



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	<b>HKcc-0900013</b>
<b>Complainant:</b>	<b>Sydney Opera House Trust</b>
<b>Respondent:</b>	<b>Jeffrey Campbell</b>

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### 1. The Parties and Contested Domain Name

The Complainant is Sydney Opera House Trust, of Sydney, New South Wales, Australia.

The Respondent is Jeffrey Campbell, of Lujoe City, Taipei County, Taiwan.

The domain name at issue is <sydneyoperahouse.tv> (“the Disputed Domain Name”), registered by Respondent with eNom Inc., of Bellevue, Washington, USA.

### 2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the “ADNDRC”) on October 16, 2009. On October 21, 2009, the ADNDRC transmitted by email to eNom, Inc. a request for registrar verification in connection with the Disputed Domain Name. On October 23, 2009, eNom, Inc. transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The ADNDRC verified that the 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 ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC formally notified the Respondent of the Complaint, and the proceedings commenced on October 23, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was November 12, 2009. The Response was filed with the ADNDRC on November 12, 2009.

After consultation of the parties according to the Supplemental Rules, article 8 para. 4 (which provides that where a single Panelist is elected and a Response is received, the sole Panelist will be the highest mutually ranked Panelist on the list of five (5) Panelists that will be provided to each Party by the ADNDRC), the ADNDRC appointed Jacques de Werra as the sole panelist in this matter on December 15, 2009.

The Panel determines that the appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

### **3. Factual background**

The Complainant is a body corporate established under the Sydney Opera House Trust Act 1961 of the New South Wales parliament in order to manage and administer the building known as Sydney Opera House as a theatre, concert hall and place of assembly (subject to the control and direction of the relevant government Minister). It is empowered to do all things it may deem incidental or conducive to the profitable and effective attainment of its objects and performance of its functions. It may acquire and hold any real or personal property and any rights and privileges which it may think necessary or convenient for its objects. To this end, the Complainant is specifically authorized to register, purchase or apply for or otherwise acquire any trademark which may seem capable of being used in the exercise or in furtherance of any of its functions or the acquisition of which may seem to be calculated directly or indirectly to benefit the Complainant.

The Sydney Opera House is one of the busiest performing arts centers in the world which is visited by 7.5 million people each year. It has become a symbol of both Sydney and Australia. It was awarded in 2007 UNESCO World Heritage Listing. The Complainant owns and operates the website <sydneyoperahouse.com> which receives 2 million visits each year.

The Complainant is the owner of two Australian word trademarks for “SYDNEY OPERA HOUSE” (registration No. 710167, which was registered on June 15, 1996, and registration No. 1225090, which was registered on June 18, 2008) for various goods and services registered in classes 3, 8, 9, 14, 16, 18, 20, 21, 25, 26, 28, 29, 30, 32, 33, 35, 36, 38, 39, 41 and 41 (“the Trademarks”).

The Disputed Domain Name was registered by the Respondent on December 31, 2006, that is ten years after the registration of the first of the Trademarks (i.e. registration No. 710167, which was registered on June 15, 1996).

The Disputed Domain Name is presently used to point to the domain name <carsondaly.tv>, which is a website that purports to be operated by Carson Daly, a US television presenter and which predominantly comprises links to various video clips hosted on “YouTube” but which also contains some advertisements.

Based on information provided by eNom, Inc. to the Respondent in an email dated November 6, 2009, the Disputed Domain Name automatically directs to the domain name <carsondaly.tv> as a part of an automatic parking program (“Domains registered at eNom.com that are not set to specific DNS or have no host records will automatically default to a parking page. For undirected .TV domains, our default is to redirect to the domain carsondaly.tv”).

### **4. Parties’ Contentions**

#### **A. Complainant**

The Complainant’s contentions may be summarized as follows:

- i. The Disputed Domain Name is identical to the Trademarks that it owns.

- ii. The Respondent has no right in the Disputed Domain Name and he is not authorized or licensed to use the Trademarks.
- iii. The Respondent has not used the Disputed Domain Name neither in connection with a bona fide offering of goods or services nor for a legitimate non-commercial or fair use since the time of the registration of the Disputed Domain Name.
- iv. The Respondent has not been commonly known by the Disputed Domain Name.
- v. The Respondent alleged in a correspondence with the Complainant that he registered the Disputed Domain Name “with the intention of harnessing the internet to promote World Heritage”. It is however not clear what the Respondent meant from this and given the international reputation of the Trademarks, it is inconceivable that the Respondent was not aware of them at the time of registration of the Disputed Domain Name, and an inference can be drawn that the such registration by the Respondent constituted bad faith registration and use.
- vi. As Sydney Opera House is a UNESCO World Heritage Listed site and the Respondent registered the Disputed Domain Name “to promote world heritage”, the Respondent is clearly relying on Sydney Opera House’s status and connection with World Heritage listing to attract people to his website.
- vii. The fact that the Disputed Domain Name has not been active since its registration for the Respondent’s stated purpose and is directed to an unrelated website also indicates that the Respondent registered and uses the Disputed Domain Name in bad faith.

B. Respondent

The Respondent’s contentions may be summarized as follows:

- i. The Complainant forfeited its rights due to its inaction over a period of nine years because the Complainant did not react against the registration and use for several years of other domain name including the Trademarks by third parties without reaction from the Complainant (i.e. <sydneyoperahouse.co.uk>, <sydneyoperahouse.org>, <sydneyoperahouse.biz> and <sydneyoperahouse.info>) so that the Respondent could infer that this was not a trademark and that the Complainant tolerated non-commercial/fair use of domain names integrating the Trademarks (the Respondent however notes that the Complainant was only interested in the .tv ccTLD for the purpose of launching a specialized digital channel at Sydney Opera House).
- ii. The Respondent consequently considers that the Complainant has been negligent in its duties to fight against infringement of the Trademarks in third party domain names so that its request to transfer the Disputed Domain Name is “therefore considered unreasonable”.

- iii. The Respondent claims to be a “heritage professional with a Cultural Heritage/IT background” and states that he worked for UNESCO. He alleges that he has the right to develop the Disputed Domain Name in a non-commercial form “as the Sydney Opera House is ‘*the heritage of all the peoples of the world*’<sup>1</sup>”, that he has not done so yet because he has been busy with finishing his Masters and developing other non-profit-culture/IT projects but that he will develop it as a part of his planned PhD to promote World Heritage in line with UNESCO’s current strategic objectives.
- iv. The Respondent claims to have refused two recent offers for compensation from the Complainant as he had no need or desire to profit from the Disputed Domain Name and needed no support to search for a suitable institution for his planned PhD.
- v. The Respondent claims that he is not responsible for the present use of the Disputed Domain Name (which redirects to the website <carsondaly.tv>) given that the registrar of the Disputed Domain Name (eNom, Inc.) has automatically redirected the Disputed Domain Name to this site (as this results from an email received by the Respondent from the registrar dated November 6, 2009 according to which “Domains registered at eNom.com that are not set to specific DNS or have no host records will automatically default to a parking page. For undirected .TV domains, our default is to redirect to the domain carsondaly.tv”).

## 5. Findings

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

### A) Identical / Confusingly Similar

The Panel is satisfied that the Complainant has rights to the Trademarks in Australia.

The Panel also fully admits the finding made in *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. D2000-1224, in which the Panel held that « The fact that the fame of the Sydney Opera House is attributable to its global significance as a building does not mean that trademark rights may not exist in the name Sydney Opera House ». From this perspective, the belief of the Respondent that « cultural icons » such as Sydney Opera House « would most likely not be trademarked » is of no relevance and does not prevent the finding that the Complainant is the owner of the Trademarks which are valid.

A comparison between the Disputed Domain Name and the Trademarks shows that the Disputed Domain Name is identical to the Complainant’s Trademarks. The only difference between the

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<sup>1</sup> As quoted by the Respondent from the Operational Guidelines for the Implementation of the World Heritage Convention.

Disputed Domain Name and the Trademarks is the appending of the gTLD “.tv” to the Trademarks, with that difference being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy. See, e.g., *Delta Compression S.R.L. v. Targon Ltd.*, WIPO Case No. D2008-1934; and *Pernod Ricard v. Tucows.com Co*, WIPO Case No. D2008-0789.

As a result, based on the rights of the Complainant in the Trademarks and on the identity between the Trademarks and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

## **B) Rights and Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the 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.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

In the Panel’s opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name which corresponds exactly to the Trademarks owned by the Complainant. In spite of the project to use the Disputed Domain Name for a World Heritage project contemplated by the Respondent, it appears that the Disputed Domain Name is presently used to point out to a third party commercial website (<www.carsondaly.tv>) in the framework of a parking program (as resulting from the email of the registrar of the Disputed Domain Name of November 6, 2009 stating that domains « will automatically default to a parking page »).

The Complainant has also established that the Respondent has no right in the Disputed Domain Name, that he is not authorized or licensed to use the Trademarks and that the Respondent has not been commonly known by the Disputed Domain Name.

The Panel thus accepts the Complainant’s *prima facie* showing and it is consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name.

The Respondent alleges for this purpose that he registered the Disputed Domain Name for a planned Cultural Heritage/IT PhD project that he wants to conduct in 2010/11 but about which he has not provided any detailed information whatsoever. The Respondent has not provided any information either on the reasons why he has chosen to register the Disputed Domain Name

which is exactly identical to the Trademarks for such project with a “.tv” extension, whereby his project does not appear to be focused at all on Sydney Opera House but shall more generally address the promotion of World Heritage as such.

Even though the Panel takes notes of the explanations given by the Respondent stating why he has not developed / activated the Disputed Domain Name so far (i.e. because he has been busy with finishing a – unidentified - Master program and developing – unidentified - other non-profit culture/IT projects), such vague and unsubstantiated reasons cannot avoid the need of the Respondent to show and establish by credible evidence his right or legitimate interests in the Disputed Domain Name.

The Panel consequently holds that the fact that the Respondent has plans to use the Disputed Domain Name for a non-profit use cannot suffice in the absence of relevant evidence duly establishing this purpose (see *Royal Caribbean Cruises Ltd. v. Gold Anchor Service and Gold Anchor Standards*, WIPO Case No. D2003-0443 ; see also *Intelligent Medical Objects, Inc. v. Domains by Proxy, Inc. / Atif Zafar*, WIPO Case No. D2009-1342 holding that « While the Respondent expressed his intention to eventually use the domain name to resolve to a non-revenue producing educational site for various medical devices, those intentions – which further have not been supported by any evidence – are nothing more than mere expectations – expectations that may never become reality. As such, the Panel looks at past and present, but not possible future, use »).

The Panel further notes that even if the Respondent has established that he worked for UNESCO in Bangkok in the past (even if this was at the time when he registered the Disputed Domain Name), this fact is not sufficient *per se* to admit that the Respondent has a right or legitimate interests in the Disputed Domain Name and that the Respondent will use the Disputed Domain Name for its stated purpose because his past activities cannot constitute as such a convincing piece of evidence for establishing the contemplated use of the Disputed Domain Name for the announced « Cultural Heritage/IT PhD project » about which no information is provided by the Respondent, in particular explaining why the project which shall relate to Cultural Heritage as such is supposed to be anchored in a domain name connected only to Sydney Opera House.

The Panel also emphasises that the Respondent has chosen to register a domain name that is identical to the Trademarks in which the Complainant has rights. As held in recent decisions, (*Canadian Tire Corporation Limited v. CK Aspen*, WIPO Case No. DTV2007-0015 referring to *1066 Housing Association Ltd. v. Mr. D. Morgan*, WIPO Case No. D2007-1461), the use of a domain name that is identical to a mark is unlikely to provide rights or legitimate interests even if the registrant is using the domain name for a genuine non-commercial criticism site. In such case, the argument is that the use of a domain name that is identical to a trade mark will usually involve impersonation of the trademark owner, and such impersonation does not provide a legitimate interest even if the domain name is being used to exercise a right of free speech. In this case, the potential free speech arguments that the Respondent could have raised are weaker than in the case of criticism sites. Consequently, the Panel is convinced that there can be even less of a claim to a right or legitimate interests made by the Respondent with respect to the Disputed Domain Name.

The Panel thinks appropriate to remind in this respect that « a respondent can always choose a domain name that does not carry with it the perception of being authorised by the trademark owner ». See *1066 Housing Association Ltd. v. Mr. D. Morgan*, WIPO Case No. D2007-1461.

On this basis, the argument raised by the Respondent who claims - by citing the Operational Guidelines for the Implementation of the World Heritage Convention - that the Sydney Opera House is « the heritage of all the people of the world » so that « allowing only the Complainant

the right to dictate how the heritage value is communicated is contrary to the spirit of the World Heritage » is of no relevance. The Respondent is indeed free to communicate about the Sydney Opera House - and more generally about Cultural Heritage - by any means of his choosing as long as this shall not create any false impression about the existence of relationships with the Complainant, whereby such relationships result from the use of a Disputed Domain Name which corresponds exactly to the Trademarks owned by the Complainant.

The Panel further specifies that the absence of legitimate interests of the Respondent in the Disputed Domain Name does not depend on whether the Respondent commercially gains from the use of the Disputed Domain Name which is made by a third party (in the course of a parking program). See, by analogy, *Canadian Tire Corporation Limited v. CK Aspen*, WIPO Case No. DTV2007-0015 (in which the relevant domain name was pointing to the same website <www.carsondaly.tv> as the one to which the Disputed Domain Name points in this case).

The Respondent claims that the request of transfer of the Disputed Domain Name made by the Complainant should be rejected as « unreasonable » because the Complainant has not reacted against the registration and use of other domain names containing the Trademarks (such as <sydneyoperahouse.info>) which led the Respondent to believe that Sydney Opera House was not protected by any trademarks.

However, the lack of reaction of the Complainant against third parties cannot be used for the benefit of the Respondent because the existence of third party domain names which were potentially infringing on the rights of the Complainant cannot provide a legally relevant source of information as to the existence or validity of trademarks owned by the Complainant. This is so because even the owners of such domain names cannot claim to be protected under the Policy because some time has elapsed since the moment when they registered the relevant domain names. This is so because the doctrine of laches is generally not considered applicable under the Policy. See *The Hebrew University of Jerusalem v. Alberta Hot Rods*, WIPO Case No. D2002-0616. This consequently means that the Complainant could potentially react against such third party domain name registrations so that the Respondent cannot rely on such registrations in order to justify the validity of his registration of the Disputed Domain Name.

This argument of the Respondent is even less admissible because he admits that the « Complainant was only interested in the .tv ccTLD » so that the Respondent implicitly concedes himself that the inaction of the Complainant against other non « .tv » domain names containing the Trademarks cannot negatively affect the steps that the Complainant is taking against the registration of the Disputed Domain Name.

Based on the response and the legal sources that are cited therein by the Respondent, it appears that the argument of the Respondent is that the fact that the Complainant delayed for 3 years following registration of the Disputed Domain Name to bring this action against Respondent should act as a bar to a finding in favour of Complainant.

However, as decided by numerous other Panels, this Panel « does not accept that there is meaningful precedent under the Policy for refusing to enforce trademark rights on the basis of a delay in bringing a claim following use of a disputed domain name » (see *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D2006-0560 ; as subsequently confirmed among others by *Legislator 1357 Limited, Legislator 1358 Limited, Ian Fleming Limited v. Alberta Hot Rods*, WIPO Case No. D2008-0832). On this basis, the Panel admits that the Complainant is still in a position to invoke the protection granted under the Policy irrespective of the passing of time since the registration of the Disputed Domain Name by the Respondent.

The Panel also notes that there is no indication whatsoever that the Respondent suffers any prejudice from such delay in taking action. As noted by another Panel in a comparable situation, this case « is not a case where a complainant sits idly by before objecting while an unsuspecting respondent builds a valuable business » (*Alstom v. Itete Peru S.A.*, WIPO Case No. D2009-0877).

The Panel notes in this respect that the Respondent has not started to use the Disputed Domain Name at all. As a result, the Respondent cannot validly claim that the Complainant should be barred from invoking the protection of the Trademarks under the Policy.

Accordingly, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

### **C) Bad Faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (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;
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt 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 examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademarks are distinctively identifying the Sydney Opera House (it being noted that the first of the Trademarks was registered more than ten years before the registration of the Disputed Domain Name).

As a result, similarly to what was held by another Panel in a previous case involving the Complainant, the Respondent cannot have failed to have known of the use of the name Sydney Opera House to identify the building located at Bennelong Point in Sydney before the



Respondent registered the Disputed Domain Name. On this basis, the panel finds that the Respondent should have known of the registration and use of the Trademarks before it registered the Disputed Domain Name and the fact that the Respondent may not have effectively known that the Complainant had registered the name as a trademark is irrelevant. See *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. D2000-1224.

As already noted above with respect to the second condition (see above B), the Panel is struck by the Respondent's absence of evidence relating to his projects relating to the future use of the Disputed Domain Name. It is also struck by the fact that the Respondent chose to register a domain name which reflects exactly the Trademarks with a ".tv" extension for which no explanation was given.

As decided by other Panels, if one accepts that registration of an identical domain name for the purpose of genuine criticism can be in bad faith, it must be admitted that an identical domain name that merely resolves to a third-party website (in the course of a parking program such as is the case here) can also be in bad faith. See *Canadian Tire Corporation Limited v. CK Aspen*, WIPO Case No. DTV2007-0015 ; *1066 Housing Association Ltd. v. Mr. D. Morgan*, WIPO Case No. D2007-1461.

In the absence of any evidence provided by the Respondent legitimizing his use of the Disputed Domain Name and explaining in a convincing manner the choice of the Disputed Domain Name, the Panel cannot conclude otherwise than by stating that the registration and use of the Disputed Domain Name was made in bad faith. See *Aventis Pharmaceuticals Products Inc. v. PBS Publishing LLC*, WIPO Case No. D2003-0122 (holding as a relevant factor for assessing the bad faith the lack of credible evidence to support Respondent's claim that the relevant domain name was registered in good faith as reflecting the alleged *bona fide* name of a new product).

On this basis, in view of the identity of the Disputed Domain Name with the Trademarks and of the absence of any evidence brought by the Respondent supporting his contemplated development project for the Disputed Domain Name, The Panel has formed the view that the Respondent's intention in registering and using the Disputed Domain Name was to divert Internet users looking for information about the Complainant and about Sydney Opera House to a website other than the Complainant's and thus to take advantage of the reputation that the Complainant has built up in the Trademarks as resulting from the well-known Sydney Opera House.

This is so because the Panel admits that the fact that the Respondent chose to register the very name of the Sydney Opera House in the Disputed Domain Name which identically corresponds to the Trademarks is likely to give the false impression of an authorized association between the Complainant and the Respondent which the Respondent knew did not and does not exist. On this basis, similarly to what was held in a previous decision involving the Complainant, the panel finds this to constitute use in bad faith. See *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. D2000-1224.

Even if the Respondent does not appear to benefit from revenues resulting from the present use of the Disputed Domain Name which points to the website <www.carsondaly.tv>, this does not prevent the finding that the registration and the subsequent holding of the Disputed Domain Name was made in bad faith (see the same reasoning adopted in the decision *Canadian Tire Corporation Limited v. CK Aspen*, WIPO Case No. DTV2007-0015, in which the relevant domain name was similarly pointing to the website <www.carsondaly.tv>).

For all these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to paragraph 4(a)(iii) of the Policy.

## **6. Decision**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <sydneyoperahouse.tv> be transferred to the Complainant.

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Jacques de Werra  
Panelist

Dated: December 29, 2009