

ADMINISTRATIVE PANEL DECISION

Mubadala Trade Marks Holding Company, LLC, Al Yah Satellite Communications Company PrJSC, and Al Maisan Satellite Communications Company, LLC v. Emedia Development Ltd. and Whois Privacy Services Pty Ltd.

Case No. D2013-0570

1. The Parties

The Complainants are Mubadala Trade Marks Holding Company, LLC, Al Yah Satellite Communications Company PrJSC, and Al Maisan Satellite Communications Company, LLC of Abu Dhabi, United Arab Emirates (“UAE”), represented by Allen & Overy LLP, United Kingdom of Great Britain and Northern Ireland (“United Kingdom”).

The Respondent is Emedia Development Ltd. of Sheerwater, Surrey, United Kingdom / Whois Privacy Services Pty Ltd. of Fortitude Valley, Queensland, Australia, internally represented.

2. The Domain Names and Registrars

The disputed domain names <yahclick.com> and <yahlive.com> are registered with Mesh Digital Limited. The disputed domain names <yahclick.net> and <yahlive.net> are registered with Fabulous.com (Mesh Digital Limited and Fabulous.com will be referred to as the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2013. On March 27, 2013, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On March 27 and March 30, 2013, the Registrars transmitted by email to the Center their verification responses confirming that the Respondent Emedia Development Ltd. is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint on April 6, 2013.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 10, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was April 30, 2013. On April 15, 2013, the Respondent submitted a request for extension of the Response due date. On April 16, 2013, the Center informed the Respondent that its request had been declined. The Response was filed with the Center on April 30, 2013.

On May 1, 2013, the Respondent submitted a supplemental filing. On May 6, 2013, the Complainant submitted a supplemental filing. The Panel has taken the additional filings of both parties into account.

The Center appointed Torsten Bettinger as the sole panelist in this matter on May 8, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The Respondent has made numerous attempts to frustrate or delay the proceedings in this matter, first by challenging the Center's authority to hear the case and the applicability of paragraph 20 of the Rules, and then via a series of ungrounded requests for additional time to file the Response, demands that the Center re-notify the Complaint, and challenges to the Complainant's submission of additional materials (despite his own election to submit a similar unsolicited supplemental filing only days prior). Further, the Respondent attempted to delay the proceeding by submitting portions of its Response only via paper hardcopy, despite the changes to the Rules which went into effect over three years ago, and of which the Respondent (a sophisticated and experienced party with regard to UDRP matters) must have been well aware.

The Panel has reviewed the case record and confirms that the Center discharged its duties appropriately under the Policy and Rules, that the Complaint was properly notified, and that all procedural requirements have been fully and adequately satisfied.

4. Factual Background

The first Complainant, Mubadala Trade Marks Holding Company, LLC, is the holder of two UAE trademark registrations for the YAHCLICK and YAHLIVE marks, registered on February 13, 2011 and June 30, 2010, respectively. All three Complainants are members of the same corporate group, and the second and third Complainants utilize the trademarks under internal license agreements. The second Complainant utilizes the YAHCLICK mark in connection with satellite broadband services in the Middle East, and the third Complainant utilizes the YAHLIVE mark for the provision of direct-to-home television services across a wide geographic region.

The disputed domain names <yahclick.com> and <yahclick.net> redirect to a pay-per-click (PPC) landing page at <yahclick.co.uk>. The disputed domain name <yahlive.com> redirects to a nearly-identical PPC landing page at <yahlive.co.uk>. The final disputed domain name <yahlive.net> does not presently resolve to active content. The <yahclick.com> and <yahclick.net> domain names were both created on October 18, 2008, the <yahlive.net> domain name was created on May 2, 2009, and the <yahlive.com> domain name was apparently also acquired by the Respondent on May 2, 2009. That said, however, there is substantial dispute between the parties as to when the Respondent assumed ownership of the domains, which has been further complicated by the historical use of a privacy service.

The Respondent is also the owner of two registered word marks, for YAHCLICK and YAHLIVE, within the United Kingdom. These marks were initially registered on July 30, 2009 and May 15, 2009, respectively. The marks are both registered for services within Class 35, for the provision of advertising services in an online context.

5. Parties' Contentions

A. Complainants

The Complainants allege that all three elements of the Policy are satisfied. With regard to the first element, the Complainants note that the disputed domain names contain the entirety of their marks with no additional or distinguishing text.

Concerning the second and third elements, the Complainants allege in their pleadings that the Respondent's only reason for registering the disputed domain names was to trade on their trademark-associated value, and to thereby earn unjustified profits from the Complainant's YAHCLICK and YAHLIVE marks. The Complainants have provided copies of a press release from October of 2008, announcing the launch of their YAHCLICK broadband Internet service. The date of this press release corresponds exactly to the creation date of both the <yahclick.com> and <yahclick.net> domain names, as well as the <yahclick.co.uk> domain name. Advertising for the Complainants' YAHLIVE brand began as early as April 2009, which is shortly before the Respondent's alleged registration of the <yahlive.net> and <yahlive.co.uk> domain names, and his purchase of <yahlive.com> via Sedo. The Respondent applied for his United Kingdom trademarks for the YAHLIVE and YAHCLICK marks shortly thereafter, on May 15th and June 30th of 2009.

The Complainants contend that the Respondent was aware of the Complainants' services and intended product launches, and deliberately set out to target their business by registering domain names corresponding to their brands as well as competing United Kingdom trademarks. Furthermore, they allege that the use of the disputed domain names to connect to PPC landing pages (or being passively held) is not consistent with a *bona fide* business activity.

The Complainants have additionally filed for two CTM marks, corresponding to the YAHCLICK and YAHLIVE marks. The Respondent has filed oppositions to these applications on the basis of his own United Kingdom trademarks, apparently for the purpose of creating leverage. The Complainants have provided evidence to show that the Respondent has on several occasions offered to sell the domain names and United Kingdom marks to the Complainant, and to lift his opposition to the Complainants' CTM applications, for various large sums of money.

B. Respondent

The Respondent is Emedia Development Ltd., which is under the control of J. Pepin, a professional domain name registrant who has acted as a respondent in a number of UDRP proceedings. The Respondent registered his YAHCLICK and YAHLIVE trademarks in 2009, and has used three of the four disputed domain names in connection with PPC advertising pages. The links on these pages contain references to *inter alia* satellite Internet services, streaming television, various Dish television and Internet services, VOIP, DSL services, television antennae, and broadband Internet.

The Respondent notes that its trademarks are registered in Class 35, for the provision of online advertising, and that as such its use of the disputed domain names is consistent with its trademark rights.

The Respondent claims that it was wholly unaware of the Complainants and their trademarks at the time it selected the disputed domain names. Its own explanation for the choice of "yahclick" and "yahlive" as domain names is as follows: "Around the same time in 2008 J[...] Pepin was looking through the OHIM CTM register and carrying out searches for CTM's beginning with the characters "yah" and saw quite a number of results, including one particular one "YahooClick" that had been applied for by the very well know company "Yahoo Inc TM, but had been abandoned [...] that sparked J[...] Pepin's mind into an interest in registering yahclick.com and yahclick.co.uk , and not anything to do with the Complainants at all."

The Respondent additionally argued a number of points concerning the Complainants' apparent lack of an officially recorded license agreement, questioning the dates of the Complainants' internal restructuring, arguing that the Complainants appear to utilize very few employees, noting the times at which the Complainants' own domain names came into active use, and questioning the Center's practices.

6. Discussion and Findings

Before turning to an analysis of the substantive elements of the UDRP, it is necessary to consider the question of consolidation, as this case involves both multiple Complainants and Respondents. The three Complainants are all part of the same corporate group, and as such have a common interest in the trademarks in question. The second and third Complainants are additionally the authorized licensees of the marks, which they use in connection with their various business activities. Thus, they share both common legal interests and a common grievance against the Respondent. The Panel finds, moreover, that it is procedurally efficient and equitable to all parties to consolidate these matters into a single Complaint, since the facts and legal rights relevant to all four marks are highly similar, and the Respondent has suffered no prejudice by the utilization of a combined Complaint format. It is therefore logical and appropriate to continue with the Complaint as filed. See *MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc.*, WIPO Case No. D2009-0985.

The Complaint, as initially filed, contained both the name of the Respondent and the privacy service which had been utilized in the registration of two of the disputed domain names. The Respondent has confirmed that it is the sole entity in control of all four of the disputed domain names. Be as that may, at the time the Complaint was submitted to the Center, the domain name holder shown in the WhoIs records was indeed the privacy service, and accordingly it was proper for the Center to accept the Complaint as filed. Despite the Respondent's protestations, many UDRP panels have agreed that the inclusion of the privacy service as a "respondent" in UDRP actions is appropriate, due to the wording of the definition of "Respondent" in the Rules. See, for example, *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. D2009-0320.

A. The UDRP Elements

The UDRP was designed as a fast, efficient mechanism for the resolution of clear-cut cases of cybersquatting. It operates on the basis of an abbreviated record, affords no opportunity for discovery or in-person pleadings, and is conducted on a comparatively rapid schedule. UDRP panels are, therefore, not capable of deciding disputes which involve a "weighing" of respective trademark rights. Nor are they competent to "look behind" a trademark granted by a national authority to question or re-assess its validity.

The Respondent's explanation of his motives in this case is, in the Panel's view, highly improbable, particularly with regard to the timing of his registration of the disputed domain names in light of the Complainants' press releases. His actions in this case are similar to the fact patterns of both *Tiara Hotels & Resorts LLC v. John Pepin*, WIPO Case No. D2009-0041 and *Abu Dhabi Future Energy Company PJSC v. John Pepin*, WIPO Case No D2008-1560, in which the respective UDRP panels ordered the transfer of the relevant domain names. In this matter, however, the Respondent has taken the additional step of securing registered United Kingdom trademark rights in identical terms.

The Panel notes that prior UDRP panels have elected to consider cases under the UDRP wherein both parties hold registered trademark rights. In perhaps the best-known case to address this issue, the *Madonna* case (*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847), the panel held that the respondent's actions were consistent with cybersquatting activities and that no weight need be accorded to the respondent's trademark registration. In that matter, however, the respondent's rights were granted by a jurisdiction which undertook no pre-registration evaluation of marks, and the respondent openly conceded that his only motive in registering the mark was to shore up his rights to the <madonna.com> domain name.

In this case, both the Complainants and the Respondent possess valid trademark rights in the terms "yahclick" and "yahlive." The Respondent's rights were granted by the United Kingdom, which does undertake a thorough pre-registration review of applied-for marks, and further the Respondent's trademarks were granted expressly for the provision of third-party online advertising (which could, in theory, encompass PPC usage). Despite the Panel's misgivings about the sincerity of the Respondent's motives and allegations, the UDRP was not designed to resolve such complicated questions of fact and law.

The complex issues raised by this case should properly be addressed by a court of competent jurisdiction, and accordingly, the Complaint must be dismissed.

B. Reverse Domain Name Hijacking

The Respondent has requested a finding of Reverse Domain Name Hijacking be made against the Complainants. The Panel declines to do so, as there is no evidence available in the case record to indicate that the Complainants have acted inappropriately in a manner designed to harass the Respondent, or could reasonably have believed that their case had no chance of success on the merits.

7. Decision

For the foregoing reasons, the Complaint is denied.

Torsten Bettinger
Sole Panelist
Date: May 23, 2013