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NATIONAL INTERNET EXCHANGE OF INDIA
Incube Business Centre, 5th Floor,
18, Nehru Place,
NEW DELHI - 110 019

Yeshiva University v. Mr. Liu (Xiong)

AWARD

1. The Parties

The Complainant is the Yeshiva University, 500 West 185th Street,
New York 10033 - 3201, United States of America.

The Respondent is Mr Liu (Xiong), 503 Room, New Delhi

2. The Domain Name and Registrar

The disputed domain name is <www.einstein.in> The said domain name is registered with Directi Internet Solutions Pvt. Ltd. The registrant is Liu The registrant organization is Xiong

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3. Procedural History

The Complaint was filed with the National Internet Exchange of India on May 20, 2010. The Complainant has made the registrar verification in connection with the domain name at issue. The print out so received are attached with the Complaint. It is confirmed that the Respondent is listed as the registrant. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

The Exchange appointed Dr. Vinod K Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter on June 12, 2010. The arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

In accordance with the Rules, the National Internet Exchange of India wanted to formally notify the Respondent of the Complaint. The sole arbitrator also desired to notify the Respondent of the Complaint. However, while registering the domain name, the Respondent has not given his complete and correct address. The only address given by the Respondent is 503 Room, New Delhi and the mobile telephone number given is 91 12345678. Therefore, it was not possible to notify the Respondent.

4. Factual Background

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

Complainant's activities

The Complainant is a research institution located in the United States of America and has its activities in some other countries also. The Complainant has a number of undergraduate, graduate and affiliated schools and divisions. It is stated that nearly 7,000 students from 38 States and 55 countries including India study at Complainant's campuses viz. the Wilf Campus, the Israel Henry Berne Campus, and Brookdale Campus in Manhattan. The Complainant has a faculty

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of 4714 full time and part time. Since 2004, ENISTEIN has been organizing symposiums in India to enhance HIV/AIDS research capacity, trials and treatments.

Respondent's Identity and Activities

Due to incomplete address, the Respondent could not be contacted. Hence, the Respondent's activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute

In relation to element (i), the Complainant contends that it is one of the worlds leading academic research institutions The Complainant's institutions include the Albert Einstein College of Medicine, Yeshiva College, Stern College for Women, Sy Syms School of Business, Benjamin N Cardozo School of Law, Wurzweiler School of Social Work, Ferkauf Graduate School of Psychology, Azrieli Graduate School of Jewish Education and Administration, Bernard Revel Graduate School of Jewish Studies, and Rabbi Isaac Elchanan Theological Seminary, etc

In relation to element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark "Einstien" Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

Regarding the element at (iii) and (iv), the Complainant contends that the main object of registering the domain name <www.einstein.in> by the Respondent is to earn profit by selling it and to mislead the general public and the customers of the Complainant. The Complainant has stated that the use of a domain name that appropriates a well known trademark or servicemark to promote competing or infringing products cannot be considered a

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"bona fide offering of goods and services".

B. Respondent

The Respondent's response to the Complainant's contentions is not known.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall 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".

According to the Policy, the Complainant must prove that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The domain name in question has been registered and is being used in bad faith and for the purposes of trafficking;

A. Identical or Confusingly Similar

According to the information submitted by the Complainant, the Complainant is the owner of the servicemark "ALBERT EINSTEIN" It is registered since November 9, 1982 for Education Services in Class 41 in the United States of America. The Complainant is also the owner of the servicemark "ALBERT EINSTEIN COLLEGE OF MEDICINE". This servicemarks is registered since January 13, 2004 for Educational Services in Class 41 (U.S. CLS 100, 101 and 107) in the United States of America. The Applications of the Complainant for the registration of the trademark "EINSTEIN (and design)" in Classes 25, 41 and 42 are also pending in European Union since November 12, 2009 and in

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India since September 01, 2009. It appears that an application for the registration of mark "EINSTEIN (and Design) was filed in Israel also in August 25, 2009. However, Annexure B to the Complaint in column Status says that it is "Closed".

The present dispute pertains to the domain name <www.einstein.in>. The other domain names possessed by the Complainants are <www.einstein.yu.edu>, <www.alberteinsteincollegeofmedicine.yu.edu>, www.alberteins <www.einsteinindia.com>, etc. The disputed domain name is very much similar to these domain names and the trademark of the Complainant. Thus, the disputed domain name is identical to the mark of the Complainant. Therefore, I hold that the domain name <www.einstein.in> is confusingly similar to the Complainant's servicemark.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the 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) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial 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.

The Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has



no rights or legitimate interests in the disputed domain name. EINSTEIN is the name and mark of the Complainant. The Respondent is known by the name of Liu (Xiong). It is evident that the Respondent can have no legitimate interest in the domain name. Further, the Complainant has not licensed or otherwise permitted the Respondent to use its name or trademark or to apply for or use the domain name incorporating said name. I, therefore, find that the Respondent has no rights or legitimate interests in the domain names.

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) Circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out of pocket costs directly related to the domain name; or
- (ii) The 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 it has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its 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 the Respondent's website or location or of a product or service on its website or location.



The contention of the Complainant is that the present case is covered by the above circumstances. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. The Respondent's registration of the domain name <www.einstein.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement and/or originates from the Complainant.

The Complainant has also stated that in or around March 2010 Mr. K. Gogoi resident of Na Ali, Jorhat, Assam 785001 had registered the domain <www.einstein.in>. On March 23, 2010 the Complainant sent a Cease and Desist notice to Mr. Gogoi. On March 31, 2010 Mr. Gogoi replied via e mail that he had registered the said domain on 19th January 2009 and that the said registration has expired on 19th January 2010. Mr. Gogoi had further stated that he did not renew it during renewal grace period as well. Therefore, within a short period (in usual domain cycle of 75 days) the said domain will be freed by registry for registration.

The aforesaid facts clearly demonstrate that the Complainant was fully aware of the date when the said domain will be available for registration. It appears that still the Complainant did not take any action for the registration of the said domain.

On April 7, 2010 the Respondent acquired the same. A visit to the domain <www.einstein.in> says that "the domain einstein.in may be for sale by its owner. More details **sedo**". A click at the said statement opens a domain <www.sedo.co.uk> which contains a description that, "domain Einstein.in is for sale. Seller's Listing Price : US \$ 3,000." It is thus clear that the Registrant is using the domain only for sale. Unfortunately, the Complainant did not give these particulars in the Complaint.

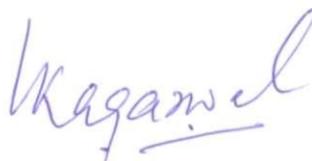
In any case, the foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith. Therefore, I conclude that the domain name was registered and used by the Respondent in bad faith.



Before concluding, I would like to add that the registrant has given his address only as **"503 Room, New Delhi and mobile telephone number as 91.12345678"**. How a domain could be registered by the Directi Internet Solutions Pvt. Ltd., the Registrars with these particulars. This requires investigation and appropriate action by the competent authorities.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith and for the purposes of sale, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.einstein.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator

Date: July 12, 2010