



DECISION

BNOS Menachem Inc. v. YLSL aka grsm yo
Claim Number: FA0203000105773

PARTIES

The Complainant is **BNOS Menachem, Inc.**, Brooklyn, NY ("Complainant") represented by **Gordon E. R. Troy**. The Respondent is **YLSL aka grsm yo**, Brooklyn, NY ("Respondent") represented by **Paul Goodman**, of **Ellenoff Grossman Schole & Cyruli, LLP**.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<bnosmenachem.org>** and **<bnosmenachem.com>**, registered with **G.K. Group**.

PANEL

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

Hon. Roger P. Kerans as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum ("the Forum") electronically on March 8, 2002; the Forum received a hard copy of the Complaint on March 11, 2002.

On March 12, 2002, G.K. Group confirmed by e-mail to the Forum that the domain names **<bnosmenachem.org>** and **<bnosmenachem.com>** are registered with G.K. Group and that the Respondent is the current registrant of the name. G.K. Group has verified that Respondent is bound by the G.K. Group 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 March 13, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of April 2, 2002 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@bnosmenachem.org and postmaster@bnosmenachem.com by e-mail.

A timely Response was received and determined to be complete on April 16, 2002.

A further submission from the Complainant was received on April 19, 2002, and this was in

compliance with Rule 7(a) of the National Arbitration Forum Rules.

On April 26, 2002, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Hon. Roger Kerans as Panelist.

RELIEF SOUGHT

The Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. BNOS MENACHEM is Hebrew for "Daughters of Menachem." It was the name adopted by the Complainant not-for-profit corporation for its school for young women in Brooklyn, New York, USA. The Complainant says the name was taken to honor the late Rabbi Menachem.
2. The Corporation was created in 1999 and the school has operated since September, 2000.
3. The Complainant had registered the name <bnosmenachem.org> but inadvertently permitted the registration to lapse.
4. The Respondent registered the names in dispute on February 12, 2002, and at the time of registration was aware of the previous registration.
5. The website of the Respondent promotes another school for young women in Brooklyn called Beis Rivka.
6. The Respondent on registration gave as an address a location in Brooklyn of a Jewish Temple not associated with either school. Also, the email address seems to be registered to a person who seems to be located in southern California, and the telephone number supplied on registration is listed for yet another person.

B. Respondent

1. BNOS MENACHEM is a generic name, and the Complainant in fact calls its school the Bnos Menachem School for Girls.
2. A use offered in tribute to the late Lubavitcher Rabbi Menachem Scheerson is generic.
3. BNOS MENACHEM is also the name of a school in Johannesburg, South Africa. It is commonplace for Jewish organizations to employ the name "BNOS" (daughters) or "BNAI" (sons) or "BETH" (children).
4. The Respondent does not say what interests it pursues with its use of the domain name in question, and limits its comments to an argument that the Complainant has not proven its case.
5. The Respondent does not identify itself, but says that it is pure speculation to say that it has no connection with the Temple located at the address supplied. Nor should any inference be drawn from a change in telephone numbers.

C. Additional Submissions for the Complainant

1. The alleged school in South Africa in fact does not exist, as evidenced by extracts from the telephone directory. Moreover, the telephone shown on the Respondent Web page is for Lubavitch Foundation Orchards, not a school.
2. Evidence is offered of use by the school merely of the name BNOS MENACHEM unaccompanied by any reference to "school for girls", as, for example, the name on a school bus.
3. The reference on the Respondent website to a South African school was uploaded only after

this Complaint was filed.

4. After the Complaint was filed, the Respondent attempted to transfer the domain names. Photographs of the new address are offered to show no school. Mail addressed to the new registrant was returned as "unknown" or "refused".

The Respondent registered the domain names in issue on the very day that the previous registration of the Complainant expired.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (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."

Paragraph 4(a) of the Policy requires that the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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

<**bnosmenachem.org**> and <**bnosmenachem.com**> are confusingly similar to the name BNOS MENACHEM, or indeed the name BNOS MENACHEM School for Girls.

Rights or Legitimate Interests

The Complainant satisfies me that it has a legitimate interest in the name BNOS MENACHEM, as it has been used by it in connection with a Brooklyn school operated by it.

The Respondent alleges that this name is generic. But the Respondent must provide evidence of alleged genericness. See *Limco, Inc. v. Rarenames*, FA 99693 (Nat. Arb. Forum Nov. 27, 2001) (finding that rather than just claiming that a term is generic, Respondent should provide further evidence of genericism, considering "words such as 'crew', 'playboy', 'quicktime' and 'scholastic' have been granted trademark registrations that have been protected in domain dispute cases").

Here, the Respondent relies on the existence of a school with a similar name in the Republic of South Africa. The Complainant, however, satisfies me that I should not accept this allegation as proven. I must proceed on the basis that this school does not exist.

It is correct that it is very possible that another Jewish organization may choose to honor Rabbi MENACHEM by describing itself as "Daughters" of MENACHEM. But the Respondent fails to persuade me that to this date any have. In any event this argument is a two-edged sword. If more than one person or corporation chooses to honor the Rabbi in this way, probably nobody, *including this Respondent*, is entitled to employ the term BNOS MENACHEM without some qualifier like "school" or "Brooklyn".

Furthermore, Respondent claims that BNOS MENACHEM is at the very most a descriptive mark. See *Lowestfare.com LLA v. US Tours & Travel, Inc.*, AF-0284 (eResolution Sept. 9, 2000) (finding that marks classified as descriptive cannot be protected unless secondary meaning is proven and to establish secondary meaning the complainant must show that the public identifies

the source of the product rather than the product itself). But, on the evidence, I have no difficulty drawing the inference that some members of the public in Brooklyn associate the name with the school.

I conclude that the Complainant has a legitimate interest in the name. The Respondent does not assert any special rights in the name, being content to argue that it should not receive any legal protection.

Registration and Use in Bad Faith

The combined facts of registration by the Respondent the very day the Complainant permitted its registration to lapse, the hazy details about ownership, the absence of any expressed purpose for or interest in the use of this name by this Respondent, the promotion on the Respondent website of another Brooklyn Jewish school for young women, and the attempt to assert after the Complaint was filed that there is such a school in South Africa, together persuade me that the real purpose of the Respondent here is to harass the Complainant. This is bad faith within Rule 4(b)(iii).

DECISION

I direct that the names <bnosmenachem.org> and <bnosmenachem.com> be transferred to the Complainant.

Hon Roger P. Kerans Panelist
Dated: May 3, 2002

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