



DECISION

Caribbean Travel Network N.V. v. Administration Department / Digital Panorama S.A.

Claim Number: FA1608001691456

PARTIES

Complainant is **Caribbean Travel Network N.V.** (“Complainant”), represented by **Carine A.D. Jänsch** of **OX & WOLF legal partners**, Curaçao. Respondent is **Administration Department / Digital Panorama S.A.** (“Respondent”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain names at issue are **<cubatravelnetwork.net>** and **<cubatravelnetwork.info>**, registered with **GoDaddy.com, LLC**.

PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Ho-Hyun Nahm, Esq. as Chair of the Panel

Professor Darryl C. Wilson and

Mr. Fernando Triana, Esq. as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on August 29, 2016; the FORUM received payment on August 29, 2016.

On August 29, 2016, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the **<cubatravelnetwork.net>** and **<cubatravelnetwork.info>** 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 August 30, 2016, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of September 23, 2016 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@cubatravelnetwork.net, postmaster@cubatravelnetwork.info. Also on August 30, 2016, 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 September 23, 2016.

Complainant's Additional Submission was received on September 28, 2016, and determined by the FORUM to be compliant with Rule 7 on September 30, 2016.

On October 4, 2016, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed

Ho-Hyun Nahm, Esq. as Chair of the Panel

Professor Darryl C. Wilson and

Mr. Fernando Triana, Esq. as Panelists.

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

i) Complainant has rights in the CUBA TRAVEL NETWORK mark pursuant to its registration of the mark with the International Bureau of the World Intellectual Property Organization (Reg. No. 965,760, registered Mar. 26, 2008).

Complainant uses the mark in furtherance of its business in the online travel booking sector. Respondent's **<cubatravelnetwork.net>** and **<cubatravelnetwork.info>** domain names are confusingly similar to the CUBA TRAVEL NETWORK mark because the mark is incorporated fully, less the spaces, and the ".net" and ".info" generic top-level domains ("gTLDs") are appended.

ii) Respondent has no rights or legitimate interests in or to the disputed domains. Respondent's domains contain fraudulent information: "Cuba Travel Network - Is Cuba's first online travel company founded in 1995" Rather, Respondent registered the domains in 2008 and the use was begun in 2009 (**<cubatravelnetwork.net>**) and 2013 (**<cubatravelnetwork.info>**). Respondent therefore is not commonly known by the disputed domains. Respondent—through its use of the disputed domains—has attempted to gain traffic through search engine optimization and incorporating links to websites of third parties offering competing services, clearly for commercial gain.

iii) Respondent registered and used the disputed domains in bad faith. Respondent has a history of cybersquatting domain names. Further, Respondent has registered and used the domains to disrupt Complainant's business and commercially gain in bad faith per Policy ¶¶ 4(b)(iii) and (iv). Lastly, Respondent had actual or constructive knowledge of the CUBA TRAVEL NETWORK mark and Complainant's rights in the mark when registering and subsequently using the disputed domains to compete with Complainant, indicating bad faith per Policy ¶ 4(a)(iii).

iv) Complainant refutes the doctrine of laches as a valid argument.

B. Respondent

i) The Panel notes the disputed domains were registered on November 3, 2008.

ii) Complainant's "International Registration" is not enough to prove rights under Policy ¶ 4(a)(i). Complainant also incorrectly states, "The words contained in the mark have no meaning." In this case, the words have a plain meaning in English and therefore Complainant does not have rights in the words. Respondent disputes the registrations in countries Complainant has secured in the countries which have flowed from the "International Registration." Complainant's USPTO registration disclaims, "No claim is made to the exclusive right to use 'CUBA TRAVEL NETWORK' apart from the mark as shown." Complainant's Annex 4 and Annex 19 purport to be evidence of common law trademark rights. This evidence does not rise to the level required for the Panel to make a finding of common law trademark rights. Also telling is Complainant's disclaimer of all rights to the words of the mark in its recent USPTO registration. *See id.*

iii) Respondent has rights and legitimate interests in the disputed domains. Respondent has been providing travel services since 1995. In 1995, Mr. Stephen Marshall, the co-founder of the Respondent and currently on its advisory board, began doing business with Ms. Alonzo's company, called Tour & Marketing, which provided Cuba travel services. In or about 2002, the Complainant's principal, Mr. Eddie Lubbers, worked as an intern for Tour & Marketing, as shown in Annex K. Respondent's understanding at the time of registration of the disputed domains was that Complainant used a CTN logo, and its rights were limited to that logo—not the descriptive phrase. Respondent saw no evidence of secondary meaning on Complainant's online offerings at that time, which consisted of a collection of links to third party travel providers. When Respondent developed its ".net" domain, the website was far superior to Complainant's at that

time. There were phone numbers for international callers, online payment processing services, a full hotel and travel booking engine, a distinct logo, and numerous other services and information available on the Respondent's website. Therefore, for 7+ years, Respondent has been operating legitimate websites through the disputed domains. The disputed domains are comprised entirely of common dictionary words.

iv) The doctrine of laches applies in this dispute.

C. Additional Submission - Complainant

Complainant submits evidence to support rights under Policy ¶ 4(a)(i). CUBA TRAVEL NETWORK, in addition to the USPTO registration, is validly registered in former Netherlands Antilles, now Curacao, Sint Maarten and BES Islands, since March 19, 2008, and in Australia since March 26, 2008. Complainant therefore has standing to bring this dispute. Complainant otherwise submits evidence to support rights under the common law in the event the Panel does not find rights per the proffered trademark representations.

Respondent did not file any evidence of prior use of the CUBA TRAVEL NETWORK name. Complainant cannot substantiate Respondent's claim that its predecessor started using the mark in 1995.

While Respondent argues that it registered the disputed domains because they were descriptive and free to register suggests knowledge of the existence of prior use by a third party. Complainant questions the rationale behind Respondent's failure to register such a name when it acquired its predecessor's business in 2004.

The Panel notes that Respondent contends the Additional Submission should not be accepted. However, the Panel finds that there is no reason not to accept Complainant's Additional Submission.

FINDINGS

- i) The Panel finds this dispute as being within the scope of the UDRP.

- ii) The Panel finds Complainant established that it had rights in the mark contained in the disputed domain names. Each of the disputed domain names is confusingly similar to Complainant's protected mark.

- iii) The majority of the Panel finds Respondent has rights to or legitimate interests in the disputed domain names (Panelist Mr. Fernando Triana has not joined this finding).

- iv) The majority of the Panel finds it is not necessary to go into details regarding the propriety of finding that acquiescence and/or laches applies (Panelist Mr. Fernando Triana has not joined this finding).

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."

Preliminary Issue: Business Dispute Outside the Scope of the UDRP

Respondent argues the following:

The Complainant is apparently trying to misuse the UDRP to seize the Respondent's business on the basis of an apparently weak claim of what amounts to allegations trademark infringement. It is beyond the limited scope of the UDRP to embark on an investigation of the validity and enforceability of trademark rights, which is required to decide the dispute between the parties. It is also outside of the scope of the UDRP to decide cases where there are competing claims of rights, as is the case here. This forum is simply not the appropriate forum to air all of the various and often prejudicial and false, allegations raised by the Complainant. For example, the Complainant has raised issues of alleged defamation, arrests, unfair competition, trademark infringement, etc., which the Respondent cannot fully address in this forum. The UDRP procedure is not well suited to the resolution of the kinds of complicated factual and legal disputes that are presented in this proceeding.

Complainant states that it "is not trying to put Respondent out Respondent's business, as Respondent suggests," and goes on to say "Respondent's 'Cuba Travel Network' is a bubble, an empty shell. Respondent failed to prove the legitimate interest in the Disputed Domain Names." Complainant also notes that Respondent's Annexes P and S do not mention the disputed domains, demonstrating a lack of interest and a leading to a conclusion that Respondent is engaged in trademark infringement or passing off. *Id.* Complainant then states that it "realizes that this does not fall within the scope of the UDRP procedure." *Id.*

The Panel finds that there is sufficient evidence for it to properly decide the dispute under the UDRP, and thus it proceeds with the case and considers the contentions of Complainant and Respondent as outlined below. See *Weber-Stephen Prod. Co. v. Armitage Hardware*, D2000-0187 (WIPO May 11, 2000) (“Like any other tribunal, however, this Panel can determine whether it has jurisdiction only from the facts and arguments presented to it. In this case, Complainant did allege bad-faith use and registration of the domain name at issue. Had Complainant proved those allegations, there would be no proper question as to this Panel’s jurisdiction.”); see also *Draw-Tite, Inc. v. Plattsburgh Spring Inc.*, D2000-0017 (WIPO Mar. 14, 2000) (“This Panel well recognizes that its jurisdiction is limited to providing a remedy in cases of ‘the abusive registration of domain names,’ or ‘Cybersquatting’ ... Like any other tribunal, however, this Panel can determine whether it has jurisdiction only from the facts and arguments presented to it. In this case, Complainant did allege bad-faith use and registration of the domain name at issue. Had Complainant proved those allegations, there would be no proper question as to this Panel’s jurisdiction.”).

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
- (2) 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

Complainant argues that it has rights in the CUBA TRAVEL NETWORK mark pursuant to its registration of the mark with the International Bureau of the World Intellectual Property Organization (Reg. No. 965,760, registered Mar. 26, 2008). The Panel also notes the USPTO registration in the case file (Reg. No. 4,943,763, registered Apr. 26, 2016); a Netherlands Antilles Trademark Registration No. 13,337 registered on March 19, 2008, and an Australian Trademark Registration No. 1,249,503 registered on March 26, 2008.

Complainant uses the mark in furtherance of its business in the online travel booking sector. Panels have agreed that rights in a mark may be established with a relevant governmental authority. *See generally Morgan Stanley v. Fitz-James*, FA 571918 (FORUM Nov. 29, 2005) (finding from a preponderance of the evidence that the complainant had registered its mark with national trademark authorities, the Panel determined that “such registrations present a *prima facie* case of Complainant’s rights in the mark for purposes of Policy ¶ 4(a)(i).”). Therefore, the Panel agrees that Complainant has demonstrated its rights under Policy ¶ 4(a)(i).

Next, Complainant argues that Respondent’s **<cubatravelnetwork.net>** and **<cubatravelnetwork.info>** domain names are confusingly similar to the CUBA TRAVEL NETWORK mark because the mark is incorporated fully, less the spaces, and the “.net” and “.info” gTLDs are appended. Such alterations have been considered irrelevant for the purposes of Policy ¶ 4(a)(i). *See Health Republic Insurance Company v. Gustavo Winchester*, FA 1622089 (FORUM July 7, 2015) (finding, “Domain name syntax requires TLDs. Domain name syntax prohibits spaces. Therefore, omitted spacing and adding a TLD must be ignored when performing a Policy ¶4(a)(i) analysis.”). Therefore, this Panel agrees that confusing similarity exists under Policy ¶ 4(a)(i).

While Respondent contends that the <**cubatravelnetwork.net**> and <**cubatravelnetwork.info**> domain names are comprised of common and generic/descriptive terms and as such cannot be found to be identical/confusingly similar to Complainant's mark, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i) as this portion of the Policy considers only whether Complainant has rights in the mark and whether the disputed domain names are identical or confusingly similar to Complainant's mark. See *Precious Puppies of Florida, Inc. v. kc*, FA 1028247 (FORUM Aug. 10, 2007) (examining Respondent's generic terms arguments only under Policy ¶ 4(a)(ii) and Policy ¶ 4(a)(iii) and not under Policy ¶ 4(a)(i)); see also *Vitello v. Castello*, FA 159460 (FORUM July 1, 2003) (finding that the respondent's disputed domain name was identical to complainant's mark under Policy ¶ 4(a)(i), but later determining the issue of whether the disputed domain name was comprised of generic terms under Policy ¶¶ 4(a)(ii) and 4(a)(iii)).

Rights or Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden 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.”).

The majority of the Panel holds that Complainant has not established a *prima facie* case in support of its arguments that Respondent lacks rights and legitimate interests under Policy ¶ 4(a)(ii). See *Terminal Supply, Inc. v. HI-LINE ELECTRIC*, FA 746752 (FORUM Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); see also *Workshop Way, Inc. v. Harnage*, FA 739879 (FORUM Aug. 9, 2006) (finding that the respondent overcame the complainant’s burden by showing it was making a *bona fide* offering of goods or services at the disputed domain name).

Respondent argues it has rights and legitimate interests in the disputed domains for the following reasons:

Respondent has been providing travel services since 1995. In 1995, Mr. Stephen Marshall, the co-founder of the Respondent and currently on its advisory board, began doing business with Ms. Alonzo’s company, called Tour & Marketing, which provided Cuba travel services. In or about 2002, the Complainant’s principal, Mr. Eddie Lubbers, worked as an intern for Tour & Marketing, as shown in Respondent’s Annex. Respondent’s understanding at the time of registration of the disputed domains was that Complainant used a CTN logo, and its rights were limited to that logo—not the descriptive phrase. Respondent saw no evidence of secondary meaning on Complainant’s online offerings at that time, which consisted of a collection of links to third-party travel providers. When Respondent developed its “.net” domain, the website was far superior to Complainant’s at that time. See Resp., at Attached Annex N. There were phone numbers for international callers, online payment processing services, a full hotel and travel

booking engine, a distinct logo, and numerous other services and information available on the Respondent's website. *Id.* Therefore, for 7+ years, Respondent has been operating legitimate websites through the disputed domains. Panels have agreed that when the burden shifts to a respondent, evidence of length of use of a domain with a legitimate purpose as a business may exist to meet and once again shift the burden back to complainant. *See Chicago Bd. Options Exch. Inc. v. Private*, FA 804703 (FORUM Nov. 29, 2006) (finding it a persuasive factor that the respondent had used the disputed domain name for over seven years in concluding that the respondent had rights or legitimate interests in the disputed domain name); *see also iLeads.com LLC v. Elec. Mktg. Sys., Inc.*, FA 187636 (FORUM Oct. 13, 2003) (finding that the respondent had rights and legitimate interests in the <aleads.com> domain name because it used the term "leads" in the generic sense to refer to the sale of leads over the Internet).

Respondent also argues that the terms of the <**cubatravelnetwork.net**> and <**cubatravelnetwork.info**> domain names are common and generic/descriptive, and therefore, Complainant does not have an exclusive monopoly on the terms on the Internet.

The majority of the Panel is of the view that the registration of the domain name in 2002 did not give Complainant protectable trademark rights to the mark that was ultimately registered. A domain name registration is not a conference of trademark rights. At that time it was still just a merely descriptive phrase at best. It was not inherently distinctive nor could it have acquired secondary meaning then. Thus anyone else was free to register the same phrase under different gTLD's. In fact, the mark never was shown to have acquired any secondary meaning until 2009 at its earliest or at its latest 2016, as a result of its recent registration by the USPTO. The mark was repeatedly rejected as unprotectable, and or disclaimed by the Complainant as to the words having meaning apart from

the design aspects of the mark, at best until 2009. This is the same time Respondent, who had been working in the same business, and who had prior relationships with Complainant as his employer, registered his domain names.

The majority of the Panel observes that Complainant offers insufficient evidence that the public associated Cuba Travel Network with him from 2002 through 2009. Anyone can register a domain name in a minute. The same is true regarding sending out bills with a d/b/a, or other types of advertisements. Using historical records of site visit data does not establish secondary meaning by which we can confer protectable common law rights through use of descriptive terms onto the Complainant. Even that data does not support enforceable trademark rights dating back to 2002. Perhaps Complainant did start his business in 2002 but he certainly did not have protectable trademark rights then in the mark he later registered in 2008. Perhaps Respondent started his business as he asserted back in 1995, but he did not have protectable rights in the phrase then either, and he used the phrase if at all then, and continues to use the phrase today, in both a common descriptive sense relative to his domain names.

Therefore, while Respondent has used the disputed domains in connection with the terms of the domain for an extended period of time, the majority of the Panel agrees that it has established its rights and legitimate interests.

As the majority of the Panel agrees with Respondent, it finds that Respondent established rights or legitimate interests in the disputed domain names pursuant to Policy ¶ 4(a)(ii). See *Kaleidoscope Imaging, Inc. v. V Entm't*, FA 203207 (FORUM Jan. 5, 2004) (finding that the respondent was using the <kaleidoscope.com> domain name for a *bona fide* offering of goods or services because the term was “generic” and respondent was using the disputed domain name as a search tool for Internet users interested in kaleidoscopes); see also

Qwest Commc'ns Int'l v. QC Publ'g Grp., Inc., FA 286032 (FORUM July 23, 2004) (stating that “Complainant’s rights in the QWEST mark are limited to its application to the tele-communications industry,” where a variety of other businesses used the mark in unrelated fields).

Registration and Use in Bad Faith

Because the majority of the Panel finds that Respondent had rights and legitimate interests, it is unnecessary, and in fact improper to find that Respondent registered and used the disputed domains in bad faith.

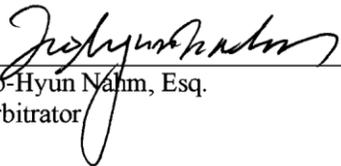
Doctrine of Laches

Because the majority of the Panel finds that Complainant has not comprehensively succeeded on the merits, it also finds that it is not necessary to go into details regarding the propriety of finding that acquiescence and/or laches applies.

DECISION

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the **<cubatrainetwork.net>** and **<cubatrainetwork.info>** domain names **REMAIN WITH** Respondent.


Ho-Hyun Nahm, Esq.
Arbitrator

Ho-Hyun Nahm, Esq., Chair of the Panel

Professor Darryl C. Wilson, Panelist

Dated: October 15, 2016

DISSENT:

With all due respect to my fellow Panelists, I dissent.

Rights or Legitimate Interests

a) *Prima Facie* Case.

Regarding this second element of Paragraph 4(a) of the Policy, UDRP Panels have unanimously consented that requiring the Complainant to prove the lack of rights or legitimate interests of the Respondent in the disputed domain name is often an impossible task: it is not only a negative but also demands access to information that is mostly within the knowledge of the Respondent¹.

¹ See *Arla Foods amba v. Bel Arbor / Domain Admin, PrivacyProtect.org*, D2012-0875 (WIPO June 7, 2012); see also *F. Hoffmann-La Roche AG v. Bargin Register, Inc. - Client Servs.*, D2012-0474 (WIPO April 24, 2012).

In *Julian Barnes v. Old Barn Studios Ltd.*, D2001-0121 (WIPO Mar. 30, 2001), the Panel stated that:

“Is the Respondent required to adduce any such evidence, if the onus is on the Complainant to prove the three elements of paragraph 4 of the Policy? While the overall burden of proof is on the Complainant, this element involves the Complainant proving matters, which are peculiarly within the knowledge of the Respondent. It involves the Complainant in the often impossible task of proving a negative. In the Panel’s view the correct approach is as follows: the Complainant makes the allegation and puts forward what he can in support (e.g. he has rights to the name, the Respondent has no rights to the name of which he is aware, he has not given any permission to the Respondent). Unless the allegation is manifestly misconceived, the Respondent has a case to answer and that is where paragraph 4(c) of the Policy comes in. If the Respondent then fails to demonstrate his rights or legitimate interests in respect of the Domain Name, the complaint succeeds under this head”.

Therefore, a Complainant is required to make a *prima facie* case that Respondent lacks of rights or legitimate interests in the disputed domain name. Once this *prima facie* case is made, the burden of production shifts to Respondent, who must come forward with concrete evidence of its rights or legitimate interests². If Respondent fails to do so, Complainant is deemed to have met the second element of Paragraph 4(a) of the Policy.

² See *Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO August 1, 2000).

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain names because of the following: i) Respondent is not commonly known by the disputed domain names; ii) Respondent registered and uses the disputed domain name to infringe Complainant's and to trade off Complainant's good will; iii) Respondent has not been authorized by Complainant to use the trademark CUBA TRAVEL NETWORK in any manner; iv) Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods and services, because the disputed domain names offer competing services; and v) Respondent has misleading unsupported claims in its website.

These assertions are enough to determine a *prima facie* case made by Complainant that shifts the burden of production to Respondent.

Despite Complainant's assertions which have been enough in several other Panel decisions to establish a *prima facie* case³, the majority of the Panel decided that with the same statements Complainant did not establish a *prima facie* case.

As in all of the cited cases, we consider that Complainant has shifted the burden of proof to Respondent, dissenting in this issue from the majority of the Panel.

Consequently, Respondent must provide evidence of its rights or legitimate interests.

³ See *LEGO Juris A/S v. NyunHwa Jung*, D2012-2491 (WIPO February 5, 2013), *Intesa Sanpaolo S.p.A. v. Francesc Valls Martinez*, D2016-0372 (WIPO April 11, 2016), *LEGO Juris A/S v. li ronghui*, D2012-2404 (WIPO February 12, 2013), *Compagnie Générale des Etablissements Michelin v. Above.com Domain Privacy / Direct Navigation Data Inc.*, D2012-1448 (WIPO September 14, 2012), *Macquarie Group Limited v. Jim Collins*, DCO2015-0031 (WIPO November 18, 2015), *EnBW Energie Baden-Württemberg AG v. Contact Privacy Inc. / ICS INC.*, D2013-1069 (WIPO July 24, 2013), *Holding Company of The Villages, Inc. v. Jaime Goldsmith*, FA1605001673212 (FORUM June 16, 2016).

b) Respondent's rights or legitimate interests in the disputed Domain Name.

Paragraph 4(c) of the Policy includes an enunciative listing of circumstances that prove Respondent's rights or legitimate interests in a disputed domain name:

(i) before any notice of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In this case, we have to take into account that the trademark registrations (Netherlands Antilles Trademark Registration No. 13,337 registered on March 19, 2008, and an Australian Trademark Registration No. 1,249,503 registered on March 26, 2008) predate the registration of the disputed domain names. The trademarks were registered without restrictions or disclaimers in March, 2008, as seen in the Netherlands Antilles Trademark Registration No. 13,337 registered on March 19, 2008, and in the Australian Trademark Registration No. 1,249,503 registered on March 26, 2008. While the disputed domain names were registered on November 3, 2008. Thus, as the general principal of law states, *prior in tempore, potior in iure*.

Furthermore, Respondent has a commercial site, notwithstanding, Respondent registered a network and an information gTLD, “.net” and “.info” respectively. Said gTLDs are not intended for commercial sites, hence, it is clear that Respondent knew of Complainant’s domain name, trademark and success when optinf for the disputed domain names.

In fact, when registering a domain name if it previously exists, the provider offers a series of options starting with the gTLD “.net”, that explains why Respondent knowing its commercial nature, chose the gTLD “.net” to be close enough to Complainant’s business.

As per Annex G of the Response, Complainant’s website in 2006, Respondent tries to divert the Panel’s attention to the logo CTN. Nonetheless, it is clear from Respondent’s evidence that Complainant was publicly using the trademark CUBA TRAVEL NETWORK before the registration of the disputed domain name.

Furthermore, as per the evidence of both Complainant and Respondent, Respondent knew Complainant business before the registration of the disputed domain names.

Moreover, Respondent’s use of the disputed domain names cannot be considered in connection with a *bona fide* offering of goods or services

In *Holding Company of The Villages, Inc. v. Jaime Goldsmith*, FA1605001673212 (FORUM, June 16, 2016), the Panel stated that:

“Prior panels have found use of a confusingly similar domain name to compete with a trademarks holder’s business is not a bona fide offering of goods or services or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(i) and Policy ¶ 4(c)(iii). See General

Motors LLC v. MIKE LEE, FA 1659965 (FORUM Mar. 10, 2016) (finding that “use of a domain to sell products and/or services that compete directly with a complainant’s business does not constitute a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).”). The Panel here finds that Respondent fails to use the <thevillagesinsurance.net> domain name to provide a bona fide offering of goods or services or a legitimate noncommercial or fair use”⁴.

Hence, no activity with competitive connection with a previously registered trademark that uses that same trademark with a different gTLD can be considered as a use of the disputed domain name in connection with a *bona fide* offering of goods or services.

Respondent’s use of the disputed domain name is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, because offering competing goods with Complainant’s trademark is directed to capitalize Complainant’s trademark CUBA TRAVEL NETWORK goodwill by attracting internet users to its disputed domain names where Respondent sells competing services⁵.

The goods and service offered are based in the confusion caused with an established business that has been in the market for over six (6) years. In fact,

⁴ See *Holding Company of The Villages, Inc. v. Jaime Goldsmith*, FA1605001673212 (FORUM June 16, 2016).

⁵ See *Alcon, Inc. v. ARanked*, FA 1306493 (FORUM March 18, 2010) (“The Panel finds that capitalizing on the well-known marks of Complainant by attracting internet users to its disputed domain names where Respondent sells competing products of Complainant is not a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) or a noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).”).

Respondent recognized the existence of Complainant since at least 2006. Thus, even if the trademark was only registered in 2008, Respondent had actual knowledge of Complainant's business and decided to register the disputed domain names using the same expressions, which can never be interpreted as legitimate.

Additionally, Respondent was not and has never been commonly known by the disputed domain name, which fails to comply with the defense set forth under Policy ¶ 4(c)(ii).

In fact, in a Google search, the first result when looking for CUBAN TRAVEL NETWORK is Complainant and, Respondent's sites appear as a sponsored site. Hence, it is clear that Respondent is taking advantage of what is known about Complainant to mislead consumers, which enforces the lack of *bona fide* in his registration and use of the disputed domain name and demonstrates that Respondent is not commonly known by the disputed domain names.

Moreover, the use made by Respondent is **not** noncommercial or fair use of the domain name, without intent for commercial gain, Respondent's websites to which the disputed domain names resolve to offer service packages and tourism deals.

Thus, Respondent behavior clearly demonstrates its lack of Rights and Legitimate Interests in the disputed domain name.

The mere pass of time does not legitimate Respondent's business and does not entail rights on Respondent's behalf. Hence, the fact that Complainant took a long time to file the complaint does not change the illegitimate use and lack of rights of Respondent.

Furthermore, the claim regarding Respondent's use since 1995 is unsupported, misleading and simply impossible to believe. It is not possible to accept Respondent's claims which have not been supported by evidence, furthermore, said claims are misleading as the disputed domain names were registered in 2008, not in 1995 and Respondent's website states that CUBA TRAVEL NETWORK has been in the market since 1995. This means that even if Respondent was in the market before the disputed domain names were registered, its identifier was not CUBA TRAVEL NETWORK. Thus, Respondent's misleading claim reinforces its lack of legitimate interests or rights in the disputed domain name.

Therefore, the second requirement of paragraph 4(b) of the Policy is met.

Registration and Use in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (1) Circumstances indicating that Respondent has registered or has 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 Respondent's documented out-of-pocket costs directly related to the domain name; or
- (2) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(3) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(4) By using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to his/her website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his/her website or location or of a product or service on his/her website or location.

Curiously enough, Respondent's defense regarding bad faith is not its good faith but Complainant's lack of rights. As established and accepted by the Panel, Complainant has trademark rights previous to the registration of the disputed domain names.

In this case, Respondent had previous relations with Complainant. Respondent registered the disputed domain names at least six years after Complainant's trademark registrations and use in its domain name.

Furthermore, Respondent acknowledges the existence of Complainant's business identified by CUBAN TRAVEL NETWORK since at least 2006. Thus, when registering the disputed domain names, Respondent knew or should have known of the existence of Complainant's trademark, domain name and website.

Even if not previously known, Respondent uses of the disputed domain names is commercial, hence, the obvious choice for a gTLD would have been ".com", which was already occupied by Complainant. Thus, at the moment of registration of the disputed domain names Respondent was aware of the existence of Complainant and still registered confusingly similar domain names to offer

competing services; using in the website unsupported and misleading claims to create in the consumer a perception of experience and trajectory that is not evidenced in the case file.

As seen in both the complaint and the response is that Respondent is using the disputed domain name to market and sell competing services, which is a bad faith indicator when using a confusingly similar domain name⁶.

Hence, registering confusingly similar domain names, even though Respondent had actual knowledge of Complainant's rights over the trademark CUBA TRAVEL NETWORK and using the disputed domain name to market and sell competing goods and services, is evidence that Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor and it is indicative of bad faith registration and use pursuant to Policy ¶ 4(a)(iii).

Furthermore, Respondent is profiting from its use of the trademark CUBA TRAVEL NETWORK in the disputed domain name by attracting Internet users to the resolving website where Respondent sells competing products and services in bad faith. Respondent has created confusion as to Complainant's affiliation or sponsorship of the disputed domain name and website in order to sell its competing products and services. This is indicative of bad faith under Policy ¶ 4(b)(iv)⁷.

Consequently, the disputed domain names incorporating Complainant's trademark, possibly disrupt Complainant's business and create a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement, thus, evidencing a bad faith registration and use pursuant to Policy ¶¶ 4(b)(iii) and (iv).

⁶ See *Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO February 5, 2001).

⁷ See *MathForum.com, LLC v. Weiguang Huang*, D2000-0743 (WIPO August 17, 2000).

Therefore, the three elements of the Policy 4(a)(iii) are satisfied in the present case and the disputed domain names should have been transferred to Complainant, according to my view point.

Doctrine of Laches

Certain jurisdictions endorse the doctrine of laches which typically bars the recovery of damages incurred before the filing of a lawsuit and courts have concluded that the rationale behind the doctrine of laches does not militate against injunctive relief. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services. The Policy offers a limited remedy to avoid future confusion in the marketplace, and it does not contemplate that such a remedy would be unavailable because of delay in instituting a Policy proceeding. Furthermore, lengthy delays in seeking legal or administrative remedies can often have the effect of eroding or undermining the Complainant's arguments with respect to Respondent's rights or legitimate interests in the disputed domain name, or Respondent's alleged bad faith in registering and using the domain name.

As laches is a defense mechanism for Respondent which finally affects the arguments regarding the elements of rights or legitimate interests in the disputed domain name and bad faith registration and use, the delay should be taken into account in those elements. Hence, we would have to review each element in order to determine whether or not the delay affected the requirements of the Policy as delay is not itself a basis to deny a claim". Consequently, the only reference to Laches is that it does not apply in this case as is not part of the Policy.

Fernando Triana, Esq. Panelist

October 15, 2016