



NATIONAL ARBITRATION FORUM

DECISION

Royal Caribbean Cruises Ltd. v. Michael Urbanczyk
Claim Number: FA0506000490111

PARTIES

Complainant is **Royal Caribbean Cruises Ltd.** ("Complainant"), represented by **Ronald E. Shapiro**, of **Miles & Stockbridge P.C.**, 1751 Pinnacle Dr., Ste. 500, McLean, VA 22102. Respondent is **Michael Urbanczyk** ("Respondent"), represented by **Karl S. Kronenberger**, of **Kronenberger & Associates**, 220 Montgomery Street, Suite 1920, San Francisco, CA 94104.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**royalcaribbeancruiseline.com**>, <**royalcaribbeancruiesline.com**> and <**royalcaribbeancruieslines.com**>, registered with **Network Solutions, Inc.**

PANEL

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

Jacques A. Léger, Q.C. as Panelist.

PROCEDURAL HISTORY

Complainant submitted a twice amended Complaint to the National Arbitration Forum electronically on June 2, 2005; the National Arbitration Forum received a hard copy of the Complaint on June 6, 2005.

On June 3, 2005, Network Solutions, Inc. confirmed by e-mail to the National Arbitration Forum that the domain names <**royalcaribbeancruiseline.com**>, <**royalcaribbeancruiesline.com**> and <**royalcaribbeancruieslines.com**> are registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On June 13, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 5, 2005 by which Respondent could file a

Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@royalcaribbeancruiseline.com, postmaster@royalcaribbeancruiesline.com and postmaster@royalcaribbeancruieslines.com by e-mail.

A timely Response was received and determined to be complete on July 5, 2005.

On July 11, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Jacques A. Léger, Q.C. as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant contends that:

- The disputed domain name **<royalcaribbeancruiseline.com>** is virtually identical to its registered trademark ROYAL CARIBBEAN CRUISES LTD. Indeed, the addition of the generic term "line" and the suppression of the generic term "Ltd." do not detract from the overall impression of the dominant part ROYAL CARIBBEAN of the domain name since they are simply descriptive terms. Moreover, the generic term "line" and "Ltd." cannot serve as source identifier or trademarks and do not affect the virtual identity of the domain name and the mark.

It further contends that:

- The **<royalcaribbeancruiesline.com>** and the **<royalcaribbeancruieslines.com>** domain names are confusingly similar to Complainant's ROYAL CARIBBEAN and ROYAL CARIBBEAN CRUISES LTD trademarks since the dominant portion and primary distinctive element, "royalcaribbean", corresponds precisely to the Complainant's trademarks. Respondent is engaging in typosquatting as the two aforementioned domain names are misspellings of Complainant famous and distinctive trademark.
- Respondent is using **<royalcaribbeancruiseline.com>** to divert and redirect Internet users interested in Complainant's products and services to Respondent's site which is apparently a travel agency through which consumers may book vacations on Royal Caribbean cruise. Such conduct does not constitute a *bona fide* offering of goods and services.
- Respondent has not registered any trademarks let alone ROYAL CARIBBEAN CRUISE LINE, ROYAL CARIBBEAN CRUIES LINE or ROYAL CARIBBEAN CRUIES LINES. Furthermore, Complainant has never licensed or otherwise authorized Respondent to use ROYAL CARIBBEAN CRUISES LTD trademark. Finally, Respondent has no business relationship with Complainant and is not affiliated in any way.
- Respondent is not making a legitimate noncommercial or fair use of the domain names without intent for commercial gain since it is misleadingly diverting consumers to a commercial website

and intentionally attracting users through a misspelling of a famous mark.

- Respondent's registration of the disputed domain names, despite actual and constructive knowledge of Complainant's rights in the trademark, is evidence of a bad faith registration. By linking the disputed domain name <royalcaribbeancruiseline.com> to a commercial website, Respondent has also used the domain name in bad faith. Indeed, it is intentionally trying to attract Internet users to its website for commercial gain by deliberately causing confusion between its domain name and Complainant's trademark.

B. Respondent

Respondent contends that:

- It does not dispute the allegation of confusing similarity between the Complainant's trademark and the disputed domain name <royalcaribbeancruiseline.com>.
- As for <royalcaribbeancruiesline.com> and the <royalcaribbeancruieslines.com>, domain names it submits that it has registered them in order to capitalize further on the joint investment of the parties. Respondent's corporation purchased the latter domain names representing common misspellings of the primary domain used under the Agreement on October 10, 2002 and January 20, 2005. The domain name <royalcaribbeancruiesline.com> was never actually used by the corporation, and to this day, the domain points to the default Network Solutions landing page. The <royalcaribbeancruieslines.com> domain name points to the corporation's primary domain name, <royalcaribbeancruiseline.com>. Because the domain names are being used pursuant to the written permission of Complainant, any "confusing similarity" analysis is simply misplaced, as the use of the trademark in the domain name is currently intentionally used to identify Complainant as the source of the products and services sold by Respondent.
- It also claims that it should benefit from "first sale doctrine" which limits a trademark owner's Lanham Act right to control the distribution of trademarked goods up to the point of those goods' first sale. This doctrine insulates a defendant from liability even where consumers are confused into believing that "the reseller is affiliated with or authorized by the producer." In the current case, Respondent was selling genuine Royal Caribbean goods and services, with the permission of Complainant, and as a result, the entire "confusing similarity" analysis is simply misplaced.
- In this case, despite the fact that Complainant fails to mention this key fact at any place in its complaint, Complainant and Respondent have a standing relationship that is embodied in a written agreement that permits Respondent to use Complainant's trademarks.
- The most important evidence is the written agreement that specifically gives Respondent the contractual right to use Complainant's trademarks to sell Royal Caribbean products and services. Additionally, there is no prohibition whatsoever in the agreement on Respondent registering or owning domain names that contain Royal Caribbean trademarks. Respondent had and currently has the right to use the disputed domain names to fulfill Respondent's obligations under the Agreement. This written Agreement and course of conduct between the parties is compelling evidence of the use of the domain name in connection with a "bona fide offering of goods and services".

- It has invested significantly in the disputed domain name, and the website associated with the domain name is ranked highly in multiple search engines. Respondent also has repeat customers, who return to its website because Respondent is commonly known by that domain name to these customers. For these reasons, Respondent is commonly known by the domain name.
- Its use of the domain name has always been a fair use of the name, due to the written agreement between the parties permitting it to use Complainant's trademarks to sell Royal Caribbean cruises. It has never intended to mislead customers, to divert customers to a site with competing products or services, or to tarnish the Complainant's trademarks. Accordingly, it is making a legitimate fair use of the domain names.
- Complainant has failed to show that Respondent acquired the domain name for the purpose of selling it to Complainant; it has not shown that Respondent registered the domain in order to prevent Complainant from reflecting its trademark in the domain name; it has also not shown that Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor and finally it has not shown that Respondent intentionally attracted users to the disputed domain by creating a likelihood of confusion with respect to the source, sponsorship or affiliation. The foregoing statements are proved especially by the existence of the written agreement the parties have agreed upon for the years 2004 and 2005.
- Respondent respectfully submits that this is a case of Reverse Domain Name Hijacking and this Panel should declare in its discretion that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

ISSUES

This dispute involves two entities in the business of selling cruise line vacations. The Respondent, Michael Urbanczyk is the sole stockholder of a Florida corporation, Direct Travel Service, Inc. On February 27, 2002, its corporation registered the domain name <royalcaribbeancruiseline.com>. In early 2004, Respondent began negotiating an agreement with the Complainant in order to allow its corporation the right to sell Royal Caribbean cruises and services and, in doing so, use various Royal Caribbean trademarks, trade names and logos.

The first agreement was signed on April 21, 2004, which was retroactive to January 1, 2004. This one-year agreement between the parties has been renewed once thus far and currently contains a term that expires in December of 2005. Surprisingly enough, the Complainant did not address this agreement issue after receiving Respondent's response.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (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 the Complainant must prove cumulatively 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 the Respondent is identical or confusingly similar to a trademark or service

- mark in which the Complainant has rights;
- (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.

Identical and/or Confusingly Similar

The test to be applied in order to determine if a Domain Name is “Confusingly Similar” is one of resemblance based on first impression and imperfect recollection (*Government of Canada v. David Bedford* (May 27, 2003) (BCICAC)). As stated by the Panel in that decision:

For each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.

Applying the resemblance test, the Panel finds in the present case, on a balance of probabilities, that a person, on a first impression, knowing the Complainant’s ROYAL CARIBBEAN CRUISES LTD mark only and having an imperfect recollection of it, would likely mistake the <royalcaribbeancruiseline.com> domain name (without the .com suffix) for the Complainant’s ROYAL CARIBBEAN CRUISES LTD mark based upon the appearance, sound or the ideas suggested by the Mark. In this regard, the addition of the word “line” and the suppression of the word “Ltd” is not sufficient to distinguish the Disputed Domain Name <royalcaribbeancruiseline.com> in appearance, sound or idea suggested from the ROYAL CARIBBEAN CRUISES LTD Mark.

In addition, the Complainant asserts that Respondent’s <royalcaribbeancruiesline.com> and <royalcaribbeancruieslines.com> domain names are confusingly similar to Complainant’s ROYAL CARIBBEAN and ROYAL CARIBBEAN CRUISES LTD. marks because Respondent intentionally misspells Complainant’s famous marks. In *Victoria’s Secret v. Zuccarini*, FA 95762 (Nat. Arb. Forum Nov. 18, 2000), the Panel found that, by misspelling words and adding letters to words, a respondent does not create a distinct mark but nevertheless renders the domain name confusingly similar to complainant’s marks. Also in *Dow Jones & Co., Inc. v. Powerclick, Inc.*, D2000-1259 (WIPO Dec. 1, 2000), the Panel held that the deliberate introduction of errors or changes, such as the addition of a fourth “w” or the omission of periods or other such “generic” typos do not change respondent’s infringement on a core trademark held by the complainant.

Furthermore, the Panel finds that the addition of the top-level domain “.com” is irrelevant in determining whether the <royalcaribbeancruiseline.com>, <royalcaribbeancruiesline.com> and <royalcaribbeancruieslines.com> domain names are confusingly similar to Complainant’s marks. In *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000), the Panel decided that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Notwithstanding the preceding arguments, the Respondent did not contest the confusing similarity between the disputed domain names and the Complainant’s trademarks.

For these reasons, the Panel Finds that the disputed domain names <royalcaribbeancruiseline.com>, <royalcaribbeancruiesline.com> and <royalcaribbeancruieslines.com> are confusingly similar to

Complainant's marks ROYAL CARIBBEAN and ROYAL CARIBBEAN CRUISES LTD.

Rights or Legitimate Interests

From the facts of this case, it is certainly not clear whether or not Respondent had rights in the domain name at the time of registration. However, what is clear is that Respondent cannot derive legitimate interest from the signing of the contract with Complainant as this clearly prohibited by section 8 (I) of the contract.

The question which remains is whether Respondent had nonetheless legitimate interest in the respect of the exploitation of the domain name at relevant time. While literally it may; indeed, it did not propose to directly conduct business under the name, it expected to use the domain name <royalcaribbeancruiseline.com> to derive legitimate income from persons who wanted to purchase Complainant's products.

However, the Panel does not propose to belabour that point nor make a finding as to whether or not Complainant has met its burden in view of the Panel's finding hereinafter on bad faith.

Registration and use in bad faith

It is most of the time quite difficult, if not impossible, to actually show bad faith, at the time of registration and use, with concrete evidence. While bad faith cannot be presumed, once Complainant has presented some evidence pointing in that direction, it is then incumbent upon Respondent to either respond or explain why its conduct should not be assimilated to bad faith. The Panel's understanding of the Policy is that although the initial burden to prove Respondent's bad faith in the registration and the use of the disputed domain name relies squarely on the shoulders of Complainant, such obligation is only to make out a *prima facie* case, and once it has done so, it is then incumbent upon Respondent to either justify or explain its business conduct (if not to demonstrate the contrary). Failure to do so will, in some circumstances, enable the Panel to draw a negative inference.

However, in the case at hand, the Panel finds that Complainant has not satisfactorily met its burden as to bad faith at least as far as use is concerned, as low as that primary threshold might be put. Indeed, Respondent having shown that at the time of the complaint, he is a contractually authorized distributor of Complainant's product; the latter is therefore, *prima facie*, precluded from claiming that Respondent's registration and use of the disputed domain name constitutes bad faith, unless he can show circumstances that warrant it. The Panel relies on *Celebrity Signatures Int'l, Inc. v. Hera's Inc. Iris Linder*, D2002-0936 (WIPO Dec. 16, 2002), wherein there was a finding of lack of bad faith since respondent "intended to use the domain name for a website selling Complainant's products, [it] was encouraged to do so by Complainant's representatives, [and it] did so for over a year without [the complainant's] objection". See also *Vanden Bos v. Proxylene Domain Trust*, FA 170632 (Nat. Arb. Forum Sept. 10, 2003) where "Complainant knew from 1997 that Respondent used and promoted the <fusac.com> domain name in the United States and Complainant cannot show bad faith registration because Complainant approved Respondent's registration of the mark in a domain name, acquiesced to it and received the benefits from it."

Of course in the present case, it cannot be said that Complainant has either encouraged Respondent to use the domain name nor that he could have shown circumstances warranting bad faith. However, as the burden rests squarely on Complainant's shoulders, the Panel is of the view that Complainant could not

disregard, once alleged and proved by Respondent, the written agreement that intervened between the parties; such inaction is fatal to Complainant's burden on the issue of bad faith.

Respondent's allegation "Prior to the parties signing the agreement, Direct Travel disclosed how it planned to use the domain name royalcaribbeancruiseline.com in fulfilling Direct Travel's obligations under the agreement, and at no time did any of the Royal Caribbean representatives voice any objection to such use of this domain name" (Response p.3) was never contradicted and no attempts were made by Complainant to even address it. For reasons unexplained, Complainant chose to ignore it. The uncontradicted evidence of Respondent is that Complainant has taken over a year to object to the Respondent's open and continuous business use of the domain name [<royalcaribbeancruiseline.com>](http://royalcaribbeancruiseline.com). Last but not least, the fact that Complainant appears to have financially benefited from the use of the domain name by Respondent points in the opposite direction to bad faith. For these reasons, the Panel draws a negative inference from both the inaction of Complainant during one year as well as the silence of Complainant in not rebutting Respondent.

Noteworthy, Complainant has failed to point out any particular facts or circumstances supporting its allegations of bad faith, thus making it difficult for the Panel to make a finding in its favor, on a balance of probabilities. Had Complainant's evidence been more complete in its complaint or with a rebuttal, the Panel may have come to a different conclusion. See *Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA 133676 (Nat. Arb. Forum Jan. 16, 2003) where the Panel found that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that respondent acted in bad faith.

For all of these reasons, the Panel finds that the Complainant has failed to meet its burden, on a balance of probabilities, that Respondent has used the disputed domain names [<royalcaribbeancruiseline.com>](http://royalcaribbeancruiseline.com), [<royalcaribbeancruiesline.com>](http://royalcaribbeancruiesline.com) and [<royalcaribbeancruieslines.com>](http://royalcaribbeancruieslines.com) in bad faith.

Complainant having failed to prove one prong of the third criterion required by section 4 (a)(iii) of the Policy, there is no need for the Panel to pursue its inquiry as to the second prong nor the criterion required by section 4 (a)(ii) (*Ricom, Inc. v. Ricom*, FA 348012 (Nat. Arb. Forum Dec. 16, 2004)).

Reverse Domain Name Hijacking

Respondent has asked the Panel to make a finding of reverse domain name hijacking. Rule 1 defines reverse domain name hijacking as "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name." See also Rule 15(e). To prevail on such a claim, Respondent must show that Complainant knew of Respondent's unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith. See, e.g., *Sydney Opera House Trust v. Trilynx Pty. Ltd.*, Case No. D2000-1224 (WIPO, Oct. 31, 2000). Furthermore, the Panel shares the opinion expressed by the panel in *Smart Design LLC v. Hughes*, D2000-0993 (WIPO Oct. 18, 2000), that, "reverse Domain Name hijacking...encompasses both intent and recklessness or knowing disregard of the likelihood that the Respondent possessed legitimate interests".

In the case at hand, it is apparent that Respondent other than simply stating that a situation of reverse domain name hijacking is present has failed to establish any of the above-mentioned criteria and/or provided evidence in support of said request. Consequently, the Respondent has failed to relieve itself of

its burden regarding this notion and no finding of reverse domain name hijacking, against Complainant, is to be made.

Re-Filing

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In *Creo Products Inc. v. Website In Development*, D2000-1490 (WIPO Jan. 19, 2001), the Panel thoroughly explained what constitutes a re-filed complaint. In essence, it consists of a subsequent complaint in relation to the same domain name that is filed by the same Complainant against the same Respondent. Reflecting on the absence of direction in the Uniform Policy and the Uniform Rules, the Panel concludes that the applicability of the Uniform Policy to re-filed complaints should be resolved in a reasonable, yet logical manner. This Panel's view is that re-filed complaints ought to only be permitted in very limited circumstances.

The Panel in *Creo* noted that "there may be situations in which an administrative panel considers that the complainant has not proved that the complaint satisfies all the requirements of the Uniform Policy, but that it is highly likely the complainant could do so upon the submission of further arguments and/or evidence. In this situation, it appears to this Administrative Panel that, rather than dismissing the complaint without prejudice, the better approach is to utilize the provisions of Rule 12 of the Uniform Rules, and request further statements and/or documents from either or both the parties."

In the present case, the Panel exercises its discretion not to retain the argument pertaining to Rule 12 as the Complaint is so deficient as to bad faith, particularly relatively to the contractual issue raised by Respondent, that it would not be practical for the Panel to presently request further statements. However, the Panel retains the solution adopted in *Not My Kid Inc. v. Ron Sawchak*, FA167978 (Nat. Arb. Forum Sept. 23, 2003). In view of the circumstances of the present case, the Panel therefore reserves the rights of Complainant to re-file with substantially new or different evidence but leaves it for another Panel to decide.

Of course, this decision on re-filing does not prevent Complainant's right to alternatively seek remedies before other jurisdictions.

DECISION

The Complainant has failed to satisfactorily established on a balance of probabilities at least one prong of the third element required under the ICANN Policy, i.e *use in bad faith* in respect of the domain names <royalcaribbeancruiseline.com>, <royalcaribbeancruiesline.com> and <royalcaribbeancruieslines.com> with Complainant's ROYAL CARIBBEAN and ROYAL CARIBBEAN CRUISES LTD marks.

Consequently, pursuant to paragraphs 4(a)(iii) of the Policy and 15 of the Rules, the Panel concludes that relief sought shall be **DENIED**, but in view of reasons outlined above, reserves all of Complainant's rights in re-filing before a newly constituted Panel.

The Respondent having failed to meet the necessary burden, his claim for a finding in reverse domain name hijacking is **DENIED**.

Jacques A. Léger, Q.C., Panelist
Dated: July 29, 2005

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