



NATIONAL ARBITRATION FORUM

DECISION

Ubisoft Entertainment S.A. v. Oakwood Services Inc.- N/A N/A
Claim Number: FA0912001298869

PARTIES

Complainant is **Ubisoft Entertainment S.A.** ("Complainant"), represented by **Joel D. Leviton**, of **Fish & Richardson P.C., P.A.**, Minnesota, USA. Respondent is **Oakwood Services Inc.- N/A N/A** ("Respondent"), Texas, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**princeofpersia.com**>, registered with **Compana, LLC**.

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on December 14, 2009; the National Arbitration Forum received a hard copy of the Complaint on December 15, 2009.

On December 15, 2009, Compana, LLC confirmed by e-mail to the National Arbitration Forum that the <**princeofpersia.com**> domain name is registered with Compana, LLC and that Respondent is the current registrant of the name. Compana, LLC has verified that Respondent is bound by the Compana, LLC 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 December 16, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 5, 2010 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@princeofpersia.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On January 14, 2010, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration 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." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

In 1989, the first PRINCE OF PERSIA® computer game was released. Since that time PRINCE OF PERSIA has become a wildly popular video game series and entertainment franchise, which includes numerous video game titles, graphic novels, strategy guides, and an upcoming major motion picture by Walt Disney Pictures and Jerry Bruckheimer films. The creator of the PRINCE OF PERSIA game, Jordan Mechner, owns the PRINCE OF PERSIA trademark as registered and used in connection with a variety of goods and services, including computer and video games. Mr. Mechner granted Ubisoft Entertainment S.A. ("Ubisoft") an exclusive worldwide license to use the PRINCE OF PERSIA trademark in connection with computer and video games, the right to use and own domain names containing the PRINCE OF PERSIA trademark, and the right to exercise rights in the PRINCE OF PERSIA trademark, including the right to bring legal action in its own name to enforce the mark.

Mr. Mechner's common law trademark rights in the PRINCE OF PERSIA mark span two decades, dating back to the release of the first PRINCE OF PERSIA computer game. Since the release of the original PRINCE OF PERSIA game in 1989, numerous other PRINCE OF PERSIA computer and video games have been released, including: PRINCE OF PERSIA 2: THE SHADOW AND THE FLAME, released in 1993; PRINCE OF PERSIA Collection released in 1998; PRINCE OF PERSIA for the Nintendo Game Boy system, released in 1999; PRINCE OF PERSIA 3D, released in 1999; PRINCE OF PERSIA: ARABIAN NIGHTS, released in 2000; PRINCE OF PERSIA: THE SANDS OF TIME, released by Ubisoft in 2003 (Ubisoft obtained rights in the franchise in 2001); PRINCE OF PERSIA: WARRIOR WITHIN, released by Ubisoft in 2004; PRINCE OF PERSIA: TWO THRONES, released by Ubisoft in 2005; and PRINCE OF PERSIA, released by Ubisoft in 2008.

In addition Mr. Mechner's longstanding common law rights in the PRINCE OF PERSIA trademark, Mr. Mechner owns a number of United States trademark registrations for marks that comprise or contain the PRINCE OF PERSIA mark, including the following registrations:

- Registration No. 1,646,934 for the mark PRINCE OF PERSIA for "computer game programs recorded on magnetic and electronic media and instruction manuals sold as a unit with the programs," which issued June 4, 1991 and has achieved incontestable status;
- Registration No. 1,831,448 for the mark PRINCE OF PERSIA 2 THE SHADOW AND THE FLAME for "computer game programs recorded on magnetic and electronic media and instruction manuals sold as a unit with the programs," which issued April 19, 1994 and has achieved incontestable status;
- Registration No. 3,074,103 for the mark PRINCE OF PERSIA WARRIOR WITHIN for, among other things, "software and electronic games," which issued March 28, 2006; and
- Registration No. 3,197,175 for the mark PRINCE OF PERSIA THE TWO THRONES for, among other things, "software and electronic games," which issued January 9, 2007.

As indicated, Ubisoft is the exclusive, worldwide licensee of the PRINCE OF PERSIA trademark for use in connection with computer and video games.

FACTUAL AND LEGAL GROUNDS

Knowing of the popularity of the PRINCE OF PERSIA® computer and video games, Respondent registered, renewed, used, and is using the *princeofpersia.com* domain name in bad faith to commercially benefit from the goodwill of the trademark and the popularity of the PRINCE OF PERSIA games. According to the whois record, Respondent purportedly first registered the *princeofpersia.com* on December 2, 2002. Since that time, Respondent has renewed the *princeofpersia.com* domain name on at least two occasions. Compare whois record showing the current expiration date of December 2, 2010, with the second whois record showing that the domain name registration expired on December 2, 2008 and then on December 2, 2009.

Prior to Respondent's initial registration of the domain name, PRINCE OF PERSIA games, including the original game, PRINCE OF PERSIA 2: THE SHADOW AND THE FLAME, and PRINCE OF PERSIA 3D, had been released and achieved critical acclaim for their graphics and game play. Moreover, prior to Respondent's initial registration of the domain name, the marks PRINCE OF PERSIA and PRINCE OF PERSIA 2 THE SHADOW AND THE FLAME were registered with the USPTO.

In 2001, Ubisoft publicly announced that it acquired rights in the PRINCE OF PERSIA video game franchise, among other properties, with its acquisition of the entertainment division

of The Learning Company. In 2003, Ubisoft released the PRINCE OF PERSIA: THE SANDS OF TIME video game, which also was critically acclaimed and received a number of “Game of the Year” honors. On the heels of the successful PRINCE OF PERSIA: THE SANDS OF TIME game, Ubisoft released the PRINCE OF PERSIA: TWO THRONES game in 2005, and PRINCE OF PERSIA in 2008. A major motion picture based on and entitled PRINCE OF PERSIA: THE SANDS OF TIME is scheduled for release in 2010.

Notwithstanding Mr. Mechner’s longstanding rights in the PRINCE OF PERSIA mark, and federal registrations for the mark that date back to the 1990s, Respondent registered the *princeofpersia.com* domain name in 2002, and continued to renew the domain name each year (e.g., in 2008 and 2009) as the video game franchise became increasingly popular and famous. On August 6, 2009, Ubisoft sent Respondent a letter requesting that Respondent transfer the *princeofpersia.com* domain name to Ubisoft, and thereafter sent follow-up emails. Respondent did not respond to Ubisoft’s correspondence. Instead, Respondent renewed the domain name registration for another year in the face of Ubisoft’s letter, and used, and continues to use, the domain name to obtain advertising and click through revenue.

In particular, when Ubisoft sent Respondent its initial letter, the *princeofpersia.com* domain name registration was set to expire on December 2, 2009. Thereafter, Respondent renewed the domain name registration. In addition, at the time when Ubisoft contacted Respondent, Respondent was passively holding the domain name. After receiving Ubisoft’s letter, Respondent modified its use of the domain name to commercially exploit the popularity of the PRINCE OF PERSIA brand. Currently, when an internet user visits the www.princeofpersia.com website for the first time, the domain name redirects to commercial websites in a manner that puts revenue directly in Respondent’s pocket. The second time an internet user visits the www.princeofpersia.com website from the same computer, a website prominently captioned with “princeofpersia.com” and “Prince of Persia” appears and contains links relating to the PRINCE OF PERSIA games, under an apparent pretext that the website is related to the Middle East and Persia. By clicking on the “Prince of Persia” link on the www.princeofpersia.com website, internet users encounter links relating to the PRINCE OF PERSIA games, including links leading to cheater codes for the PRINCE OF PERSIA games.

Unquestionably, Respondent registered and renewed the *princeofpersia.com* domain name in bad faith, and is using the domain name in bad faith to derive revenue.

[a.] The Domain Name Registered By Respondent Is Identical and/or Confusingly Similar To a Mark In Which Ubisoft Has Rights

As set forth above, Jordan Mechner owns common law rights in the PRINCE OF PERSIA mark dating back to 1989, over a decade before Respondent initially registered the *princeofpersia.com* domain name in 2002. Since the release of the first PRINCE OF PERSIA game, the mark has been used continuously with a line of video games. In addition, Mr. Mechner owns federal registrations for the PRINCE OF PERSIA mark, at least two of which long predate the initial registration of the domain name and have achieved incontestable statuses. An incontestable registration serves as “conclusive evidence of the validity of the registered mark and of registration of the mark, of the registrant’s ownership of the mark, and of the

registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115 (b). *See also Reed Elsevier Inc. v. Domain Deluxe*, FA 234414 (Nat. Arb. Forum Mar. 18, 2004) (citing *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985) to confirm that incontestable registrations are conclusive evidence of the registrant's exclusive right to use the mark).

Ubisoft holds an exclusive, worldwide license from Mr. Mechner to use the PRINCE OF PERSIA trademark in connection with computer and video games. Under that license, Ubisoft may own domain names containing the PRINCE OF PERSIA mark and may exercise the rights in the PRINCE OF PERSIA trademark and registrations, including by bringing legal action in its own name to enforce the mark.

An exclusive licensee such as Ubisoft may file a UDRP complaint in its own name. *Guthy-Renker Corp. v. Marvin Addington*, FA109053 (Nat. Arb. Forum May 22, 2002) ("Complainant has provided evidence that it acquired exclusive trademark rights . . . including the right to bring legal proceedings related to the [trade]mark."); *Sweetface Fashion Co. v. Len Molden*, FA104947 (Nat. Arb. Forum March 26, 2002) (finding that Complainant's "attest[ing] that it is the . . . exclusive licensee of the trademarks" was "sufficient evidence of ownership rights to satisfy the Panel"); *Dale Earnhardt, Inc. v. Noramar Enter.*, FA117040 (Nat. Arb. Forum Oct. 1, 2002) (relying on an affidavit to establish that the Complainant was an exclusive licensee); *Nat'l Assoc. for Stock Car Auto Racing Inc. v. Jason DeFillippo*, FA165152 (Nat. Arb. Forum Aug. 14, 2003) ("Complainant has established rights in the WINSTON CUP mark via the submission of proof that it is licensed to use the mark, which is registered with the U.S. Patent and Trademark Office."); *GMAC LLC v. Whois Guard Protected*, FA 942715 (Nat. Arb. Forum May 9, 2007) (holding that complainant's assertion "that Complainant is the exclusive licensee of these marks" established that Complainant had rights in the marks). As the exclusive licensee of the PRINCE OF PERSIA trademark, with the right to own domain names containing the mark and to enforce the rights in the mark, Ubisoft has rights in the PRINCE OF PERSIA trademark.

The *princeofpersia.com* domain name is comprised solely of the well-known and distinctive PRINCE OF PERSIA trademark. A generic top-level domain such as .com does not distinguish the domain name from the well-known trademark. *Hugh Jackman v. Peter Sun*, FA 248716 (Nat. Arb. Forum May 10, 2004) ("Generic top-level domains are irrelevant in determining whether a domain name is identical to another's mark."). Given Ubisoft's rights in the PRINCE OF PERSIA mark as the exclusive licensee, and the identical nature of the domain name to the mark, Section 4(a)(i) of the Policy clearly is satisfied.

[b.] Respondent Has No Rights or Legitimate Interests In the Domain Name

Respondent has not used the *princeofpersia.com* domain name in connection with a bona fide offering of goods or services; Respondent is not making a noncommercial fair use of the domain name; and Respondent has never been known as or referred to as "Prince of Persia."

Respondent has used the domain name in a number of ways, none of which provide Respondent with rights or a legitimate interest in the *princeofpersia.com* domain name. When

Ubisoft contacted Respondent, Respondent was holding the domain name. Respondent's passive holding of the *princeofpersia.com* domain name for a number of years demonstrates that Respondent does not have rights or a legitimate interest in the domain name. *Publix Asset Management Company v. ieWeb*, FA1282607 (Nat. Arb. Forum Oct. 6, 2009) (finding lack of rights or legitimate interest because respondent "bought and kept, without using, a domain name that evokes a famous brand"); *Bloomberg Finance L.P. v. Sung Om Yun*, FA 1265735 (Nat. Arb. Forum July 1, 2009) (holding that lack of use demonstrates a lack of a bona fide offering of goods or services or a noncommercial fair use).

After Ubisoft directly notified Respondent of Ubisoft's rights in the PRINCE OF PERSIA trademark, Respondent renewed the domain name and began using the domain name in connection with commercial websites to which the domain name resolves and on which revenue-generating links are placed. Using another's mark in a domain name to obtain advertising and click-through revenue, either by diverting users to other websites or hosting links to other websites, is not a bona fide offering of goods and services or a noncommercial or fair use. *WeddingChannel.com Inc. v. Andrey Vasiliev a/k/a NA and Free Domains Parking*, FA156716 (Nat. Arb. Forum June 12, 2003) ("Respondent has always used the disputed domain name to redirect Internet users to websites unrelated to the WEDDING CHANNEL mark, websites where Respondent presumably receives a referral fee for each misdirected Internet user. This diversionary and commercial use of Complainant's mark is not a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶4(c)(iii)."); *Elsevier B.V. v. Domain Deluxe*, FA 237520 (Nat. Arb. Forum March 24, 2004) ("Respondent uses the disputed domain name to host a portal website that's principal purpose is to generate revenue via the use of advertisements....[S]uch an enterprise qualifies as neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name."); *Herbalife Int'l of Am., Inc. v. Beamline*, FA 592343 (Nat. Arb. Forum Dec. 27, 2005) ("The Panel presumes that respondent receives click-through fees for hosting links....").

In addition, the whois record for the *princeofpersia.com* domain name identifies Respondent as Oakwood Services Inc. N/A N/A. Failure of the whois record to indicate that Respondent is commonly known as "Prince of Persia" suggests that Respondent is not known by that trademark. *See Tercent Inc. v. Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003). Moreover, given the distinctive nature and notoriety of Respondent's PRINCE OF PERSIA trademark, Respondent would be hard pressed to claim that it is commonly known as "Prince of Persia." *See Geoffrey, Inc. v. Toyrus.com*, FA 150406 (Nat. Arb. Forum April 5, 2003) ("Based on the fame of Complainant's TOYS "R" US mark, Respondent would be hard-pressed to establish that it is commonly known as TOY R US or <toyru.com>").

To the extent Respondent claims that PRINCE OF PERSIA is common term or geographically descriptive term, and that it is making a bona fide use of the domain name to generate click-through revenue based on a geographically descriptive term (as it did in *Graco Children's Prods. Inc. v. Oakwood Services Inc.*, D2009-0813 (WIPO Aug. 14, 2009)), not only was PRINCE OF PERSIA a federally registered trademark *before* Respondent initially registered the domain name, PRINCE OF PERSIA is not a common or geographically descriptive term, as can be confirmed by an internet search. As such, PRINCE OF PERSIA is a distinctive and well-

known trademark, not a common or geographically descriptive term. Moreover, Respondent uses the *princeofpersia.com* domain name to attract advertising that relates to PRINCE OF PERSIA games, which further evidences the distinctive nature of the PRINCE OF PERSIA mark and Respondent's lack of rights or legitimate interest in the domain name. *Graco Children's Prods. Inc.*, D2009-0813 ("Respondent has used the disputed domain name to attract paid advertising that clearly is related to Complainant's APRICA mark.").

Given the foregoing, it is apparent that Respondent has no legitimate interests in the *princeofpersia.com* domain name, as legitimate interests are defined in Sections 4(c)(i)-(iii) of the UDRP. As such, Ubisoft has satisfied the second element of its Complaint under the Policy Section 4(a)(ii).

[c.] Respondent Registered and Is Using the Domain Name In Bad Faith

1. Respondent Is Attempting to Attract for Commercial Gain Users to Its Websites by Creating a Likelihood of Confusion

Respondent is using the website associated with the *princeofpersia.com* domain name to direct internet users to third-party commercial websites and to display revenue-generating links, including links to websites that provide cheat codes for PRINCE OF PERSIA games. Respondent undoubtedly is acting in bad faith by capitalizing on the likelihood of confusion it is creating by using the well-known and distinctive PRINCE OF PERSIA trademark. Using a domain name comprising the trademark of another to divert internet users to unrelated websites for Respondent's commercial gain demonstrates bad faith registration and use pursuant to Policy Section 4(b)(iv). *Troi Torain v. Jasper Developments*, FA653324 (Nat. Arb. Forum April 18, 2006) ("Respondent is diverting Internet users seeking Complainant's radio entertainment services to unrelated websites for its own commercial gain."). Similarly, use of a domain name in connection with a site containing revenue-generating click-through links further demonstrates bad faith under Policy Section 4(b)(iv). See *Hyatt Corp. v. Unasi Inc.*, FA 545021 (Nat. Arb. Forum Oct. 3, 2005); *Countrywide Home Loans, Inc. v. Steve Kerry d/b/a N. W. Enter. Inc.*, FA669549 (Nat. Arb. Forum May 15, 2006); *The Leather Factory, Inc. v. Virtual Sky*, FA 611781 (Nat. Arb. Forum Feb. 1, 2006); *3M Co. v. Excellence Internet Services, Ltd.*, FA 771820 (Nat. Arb. Forum Sept. 26, 2006).

2. Respondent Had Knowledge of Complainant's Rights Prior To the Initial Registration of the Domain Name

Respondent registered the *princeofpersia.com* domain name over a decade after the first PRINCE OF PERSIA game was released and the first federal registration for the PRINCE OF PERSIA mark issued. Prior to the initial registration of the domain name, a number of PRINCE OF PERSIA games had been released, there were two federal registrations for marks that comprise or contain PRINCE OF PERSIA, and Ubisoft publicly announced that it acquired rights in the PRINCE OF PERSIA franchise. "Registration of a domain name that is confusingly similar to a mark, despite knowledge of the mark holder's rights, is evidence of bad faith registration pursuant to Policy ¶4(a)(iii)." *Hugh Jackman v. Peter Sun*, FA 248716 (Nat. Arb. Forum May 10, 2005). See also *Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24,

2002) (“[T]here is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.”); *Eastman Kodak Co. v. Dionne Lamb*, FA 97644 (Nat. Arb. Forum July 17, 2001) (“Registering a name that the registrant knows belongs to someone else and that the registrant knows will confuse the users about the source or sponsorship of the domain name is bad faith.”).

Moreover, even in the highly unlikely event that Respondent did not have actual knowledge of the PRINCE OF PERSIA trademark when it initially registered the domain name, Respondent nonetheless was imparted with constructive knowledge of the mark pursuant to the federal trademark registrations. *See Victoria’s Secret v. Sherry Hardin*, FA 96694 (Nat. Arb. Forum March 31, 2001) (“Registration with actual or constructive knowledge of Complainant’s marks is evidence of bad faith.”); 15 U.S.C. § 1072. At a minimum, Respondent had constructive knowledge of PRINCE OF PERSIA mark when it initially registered the domain name. As such, Respondent knew or should have known of Donaldson’s trademark rights, and such knowledge indicates bad faith. *See Marriott Int’l, Inc. v. John Marriot*, FA 94737 (Nat. Arb. Forum June 15, 2000) (finding bad faith because “Respondent knew or should have known that MARRIOTT was a mark of Complainant....”).

3. Renewing the Domain Name Demonstrates Bad Faith

Registration of a domain name includes the initial registration as well as the renewal of a domain name. *TRAVELHOST, Inc. v. Bill Soistmann*, FA1265785, (Nat. Arb. Forum July 23, 2009). Renewing a domain name, like initially registering a domain name, with actual knowledge of the Complainant’s rights constitutes bad faith registration and use. *Id.* (“The Panel finds that under the Policy, ‘registration’ includes the renewal of a previous domain name. Thus Respondent had actual knowledge of Complainant’s right in the mark at the time of registration. Respondent’s conduct constitutes bad faith registration and use pursuant to Policy ¶4(a)(iii).”). *See also Philip Y. Kim v. Texas Int’l Prop. Assoc. – NA NA*, FA1152004 Nat. Arb. Forum April 17, 2008); *Houlberg Dev. v. Adnet Int’l*, FA95698 (Nat. Arb. Forum Oct. 27, 2000) (finding bad faith because “Respondent had actual knowledge of Complainant’s asserted rights ... before it renewed the domain name).

Here, Respondent renewed (*i.e.*, registered) the *princeofpersia.com* domain name *after* all four of the federal registration cited above issued, *after* Ubisoft released the PRINCE OF PERSIA: THE SANDS OF TIME game, which was hailed as a year’s best game and which has been made into a major motion picture, and *after* Ubisoft contacted Respondent providing direct knowledge of Ubisoft’s rights in the PRINCE OF PERSIA trademark. Respondent’s repeated renewal of the domain name in light of the federal registrations for the mark, the popularity of the PRINCE OF PERSIA games, and Respondent’s actual knowledge of Ubisoft’s rights plainly demonstrates bad faith registration and use.

4. Respondent’s Passive Holding of the Domain Name Demonstrates Bad Faith

Prior to being contacted by Ubisoft, Respondent was passively holding the domain name. Such passive holding also indicates bad faith registration and use. *Publix Asset Management*

Company v. ieWeb, FA1282607 (Nat. Arb. Forum Oct. 6, 2009) (“The Panel find that this passive holding constitutes bad faith registration and use within the meaning of Policy ¶4(a)(iii).”); *Caravan Club v. Mrgsale*, FA 95314 (Nat. Arb. Forum Aug. 30, 2000) (“Passive holding of a domain name permits an inference of registration and use in bad faith.”).

5. Respondent Has a Pattern of Registering Domain Names Containing the Marks of Others

Registering multiple domain names containing the trademarks of others constitutes bad faith registration and use. *Big Dog Holdings, Inc. v. Frank Day*, FA 93554 (Nat. Arb. Forum March 9, 2000); *FDNY Fire Safety Education Fund, Inc. v. Roger Miller*, FA 145235 (Nat. Arb. Forum March 26, 2003); *Gamesville.com, Inc. v. Zuccarini*, FA 95294 (Nat. Arb. Forum Aug. 30, 2000). Respondent has a documented history of registering domain names containing the trademarks of others. *Lauffer Media, Inc. v. Oakwood Services, Inc.*, D2009-1180 (WIPO Oct. 24, 2009); *Graco Children’s Prods. Inc. v. Oakwood Services Inc.*, D2009-0813 (WIPO Aug. 14, 2009); *The Trustees of the British Museum v. Oakwood Services inc.*, D2007-1145 (WIPO Oct. 31, 2007). Respondent’s pattern of egregious conduct further establishes bad faith.

Evidence that Respondent registered and is using the *princeofpersia.com* domain name in bad faith is plentiful. As such, Ubisoft has satisfied the third and final element of its Complaint.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Ubisoft Entertainment S.A., is a manufacturer and provider of computer games. Complainant promotes one of its series of games under the PRINCE OF PERSIA mark, which Complainant registered with the United States Patent and Trademark Office (“USPTO”) on June 4, 1991 (Reg. No. 1,646,934). Complainant has used the PRINCE OF PERSIA mark continuously in commerce since at least as early as 1989, and now uses the mark to promote numerous video game titles, graphic novels, strategy guides, and a upcoming major motion picture by Walt Disney Pictures and Jerry Bruckheimer Films.

Respondent, Oakwood Services Inc.- N/A N/A, registered the <**princeofpersia.com**> domain name on December 2, 2002. The disputed domain name resolves to a website that features links to third-party websites unrelated to Complainant.

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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it

considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

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

The Panel finds Complainant has established rights in the PRINCE OF PERSIA mark for purposes of Policy ¶4(a)(i) through its trademark registration with the USPTO (Reg. No. 1,646,934 issued June 4, 1991). *See Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark."); *see also Expedia, Inc. v. Tan*, FA 991075 (Nat. Arb. Forum June 29, 2007) ("As the [complainant's] mark is registered with the USPTO, [the] complainant has met the requirements of Policy ¶4(a)(i).").

Complainant contends Respondent's <princeofpersia.com> domain name is identical to its PRINCE OF PERSIA mark. The <princeofpersia.com> domain name differs from Complainant's mark in two ways: (1) the spaces have been removed from the mark; and (2) the generic top-level domain ("gTLD") ".com" has been added. The Panel finds the removal of spaces from a mark does not sufficiently distinguish a domain name from a mark that it incorporates for the purposes of Policy ¶4(a)(i). The Panel also finds the addition of a gTLD does not reduce the likelihood of confusion between the domain name and the mark, because every domain name must contain a top-level domain. Therefore, the Panel finds that these changes do not minimize or eliminate the resulting likelihood of confusion, and so it finds the <princeofpersia.com> domain name is identical to Complainant's PRINCE OF PERSIA mark pursuant to Policy ¶4(a)(i). *See Bond & Co. Jewelers, Inc. v. Tex. Int'l Prop. Assocs.*, FA 937650 (Nat. Arb. Forum Apr. 30, 2007) (finding that the elimination of spaces between terms and the addition of a gTLD do not establish distinctiveness from the complainant's mark under Policy ¶4(a)(i)); *see also Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2001) (finding <hannoverre.com> to be identical to HANNOVER RE, "as spaces are impermissible in domain names and a generic top-level domain such as '.com' or

‘.net’ is required in domain names”); *see also* *W. Union Holdings, Inc. v. XYZ*, D2005-0945 (WIPO Oct. 20, 2005) (finding <wuib.com> identical to the complainant’s mark because the generic top-level domain (gTLD) “.com” after the name WUIB is part of the Internet address and does not add source-identifying significance).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant contends Respondent lacks all rights and legitimate interests in the <**princeofpersia.com**> domain name. Under Policy ¶4(a)(ii), after the complainant makes a *prima facie* case against the respondent, the respondent then has the burden of showing evidence that it does have rights or legitimate interests in the disputed domain name. The Panel finds Complainant has made a *prima facie* case under Policy ¶4(a)(ii). Respondent has failed to respond to these proceedings. *See Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent has no right or legitimate interest is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist); *see also Desotec N.V. v. Jacobi Carbons AB*, D2000-1398 (WIPO Dec. 21, 2000) (finding that failing to respond allows a presumption that the complainant’s allegations are true unless clearly contradicted by the evidence).

Complainant contends Respondent is not commonly known by the <**princeofpersia.com**> domain name nor has it ever been the owner or licensee of the PRINCE OF PERSIA mark. The WHOIS record for the disputed domain name lists Respondent as “Oakwood Services Inc.- N/A N/A.” Respondent has also failed to show any evidence contrary to Complainant’s contentions. The Panel therefore finds Respondent is not commonly known by the <**princeofpersia.com**> domain name pursuant to Policy ¶4(c)(ii). *See Coppertown Drive-Thru Sys., LLC v. Snowden*, FA 715089 (Nat. Arb. Forum July 17, 2006) (concluding that the respondent was not commonly known by the <coppertown.com> domain name where there was no evidence in the record, including the WHOIS information, suggesting that the respondent was commonly known by the disputed domain name); *see also Braun Corp. v. Loney*, FA 699652 (Nat. Arb. Forum July 7, 2006) (concluding that the respondent was not commonly known by the disputed domain names where the WHOIS information, as well as all other information in the record, gave no indication that the respondent was commonly known by the disputed domain names, and the complainant had not authorized the respondent to register a domain name containing its registered mark).

Complainant contends Respondent is using the <**princeofpersia.com**> domain name to advertise and link to third-party websites. The Panel finds that using a domain name to promote a businesses unrelated to a complainant is neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use of a domain name under Policy ¶4(c)(iii). *See Disney Enters., Inc. v. Kamble*, FA 918556 (Nat. Arb.

Forum Mar. 27, 2007) (holding that the operation of a pay-per-click website at a confusingly similar domain name was not a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii)); *see also* *ALPITOUR S.p.A. v. balata inc*, FA 888649 (Nat. Arb. Forum Feb. 27, 2007) (finding that “using the confusingly similar <viaggidea.com> domain name to operate a website that features links to various commercial websites from which Respondent presumably receives referral fees....is neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate non-commercial or fair use pursuant to Policy ¶4(c)(iii).”). The Panel therefore finds Respondent’s use of the <**princeofpersia.com**> domain name is neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use of the <**princeofpersia.com**> domain name under Policy ¶4(c)(iii).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Complainant contends Respondent is gaining commercially from “click-through fees” that Respondent is collecting from the third-party websites, and these fees are evidence of Respondent’s bad faith registration and use of the <**princeofpersia.com**> domain name pursuant to Policy ¶4(b)(iv). The Panel agrees and finds Respondent’s commercial gain from its use of the <**princeofpersia.com**> domain name is evidence of its bad faith registration and use of the disputed domain name pursuant to Policy ¶4(b)(iv). *See MySpace, Inc. v. Myspace Bot*, FA 672161 (Nat. Arb. Forum May 19, 2006) (holding that the respondent registered and used the <myspacebot.com> domain name in bad faith by diverting Internet users seeking the complainant’s website to its own website for commercial gain because the respondent likely profited from this diversion scheme); *see also The Ass’n of Junior Leagues Int’l Inc. v. This Domain Name My Be For Sale*, FA 857581 (Nat. Arb. Forum Jan. 4, 2007) (holding that the respondent’s use of the disputed domain name to maintain a pay-per-click site displaying links unrelated to the complainant and to generate click-through revenue suggested bad faith registration and use under Policy ¶4(b)(iv)).

It also appears Respondent has engaged in a pattern or practice of registering domain names that contain the trademarks of others.

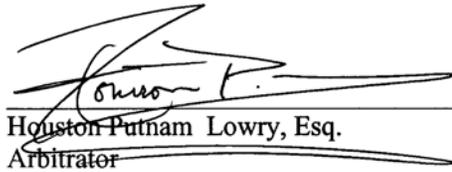
In addition, the contact information for Respondent is incorrect. This raises a rebuttable presumption of bad faith in both the registration and the use of the domain name, *Agent Host v. Host Dot Com Investments* AF-0343 (2000). Respondent has done nothing to rebut this presumption.

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**princeofpersia.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: January 28, 2010

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