Panel Decision for dispute CAC-ADREU-005486

Case number	CAC-ADREU-005486
Time of filing	2009-10-27 10:33:05
Domain names	morganstanleysmithbarney.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Morgan Stanley Smith Barney Holdings (UK) Limited, Sarah Cole

Respondent

Organization / Name	morganstanley-smithbarneymorganstanley

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 other legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, a company incorporated in England and Wales, is a wholly owned subsidiary of a joint venture of Morgan Stanley and Citigroup Inc. The joint venture combines wealth management businesses which previously traded on a substantial scale under the names “Morgan Stanley” and “Smith Barney”. The disputed domain name, morganstanleysmithbarney.eu, was registered by the Respondent three days after the formation of the joint venture was announced and it has been pointed to a website which displays search engine results on itself. The Respondent gave his name to the Registry as “morganstanley-smithbarneymorganstanley” with an address in “seoul Teukbyeolsi France”.

A. COMPLAINANT

The Complainant seeks transfer of the domain name to itself on the grounds that:

(a) The Complainant’s parent company owns registered and unregistered rights in the name “Smith Barney”, including a Community trademark, which have been licensed to the Complainant. Morgan Stanley owns registered and unregistered rights in the name “Morgan Stanley”, including a Community trademark, which have also been licensed to the Complainant and its parent company.

(b) The Respondent registered the disputed domain name without rights or legitimate interests in it and in bad faith and is using it in bad faith. He used a false name to register it and has no connection with the Complainant. The registration of the domain name three days after the announcement of the creation of the Complainant’s parent company as a joint venture of Morgan Stanley and Smith Barney cannot have been coincidence and must have been to take unfair advantage of and/or to use the domain name to the detriment of the Complainant’s rights.

(c) Internet users will assume that the disputed domain name is owned and/or controlled by the Complainant or an associated company. The registration and use of the domain name are intended to pass off.

(d) The Respondent used a false address to register the domain name and does not meet the general eligibility criteria.

B. RESPONDENT

The Respondent has not submitted any response to the Complaint.

DISCUSSION AND FINDINGS

1. In accordance with article 22(11) of Regulation 874/2004 (“the Regulation”), the disputed domain name must be revoked or transferred to the Complainant if the Panel finds that its registration is speculative or abusive as defined in article 21 of the Regulation.

2. A registration is speculative or abusive according to article 21 of the Regulation if

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

(b) it has been registered by its holder without rights or legitimate interests, or it has been registered or is being used in bad faith.

3. In accordance with paragraph 10 of the ADR Rules, where a Respondent fails to submit a Response to the Complaint within the time specified in them, the Panel may consider this failure as grounds to accept the claims of the opposite party and shall draw such inferences from the Respondent’s default as it considers appropriate.

4. The Panel finds that the disputed domain name is confusingly similar to both “Smith Barney” and “Morgan Stanley”. Given the association of these names created by the formation of the joint venture, the combination of the two names in the disputed domain name does not avert confusion between the domain name and either of the individual names.

5. It is also clear that rights in both “Smith Barney” and “Morgan Stanley” are recognised by national and Community laws.

6. The Panel further finds that the disputed domain name was registered by the Respondent without any rights or legitimate interests. It is obvious that the name used by the Respondent in effecting the registration is not his real name. The Panel has no hesitation in accepting the claims of the Complainant in this regard in the absence of any Response under paragraph 10 of the ADR Rules.

7. It follows that the disputed domain name must be revoked or transferred to the Complainant.

8. Article 22(11) of the Regulation provides that where it is found that the registration is speculative or abusive, the domain name should be transferred to the Complainant if the latter so requests and meets the general eligibility criteria set out in article 4(2)(b) of Regulation 733/2002; and otherwise it should be revoked.

9. The general eligibility criteria set out in article 4(2)(b) of Regulation are: an undertaking having its registered office, central administration or principal place of business within the Community; or an organisation established within the Community; or a natural person resident in the Community.

10. The Complainant has requested transfer, but has provided minimal evidence that it satisfies the general eligibility criteria. Nevertheless, the Panel infers from the information provided that the Complainant is an undertaking having its registered office within the Community and/or an organisation established within the Community.

11. The disputed domain name should therefore be transferred to the Complainant.

DECISION

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

the domain name MORGANSTANLEYSMITHBARNEY be transferred to the Complainant

PANELISTS

Name	**Jonathan Turner**

DATE OF PANEL DECISION 2010-01-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, a company incorporated in England and Wales, was a wholly owned subsidiary of a joint venture combining wealth management businesses which previously traded on a substantial scale under the names “Morgan Stanley” and “Smith Barney”. The disputed domain name, morganstanleysmithbarney.eu, was registered by the Respondent three days after the formation of the joint venture was announced and was pointed to a website which displayed search engine results on itself. The Respondent gave his name to

the Registry as “morganstanley-smithbarneymorganstanley” with an address in “seoul Teukbyeolsi France”.

The Panel found that the disputed domain name was confusingly similar to both “Morgan Stanley” and “Smith Barney” and that rights in these names were recognised under national and Community laws. The Panel further found that the Respondent had registered the domain name without any rights or legitimate interests. Since the Complainant requested transfer and it could be inferred from the information provided that it satisfied the general eligibility criteria, the Panel concluded that the Domain Name should be transferred to it.