONLINE® is not affiliated with any who’s who print publisher. It disclaims any connection to Marquis Who’s Who™, which is identified as a publisher of numerous traditional who’s who print publications.

39. The Respondent’s predecessor successfully registered the following domain names on the dates indicated. These domain names were transferred to the Respondent in 1997 making it and its predecessor one of the very early entrants into the who’s who field as it relates to the Internet and telecommunications:

<table>
<thead>
<tr>
<th>Domain Name</th>
<th>Registration Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>whoswho.com</td>
<td>11-02-1994</td>
</tr>
<tr>
<td>whoswho-online.com</td>
<td>08-07-1995</td>
</tr>
<tr>
<td>whoswho-world.com</td>
<td>08-06-1995</td>
</tr>
<tr>
<td>whoswho-corporate.com</td>
<td>08-06-1995</td>
</tr>
<tr>
<td>whoswho-america.com</td>
<td>08-06-1995</td>
</tr>
<tr>
<td>whoswho-asia.com</td>
<td>08-06-1995</td>
</tr>
<tr>
<td>whoswho-europe.com</td>
<td>08-06-1995</td>
</tr>
<tr>
<td>whoswho.net</td>
<td>10-12-1995</td>
</tr>
</tbody>
</table>

40. After the .biz top-level domain name became available, the Respondent secured whoswho.biz and did not renew the registration for the domain whoswho-corporate.com, since whoswho.biz was viewed as a shorter, better and more fitting domain for business registrants.

41. The subject domain names support active email addresses and are operational. The email address provided by the Claimants for the Respondent in this proceeding is an address that has been functional since 1994.
42. One of the principal features of the Who's Who Online® website is that it is searchable. This functionality remains and has been operational on the site for almost eight years.

43. The Respondent did not register the subject domain names to sell them to the Complainants, to prevent the Claimants from registering a similar domain name, to disrupt the Claimants’ business, or to attract and confuse customers.

44. In May 1994, before registering any domain name, the Respondent’s predecessor offered knowledge of the Internet to the Complainants in order to establish a joint venture with them. The offer was declined. The Claimants disavowed any interested in expanding their activities to the Internet and wished the Respondent’s predecessor good luck regarding in doing so.

45. Only subsequent to the Complainants’ disavowal of the Internet did the Respondent register the subject domain names. In June 1997, almost three years after the initial registration, the Complainants, represented by Whitman Breed Abbott and Morgan, a firm now merged with Winston and Straw, one of the Complainants’ attorneys in this proceeding, threatened the Respondent with legal action alleging a violation of the Lanham Act. The Complainants’ attorneys demanded that the Respondent desist from any further use of the subject domain names and the Respondent’s registered trademarks.

46. The Complainants abandoned their threat of legal action until July 2003 when this proceeding was commenced.

47. The Complainants have stated an intention to litigate the transfer of the whoswho.info domain name.

48. The Respondent recently acquired domain name whoswho.info. The Respondent has informed the Complainants about this acquisition and requested them to include the whoswho.info domain name in this proceeding. The Complainants have refused to do so despite their announced intention to seek its transfer.

49. The Respondent requests the Administrative Panel to determine its right to use whoswho.info in this proceeding, in order to avoid further litigation and legal costs.
50. The Respondent seeks the costs of this proceeding.

51. The following additional information derives from the further material filed by the parties.

52. The Claimants say that the Respondent has not disputed that the subject domain names are confusingly similar to the Reed Marks. The Respondent states that the Claimants’ rights are not exclusive and that the market for the use of “who’s who” is crowded. It contends that in such circumstances, there can be no confusion other than through words or symbols attached to “who’s who”.

53. The Claimants are very recent entrants to the Internet. Their descriptive trademarks and associated designs and logos are not well known on the Internet. The Reed Marks are not registered in the classes that pertain to the Internet.

54. The Claimants assert that they did not include the additional domain name because they did not know that the Respondent owned it at the time the proceeding was initiated. Costs are rejected on the basis that the relief available in a domain name dispute proceeding is limited and does not extend to the relief sought.

55. The parties dispute the significance of data obtained through internet searches.

DISCUSSION

56. The parties refer to other domain name decisions and to the decisions of domestic courts. While these are neither controlling nor binding on the Administrative Panel, consideration of them often is of assistance.

57. A domain name dispute usually is not a process for the resolution of disputed issues of fact and contested intellectual property rights.

IDENTITY/CONFUSING SIMILARITY

58. The Complainant alleges that whoswho-america.com, whoswho-world.com, whoswho.com, whoswho.net, whoswho.biz are confusingly similar to the Complainants’ trademarks. It relies on its registration and use of the Reed Marks.
59. It is clear that the Complainants have rights to the Reed Marks and that the subject domain names are similar to them. The issue is whether they are confusingly similar. That question is considered objectively, that is, actual confusion is not required, but the context of the Complainants’ use of their marks is a relevant consideration.

60. The Respondent contends that the Complainants’ rights are limited because the root words of its mark are generic. That is a proposition that would be addressed more properly in proceeding designed to consider the validity of trademarks. Generally, a domain name dispute is not such a forum.

61. The Respondent asserts: “…there is a difference between [the Respondent’s] use of its domain names and [the Claimants’] trademarks. There is no risk of confusion between the two, given the extremely crowded field in which they both exist and the different consumer audiences they attempt to serve”.

62. The fact that the parties historically have operated in different mediums does not obviate the potential for confusion. Objectively, a user of the Internet is likely to be confused by similarity of the subject domain names with the Complainants’ marks.

63. The Administrative Tribunal is satisfied that the Complainants’ have met the requirements of paragraph 4(a)(i).

RIGHTS AND LEGITIMATE INTERESTS

64. The Complainants allege that the Respondent has no rights or legitimate interests with respect to the subject domain names. It is suggested that the subject domain names are not being used and that the marks that support them have been abandoned. As such, it is asserted, the marks are vulnerable. As noted, attacks on the legitimacy of registered trademarks usually is best dealt with in proceedings designed to address such matters. A domain name dispute generally is not such a forum.

65. The activities of the Respondent are alleged to derive from a disagreement between the Claimants and the individual who is behind the Respondent.
66. Militating against this is the fact that the Respondent has marks which relate directly to the subject domain names. More importantly, it asserts that it is using its marks and indirectly the subject domain names in the course of its business.

67. The parties joined issue on these matters prior to the initiation of this proceeding. They appear to have a long-standing disagreement concerning rights to marks and domain names that relate to “who’s who”.

68. The resolution of their dispute should not be resolved in this proceeding. A tribunal which is equipped with the ability to receive, consider and resolve disputed issues of fact is required.

69. On the material before it, the Administrative Tribunal cannot find that the Respondent does not have a legitimate interest in the subject domain names.

70. The Administrative Tribunal is not satisfied that the Claimant has met the requirements of paragraph 4(a)(ii).

**BAD FAITH**

71. In support of the contention of Respondent’s bad faith registration and use the Complainants refer to an alleged disagreement between them and the principal of the Respondent and to the fact that he clearly knew of the Complainants’ rights.

72. Reference also is made to the use, or lack thereof, which the Respondent has made of the subject domain name.

73. The Respondent asserts that the Complainants gave their blessing to the Respondent’s registration and that, in any event, the Complainants long knew of the registrations but did nothing about them.

74. Again, these are hotly contested issues of fact which should not be resolved in this proceeding.

75. The Administrative Panel is not satisfied that the Complainants have met the requirements of paragraph 4(a)(iii)
COUNTERCLAIM

76. The Respondent asked the Administrative Panel to incorporate another domain name into this proceeding and to order costs. The Administrative Panel declines to do either.

77. As has been noted, this proceeding is but one step in a long-standing dispute. Both sides feel strongly about their respective positions. An award of costs, even if there were jurisdiction to make it, about which the Administrative Panel makes no finding, would not be appropriate.

78. Equally inappropriate in the circumstances of this case, would be consideration of an additional domain name.

CONCLUSION

79. In light of my findings above that:

   (a) the registered domain name is confusingly similar to Complainants’ protected marks;

   (b) the Claimants have not established that the Respondent does not have rights or legitimate interests with respect to the subject domain names; and

   (c) the Complainants have not established that the Respondent registered and is using the subject domain names in bad faith, as that term is defined in the ICANN Policy, the Administrative Panel dismisses the Complainant.

REMEDY

80. The Complainants’ request to transfer the subject domain names is DENIED.

81. The Respondent’s counterclaim is DENIED

__________________________________  October 6, 2003
Signature of Administrative Panel