



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Lana Marks, Ltd., Inc. v. SYP Web

Case No. D2000-0304

1. The Parties

Complainant:

Lana Marks, Ltd., Inc.
233 Sunset Avenue, Suite 220
Palm Beach, Florida 33480
United States of America

Respondent:

SYP Web
1405 Ave. Z, Suite 626
Brooklyn, New York 11235
United States of America

2. The Domain Name(s) and Registrar(s)

Contested Domain Name: lanamarks.com

Registrar:

Network Solutions, Inc. (NSI)
505 Huntmar Drive
Herndon, Virginia 20170
United States of America

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <<http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in

accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed electronically, by e-mail, with the Arbitration and Mediation Center of the World Intellectual Property Organization (the "Center") on April 18, 2000, and in hard-copy form, with annexes A-G, and the appropriate payment, on April 20, 1999, with the original signature page of the Complaint subsequently filed with the Center on May 15, 2000. The Complainant states that on April 17, 2000, its attorneys served a copy of the Complaint, by courier, on the Respondent and provided a copy of the Complaint, by e-mail, to NSI.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN-approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined that the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 2, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to the domain name; specifically, contact and registrant information for the contested domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of the domain name. On May 3, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the ICANN Policy is in effect, and that the domain name, as of May 3, 2000, was "active".

On May 8, 2000, the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, both by e-mail and in hardcopy form by courier (the latter including a copy of the annexes supplied by the Complainant). The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a) and 4(a) of the Rules.

Hence, with the notification to the Respondent having occurred on May 8, 2000, under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on May 8, 2000.

Having reviewed the complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on May 27, 2000, to file its response with the Center and serve a copy of the response on the Respondent.

As of May 27, 2000, the Center has received no such response from the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on June 9, 2000, the Center contacted the undersigned requesting his service as a sole panelist to consider and decide this dispute. The undersigned accepted and on June 12, 2000, returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. On June 15, 2000, the Center appointed the undersigned as the sole panelist to consider this dispute, and so notified both parties by e-mail. Based on deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the undersigned to the Center on or before June 29, 2000.

This dispute concerns one domain name alone, specifically "lanamarks.com". The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, SYP Web, has failed to respond to the Complaint, all the facts alleged by the Complainant, Lana Marks, Ltd., Inc., will be accepted as true. For convenience of the reader, the factual allegations, to the extent needed, from the Complaint are reproduced below.

The dispute is based on the following trademark and its usage by the Complainant:

LANA MARKS

This trademark is used by the Complainant in connection with: jewelry articles made of gold, sterling silver, and other precious metals, with or without precious and semi-precious stones, namely belt buckles, necklaces, chains, rings, earrings, pins, brooches and pendants, and bracelets; and Leather goods, namely diaries, ladies' and men's handbags, briefcases, travel bags, passport covers, wallets, key cases, shoes and belts.

This trademark is the subject of United States Trademark Registration No. 1,989,728 issued on July 30, 1996, which claims first use in both inter-state and intra-state commerce in the United States on July 1994. The Complainant has supplied a copy of this registration in Annex C to the Complaint. This trademark was originally registered to "Lana of London, Ltd.". A name change certificate was recorded in the US Patent and Trademark Office (PTO) on June 17, 1996, beginning at frame 0180 of reel 1474 which effectively changed the registrant's name to that of the present Complainant. A copy of a recorded name change certificate and a PTO Notice of Recordation is provided in Annex E to the Complaint.

The Complainant states that its goods, that bear and are distributed under its registered trademark, are generally considered "high-end, designer" goods, which are sold in "upscale" department stores such as Bergdorf Goodman, Neiman Marcus and Saks Fifth Avenue. In that regard, the Complainant has provided, in Annex D to its Complaint, a copy of a print advertisement, dated September 1995 from Vogue magazine, that featured some of its wares under the trademark "LANA MARKS".

The Complainant states that the trademark is the name of a living individual, Lana Marks -- whose consent to registration of the trademark is noted on the registration. Lana Marks is the founder, CEO and primary jewelry and leather goods designer of complainant.

The Complainant further states that its trademark has been in continuous use since at least as early as July 1994, and that it has expended substantial sums of money promoting and advertising goods that bear this mark. As such, the Complainant alleges that it has acquired valuable goodwill in its trademark and that this mark has become widely and favorably known in connection with the Complainant's goods.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) the domain name in question is similar, specifically identical, to its registered trademark;
- (b) any rights the Respondent has in the domain name in contention are illegitimate; and
- (c) the Respondent has registered this domain name in bad faith.

i) similarity

As to similarity of the contested domain name to its registered trademark, the Complainant has provided a copy, as noted above, of its US trademark registration, along with a recorded assignment indicating title to the trademark currently exists in the Complainant. Given that the registration issued on July 30, 1996, a declaration of continued use, as required under § 8 of the Lanham Act (15 USC §§ 1058) for the trademark registration to continue in force, is not due until July 30, 2001, at the earliest. As such, this registration is currently active.

For all practical purposes, the domain name in question is identical to the Complainant's LANA MARKS trademark. The exceptions are omission of a space between the two words as shown in the registered trademark with respect to those words being appended together in the domain name and the inclusion of a top level domain (.com) in the domain name not included in the trademark, both of which are de minimis and immaterial.

ii) illegitimate use

The Complainant has been known by, and has been using, the name and trademark LANA MARKS since July 1994. The trademark, LANA MARKS, is also the name of the founder, chief executive officer as well primary jeweler and leather goods designer of the Complainant, i.e. Ms. Lana Marks.

During approximately the past six years, the Complainant has repeatedly advertised and distributed its goods under its trademark to a variety of up-scale department stores.

The Complainant states that, given the fact that the domain name incorporates the name of the Complainant, the Respondent has no reason for registering the complainant's trade name and founder's name, Lana Marks, as a domain name. In that regard, the Complainant alleges that the domain name has no meaning or significance to the Respondent.

Hence, the Complainant concludes that the Respondent could not claim any legitimate interests in the contested domain name, comprised of the LANA MARKS trademark (plus the top level domain '.com' but without a space between the words).

iii) bad faith

The Complainant alleges that the Respondent registered the trademark as a domain name primarily for precluding the Complainant from reflecting its registered trademark in a corresponding domain name or for the purpose of renting, selling or otherwise transferring the domain name registration to the Complainant or a competitor thereof for payment above and beyond the costs incurred by the Respondent in securing its domain name registration.

According to the WHOIS database of NSI -- copies of the salient records have been provided in Annex F of the Complaint, the Complainant points to various domain names that identify widely-known individuals or organizations active in the fashion industry, the same industry as the Complainant, which the Respondent has registered. For example, these include the following domain names and their associated personal or organizational names: helenarubenstein.com (Helena Rubenstein), josephwards.com (Joseph Edwards), cybervogue.com (Vogue) and 1800boss.com (Hugo Boss). In Annex G, an affidavit is provided by the Complainant evidencing that when a website addressed by each of these domain names was accessed through a conventional web browser, a common error message, indicative of a lack of any relevant web server, was returned; hence, signifying that each of these domain names is not currently being used.

Furthermore, the Complainant points to another domain name, again through the WHOIS information provided in Annex F, registered by the Respondent that includes a name of an organization outside of the Respondent's industry; specifically 800hershey.com which includes, of which the Panel takes judicial notice, the very widely recognized third party trademark "Hershey" which has been in use, for at least several decades, and is currently used on an international basis in connection with candy.

B. Respondent

To date, the Respondent has not filed any response to the Complaint.

6. Discussion and Findings

In view of the lack of any response filed by the Respondent, SYP Web, this proceeding has proceeded by way of default. Hence, in the absence of any refuting evidence, all the facts and allegations submitted by the Complainant, Lana Marks, Ltd., Inc., are accepted as true.

Apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings:

A. Similarity

No doubt exists whatsoever that the domain name in question, while not absolutely identical to the Complainant's registered trademark ("LANA MARKS"), is clearly sufficiently similar to it as to cause a likelihood of confusion to arise between the relevant consumers of the Complainant and those who were to view the disputed domain name -- when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer the disputed domain name, were to start using the domain name in conjunction with goods similar to those of the Complainant. Such confusion, should it occur, would undoubtedly cause consumers to think that a relationship of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all.

The differences between the domain name and the registered trademark, being the deletion of a space between the words "LANA" and "MARKS", along with appending of a top-level domain (.com) are so de minimis as to be utterly inadequate to preclude any such confusion from occurring.

As such, the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy.

In fact, for the reasons set forth below with respect to Illegitimacy and Bad Faith, given the conduct of SYP Web, as evidenced by its registrations of various domain names bearing very high degrees of similarity to the names of other contemporary renown individuals or organizations in the fashion industry, and one in an unrelated industry, the Panel concludes that:

- (i) SYP Web intentionally chose the contested domain name for its high and nearly identical degree of similarity with the trademark under which the Complainant undertakes its business, and
- (ii) with the principal reason of causing consumer confusion to eventually occur in order to injure the Complainant's business and reputation should the domain name become active in an attempt to induce the Complainant to purchase the domain name from the Respondent (or from a third party to which the Respondent would transfer the domain name).

B. Illegitimacy

Based on the evidence submitted by the Complainant, the Panel makes the following findings regarding illegitimacy.

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its trademark in conjunction with the goods listed in its registration.

Furthermore, the trademark is highly distinctive and not descriptive of any goods with which the trademark is registered.

The Respondent has yet to provide any basis that would legitimize any claim it has to the trademark in connection with any goods or services which it might be providing. In fact, it is extremely unlikely that Respondent can even make such a claim. The simple reason is that the trademark includes the personal name of the CEO of the Complainant and, as the Panel infers from the Complaint, the Complainant has absolutely no relationship whatsoever with the Respondent. Hence, any use to which the Respondent were to put the trademark in connection with the goods listed in the registration would directly violate the exclusive trademark rights now residing in the Complainant.

In light of the above findings, the Panel is unpersuaded that the Respondent has any rights in the contested domain name, whether on a commercial or non-commercial basis.

Thus, the Panel finds that any use of the contested domain name by the Respondent is illegitimate within paragraph 4(a)(ii) of the Policy.

C. Bad Faith

The Respondent's repetitive conduct in registering various domain names, that included the names of contemporary individuals and organizations active in the same industry as the Complainant's as well as in an unrelated industry, appears to the Panel to evidence, at least inferentially, an intent by the Respondent, rather than to legitimize the use of the contested domain name, to:

- (a) eventually sell the contested domain name to the Complainant for an amount in excess of the costs of its registration, or to a third-party unrelated to the Complainant, or
- (b) prevent the Complainant, as lawful owner of the registered trademark "LANA MARKS", from reflecting its trademark in a corresponding domain name.

The Panel infers, based on a lack of any response from the Respondent, that the Respondent has no reasonable grounds to believe that any use which it has or will make of contested domain name constitutes fair or otherwise lawful use.

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith under paragraphs 4(a)(iii) of the Policy.

In this connection, the Panel additionally notes that, in the Panel's view, the Respondent's actions in registering the present domain name clearly evince bad faith in violation of the Anti-Cybersquatting provisions of the Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

Thus, the Panel concludes that the Complainant, apart from default of the Respondent, has provided sufficient proof of its allegations to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

In accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the relief sought by the Complainant is hereby granted. The domain name is ordered transferred to the Complainant. The Center is authorized to publish this entire decision in its discretion on a publicly accessible web site.

Peter L. Michaelson
Panelist

Dated: June 23, 2000