Decision for dispute CAC-UDRP-100286

Case number	**CAC-UDRP-100286**
Time of filing	**2011-08-03 10:21:26**
Domain names	**dyl.com**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**DYL, LLC**

Complainant representative

Name	**Marvin Kirby Roberts III**

Respondent

Name	**Lydia Lafont**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The complainant, DYL, is a Limited Liability Company formed and registered under the laws of the State of Ohio. It has used "DYL" as a trade name since formation and has a pending registration (applied for on July 25, 2011) for "DYL" before the USPTO (Serial No. 85380410) under ICs 009 & 035 for "software providing on-line telephone transfers, hosted CoIPL phone systems, and lead management for sales leads." Additionally, DYL is the owner of "Dial Your Leads", a trademark registered on March 1, 2011 with the USPTO (Registration No. 3924384) under IC 035 for "business referral services, namely, promoting the goods and services of others by passing business leads and orders to advertisers" and owns and operates the domain dialyourleads.com, where complainant offers such services as described above and sets its terms of use as DYL, LLC.

FACTUAL BACKGROUND

The complainant, DYL, is a Limited Liability Company formed and registered under the laws of the State of Ohio. It has used "DYL" as a trade name since formation and has a pending registration (applied for on July 25, 2011) for "DYL" before the USPTO (Serial No. 85380410) under ICs 009 & 035 for "software providing on-line telephone transfers, hosted CoIPL phone systems, and lead management for sales leads." Additionally, DYL is the owner of "Dial Your Leads", a trademark registered

on March 1, 2011 with the USPTO (Registration No. 3924384) under IC 035 for "business referral services, namely, promoting the goods and services of others by passing business leads and orders to advertisers" and owns and operates the domain dialyourleads.com, where complainant offers such services as described above and sets its terms of use as DYL, LLC.

The disputed domain name has been registered on 28 October 1997. The disputed domain name is presently not used to host a website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant considers the Disputed Domain Name "DYL.com" to be identical to the complainant's company name ("DYL"), tradename ("DYL"), pending trademark registration with the USPTO ("DYL"), and its common law trademark ("DYL"). Additionally, Complainant considers the Disputed Domain Name to be composed of an acronym that is confusingly similar to complainant's USPTO registered and common law trademark "Dial Your Leads".

Furthermore, Complainant considers Respondent not to have any rights or legitimate interest in the domain name and that such is shown by the fact that Respondent was merely passively holding the domain name.

Finally Complainant contends that the Disputed Domain Name was registered and is being used in bad faith.

RESPONDENT:

Respondent claims to be the CEO of DYL LLC France and to be active in the garment industry. Respondent states not to recognize any jurisdiction other than in France. Furthermore, Respondent argues that there can be no confusion between the Disputed Domain Name and Complainant’s trademark, since Respondent is not active in the same type of business. Respondent also claims to have a legitimate interest in the Disputed Domain Name as it would have been using the domain name mainly for communication purposes rather than for website activity. Respondent considers that this evidences the absence of bad faith.

RIGHTS

The Complainant has not shown, to the satisfaction of the Panel, that the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has not shown , to the satisfaction of the Panel, that the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”
Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:

1) the domain name is identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain name; and
3) the domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

Complainant has established that it has prior rights in its business name ‘DYL LLC’ and that it has applied for a trademark registration with the USPTO for the word mark ‘DYL’. The trademark application shows that Complainant’s first use in commerce of the DYL word mark dates back from 31 May 2009. However, Complainant does not show that its applied-for trademark has acquired secondary meaning. Hence, Complainant does not show to have any registered or common law trademark rights in ‘DYL’ at the moment of filing of its complaint.

On the other hand, Complainant has registered trademark rights in the word mark ‘Dial Your Leads’. Complainant asserts that the disputed domain name ‘dyl.com’ is confusingly similar to its ‘Dial Your Leads’ trademark, as ‘DYL’ would be an acronym of Complainant’s trademark.The Panel finds that the mere fact that the disputed domain name could be an acronym, as it is composed of the first letters of each individual word that composes the trademark, is insufficient to decide that there is confusing similarity between the disputed domain name and the ‘Dial Your Leads’ trademark. At least, Complainant should demonstrate that the ‘Dial Your Leads’ trademark is known by its acronym and that the acronym acquired secondary meaning. However, Complainant fails to show that ‘DYL’ is a known acronym of the ‘Dial Your Leads’ trademark or that it has any secondary meaning.

Accordingly, the Panel finds that the first requirement of paragraph 4(a) of the Policy has not been met.

B. Rights or Legitimate Interest

Under paragraph 4(a)(ii) of the Policy, Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established in previous UDRP decisions that it is sufficient for Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to Respondent. (See Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO Case No. D2005 1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003 0455; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. 2004 0110).

Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorised Respondent to use or apply for any domain name incorporating Complainant’s business name or applied-for trademark. Respondent does not appear to make any legitimate use of the domain name for non-commercial activities.

In fact, Respondent is making no use of the disputed domain name. Respondent claims that it uses the domain name mainly for communication purposes rather than for website activity, but provides no evidence of the use of the domain name for communication purposes. Furthermore, the parking page to which the disputed domain name refers, mentions that the website is under construction and coming soon. This does not seem to be in line with Respondent’s statement that the domain name is not intended for website activity.

Respondent also claims to be the CEO of a French company named 'SARL DYL'. In order to corroborate this statement, Respondent provides an alleged letter of the French tax authorities where mention is made of 'SARL DYL'. However, this letter does not contain any signature and does not show that Respondent is the CEO of a company named 'SARL DYL'. If Respondent actually is the CEO of such company, Respondent would not have had any difficulty to show this with conclusive evidence, such as articles of incorporation. Respondent fails to do this.

As a result, Complainant has made a prima facie case that Respondent has no right or legitimate interest in the disputed domain name and Respondent has failed to provide proof to the contrary.

C. Registration and use in bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith. (See BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007, where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of telecommunications services suffix ("voip") suggested knowledge of the complainant's rights in the trademarks).

In the present case, the disputed domain name has been registered on 28 October 1997. It is unclear that Complainant was already active under the name 'DYL LLC' at the time of registration of the disputed domain name. Moreover, the first use in commerce of the 'DYL' trademark appears to date back form 31 May 2009, long after the disputed domain name has been registered. Also, Complainant does not show to be active outside the United States, whereas Respondent is located in France.

Given the above, it is very unlikely that Respondent knew about Complainant at the time of registering the disputed domain name. According to the Panel, the mere fact that Respondent did not use the disputed domain name, is insufficient to prove that the disputed domain name has both been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **DYL.COM**: Remaining with the Respondent

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2011-09-19

Publish the Decision