

Wikimedia Foundation Inc. v. Value Domain and Digirock, Inc.

Case No. D2009-0139

1. The Parties

The Complainant is Wikimedia Foundation Inc. of San Francisco, United States of America (“USA”), represented by The Gigalaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, USA.

The Respondents are Value Domain and Digirock, Inc., of Osaka, Japan.

2. The Domain Name and Registrar

The disputed domain name <visualwikipedia.com> (the “Domain Name”) is registered with eNom (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) by email on February 2, 2009, and in hard copy on February 6, 2009.

The Center transmitted its request for registrar verification to the Registrar by email on February 3, 2009. The Registrar replied the same day, stating that the Domain Name had been placed under a locked status to prevent transfers or changes during this proceeding; confirming that its registration agreement was in English and required the registrant to consent to the jurisdiction of the courts located in Kings County, Washington, USA; and providing the contact details in respect of the registrant of the Domain Name held on its Whois database.

On February 9, 2009, the Center asked the Registrar to clarify the identity of the registrant, since the information provided in its response to the Center’s verification request appeared to conflict with that obtained by the Center from the Registrar’s WhoIs database. The Registrar replied the same day, stating that due to a technical issue, the organization field did not show when its WhoIs database was accessed, but the full details on its internal database, i.e. the information in its reply to the Center’s verification request, should be regarded as authoritative.

The contact details provided by the Registrar to the Center in response to the verification request identified the registrant as “Digirock, Inc.”, with a first name “Value” and last name “Domain”. The Center provided this information to the Complainant and invited it to submit an appropriate amendment to the Complaint, which had identified the Respondent as “Value Domain”. The Complainant submitted an amendment to the Complaint adding Digirock, Inc., as a second Respondent by email on February 10, 2009, and in hard copy on February 16, 2009.

In the meanwhile, by email of February 7, 2009, a person identifying himself as Takayuki Hoshi forwarded an email of January 5, 2009, which he had written in response to a cease and

desist letter sent to the Respondent by the Complainant's representative. This correspondence had in fact been included in the annexes to the Complaint.

The Center verified that the Complaint together with the Amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), 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 paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 11, 2009. In accordance with paragraph 5(a) of the Rules, the due date for Response was March 3, 2009. The Respondent did not file any further Response in addition to its email of February 7, 2009.

The Center appointed Jonathan Turner as the sole panelist in this matter on March 10, 2009. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules. Having reviewed the file, the Panel is satisfied that the Complaint together with the Amendment to the Complaint complied with applicable formal requirements, was duly notified to the Respondent and has been submitted to a properly constituted Panel in accordance with the Policy, the Rules and the Supplemental Rules.

4. Factual Background

The Complainant is a non-profit, charitable organization dedicated to encouraging the development and distribution of free information. It operates the Wikipedia websites at "www.wikipedia.org" and "www.wikipedia.com". It has registered WIKIPEDIA as a trademark in many countries around the world from as early as January 2006.

The Domain Name was registered on November 19, 2007. At the date of the Complaint it resolved to a website which carried a banner with the text "VisualWikipedia *for knowledge lovers*" followed by a heading "Welcome to VisualWikipedia" and the following explanation: "VisualWikipedia is a visual, intuitive, and interactive web interface to encyclopedic knowledge/information. It is designed to provide a fun place to learn stuff in an efficient manner."

The Complainant's representative sent a cease and desist letter to the Respondent on December 29, 2008, demanding that the Respondent stop using the Domain Name and confirm that it would comply with any requests of the Complainant to transfer the Domain Name to it. A response to this letter was sent by T. Hoshi, apparently on behalf of the Respondent, on January 6, 2009.

The Domain Name has now been redirected to a website at "www.viswiki.com". The home page of this website has a banner containing the text: "VisWiki.com *all new VisualWikipedia*" followed by the heading "Welcome to VisWiki" and an explanation "VisualWikipedia.com has recently been renamed to VisWiki.com! /You can think of it as a shorter form of its previous name ..."

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its registered trademark WIKIPEDIA, pointing out that the Domain Name wholly incorporates this mark together with a descriptive word and the top-level domain name suffix which should be disregarded.

The Complainant submits that the Respondents have no rights or legitimate interests in the Domain Name, stating that it has not authorized them to use its mark, that they have not used or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services, that they are not commonly known by the Domain Name, and that they are not making legitimate noncommercial or fair use of it. The Complainant contends that the Respondents' use of the Domain Name for a website providing services directly competing with its own is not *bona fide*, legitimate or fair.

The Complainant further alleges that the Domain Name was registered and is being used in bad faith, in that the Respondents have intentionally attempted to attract Internet users to their website for commercial gain by creating a likelihood of confusion as the source, sponsorship, affiliation or endorsement of the Respondents' website or services. The Complainant also alleges that the Respondents registered the Domain Name to prevent the Complainant from reflecting its mark in a corresponding domain name.

The Complainant requests a decision that the Domain Name be transferred to it.

B. Respondent

Mr. Hoshi's email to the Complainant's representative of January 6, 2009 does not comply with the formal requirements for a Response. However, the Panel has decided to admit it, in the interest of avoiding any perception of unfairness to the Respondents, while taking into account the non-compliance with the Rules (and in particular the lack of certification of its completeness and accuracy) in assessing the weight to be attached to it.

Mr. Hoshi states that he admires the Complainant and its work and that he tried to do similar, but more accessible work, with "VisualWikipedia", which he solely owns and operates. He says that it is not a commercial website and he has not profited at all from it. He points out that every page of the website has an explicit non-affiliation notice, which he has clarified in response to the Complainant's representative's letter. He adds that the design of VisualWikipedia is very different from that of WIKIPEDIA. He says that when he registered the Domain Name, he believed the use of "Wikipedia" in it to be fair use or otherwise lawful.

He denies that the UDRP applies on the grounds that he is not using the Domain Name in bad faith and that it is not confusingly similar to the Complainant's mark.

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, in order to succeed in this proceeding, the Complainant must prove (i) that the Domain Name is identical or confusingly similar to a mark in which it has rights; and (ii) that the Respondents have no rights or legitimate interests in respect of the Domain Name; and (iii) that the Domain Name has been registered and is being used in bad faith. These requirements will be considered in turn.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has registered rights in the mark WIKIPEDIA.

The Panel further finds that the Domain Name is confusingly similar to this mark, from which it differs only in the addition of the descriptive word “visual” and the generic top-level domain suffix. The Panel considers that many Internet users would suppose that the Domain Name locates a website of or connected to the Complainant providing encyclopedic content in a visual format.

The possibility that Internet users might be disabused by disclaimers on accessing the Respondents’ website is irrelevant. In accordance with the terms of the UDRP and many cases decided under it, the comparison to be made under this first requirement is between the Domain Name and the Complainant’s mark. The assessment of this issue is not affected by the content of a respondent’s website. Indeed, the UDRP contemplates that domain names may be registered and used in bad faith, even where Internet users visiting a respondent’s website rapidly appreciate that it is not operated by or with the consent of the Complainant: see e.g. *Lilly ICOS LLC v. Brian Focker*, [WIPO Case No. D2005-0729](#); *ACCOR v. Mr. Young Gyoon Nah*, [WIPO Case No. D2004-0681](#); and *Bass Hotels & Resorts, Inc. v. Mike Rodgerall*, [WIPO Case No. D2000-0568](#).

The first requirement of the UDRP is satisfied.

B. Rights or Legitimate Interests

The Panel considers that the Respondents have not used or made preparations to use the Domain Name or a corresponding name in connection with a *bona fide* offering of goods or services. Nor are they making legitimate or fair use of the Domain Name. On the contrary, the Panel finds that the Respondents have used and are using the Domain Name to divert Internet users to their competing website by confusion with the Complainant’s mark. Such use is not in good faith or legitimate or fair, and does not give rise to rights or legitimate interests within the meaning of the UDRP: see *Mentor ADI Recruitment Ltd (trading as Mentor Group) v. Teaching Driving Ltd*, [WIPO Case No. D2003-0654](#).

The Panel further finds on the evidence that the Respondents have not been commonly known by the Domain Name and that there is no other basis on which the Respondents can claim to have rights or legitimate interests in respect of the Domain Name.

The second requirement of the UDRP is satisfied.

C. Registered and Used in Bad Faith

The Panel finds that the Domain Name was registered and is being used in order to attract Internet users to the Respondents’ competing website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of their website or service.

Even if the Respondents derive no immediate financial benefit from their website, they are still taking unfair advantage of the reputation of the Complainant’s mark to divert Internet users to their website through confusion. In the Panel’s view, such use of a domain name and

its registration with intent to use it in this way are and were in bad faith within the meaning of the UDRP: see e.g. *Google Inc. v. Jeltos Consulting/N. Tea Pty Ltd.*, [WIPO Case No. D2008-0994](#).

The Panel concludes that the third requirement of the UDRP is satisfied.

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 Name, <visualwikipedia.com>, be transferred to the Complainant.

Jonathan Turner
Sole Panelist

Dated: March 12, 2009