

CPR Institute for Dispute Resolution

ADMINISTRATIVE PANEL DECISION

Under the ICANN Uniform Domain Name Dispute Resolution Policy

COMPLAINANT

XS, Inc.
2610 Wycliff Drive, Suite 402
Raleigh, NC 27607

Phone: 919-327-9521
Fax: 919-327-9621

Email: smcfarland@xsinc.com

vs.

File Number: CPR0001

Date of
Commencement: June 13, 2000

Domain
Name: **excessag.com**

Registrar: Network Solutions, Inc.

Arbitrator: Sandra A. Sellers

RESPONDENT

World Wide Web Marketplace, Inc.
5200 NW 43rd St., Suite 102-317
Gainesville, FL 32606
Phone: 352-380-0339
Fax: 352-380-0779
Email: dab@mindspring.com

Before Sandra A. Sellers, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on June 9, 2000 and, after review for administrative compliance, transferred to the respondent on June 13, 2000. The Respondent did file a Response on or before July 3, 2000. 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 consideration of the written submitted record including the Complaint (including Attachments A through II) and the Response (including Exhibits 1 through 5), I find as follows:

FINDINGS

Respondent's registered domain name, **excessag.com**, was registered with Network Solutions, Inc. on January 24, 2000. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to

the UDRP.

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

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

THE PARTIES' TRADEMARKS AND DOMAIN NAMES

The Complainant's Service Mark and Domain Name

According to XS, Inc.'s pending US service mark application, "**XS Ag**" has been used since January 1999 for online trading and auction services featuring agricultural products, seed and chemicals; providing information regarding agricultural products, seed and chemicals; and online trading services in which seller posts items to be auctioned and bidding is done electronically all via a global computer network. XS, Inc. also has adopted the service marks "XS" and "XSChem" in connection with its web-based auction services for the sale of products in the agricultural field.

XS, Inc. registered **xsag.com** with Network Solutions, Inc. on June 2, 1999. The domain name **xsag.com** reverts to XS, Inc.'s website. XS, Inc. also has registered the domain names **xsinc.com** and **xschem.com**, which also revert to the xsag.com web site. The home page of xsag.com depicts a triangular picture of a farm, under which appears the following text:

XSAg.com
Buy and sell agricultural chemicals, seeds, parts, and
equipment at XSAg with web auctions, fixed price, and
"name your price" listings!

The bottom of the home page also indicates that XSAg.com is a service mark of XS, Inc.

The Respondent's Service Mark and Domain Name

Respondent registered **excessag.com** with Network Solutions, Inc. on January 24, 2000. Respondent also registered excesschem.com, excessfruit.com, excessgrain.com, excesscrop.com and excessfarm.com on March 9, 2000.

On March 15, 2000, Excess Ag, Inc., which has the same address as Respondent, filed a US service mark application for computer services, namely, providing a database regarding agriculture products and services via an online electronic communication network. The application states that the mark was first used on March 13, 2000.

A printout of Respondent's home page, <http://www.excessag.com/>, is attached to this decision. It states, in part, that "you will find agriculture information and products that will keep you growing. We also offer you a way to list your excess chemicals, agriculture products, crops, and equipment absolutely FREE." The web site lists ten categories of product advertisements; however, not a single product was listed for sale or purchase when this site was visited by this Arbitrator. Otherwise, the website contains only an E-Mall Shopping Online page, which has links to nineteen retailers of general consumer goods and services (see <http://www.excessag.com/Shopping/Shopping.asp>, which also is attached to this decision.)

IDENTITY/CONFUSING SIMILARITY

Complainant alleges that **excessag.com** is identical or confusingly similar to Complainant's service mark, **XSag**, in which the Complainant has rights.

First, I find that XS, Inc. has common law rights to the service mark, XSag. Complainant has been using the XSag mark since January 1999. It registered the domain name xsag.com in June 1999. Press clippings attached to the complaint show that the mark and its associated services have received extensive publicity.

UDRP 4(a) (i) does not require that Complainant hold a registration for a trademark or service mark; it requires only that the Complainant has rights in the mark that is identical or confusingly similar to the disputed domain name. Therefore, it does not matter whether or when the Complainant applied for registration of the XSag service mark.

Second, I find that Complainant's service mark, XSag, and its domain name, xsag.com, are homophonically identical or confusingly similar to Respondent's domain name, excessag.com. "XSag" and "Excess Ag" are identical in pronunciation. Furthermore, searches on various Internet search engines for one of these marks yields results reflecting the other mark.

Finally, it is important to note that the parties' homophonically identical marks are for services that are directly competitive, which is likely to cause confusion. Both parties have service mark applications pending before the US Patent and Trademark Office for services related to online listing and trading of agricultural products and chemicals. The home pages of both parties' web sites mention auctions, listing or purchase and sale of agricultural chemicals, products, and equipment.

I therefore conclude that the registered domain name is homophonically identical or confusingly similar to Complainant's protected mark.

RIGHTS AND LEGITIMATE INTERESTS

Complainant alleges that Respondent has no rights or legitimate interest with respect to the domain name at issue. In support for this allegation, Complainant notes that Complainant was the first to use its XSag service mark and xsag.com domain name, and that Respondent knew of Complainant's business before registering excessag.com or applying for registration of the Excess Ag service mark. Respondent, on the other hand,

notes that it has shown evidence of use or demonstrable preparations to use the mark prior to receiving Complainant's cease and desist letter. However, Respondent admits that it knew of Complainant's business at some time before registering the excessag.com domain name on January 24, 2000.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by (a) before notice to Respondent of the dispute, Respondent's use of, or 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; or (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.

Based on its admission (Boudreau Affidavit ¶ 14), I find that Respondent knew of Complainant's XSag service mark and xsag.com domain name before January 24, 2000. This knowledge was obtained prior to Respondent's registration of the excessag.com domain name (January 24, 2000), prior to Respondent's use of the Excess Ag service mark (March 13, 2000), and prior to Excess Ag, Inc.'s application for a US service mark for Excess Ag (March 15, 2000). Respondent clearly was the "second comer" to use of a mark homophonically identical to Complainant's mark.

Furthermore, Respondent appears to have no legitimate interest in using the mark. First, Respondent recites its efforts to use or prepare to use the disputed domain name prior to receipt of Complainant's cease and desist letter on April 7, 2000. However, its expenses appear to include only registration of the domain name, application for the service mark, incorporation of Excess Ag, Inc., and payment for development of the excessag.com web site. Respondent's expenses are minimal, at least compared to the millions of dollars spent by Complainant on its online services. Second, from visiting Respondent's web site, it appears that Respondent's primary efforts have been expended on developing its E-Mall Shopping page, from which Respondent gets revenue if site visitors click through to the retailers' sites. Finally and most persuasive, no ads appear on the excessag.com website, despite its purported purpose of showcasing advertisements of excess agricultural products.

I therefore conclude that Respondent does not have rights or legitimate interest with respect to the domain name at issue.

BAD FAITH

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) 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.

I find that Respondent registered the domain name in bad faith. Respondent admits that it knew of Complainant's business prior to registration of Respondent's excessag.com domain name or any use of Respondent's Excess Ag mark. Respondent could have chosen a different domain name and mark to reflect its services, before expending any resources on registration of a domain name or service mark, but chose not to do so. For example, Respondent may have chosen "surplusag" instead of "excessag", and still have conveyed the same concept. Furthermore, Respondent continued to use the domain name even after receiving Complainant's cease and desist letter, and refused Complainant's demand to transfer the domain name to Complainant.

Additionally, Respondent clearly uses the confusingly similar domain name to attract Internet users to Respondent's site for commercial gain. The only active part of Respondent's site is the electronic shopping mall, which has links to nineteen retailers of general consumer goods and services. Respondent will receive a reward for customers who clicks through to the commercial retailers' sites.

I therefore conclude that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of my findings above that (a) the registered domain name is homophonically identical or confusingly similar to Complainant's protected mark; (b) Respondent does not have rights or legitimate interest with respect to the domain name at issue; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

REMEDY

Complainant's request to transfer the domain name **excessag.com** is hereby GRANTED. The domain name shall be transferred to Complainant XS, Inc.

Sandra A. Sellers, Panelist

Dated: July 18, 2000
McLean, VA, USA

Attachments: printouts of

<http://www.excessag.com/>
<http://www.excessag.com/Shopping/Shopping.asp>