# Panel Decision for dispute CAC-ADREU-006417

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| Case number | CAC-ADREU-006417 |
| Time of filing | 2013-05-07 13:00:00 |
| Domain names | www.roundupready.eu |

## Case administrator

Lada Válková (Case admin)

## Complainant

Organization

## Respondent

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| Organization | Zhoujingjing |

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 other legal proceedings relating to the Domain Name.

FACTUAL BACKGROUND

The Complainants in this ADR Proceeding are Monsanto Technology LLC of the USA and its subsidiary, Monsanto UK Limited of the United Kingdom. Monsanto UK Limited is a licensee of various trade marks in Europe registered by Monsanto Technology and is entitled, by virtue of the said licence to institute all appropriate proceedings to enforce such licence and preserve its parent's trade mark rights. The Complainants are a leading provider of agricultural products including seeds and weed control products. The Complainants' ROUNDUP READY system of herbicides was developed in 1974 and is advertised and promoted across the United States, Europe and globally. Monsanto Technology LLC is the owner, and Monsanto UK Limited is the licensee of a variety of registered trade marks globally for the word mark ROUNDUP READY including German registered trade mark no. DE2067431, registered on 13 June 1994 in international class 5 (herbicides).

The Respondent appears to be a natural person with an address in Hamburg and/or Bonn, Germany. The Domain Name was created on 30 September 2012 and has since been used in conjunction with a pay-per-click advertising scheme. The Domain Name has also been listed as available for sale.

The Complaint was filed on 17 December 2012. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for the Domain Name on 7 January 2013. On 14 January 2013, EURid replied in a non-standard communication confirming that the Domain Name roundupready.eu was registered with PDR Ltd., that the current Registrant of the Domain Name was the Respondent, that the Domain Name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the Domain Name was English. It also provided the full details from the WHOIS database for the registrant and registrar technical contacts.

On 17 January 2013, the Czech Arbitration Court conducted a formal compliance review in respect of the Complaint and found it to be deficient. Accordingly, on the same date, the Czech Arbitration Court notified that the Complaint had various deficiencies. On 24 January 2013, the Complainants filed an amended Complaint which was duly submitted to a formal compliance review by the Czech Arbitration Court on 31 January 2013 and found to be in compliance. Accordingly, the formal date of commencement of the ADR Proceeding was therefore 31 January 2013 and a Notification of Complaint and Commencement of ADR Proceeding was issued to the Respondent on that date. This stated that a Response was to be submitted within 30 working days. On 1 March 2013, the Czech Arbitration Court filed a non-standard communication stating that the written notice addressed to the Respondent, which had been issued to both Hamburg and Bonn, had been returned undelivered to the Czech Arbitration Court on 28 February 2013.

The Respondent did not comply with the deadline to file a response and the Czech Arbitration Court notified the Respondent of its default on 4 April 2013.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the appointed Panel on 16 April 2013, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ('ADR Rules') and the date by which a decision on the matter was due, which was specified as 10 May 2013.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 19 April 2013.

## A. COMPLAINANT

The Complainants seek a decision transferring the Domain Name to Monsanto UK Limited.

The Complainants assert that the Domain Name is identical and confusingly similar to the Complainants' ROUNDUP READY trade mark. The Complainants submit that the Respondent lacks rights or legitimate interests in the Domain Name in that the Respondent has not used the Domain Name or any corresponding name in connection with the offering of goods or services and has not made demonstrable preparations to do so. The Complainants submit that the Respondent has never been commonly known as the Domain Name and has never used any trade mark or service mark similar to the Domain Name by which the Respondent may have come to be known. The Complainants state that the Respondent has never operated any bona fide or legitimate business under the Domain Name and is not making a protected non-commercial or fair use thereof. The Complainants assert that the Respondent uses the Domain Name in conjunction with an advertising pay-per-click page and that past panels have found that such use is not a legitimate non-commercial or fair use of a domain name. The Complainants state that the Respondent's intent in using the Domain Name is to mislead consumers or harm the reputation of the Complainants' trade mark. The Complainants note that they have not granted the Respondent any licence, permission or authorisation by which the Respondent could own or use domain name registrations that are confusingly similar to any of the Complainants' trade marks.

The Complainants submit that the Respondent registered and uses the Domain Name in bad faith. The Complainants state that the Respondent has listed the Domain Name for sale through an auction site and note that paragraph B11(f)(1) of the ADR Rules provides for a finding of bad faith registration or use in circumstances indicating that a disputed domain name was registered primarily for the purpose of selling it to a complainant. The Complainants note that past panels have held that a general offer to sell a disputed domain name is evidence that a respondent lacks rights and legitimate interests therein.

The Complainants assert that the Respondent knew or should have known of the Complainants' trade marks based on registration of the said marks in the United Kingdom and Europe. The Complainants submit that had the Respondent conducted a trade mark search prior to registration of the Domain Name the Respondent would have seen the Complainants' trade marks. The Complainants argue that the Respondent could not possibly have registered the Domain Name in good faith due to the Complainants' degree of global fame and notoriety. The Complainants state that failure to restrain from registration of a domain name that is identical or confusingly similar to a registered or famous mark also exemplifies bad faith by a registrant.

The Complainants submit that the Domain Name has been used to intentionally attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s web site or location or of a product or service on the Respondent’s web site or location for a pay-per-click advertising scheme.

## B. RESPONDENT

The Respondent did not file a Response to the Complaint.

## DISCUSSION AND FINDINGS

1. Preliminary - No Response

The Respondent has not filed a formal Response to the Complaint. In such an eventuality, the effect of the provisions of Article 22(10) of Commission Regulation (EC) No 874/2004 ('Regulation 874') and Paragraph B10(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 874 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. Applicable provisions

This Complaint is brought under the auspices of Regulation 874 and the ADR Rules. Article 22(1)(a) of Regulation 874 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21.

Article 21(1) states that a registered domain name may 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 21(2) provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) states that:

"[…]

"'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

Article 22(11) states that in the case of a procedure against a domain name holder, 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. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 ('Regulation 733').

Article 4(2)(b) of Regulation 733 provides the following general eligibility criteria:

(i) undertaking having its registered office, central administration or principal place of business within the Community, or

(ii) organisation established within the Community without prejudice to the application of national law, or

(iii) natural person resident within the Community.

Paragraph B11(d)(1) of the ADR Rules provides as follows:-

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules 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."

It is clear from the applicable provisions that the burden of proving that the .eu domain name registration in question is speculative or abusive lies with the complainant. Accordingly, the first question for the Panel in the present case is whether the Complainants have

proved that the Domain 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.

3. Rights - identical or confusingly similar

The Complainants have provided evidence that Monsanto Technology LLC is the owner of various registered trade marks for the word mark ROUNDUP READY, including for example German registered trade mark no. DE2067431. The Complainants have also stated that Monsanto UK Limited is a licensee of such trade marks and is thereby entitled to institute all appropriate proceedings to enforce such licence.

As far as Monsanto UK Limited is concerned, the Overview of CAC panel views on several questions of the alternative dispute resolution for .eu domain name disputes ("CAC Overview") states the majority view at paragraph 12 in answer to the question "Can a trademark licensee have rights in a trademark for the purpose of filing a complaint?" that an exclusive licence represents a right referred to in Article 21(1) of Regulation 874 and that the majority view is that a licence is also considered as a recognised right within the meaning of the said Article. The Panel in the present case subscribes to the majority view.

Accordingly, the Panel finds that ROUNDUP READY is a name in respect of which a right is recognised by Community law and which is clearly identical to the Domain Name, disregarding the top level domain '.eu' as is customary for the purposes of comparison.

4. Respondent's Rights or Legitimate Interest

Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent may demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods or services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate, non-commercial or fair use of the domain name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or Community law.

In the present case the Respondent has not filed a Response and has accordingly failed to provide the Panel with any information demonstrating or tending to demonstrate that it has a right or legitimate interest in the Domain Name. For their part, the Complainants make a convincing prima facie case that the Respondent has no such rights or legitimate interests by virtue of the fact that (1) the Complainants have given no licence or permission to the Respondent to use the Complainants' ROUNDUP READY trade mark in a domain name; and (2) the use of the Domain Name, namely to display pay-per-click advertising, indicates that the Respondent thereby intends to mislead consumers.

Where such a prima facie case has been made out by the Complainants, the burden shifts to the Respondent to provide an explanation of its rights or legitimate interests in the Domain Name, if any. There appears to the Panel to be no evidence on the record indicating that the Respondent might have been able to show circumstances corresponding to those in Article 21(2) of Regulation 874 nor any other facts or circumstances in the present case indicating that the Respondent has any rights or legitimate interests in the Domain Name. The screenshot provided by the Complainants shows that the pay-per-click advertising links displayed on the website associated with the Domain Name do not relate to the Complainants' herbicide products and are predominantly focused on DVDs. Nevertheless, the Panel is satisfied that the term ROUNDUPREADY in the Domain Name does not have any generic meaning which is referenced by such advertising links and thus it is reasonable for the Panel to infer that the Respondent is using the attractive force of the Complainants' trade mark to draw visitors in and thereafter to present them with unrelated products by way of advertisements, from which the Respondent derives a commercial benefit. In the Panel's opinion, such use of the Domain Name cannot be considered a bona fide offering of goods or services, nor in the Panel's view could it be considered to confer any right or legitimate interest upon the Respondent.

The Panel therefore concludes that, on the balance of probabilities, the Domain Name was registered by the Respondent without rights or legitimate interest. The Domain Name registration is therefore speculative or abusive, and should be subject to revocation under Article 21(1)(a) of Regulation 874.

In view of this finding, it is not necessary for the Panel to consider whether the Domain Name is also subject to revocation under Art 21(1)(b) of Regulation 874 (which requires a finding that the Domain Name was registered or is being used in bad faith).

The Complainants have requested transfer of the Domain Name in favour of the Complainant Monsanto UK Limited. Pursuant to Article 22(11) of Regulation 874 the Complainants must satisfy the general eligibility requirements set out in Article 4(2)(b) of Regulation 733 before they may be found entitled to a transfer of the Domain Name. In the present case it appears to the Panel that Monsanto UK Limited satisfies such criteria and that the Panel may order to transfer to this Complainant further to the decisions of the panels in both Turkcell Iletisim Hizmetleri AS v. dilek TANIK, CAC 5837 and AKBANK TURK A.S. v. Gizem Yapakci, CAC 5117.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name ROUNDUPREADY.EU be transferred to the Complainant Monsanto UK Limited.

## PANELISTS

| Name | **Andrew D S Lothian** |
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DATE OF PANEL DECISION 2013-04-26

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ROUNDUPREADY.EU

II. Country of the Complainant: USA / United Kingdom, country of the Respondent: Germany

III. Date of registration of the domain name: 30 September 2012.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trade mark registered in Germany, reg. No. DE2067431, for the term ROUNDUP READY, filed on 11 June 1993, registered on 13 June 1994 in respect of goods and services in class 5.

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. The record showed no indication of any rights or legitimate interest on the part of the Respondent in the Domain Name and the Complainant had made out a prima facie case on this point arising from the use of the Domain Name for pay-per-click advertising purposes. While the advertisements concerned did not directly relate to the Complainants' trade mark, the Panel was satisfied that the Respondent was using the attractive force of the said trade marks to draw visitors to the associated website, given the distinctiveness of the said trade mark and the lack of any generic meaning of the Domain Name corresponding to the advertising links. Accordingly, and in the absence of any formal Response or other explanation from the Respondent, the Panel found that the Respondent did not have any rights or legitimate interest in the Domain Name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Not considered.
2. In view of the Panel's finding of a lack of rights or legitimate interest on the part of the Respondent, it was not necessary for the Panel to consider whether the Domain Name was also subject to revocation under Art 21(1)(b) of Regulation (EC) No 874/2004.

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

XII. Is Complainant eligible? Yes, noting that only the Second Complainant, being the United Kingdom subsidiary of the USA registered First Complainant was eligible in terms of Article 4(2)(b) of Regulation (EC) No 733/2002.