

ADMINISTRATIVE PANEL DECISION

Walk the Walk Worldwide v. Name Administration Inc. (BVI)

Case No. D2013-0731

1. The Parties

The Complainant is Walk the Walk Worldwide of London, United Kingdom of Great Britain and Northern Ireland (“United Kingdom”), represented by Wallace LLP, United Kingdom.

The Respondent is Name Administration Inc. (BVI) of Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom, represented by John Berryhill, Ph.d., Esq., United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <walkthewalk.com> (the “Domain Name”) is registered with iRegistry Corp. (fka) Domain Name Sales Corp. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2013. On April 23, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 25, 2013, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced May 2, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was May 22, 2013. The Response was filed with the Center on May 23, 2013.

The Center appointed Steven A. Maier, Ian Lowe and the Hon Neil Brown Q.C. as panelists in this matter on June 11, 2013. The Panel finds that it was properly constituted. Each member of the Panel has submitted

the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a company limited by guarantee which was incorporated in Scotland on November 1, 1999. It is also a charity registered in Scotland. It is engaged in particular in fundraising connected with breast cancer.

The Complainant is (or was) the owner of trademark registrations in numerous jurisdictions which comprise or include the term "walk the walk". The registrations include the following:

- (1) Community Trade Mark number 2126332 for the words "WALK the WALK" together with a footprint logo registered with effect from March 12, 2001 in International Classes 9, 14, 16, 25, 36 and 41. The trademark expired on March 12, 2011.
- (2) United States trademark number 2850096 for the words "WALK the WALK" together with a footprint logo registered with effect from September 26, 2001 in International Classes 9, 14, 16, 25, 36 and 41. The registrations in Classes 9, 14 and 41 were subsequently cancelled, as were a number of the categories of goods and services in the remaining classes.
- (3) Australian trademark number 885705 for the words "WALK the WALK" together with a footprint logo registered with effect from August 13, 2001 in International Classes 9, 14, 16, 25, 36 and 41. The trademark is currently expired.
- (4) Canadian trademark number TMA652437 for the words "WALK the WALK" together with a footprint logo registered with effect from on November 1, 2002 for various categories of goods and services.
- (5) Brazilian trademarks numbered 825949769, 825949777, 825949785, 825949793, 825949807 and 825949815 for the words "WALK the WALK" together with a footprint logo registered with effect in each case from October 13, 2003 in International Classes 14, 16, 25, 28, 36 and 41 respectively.
- (6) Singapore trademarks numbered T0519825C and T0519826A for the words "WALK the WALK" together with a footprint logo registered with effect from October 10, 2005 in International Classes 36 and 41 respectively.
- (7) United Kingdom trademark number 2390892 for WALK THE WALK registered with effect from April 30, 2005 in International Classes 9, 14, 16, 18, 25, 26, 28, 35, 36, 41, 42, 44 and 45.
- (8) Community Trade Mark number 5597471 for WALK THE WALK registered with effect from January 4, 2007 in International Classes 9, 14, 16, 18, 25, 28, 35, 36, 41, 42, 44, 45.
- (9) Canadian trademark number TMA779394 for WALK THE WALK registered with effect from January 9, 2007 for various categories of goods and services.
- (10) New Zealand trademark number 777701 for WALK THE WALK registered on July 10, 2008 with effect from October 15, 2007 in International Classes 9, 14, 16, 18, 25, 26, 28, 35, 36 and 41.
- (11) Australian trademark number 1211233 for WALK THE WALK registered with effect from November 21, 2007 in International Classes 9, 14, 16, 18, 25, 26, 28, 35, 36, 41, 42, 44 and 45.
- (12) Gibraltar trademark number 9847 for WALK THE WALK registered on August 8, 2008 in International Classes 9, 14, 16, 18, 25, 26, 28, 35, 36, 41, 42, 44 and 45.

The Complainant's above trademarks include, or included, registrations relating not only to charitable fundraising and organizing sporting events, but also to a number of categories of goods and services relating to sport, training, exercise, diet, fitness and health.

The Respondent is a corporation registered in the Cayman Islands. It registered the Domain Name on October 15, 2004.

At the date of the Center's formal compliance check, namely May 2, 2013, the Domain Name resolved to a website at "www.walkthewalk.com" which contained links to providers of goods and services relating to exercise, fitness, health and nutrition. The website also offered the Domain Name for sale.

5. Parties' Contentions

A. Complainant

The Complainant submits that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (paragraph 4(a)(i) of the Policy).

The Complainant provides evidence of the trademark registrations referred to above.

The Complainant states that it has used the name "Walk the Walk" since 1997, initially as an unincorporated charity. From 2001 until 2005, it registered trademarks for a device comprising the words "WALK the WALK" together with a footprint logo. However, from 2005 onwards it amended its filing strategy and registered trademarks for the words WALK THE WALK alone. Insofar as any of its earlier marks have expired, they have been replaced with the more recent marks.

The Complainant submits that the predominant part of the earlier marks, which were registered prior to the registration of the Domain Name, was the term "WALK the WALK". The Domain Name is identical to the predominant part of the earlier marks and identical to the more recent marks.

The Complainant states that while its main function is the funding of cancer research and the care of individuals with cancer and other illnesses, it raises money through walking activities, entering teams into marathons around the world and organising its own marathon activities in London, Edinburgh, Iceland and New York. As part of its activities it promotes health, fitness and wellbeing. It submits that by reason of these matters it has, since 1999, built up substantial goodwill in the name "Walk the Walk" in a number of countries and that the phrase "walk the walk" is closely associated with the Complainant.

The Complainant submits that while the phrase "You can talk the talk, but can you walk the walk?" is in general usage, the shorter phrase "walk the walk" is not generic. In relation to health and fitness, this phrase is only associated with the Complainant. The Respondent is using the Domain Name to link to providers of exercise, fitness and nutrition products, which adds to the confusion between the Domain Name and the Complainant's marks.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii) of the Policy).

The Complainant states that, so far as it is aware, the Respondent has never been known by the Domain Name, has not carried out any business using the Domain Name and is not making any legitimate noncommercial or fair use of the Domain Name.

The Complainant submits that the Respondent has used the Domain Name to resolve to a web page which offers the Domain Name for sale and provides sponsored links to providers of health-related products and services. It produces a print-out of a web page at "www.walkthewalk.com". The web page includes the statement "Click here to buy WalkTheWalk.com for your website name!" It includes links to numerous providers of products and services related to health, diet, weight loss, fitness, exercise and sport. The Complainant states that much of its fundraising is derived from organizing marathons and other healthy activities and that it appears that the Respondent is attempting to obtain commercial advantage by utilizing the Domain Name in respect of activities in which the Complainant not only has a trade mark but in which it has built significant goodwill.

The Complainant states that it understands that the Respondent's website previously contained links to pornography, although these now appear to have been removed.

The Complainant submits that the Domain Name was registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The Complainant submits that the Respondent registered the Domain Name in 2004, several years after the Complainant made its first trademark applications.

Furthermore, the Complainant states that the Respondent has never used the Domain Name in respect of any trade or commercial activities or made any other proper use of the name. While some organizations do use the phrase "walk the walk", there are none that do so without any embellishment as a corporate or trading name.

The Complainant states that in August 2012 it approached Domain Name Sales (being the organization to which the link on the Respondent's website connects) in an attempt to purchase the Domain Name. It produces an email from Maureen at Domain Name Sales to alastair@fasterfwd.com stating that "the seller informs us they would sell the domain to you for \$56,000 USD". The Complainant submits that this sum is considerably in excess of both the value of the Domain Name and the Respondent's out-of-pocket costs directly related to it.

The Complainant contends that, by including on its website sponsored links specifically related to health and wellbeing, being the key areas in which the Complainant operates, the Respondent is intentionally attempting to attract for commercial gain Internet users to its website, or to the locations connected with those sponsored links, by creating a likelihood of confusion with the Complainant's mark and brand.

The Complainant seeks a transfer of the Domain Name.

B. Respondent

The Respondent submits that this proceeding relates to a common expression that is used by a wide variety of parties including the Respondent and is neither exclusive to nor distinctive of the Complainant. The Domain Name was registered by the Respondent when it was abandoned by an aerobic fitness firm in 2004 and has been used for nine years for the sale of shoes and other goods related to walking, many of those years preceding the bulk of the Complainant's trademark registrations.

With regard to the Complainant's trademarks, the Respondent concedes that paragraph 4(a)(i) of the Policy involves a threshold consideration. However, the Respondent contends that many of the registrations on which the Complainant relies took effect only after registration of the Domain Name and can not therefore support any finding of bad faith. In particular, the Complainant had no registrations prior to the date of registration of the Domain Name others than those for its stylized logo. Furthermore, the Complainant's activities at that time related to entering teams in sporting events and it was only later that it recast itself as a merchant dealing in fitness wear.

The Respondent submits that the Complainant has failed to provide evidence of its actual use of its registered trademarks in connection with the numerous classes of goods and services claimed, and that, in connection with its United States trademark, the registration in three classes was cancelled as not supported by use. The claims stricken from that trademark registration included in particular footwear, underwear, undergarments, lingerie, vests, sweatshirts, shirts, pants, sweatpants, sweat tops, leggings, tracksuit bottoms, jogging pants, jackets, shorts, shoes, training shoes, hats, baseball caps, baseball hats, belts, gloves and socks. This factor contradicts any claim on the part of the Complainant to have used the trademark for goods of this nature since 2001 and points instead to its non-use for those goods.

The Respondent strongly disputes the Complainant's contention that the phrase "walk the walk" is not in common usage in its own right, *i.e.* that it is only commonly used in conjunction with the "You can talk the talk ..." component. The Respondent exhibits dictionary definitions of the phrase "walk the walk" including the meaning "to show that something is true or real through one's actions".

The Respondent also disputes any contention on the part of the Complainant that the phrase "walk the walk" is associated exclusively with the Complainant or with activities related to fitness. The Respondent states that the Complainant does not enjoy a monopoly in the phrase and cannot establish that no other party is

entitled to use it. The Respondent exhibits evidence of the use of the phrase in commerce in connection with footwear, walking, golf, bible studies, skate-wear, whisky and architecture, and also in connection with books on leadership and life coaching and in the title of a magazine article. The Respondent also exhibits evidence of United Kingdom and United States trademark registrations by third parties, for marks comprising or including the term "walk the walk" (without any "talk the talk" component) for various classes of goods and services including audit and financial services, education, IT design, fashion shows and architecture.

With regard to the issue of "rights or legitimate interests" the Respondent submits that these include the descriptive use of ordinary terms for advertising purposes. In the case of the phrase "walk the walk", any party including the Respondent is free to use the phrase otherwise than in connection with running charitable events and entering teams in foot races. The Respondent would, therefore, be free to use the phrase in connection with pornography, although it has not in fact done so as the Complainant wrongly suggests, and there is no evidence to support this scurrilous allegation. The Respondent has legitimately used the Domain Name, which uses the term "walk" twice, in connection with activities related to exercise and fitness, including walking.

The Respondent points to paragraph 2.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") which considers whether parking and landing pages or pay-per-click links generate rights or legitimate interests in the disputed domain name. This states:

"Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" [see also paragraph 3.8 below] or from "legitimate noncommercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder. As an example of such permissible use, where domain names consisting of dictionary or common words or phrases support posted PPC links genuinely related to the generic meaning of the domain name at issue, this may be permissible and indeed consistent with recognized sources of rights or legitimate interests under the UDRP, provided there is no capitalization on trademark value (a result that PPC page operators can achieve by suppressing PPC advertising related to the trademark value of the word or phrase). By contrast, where such links are based on trademark value, UDRP panels have tended to consider such practices generally as unfair use resulting in misleading diversion."

(Emphasis added by the Respondent.)

The Respondent refers to previous cases under the UDRP in which complaints against it have been unsuccessful, including *DataServ, L.L.C. v. Name Administration Inc. (BVI)*, WIPO Case No. D2012-1538, concerning the domain name <dataserv.com>; *Visa Europe Limited v. Name Administration Inc. (BVI)* WIPO Case No. D2010-1531 concerning the domain name <premiercard.net>; and *Manga Films, S.L. v. Name Administration, Inc.*, WIPO Case No. D2005-0730 concerning the domain name <mangafilms.com>. In each of these cases the Respondent was found to have used a domain name comprising descriptive or dictionary words without knowledge of, or any obvious intention to take advantage of, the relevant complainant's trademark.

In this case, the Respondent states that it is using the Domain Name in connection with links that relate to walking and fitness and that there is no reference on its website to charitable events, fundraising or the like. There is no evidence that the Respondent is using the Domain Name as a brand or that it is in any way trading off the reputation of the Complainant.

With regard to bad faith, the Respondent contends that this involves an enquiry into both the Respondent's knowledge and its intentions in registering the Domain Name.

The Respondent states that it obtained the Domain Name, some nine years prior to the commencement of this proceeding, it having originally been registered by an aerobics company. The activity of this company presumably related to walking and there is no reason to suppose the original registration had any connection

with the Complainant or its activities. The Respondent has since used the Domain Name in connection with walking and exercise, *i.e.* activities to which the phrase “walk the walk” pertains. Again, there is nothing in this use to suggest any exploitation of the Complainant’s claimed reputation.

The Respondent accepts that it has linked the Domain Name to a secondary brokerage site which offers the name (and indeed the Respondent’s entire portfolio of names) for sale. The Respondent notes that under paragraph 4(b)(i) of the Policy it may be an indication of bad faith if the Respondent has:

“... registered or... acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.”

However, the correspondence to which the Complainant refers is dated 2012 and can not be probative of the Respondent’s intent when it acquired the Domain Name in 2004. Furthermore, the Complainant has provided only selective correspondence relating to the purchase enquiry, excluding e.g. the original enquiry itself. It is not clear how alastair@fasterfwd.com is connected with the Complainant and there is no evidence that the response to the enquiry was directed to the Complainant or any competitor of the Complainant. The Respondent cites a number of UDRP decisions to the effect that responding to an enquiry from the Complainant does not of itself evidence an intention to sell to the Complainant and observes that, in this case, the Complainant does not even appear to have been involved. The response made to “Alastair” was a typical response to a purchase enquiry and was not based on any alleged “trademark value” of the Domain Name.

Finally, the Respondent points to the Complainant’s long delay in bringing the present proceeding. While conceding that this is not of itself determinative of the claim, the Respondent submits that the Complainant cannot produce a sales enquiry from 2012 in order to establish the Respondent’s “primary purpose” in 2004. Further, the delay would not be consistent with any suggestion of disruption to the Complainant’s business.

6. Discussion and Findings

In order to succeed in its Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

- (i) that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) that the Respondent has 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.

A. Identical or Confusingly Similar

The Complainant is the owner of two broad categories of trademark registrations which are relevant to this proceeding. First, it is (or was) the owner of registrations in various jurisdictions for the words “WALK the WALK” together with a footprint logo, a number of these registrations having effect from 2001. Secondly, it is the owner of word-only marks for WALK THE WALK, these registrations having effect from 2005. In both cases the registrations relate to numerous classes of goods and services. While the word-only marks date from after the date of registration of the Domain Name, this is not a relevant consideration for the threshold test of whether the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Ignoring the spaces in the mark WALK THE WALK and the gTLD “.com” in the Domain Name, the Panel finds that Domain Name is identical to the Complainant’s trademark WALK THE WALK. Accordingly, the Complainant has established that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent has used the Domain Name for the purposes of a “pay per click” website offering links to providers of various goods and services. On the evidence available to the Panel, the goods and services in question have included exercise, fitness, health, nutrition, diet, weight loss and sport. It is also common ground that the Respondent has offered the Domain Name for sale and the Panel accepts that its agent quoted a price of USD 56,000 in response to a purchase enquiry which was made on behalf of the Complainant.

The Domain Name comprises the term “walkthewalk” together with the gTLD “.com”. It is accepted by the Complainant that the phrase “walk the walk” is in common usage as part of the longer adage “You can talk the talk, but can you walk the walk?” However, while the Respondent submits that the phrase “walk the walk” is also in common usage in its own right, the Complainant disputes that it is in common usage independently of the “talk the talk” element. The Panel is satisfied that, as is evident both from the dictionary definitions and multiple examples of the use of the phrase provided by the Respondent, the phrase “walk the walk” is in common and popular usage independently of the “talk the talk” element.

Where a domain name comprises a generic or descriptive term of this kind, it is the consensus view of UDRP panels that, while the mere registration of the domain name will not confer rights or legitimate interests in the name, its use in connection with that generic or descriptive meaning may do so (see, *e.g.*, paragraph 2.2 of the WIPO Overview 2.0). In each such case, the panel must assess whether the respondent is making legitimate use of the domain name in connection with the meaning relied on or, alternatively, seeking to take unfair advantage of the rights of the trademark owner.

In this case, the Panel finds that the Respondent has made legitimate use of the Domain Name. It is reasonable for a trader to use the generic term “walk the walk” to offer goods and service falling within the same *genus* as that term and the Panel is satisfied that all of the goods and services that appear to have been offered by the Respondent are sufficiently closely connected with walking to do so. The fact that the Respondent has offered these goods and services by way of a “pay per click” website does not of itself render its use of the name illegitimate (see, *e.g.*, paragraph 2.6 of the WIPO Overview 2.0).

Further, the Panel can find no evidence, nor any reason to infer, that the Respondent was motivated to acquire the Domain Name, or that it has used it, in order to take unfair advantage of the goodwill in the Complainant’s trademarks. At the date of the Respondent’s acquisition of the Domain Name the Complainant’s trademarks were confined to the words “Walk the Walk” together with a footprint logo. Furthermore, the Panel accepts that, while the Complainant’s registrations extended to a large number of goods and services (some of which were cancelled) the Complainant was known at that time principally for its fundraising activities in connection with cancer, including organizing marathons. Accordingly, the Panel does not accept that the Complainant enjoyed any exclusivity in the term “walk the walk” for other purposes. The Panel accepts that the Respondent has not used the Domain Name in connection with fundraising or charitable events and can see no basis for a finding that it was motivated to acquire or use the Domain Name in the knowledge of the Complainant’s trademark or with the objective of taking advantage of the Complainant’s goodwill.

In the light of the above matters, the Panel concludes that the Complainant has failed to establish that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

The Panel accepts the Respondent’s contention that the question of bad faith requires an assessment of the state of knowledge of the respondent in any particular case and its motivation in registering and using the domain name in question.

In the present case, a number of the same observations apply as in the case of “rights or legitimate interests”. In particular, the Complainant has failed to establish that it has any exclusivity in the term “walk

the walk” so far as the goods and services offered by the Respondent are concerned, or that the Respondent was motivated to register or to use the Domain Name by a desire to take advantage of the Complainant’s goodwill in its trademarks.

The Complainant states that it understands that the Respondent at one time used the Domain Name to link to pornography, although those links appear to have been removed. This allegation is not supported by any evidence and is denied by the Respondent. In any event, since the Panel is not of the view that the term “walk the walk” is exclusive to the Complainant, it is questionable whether any use of the Domain Name in connection with pornography would lead to a conclusion of bad faith use. In particular, the Complainant would face a difficulty in showing that this use either took unfair advantage of, or was unfairly detrimental to, the reputation of its trademark in this regard.

The Complainant also seeks to rely on the Respondent’s offer to sell the Domain Name for USD 56,000. However, in order to establish the circumstances contemplated by paragraph 4(b)(i) of the Policy, the Complainant must demonstrate that the Respondent registered the Domain Name primarily for the purpose of selling the Domain Name to the Complainant or a competitor of the Complainant. The Panel finds that there is no evidence to support, and no basis to infer, any such finding in this case. The term “walk the walk” is not exclusively associated with the Complainant, the Respondent’s offer to sell the Domain Name was directed to the public at large, and the specific offer for sale on which the Complainant relies was made some eight years after the Respondent’s acquisition of the Domain Name and in response to the Complainant’s own enquiry.

Finally, the Complainant contends that, by including on its website sponsored links specifically related to health and wellbeing, being the key areas in which the Complainant operates, the Respondent is intentionally attempting to attract for commercial gain Internet users to its website, or to the locations connected with those sponsored links, by creating a likelihood of confusion with the Complainant’s mark and brand (paragraph 4(b)(iv) of the Policy). However, the Panel has found that the Respondent’s use of the Domain Name for this purpose is legitimate, comprising the use of a generic term to link to goods and services which are reasonably to be associated with that term. The Panel finds no basis to conclude that the Respondent acquired or has used the Domain Name in an attempt to cause confusion with the Complainant’s trademark or in any way to take unfair advantage of the Complainant’s goodwill.

Accordingly, the Panel finds that Complainant has failed to establish that the Domain Name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

Steven A. Maier
Presiding Panelist

Ian Lowe
Panelist

The Hon Neil Brown Q.C.
Panelist
Date: June 21, 2013