# Decision for dispute CAC-UDRP-100651

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| Case number | **CAC-UDRP-100651** |
| Time of filing | **2013-08-21 15:25:40** |
| Domain names | **voomy.com** |

## Case administrator

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| Name | **Lada Válková (Case admin)** |

## Complainant

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| Name | **Vitalii Stavropolskyi** |

## Complainant representative

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| Name | **Sergii Barinov** |

## Respondent

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| Name | **Daniel Shen** |

IDENTIFICATION OF RIGHTS

The Complainant owns Ukraine registered trademark No. 87546 for VOOMY registered on November 11, 2008 upon application made on September 13, 2006 and international registered trademark No. 1165718 for VOOMY, registered on November 23, 2012 in the European Union (CTM), United States of America, Israel, Belarus, Kazakhstan and Russian Federation.

FACTUAL BACKGROUND

The Complainant is the founder and CEO of the VOOMY IT-park project in the Ukraine, a technology and business centre being developed in the city of Kharkiv which will start to operate in early 2014, offering a range of services to startups, IT-companies and individual IT-freelancers under the ‘VOOMY’ trademark.

The disputed domain name <voomy.com> (the "Domain Name") was registered by the Respondent on June 6, 2004.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Some of the VOOMY IT-park services have been provided to IT-startups by the Complainant under the ‘VOOMY’ trademark since the beginning of 2012. The ‘VOOMY’ trademark has been in active use in commerce since the beginning of 2012 being a well-known brand among the relevant group in Ukraine and abroad in connection with the VOOMY-IT park project.

The Complainant intends to use the Domain Name for international commercial and promotion purposes in all countries covered by ‘VOOMY’ trademark protection as the TLD ‘.com’ is more favourable, credible and advantageous for international commercial activity than the national Ukrainian ccTLD ‘.ua’. It should be particularly emphasized that the international business activity of the Complainant will be expanded to the USA as the Silicon Valley of California is a renowned high-tech startups world center.

The Domain Name is confusingly similar to the Complainant's VOOMY trademark and the Respondent has no rights or legitimate interests with respect to the Domain Name, which was registered and is being used in bad faith.

As to legitimacy, according to WHOIS information, the Respondent has owned the Domain Name since 2004. Hitherto the Domain Name has not been used by the Respondent at all and at present there is no <voomy.com> website. To the Complainant’s knowledge the Respondent is not commonly known by the Domain Name and does not hold any trademark, company name or any other relevant rights to a name which corresponds to the Domain Name. The Respondent is not affiliated with or authorized by the Complainant in any way to use the name ‘VOOMY’.

As to bad faith, it was obvious from the <voomy.com> web-site that the Respondent had been passively holding the Domain Name with the purpose of selling it because the message ‘this domain is available for sale for $950 USD" was displayed at the relevant webpage. When contacted by the Complainant, the Respondent confirmed that the Domain Name was for sale and said he could sell it directly or through the Sedo.com domain brokerage service. The Complainant decided to buy the Domain Name through Sedo.com for reasonable compensation for the Respondent's costs of registration and transfer of the Domain Name to the Complainant. In contrast the Respondent demanded from the Complainant through the Sedo.com broker the amount of $25 000 USD and then $15 000 USD, prices which much exceeded the initially published selling price of $950 USD.The Respondent increased the selling price after he became aware that the Complainant was known under the ‘VOOMY’ trademark and that the name ‘VOOMY’ was actively used by the Complainant in commerce. So the Complainant ceased negotiations with the Respondent. Now the Domain Name is not used by the Respondent in any way and is not available at all.

It is the Respondent's usual practice to register domain names for the purpose of selling them since there was a message displayed on the <voomy.com> web-page that ‘other domains are available for sale’ with a list of 22 domain names including some very similar to voomy.com such as vomy.com, voomee.com, voomi.com, voomie.com, vumee.com, vumi.com, vumie.com.

The passive holding of the Domain Name by the Respondent with the purpose of selling it to the Complainant for valuable consideration in excess of the holder’s documented out-of-pocket costs directly related to the Domain Name infringes the Complainant’s rights. As established in a number of prior cases, the concept of ‘bad faith use’ in paragraph 4 (b) of the Policy includes not only positive action but also passive holding; e.g. case SOCIETE GENERALE v. William Hughes, ADR.eu UDRP Case No. 100588.

RESPONDENT:
Voomy is a private online accounting system tailored towards the needs of property owners who want a robust experience, but have needs that are not fulfilled by traditional systems. I put a great deal of effort developing this site over a period of several years, and am preparing for an official launch soon.

To showcase the site's functionality, it is necessary to login to the site. Selecting, say, the Account tab, enables drilling down

to explore the different accounts, add/delete entries, etc. The account balances should automatically change, and the Trial Balance tab will auto-update and reconcile all accounts. The Properties tab keeps track of assets, ownership percentage, disposal information, and profit margins (if any). The site was built using Java and Google Web Toolkit on the front-end, and MySQL database on the back-end. It employs more advanced web technologies such as AJAX and DHTML, and is cross-browser compatible.

In preparation for launch, I am also re-directing <voomee.com> and <voomie.com> to the site, in case the user misspells it.

I have no intention of stealing traffic away from the Complainant in the Ukraine. My clients are all strictly U.S.-based. I don't believe there is anything outwardly appearing on the site which would indicate an intent to deceive a user about the nature of the site. The Complainant's Voomyitpark.com appears to be an actual phyical building for professionals to congregate and work, which is obviously quite orthogonal to my online accounting program. The Complainant's fancy Flash introduction is diametrically opposite to my site's plain-and-simple approach. As the site develops further and my branding takes shape, it will be even more clear this online accounting program has nothing to do with the Complainant's Ukrainian-based business.

COMPLAINANT'S REPLY:

The Respondent`s answer as to how he uses the Domain Name is aimed to deceive the Panel and make a false impression of the Respondent`s right or legitimate interest in the Domain Name for the following reasons .

The Respondent started to make attempts to demonstrate that he uses the Domain Name in connection with a bona fide offering of his goods or services only after getting notification from the Complainant and from the ADR.eu about the commencement of this administrative proceeding.

The Respondent says he put a great deal of effort into developing this site over a period of several years. But right before the commencement of this proceeding the Domain Name had not been used by the Respondent and the website was entirely unavailable due to the message ‘This web-page is not available...’ as is shown in an attachment to the Complaint that was made just before the beginning of this proceeding.

For several years the Domain Name was only for sale and the website contained only a message ‘this domain is available for sale`, as shown in the Complaint as at December 26, 2012.

Moreover the Respondent attempted to sell the Domain Name to the Complainant in 2012 notwithstanding that according to the Response the Respondent at the same time must have been making his great, difficult and long work in developing the site <voomy.com>.

A short time after receiving notification of the commencement of this proceeding, the Respondent connected the Domain Name to an inactive and empty web-site named `The Voomy room` that purported to be a site of a Mrs. Smith`s Classroom. But according to the Response <voomy.com> is a private online accounting system. Such holistic and incompatible changes in target use and functionality of the <voomy.com> site is further evidence that Respondent is not interested in using the Domain Name in connection with a bona fide offering of his goods or services.

It is clear from the Complaint that the Complainant`s services are not limited only by the physical building located in Ukraine but the Complainant will offer such services as financing, marketing, promoting and business-incubating etc. for small business and IT-startups in all the countries covered by protection of his trademark `VOOMY` and ante omnia in the US.

The word `voomy` is an adjective from the noun `va-va-voom` which means `the quality of being exciting, vigorous, or sexually attractive. This word originated in the US in the 1950s, representing the sound of a car engine being revved. The motto of the Complainant`s business is `The business that makes go va-va-voom`. The Complainant owns a relevant trademark and uses this motto in his web-sites. The Respondent, in contradistinction to this, is not commonly known by the Domain Name and does not hold any trademark, company name or any other relevant rights to the name which corresponds to the Domain Name.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the Domain Name is identical and confusingly similar to the registered trademark VOOMY, in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

In light of the Panel's decision in relation to bad faith, it is unnecessary to determine whether the Complainant has 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 failed to show, 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, which requires a showing of both bad faith registration and bad faith use).

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

The Panel accepts that the word "voomy" is an adjective from the noun `va-va-voom`, meaning `the quality of being exciting, vigorous, or sexually attractive, originating in the US in the 1950s and representing the sound of a car engine being revved.

The Domain Name is clearly identical and therefore confusingly similar to the Complainant's registered VOOMY trademark, the gTLD ".com" being inconsequential and to be disregarded: Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525; Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429.

The Respondent's unsupported explanation that he has been preparing for some years to use the Domain Name for a private accounting system is hard to reconcile with the Complainant's evidence that the Domain Name was simply offered for sale, together with others, for some years. The Panel prefers the Complainant's evidence in this regard.

The position established on the material before the Panel is that in 2004 the Respondent registered as the Domain Name an adjective formed from an uncommon noun and thereafter used the Domain Name passively for several years by posting on his website a notice that the Domain Name was for sale for US$950. When the Complainant sought to buy it between April and October, 2012, the Respondent greatly increased his asking price, no doubt because he discovered the connection between the Complainant and the VOOMY trademark. Upon these proceedings being brought, the Respondent has put forward an unconvincing submission that he has been engaged for years in preparation to use the Domain Name for an accounting system, a submission not supported by any evidence and contradicted by his proven willingness to sell the Domain Name as recently as 2012.

The question for determination is whether, in these circumstances, the Complainant has established both bad faith registration and bad faith use. The Panel determines that he has not done so.

"A complainant is generally expected to show both the respondent’s knowledge of the relevant mark at the time of registration of the subject domain name (whether actual, constructive, or inferred from circumstances of willful blindness), and the respondent’s intent to target or benefit in some way from inclusion of the complainant’s mark in the subject domain name": China Care Foundation, Inc. v. Choi Yun Gul, WIPO Case No. D2010-1208. See also Validas, LLC v. SMVS Consultancy Private Limited, WIPO Case No. D2009-1413 and the majority opinion in A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc., WIPO Case No. D2010-0800.

Here, accepting the Complainant's evidence in its entirety, because the Domain Name was registered in 2004, a little over 2

years before the Complainant first applied to register his VOOMY trademark, and in the absence of any evidence that the Complainant had acquired unregistered trademark rights prior to the registration of the Domain Name, the Panel is unable to find that the Respondent had the Complainant or his VOOMY trademark in mind when the Respondent registered the Domain Name.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of both the registration and use of the domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, including:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name.

The mere offering of a domain name for sale for more than the out-of pocket costs directly related to the domain name does not constitute evidence of bad faith registration and use within Rule 4(b)(i). That sub-paragraph of the Rule requires a showing that the Respondent registered or acquired the Domain Name primarily for the purpose of selling it to the Complainant or to a competitor of the Complainant for a price exceeding those costs: The World Phone Company (Pty) Ltd v. Telaccount Inc., WIPO case No. D2000-1163. Here, as mentioned, there is no evidence that the Respondent had the Complainant or any competitor of the Complainant in mind when he registered the Domain Name, 2 years before the Complainant applied to register VOOMY as a trademark, so even though the Respondent appears to have registered the Domain Name in order to sell it, there is no basis for a finding that he did so primarily for the purpose of selling it to the Complainant or to a competitor of the Complainant. This leads inescapably to a finding that the Complainant has failed to establish bad faith registration.

The Complainant invokes the principle of "passive use" formulated in Telstra Corp. v. Nuclear Marshmallows, WIPO Case No. D2000-0003 and followed such cases as SOCIETE GENERALE v. William Hughes, ADR.eu UDRP Case No. 100588, DCI S.A. v. Link Commercial Corp., WIPO Case No. D2000-1232 and Clerical Med. Inv. Group Ltd. v. Clericalmedical.com, WIPO Case No. D2000-1228. In each of those cases, however, the Complainant's trademark rights existed prior to registration of the domain name and the respondent was found likely to have been aware of the trademark at the time of registration. None of those cases provide support for the proposition that passive use can demonstrate both bad faith registration and bad faith use in the circumstances of this case, in which the Respondent cannot have had the Complainant or his yet to be acquired VOOMY trademark in mind when registering the Domain Name.

Accordingly the Panel finds that the Complainant has failed to establish the elements necessary to entitle him to relief.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

## PANELLISTS

| Name | **Alan Limbury** |
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DATE OF PANEL DECISION 2013-09-27

Publish the Decision