Panel Decision for dispute CAC-ADREU-006303

Case number	CAC-ADREU-006303
Time of filing	2012-10-24 18:09:40
Domain names	americaneagleoutfitters.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	Retail Royalty Company

Respondent

Name	SUN KING

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 unaware of any other legal proceeding pending or decided relating the disputed domain name.

FACTUAL BACKGROUND

The first Complainant is Retail Royalty Company ("Complainant 1"), an U.S. Corporation who owns, among others, the trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS. The trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS are registered in numerous countries throughout the world, including Europe.
Complainant 1 is a wholly-owned subsidiary of the U.S. Corporation American Eagle Outfitters, Inc ("AEO") who has been operating under the above mentioned trademarks for 35 years. Actually, AEO offers clothing and accessories since 1977 and now operates over 1.000 retail stores throughout the United States and other countries. The trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS, owned by Complainant 1, have achieved strong consumer recognition and goodwill.
Complainant 1 requests that American Eagle NL Hold Co B.V. ("Complainant 2") is added as a second Complainant in these proceedings. Complainant 2 is a Company related to Complainant 1, being part of the same corporate Group.
Respondent registered the disputed domain name <americaneagleoutfitters.eu> on May 2, 2012.
On October 7, 2012, Complainant 1 initiated ADR proceedings. Complainant 1 requested that the disputed domain name was transferred to Complainant 2 pursuant to ADR Rule B11 (b). Respondent did not submit a Response or any other communication.

A. COMPLAINANT

The Complainants have established that they have rights in the AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS trademarks through registration and continuous use in the United States and also in other countries including European Community countries. In particular Complainant 1 proved to be the owner of (i) the European Community Trademark AMERICAN EAGLE OUTFITTERS no. 5287875 filed on August 31, 2006 and registered on June 29, 2011 for products and services included in classes 3, 14, 25 and 35 and (ii) the European Community Trademark AMERICAN EAGLE OUTFITTERS no.10029891 filed on June 8, 2011 and registered on October 19, 2011 for products included in class 18.
The domain name in dispute <americaneagleoutfitters.eu>, is identical to Complainants trademark, because the addition of the generic top-level domain name .eu is deprived of any weight in the similarity test of the signs.
The Complainants do not know about any right or any legitimate interest held by the Respondent in the disputed domain name. The Respondent has not sought nor been granted permission to use the trademarks AMERICAN EAGLE, AMERICAN EAGLE OUTFITTERS, or other trademarks owned by Complainant 1.
The Complainants state that the disputed domain name has been registered and used in bad faith.
In Complainants view, the Respondent’s purpose in registering the disputed domain name, which fully incorporates the trademark AMERICAN EAGLE OUTFITTERS, is to attract Internet users to its website for commercial gain, to suggest that it is somehow related or affiliated with the Complainants and to divert traffic.

The disputed domain name, according to Complainants assertions, is used in bad faith since it disrupts the Complainants business. Actually, the true purpose in registering the disputed domain name is to capitalize on the reputation of the trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS. In other words, Complainants believe that Respondent has intentionally attempted to attract Internet users for financial gain to the Respondent's website by creating a likelihood of confusion with the AMERICAN EAGLE OUTFITTERS trademark, as to the source, affiliation and endorsement of the Respondent's website. It obviously constitutes bad faith registration and use.

B. RESPONDENT

The Respondent failed to provide its response within the requested deadline.

DISCUSSION AND FINDINGS

The disputed domain name <americaneagleoutfitters.eu> wholly incorporates the Complainant 1's trademark AMERICAN EAGLES OUTFITTERS. It is well-established that the specific top level of a domain name <.eu> does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of the Regulation (EC) No. 874/2004 (See CAC Case. No. 00227 - kunst.eu; CAC Case No. 00387 - gnc.eu; CAC Case No. 00596 - restaurants.eu; CAC Case No. 01584 – ksb.eu; CAC Case No. 02438 – ask.eu; CAC Case No. 00283 – lastminute.eu). According to Article 21 (1) of Regulation (EC) No. 874/2004 a registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, 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(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.
It is undisputed that the Complainant 1's trademark AMERICAN EAGLES OUTFITTERS is identical to the domain name <americaneaglesoutfitters.eu>.
The Complainants have asserted that the Respondent is not known by the name AMERICAN EAGLE OUTFITTERS or similar and does not hold any rights on the domain name in dispute. Complainants have also asserted that Respondent is not an authorized dealer of Complainants products. These assertions are not contradicted by the Respondent. Should the Respondent have rights or legitimate interests in the domain name, the Panel assumes that it would have advised the Panel of the same. As no response was filed, the Panel believes that the Respondent does not have rights or legitimate interests in the contested domain name. Therefore, in the Panel's view, the Complainants have satisfied the requirements of Article 21(1)(a).
In the absence of any submission, Respondent was unable to prove that it was unaware of Complainants or of its well-known trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS. Since the above trademarks have been extensively used from approximately 35 years and have acquired a high degree of public recognition, fame and distinctiveness, in the Panel's view Respondent has registered the disputed domain name in bad faith being perfectly aware of existence of the trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS.
Furthermore, the website connected to the domain name <americaneagleoutfitters.eu> consists of a web page proposing links for different products including clothing. Therefore the Respondent has been using the disputed domain name with the only purpose of diverting consumers of the Complainants products to the Respondent's site by using the Complainants trademark. This behavior is clear evidence that Respondent intends to use the notoriety of the trademarks AMERICAN EAGLE and AMERICAN EAGLE OUTFITTERS for commercial gain. Such use has been held to be an offering of goods and services in bad faith. Therefore, in the Panel's view, the Complainants have satisfied the requirements of Article 21(1)(b).
Complainant 1 requested that the disputed domain name was transferred to Complainant 2 pursuant to ADR Rule B11 (b). First of all it should be noted that Complainant 1 did not provide clear evidence of the relationship between Retail Royalty Company and American Eagle NL Hold Co B.V. In particular, the exhibit 2 attached to Complaint shows the subsidiaries of "AEO" and American Eagle NL Hold Co B.V. is not included between the companies listed in the above document. Furthermore, the Panel found that Complainant 1 has not provided evidence that Complainant 2 satisfies the general eligibility criteria for registration of a domain name .eu indicated by Article 4(2)(b) of Regulation (EC) No. 733/2002 and Article 22(11) of Regulation (EC) No. 874/2004 (See CAC Case. No. 06185 - myfanta.eu). Therefore, in the Panel's view, the domain name in dispute should be revoked.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name AMERICANEAGLEOUTFITTERS.EU be revoked.

PANELISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2012-10-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: AMERICANEAGLEOUTFITTERS.EU

II. Country of the Complainant 1: United States of America, country of the Complainant 2: not confirmed, country of the Respondent: Spain (but probably China)

III. Date of registration of the domain name: 2 May 2012

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

1. European Community Trademark AMERICAN EAGLE OUTFITTERS no. 5287875 filed on 31 August 2006 and registered on 29 June 2011 for products and services included in classes 3, 14, 25 and 35
2. European Community Trademark AMERICAN EAGLE OUTFITTERS no.10029891 filed on 8 June 2011 and registered on 19 October 2011 for products included in class 18, among many other registered rights

V. Response submitted: No

VI. Domain name is identical to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: Respondent has no rights in the contested domain name since it does not correspond to a trademark registered in the name of the Respondent or to the name of the Respondent. No other right or legitimate interest was claimed or evidenced by the Respondent.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the Respondent has been using the disputed domain name with the only purpose of diverting consumers of the Complainants products to the Respondent's site by using the Complainants trademark.

IX. Other substantial facts the Panel considers relevant: Complainant 1 has not provided evidence of the commercial relationship with Complainant 2. Furthermore there are no proves that Complainant 2 satisfies the general eligibility criteria for registration of a domain name .eu

X. Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: None