Panel Decision for dispute CAC-ADREU-006219

Case number	CAC-ADREU-006219
Time of filing	2012-05-15 01:44:01
Domain names	clarkssale.eu, clarksstore.eu, clarksonline.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	Smart Voucher Ltd t/a Ukash

Respondent

Organization	NA

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any pending Legal Proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a registered company named “C. & J. Clark International Ltd,” and based in Great Britain. The Complainant is a shoe manufacturer and retailer and uses the domain Clarks.eu for commercial purposes and is owner of several Trademarks containing “Clarks” and is using them.

The Respondent registered domain names “clarkssale.eu”, “clarksstore.eu” and “clarksonline.eu” under which it hosted websites similar to the Complainant’s and sold products similar to those marketed by the Complainant.

On 17 January 2012, the Complainant initiated ADR proceedings. The Complainant, represented by Safenames Ltd, submitted a complaint against the Respondent claiming that the Respondent registered the domain names without rights or legitimate interest and in bad faith and that, therefore the registration should be declared abusive within the meaning of Article 21 of EC Regulation No. 874/2004 (hereinafter “Public Policy Rules”).

The Respondent did not submit a Response or any other communication.

According to the ADR Rules, Paragraph B3 f) the Respondent and the Complainant were informed by the case administrator of the default. Even so the following five days after receiving this notification the Respondent did not react (challenge the notice of Respondent ´s Default according to Paragraph B3 (g) of the ADR Rules).

A. COMPLAINANT

A. The domain names are identical or confusingly similar to the name or names in respect of which a right or rights are recognised or established by national and/or Community law

Complainant in these proceedings is C. & J. Clark International Ltd, a company incorporated in 1915 under the laws of England and Wales. Complainant trades under the name of Clarks and is a famous British, international shoe manufacturer and retailer based in Somerset, England. Please refer to Exhibit A for further details regarding Complainant’s company details.
Complainant claims a legitimate interest regarding the registration of the disputed domain names on the basis that Complainant is a holder of “prior rights” as defined in Article 10(1) of Regulation. Complainant derives ‘prior rights’ through title to the trademark registrations for which Complainant is listed as the sole proprietor.
Complainant uses its marks in connection with the design, manufacture, and distribution of quality footwear products and fashion

accessories which includes bags, purses and umbrellas. Complainant also operates its own retail, outlet, and online stores under its CLARKS marks. Additionally, Complainant uses the above trademarks in advertisement campaigns around the globe and Complainant's CLARKS marks are clearly visible on Complainant's official website located at <CLARKS.COM>
As part of Complainant's business strategy, Complainant and its subsidiaries have already registered many domain names which either consist solely of, or contain its CLARKS marks. Complainant utilises the individual domain names to provide its customers with information specific to their location.
Complainant has built an austere reputation for itself in relation to its various lines of footwear and related products and as a result of the valuable goodwill that Complainant has built up in its Clarks brand, Complainant has been able to establish a strong customer base. Complainant's renown has made the term "CLARKS" become a household name synonymous with Complainant and Complainant's products.

B. The domain names have been registered by their holder without rights or legitimate interests in respect of the domain names that are the subject of the Complaint

On the surface, it appears that the Respondent has used the domain names in dispute in connection with an offering of goods or services prior to any notice of the current alternative dispute resolution procedure. However, Complainant avers that Respondent's use of the domain names at dispute cannot give rise to legitimate interests as the current websites cannot be considered a true offering of goods or services. As far as Complainant is aware, the Respondent does not appear to fulfill their obligations as a vendor as consumers do not receive any goods or services after payment is taken from them.

The domain name <CLARKSSALE.EU> was until recently still active, and pointed to a website which was very similar to the content and layout of the respective websites currently located at <CLARKSSTORE.EU> and <CLARKSONLINE.EU>. Although the products displayed on the website are identified using the CLARKS mark and use style names associated with genuine CLARKS style shoes, Complainant maintains that the shoes offered by Respondent are different in appearance from Complainant's genuine CLARKS footwear.

Additionally, Respondent's websites features Complainant's "CLARKS" trademark logo and artwork and as such, Complainant contends that this is evidence that the Respondent is clearly attempting to pass itself off as Complainant in order to increase the sales of its counterfeit goods.

Complainant contends that the very nature of the websites to which the domain names at dispute resolve supports Complainant's assertion that the current use of the domain names by the Respondent is insufficient to show a legitimate interest as they are used for fraudulent and pirating purposes. Complainant contends that the Respondent has no other interest in or connection with the terms "CLARKS SALE"; "CLARKS STORE"; and "CLARKS ONLINE" other than to use the terms to trade on the valuable goodwill associated with Complainant.

Unlike the applicant who has made a name for itself as CLARKS, the terms contained within the domain names at dispute are not aliases or pseudonyms by which Respondent is commonly known. Additionally, simple Google searches for the combinations of the Complainant's CLARKS brand and terms contained in the disputed domain names, plus the name of the Registrant have returned no results at all. Furthermore, searches conducted within the International, European Community and French trademark databases for the aforementioned terms did not yield any results that correspond to Respondent. Searches within France's business register and French telephone directories have, likewise, returned no relevant results which could support Respondent's assertions of being commonly known by the domain names at dispute.

There is no legal or business relationship between Complainant and Respondent and Respondent has never been licensed, authorised, or granted rights to use, or to register the Complainant's famous CLARKS marks as part of a domain name. In the absence of such "permission from the Complainant...it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent."
Complainant is aware of no basis upon which the Respondent was entitled to register the domain name or circumstances in which it could be used in the course of trade by the Respondent given that (i) he was clearly aware of both the existence and the nature of the activities of the Complainant and (ii) not a single trademark or valid right can be found to support Respondent.
Complainant avers that Respondent will be unable to provide credible reasons behind his selection of the disputed domain names as he clearly has no legitimate rights or interests in the domain names. Complainant's CLARKS products are readily available throughout Europe both in commerce and via the Complainant's website and as such, any conduct or activity by Respondent in relation to the domain names, be it commercial or of any other nature, is likely to constitute a material violation of the laws of the United Kingdom as well as EU legislation on unfair competition and industrial property.
With consideration to the above, Complainant has found no evidence which would indicate that the domain names should remain with the Respondent. On the contrary, it is unimaginable that the Respondent chose the specific domain names with the intention of

systematic exploitation of the goodwill associated with Complainants CLARKS trademarks. Complainant relies on the legal principle of negativa non sunt probanda and asserts that on a balance of probabilities Respondent registered the disputed domain names without rights or legitimate interests. Thus Complainant reverently requests the Panel make a finding in its favour as Complainant has discharged its burden under Article 21(1)(a) of the Regulation.

C. The domain name should be considered has having been registered or being used in bad faith

Complainant warrants that the disputed domain names are abusive registrations on the part of Respondent and such conclusion can be drawn from the manner in which Respondent registered and used the disputed domain names.
Firstly, Complainant surmises that Respondent has registered the disputed domain names with opportunistic intent and that such registrations took place with full awareness and in willful ignorance of Complainant's rights and reputation in the CLARKS name and marks.
As mentioned previously, Complainant enjoys a worldwide reputation and strong market identity. Given Complainant´s strong and established position within the European and International markets, it is inconceivable to Complainant that at the time of Registration, Respondent could have been unaware of Complainant and the status and renown of Complainant's CLARKS name and marks.
Complainant's trademarks were duly registered and added to a publicly accessible database of protected trademarks well before Respondent's registration of the disputed domain names. Furthermore, the trademarks relied upon are Community Trademarks which apply to the whole of the European Union, and thus also the home country of the Respondent, France, where Complainant's products are also available for sale.
Complainant relies on prior case law that held bad faith registration could be established in circumstances where there is no factual relation between the Respondent and the disputed domain name: "The registration of a domain name identical or confusingly similar to a famous trademark by a person with no verifiable right or legitimate interest in the name constitutes a strong presumption that the domain name was registered in bad faith."
Furthermore, Complainant contends that it is highly improbable that Respondent registered the domain names at dispute by mere coincidence and independent of the knowledge of Complainant's CLARKS marks. Respondent cannot credibly claim to be ignorant of Complainant's marks at the time of registration as Respondent's clear intent to target and to capitalise on the goodwill associated with Complainant is made evident through the manner in which the domains have been used. Indicia of Respondent's awareness and knowledge of Complainant's marks can be seen through the choice of Meta keywords utilised by Respondent in order to further attract and divert traffic from Complainant.

The registration of multiple domain names which take advantage of Complainant's CLARKS marks further adds to the presumption of bad faith against Respondent. The close association between the suffixes in the respective domain names and the forum in which Complainant utilises its marks "provide opportunities for possible cybersquatting activities" and demonstrates that the domain names were not just random domain names that the Respondent decided to register but specifically chosen for illicit purposes.
Respondent is unduly disturbing Complainant's business through the detriment and dilution of Complainant's renowned CLARKS trademarks. Complainant avers that Respondent's conduct falls under Article 21(3)(c) of the Regulation where the domain names have been registered primarily for the purpose of disrupting the professional activities of a competitor.
On information and belief, the products sold by Respondent through the use of the websites located at the various disputed domain names are in fact counterfeit products. Although, at the time of filing, the sites at <CLARKSSALE.EU> and <CLARKSONLINE.EU> no longer appear to be active, Complainant avers that the very fact that the websites were designed to mislead consumers and Internet users alike is indicative of Respondent's bad faith.
Complainant avers that Respondent's registration and use of the disputed domain names in relation to fraudulent activities constitutes a disruption of Complainant's business. Internet users who come across the websites may purchase shoes from Respondent rather than from Complainant, especially where Complainant's CLARKS marks and logos are prominently displayed on the website along with the inclusion of product names associated with Complainant.

Respondent presumably receives monetary gain for all sales made on the websites resolving from the disputed domain names and Complainant avers that this demonstrates their intent for commercial gain. Respondent has evidently chosen to operate websites selling pirated goods at these specific domain names in order to profit from the confusion the domain names would cause.
Respondent's attempt to pass itself off as Complainant is evidently bad faith use as the websites are used to perpetrate fraud upon individuals who respected the goodwill surrounding Complainant's CLARKS marks. Respondent's conduct tarnishes the reputation and renown associated with Complainant's CLARKS marks. Complainant refers the Panel to Exhibit H which demonstrates the discernable harm caused to Complainant's brand as Complainant's relationship with its customers is negatively impacted.

B. RESPONDENT

The Respondent failed to provide its Response within the required deadline and did not respond in any way.

DISCUSSION AND FINDINGS

DISCUSSION AND FINDINGS

Given the facts and arguments of the parties, the Panel should decide whether the conditions of article 21 of Reg. No. 874/2004 are satisfied to decide whether the disputed domain names should be transferred to the Complainant or not.

1) ON THE PRIOR RIGHTS

Pursuant to Article 21. Reg. No. 874/2004, “A registered domain name shall be subject to revocation […] where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10.”

The Panel finds that the trademark rights vested in the name CLARKS claimed by the Complainant are clearly substantiated.

The Complainant justifies that it owns various trademark registrations for “Clarks” as well as several corresponding domain names in many extensions including .EU.

Besides, CLARKS is the Complainant’s trade name, under which it has been running its business for many years, as established by the Documentary evidence submitted to the panel.

2) ON THE IDENTITY OR CONFUSINGLY SIMILARITY OF THE DOMAIN NAME

a) The disputed “Clarkssale.eu”, “clarkstore.eu”, ”clarksonline.eu” domain names incorporate the trademarks that the Complainant claims it holds.

b) It is well-established that the extension of a domain name “.eu” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar to a trademark pursuant to Article 21 (1) of the Regulation (EC) No. 874/2004 (cf case No. 00283, lastminute.eu).

c) on the mentions of “online”, “sale” and “store” in the respective domain names.

- In ClarksOnline.eu, the word "ONLINE" appears in the Domain Name added to "Clarks". As outlined in ADR Case No. 04645 (“Airfranceonline.eu”), “the word "ONLINE" constitutes one of the most generic terms used to refer to information society services […] As a consequence, the word or string of characters "ONLINE" cannot be considered as distinctive or capable of dispelling a risk of confusion”.

- In ClarksSale.eu, the word “SALE” appears in the Domain name added to “Clarks”. The Panel refers to ADR Case No. 05546 Alkostore.eu: “Adding a generic and non-distinctive element to a protected name does not remove or indeed even lessen the confusing similarity between the disputed domain name and the Complainant’s registered rights, but rather informs the internet user that the website where the disputed domain name points is a place where the products […] are for sale”.

- In ClarksStore.eu, the word “STORE” appears in the Domain name added to “Clarks” and the Panel believes the same rationale applies.

The Panel thus finds that all domain names are confusingly similar to the trademarks invoked by the complainant and therefore deems the first requirement of Article 21 (1) of the Regulation (EC) No. 874/2004 is satisfied.

3) ON THE LEGITIMATE INTEREST IN THE NAME

“A registered domain name shall be subject to revocation […] where it
(a) has been registered by its holder without rights or legitimate interest in the name;

Pursuant to Article 10 of the Regulation (EC) No. 874/2004, the legitimate interest condition is considered as fulfilled when:
a) prior to any notice of an alternative dispute resolution procedure, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so
b) the Respondent has been commonly known by the domain name
c) the Respondent is making a legitimate and non commercial or fair use of the domain name, without intend to mislead consumers or harm the reputation of the name on which a right is recognized.

The Respondent, being in default, has not presented any justification for having registered or holding any of the disputed domain names.

The Panel therefore considers that there is no element in the present case which may be interpreted as justifying a finding that Respondent has any rights or legitimate interests in the disputed domain name.

4) ON THE RESPONDENT'S BAD FAITH

"A registered domain name shall be subject to revocation where it
(b) has been registered or is being used in bad faith."

The Complainant is a major shoe maker company and it asserts that it has been using its corporate name, trade name and trade mark CLARKS for many years all throughout the world.

The Panel agrees that the notoriousness of the name CLARKS is indisputable.

It is the Panel's opinion that the Respondent necessarily had the Complainant's trademarks in mind when it registered the disputed domain names for it could realistically ignore that there is only one CLARKS company in the world and that the name CLARKS is not free to use.

This is of course confirmed by both the screen shots offered by the Complainant that appear to show that all three domain names were linked to sites pretending to sell Clarks merchandise without any legitimate right to do so. It is moreover underlined by a search on "clarkssale.eu" which clearly shows that the site was identified as a "scam" site misleading customers that were willing to buy Clarks products and complaining that they never received them.

In the Panel's view therefore, the Respondent's behavior does not appear to have been dictated by a bona fide intent to use the disputed domain name. The Respondent did act in bad faith when it sought to register the disputed domain names.

5) TRANSFER OF THE DOMAIN NAME

The Complainant is a company incorporated under the laws of England and Wales and having its place of business within the European Community. Therefore, the requirements for the requested transfer of the domain name to the Complainant are satisfied (Section B No. 1 (b) (12) of the ADR Rules).

The Panel finds that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain names CLARKSSALE, CLARKSSTORE, CLARKSONLINE be transferred to the Complainant

PANELISTS

Name	Jean-Christophe A. Vignes

DATE OF PANEL DECISION 2012-04-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: clarksonline.eu, clarksstore.eu, clarkssale.eu

II. Country of the Complainant: UK, country of the Respondent: France

III. Date of registration of the domain name: 4 November 2011, for all three domains

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

Figurative CTM reg. no 000167916 for the term Clarks registered on 16 July 1998
Word CTM reg. no 000167940 for the term CLARKS registered on 16 July 1998
Word CTM reg. no 001694793 for the term CLARKS registered on 7 March 2002
Figurative CTM reg. no 003909744 for the term Clarks registered on 15 November 2005
Figurative CTM reg. no 004256681 for the term Clarks registered on 20 January 2006
Figurative CTM reg. no 004625844 for the term clarks registered on 13 July 2006
Figurative CTM reg. no 004656518 for the term Clarks registered on 31 August 2006
Figurative CTM reg. no 008133175 for the term Clarks registered on 23 December 2009
Figurative CTM reg. no 009198748 for the term Clarks registered on 27 January 2011

V. Response submitted: No

VI. Domain names are confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to lack the rights and legitimate interests: “Clarks” is a registered and famous trademark which was not licensed to the Respondent.

2. Rights or legitimate interests the Respondent claims to have: N/A
3. Does the Panel consider the Respondent to have no rights or legitimate interests: No

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to have registered or use the domain names in bad faith: no prior right, no license.
2. How the Respondent rebuts the statements of the Complainant: N/A
3. Does the Panel consider the Respondent to have registered or use the domain name/s in bad faith: Yes

IX. Other substantial facts the Panel considers relevant: use of scamming sites

X. Dispute Result: Transfer of the disputed domain names

XI. Procedural factors the Panel considers relevant: None