



CPR Institute for Dispute Resolution

COMPLAINANTS

Dow Jones & Company, Inc
200 Liberty Street,
New York, New York 10281;

Dow Jones, L.P.,
84 Second Avenue,
Chicopee, Massachusetts;

and

Review Publishing Company,
Inc.,
Citicorp Center,
18 Whitfield Road, Causeway
Bay, Hong Kong.

(hereafter collectively, "Dow
Jones")

File Number: CPR002

Date of Commencement: July 10, 2000

Domain Names: "theasianwallstreetjournal.com"
and
"fareasterneconomicreview.com"

Registrar: Alabanza, Inc., d/b/a
"Bulkregister.com,"
and
Internet Domain Registrars, d/b/a,
"Registrars.com,"
respectively

Arbitrator: James P. O'Shaughnessy

vs.

RESPONDENT

Allied Pacific Singapore
Technologies Pte Ltd.,
541 Orchard Rd.,
#10-01 Liat Towers,
Singapore 238881,
telephone number 65-887-
0880,
fax number 65-887-0700,
e-mail
address [admin@alliedpacific.c
om.sg](mailto:admin@alliedpacific.com.sg).

(hereafter "APST")

Before James P. O'Shaughnessy, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on June 30, 2000 and, after review for administrative compliance, was served on the Respondent on July 10, 2000. The Respondent filed a Response on or about July 29, 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 the written submitted record including the Complaint, along with attachments A through V thereto, the Response, a string of e-mail communications between the Parties and CPR, and my personal review of the Respondent's website (as recounted below), I find as follows:

FINDINGS

Respondent's registered domain name, "fareasterneconomicreview.com", was registered with Registrars.com on January 13, 2000. Complaint, ¶ 29; Exhibit B. Respondent's registered domain name, "theasianwallstreetjournal.com", was registered with BulkRegister.com on February 13, 2000. Complaint, ¶ 32; Exhibit A. Both registration agencies require their registrants to submit to this forum to resolve any dispute concerning their domain names, 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' MARKS AND BUSINESSES:

Dow Jones is a publisher. Its publications include, among others, *The Wall Street Journal*, *The Asian Wall Street Journal*, and *The Far Eastern Economic Review*. Dow Jones alleges, and APST does not contest, that these print publications provide business, financial and other news and information to millions of readers each business day. Complaint, ¶ 11.

Dow Jones is the proprietor of trademarks covering each of the foregoing publications. Pertinent to these proceedings, Dow Jones has secured trademark registrations for each of the marks THE ASIAN WALL STREET JOURNAL and FAR EASTERN ECONOMIC REVIEW.

The mark, THE ASIAN WALL STREET JOURNAL, is the subject of at least one incontestable United States Trademark Registration, Registration No. 1,083,954, as well as registrations throughout several countries in Asia, including Singapore Registration No. 69058, first issued on September 15, 1976. The record shows these registrations to be in full force and effect. Dow Jones has also established an Internet presence under this mark, having registered the domain name "asianwallstreetjournal", with both ".com" and ".org" designations, and the corresponding acronym domain name, "awsj.com". Websites under these domain names are linked to and through Dow Jones's www.dowjones.com and www.interactive.wsj.com. Complaint, ¶s 12-19; Exhibits C-F, H.

The mark, FAR EASTERN ECONOMIC REVIEW, is likewise the subject of several trademark registrations. These include, among others in North America and Asia, United States Registration No. 2,256,653 and Singapore Registration No. T94/07309E. Dow Jones has registered the domain name "feer.com", the commonly known acronym for this publication. Complaint, ¶¶ 20-27; Exhibits J-L.

Dow Jones alleges that it has expended substantial sums over a long period of time to advertise and promote its publications, *The Asian Wall Street Journal* and *Far Eastern Economic Review*. Dow Jones further alleges that the effect of this history of advertising and promotion has been to create in the minds of the consuming public a strong association between the subject trademarks and the goods and services offered by Dow Jones. Complaint, ¶¶ 17, 25. APST does not contest these allegations and I take them as proven.

APST operates a website at www.marketplay.com.sg. Its homepage is illustrated in Exhibit N to the Complaint. I studied the content of this website as it appeared to any member of the public who would have accessed it on August 7, 2000.

APST advertises MarketPlay as a website for investors to hedge the rise or fall of major financial indices, including the Dow Jones Industrial Average, the NASDAQ Composite, the S&P 500 Index, among others. Complaint, ¶ 28. One may join the membership of MarketPlay by tendering a credit card account on which funds may be drawn. Members then "hedge" fluctuations in these capital markets by placing an amount of money at stake depending on specific point variations in a selected index. Odds are quoted for the chosen variation. For example, recently quoted odds for a fall in the DJIA within the range of 150.01 to 200.00 points ("Sector 14") were 8:1. Thus, according to the information published on APST's MarketPlay website, a member with a stock portfolio influenced by a fall in the DJIA could hedge against such a fall by risking a correlated amount in a chosen sector with odds reflecting what that member believes is likely to happen.

One may readily conclude, after studying the MarketPlay website, that its structure is more suited for wagering than hedging. Nevertheless, APST holds MarketPlay out as a site where savvy investors may balance capital market risks they face in their stock portfolios. Thus, APST would strive to appeal to a customer base familiar with business and financial markets, along with popular publications reporting on them.

Having secured domain name registrations for the two disputed Internet addresses, APST has hyperlinked those websites to its MarketPlay website. Complaint, ¶¶ 29, 32. At the outset of this dispute between the Parties, one logging on to the Internet using either of the two disputed addresses would automatically have been linked to Respondent's MarketPlay site. While this dispute has been maturing, APST has at least sporadically if not permanently disabled the automatic link between the addresses corresponding to the disputed domain names and its MarketPlay site. Complaint, ¶¶ 34-35; Response at 1.

IDENTITY/CONFUSING SIMILARITY: Dow Jones alleges that the domain name "theasianwallstreetjournal.com" is identical or confusingly similar to Complainants' trademark, THE ASIAN WALL STREET JOURNAL, which applies to daily newspapers and other printed publications

on finance. Dow Jones also alleges that the domain name, “fareasterneconomicreview.com”, is identical or confusingly similar to Complainants’ trademark, FAR EASTERN ECONOMIC REVIEW, which applies to publications concerning business, financial and general news. Complaint, ¶s 37-38.

A simple comparison of the disputed domain names and the registered trademarks shows them to be identical. Respondent, APST, has simply “dot commed” Complainant’s registered trademarks and converted them into Internet addresses.

The names are used in the same or collateral channels of commerce. This factor exacerbates the likelihood of confusion. In addition to any likelihood of confusion over the source of the Parties’ respective goods and services, a consumer of these goods or services could be led to conclude that Complainants authorize, sanction or otherwise are associated or affiliated with Respondent’s website and the so-called hedging services it provides. Indeed, from the totality of the record, I find that this is the primary reason Respondent appropriated these trademarks as its domain names. The inference is inescapable from the record that Respondent attempts to divert Internet traffic to its MarketPlay website by appropriating Complainants’ trademarks as Respondent’s Internet addresses, only to direct those who initially log on to those sites from them to Respondent’s MarketPlay site. When one attempts to create confusion as to source or affiliation, it is permissible for the factfinder to conclude that the attempt is successful. This is an independent ground for my conclusion on the issues of similarity and likelihood of confusion.

I therefore conclude that the registered domain name, “theasianwallstreetjournal.com”, is identical or confusingly similar to Complainants’ protected mark, THE ASIAN WALL STREET JOURNAL. I further conclude that the registered domain name, “fareasterneconomicreview.com”, is identical or confusingly similar to Complainants’ protected mark, FAR EASTERN ECONOMIC REVIEW.

RIGHTS AND LEGITIMATE INTERESTS: Complainants allege that Respondent has no right or legitimate interest with respect to the domain names at issue. In support of this allegation, Complainants demonstrate that they hold exclusive rights to the trademarks underlying the disputed domain names and aver that they have not granted to Respondent any rights to use such trademarks. They further allege that Respondent has no relationship with Dow Jones that would authorize Respondent’s use of these trademarks as the basis for the disputed domain names. Complainants also allege that Respondent’s use of the disputed domain names is not a *bona fide* use, particularly insofar as the use made by Respondent is primarily if not exclusively to link interested Internet traffic from those sites to Respondent’s commercial site, MarketPlay, using consumers’ awareness of Complainants’ trademarks as the vehicle for doing so. Complaint, ¶s 39-43.

Respondent, on the other hand, asserts that its interests are legitimate. Respondent offers two, closely related reasons. First, Respondent says, Dow Jones had not elected to secure the disputed domain names for itself until Respondent “proudly elected to display their [Complainants’] logo free of charge.” Next, Respondent asserts that Complainants themselves had failed to make any fair or legitimate use of these same domain names, having allowed them “to have laid dormant until recently . . .” Response at 2.

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.

The present record reveals no evidence favorable to Respondent's claim that its use of the disputed domain names is legitimate. Respondent offers no evidence that it commenced its use or preparations for use of the disputed domain names before receiving notice from Complainants of their objections. Respondent offers no evidence of any association between its trade identity and either of the disputed domain names. Respondent offers no argument, let alone evidence, that its use of the disputed domain names in any way amounts to fair use.

Indeed, all of the evidence of record points directly to the contrary. Respondent's criticism of Complainants, for having allowed these domain names to "have laid dormant," does not suffice for evidence of Respondent's legitimate appropriation of them. In fact, common experience shows us that most companies have rights that routinely lay dormant, to use the Respondent's jargon. A large company with a significant asset base is likely to have a great number of dormant or latent rights. This is especially true when the asset base has a substantial intangible asset component. It is routine for a company, almost of any size, to have vastly more opportunities it might wish to seize than resources available to pursue them. In exactly this sense, those opportunities and the associated rights and assets, whether tangible or intangible, lie dormant until the company—their owner—chooses to convert or extract the latent value they represent.

Respondent confuses dormancy of the latent value of an asset, such as the transformation of trademark rights into domain name rights, with abandonment of either the asset or the rights in respect of it. There is no doubt on the present record that Complainants have never abandoned any right in respect of the trademarks underlying the disputed domain names. The mere fact that Complainants had not, prior to Respondent, transformed the value those trademarks represented when used as these domain names, in no way permits Respondent to appropriate those values to itself.

I therefore conclude that Respondent does not have any right or legitimate interest with respect to either of the domain names at issue.

BAD FAITH: In support of the contention of Respondent's bad faith registration and use, Complainants state the obvious. They say that Respondent has intentionally adopted domain names based on Complainants' famous trademarks for the purposes of creating confusion and diverting Internet traffic to Respondent's MarketPlay site. Complaint, ¶¶ 45-52. The absence of any legitimate interest, in the view of Complainants, is evidence of bad faith. Complainants characterize APST as a "cybersquatter" and rely on precedent addressing that issue in a manner favorable to Complainants' legal position here.

Respondent's Response in these proceedings, brief as it is, focuses mostly on this issue—bad faith—as if the absence of bad faith somehow would sanction its actions. Respondent raises five issues under this banner. Response at 1-2.

Respondent asserts, at least inferentially, that Complainants must prove bad faith "beyond doubt." The ICANN Rules are silent on the burden of proof to be applied in these proceedings. As for matters of evidence, ICANN Rule 10 (d) states that the Panel shall determine admissibility, relevance, materiality

and weight. I apply here the civil law burden of proof by a preponderance of the evidence. There is no sound reason to insist on the higher civil burden of clear and convincing evidence and I reject out of hand Respondent's suggestion that a "beyond doubt" or, more properly, "beyond reasonable doubt" standard should apply.

Respondent attempts to couch its actions as permissible by describing its activities as those of a "fan club." Respondent apparently believes that by casting its actions as those of a "fan club site" it can recast its behavior as proper or, at the least, as behavior lacking bad faith. However, the record belies respondent's reliance on this characterization. For example, in correspondence between APST and Complainants' attorneys, Respondent said:

Whilst the domain name [fareastereconomicreview.com] may bear some resemblance at first glance to your clients' trademark, this, in all respects, does not entitle your clients to demand that we transfer our legitimate rights to the domain name to your clients . . .

Complaint, Exhibit Q. Such a statement does not square with the position that Respondent operates a "fan club" for Dow Jones. Moreover, the absence of any content on Respondent's website, other than a banner proclaiming that

We strongly support the following:

followed by Complainants' logo for the Far Eastern Economic Review, is inconsistent with what would normally be expected of a fan club. Thus, on this record, I reject Respondent's argument that its operation of websites under the disputed domain names is in any way sanctioned as a fan club and, even if true, that it would counter Complainants' evidence of Respondent's bad faith.

Respondent attempts to counter the allegations of bad faith by reliance on its decision to remove Complainants' logo from Respondent's website when Complainants demanded that action. I find this argument no better than ambiguous evidence of Respondent's true intentions. Once again, it does not suffice for a demonstration of good faith or, more importantly to these proceedings, the absence of bad faith.

APST raises two arguments concerning its decision to hyperlink its MarketPlay site from the sites operated under the disputed domain names. The first is difficult to understand. I interpret Respondent's position to be that it is premature to decide the propriety of its behavior until there is a dispositive ruling on an unrelated claim of British Telecom over patents on Internet hyperlinking.* I disagree. Respondent's second point is equally meritless—APST argues that I should liken this situation to the purchase of a newspaper, where the purchaser's interest is animated only by what is seen on the front page. Thus, according to Respondent, it is permissible to hyperlink as it does because one is no more "aware of what lies beyond the initial hyperlink click" as one would be aware of the content of a newspaper simply looking at the front page.

Like most faulty syllogisms, preposterous conclusions follow from patently absurd premises. I reject Respondent's arguments that its hyperlinking activities show an absence of bad faith.

* British Telecom holds certain patent rights it believes to cover the use of hyperlinks in Internet communications. That company is pursuing its own licensing and enforcement program. Those actions have absolutely no bearing on any issue in this arbitration.

Respondent's final attempt to cleanse its behavior is once again rooted in illogic. Respondent relies on the alleged legitimacy of its actions to demonstrate its good faith in undertaking them. Legitimacy in Respondent's view is predicated on its obtaining registrations for the disputed domain names from accredited ICANN registrars in the first place. Thus, so the argument goes, the decisions to award the registration of the disputed domain names to Respondent is proof in itself that the registrations embody legitimate interests, the antithesis of bad faith. I reject Respondent's circular reasoning.

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 am sympathetic to Complainants' position as they attempt to adduce evidence of "bad faith." Like intent, it is an element more readily seen on a record than proven by reference to specific evidence contained within it. On the contrary, Respondent's failure to offer any meaningful explanation for its decision to adopt these domain names stands in stark contrast to the inferences to be drawn from those actions. Based on the totality of the record before me, I find that Respondent has secured the disputed domain names and operated websites under them primarily if not exclusively as an intentional attempt to attract, for commercial gain, Internet users to Respondent's MarketPlay website by creating a likelihood of confusion with Complainants' marks as to the source, sponsorship, affiliation or endorsement of Respondent's website or location, or of a product or service on Respondent's website or location.

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

CONCLUSION

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

REMEDY

Complainants' request to transfer the domain names, "the asianwallstreetjournal.com" and "fareasterneconomicreview.com" is hereby GRANTED. The domain name, "the asianwallstreetjournal.com" shall be transferred to Complainant Dow Jones & Co., owner of the corresponding domain name "asianwallstreetjournal.com", whereas the domain name, "fareasterneconomicreview.com", shall be transferred to Complainant Review Publishing Co., owner of the corresponding domain name, "feer.com".

Signature of Arbitrator

Date