CPR INSTITUTE FOR DISPUTE RESOLUTION

Reed Publishing (Nederland) B.V. and Reed Elsevier Inc.,
Complainants,

-v-

Select Gourmet Foods Inc.,
Respondent.

COMPLAINT

Complainants Reed Publishing (Nederland) B.V. and Reed Elsevier Inc. (collectively “Reed”), by their attorneys, Whitman Breed Abbott & Morgan LLP, by way this Complaint against Defendant Select Gourmet Foods Inc. ("SGF"), request that it be submitted for decision in accordance with the Uniform Domain Name Dispute-Resolution Policy ("Dispute-Resolution Policy") and with the ancillary Rules of the Internet Corporation For Assigned Names and Numbers ("ICANN") and hereby say:

I. THE PARTIES

1. Complainant Reed Publishing (Nederland) B.V. ("Reed Nederland") is and at all relevant times was a limited liability company formed under the laws of the Netherlands having its principal place of business in the Netherlands at 4 Van de Sande, Bakhuyzenstraat, 1061 AG
Amsterdam, Netherlands. Reed Nederland's email address is: erik.ekker@reed-elsevier.nl; telephone number is 31(0)20 51 52 195; and telefax number is 31(0)20 61 65 606.

2. Complainant Reed Elsevier Inc. (“Reed Elsevier”) is and at all relevant times was a corporation incorporated under the laws of the State of Massachusetts having its principal place of business in the State of Massachusetts at 275 Washington Street, Newton, Massachusetts 02458. Reed Elsevier's email address is: henry.horbaczewski@reed-elsevier.com; telephone number is (617) 558-4227; and telefax number is (617) 558-4649.

3. The headquarters of the business and intellectual property rights that are the subject of this action is situated at Reed Elsevier’s Marquis Who’s Who Division whose principal offices are located at 121 Chanlon Road, New Providence, New Jersey 07974 ("Reed Elsevier - New Providence"). Reed Elsevier - New Providence's email address is: r.mysel@renp.com; telephone number is (908) 464-6800; and telefax number is (908) 771-8645.

4. Upon information and belief, Respondent SGF is a corporation or other entity existing under the laws of the State of Washington having its principal place of business at 15022 Juanita Drive NE, Kenmore, Washington 98028. Upon information and belief, SGF's email address is: sgfoods@Yahoo.com; telephone number is (206) 528-0332; and telefax number is (425) 487-3749.

5. Upon information and belief, Mr. Mohammed Souaiaia is the President, Ms. Margaret Souaiaia is the Vice-President and Mr. Hedi Mzali is the Treasurer of Respondent SGF.
II. THE DOMAIN NAMES AND REGISTRAR

6. The domain names at issue are: "whoiswhoinamerica.com," "whoiswhointheworld.com," "whoiswhoinmedicine.com," "whoiswhoinpolitics.com" and "whoiswhoinlaw.com" The Registrar of these domain names is Network Solutions, Inc.

7. Because the CPR Institute for Dispute Resolution ("CPR") has been approved by ICANN to hear this dispute and act as a dispute resolution service provider, CPR has jurisdiction over Reed’s claims pursuant to the Dispute-Resolution Policy incorporated by reference into the Registration Agreement between Respondent SGF and its Registrar.

8. In accordance with Rule 3(b)(xiii) and in the event SGF challenges a decision in this administrative proceeding canceling or transferring the domain names at issue, Reed agrees to submit to the jurisdiction of the United States District Court for the Eastern District of Virginia, Alexandria Division, as set forth in paragraph 24 of the Network Solutions' Service Agreement.

III. FACTUAL BACKGROUND

A. Reed’s Marquis Who’s Who Business

9. Reed Nederland is the owner, and Reed Elsevier is the exclusive licensee (Exhibit A annexed hereto), of a number of famous and/or incontestable registered trademarks specifically including, but not limited to, WHO’S WHO IN AMERICA (Reg. Nos. 378,389 and 2,275,121) first used in commerce on June 20, 1899 (Exhibit B), WHO’S WHO IN THE WORLD (Reg. No. 2,247,065), first used in commerce on December 28, 1970 (Exhibit C), WHO'S WHO IN MEDICINE AND HEALTHCARE (Reg. No. 2,242,351) first used in commerce on May 31, 1995 (Exhibit D), WHO'S WHO IN AMERICAN POLITICS (Reg. No. 2,247,065), first used in commerce in 1967 (Exhibit E) and WHO'S WHO IN AMERICAN
LAW (Reg. Nos. 1,529,670 and 2,245,379), first used in commerce in 1977 (Exhibit F), together with more than approximately thirty other marks incorporating the phrase WHO’S WHO that are in active use by Reed Elsevier’s Marquis Who’s Who Division (collectively the “Reed Marks”).

10. Since 1899, Reed and its 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 Reed publishes and sells throughout the world.

11. The Reed Marks are widely recognized in numerous markets, including but not limited to the library and reference community and among biographees and individual purchasers or users of Reed’s Marquis Who’s Who biographical directories.

12. Reed and its predecessors have spent millions of dollars in promoting and protecting the Reed Marks, and have consummated millions of dollars of sales of publications bearing the Reed Marks. (See Declaration of Randy Mysel annexed hereto as Exhibit G.) In addition, Reed promotes its Marquis Who's Who family of biographical directories on the Internet through its web site at "www.marquiswhoswho.com." (Exhibit H.)

13. As a result of the efforts of Reed and its predecessors and through their continuous and extensive use for nearly one hundred years of their marks incorporating the component phrase WHO’S WHO in connection with the publication and sale of biographical directories, and more recently through sales of electronic versions of such directories, Reed has established substantial and valuable goodwill in its products, services and reputation which is represented by the Reed Marks. One of the measures of external value of goodwill is reflected by the extensive unsolicited third party recognition. (Exhibit I.) Another measure of the value of a trademark is
reflected by the several licenses Reed has granted in connection with the trademarks, titles and editorial content which in aggregate yields annual royalties in medium six figures.

B. The Business of Respondent

14. Upon information and belief, Respondent SGF was formed by Mr. Souaiaia in or about October, 1992 for the purpose of selling specialty foods, specializing in game meats, caviar, olives, olive oils and produce.

15. On or about December 26, 1999, despite having no apparent or legitimate connection to the domain names, SGR registered the names at issue here: "whoiswhoinamerica.com," "whoiswhointheworld.com," "whoiswhoinmedicine.com," "whoiswhoinpolitics.com" and "whoiswhoinlaw.com." (Exhibit J.)

16. Not including the domain names representing SGF's service mark - "selectgourmetfood.com" and "selectgourmetfoods.com" - SGF has registered an additional 37 domain names. Like the domain names at issue here, several others of these domain names do not appear to be associated with the gourmet foods industry. For example, SGF has registered "humanrightsintheworld.com" and "howtomakealotofmoney.com," neither which has an apparent connection to the specialty foods industry. (Exhibit K.)

17. As of July 12, 2000 all of the web sites, except the two sites which correspond to SGF's service mark, were "parked homepages" and not active. (Exhibit L.)

18. On or about January 31, 2000, Reed forwarded a cease and desist letter setting forth Reed's trademark rights in the domain names registered by SGF. (Exhibit M.) Again on March 30, 2000, Reed sent another letter to SGF including the proper transfer agreements as well as proof of Reed's federal trademark registrations in the relevant marks. (Exhibit N.) After Reed's
attempt to settle this dispute without resorting to litigation failed, Reed brought the instant proceeding.

IV. REED'S STATEMENT OF THE CASE

A. SGF Has No Rights To The Domain Names At Issue Here

1. SGF's Domain Names Are Identical Or Confusingly Similar To Reed's Trademarks.

   19. SGF, through its use of identical and confusingly similar domain names, seeks to capitalize on and to rely on the fame of Reed’s Marks and Reed’s publications to attract and to divert traffic to its web site(s).

   20. The domain name "whoiswhinamerica.com" is virtually identical to and slavishly imitates the appearance, sound and meaning of Reed’s incontestable trademark WHO’S WHO IN AMERICA®, which is used on its flagship publication. SGF’s registration of a domain name that is virtually identical to Reed’s most prominent title and trademark cannot have been for any purpose other than to create an association with Reed’s fame and to divert natural traffic from Reed’s own websites.

   21. In the same manner, SGF’s domain name "whoiswhintheworld.com" is virtually identical to and imitates the appearance, sound and meaning of another of Reed’s most prominent publications, WHO’S WHO IN THE WORLD®.

   22. The domain name "whoiswhoinmedicine.com" is in large part, identical to, and on an overall basis substantially similar to, and imitates the appearance, sound and meaning creating a strong association with Reed’s publication, WHO’S WHO IN MEDICINE AND HEALTHCARE®.
23. The domain name "whoiswhoinpolitics.com" is substantially similar to, and imitates the appearance, sound and meaning creating a strong association with Reed’s publication, WHO’S WHO IN AMERICAN POLITICS®.

24. The domain name "whoiswhoinlaw.com" is substantially similar to, and imitates the appearance, sound and meaning creating a strong association with Reed’s publication, WHO’S WHO IN AMERICAN LAW®.

25. The similarity between SGF’s domain names and the sight, sound and meaning of Reed’s four marks at issue here is so great as to be likely to cause confusion, mistake or deception as to the source or origin of SGF’s products and services in that the public and others are likely to believe that SGF’s web sites are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way connected with Reed and its Marquis Who’s Who family of publications.

2. SGF Has No Rights or Legitimate Interests In Connection With The Domain Names At Issue.

26. It seems obvious that SGF has never used the domain names at issue here or the names corresponding to these domain names in connection with a bona fide offer of goods or services. In fact, the web sites have not been activated and contain a message stating only that the site is "the parked homepage" of each domain name.

27. Upon information and belief, SGF has never been commonly known by the domain names at issue here.

28. Upon information and belief, SGF’s registration of the subject domain names is not justified by any intent to make legitimate noncommercial or fair use of the domain names, or to use them without intent for commercial gain.
3. **SGF Has Registered and Is Using The Domain Names At Issue Here In Bad Faith.**

29. SGF is fully aware that Reed’s Marks exist, are currently in use, and that Reed’s trademark rights are enforceable. That SGF registered names identical to Reed's flagship publication - WHO'S WHO IN AMERICA® and names identical or nearly identical to Reed's other prominent titles and trademarks creates an unmistakable inference that SGF selected and registered its domain names in bad faith and for the express purposes of obtaining a “free ride” and of appropriating Reed’s long established reputation and goodwill. Alternatively, SGF registered these domain names with the hope that it could "sell" the names to their rightful owners - in this case Reed.

30. Although SGF may seek to rebut the inference of illegitimacy of its motives by suggesting some purpose for which SGF has registered these domain names, it is beyond dispute that SGF has registered *multiple* names, including those at issue here, unrelated either to SGF's traditional business or to each other, clearly suggesting that its motive is improper.

31. In addition, SGF's failure to change its conduct -- (1) after being notified that Reed objected to its domain names which were identical to or confusingly similar to the Reed Marks and (2) after Reed forwarded proof of Reed's federal registrations for the relevant marks -- is strong evidence that SGF has acted in bad faith.

32. Given the circumstances set forth above, Reed strongly contends that SGF has registered these domain names: (a) to attract Internet users to its domain names by creating a likelihood of confusion with the Reed Marks as to the source, sponsorship, affiliation or endorsement of the SGF domain names and/or for the purpose of disrupting Reed's business; (b) to divert or siphon off Internet traffic intended for Reed and its trademarked publications; (c) to
prevent Reed from reflecting the mark in a corresponding domain name; (d) to sell or otherwise transfer the domain name registrations to Reed or one of its competitors for a sum greater than SGF's out-of-pocket costs directly related to the domain names; and/or (e) to otherwise profit wrongfully from the unauthorized use of Reed's well known Marks, to the detriment of Reed's business and to the detriment of Internet consumers trying to reach Reed.

33. SGF's use of the aforementioned domain names intentionally infringes upon and violates the rights of Reed in its well known titles and trademarks, and has damaged and is continuing to cause injury to Reed’s business, reputation and goodwill.

V. OTHER LEGAL PROCEEDING

34. Reed has previously fought for and succeeded in obtaining the transfer of closely related domain names to those at issue here in the matter of Reed Publishing (Nederland) B.V. v. Beverly, (No. CV9800105 AHS) (C.D.Cal. 1999). In the Beverly case, the Judge found that the defendant had infringed Reed's trademark rights when he registered, among others, the domain names: "whoswhoinamerica.com" and "whoswhointheworld.com" and ordered the defendant to transfer to Reed a total of six domain names which also included: “whoswhoinhealth.com,” “whoswhoin.com,” “whoswhoinbusiness.com,” and “whoswhoineducation.com.” (Exhibit O.)

VI. DEMAND FOR RELIEF

35. WHEREFORE, Reed Publishing (Nederland) B.V. and Reed Elsevier Inc. demand judgment in their favor and against SGF and a mandatory injunction requiring SGF to transfer the domain names: "whoiswhoinamerica.com," "whoiswhointheworld.com," "whoiswhoinmedicine.com," "whoiswhoinpolitics.com" and "whoiswhoinlaw.com" to Reed Elsevier - New Providence.
VII. CONCLUSION

36. For all of the foregoing reasons, Reed respectfully requests that its request for relief be granted in all respects.

37. In accordance with Rule 3(b)(xiv), Reed agrees that its claims and remedies concerning the registration of the domain names at issue here, 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 dispute-resolution provider 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.

38. In further accordance with Rule 3(b)(xiv), Reed certifies that the information contained in this Complaint is to the best of Reed'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.

WHITMAN BREED ABBOTT & MORGAN LLP
Attorneys for Plaintiffs Reed Publishing (Nederland) B.V. and Reed Elsevier Inc.

By: _______________________________

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DATED: July 20, 2000
CERTIFICATION OF SERVICE

In accordance with paragraph 2(b) of the Rules a copy of this Complaint was mailed to SGF, at the addressed set forth in ¶ 4 above, on July 20, 2000.