COMPLAINANT
Design Link International, Inc.
25 Kingston Street
Boston, MA 02111
Tel. #617.451.9050
Fax #617.451.9310
E-Mail: cahill@deslink.com

vs.

RESPONDENT
Ash Mehta
Designlink OnLine Services
2034 Montclair Circle
Walnut Creek CA 94596
Tel. #925.934.7355
Fax #925.935.3825
E-Mail: ash@designlink.com

Before Harold D. Field, Jr., Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on May 7, 2001 and, after review for administrative compliance, was served on
the Respondent. The Respondent filed a Response on or about June 4, 2001. I was appointed Arbitrator
pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the
Internet Corporation for Domain Names and Numbers ("ICANN"). Upon the written submitted record
including the Complaint, the Response, and the Supplemental Brief of Complainant, as well as the pertinent
records of the United States Patent and Trademark Office publicly available through the Trademark Application
and Registration Retrieval System (TARR) and the U.S. Trademark Electronic Search System (TESS), and the
WHOIS database of the Registrar, Network Solutions, I find as follows:

FINDINGS

The Response appears to have been served a few days after the time allowed by ICANN UDRP Rule 5(a), and there
is no express authorization in the Rules for the service of Complainant's Supplemental Brief. I have, however,
exercised my discretion under Rules 10(a) and 10(b) to receive and consider both documents.

Respondent's registered domain name, "designlink.com," was registered with Network Solutions ("Registrar") on
January 31, 1994. In registering the name, Respondent agreed to submit to this forum to resolve any dispute
concerning the domain name, pursuant to the UDRP. The registration expires on February 2, 2003.

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

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

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

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

IDENTITY/CONFUSING SIMILARITY:

Complainant alleges that it has been operating for 15 years as Design Link. Complainant’s business has been the national distribution in the United States of imported furniture. Complainant will commence the U.S. manufacture and distribution of seating in June 2001.

On February 2, 1998, Complainant applied to the United States Patent and Trademark Office to register the word mark “Design Link” (without any design) as a trademark for furniture and related items. Consistent with Complainant’s allegation here, the application claimed first use in commerce in October 1986. That initial application was abandoned in 1999. Thereafter, on January 3, 2000, the Complainant filed an application to register the words Design Link plus a design, claiming first use in commerce on December 21, 1999. The new application led to the registration of Complainant’s compound mark of words plus design on January 3, 2001, for furniture in international class 20.

Complainant alleges that the registered domain name is identical to Complainant’s registered trademark. On this record, I conclude that Complainant has some degree of common law trademark rights in the word mark Design Link as used with furniture for some 15 years. Respondent’s domain name is identical with Complainant’s longstanding common law trademark Design Link (except for the inconsequential addition of the TLD designator, “.com”).

The domain name in question is not identical to the registered trademark because the latter includes a design. Respondent does not sell furniture or any related product. Instead, Respondent is in the business of providing a service for creative professionals by allowing artists, photographers, graphic artists and similar professionals to share information relating to their services and creative endeavors. The UDRP, however, makes no distinction in the first required finding based on similarity or dissimilarity of products and services. Instead, “the test is confined to a consideration of the designated domain name and the trademarks.” Gateway, Inc. v Pixelera.com, Inc. WIPO Case No. D2000-0109. Although similarity of products or services would reinforce or corroborate a finding that a domain name is confusingly similar to a trademark, similarity of products or services is not essential. Domain names are registered without limitation as to products or services. I conclude that Respondent’s domain name, in addition to being identical with Complainant’s common law trademark, is confusingly similar to Complainant’s registered trademark. Respondent does not contest Complainant’s allegation in this regard.

RIGHTS AND LEGITIMATE INTERESTS:

UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that:

(a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;

(b) Respondent has been commonly known by the domain name; or

(c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent represents that it maintained a web site at designlink.com from in or about January 1994 through approximately 1998. Although the web site was then discontinued, Respondent has continued to use the domain
to provide e-mail service and bulletin board service to more than 300 registered users. Respondent's owner currently uses the e-mail address "ash@designlink.com."

On October 5, 1996, Respondent entered into an agreement with a third party which was using the mark Design Link in connection with a business related to Respondent's business. The agreement settled trademark litigation between Respondent and the third party, and further provided that Respondent and the third party would share the domain name designlink.com by providing an initial screen which would offer the user a choice between Respondent and the third party, and then transfer the user to the internet address/web page of the party selected. While it does not appear whether or not this arrangement was actually implemented between 1996 and 1998, the agreement provides that the third party would have the right to take over the designlink.com domain name in the event that Respondent failed to maintain the initial screen pursuant to the agreement. There is no indication that the third party has exercised this right. Although the third party had a federal service mark registration dated March 29, 1994 for the word mark DESIGN LINK, this registration was cancelled on April 28, 2001 for failure of the registrant to file an affidavit under Section 8. The failure to file this affidavit and the failure to exercise its right to take over the designlink.com domain name suggest that the third party is no longer interested in the domain name or the mark, but its rights are not before me in this proceeding.

Since Respondent has evidently made continuous bona fide use of the domain name, and currently uses the domain name as an e-mail address – even though not as a web site – I conclude that Respondent does have a right and a legitimate interest in the domain name. Pueblo International, Inc. v. Pueblo Technology Publishing, Nat. Arb. Forum Claim No. FA 00700095252.

BAD FAITH:

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation:

(i) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's costs;

(ii) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name;

(iii) registration for the primary purpose of disrupting the business of a competitor; or

(iv) an intentional attempt to attract, for commercial gain, internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location, or of a product or service on Respondent's web site or location.

It appears that Respondent registered the domain name designlink.com for bona fide business purposes in 1994. There is no indication that Respondent was then aware of Complainant's trademark usage of the term Design Link. Respondent used the domain both as a web site and as an e-mail address.

Complainant asserts that it has offered to purchase the domain, "but each offer is met with an extortionate request for money." Respondent, on the other hand, asserts that it "never asks for payment and is not interested in selling the domain name." Although I cannot resolve this factual dispute about a request for payment on the record presented, that question is not decisive here. Respondent would undoubtedly incur some burden and expense if it gave up its e-mail address and had to change the e-mail address books of 300 users of Respondent's service. Respondent understandably does not wish to follow that course.

Under these circumstances, I conclude that Respondent has not registered or used the domain name designlink.com in bad faith, as that term is defined in the UDRP. “It simply wants to continue using it as its e-mail
address and does not want to sell it. In the last analysis, it is first come, first served.” Pueblo International, supra.

CONCLUSION

In light of the findings above that Respondent does have rights or legitimate interests with respect to the domain name at issue and that Respondent has not registered or used the domain name in bad faith, I find in favor of Respondent.

REMEDY

Complainant's request to transfer the domain name designlink.com is hereby DENIED.