



CPR Institute for Dispute Resolution

File Number: CPR 0502
Date of Commencement: January 13, 2005
Domain Name: MOSDEF.COM
Registrar: Network Solutions, LLC

COMPLAINANT

Name: Dante Smith (p/k/a Mos Def)
Address: c/o Frankfurt Kurnit Klein & Selz, P.C., 488 Madison Avenue, New York, NY
10019
Tel: 212-826-5597
Fax: 212-593-9175
E-mail: jvoutsinas@fkks.com

vs.

RESPONDENT

Name: Mosdef
Address: 717 South Mill Avenue, Suite 316, Tempe, AZ 85281
Telephone: 602-829-8982
Fax: N/A
E-mail: mosdef@concentric.net

Before Thomas M. Pitegoff, Esq., Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR Institute for Dispute Resolution (CPR) on January 13, 2005. After review for administrative compliance, CPR served the Complaint on Respondent. On February 7, 2005, CPR notified Respondent that Respondent failed to file a timely Response. On February 15, 2005, CPR appointed me as Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (UDRP) and the Rules for UDRP (the "Rules") promulgated by the Internet Corporation for Domain Names and Numbers (ICANN).

ICANN Rule 5(e) states "If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint."

Upon the written submitted record including the Complaint and its attachments, I find as follows:

FINDINGS

Respondent's domain name, MOSDEF.COM, was registered with Network Solutions, LLC, on November 2, 1997. In registering the name with Network Solutions, LLC, an ICANN accredited registrar, Respondent agreed to submit to this forum to resolve any dispute concerning the 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 Complainant 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.

IDENTITY/CONFUSING SIMILARITY

UDRP Paragraph 4(a)(i) calls for a finding that Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

Complainant is a world-famous actor and rap musician. He has used the "Mos Def" mark in connection with his career as an entertainer since at least as early as 1994. He has released four albums of recorded music, the latest of which, called *The New Danger*, was released October 12, 2004, and reached number 2 on Billboard's Top R&B/Hip Hop Album chart and number 5 on Billboard's Album Chart. He was a guest artist on more than twenty albums. He has appeared in motion picture films such as "The Italian Job," "Brown Sugar" and "Monster's Ball". He appeared on Broadway in 2002 in the Tony nominated, Pulitzer Prize-winning "Topdog/Underdog" and played the lead role in the London production of the same play. He was awarded an Obie in 2003 for his work in an off-Broadway play.

While Complainant has not yet obtained a trademark registration for his name, his fame as a rap artist and actor establishes the kind of reputation that warrants protection against passing off. Complainant alleges that he has used the "Most Def" mark continuously, exclusively and extensively in connection with entertainment services throughout the United States and other countries since at least as early as 1994.

Accordingly, I conclude that the registered domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

RIGHTS AND LEGITIMATE INTERESTS

Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue.

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; 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 trademark MOSDEF is registered in Respondent's name with the United States Patent and Trademark Office for clothing (claiming a date of first use of 1996) and entertainment services (claiming a date of first use of 1995). Complainant has instituted proceedings in the United States Patent and Trademark Office to cancel Respondent's registrations. I do not have access to the pleadings in the cancellation proceeding, and I do not know how the United States Patent and Trademark Office will rule in that proceeding. I must reach a decision solely on the basis of the Complaint. Under Section 15 of the Rules, "A Panel shall decide a complaint on the basis of the statements and documents submitted"

Complainant alleges that Complainant's use of the MOS DEF trademark preceded Respondent's use and that Respondent therefore has no right to use the MOS DEF trademark. Complainant also states that the domain name in dispute does not currently display website content, but that it did at one time. The fact that the domain name does not point to a website may imply that Respondent has ceased doing whatever business Respondent may have been doing under the MOS-DEF trademark, possibly out of concern that Complainant's rights may be superior to those of Respondent.

In the absence of a response, I conclude that Respondent does not have rights or legitimate interests with respect to the domain name at issue.

BAD FAITH

Complainant alleges that Respondent's domain name has been registered and is being used in 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 at-

tract, 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.

Complainant contends that Respondent cannot provide a legitimate reasonable explanation for the selection of MOSDEF.COM as a domain name or as a trademark. MOS DEF or MOSDEF does not appear in any dictionary and is not the name of Respondent. A search on the OneLook Dictionary Search website yields one reference to "Mos Def" on the Wikipedia online encyclopedia as the Complainant, "Brooklyn-born rapper and actor". Accordingly, the only legitimate use of the domain name is to refer to Complainant or his services. Thus, the only possible explanation for Respondent's selection of MOSDEF.COM as a domain name is to attract for commercial gain Internet users to Respondent's web site by trading on the fame of Complainant's mark.

Complainant alleges that this constitutes a deliberate attempt to trade off of Complainant's reputation. Respondent has used his website to sell infringing merchandise bearing the infringing mark. The "frequently asked questions" page of Respondent's site (which was taken down after Respondent received correspondence from Complainant's attorney) promoted this confusion. The fact that Respondent removed the website implies that Respondent has been using the disputed domain name in bad faith.

Complainant alleges that Respondent's website was nothing more than an effort by Respondent to promote his clothing line that bears an infringing mark by creating confusion as to his association or involvement with Complainant. This constitutes "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."

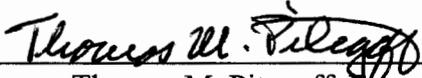
I therefore conclude that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of the findings above that (a) the registered domain name is identical or confusingly similar to Complainant's protected mark; (b) Respondent does not have rights or legitimate interests 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 Complainant.

REMEDY

Complainant's request to transfer the domain name MOSDEF.COM is hereby GRANTED. The domain name shall be transferred to Complainant.



Thomas M. Pitegoff, Esq.

February 24, 2005

Date