Panel Decision for dispute CAC-ADREU-006220

Case number	CAC-ADREU-006220
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Domain names	<microsoftzune.eu>

Case administrator

	Tereza Bartošková (Case admin)

Complainant

Organization	Microsoft B.V.

Respondent

Organization	Unknown

FACTUAL BACKGROUND

The Complainant is Microsoft B.V., a company based in the Netherlands. It is a subsidiary of Microsoft Corporation ("Microsoft"), an American company with offices based in Redmond (State of Washington, USA). The Complainant is a non-exclusive licensee of various Trade Marks in Europe registered by Microsoft and is entitled, by virtue of said license to institute all appropriate proceedings to enforce such license and preserve its parent's trade mark rights.

In making this Complaint, the Complainant relies on the Community Trade Marks held by Microsoft, which consist of the terms MICROSOFT and ZUNE, including:

• MICROSOFT n°000330910, filed on 22 July 1996 for classes 35, 41 and 42;
• MICROSOFT n°000479956 filed on 4 March 1997 for class 9;
• MICROSOFT n°000530253 filed on 2 May 1997 for classes 9, 16, 25, 38, 41 and 42;
• MICROSOFT n°002850634 filed on 13 September 2002 for class 25;
• MICROSOFT n°003212198 filed on 4 June 2003 for classes 36, 37 and 40;
• MICROSOFT n°003500824 filed on 21 November 2003 for class 16; and
• ZUNE n°005260211 filed on 16 August 2006 for classes 9, 16,25, 28, 35, 38, 41.

Microsoft has registered domain names worldwide including <microsoft.com>, <microsoft.net>, <microsoft.org>, <microsoft.co.uk>, <microsoft.de>, <microsoft.es> and <microsoft.fr>, <zune.com>, <zune.net>, <zune.org>, <zune.co.uk>, <zune.de>, <zune.es>, <microsoftzune.com> and <microsoftzune.net>.

Under the European extension, .EU, Microsoft has registered various domain names including <microsoft.eu> and <zune.eu>. Under the French extension .FR, Microsoft has registered <microsoft.fr> and <zune.fr>.

The Respondent is Peter Schmid. The Respondent has not participated in these proceedings, and all that is known is that the registrant gave an address in France.

A. COMPLAINANT

The Complainant contends that it is entitled to the relief claimed on the following grounds:

(A) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law.

The Disputed Domain Name fully incorporates both the Complainant's MICROSOFT and ZUNE Trade Marks protected under national and/or Community law as required by the ADR Rules. The Disputed Domain Name is simply composed of the juxtaposition of the terms MICROSOFT and ZUNE. While it is not identical to one particular Trade Mark, it simply reproduces identically two of the Complainant's Trade Marks and is therefore confusingly similar to both the MICROSOFT and ZUNE Trade Marks.

The Community Trade Marks grant protection to Microsoft in the terms MICROSOFT and ZUNE in all twenty-seven (27) member states of the European Union, including France where the registrant of the Disputed Domain Name, Mr. Peter Schmid, resides.

(B) The domain name has been registered by the Respondent without rights or legitimate interest in the name

A preliminary search by the Complainant adequately proves that the Respondent has no Community or International trade mark rights in either of the terms MICROSOFT or ZUNE.

The only MICROSOFT trade marks registered in France are held by the Complainant and that the only two ZUNE trade marks registered in France either belong to the Complainant or to a natural person whose family name is Zune.

On the French National Register of Commerce, the only active companies in France using the term MICROSOFT in their corporate names are Microsoft France, Microsoft EMEA and Microsoft Research & Development France SAS, all of which are affiliates of the Complainant. Also the only entries in relation to ZUNE correspond to private individuals having registered their business activities using their family names. The Respondent does not appear to have any connection with any of these business registrations.

Furthermore, the Respondent has never been authorised or otherwise licensed or permitted by the Complainant to use any of its trade marks. The Complainant and the Respondent are not affiliated with each other in any way.

Prior to any notice of the dispute, the Respondent was using the Disputed Domain Name to point towards a parking webpage which contains a number of commercial links promoting third party products, some of which relate to the sale of media players and accessories for such products.

Such use of the Disputed Domain Name cannot be regarded as a use in connection with any legitimate offering of goods or services or any preparations in this respect. The use of the Disputed Domain Name to point to such a website was clearly exclusively intended to misappropriate and benefit from Microsoft's goodwill and investments in the development of the MICROSOFT and ZUNE brands, brands which have gained worldwide fame and notoriety as a result of the efforts of Microsoft and its affiliates, as underlined above.

In addition, the Disputed Domain Name was registered by the Respondent only two days after the Zune brand of products and services was launched by Microsoft. This must have been with the obvious intent to benefit from such announcement by using the domain name for wrongful purposes, with no intention to provide any legitimate offering of goods or services.

To the Complainant's knowledge, the Respondent has no genuinely competing name or trade mark rights to the Disputed Domain Name and only chose a domain name incorporating the MICROSOFT and ZUNE brands because he knew that this would pick up traffic intended for websites operated by Microsoft.

The Respondent's use of the Disputed Domain Name cannot be said to be legitimate, as it was clearly calculated to take advantage of the MICROSOFT and ZUNE brands, consequently misleading consumers and harming the intellectual property

rights and the reputation of Microsoft's goods, services and websites. In addition, the fact that the Disputed Domain Name is pointing to a website which offers commercial links to Microsoft's competitors will only have caused an unsatisfactory and potentially harmful experience for internet users searching for a genuine Microsoft website accessing this website by mistake.

(iii) The domain name has been registered or is being used in bad faith".

The Disputed Domain Name was first registered on 16 September 2006, as evidenced by the WHOIS record for this domain name. This registration therefore occurred over 10 years after the date of registration of Microsoft's first CTM for the term MICROSOFT and more than 30 years after the inception of Microsoft. The registration also occurred just one (1) month after the filing of the ZUNE CTM and just two (2) days after Microsoft's announcement of the launch of the Zune brand of products and services.

In this respect, the term MICROSOFT has achieved the status of a well-known trade mark.

Such status for MICROSOFT as a well-known trade mark has been evidenced by the fact that it was ranked the third most valuable trade mark in the world by the Interbrand 2011 Report which valued it at over 59 billion US dollars (see Annex 10 - Interbrand 2011 Report). In consideration of the fame of Microsoft's trade marks, of the Zune products and services, it appears totally impossible the Respondent was not aware of the existence of Microsoft and its Zune products and services at the time of registration of the Disputed Domain Name.

The Disputed Domain Name is composed of the juxtaposition of two of Microsoft's trade marks in unaltered form. Given the distinctiveness of the two terms and the fact that the Disputed Domain Name is - with the exception of the extension - identical to a number of domain names registered by the Complainant (and which point to its main website for the Zune platform, www.zune.net, namely <microsoftzune.com> and <microsoftzune.net>), it is inconceivable that the Respondent did not have the Complainant in mind when the Disputed Domain Name was registered and did not intend to profit in some way from the Complainant's rights.

The Disputed Domain Name is being used to point to a website offering commercial links to products and services offered by third parties other than Microsoft. Such use, which greatly aggravates the damage caused to the Complainant by the registration of the Disputed Domain Name, evidently constitutes a bad faith appropriation of Microsoft's intellectual property rights. The Respondent's use of the Disputed Domain Name is therefore calculated to take advantage of the reputation of the MICROSOFT and ZUNE brands and to confuse internet users so as to divert traffic.

It is not necessary for the respondent itself to have profited directly from this kind of use in order to establish bad faith use, and it would be sufficient for the registrar (GoDaddy.com) or the third parties behind the sponsored links to have made some profit from such arrangements.

The Disputed Domain Name has never been used other than to point towards a GoDaddy holding page. This makes it highly likely that the Disputed Domain Name was acquired primarily for the purpose of selling it to the owner of the MICROSOFT and ZUNE brands.

The Respondent's email address is listed as contactus@advertoglobe.com. The domain name <advertoglobe.com> points to a website for an internet marketing solutions company based in Richmond, Canada, which also gives the contact email address contactus@advertoglobe.com. There is therefore a clear link between this company and the Respondent in this case. The domain name <advertoglobe.com> is owned by a Jason Prasad, who was the unsuccessful respondent (also of Richmond, Canada) in the following UDRP case: Anachusa Ltd. v. Prasad Jason, advertoglobe, WIPO Case No. DCO2010-0041. Thus it is clear that the Respondent, via a closely connected entity sharing the same email address, has engaged in previous cybersquatting behaviour.

The Disputed Domain Name has not been used in a relevant way for at least two years from the date of registration (redirection to a registrar holding page clearly does not qualify as "relevant") and thus it can be seen that this is preventing

the Complainant from reflecting its trade marks in a corresponding domain name.

The domain name was intentionally used to attract Internet users, for commercial gain to the Respondent’s website or other on-liocation,which is the case even if another third party is profiting from the use of the Disputed Domain Name, rather than the Respondent, such as the registrar or the providers of the sponsored links.

B. RESPONDENT

The Respondent did not participate in these proceedings. The ADR.eu case administrator reported that "the written notice of ADR Proceeding No 06220 sent out on 8 February 2012 and addressed to the Respondent was returned undelivered to the Czech Arbitration Court on 17 February 2012.

DISCUSSION AND FINDINGS

The Panel finds that:

1. The Complainant is the non-exclusive licensee of various Trade Marks in Europe registered by Microsoft and is entitled, by virtue of said license to institute all appropriate proceedings to enforce such license and preserve its parent's trade mark rights.

2. The Complainant is entitled to rely upon the Community Trade Marks held by Microsoft, which consist of the terms MICROSOFT and ZUNE, and reproduced to the satisfaction of the Panel. Furher the Complainant is entitled to rely upon registered domain names including <microsoft.eu> and <zune.eu>.and <microsoft.fr> and <zune.fr>. The term MICROSOFT has achieved the status of a well-known trade mark.

3. The Disputed Domain Name is confusingly similar to the Complainant's Trade Marks and business names, which are recognized or established by the national law of a Member State and/or Community law. In this regard, the Panel finds as a fact that the Disputed Domain Name fully incorporates both the Complainant's MICROSOFT and ZUNE Trade Marks protected under national and/or Community law as required by the ADR Rules. The Disputed Domain Name is simply composed of the juxtaposition of the terms MICROSOFT and ZUNE. While it is not identical to one particular Trade Mark, it simply reproduces identically two of the Complainant's Trade Marks and is therefore confusingly similar to both the MICROSOFT and ZUNE Trade Marks.

4. The domain name has been registered by the Respondent without rights or legitimate interest in the name. The Panel accepts as a fact that (a) the Respondent has no Community or International trade mark rights in either of the terms MICROSOFT or ZUNE, and is not authorised or licensed to use the Complainant's trade marks; (b) The Respondent does not have any connection with any of these business lawfully using the name ZUNE; (c) the Disputed Domain Name was registered by the Respondent only two days after the Zune brand of products and services was launched by Microsoft with the unchallenged intent to benefit from such announcement by using the domain name for wrongful purposes, with no intention to provide any legitimate offering of goods or services.

5. The domain name has been registered in bad faith. The Panel is persuaded on the basis that the Disputed Domain Name was first registered on 16 September 2006, 10 years after the date of registration of Microsoft's first CTM for the term MICROSOFT, just one (1) month after the filing of the ZUNE CTM and just two (2) days after Microsoft's announcement of the launch of the Zune brand of products and services - bearing in mind the worldwide renown of the trade marks.

6. The domain name is being used in bad faith. The Disputed Domain Name is being used to point to a website offering commercial links to products and services offered by third parties other than Microsoft. The Disputed Domain Name has not been used in any other way for at least two years from the date of registration. It is fair to conclude that someone, even if it is not the respondent, is profiting or stands to profit from use of the Disputed Domain Name.

7. The Complainant is entitled to have to the Disputed Domain Name transferred to it.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name MICROSOFTZUNE be transferred to the Complainant

PANELISTS

Name	**Joseph Dalby, Barrister, UK & Ireland**

DATE OF PANEL DECISION 2012-04-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: MICROSOFTZUNE.EU

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

III. Date of registration of the domain name: 16 September 2006

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word CTM, reg. No. 000330910 , for the term MICROSOFT, registered on 22 July 1996
2. word CTM, reg. No. 005260211, for the term ZUNE, registered on 16 August 2006

V. Response submitted: No

VI. Domain name is 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:(a) the Respondent has no Community or International trade mark rights in either of the terms MICROSOFT or ZUNE, and is not authorised or licensed to use the Complainant's trade marks; (b) The Respondent does not have any connection with any of these business lawfully using the name ZUNE; (c) the Disputed Domain Name was registered by the Respondent only two days after the Zune brand of products and services was launched by Microsoft with the unchallenged intent to benefit from such announcement by using the domain name for wrongful purposes, with no intention to provide any legitimate offering of goods or services.

2. Rights or legitimate interests the Respondent claims to have: None

3. Does the Panel consider the Respondent to have no rights or legitimate interests: No rights/legitimate interest.

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 name/s in bad faith: Registered: the Disputed Domain Name was first registered on 16 September 2006, 10 years after the date of registration of Microsoft's first CTM for the term MICROSOFT, just one (1) month after the filing of the ZUNE CTM and just two (2) days after Microsoft's announcement of the launch of the Zune brand of products and services - bearing in mind the worldwide renown of the trade marks. Used: The Disputed Domain Name is being used to point to a website offering commercial links to products and services offered by third parties other than Microsoft. The Disputed Domain Name has not been used in any other way for at least two years from the date of registration. Someone, even if it is not the respondent, is profiting or stands to profit from use of the Disputed Domain Name.

2. How the Respondent rebuts the statements of the Complainant: None

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: None

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None