# Panel Decision for dispute CAC-ADREU-004882

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| Case number | CAC-ADREU-004882 |
| Time of filing | 2008-01-09 11:20:00 |
| Domain names | wpcarey.eu |

## Case administrator

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|---|---|
| Name | Tereza Bartošková |

## Complainant

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| Organization / Name | W. P. Carey, Mr. Leonard Law |

## Respondent

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| Organization / Name | cc, j m |

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any legal proceedings which relate to the disputed domain name

FACTUAL BACKGROUND

W. P. Carey conducts its business activities throughout Europe and uses “W. P. Carey” as a protectible trade name and service mark. W. P. Carey holds rights in “W. P. Carey” that are recognized or established by the national law in at least two Member-States (namely, the United Kingdom and Germany) of the European Community.

Respondent has registered the domain name “wpcarey.eu"

Since 1973, W. P. Carey has been assisting companies with meeting their capital needs through net lease financing. The company initially operated its business only in the United States, where it operated under the trade name W. P. Carey. However, in 2000, the company opened its London office in the United Kingdom and continues to maintain an office at 52 Jermyn Street, London, United Kingdom SW1Y 6LX. 7. The name “W. P. Carey & Co. Limited” is registered in the United Kingdom (Registration No. 4244798), and has been so since 2001. W. P. Carey has operated its business under the trade name “W. P. Carey” since that time, and uses the name as a service mark in connection with the sale of its net leasing financing services. W. P. Carey operates from its London office and maintains signage outside of its office space within the interior of the building. The signage displays the “W. P. Carey” trade name. W. P. Carey has several registered domain names like wpcarey.co.uk, (2) wpcarey.me.uk, (3) wpcarey.org.uk, (4) wpcarey.de (5) wpcarey.com, (6) wpcarey.us, (7) wpcarey.tv, (8) wpcarey.org, (9) wpcarey.biz (10) wpcarey.at, (11) wpcarey.be, (12) wpcarey.cz, (13) wpcarey.dk, (14) wpcarey.es, (15) wpcarey.fr, (16) wpcarey.gr, (17) wpcarey.gs, (18) wpcarey.hu, (19) wpcarey.it, (20) wpcarey.lt, (21) wpcarey.lu, (22) wpcarey.lv, (23) wpcarey.ms, (24) wpcarey.nl, (25) wpcarey.ro, (26) wpcarey.se, (27) wpcarey.si, (28) wpcarey.sk, (29) wpcarey.tc. With regard to the UK domain names, Complainant first registered the domains in 2004.

In each case, including UK and German domain names, the domain resolves to a website that displays the W. P. Carey trade name and service mark.

W. P. Carey has also placed advertisements using the “W. P. Carey” name and mark in the European Venture Capital Journal, the Financial Times, the Economist, Wall Street Journal Europe, Immobilien-Zeitung, and Automobilwoche

W. P. Carey has also participated in trade shows in Europe, namely MIPIM in France and Expo Real in Germany. In each of these trade shows, W. P. Carey has displayed the W. P. Carey name and mark.

W. P. Carey has also distributed press releases throughout Europe announcing substantial deals and transactions.

In the course of operating its business in Europe, W. P. Carey has received press throughout the European Community.

Respondent is in the business of selling domain names and purports to operate a domain name sales operation under the names “Gold Domain” and “eudomain4u.” Respondent’s email address listed on wpcarey.eu is eudomain4u@yahoo.com.

The disputed domain currently resolves to a page that exhibits the message, in English: “This Domain Name is For Sale!”

According to the EURid WHOIS database, Respondent first registered the disputed domain on April 7, 2006.

In August 2007, when asked to transfer the domain name to the Complainant, the Respondent offered to sell the domain name for no less than $55,000.

A. COMPLAINANT

Complainant argues that the domain name is virtually identical to "W.P. Carey" in respect of which complainant has a right established by the national law of the United Kingdom and Germany Section 11 (d) 1 (i) "ADR Rules".

The common-law tort of “passing off” protects businesses from unscrupulous efforts to trade on their goodwill or deprive them of their sole right to enjoy that goodwill.

As a general matter, all business with customers in the UK have goodwill. (See, e.g., Stannard v. Reay [1967] FSR 140 (holding that owner of a mobile fish and chip shop in a holiday resort had goodwill in his business despite the transient nature of his customers)). Placing advertisements in the UK and conducting business in the country is enough to give rise to protectible goodwill under a passing-off cause of action. (See, e.g., Sheraton Corp. of America v. Sheraton Motels Ltd. [1964] RPC 202 (holding evidence of advertising in the UK and bookings in the UK established a passing-off cause of action). However, goodwill need not be attached to a specific place of business in the UK; rather, a simple connection to the UK along with some services bring provided in the UK is sufficient. (See, e.g., Pete Waterman & Others v. CBS United Kingdom Ltd. [1993] EMLR 27).

With respect to domain names, the tort of passing off has been found specifically to protect a claimant from having its name, and the goodwill established therein, “hijacked” by a cyber squatter using the domain as “instrument of fraud.” (See, e.g., British Telecommunications Plc. & Others v. One in a Million Limited & Others [1999] 1 ETMR 61). Mere registration and maintenance of a domain which leads people to believe that the domain name holder was linked with the claimant is enough to be an instrument of fraud. “Unregistered rights arising from . . . use of the name in trade protected in England under English law . . . will suffice for § 11(d)(1)(i).” (City Inn Ltd. v. World Online Endeavours Ltd., ADR.eu Case No. 03396 at ¶ 15 (Feb. 23, 2007).)

W. P. Carey has built up enormous goodwill in its name, as demonstrated by the nearly $2 Billion (USD) in European transactions it has closed, the UK press coverage it has received, the press releases it has distributed and advertisements it has made, and its participation in prominent European trade shows. There can be no doubt that W. P. Carey holds rights in its name (“W. P. Carey”) that are recognized or established by the law of the United Kingdom, and that the disputed domain is identical to that name.

German law also confers to W. P. Carey rights in its name. Under the German Civil Code, § 12 BGB, corporations have a right to their name, a right which entitles them to exclude an infringer from acquiring the identical domain name. Further, the German Trademarks Act protects distinctive company names, even in the absence of trademark registration, when a company has used the mark in Germany in a manner that gives rise to the impression of lasting commercial activity in Germany. Where the mark is well known in Germany, a third party infringer may not use the name even if no risk of confusion exists. Finally, a business may enjoin a cybersquatter from using its name because registering a domain purely for the purposes of monetary exploitation of the rightful owner’s interest can be deemed immoral under §§ 226, 826 BGB. 23. W. P. Carey unquestionably holds rights in its name that are recognized or established by the law of Germany. W. P. Carey is entitled to employ its name in commerce without interference from a cybersquatter. W. P. Carey’s significant business deals (and the very nature of those deals, whereby W. P. Carey has purchased the real estate of German companies and leased it back to them) demonstrate beyond all serious contention lasting commercial activity in Germany. Moreover, as discussed below, Respondent seeks only to exploit the goodwill built up by W. P. Carey in the disputed domain. This immoral means is illegitimate in the eyes of German law and gives W. P. Carey the right to evict the cybersquatter. 24. Based on the foregoing, Complainant satisfies the requirements of § 11(d)(1)(i).

RESPONDENT REGISTERED WPCAREY.EU WITHOUT RIGHTS OR LEGITIMATE INTEREST IN W. P. CAREY'S BUSINESS NAME.

Respondent is in the business of selling domain names and purports to operate a domain name sales operation under the names "Gold Domain" and "eudomain4u." Respondent's email address listed on wpcarey.eu is eudomain4u@yahoo.com.

The disputed domain currently resolves to a page that trumpets the message, in English: "This Domain Name is For Sale!" See Annex A, Documents Concerning Respondent. Respondent also uses the same page to promote and advertise its "Gold Domain"/"eudomain4u" domain business.

According to the EURid WHOIS database, Respondent first registered the disputed domain on April 7, 2006. As of August 27, 2007, Respondent had not updated the website since April 19, 2006. See Annex A, Documents Concerning Respondent. As of December 16, 2007, the WHOIS database reported the last update to the domain on October 26, 2007, but no discernible changes were made to the site. See Annex A, Documents Concerning Respondent.

Respondent does not carry on, nor intends to carry on, any business or activity using the name "WPCAREY," "W. P. Carey" or any similar formulation. Apart from the very strong association with Complainant's business, the combination of letters -- w-p-c-a-r-e-y -- seems to denote an individual person's name. This unique combination of letters clearly has no suggestive or descriptive value and no value other than the substantial value as may be associated with Complainant's business. 29. Under Section 11(d)(1)(ii) of the ADR Rules, "the domain name has been registered by the Respondent without rights or legitimate interest in the name" and, therefore, Complainant is entitled to revocation and transfer of the domain name.

RESPONDENT REGISTERED THE DISPUTED DOMAIN IN BAD FAITH AND IS USING IT IN BAD FAITH.

The evidence shows that Respondent's only purpose in registering and maintaining the domain was to extort an exorbitant fee from the entity that has built up goodwill in the registered name, W. P. Carey. 31. In August 2007, when asked to transfer the domain name to the Complainant, the Respondent offered to sell the domain name for no less than $55,000.

Section 11(f) of the ADR Rules provides in pertinent part as follows: For purposes of Paragraph 11(d)(1)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith: (1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or Community law, or to a public body; or . . . (4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent; or (5) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.

There are clearly circumstances that indicate that the domain was registered and acquired primarily for sale to W. P. Carey. These circumstances include that the domain is unique and associated with a very well-known company, that Respondent is in the business of selling domains, that Respondent posted the domain for sale, and that Respondent attempted to extract the exorbitant fee of $55,000 for the domain. See ADR Rules § 11(d)(1)(iii)(1).

Moreover, the domain name was intentionally used to attract Internet users for commercial gain to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's name. Respondent used Complainant's well-recognized name to attract visitors to the page to which www.wpcarey.eu resolves, which advertises Respondent's domain services, email address and other web address. Additionally, Respondent uses the site in concert with Go Daddy Domains to attract visitors to Go Daddy's site, a site which is also advertised at www.wpcarey.eu. See ADR Rules § 11(d)(1)(iii)(4).

It is also worthy of note and indicative of bad faith that “the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.” See ADR Rules, Section 11(d)(1)(iii)(5). Finally, Respondent’s bad faith is further evidenced by its failure to provide required contact information (the name “j m”; the organization “cc”, the fax number +1.111111111111) in violation of registration agreement with Go Daddy. The failure to supply complete and accurate contact information in accordance with registration agreement has been recognized as evidence of bad faith. See, e.g., Ticketmaster Corp. v. Dmitri Penn, WIPO Case No. D2000-1550 at § 6 (Jan. 16, 2001) (absence of complete or correct information in the application for registration suggests a desire to create a covert position and make communication difficult and constitutes bad faith); Cabletron Systems, Inc. v. DSL Enters., WIPO Case No. D2000-0571 at § 6 (Aug. 18, 2000) (providing false telephone number, e-mail address and identities to the Complainant and the registrar is an act of bad faith); Quixtar Investments, Inc. v. Smithberger, WIPO Case No. D2000-0138 at § 6 (Aug. 1, 2000) (use of false registration information to hide true identity is evidence of bad faith registration and use). 37. Accordingly, Respondent is guilty of bad faith registration and (in the alternative) use of the disputed domain. Complainant W. P. Carey holds prior rights, within the meaning of EC No. 874/2004, art. 10, in its name that are recognized and established by the national law in the United Kingdom and Germany, both members of the European Community.

The respondent, in violation of his Registration Agreement (in which it warranted that the registration of the disputed domain was being done in good faith) and in disregard of W. P. Carey’s rights, has registered the domain name “wpcarey.eu,” which is identical and confusingly similar to W. P. Carey’s business name, without having any rights or legitimate interest in the name, and in bad faith and is now using the name in bad faith. Accordingly, W. P. Carey is entitled to have the disputed domain revoked from the respondent and transferred to W. P. Carey.

B. RESPONDENT

The Respondent has not responded.

DISCUSSION AND FINDINGS

According to Article B11 (d) of the ADR Rules the Panel will decide to grant the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR Proceeding where the Respondent is the holder of the domain name in respect of which the Complainant was initiated that

(i) the domain name is identical confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and; either

(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name;or

(iii) the domain name is registered or is being used in bad faith.

There is no doubt a confusion between the disputed names. The fact that domain name appears as "wpcarey" and the Complainant uses W. P. Carey in its business does not change that conclusion. In addition the "distinction" cannot be provided by the ".eu" as confirmed by the established jurisprudence, too. Then we can conclude that the domain name is identical to the name of the Complainant.

The Complainant provided enough documents proving he is the right holder of the name and this right is recognized at least under two national laws (UK and Germany).

The second condition relates to the legitimate interest or rights of the Respondent to the disputed name. Here is where the Response of the Respondent would be helpful as normally the burden of proof is "divided" between both parties. However, we must use the criteria provided by 11 f) of ADR Rules e.g. when evaluating the evidence we have in this procedure.Using these general conditions as a way to establish a legitimate interest of the Respondent on the disputed name we can conclude that the Respondent did not use the domain name or a name corresponding to the domain name in connection with the offering of good or services nor has made demontrable preparation to do so, nor has been commonly known by the same domain name.

What we know now is that the only use made by the Respondent is the display of the domain name on a site for the purpose of selling it.

Then we can conclude that the Respondent has no right or legitimate interest in the domain name.

Finally we must decide if we have here enough evidence to demonstrate the bad faith of the Respondent. One more time his silence does not make easy the task of the Panel.

We do not totally agree with the reasons given by the Complainant concerning the bad faith of the Respondent. In fact it is not clear for us that the domain name was registered and acquired primarily for sale to W.B. Carey or that the domain name was intentionally used to attract Internet users for commercial gain to Respondent´s website or other on-line locations, by creating a likelihood of confusion with the Complainant´s name. The truth is that the Respondent is offering the name to everybody on a website and he is not a competitor of the Complainant trying to attract Internet users to its own business using that name.

But according to 11 f) of the ADR Rules those evoked conditions are not limited, e.g., there could be more facts that can make us conclude about the bad faith of the Respondent. In this case we see at least two circumstances that lead us to the conclusion of the Respondent´s bad faith. The first one is the circumstance that the only concern of the Respondent regarding the name is to sell it. The domain name is not in use for business or non-commercial or fair use. The only goal of the Respondent is to make money. The second circumstance is the Respondent's failure to provide required contact information. Someone who is in good faith does not cover its identity under names as "j m" or fax numbers like 111111111. This suggests, in fact, a wish to create a covert position and making communication difficult.

These clearly demonstrated circumstances are evident signs of bad faith in the registatrion of the domain name in cause, that is to say, the domain name has been acquired only to be on a kind of "auction" for making money, not to be used on a fair commercial or even non-commercial way.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name WPCAREY be revoked

## PANELISTS

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| Name | **Manuel Lopes Rocha** |

DATE OF PANEL DECISION 2008-05-21

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the owner of a trade name "W.P.Carey" conducting its business both off and on-line with that name. The domain name "wpcarey.eu" registered by the Respondent is identical to the name of the Complainant.

The Respondent did not respond to the Complainant and has not provided any evidence concerning his rights and/or legitimate interest in the disputed name. According to the evidence provided no right or legitimate interest was demonstrated. The only known use of the domain name is its display for sale on a website.

The Panel is of the opinion that beyond those conditions the domain name has been also registered in bad faith by the Respondent as he is trying to sell that domain name through the alrady referred web site. At the same time he gave no complete and accurate contact information, suggesting a wish to create a covert position and making communication difficult.

This is why the Panel decided that the domain name must be revoked.