Panel Decision for dispute CAC-ADREU-006328

Case number	CAC-ADREU-006328
Time of filing	2012-10-26 16:31:56
Domain names	eyedoc.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization

Respondent

Name	Miguel Rebelo Silva

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

N/A

FACTUAL BACKGROUND

The Complainant, Joachim Oldendoerp, is an ophthalmologist with a practice in Euskirchen, Germany.

The Complainant owns a Community Trade Mark in the term EYEDOC (registered on 16 October 2008), together with the domain name <eyedoc.de>.

The Respondent, Miguel Rebelo Silva, part owns a Portuguese company incorporated on 7 January 2011. The company provides medical ophthalmology care and services.

The Respondent registered <eyedoc.eu> (the "Disputed Domain Name") on 10 August 2011. It is not pointing to an active website but has been used to send and receive email.

The Complainant filed a Complaint under the .EU Alternative Dispute Resolution ("ADR") procedure with the Czech Arbitration Court on 16 August 2012. The deadline for submitting the Response was 12 October 2012 and it was filed on 5 October 2012. The Panel was appointed on 12 October 2012.

A. COMPLAINANT

The Complainant asserts the following:

- The Complainant is an ophthalmologist with a practice in Euskirchen, Germany. Patients from all over Germany are treated. On 16 October 2008, the Complainant registered the term EYEDOC as a Community Trade Mark (registration number 006849202) for medical services, amongst other things. Since then the Complainant has used the trade mark intensively for ophthalmologic services, in particular in connection with the website www.eyedoc.de.

- On 10 August 2011, the Respondent registered the Disputed Domain Name. It is identical to the Complainant’s trade mark.

- The Disputed Domain Name has been registered by the Respondent without rights or legitimate interest in the name. According to the Complainant, since the registration the Respondent has not made any active use of the Disputed Domain Name to support any offer of goods or services, but has merely "parked" it. Based on the Complainant's research, the Respondent has nothing to do with medical or ophthalmologic services. As evidenced by LinkedIn, the Respondent works in the field of telecommunications. Therefore no

circumstances exist allowing the assumption that the Respondent has made or will make legitimate use of the Disputed Domain Name. In this regard it is sufficient for the Complainant to prove that the obvious facts do not demonstrate that the Respondent has a right or legitimate interest in the Disputed Domain Name. The burden of proof then shifts to the Respondent, who has to prove his rights or legitimate interest in the Disputed Domain Name. The Complainant concludes that the Respondent will not succeed in doing this.

B. RESPONDENT

First, the Respondent restates the Complainant's assertions leading to his demand for transfer of the Disputed Domain Name, namely that:

- the Respondent does not have a legitimate interest;
- the Respondent does not have a right in the Disputed Domain Name; and
- the Respondent is not using it.

The Respondent underlines that any company or organisation based in the European Union (EU) and any natural person living in the EU is eligible to register a .EU domain name. The eligibility criteria are defined in Article 4 of EC Regulation 733/2002 and also referred to at Article 3(b) of EC Regulation 874/2004. The Respondent states that he is a Portuguese citizen living in Portugal (identity card attached), and that Portugal has been an EU member state since 1986.

The Respondent states that he owns, in partnership with another individual, a registered company called "Eyedoc", based in Portugal, and uses the Disputed Domain Name for commercial purposes. In consequence the Respondent argues that he does not agree with the Complainant's assertions for the following reasons:

1. As for the allegation that the Disputed Domain Name has been registered by the Respondent without rights or legitimate interests in the name, it should be noted that:

(a) The Respondent owns the company “Eyedoc” in partnership with a licensed medical doctor, who is a specialist in ophthalmology licensed to practice both in Portugal and in the UK, registered with the Portuguese Medical Association, the UK’s General Medical Council, the Royal College of Ophthalmologists and the American Academy of Ophthalmology (copies of the publicly accessible databases illustrating this attached).

(b) The Respondent's "Eyedoc" company has its registered office at Avenida Salvador Allende 18, Nova Oeiras, Portugal, and is registered at the Commercial Registry Office of Cascais, under number 509673511 (link to the official certificate attached). It provides medical ophthalmology care and services, namely, consultations, eye surgery and post-operative check-ups.

(c) The company has offered services throughout Portugal.

(d) The company name is identical to the Disputed Domain Name.

(e) The Respondent sought the registration of the Disputed Domain Name because his business partner is an ophthalmology doctor ("Eye Doc" is a common English term meaning ophthalmology doctor) and their company provides ophthalmology care. In other words registration of the Disputed Domain Name was not a random choice.

2. As for the allegation that the Respondent is not using the Disputed Domain Name and has merely parked it, the Respondent makes the following points:

(a) The Respondent has been using the Disputed Domain Name to send and receive emails, without being aware of the Complainant or his alleged trade mark and German website.

(b) The Respondent is therefore making a legitimate use of the Domain Name for the following reasons:

- the email services of the Disputed Domain Name have been in active use since it was registered;
- there are Mail Exchange Servers (MX servers) and email addresses configured for the Disputed Domain Name (screenshot of the MX records attached);
- the Disputed Domain Name is used on a daily basis to communicate with patients, suppliers, hospitals, clinics and official authorities.

The Respondent therefore asserts that it has been clearly demonstrated that the Disputed Domain Name is an important and strategic business tool, even though it does not point to an active website.

(c) The Respondent states that the Disputed Domain Name is a strategic business investment and that transferring it to another entity would constitute loss of business revenue. The email address constitutes a privileged form of communication with existing patients, and new potential patients also become aware of it through "word of mouth". In the Respondent's opinion, discontinuing the use of this email address would lead to the loss of future revenue from current and potential patients and other business leads. Such loss cannot be easily quantified but the Respondent asserts that it would amount to several hundred thousand Euros.

The Respondent states that, according to Articles 21(1) and 22(11) of EC Regulation 874/2004 and Paragraph B11(d)(1) of the .EU ADR Rules, the Complainant bears the burden of proof in proving the following:

"(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."

The Respondent argues that, as the Complainant hasn't made an effort to establish any of the above and the Respondent is presenting documentary and technical evidence to the contrary, the Complaint is groundless and should be dismissed. In the Respondent's opinion the Complainant's trade mark can hardly be considered "recognised" (as demonstrated by a Google search) and his website is in German and therefore irrelevant to the present case.

The Respondent is of the opinion that the Complainant is using the ADR proceeding in an abusive way to acquire the Disputed Domain Name because the Complaint comprises factual errors which are likely to have been made with the intent to deceive. The Respondent believes that he has sufficiently shown his intent to use the Disputed Domain Name in a legitimate way.

In the Respondent's opinion, the above demonstrates that the Respondent has been using a name corresponding to the Disputed Domain Name in connection with the offering of services - the Respondent is nationally known by the Disputed Domain Name. The Respondent then cites to Article 2, paragraph 2 of EC Regulation 874/2004 which he argues corroborates his Response:

"(…) a specific domain name shall be allocated for use to the eligible party whose request has been received first by the Registry in the technically correct manner and in accordance with this Regulation. For the purposes of this Regulation, this criterion of first receipt shall be referred to as the "first-come-first-served" principle."

The Respondent states that the last paragraph of Article 14 of EC Regulation 874/2004 provides that the Registry shall register domain names on a first come first served basis, if it finds that applicants have demonstrated a prior right in accordance with paragraphs 2 to 4 of the same Article. The Respondent therefore argues that the purpose of Regulation 874/2004 is not to ensure that the entity that holds the first right to a trade mark within the EU is granted the corresponding domain - as the Complainant would seem to imply - but to grant domain names on a first come first served basis.

The Respondent argues that every domain name is globally unique, and since there are many companies sharing the same or similar names, the fact that domain names are registered on a first come first served basis means that companies must register names at the earliest opportunity. The Respondent states that the Disputed Domain Name was available when the Respondent applied for it and the Respondent hasn't been misleading consumers and harming intellectual property rights or the Complainant's reputation.

DISCUSSION AND FINDINGS

Paragraph B11(d)(1) of the Rules provides that the Panel shall issue a decision granting the remedy requested in the event that the Complainant proves the following:

“(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.”

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant the Panel finds that the Complainant has a registered Community Trade Mark in the term EYEDOC.

The Panel considers that, as previously held in numerous other Panel decisions, the generic top level domain suffix .EU is without legal significance and has no effect on the issue of similarity.

On the basis of these considerations, the Panel finds that the Disputed Domain Name is identical to a trade mark in which the Complainant has rights recognised by the national law of an EU Member State and/or Community law. Paragraph B11(d)(1)(i) of the Rules is therefore satisfied.

B. Rights or Legitimate Interests

The second element to consider under Paragraph B11(d)(1)(ii) of the Rules is whether the Respondent has registered the Disputed Domain Name without rights or legitimate interests in it. Paragraph B11(e) of the Rules sets out various ways in which a Respondent may demonstrate rights or legitimate interests in a domain name, without limitation, as follows:

"(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 undertaking, organization or 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."

As far as the burden of proof is concerned, the Panel finds the Overview of CAC panel views (available here: http://eu.adr.eu/html/en/handbook_final_for_publication.pdf) to be very useful. The Panel subscribes to the majority view which provides that the Complainant only needs to establish a prima facie case concerning the Respondent's lack of rights or legitimate interests and the onus then shifts to the Respondent to rebut the Complainant's assertion (see Paragraph 17).

It is debatable whether the Complainant has in fact done enough to establish a prima facie case because the Complainant's submission is very short. However it is clearly always difficult to prove a negative and the Complainant has highlighted what seem to be two pertinent facts, namely that the Disputed Domain Name is not pointing to an active website and that the Respondent's LinkedIn profile would suggest that he works in the field of telecommunications rather than ophthalmology services.

However it is ultimately unnecessary for the Panel to decide whether this is in fact enough to establish a prima facie case because the Panel finds that the Respondent has done more than enough to rebut the Complainant's assertions.

Based on the submissions and evidence provided by the Respondent, the Panel is satisfied that the Respondent has rights and legitimate interests in the Disputed Domain Name for the following reasons:

- Prior to any notice of the dispute, the Respondent has used the Disputed Domain Name in connection with the offering of goods or services in accordance with Paragraph B11(e)(1). Even though the Disputed Domain Name is not pointing to an active website, the Respondent has supplied evidence that it is being actively used to send and receive email. There is nothing to suggest that legitimate use of a domain name has to involve pointing it to a website, and in the Panel's opinion use for email is just as legitimate.

- The Respondent has been commonly known by the Disputed Domain Name in accordance with Paragraph B11(e)(2). The Respondent has supplied evidence that he part owns a company that was incorporated in Portugal under the name "Eyedoc" over seven months before the Disputed Domain Name was registered. Furthermore, the Disputed Domain Name is being used in connection with services offered by the Respondent's Eyedoc company.

It should be noted that, at the time the Disputed Domain Name was registered in 2011, it was only necessary for the Respondent, as a natural person, to be resident within the EU and that no prior rights were necessary (this was only a requirement during the initial Sunrise Period). The Respondent's submission is thus slightly confused in this regard as it cites Article 14 of EC Regulation 874/2004 which only relates to the validation of prior rights during the Sunrise Period and provides that domain names during this period were granted to prior right holders on a first come first served basis.

However, Article 14 of EC Regulation 874/2004 nevertheless illustrates the point that .EU domain names were never meant to be allocated to the holder of the earliest prior right and, where there are two legitimate prior right holders within the EU, the owner of the oldest prior right does not take priority. In this case the Complainant's Community Trade Mark dates from 2008, whereas the Respondent's company was incorporated in 2011, but nothing in the relevant EC Regulations or the Rules provides that this grants the Complainant a better right to the Disputed Domain Name. The Panel finds that both Parties have legitimate prior rights, but the Respondent was first to register the Disputed Domain Name and thus there is no reason to overturn this.

The Panel therefore finds that the Respondent has rights or legitimate interests in the Disputed Domain Name. Paragraph B11(d)(1)(ii) of the Rules is therefore not satisfied.

C. Registered or Used in Bad Faith

The third element that falls to be considered under Paragraph B11(d)(1)(iii) of the Rules is whether the Disputed Domain Name has been registered or is being used in bad faith. In view of the fact that it is only necessary for a complainant to succeed on either the second element under Paragraph B11(d)(1)(ii) or the third element under Paragraph B11(d)(1)(iii), it is still technically possible for a complainant to succeed even if a respondent has been found to have rights or legitimate interests (even though this may seem rather unlikely). Given that this is the case here, it is therefore necessary for the Panel to go on to consider the issue of bad faith.

As far as the burden of proof in relation to bad faith is concerned, again the Panel would subscribe to the majority view (set down in the Overview of CAC panel views) that it is for the Complainant to prove that the Respondent has registered or used the Disputed Domain Name in bad faith on the balance of probabilities (again see Paragraph 17).

The Complainant makes no reference to registration or use in bad faith in his submission and has not attempted to prove this. In any event, given the evidence put forward by the Respondent, the Panel concludes that the Respondent has not registered or used the Disputed Domain Name in bad faith. The Parties operate entirely in different countries (Germany and Portugal) and nothing would suggest that the Respondent had heard of the Complainant either at the time when he registered the Disputed Domain Name or indeed since. In view of the fact that the Parties appear to be targeting different geographical markets, it seems clear that the Respondent is not trying to profit from the goodwill and reputation of the Complainant.

The Panel therefore concludes that the Complainant has not succeeded in proving that the Disputed Domain Name was registered or is being used in bad faith. Paragraph B11(d)(1)(iii) of the Rules is therefore not satisfied.

D. No Abuse of ADR Proceeding

Paragraph B12(h) provides that the Panel may declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of administrative proceeding. The Respondent appears to be requesting such a declaration when he states "it appears that the Complainant is using this ADR proceeding in an abusive way to acquire the Domain Name in dispute, because it comprises factual errors which are likely to have been made with the intent to deceive."

However, whilst the Complaint is short, the Panel does not think that it was initiated in bad faith and is of the opinion that the Complainant genuinely believed that the Respondent had no rights or legitimate interests in the Disputed Domain Name based on publicly available information. Although there is no duty on a complaint to contact a respondent before filing a complaint under the .EU ADR Rules, this may have been advisable in this case as it may have enabled the Complainant to make a better assessment of his chances of success and thus to avoid filing an unsuccessful Complaint. However the Panel finds that the Complaint does not constitute an abuse of administrative proceeding

It should be noted however that the Panel's decision only relates to the Complaint's failure to make out his case under the .EU ADR Rules and has no bearing on any other issues. In particular the Panel makes no finding on the question of whether or not the Respondent's activities infringe the Complainant's Community Trade Mark in the term EYEDOC.

DECISION

For all the foregoing reasons, in accordance with Paragraph B12 of the Rules, the Complaint is denied and the Panel orders that the Disputed Domain Name should remain with the Respondent.

PANELISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2012-10-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: eyedoc.eu

II. Country of the Complainant: Germany, country of the Respondent: Portugal

III. Date of registration of the domain name: 10 August 2011

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. 006849202, for the term eyedoc, filed on 20 April 2008, registered on 16 October 2008 in respect of goods and services in classes 5, 9, 10 and 44

V. Response submitted: Yes

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Yes
2. Why: The term eyedoc is a common English term meaning ophthalmology doctor. The Respondent part owns a Portuguese company that provides medical ophthalmology care and services. Prior to any notice of the dispute, the Respondent has used the Disputed Domain Name in connection with the offering of services in accordance with Paragraph B11(e)(1). Even though the Disputed Domain Name is not pointing to an active website, the Respondent has supplied evidence that it is being actively used to send and receive email. There is nothing to suggest that legitimate use of a domain name has to involve pointing it to a website, and in the Panel's opinion use for email is just as legitimate.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. No
2. Why: The Complainant made no reference to registration or use in bad faith. Moreover, the Parties operate entirely in different countries (Germany and Portugal) and nothing would suggest that the Respondent had heard of the Complainant either at the time when he registered the Disputed Domain Name or indeed since. In view of the fact that the Parties appear to be targeting different geographical markets, it seems clear that the Respondent is not trying to profit from the goodwill and reputation of the Complainant.

IX. Other substantial facts the Panel considers relevant: The Respondent suggested that the Complaint has been filed in bad faith. The Panel does not think that it was initiated in bad faith and is of the opinion that the Complainant genuinely believed that the Respondent had no rights or legitimate interests in the Disputed Domain Name based on publicly available information.

X. Dispute Result: Complaint denied

XI. Procedural factors the Panel considers relevant: None