Panel Decision for dispute CAC-ADREU-006281

Case number	CAC-ADREU-006281
Time of filing	2012-09-10 08:36:48
Domain names	yahooscan.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	Yahoo! Inc.

Respondent

Name	Toma Cristian

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed Domain Name.

FACTUAL BACKGROUND

The Complainants are Yahoo! Inc. from the USA and Yahoo! UK Limited from the United Kingdom (together “Yahoo!”). Yahoo! UK Limited (“Yahoo! UK”) operates as a subsidiary of Yahoo!, Inc.

Yahoo! UK Limited is a licensee of various trade marks in Europe registered by Yahoo! Inc. 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 Complainants rely on the following trade mark registrations of Yahoo! Inc. which consist of the term YAHOO!:

• Community trademark reg. no. 000693127 for the word "YAHOO!" (reg. date 22 January 2001)
• Community trademark reg. no. 001076181 for the word "YAHOO!" (reg date 7 June 2000)
• Community trademark reg. no. 002003150 for the word "YAHOO!" (reg. date 5 March 2002)
• Community trademark reg. no. 003949088 for the word "YAHOO!" (reg. date 1 October 2006)
• Community trademark reg. no. 001854215 for the word "YAHOO!" (reg. date 20 November 2001)
• Community trademark reg. no. 002309904 for the word "YAHOO!" (reg. date 3 September 2002)
• the United States of America trademark reg. no. 2,403,227 for the word "YAHOO!" (reg. date 14 November 2000)
• the United States of America trademark reg. no. 2,564,963 for the word "YAHOO!" (reg- date 30 April 2002)

The Complainants’ trade marks and trade names are collectively called the “Yahoo! Mark”.

The Complainants own the domain names YAHOO.COM and YAHOO.EU.

In addition to the services offered at Yahoo!’s home website www.yahoo.com, it operates many additional sites under the YAHOO! trade mark. For example, Yahoo! offers a wide variety of services using the YAHOO! Mark together with a descriptive name of its services including: YAHOO! Movies, YAHOO! Shopping, YAHOO! Answers, YAHOO! Mail, YAHOO! Messenger, YAHOO! Entertainment, YAHOO! Toolbar, YAHOO! Games, YAHOO! Finance, YAHOO! Music, YAHOO! News, YAHOO! Sports, and YAHOO! Weather.

The Respondent is Toma Cristian with an address in Romania. The Respondent has not participated in these proceedings. The domain

name yahooscan.eu is currently redirected to a website www.ydetector.org which is described to be “A website for Yahoo! Messenger status checking. With Ydetector.org you can now bypass Yahoo! Messenger's Invisible Settings with ease. It's quick and intuitive interface, Ydetector.org offers you the ability to see if your friend is truly online or if they are invisible.”

A. COMPLAINANT

Yahoo! Inc. (“Yahoo!”) is the premier digital media company in the world, with content covering news, shopping, photo sharing, and finance, among other things, and is the second most popular electronic mail service provider in the world. Yahoo!’s web sites are one of the most trafficked Internet destinations worldwide.

Yahoo! is the owner of the service mark and trademark YAHOO! and the trade name YAHOO! as well as the domain name YAHOO.COM. In continuous use since 1994, the YAHOO! Mark has become one of the most recognized brands in the world, and has been ranked as one of the top 100 global brands in the 2008 and 2009 “BRANDZ Top 100 Most Powerful Brands” report issued by Millward Brown in cooperation with the Financial Times and in the 2009 BusinessWeek/Interbrand Annual Brand Report.

Yahoo! UK Limited (“Yahoo! UK”) is an Internet services company located in the United Kingdom that operates as a subsidiary of Yahoo!, Inc. It provides Internet services under the YAHOO! Mark in the United Kingdom and Ireland, and is the registrant of the domain name YAHOO.EU.

YAHOO!-branded websites have long been among the most visited and well-recognized websites on the Internet. For example, during the month of January 2012, YAHOO!-branded websites attracted over 700 million visitors worldwide, reaching almost 50 % of the global online population. The YAHOO! homepage, located at www.yahoo.com, is the fourth most visited website in the world, and the fifth most visited website in Romania, Respondent’s home country. Yahoo! operates many additional sites under the YAHOO! Mark.

Yahoo! is the holder of various registered trademarks for the word “YAHOO!” in the European Union and the USA.

EURid’s Whois database shows that the disputed Domain Name was registered on 1 September 2008, and that the current Respondent registered or otherwise obtained the Disputed Domain Name on 5 July 2010. Therefore, Complainants’ Community and other rights in the famous and well known YAHOO! Mark predate the registration of the yahooscan.eu domain name.

The domain name yahooscan.eu resolves to a website located at the domain name ydetector.org entitled “YDetector.org” that is “a website for Yahoo! Messenger status checking. With Ydetector.org you can now bypass Yahoo! Messenger's Invisible Settings with ease. It's quick and intuitive interface, Ydetector.org offers you the ability to see if your friend is truly online or if they are invisible.” The website has multiple advertisements and links to Complainants’ competitors like Google through which Complainants presume Respondent generates click-through fees. Accordingly, the Respondent is not currently using the Disputed Domain Name to host its own website, but is redirecting users from the disputed Domain Name to a competing commercial website at a different domain name that provides monetized links to Complainants’ competitors.

On 7 July 2011 and on 15 July 2011, Complainants’ counsel in the United States attempted to contact the Respondent as soon as it became aware of the disputed Domain Name. As of the filing of the Complaint, Complainants have not been contacted by Respondent.

Article 21 (1) of Commission Regulation 874/2004 of 28 April 2004 (the “Public Policy Rules”) sets out the rules for domain name revocation. Complainants have rights in names which are recognized by national and/or Community laws, all of which pre-date the registration of the disputed Domain Name.

The disputed Domain Name is confusingly similar to Complainants’ famous YAHOO! Mark, which is recognized by Community law, because it contains the famous YAHOO! Mark in its entirety (exclamation points are not permitted in domain names) and adds the generic or descriptive term “scan”. This does nothing to distinguish the disputed Domain Name from the YAHOO! Mark. Indeed, consumers accustomed to Complainants’ use of the YAHOO! Mark together with a word descriptive of its services, such as YAHOO! Instant Messenger, are likely to perceive the disputed Domain Name as another such use of the YAHOO! Mark and therefore to identify the disputed Domain Name as being connected with Complainants. Further or alternatively, consumers are likely to conclude that the “scanner” offered at web site www.yahooscan.eu is a tool offered by Complainants in order to enhance the consumer’s experience of Complainants’ services. Consumers are thus led to perceive a connection between Complainants and the disputed Domain Name.

There is no legal or business relationship between Complainants and the Respondent which would give rise to any license, permission, or authorization for the Respondent to use the disputed Domain Name.

There is no evidence in the Whois for the disputed Domain Name or its subsequent use of the disputed Domain Name that the

Respondent has:

• used the disputed Domain Name in connection with the offering of goods or services or has made demonstrable preparation to do so, even after three years;
• been commonly known by the disputed Domain Name; or
• made legitimate and non-commercial or fair use of the disputed Domain Name (or explicable reason as to why the Respondent chose the disputed Domain Name) without intent to mislead consumers or harm the reputation of the YAHOO! Mark.

To the contrary, the disputed Domain Name merely redirects to another competing commercial website to Complainants. The Yahoo! Marks are famous, and are well known and in use for instant messaging services, software products, and providing information via websites. By using the Yahoo! Marks without permission from Yahoo! Inc., this website creates the impression that it is an authentic Yahoo! website, when in fact it is not. Moreover, consumers are likely to be confused that this website is somehow associated with or sponsored by Yahoo!, when in fact it is not. Indeed, there is no other reason for the owner to use the arbitrary and famous YAHOO! Marks other than to trade off the established goodwill in the Yahoo! Marks and to confuse consumers seeking Yahoo! websites into visiting its website. There is no justification for the Respondent's registration of the disputed Domain name: it is an infringing and commercial exploitation of the YAHOO! Mark, with all of its positive association and goodwill. Complainants therefore submit that the Respondent has no rights or legitimate interests in the disputed Domain name.

Complainants submit that the disputed Domain Name was registered and is being used by the Respondent in bad faith.

As Respondent uses a Yahoo! email, registered the disputed Domain Name after the YAHOO! Mark became famous, and redirected the disputed Domain Name to a website that contains numerous Yahoo! marks and offers competing services, it is clear that Respondent was aware of Complainants and the famous YAHOO! Mark at the time that it registered the disputed Domain Name. This suggests that the Disputed Domain Name was registered for the primary purpose of disrupting the professional activities of Yahoo!.

The yahooscan.eu domain name contains the famous YAHOO! Mark and redirects users to another website that offers competing services with Yahoo!'s websites. The Respondent presumably obtains advertising and click-through fees in respect of the advertising appearing on the website to which the disputed Domain Name resolves. The yahooscan.eu website heavily uses Complainant's famous YAHOO! Mark. It can be inferred that the disputed Domain Name was selected in order to attract internet users seeking Complainants' services and to divert them to the Respondent's website in order for the Respondent to profit commercially. Accordingly, Complainants submit that the disputed Domain Name was intentionally registered and is being used to attract Internet users, for commercial gain, to the Respondent's website by creating a likelihood of confusion with a name on which a right is recognized or established by national and/or Community law, with such likelihood arising as to the source, sponsorship, affiliation, or endorsement of the websites or location or of a product or service on the website or location of the holder of a domain name. There is thus overwhelming evidence that the disputed Domain Name was registered and is being used in bad faith.

For the above reasons, Complainants submit that the disputed Domain Name should be transferred to Yahoo! UK Limited.

B. RESPONDENT

The Respondent did not provide any response to the complaint.

DISCUSSION AND FINDINGS

In consideration of the factual background and the Parties' contentions stated above, I come to the following conclusions:

1. The relevant provisions

A. EC Regulation No. 874/2004 of, laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration

Article 2 (6) provides that domain names registered under the .eu TLD shall only be transferable to parties that are eligible for registration of .eu domain names.

Article 21 provides that 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 recognised or established by national and/or Community law, such as the rights mentioned in Article 10 (1), and where it (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith.

Article 22 (10) provides that failure of any of the parties involved in an ADR procedure to respond within the given deadlines may be considered as grounds to accept the claims of the counterparty.

Article 22 (11) provides that the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

C. ADR Rules

Paragraph B 10 provides that in the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party. Unless provided differently in these ADR Rules, if a Party does not comply with any provision of, or requirement under, these ADR Rules, the Supplemental ADR Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Paragraph B 11.d provides that the Panel shall issue a decision granting the remedies requested in the event that the Complainant proves (1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that

(i) 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 and; either

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

or

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

Paragraph B 11.e provides that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent’s rights or legitimate interests to the domain name for purposes of Paragraph B 11.d (1/ii):

(1) prior to any notice of the dispute, 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;

(2) the Respondent, being an a natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by
national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law.

Paragraph B 11.f provides that for purposes of Paragraph B 11.d (1/iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith:

(1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or Community law, or to a public body; or

(2) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:
(i) the Respondent has engaged in a pattern of such conduct; or
(ii) the domain name has not been used in a relevant way for at least two years from the date of registration

(3) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

(4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.

4. Conclusions

PROCEDURAL ISSUES

1. Failure to provide a response

The Respondent has not filed a response to the complaint submitted by the Complainant. In such a situation, the effect of the provisions of Article 22 (10) of Regulation No. 874/2004 and Paragraph B 10.a of the ADR Rules is that the failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21 (1) of Regulation No. 874/2004 and Paragraph B 11.d (1) of the ADR Rules are satisfied.

SUBSTANTIAL ISSUES

1. Yahoo! UK Limited is the subsidiary of Yahoo! Inc., and a licensee of various trade marks in Europe registered by Yahoo, Inc. Yahoo! UK Limited is by virtue of said license entitled to institute appropriate proceedings to enforce such license and preserve its parent's trade mark rights.

2. The Complainants are entitled to rely upon the Community Trade Marks held by Yahoo, Inc., which consist of the term YAHOO!, and reproduced to the satisfaction of the Panel. The term YAHOO! has achieved the status of a well-known trade mark. The Complainants are also entitled to rely upon registered domain names including <yahoo.com> and <yahoo.eu>.

3. The disputed 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.

In this regard, the Panel finds as a fact that the disputed Domain Name incorporates the Complainants' YAHOO! trade mark protected under national and/or Community law as required by the ADR Rules. The disputed Domain Name is simply composed of the registered and arbitrary trade mark YAHOO! (without the exclamation mark that cannot be included in any domain name) and a generic and descriptive word SCAN. While it is not identical to any particular trade mark, the simple adding of a generic and descriptive word to the protected trade mark makes the disputed Domain Name confusingly similar to the YAHOO! trade mark. The descriptive word SCAN is furthermore related to the well-known services provided under the trade mark YAHOO!, namely internet searches which can be described as "scanning".

Therefore, the first requirement established by Paragraph B 11.d of the ADR Rules has been duly satisfied.

4. The domain name has been registered by the Respondent without rights or legitimate interest in the name.

According to the Complainants, The Respondent has not used the disputed Domain Name in connection with the offering of goods or services and has not made demonstrable preparation to do so, is not commonly known by the disputed Domain Name; nor has the Respondent made legitimate and non-commercial or fair use of the disputed Domain Name (or explicable reason as to why the Respondent chose the disputed Domain Name) without intent to mislead consumers or harm the reputation of the YAHOO! Mark.

It is this Panel's opinion that the Complainant did not submit definitive supporting evidence proving that the Domain Name was registered without rights or legitimate interest in the name. However, this Panel agrees with the position stated in many ADR Decisions (amongst others No. 2035 <warema.eu>, 4925 <nyu.eu>, 5156 <yakult.eu> and 5051 <denon.eu>) that although the burden of proof lies with the Complainant, the existence of a right or legitimate interest is difficult to prove since the relevant facts lie mostly in the sphere of the Respondent. Therefore, it shall be sufficient that the Complainant proves that the obvious facts do not demonstrate a right or legitimate interest of the Respondent in the Domain Name. The burden of proof then shifts to the Respondent, who shall be able to prove his/her rights or legitimate interest in the Domain Name.

The Respondent was given the possibility to prove his/her rights or legitimate interest in the Domain Name but the Respondent failed to

file any response to the Complaint. In this respect, the Panel may consider the failure by the Respondent as grounds for accepting the claims of the Complainant, and that the Panel may draw such inferences from the default as it considers appropriate.

This Panel has not found any evidence regarding a possible right or legitimate interest in the Domain Name of the Respondent. The Panel accepts as a fact that (a) the Respondent has no Community, national or international trade mark rights in the term YAHOO or YAHOO!, and is not authorised or licensed to use the Complainants' trade marks; (b) The Respondent does not have any connection with any of these businesses lawfully using the name YAHOO or YAHOO!; (c) the Complainants' trade mark registrations predate the registration of the disputed Domain Name by the Respondent.

This Panel concludes that the Domain Name has been registered by the Respondent without rights or legitimate interest in the name.

Therefore, the second requirement established by Article B.11.d of the ADR Rules has been duly satisfied.

The above conclusion that the Respondent does not have rights or legitimate interests in the domain name is enough to satisfy the requirements of Article 21 of the Regulation No. 874/2004 and Paragraph B 11.d of the ADR Rules. However, for completeness, this Panel would like to assess whether the domain name was registered or is being used in bad faith.

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 1 September 2008, 7 years after the date of registration of Yahoo, Inc's first Community Trade Mark for the term YAHOO! - bearing in mind the worldwide renown of the YAHOO! Marks. Furthermore, the Respondent himself uses an e-mail address provided by the Complainants' e-mail services, namely "nym3ny@yahoo.com" and has used it at the time of the registration, proving that the Respondent was aware of the YAHOO! Mark at the time of the disputed Domain Name registration.

6. The domain name is being used in bad faith.

The disputed Domain Name is being redirected to a website that contains numerous Yahoo! marks and offers competing services offering commercial links to products and services offered by third parties other than Yahoo!, many being the Complainants' competitors. It is fair to conclude that someone, even if it is not the Respondent, is commercially profiting or stands to profit from use of the disputed Domain Name. Thus, the Domain Name is being intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.

Therefore, the third requirement – alternative to the second requirement - established by Article B.11.d of the ADR Rules has been duly satisfied.

7. In the absence of evidence to conclude otherwise, the Panel has decided to accept the Complaint. The Complainant Yahoo! UK Limited is entitled to have 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 YAHOOSCAN be transferred to the Complainant Yahoo! UK Limited.

PANELISTS

Name	**Elina Koivumäki, Attorney-at-Law**

DATE OF PANEL DECISION 2012-08-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: YAHOOSCAN.EU

II. Country of the Complainants: USA and the United Kingdom, country of the Respondent: Romania

III. Date of registration of the domain name: 1 September 2008

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

• Community trademark reg. no. 000693127 for the word "YAHOO!" (reg. date 22 January 2001, classes 3, 20, 24, 29, 30, 35, 36, 38, 39 and 42)
• Community trademark reg. no. 001076181 for the word "YAHOO!" (reg date 7 June 2000, classes 9, 16, 35, 39, 41 and 42)
• Community trademark reg. no. 002003150 for the word "YAHOO!" (reg. date 5 March 2002, classes 9, 14, 16, 18, 21, 28 35 and 41)
• Community trademark reg. no. 003949088 for the word "YAHOO!" (reg. date 1 October 2006, classes 35, 37, 40, 43, 44 and 45)
• Community trademark reg. no. 001854215 for the word "YAHOO!" (reg. date 20 November 2001, classes 9, 16 and 36)
• Community trademark reg. no. 002309904 for the word "YAHOO!" (reg. date 3 September 2002, classes 9, 12 and 28)
• the United States of America trademark reg. no. 2,403,227 for the word "YAHOO!" (reg. date 14 November 2000, classes 9, 35, 38, 39 and 42)
• the United States of America trademark reg. no. 2,564,963 for the word "YAHOO!" (reg- date 30 April 2002, class 38)
• company names Yahoo! Inc. and Yahoo! UK Limited

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainants

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):

1. Why the Complainants consider the Respondent to lack the rights and legitimate interests: There is no legal or business relationship between Complainants and the Respondent which would give rise to any license, permission, or authorization for the Respondent to use the disputed Domain Name.

2. Rights or legitimate interests the Respondent claims to have: No response submitted

3. Does the Panel consider the Respondent to have no rights or legitimate interests: No rights / no 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: Respondent uses a Yahoo! email address, registered the disputed Domain Name after the YAHOO! Mark became registered and famous, and redirected the disputed Domain Name to a website that contains numerous Yahoo! marks and offers competing services. It is clear that Respondent was aware of Complainants and the famous YAHOO! Mark at the time that it registered the disputed Domain Name. The Respondent presumably obtains advertising and click-through fees in respect of the advertising appearing on the website to which the disputed Domain Name resolves. The website heavily uses Complainant’s famous YAHOO! Mark. Complainants submit that the disputed Domain Name was intentionally registered and is being used to attract Internet users, for commercial gain, to the Respondent’s website by creating a likelihood of confusion with a name on which a right is recognized or established by national and/or Community law, with such likelihood arising as to the source, sponsorship, affiliation, or endorsement of the websites or location or of a product or service on the website or location of the holder of a domain name.

2. How the Respondent rebuts the statements of the Complainant: No response filed.

3. Does the Panel consider the Respondent to have registered or use the domain name/s in bad faith: Yes, even though it is not necessary for separate ruling as the Respondent has no rights or legitimate interests in the Domain Name.

IX. Other substantial facts the Panel considers relevant: The Panel finds that the Respondent did register and uses the Domain Name in full knowledge of the Complainants and their YAHOO! Mark as the Respondent has used at the time of the Domain Name registration and still uses an e-mail address with @yahoo.com and the content of the website where the disputed Domain Name is related to the Complainants and their well-known YAHOO! Mark.

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes