

ADMINISTRATIVE PANEL DECISION

The Estate of Roberto Clemente v. Kelly Transport
Case No. D2022-1196

1. The Parties

The Complainant is The Estate of Roberto Clemente, United States of America ("United States" or "US"), represented by CMG Worldwide, Inc., United States.

The Respondent is Kelly Transport, United States.

2. The Domain Name and Registrar

The disputed domain name <robertoclemente.com> ("Disputed Domain Name") is registered with Network Solutions, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 6, 2022. On April 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 8, 2022, 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022.

On April 21, 2022, the Center received an informal communication from the technical contact.

The Respondent did not submit any response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment on May 5, 2022.

The Center appointed David H. Bernstein as the sole panelist in this matter on May 11, 2022. The Panel finds that it was properly constituted. 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.

Because the Respondent did not file a Response, the Panel reviewed the record to ensure that the Center discharged its obligations to give the Respondent fair notice of this proceeding. *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#). The Center did appropriately follow the Rules by sending notification of the Complaint to the Respondent via email, fax, and courier. The Center did not receive any notice that the email addresses used for notice were invalid or that the messages could not be delivered. The Center's fax notice could not be delivered because of a problem with the telephone line or detached connection and the Center received a non-delivery report. For the courier service, the Center sent written notice of the Complaint to the Respondent via DHL Express. One day after the courier packages were sent, DHL reported that "further consignee information [was] needed," and therefore the delivery was "on hold." The Center asked DHL to reattempt delivery, but since those efforts also were unsuccessful, the Center ultimately approved destruction of the packages.

If these packages were not delivered to the Respondent because the Respondent failed to maintain accurate contact information in its WHOIS data, that is a problem of the Respondent's own making. However, the Panel was concerned that the failure of delivery of the written notice may have been caused by the fact that the Respondent's address was a post office box. It is not clear to the Panel whether the service used by the Center would normally be delivered to a post office box in the United States. The Panel notes that the post office box address included in the registrar verification appears to be accurate since that address also is listed as the "postal address" on the "siccode.com" website to which the Disputed Domain Name previously resolved according to Annex 5 of the Complaint

The Panel's concern about service was exacerbated by the fact that the technical contact suggested that the Center attempt to contact the owner of the <siccode.com> domain name, since that person also was the owner of the Disputed Domain Name. Specifically, in its informal communication, the technical contact stated: "I have had nothing to do with this domain for over 10 years more likely 15 years. I think Wallnet had registered the domain for John Kelly of Kelly Transport which is some sort of trucking company. This was back in the days of dial up internet :) I'm actually surprised I am still a technical contact. I believe the main domain John Kelly had with us was siccode.com. You may have some luck tracking him down with that."

It is not the Center's obligation to dig this deeply into the record, nor is it the Center's obligation to re-notify the Complaint at the request of a technical contact. If anything, the technical contact, who presumably was selected as technical contact by the registrant, should have notified the Respondent directly if he had information on how to contact the Respondent. However, because the Panel was concerned that the courier delivery to the post office box address failed, in an abundance of caution, the Panel requested that the Center re-notify the Complaint and send the notification to the post office box through a different service, as well as to the physical address found on the "Contact Us" page of the "siccode.com" website and to the email addresses associated with the "siccode.com" website.

Before re-notifying the Complaint, though, the Panel first asked the Complainant to submit a Supplemental Submission addressing certain questions that the Panel had based on its review of the Complaint. Those questions were:

- a. Who is the owner of United States Trademark Registration No. 5,176,650 and of the ROBERTO CLEMENTE trademark more generally, and what is the relationship, if any, between that owner and the Complainant? To the extent the Complainant is not the owner of the trademark and/or trademark registration, what is the basis for requesting that the Disputed Domain Name be transferred to the Complainant, and has the owner of the trademark consented to such transfer?
- b. When did the Complainant become aware of the Disputed Domain Name, has the Complainant taken any steps to challenge the Disputed Domain Name prior to the filing of the Complaint, and why did the

Complainant not take action against the Disputed Domain Name, which was registered in 1998, until 2022?

On June 6, 2022, the Complainant submitted its Supplemental Submission responding to these inquiries. Subsequently, on June 17, 2022, the Center re-notified the Complaint, along with the Complainant's Supplemental Submission, and set a deadline of July 7, 2022 for the Respondent to Respond.

On July 7, 2022, the Respondent sent an email to the Center, which serves as confirmation that the Respondent received actual notice of the Complaint. The totality of the email is as follows: "Does this qualify as a "Response" by July 7, 2022? If not, please advise. – John."

The Respondent's email was ambiguous; it was not clear to the Panel whether the Respondent intended to submit a Response as an attachment (there was no attachment to the Respondent's July 7, 2022 email) or whether the Respondent was basically submitting only that email, without any substantive response. The Center sought to clarify this issue in a follow up email to the Respondent on July 11, noting the absence of an attachment and inquiring as to whether the Respondent intended to submit an attachment, but the Respondent did not respond to that inquiry. Accordingly, on July 15, 2022 the Center notified the Parties that the decision due date had been reset to July 25, 2022.

4. Factual Background

Roberto Clemente was a well-known Major League Baseball player who passed away in 1972. Clemente Properties, Inc. has utilized the ROBERTO CLEMENTE mark since 1955 and registered the mark with the United States Patent and Trademark Office ("USPTO") on April 4, 2017 (Registration No. 5,176,650). Annex 4 of the Complaint. Luis Clemente – President of Clemente Properties, Inc. – hired the Complainant (the Estate of Roberto Clemente) to manage business relating to the ROBERTO CLEMENTE mark. Exhibit B to the Supplemental Submission.

Clemente Property, Inc.'s US trademark registration covers multiple Classes: Class 6 (figurines, statues), Class 9 (audio and video recordings), Class 16 (photo albums, books about baseball), Class 17 (rubber figurines), Class 20 (mirrors, plaques made of bone, ivory, plastic), Class 21 (cups, dishes), Class 25 (wearing apparel), Class 28 (baseballs, baseball bats, games), Class 35 (business consultation and management services), Class 36 (charitable foundation services), Class 38 (radio and television broadcasting), and Class 41 (educational and entertainment services).

The Respondent registered the Disputed Domain Name on December 2, 1998, and previously used it to redirect to "siccode.com," as shown in Annex 5 of the Complaint. At the time the Disputed Domain Name redirected to "siccode.com," the web page contained paid advertisements. The "siccode.com" web page serves primarily as a search engine where an Internet user can look up the standard industrial classification ("SIC") code of a specific company or category of company. The <siccode.com> domain name is registered to Perfect Privacy LLC, a subsidiary of Network Solutions, LLC, and is the Respondent's business web page. Since at least March 31, 2022, the Disputed Domain Name has not resolved to an active web page. Annex 6 of the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Disputed Domain Name is confusingly similar to, or identical to, the registered mark, ROBERTO CLEMENTE, in which the Complainant has rights.

The Complainant asserts that the Respondent has no right or legitimate interests in the Disputed Domain Name. In support of this contention, the Complainant argues that the Respondent (i) registered the Disputed Domain Name "decades after" the Complainant began using the ROBERTO CLEMENTE mark, (ii) is not a

licensee or otherwise authorized to use the Complainant's ROBERTO CLEMENTE mark, (iii) is not commonly known by the Disputed Domain Name, (iv) is not using and has no evidence of plans to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services, and (v) diverted customers to the Respondent's own web page for commercial gain, which is not a fair use of the Disputed Domain Name.

The Complainant further argues that the Respondent registered and used the Disputed Domain Name in bad faith to attract Internet users to the Respondent's own web page for commercial gain through the misleading use of the famous personality, Roberto Clemente, as the domain name.

In its Supplemental Submission, the Complainant also offered an explanation as to why this Complaint was brought in 2022, almost twenty-four years after the Respondent first registered the Disputed Domain Name. The Complainant asserts that, upon Roberto Clemente's death in 1972, the use of the ROBERTO CLEMENTE mark fell to his widow, Vera Clemente, who "declined to spend her very limited resources going after the Respondent to recover her rightfully owned intellectual property." Upon Vera Clemente's own death in 2019, her three children "took charge of managing the intellectual property rights associated with their father." In 2022, the children hired an intellectual property management firm who advised them to initiate this UDRP action in order to obtain rights in the Disputed Domain Name.

B. Respondent

As noted above, the Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements that the Complainant must prove by a preponderance of evidence in order to obtain transfer of the Disputed Domain Name:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) addresses the potential impact of the Respondent's default:

"Noting the burden of proof on the complainant, a respondent's default (*i.e.*, failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true."

Thus, notwithstanding the Respondent's failure to respond to the Complaint, the burden remains on the Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#). However, the Respondent's default does mean that the Panel may accept as uncontested the factual averments in the Complaint and Supplemental Submission. *Seasonal Comfort Co. v. Irina Inkina*, WIPO Case No. [D2020-2567](#).

A. Identical or Confusingly Similar

The Complainant has established that Clemente Properties, Inc. has rights in the ROBERTO CLEMENTE mark by virtue of its ownership of a United States trademark registration. See [WIPO Overview 3.0](#), Section 1.2.1. The Complainant has established that it has rights in the mark by virtue of its appointment to act as

the agent of Clemente Properties, Inc. Exhibit B to the Supplemental Submission.

The Disputed Domain Name incorporates the Complainant's ROBERTO CLEMENTE mark in its entirety. The Panel therefore concludes that the Disputed Domain Name is identical to the Complainant's ROBERTO CLEMENTE mark. Accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name. See [WIPO Overview 3.0](#), Section 2.1. Once this burden is met, the burden of production shifts to the Respondent to demonstrate its rights or legitimate interests in the Disputed Domain Name (though the burden of proof remains on the Complainant at all times). See *id.* If the Respondent does not satisfy its burden of coming forward with some evidence to rebut the Complainant's *prima facie* showing, or if the Respondent fails to file a response at all, the Complainant's *prima facie* showing will be sufficient to meet its burden of demonstrating that the Respondent has no rights or legitimate interests in the Disputed Domain Name. See *id.*

The Complainant has made the requisite *prima facie* showing that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Complainant has demonstrated that its principal owns the ROBERTO CLEMENTE trademark in the United States and that it has not granted the Respondent any right to use that mark. There is no content on the Respondent's web page or evidence in the record that supports a finding of rights or legitimate interests under paragraph 4(c) of the Policy. There is no indication in the record that the Respondent is commonly known by the Disputed Domain Name. There are no indicia of the Respondent's use or plan to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services; the Disputed Domain Name does not currently resolve to an active web page. Finally, the Complainant has shown, using the Internet Wayback Machine, that the Disputed Domain Name previously redirected to the Respondent's business web page. Annex 5 to the Complaint. There is no material relating to Roberto Clemente on the Respondent's website and paid ads were displayed on the right-hand side of the website. The use of such ads reflects an attempt by the Respondent to derive commercial gain from the Complainant's trademark, which is not a legitimate noncommercial or fair use of the Disputed Domain Name.

The Panel did consider whether the Respondent's 23-year ownership of the Disputed Domain Name may have given rise to any rights or legitimate interests. Although such a long delay in bringing a claim may give a respondent an opportunity to come up with some use that might qualify as legitimate, delay alone cannot give rise to rights or legitimate interests, nor does it otherwise preclude relief to a complainant. [WIPO Overview 3.0](#) at 4.17. Here, the Complainant has a credible explanation for its delay, and the Respondent has not come forward with any evidence that might explain how the delay has prejudiced the Respondent or given it any rights or legitimate interests in the continued registration of this domain name.

The Respondent has not submitted any Response. As such, the Complainant's *prima facie* showing is un rebutted.

For these reasons, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Bad faith use and registration may be established under paragraph 4(b)(iv) of the Policy if the Complainant can show that the Respondent "intentionally attempted to attract, for commercial gain, Internet users to [its] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [its] website or location or of a product or service on [its] website or location." As discussed above, the Complainant has shown that the Respondent was using the Disputed Domain Name to redirect Internet users to the Respondent's business web page, which contained paid ads. By using the Complainant's famous trademark as the Disputed Domain Name, the Respondent

created a risk of confusion that visitors to the web page would expect to access a website operated by the Complainant. The Respondent profited off of this confusion through paid ads.

Given Roberto Clemente's fame, it is reasonable for the Panel to infer that the Respondent was aware of Roberto Clemente and the Complainant's use of the ROBERTO CLEMENTE mark when the Respondent registered the Disputed Domain Name in 1998. See [WIPO Overview 3.0](#), Section 3.8.1. By registering a domain name that copies the Complainant's mark in its entirety, the Respondent was impersonating the Complainant, and then diverting Internet visitors to a website unrelated to the Complainant but rather with paid advertising. Such conduct constitutes registration and use in bad faith under the Policy. See [WIPO Overview 3.0](#), section 3.1.4 and UDRP 4(b)(iv).

The Panel therefore concludes that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <robertoclemente.com> be transferred to the Complainant.

/David H. Bernstein/

David H. Bernstein

Sole Panelist

Date: July 25, 2022