

DECISION

NYSE Group, Inc. v. Val Sklarov / BentleyTek / America 2030 Capital
Claim Number: FA1709001748855

PARTIES

Complainant is **NYSE Group, Inc.** (“Complainant”), represented by **Richard L. Cruz** of **DLA Piper LLP**, Pennsylvania, USA. Respondent is **Val Sklarov / BentleyTek / America 2030 Capital** (“Respondent”), Ukraine.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<nyseloan.com>**, **<nyse-loan.com>**, **<nyseloans.com>**, **<nyse-loans.com>**, **<nyse.tips>**, **<nysetrading.net>**, **<nysemarket.net>**, **<nyse.email>**, **<nyse.vip>**, **<nyse.pro>**, **<nyse-exchange.com>**, **<nyse.technology>**, **<nyse-trading.org>**, **<nyse.cloud>**, **<nyse.directory>**, **<nyse.rocks>**, **<nyse-stocks.com>**, **<nyse-trader.net>**, **<nyse-trading.net>**, **<nyse-trader.com>**, and **<nyse.solutions>**, registered with **GoDaddy.com, LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Daniel B. Banks, Jr., as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on September 13, 2017; the FORUM received payment on September 14, 2017.

On Sep 14, 2017, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the **<nyseloan.com>**, **<nyse-loan.com>**, **<nyseloans.com>**, **<nyse-loans.com>**, **<nyse.tips>**, **<nysetrading.net>**, **<nysemarket.net>**, **<nyse.email>**, **<nyse.vip>**, **<nyse.pro>**, **<nyse-exchange.com>**, **<nyse.technology>**, **<nyse-trading.org>**, **<nyse.cloud>**, **<nyse.directory>**, **<nyse.rocks>**, **<nyse-stocks.com>**, **<nyse-trader.net>**, **<nyse-trading.net>**, **<nyse-trader.com>** and **<nyse.solutions>** domain names are registered with GoDaddy.com, LLC and that Respondent is the current registrant of the names. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On September 18, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 10, 2017 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent’s

postmaster@nyse.email, postmaster@nyse.vip, postmaster@nyse.pro, postmaster@nyse-exchange.com, postmaster@nyse.technology, postmaster@nyse-trading.org, postmaster@nyse.cloud, postmaster@nyse.directory, postmaster@nyse.rocks, postmaster@nyse-stocks.com, postmaster@nyse-trader.net, postmaster@nyse-trading.net, postmaster@nyse-trader.com, postmaster@nyse.solutions. Also on September 18, 2017, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on October 9, 2017.

On October 13, 2017, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Daniel B. Banks, Jr., as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant, NYSE Group, Inc., operates the leading global exchange for trading in securities under its iconic brand. In connection with this business, Complainant uses the NYSE mark. Complainant has rights in the NYSE mark based upon multiple registrations with the United States Patent and Trademark Office ("USPTO") as well as other national trademark agencies (e.g. Reg. No. 909,350, registered Mar. 2, 1971). Respondent's domain names are confusingly similar to the NYSE mark, as they each contain the mark in its entirety, to which generic terms such as "loans," "trading," "stock," "market," and "exchange" have been added. In some instances, the additional generic terms are part of the domain name and the generic top-level domain ("gTLD") ".com," ".org," or ".net" is added; in other instances, the domain name consists exclusively of Complainant's NYSE mark, and the only change is the addition of a descriptive gTLD.

Respondent has no rights or legitimate interests in the disputed domain names. Respondent is not commonly known by the domain names, nor has Complainant licensed or authorized Respondent to use the NYSE mark for any reason. Respondent's use of the domain names does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial fair use. Rather, each of the domain names resolves to a parked page.

Internet users. Also, Respondent is failing to actively use the names. Finally, due to the fame and notoriety of Complainant's NYSE mark, and the fact that many of the disputed domain names were registered within minutes of Respondent responding to a cease-and-desist letter from Complainant; Respondent clearly registered the domain names opportunistically in bad faith.

B. Respondent

Complainant does not have rights in the NYSE mark throughout the world, specifically in Ukraine, where Respondent resides. Complainant does not conduct business in Ukraine, and does not target Ukrainian customers. Ukraine is a sovereign country which has its own Trademark and Patent Office and does not adhere to trademark protection on its territory afforded to third parties in other countries. Further, the letters "Y" and "S" do not exist in the Cyrillic alphabet, so Ukrainian consumers would not be confused by the domain names.

Respondent intends to launch a website named "New York Services Enterprise" ("NYSE") which will offer mortgages, business and real estate loans, auto loans, insurance, credit card financial consulting, real estate sales and construction services to customers in Ukraine. Respondent has been offering these services since March 2015 under the name "America 2030 Capital, LLC."

Respondent did not and could not have bought the domain names in bad faith because Complainant has no trademark protection in Ukraine. Respondent did not purchase the domain names in order to disrupt the business of Complainant, because Complainant does not conduct business in Ukraine, and Respondent is involved in a different business than Complainant. Respondent could not have known of Complainant's NYSE mark, because the mark does not exist in Ukraine.

FINDINGS

- 1 - The disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights.
- 2 - Respondent has no rights or legitimate interests in respect of the domain names.
- 3 - The domain names have been registered and are being used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "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 requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

Identical and/or Confusingly Similar

Complainant claims rights in the NYSE mark based upon registration of the mark with the USPTO (e.g. Reg. No. 909,350, registered Mar. 2, 1971). Registration of a mark with the USPTO is sufficient to establish rights in that mark. *See Home Depot Product Authority, LLC v. Samy Yosef / Express Transporting*, FA 1738124 (FORUM July 28, 2017) (finding that registration with the USPTO was sufficient to establish the complainant's rights in the HOME DEPOT mark). The fact that the mark is not registered in the jurisdiction of Respondent is not dispositive in a Policy ¶ 4(a)(i) analysis. *See Viber Media S.à r.l. v. Kristaps Sirmals / SIA "FULL FACTORY"*, FA 1626671 (FORUM Aug. 4, 2015) ("Accordingly, even though Respondent reportedly resides in Latvia, the Panel finds that Complainant's USPTO registration is sufficient under Policy ¶ 4(a)(i)."). The Panel finds that Complainant's registration of the NYSE mark with the USPTO is sufficient to establish rights in the mark under Policy ¶ 4(a)(i).

Complainant also complains that the disputed domain names are identical or confusingly similar to the NYSE mark:

Complainant contends the <nyse.tips>, <nyse.email>, <nyse.vip>, <nyse.pro>, <nyse.technology>, <nyse.cloud>, <nyse.directory>, <nyse.rocks>, and <nyse.solutions> are identical to the NYSE mark, as they each consist entirely of the mark and merely add various gTLDs to the mark. Addition of a gTLD to mark is insufficient to distinguish the domain name from the mark for the purposes of Policy ¶ 4(a)(i). *See Marquette Golf Club v. Al Perkins*, FA 1738263 (FORUM July 27, 2017) ("When a respondent's domain name incorporates a mark in its entirety and merely adds a generic top-level domain (gTLD), ".com", then the Panel may find that the disputed domain name is identical to Complainant's mark."). Complainant contends that some of the gTLDs chosen by respondent are descriptive and may enhance the confusing similarity. The Panel therefore finds the nine domain names to be identical to the NYSE mark for the purposes of Policy ¶ 4(a)(i).

Complainant also asserts that the <nyseloan.com>, <nyse-loan.com>, <nyseloans.com>, <nyse-loans.com>, <nysetrading.net>, <nysemarket.net>, <nyse-exchange.com>, <nyse-trading.org>, <nyse-stocks.com>, <nyse-trader.net>, <nyse-trading.net>, and <nyse-trader.com> domain names are confusingly similar to the mark, as they each contain the NYSE mark in its entirety and merely adds one of the descriptive terms "loan," "loans," "trading," "market," "exchange," "stocks," or "trader;" and a gTLD. Some also add a hyphen. Addition of a descriptive or generic term and a gTLD are insufficient to distinguish a mark from a domain name per Policy ¶ 4(a)(i). *See Microsoft Corporation v. Thong Tran Thanh*, FA 1653187 (FORUM Jan. 21, 2016) (determining that confusing similarity exists where [a disputed domain name] contains Complainant's entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy). Also, the addition of hyphens is irrelevant in a Policy ¶ 4(a)(i) confusing similarity analysis. *See Health Devices Corp. v. Aspen S T C*, FA 158254 (FORUM July 1, 2003) ("[T]he addition of hyphens to a domain name does not distinguish it from the domain name of a complainant.

Rights or Legitimate Interests

The Panel finds that Complainant has made a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain names under Policy ¶ 4(a)(ii). The burden then shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (FORUM Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (FORUM Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant argues that Respondent has no rights or legitimate interests in the disputed domain names, as Respondent is not commonly known by the disputed domain names, nor has Complainant authorized Respondent to use the NYSE mark in any way. In a Policy ¶ 4(c)(ii) analysis, WHOIS information can support a finding that the respondent is not commonly known by a disputed domain name. *See Chevron Intellectual Property LLC v. Fred Wallace*, FA1506001626022 (FORUM July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under Policy ¶ 4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name). The WHOIS information of record identifies Respondent as “Val Sklarov.” Additionally, lack of evidence in the record to indicate that the respondent had been authorized to register a domain name using a complainant’s mark supports a finding that Respondent does not have rights or legitimate interests in said domain name. *See Navistar International Corporation v. N Rahman*, FA1505001620789 (FORUM June 8, 2015) (finding that the respondent was not commonly known by the disputed domain name where the complainant had never authorized the respondent to incorporate its NAVISTAR mark in any domain name registration). The Panel finds, under Policy ¶ 4(c)(ii), that Respondent has not been commonly known by the disputed domain names.

Complainant argues that Respondent’s lack of rights and legitimate interests in the disputed domain names is demonstrated by its failure to use the names to make a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use. Rather, Complainant contends each of the domain names resolves to a parked page, which is not a use indicative of rights or legitimate interests per Policy ¶¶ 4(c)(i) or (iii). *See Kohler Co. v. xi long chen*, FA 173791 (FORUM Aug. 4, 2017) (“Respondent has not made a *bona fide* offering of goods or services, or legitimate non-commercial or fair use of the domain. Respondent’s <kohler-corporation.com> resolves to an inactive webpage displaying the message “website coming soon!” Respondent’s domain names each resolve to a page which only states “website coming soon.” The Panel therefore finds that Respondent lacks rights or legitimate interests in the disputed domain names.”).

Registration and Use in Bad Faith

Complainant argues that Respondent has registered the disputed domain names in bad faith as part of a pattern of such bad faith registrations. Bad faith registration and use can be demonstrated under Policy ¶ 4(b)(ii) through a showing of a history of such registrations, multiple registrations containing a complainant's mark. *See Australian Stock Exch. v. Cmr Internet (Australia) Pty Ltd*, D2000-1384 (WIPO Nov. 30, 2000) (finding bad faith under Policy ¶ 4(b)(ii) where the respondent registered multiple infringing domain names containing the trademarks or service marks of other widely known Australian businesses); *see also Microsoft Corporation and Skype v. zhong biao zhang / Unknown company / zhong zhan*, FA1401001538218 (FORUM Feb. 20, 2014) (holding that the respondent's registration of three domain names incorporating variants of the complainant's SKYPE mark reflected a pattern of bad faith registration under Policy ¶ 4(b)(ii)). Complainant claims Respondent has registered domain names incorporating the well-known marks of other companies in the financial sector. *See Compl. Annexes Z-AA*. The Panel notes that Respondent has registered 21 domain names containing the NYSE mark. The Panel therefore finds that Respondent registered and used the domain names in bad faith per Policy ¶ 4(b)(ii).

Complainant also contends that Respondent registered the disputed domain names in order to confuse and attract Internet users. Such use can demonstrate bad faith per Policy ¶ 4(b)(iv). *See DatingDirect.com Ltd. v. Aston*, FA 593977 (FORUM Dec. 28, 2005) ("the Panel finds that the respondent is appropriating the complainant's mark in a confusingly similar domain name for commercial gain, which is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iv)."); *see also Phat Fashions, LLC v. Kruger*, FA 96193 (FORUM Dec. 29, 2000) (finding bad faith under Policy ¶ 4(b)(iv) even though the respondent has not used the domain name because "it makes no sense whatever to wait until it actually 'uses' the name, when inevitable when there is such use, it will create the confusion described in the Policy"). Complainant contends that its NYSE mark is so notorious that any use of the domain names by Respondent would be infringing. The Panel agrees and finds Respondent to have registered and used the domain names in bad faith per Policy ¶ 4(b)(iv).

Complainant also asserts, along the same lines, that Respondent's registration and use of the domain names was opportunistic. Opportunistic bad faith can be found when a complainant can show the registration of a domain name was done in order to take advantage of the complainant's famous mark. *See Twitch Interactive, Inc. v. Jason Hardwick*, FA150100160132 (FORUM Feb. 25, 2015) (finding that the respondent had engaged in opportunistic bad faith pursuant to Policy ¶ 4(a)(iii), where the respondent registered the <twitchtv.net> domain name just two days after the complainant's launch announcement for TwitchTV (which received widespread news coverage)); *see also Arizona Board of Regents, for and on behalf of Arizona State University v. Weiping Zheng*, FA1504001613780 (FORUM May 28, 2015) (finding that the respondent had acted in opportunistic bad faith according to Policy ¶ 4(a)(iii), when it registered the disputed domain name just one week after the complainant filed applications to register the SUB DEVIL LIFE mark, and just days after those applications became public through the USPTO's website). The Panel finds that Respondent acted in bad faith in registering and using the domain names in bad faith per Policy ¶ 4(b)(iv).

letter acknowledging Complainant's rights in the NYSE mark. The Panel therefore finds Respondent to have registered and used the disputed domain names in bad faith per Policy 4(a)(iii).

Complainant also contends that Respondent is not actively using the disputed domain names which further demonstrates its bad faith. Inactive holding of a domain name can demonstrate bad faith per Policy ¶ 4(a)(iii). *See VideoLink, Inc. v. Xantech Corporation*, FA150300160873 (FORUM May 12, 2015) ("Failure to actively use a domain name is evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii)."). The evidence establishes that the disputed domain names do not resolve to active websites. The Panel finds that Respondent's failure to make an active use of the domain names demonstrates its bad faith per Policy ¶ 4(a)(iii).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <nyselloan.com>, <nyse-loan.com>, <nysel loans.com>, <nyse-loans.com>, <nyse.tips>, <nysetrading.net>, <nysemarket.net>, <nyse.email>, <nyse.vip>, <nyse.pro>, <nyse-exchange.com>, <nyse.technology>, <nyse-trading.org>, <nyse.cloud>, <nyse.directory>, <nyse.rocks>, <nyse-stocks.com>, <nyse-trader.net>, <nyse-trading.net>, <nyse-trader.com>, and <nyse.solutions> domain names be **TRANSFERRED FROM RESPONDENT TO COMPLAINANT**.

Daniel B. Banks, Jr., Panelist

Dated: October 23, 2017