Panel Decision for dispute CAC-ADREU-004925

Case number	**CAC-ADREU-004925**
Time of filing	**2008-06-19 14:57:48**
Domain names	**nyu.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**New York University in France, Christopher Bouchard**

Respondent

Organization / Name	**Vinitsia, Ltd.**

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

There are no other legal proceedings of which the panel is aware that are pending or decided and that are related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, New York University in France, is a licensee of the holder of the trade mark NYU, New York University, a private university located in New York, US. New York University is the owner of the trademark NYU, which is protected through word mark registration through the community trademark registration No. 323,253 NYU.

The Respondent, Vinitsia Ltd., registered the disputed domain name on 7 April 2006, the first day of the Land Rush period. Respondent provided the short Response and, however, has not in general disputed Complainant‘s contentions.

A. COMPLAINANT

Complainant submits that 1) it has rights in the registered trademark NYU under Community law, 2) the Domain Name is identical to Complainant's mark NYU, 3) the Domain Name has been registered without rights or legitimate interest in the name, and 4) that the Domain Name has been registered and is being used in bad faith.

1. Complainant's rights in name "NYU"

Complainant argues that New York University ("the University")owns European Community Trade mark Registration No. 323,253 for the Mark NYU(Classes 16, 18 and 25). The University has subsidiaries and affiliated offices throughout the Community, including Complainant, which is located in France, and other subsidiaries or branches in the United Kingdom, Spain, the Czech Republic, and Italy. Complainant is located in Paris, France, and offers educational services to students enrolled in the University. The University has a licensing arrangement with Complainant permitting Complainant to use the registered Mark NYU (CTM Reg. No. 323,253). Given the license arrangement in place between the University and Complainant, the Complainant has the right to enforce the rights licensed to it by the University in the Mark.

2. Identicality/Similarity of the disputed domain name

The Complainant states that the disputed second level domain name <nyu> is identical to the the Mark NYU. Moreover, the country code top level domain name <.eu> is confusingly similar the generic top level domain name <.edu> which is used for the University‘s primary website <www.nyu.edu>.

3. Registration without rights or legitimate interest in the name

The Complainant made the analysis on the current use of the disputed domain name which shows that the Respondent was merely using the domain name to host sponsored links, therefore the Respondent did not have a legitimate interest in the disputed domain name under Article 21(2)(a). With respect to Article 21(2)(b), Complainant found no evidence to indicate that Respondent is, or ever was, known by "NYU." Respondent does not appear to own a registration for NYU under Community law, U.K. law, or U.S. law, and neither the University nor Complainant has granted a license to Respondent to use the Mark. With respect to Article 21(2)(c), Respondent is making commercial use, not non-commercial fair use.

4. Respondent‘s bad faith

According to Complainant, Respondent is using the confusingly similar Domain Name intentionally to attract Internet users for commercial gain, as is evidenced by the sponsored links on its web site. Respondent has engaged in a pattern of conduct of registering domain names that include other parties' marks (six .eu ADR complaints, five of which have resulted in the transfer or deletion of the domain name in cases No. 1304 (KEMET), No. 1412 (NOURKRIN), No. 3149 (EDSCHA), No. 4269 (SALOMONSPORTS), and No. 4881 (JETPILOT). Respondent was incorporated in the U.K. on March 21, 2006, and has a registered office at 46 Peel Street Hull, East Yorkshire HU3 1QR. There are at least seven other companies that were registered on the same day, each of which shares the same address. (See Annex VII for incorporation documents). These companies appear to be affiliated with each other. At least 21 successful .eu ADR complaints have been filed in relation to domain names registered by Respondent and its affiliated companies, and the ADR Panel found that the domain name at issue had been registered in bad faith in at least 10 of them. Respondent and its affiliated companies have failed to respond to at least 15 ADR complaints. Complainant tried unsuccessfully to contact Respondent by e-mail and fax, sent on May 11, 2007, and mail sent to Respondent by courier was returned as undeliverable. The Respondent's failure to respond to the allegations in the University's earlier cease and desist letter constitute bad faith, and Respondent's failure to provide correct contact information also is evidence of bad faith.

Finally, Complainant requests to transfer the disputed domain name to the Complainant as it has principal place of business within the Community.

B. RESPONDENT

As mentioned above, the Respondent provided very short Response and, however, has not in general disputed Complainant‘s contentions. It has only stated that the disputed domain name was registered without prior knowledge of the alleged prior rights of the Complainant. Respondent has registered this three letter domain name for use in a future project. Moreover, the Respondent confirmed that it is prepared to surrender the domain name if the Complainant drops the ADR.

DISCUSSION AND FINDINGS

1. Licence Issue

It is important to verify whether the New York University in France (the Complainant) is the legitimate licensee of the mark NYU which is owned by the holder New York Univeristy which is based in US. The Complainant presented a Licence Declaration for a Registered Trade Mark (See Annex II of the Complaint) as evidence of the license arrangement between the University and Complainant. Art. 1 of this Declaration states that „Licencor and Licensee have, prior to receipt of the Domain Name Application by the Registry, entered into the licence arrangement concerning the use of the Trade Mark referred to above.“ The Complainant refers to the .eu ADR Case No. 4108 (YOUNGLIFE) that such evidence was sufficient to allow the licensee to enforce a trademark right according to Article 10(1) of Regulation (EC) 874/2004 and to permit transfer of the domain name to the complainant/licensee according to Article 4.2(b)(iii) of Regulation (EC) 733/2002. The Panel agree with the Complainant. Moreover, in .eu ADR Case No. 4881 (JETPILOT) the Panel went even further: it requested that the Complainant provides formal consent of the licensor. The Complainant did provide the consent of the owner of the trade mark in the form of a telefax message and the Panel was satisfied that the rightholder provided consent with the transfer of the disputed domain name to the Complainant. In the current case the Panel is also satisfied with Licence Declaration for a Registered Trade Mark as such formal consent of the rightholder given to the Complainant (the licensee – The New York University in France).

2. Identicality/Similarity of the disputed domain name

It is obvious that the disputed second level domain name <nyu> is identical to the the Mark NYU. The similarity of the top level domains (<.edu> and <.eu>) is not important for this case as the identicality of the second level domain was enough to conclude the most important element of application of Article 21 of Regulation (EC) 874/2004.

3. Respondent‘s lack of rights or legitimate interests in the name

The Panel considers that Complainant sufficiently presented and proved Respondent‘s lack of rights or legitimate interests in the disputed domain name.
In Panel decision ADR 2035 (WAREMA) the Panel stated: “Furthermore, the Panel holds that although the burden of proof lies with the Complainants, the existence of a right or legitimate interest is difficult to prove since the relevant facts lie mostly in the sphere of the holder. Hence, the Panel holds that it is sufficient that the Complainants contend that the obvious facts do not demonstrate a right or legitimate interest of the Respondent in the Domain Name. The onus then shifts to the Respondent to produce factual evidence for a right or legitimate interest”. This approach shall be followed in the current case. The Complainant complied with the stated requirements and the Respondent filed a very short Response which has not in general disputed Complainant‘s contentions.

Respondent has only stated that the disputed domain name was registered without prior knowledge of the alleged prior rights of the Complainant. This allegation is more than doubtful. It is highly unlikely that Respondent would not have known of the New York University's and likely Complainant's rights in the Mark NYU when it registered the Domain Name. Complainant, the University, and the University's subsidiaries have provided educational services and related products in the European Union and around the world for many years. New York University is well known throughout the world, as is its mark NYU, which it has used since 1896. The University also has had an active study abroad program since at least as early as 1958, and its students currently study in 18 countries as part of the program (more information can be accessed at http://www.nyu.edu). Therefore, it is almost evident that Respondent had the University in mind when it registered the Domain Name. In fact, Respondent uses the University's full name, New York University, in the first sponsored link on the main page. In addition, the founders of Respondent are domiciled in the United States. (See Annex VI of Complaint for the UK incorporation documents for Vinitsia Ltd, indicating that the founders live in the United States.) The Panel agree with the Complainant‘s reference to .eu ADR Case No. 4318 (E-AIRFRANCE), where ADR panel held that the fame of the mark AIR FRANCE was strong evidence that the holder registered the domain name with the complainant's trademark in mind. In addition, the facts that Respondent registered the disputed domain name on the first day of the Land Rush period, chose to use a famous registered trademark as its second level domain, currently uses the web site associated with the Domain Name as a placeholder with sponsored links that reference the New York University and generate revenue for Respondent, and has a pattern of conduct of registering domain names of third parties, are strong evidence that Respondent has no legitimate interest in the name NYU.

Respondent also alleged that it has registered this three letter domain name for use in a future project. No evidence of the existence of any „future project“ was provided. Respondent has not made any demonstrable preparations to launch any project. Finally there is no indication on the Internet or otherwise that the Respondent is making a legitimate and non-commercial or fair use of the disputed domain name.

4. Respondent‘s bad faith

Evidence regarding Respondent‘s bad faith is very strong too.

First, Respondent is using the confusingly similar Domain Name intentionally to attract Internet users for commercial gain (sponsored links on its web site).

Second, Respondent has engaged in a pattern of conduct of registering domain names that include other parties' marks (six .eu ADR complaints, five of which have resulted in the transfer or deletion of the domain name in cases No. 1304 (KEMET), No. 1412 (NOURKRIN), No. 3149 (EDSCHA), No. 4269 (SALOMONSPORTS), and No. 4881 (JETPILOT).

Third, Respondent was incorporated in the U.K. on March 21, 2006, and has a registered office at 46 Peel Street Hull, East Yorkshire HU3 1QR. There are at least seven other companies that were registered on the same day, each of which shares the same address. (See Annex VII of Complaint for incorporation documents of these companies). These companies are affiliated with each other. At least 21 successful .eu ADR complaints have been filed in relation to domain names registered by Respondent and its affiliated companies, and the ADR Panel found that the domain name at issue had been registered in bad faith in at least 10 of them. Respondent and its affiliated companies have failed to respond to at least 15 ADR complaints.

Fourth, Complainant tried unsuccessfully to contact Respondent by e-mail and fax, sent on May 11, 2007, and mail sent to Respondent by courier was returned as undeliverable. The Respondent's failure to respond to the allegations in the University's earlier cease and desist letter constitute bad faith, and Respondent's failure to provide correct contact information also is evidence of bad faith.

Fifth, the Respondent‘s allegation in Response that it is prepared to surrender the domain name if the Complainant drops the ADR is last but not least pattern of conduct which is enough to conclude the bad faith of the Respondent.

Because the Complainant, New York University in France, is an entity eligible to be the holder of .eu domain name in accordance with the Par. 4(2) b) of Regulation 733/2002, the Panel orders that the domain name nyu.eu be transferred to New York University in France.

DECISION

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

the domain name NYU be transferred to the Complainant

PANELISTS

Name	Darius Sauliunas

DATE OF PANEL DECISION 2008-09-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, New York University in France, is a licensee of the holder of the trade mark NYU, New York University. The Respondent, Vinitsia Ltd., registered the disputed domain name on 7 April 2006, the first day of the Land Rush period. Respondent provided the short Response and, however, has not in general disputed Complainant‘s contentions. The trade mark NYU for the New York University is famous mark, therefore, the Panel concluded that Respondent was likely to be aware of corresponding prior rights of the Complainant. The Panel found many evidence of bad faith and ordered the disputed domain name to be transferred to the Complainant.