



# CPR Institute for Dispute Resolution

## COMPLAINANT

JVC Americas Corp.  
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Wayne, NJ 07470  
Tel.#212.907.7337  
Fax #212.754.0330  
E-mail:rtaffet@golenbock.com

File Number: CPR 007

Date of Commencement: September 22, 2000

Domain Name(s): <jvc-america.com>

Registrar: Network Solutions, Inc.

Arbitrator: Honorable Nelson A. Diaz

vs.

## RESPONDENT

Damian Macafee  
69 Charlotte Street  
London, W1P 1LA,UK  
Tel.#unknown  
Fax #unknown  
E-mail: macafee@mail.be

Before The Honorable Nelson A. Diaz, Arbitrator

### 1. The Parties

Complainant is JVC Americas Corp. ("Complainant"), located at 1700 Valley Road, Wayne, NJ, 07470. Complainant is represented by Richard S. Taffet.

Respondent is Damian Macafee ("Respondent"), located at 69 Charlotte Street, London, W1P 1LA, UK. Respondent filed no response and therefore was not represented.

### 2. The Domain Name and Registrar

The domain name at issue is <jvc-america.com>. The registrar is Network Solutions, Inc. (the "Registrar"), 505 Huntmar Park Dr., Herndon, Virginia 20170-5139 USA.

### 3. Procedural History

CPR Institute For Dispute Resolution ("CPR") received the Complaint on September 20, 2000. CPR verified that the Complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the

Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”). Pursuant to paragraph 2(a) of the Rules, CPR thereafter sent the Respondent a notification of the administrative proceeding together with copies of the Complaint. No response was received.

As Respondent did not submit a response to the Complaint within twenty (20) days pursuant to Rule 5(a), the Administrative Panel issues its decision below based upon the Complaint, the filed documents, the Policy, the Rules, and the Supplemental Rules without the benefit of any response from Respondent.

#### **4. Factual Background**

The trademark on which the complaint is based is “JVC”. The JVC trademark is owned and maintained by the Victor Company of Japan, Ltd. and is subject to United States Patent and Trademark Office Reg. No. 0759231, issued on October 29, 1963; Reg. No. 0746171, issued on March 5, 1963 and Reg. No. 1200874, issued on July 13, 1982.

For more than 30 years, the Complainant has been doing business under the name JVC. Complainant has expended substantial time, effort and funds to develop numerous trademarks and service marks, including the mark, JVC, which is used in connection with consumer and professional electronic products. JVC brand products are sold through more than 2,000 dealers in the United States, and in more than 100 countries around the world. JVC spends millions of dollars annually to promote and market the JVC name in connection with JVC brand products.

Respondent registered the domain name <jvc-america.com> on May 9, 2000. On May 26, 2000, General Counsel for JVC sent a letter to Respondent demanding that he cease and desist from further use of the domain name. On or about September 6, 2000, Respondent indicated to a third party by e-mail that he had full knowledge of and familiarity with JVC and its products. He stated that he “like[s] JVC as a company, and for its products.” In this e-mail, Respondent made it clear that he would be willing to release the domain name in question in return for money, other URLs or JVC merchandise.

#### **5. Parties’ Contentions**

- A. Complainant contends that the domain name <jvc-america.com> is substantially similar to Complainant’s JVC mark.
- B. Complainant contends that Respondent has no rights or legitimate interest in the disputed domain name.
- C. Complainant contends that Respondent registered and is using the domain name in bad faith in violation of the Policy.
- D. Respondent does not contest these contentions.

## 6. Discussion and Conclusions

The undersigned certifies that he has acted independently as the Presiding Panelist and that he has no known conflicts of interest to serve as the Arbitrator in this proceeding. Having been duly selected, and being impartial, the undersigned provides the following discussions and conclusions:

To obtain the requested relief, paragraph 4(a) of the Policy requires the Complainant to prove each of the following:

- i. That the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. That the Respondent has no rights or legitimate interest in the domain name; and
- iii. That the domain name has been registered and used in bad faith.

### A. Similarity Between Registrant's Domain Name and Complainant's Trademark.

Under paragraph 4(a) of the Policy, it is clear that the domain name registered by Respondent, <jvc-america.com>, is substantially similar to, and, in fact, nearly identical to Complainant's JVC mark. The addition of the geographic descriptor, America, is not significant in determining similarity, particularly where the owner of the mark is known as JVC Americas Corp. The panel concludes that Complainant has met its burden of proof on the first prong and that the domain name is confusingly similar to Complainant's trademark.

### B. Respondent's Rights or Legitimate Interest in the Domain Name.

Under paragraph 4(c) of the Policy, evidence of a registrant's rights or legitimate interest in the domain name includes:

- i. Demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services prior to the dispute;
- ii. An indication that the registrant has been commonly known by the domain name even if it has acquired no trademark rights; or
- iii. Legitimate noncommercial or fair use of the domain name without intent to divert consumers or to tarnish the trademark.

Respondent has not shown, and cannot show, that it has made any legitimate use of the disputed domain name which is confusingly similar to the trademark of Complainant that has been widely and continuously used in commerce for more than 30 years. Complainant has met its burden of proof with regard to the second prong under paragraph 4(a).

C. Respondent's Bad Faith Registration and Use of the Domain Name.

Under paragraph 4(b) of the Policy, evidence of Respondent's bad faith registration and use includes:

- i. Circumstances indicating the domain name was registered for the purpose of resale to the trademark owner or competitor for profit;
- ii. A pattern of conduct showing an attempt to prevent others from obtaining a domain name corresponding to their trademarks;
- iii. Registration of the domain name for the purpose of disrupting the business of competitor; or
- iv. Using the domain name to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with the trademark owner's mark.

Complainant has provided documentary evidence that Respondent offered to relinquish the domain name for money, other URLs or JVC merchandise and thus violated prohibition under paragraph 4(b)(i) against selling domain names for profit.

Additionally, under the terms of Respondent's registration agreement with the Registrar, as well as the terms of the Policy paragraph 2(b), Respondent was required upon registration to represent and warrant that the registration did not infringe upon, nor otherwise violate, the rights of any third party. The Panel, in its discretion, finds that in view of the fame and substantial goodwill associated with Complainant's trademark, JVC, Respondent knew or should have known that registration of <jvc-america.com> was likely to violate another's intellectual property rights. Under the circumstances, the Panel finds that Respondent registered the domain name in bad faith.

Finally, Respondent's bad faith use of the domain name is clearly demonstrated by his inaction, that is, his passive holding of the domain name <jvc-america.com> to the exclusion of Complainant, the owner of the JVC mark. In the now famous Telstra case, it was firmly established that inaction and passive holding of a domain name satisfies the bad faith requirements of the Policy. See Telstra, WIPO Case No. D2000-003, at 10-11; see also, Ingersoll-Rand Co., WIPO Case No. D2000-0021; Symlicity Corporation v. Bob Gately, WIPO Case No. D2000-0425 (citing nine cases following Telstra).

The Panel hereby finds that Complainant has met its burden of showing that Respondent has registered and used the domain name in bad faith.

Accordingly, under the standards applicable to this proceeding, the Panel concludes that Complainant is entitled to relief on the record presented.

## **7. Decision**

The Panel concludes: (a) that the domain name <jvc-america.com> is confusingly similar to Complainant's trademark; (b) that Respondent has no rights or legitimate interest in the domain name; and (c) that Respondent registered and used the domain name in bad faith. Therefore, pursuant to the Policy and the Rules, the Panel orders that the domain name <jvc-america.com> be transferred to Complainant.

Date: February 11, 2009

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Nelson A. Diaz  
Presiding Panelist

