PROCEDURAL HISTORY

The Complaint was filed with CPR on August 7, 2002 and, after review for administrative compliance, served on the Respondent on August 8, 2002. The Respondent did not file a Response on or before August 29, 2002 or at any time during these proceedings. I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including the Complaint and attachments, I find as follows:

FINDINGS

Respondent’s registered domain name, “nycslt.org”, was registered with Network Solutions, Inc. on March 14, 2000. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

i. Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

ii. Respondent has no rights or legitimate interests in respect of the domain name; and

iii. Respondent’s domain name has been registered and is being used in bad faith.
IDENTITY/CONFUSING SIMILARITY:
Complainant alleges that in early 2000, it entered into a contract with a small advertising agency, SLI, to develop a web site for Complainant’s New York Urban League’s School Leadership Teams Parent Engagement Initiative. Under the terms of the contract with SLI, specifically Section I – Scope of Services subsection i and j respectively, SLI was to “develop a web site for the NYC School Leadership Project and work with the NYUL and the Board of Education and the MIS staff member to develop and post content on the web site.” In addition, “SLI will be responsible for hosting and managing all technical aspects of the site.”

Complainant further alleges that SLI assigned execution of this project to one of its consultants, Respondent, James Sol. The site was complete over a period of a few months and, in registering the subject domain name, Respondent, James Sol, named himself as the registrant. Complainant claims that the design of the site and the domain name were created for the benefit of Complainant and were to be owned solely by Complainant pursuant to the contract’s Section VI – Ownership of Materials, “All rights title and ownership of materials produced for this project shall be the property of the New York Urban League.”

Finally, Complainant states that it has paid all expenses in connection with creation, registration, maintenance and administration of the site and the subject domain name and has already spent tens of thousands of dollars in advertisements in newspapers, magazines, television and radio PSAs, e-billboards, bus shelters, subway advertisements, calendars, bookmarks, etc. promoting the name nycslt.org as part of its promotion of the web address http://www.nycslt.org.

UDRP inquiries and rights are based on trademarks and service marks, not on domain names. However, Complainant makes a showing of its use of the domain name not just as the domain name but as a trademark or service mark in the course of trade. The use of the domain name “nycslt.org” in its advertising and promotion did create trademark and service mark rights which belong to Complainant, the company which operated the web portal, not to the Respondent, who only held the position of registrant of the domain name.

Based upon the foregoing uncontroverted allegations in the Complaint, I therefore conclude that the registered domain name “nycslt.org” is identical or confusingly similar to Complainant’s trademark, nycslt.org, which identifies Complainant’s New York Urban League’s School Leadership Teams Parent Engagement Initiative.

RIGHTS AND LEGITIMATE INTERESTS:
Complainant claims that Respondent has no rights or legitimate interests with respect to the domain name at issue. In support of this allegation, Complainant points to the language of the underlying contract between it and SLI, Respondent’s employer, and notes that once the site was developed for it, the domain name should have been registered in the Complainant’s name but it was not.

UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.
The Complaint implicitly asserts that the Respondent has no rights or legitimate interests in the domain name. The Respondent, by failing to respond to the Complaint, does not even claim, let alone prove, that it did have any rights or legitimate interests in the domain name. It is even difficult to imagine what legitimate interest Respondent might have had in registering the domain name for himself and against the legal interest of his employer’s client, the Complainant. Again, therefore, based upon the uncontroverted position stated in the Complaint, I conclude that Respondent does not have rights or legitimate interests with respect to the domain name at issue.

BAD FAITH:

The final threshold test requires that Complainant prove that Respondent’s domain name has been registered and is being used in bad faith. Although the Complainant specifically does not allege that the Respondent is using its site in any capacity, malicious or otherwise, the Complainant has argued that the Respondent was fully aware of the Complainant’s rights in and to the domain name at the time of Respondent’s registration of the subject domain name in his own name.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent’s cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent’s web site by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation or endorsement of Respondent’s web site or location, or of a product or service on Respondent’s web site or location.

This list is clearly not intended to be exhaustive, however, and in the absence of any response from the Respondent, the Complainant has abstained from speculating on the motivation of the Respondent. Nevertheless, it is obvious that the Respondent could have registered the domain name in Complainant’s name, in trust for the Complainant, in Respondent’s employer’s name, SLI, or just have recommended that Complainant do so itself. This would have protected the Complainant’s domain name without allowing the Respondent to effectively obtain a competing legal interest in the identical domain name. I am persuaded, therefore, to conclude that the domain name was not registered by Respondent in its own name in good faith. In the circumstances of this case, then, I regard this as prima facie amounting to conduct in bad faith.

I therefore conclude that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.
CONCLUSION

In light of my findings above that (a) the registered domain name is identical or confusingly similar to Complainant’s protected mark; (b) Respondent does not have rights or legitimate interests with respect to the domain name at issue; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

REMEDY

Complainant’s request to transfer the domain name “nycslt.org” is hereby GRANTED. The domain name shall be transferred to Complainant New York Urban League, Inc.

Louise E. Dembeck
September 13, 2002