Panel Decision for dispute CAC-ADREU-006710

Case number	CAC-ADREU-006710
Time of filing	2014-07-11 20:25:02
Domain names	cem11plus.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	The University of Durham

Respondent

Organization	C.I.T

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 Respondent has filed an application with the UK Intellectual Property Office ("IPO") for a declaration of invalidity against the Complainant's UK trade mark no. 2654219 for the term "CEM". The Respondent seeks a suspension of this case pending resolution of the IPO proceedings. The Panel declines to suspend the case for the following reasons.

First, paragraph B7(c) of the ADR Rules requires the Panel to ensure that the ADR case takes place with "due expedition".

Second, the ADR Rules do not include a provision equivalent to the paragraph 18 of the UDRP Rules whereby UDRP panels are given discretion to suspend or terminate the case in the event of related legal proceedings. On the contrary, paragraph A5 of the ADR Rules states that the ADR case shall not be prejudiced by any "court proceeding" (aside from the requirement to terminate the case if there has been a relevant final adjudication by a competent body). Paragraph A5 relates to court proceedings but it must apply equally, if not with greater force, to proceedings before trade mark registries.

Third, even if Panel were to treat UK trade mark no. 2654219 as invalid, it would not have made any difference to the outcome of the case as the Complainant can rely on another of its other trade marks. See below.

FACTUAL BACKGROUND

The Centre for Evaluation and Monitoring ("CEM") was established over thirty years ago. Within the last twenty years it was acquired by the Complainant, becoming a department of the Complainant. CEM is now one of the largest independent providers of educational assessment and monitoring systems in the world. CEM's assessments are used in relation to over one million children in more than fifty countries. Through CEM, the Complainant delivers paper and computer-based services to schools, trusts and local authorities in the UK. Those services include "11 plus" tests for ten and eleven-year old children, as part of the selection process for grammar school entry. In an attempt to ensure that testing is as fair as possible, and does not rely on excessive preparation, the Complainant makes a point of not making any legitimate practice materials available to the public commercially.

The Complainant owns the following UK trade marks, each in classes in 41 and 42: (1) No. 2620085 – figurative mark consisting of the word "CEM" with "Centre for Evaluation & Monitoring" adjacent to it in very small font plus a small star logo filed 4 May 2012. (2) No. 2654219 for the word "CEM" filed 8 February 2013. (3) No. 2654223 for the words "CEM Centre for Evaluation & Monitoring", also filed 8 February 2013.

On 9 November 2013, in a previous case between the parties an expert appointed under Nominet UK's Dispute Resolution Service issued a decision transferring the domain name <cem11plus.co.uk> from the Respondent to the Complainant on grounds that it was an abusive registration. Similarly, on 19 December 2013 a National Arbitration Forum ("NAF") panellist ordered transfer of the domain name

<cem11plus.com> from the Respondent to the Complainant.

The Respondent registered the disputed domain name on 16 December 2013.

The Panel has visited the site at the disputed domain name. It consists of a “gateway” page with two adjacent notices of equal prominence:

“Are you looking for Children’s Educational Material for the 11+ (CEM 11+ TM)? If so, click below.” (Beneath this is a button marked “<11plus.eu>”.)

and

“Are you looking for CEM Centre for Evaluation & Monitoring®, based at the University of Durham®?” (Beneath this is a button marked “cem.org”.)

Clicking the “<11plus.eu>” button leads to another site of the Respondent at www.<11plus.eu> which offers advice and information about the 11 plus examinations. The opening paragraph on the home page states:

“This 11plus website provides advice and information about 11 plus exams and Children's Educational Material (CEM) for the 11+. The CEM 11+™ site includes advice on how to prepare for 11plus exams in England and material suitable for preparation. This is NOT the official website of CEM Centre for Evaluation & Monitoring® or the University of Durham® and this site has no connection or association with either organisation. The CEM Centre for Evaluation & Monitoring® does NOT sell any preparation material to the public nor does it endorse any products and it does not deal directly with the public.”

A. COMPLAINANT

Here is a summary of the Complainant’s submissions:

CEM has been known as “CEM” and / or the “Centre for Evaluation and Monitoring” for the entire thirty year period over which CEM has been trading and has never been known by any other name or mark. The Complainant has invested a considerable amount of time and money in establishing exclusive proprietary rights to these marks in the UK. CEM has establish a reputation that has allowed the mark “CEM” to become internationally recognised in association with excellence in the provision of entrance testing services to schools.

The disputed domain name is confusingly similar to the Complainant’s trade marks. It comprises the Complainant’s mark “CEM” plus a generic term directly related to the Complainant’s business – the provisions of 11 plus test services.

In the recent Nominet and NAF proceedings, the Respondent attempted to add legitimacy to his use of the acronym “CEM”, by suggesting that the acronym in fact stands for ‘Children’s Educational Materials’. The words he claims to correspond to this acronym have been inconsistent. He has a tendency of inventing expressions to conveniently fit this acronym to defend proceedings such as these. The Respondent has never legitimately used “CEM” to refer to anything other than the Complainant.

By the date of registration of the disputed domain name, the Respondent had already lost the Nominet case and the NAF decision was pending. The Respondent clearly registered the disputed domain name in anticipation of the loss of <cem11plus.com>. The Respondent has transferred the entire contents of the former websites at <cem11plus.co.uk> and <cem11plus.com> to the website at the disputed domain name.

The Respondent has registered the domain in question so as to be confusingly similar to the Complainant's marks, for the express purpose of confusing the public seeking information relating to the Complainant and its testing into instead ultimately visiting the Respondent’s sites for his commercial benefit.

Although the site is used as a gateway page, there has already been initial interest confusion leading the visitor to the commercial services of the Respondent.

The Respondent infringed copyright in the Complainant’s materials on the former website at <cem11plus.co.uk>. He attempted to discover the confidential contents of test papers supplied by the Complainant and advertise what he believed to be its contents. He wrongly encouraged individuals to use entrance test opportunities held in schools in areas outside of their home catchments as 'mock' tests.

B. RESPONDENT

Here is a summary of the Respondent's submissions:

The disputed domain name is not identical to any trade mark owned by the Complainant. Nor is it confusingly similar. The domain "cem11plus" can be split in to three distinct parts: "cem", "11" and "plus". Neither component can function as a legitimate trade mark. "11" and "plus" are generic, one being a number and one being "plus" or "+".

"CEM" is simply an acronym with over 100 different meanings in the field of education, including "Children's Educational Material". There are other valid trade marks within the UK and EU including an earlier mark for the "College of Estate Management". Numerous universities and other establishments within the UK and EU use the "CEM" acronym. No one organisation can claim sole use of an acronym that is so widely used. Combining one generic term with two other generic terms does not provide a term which is confusingly similar to another generic term.

No actual evidence has been put forward of confusion.

It is notable the Complainant does not take action against <11pluscem.co.uk> and <11pluscem.com>. This indicates that the complaint has been made in bad faith and claims of initial interest confusion are bogus.

In the Nominet case, the Complainant claimed that CEM had been known as "CEM Centre" and/or the "Centre for Evaluation and Monitoring" for its entire period of trading and by no other names. Yet the Complainant now claims that it has been known as "CEM" and/or the "Centre for Evaluation and Monitoring". This demonstrates dishonesty. CEM was never known as just "CEM". It was referred to as "CEM Centre". The "CEM" acronym was in such wide usage that it could not be claimed as a legitimate trade mark. It is inconceivable that a large university would not have bothered to trade mark "CEM" for over 20 years if it was in fact known as "CEM".

The Complainant provides no evidence in support of its claims of excellence or even evidence that it is well known.

For most of its period of trading, the Complainant had no registered trade mark.

When the Respondent first used "CEM" as Children's Educational Material, he had never heard of the Complainant. Most people in the UK and EU have never heard of them. The public only becomes aware of them when their children prepare for the 11 plus and if the tests are supplied by the Complainant. The public search for "Children's Educational Material" and not the Complainant.

The Respondent has been using the term "CEM" for a number of years in non-competing activities and has unregistered rights in the acronym. A trade mark was not applied for as it is a generic acronym, incapable of acting as a trade mark, particularly in education. The Respondent used the "CEM" acronym before the Complainant had ever registered rights in "CEM" or its CEM logo. The logo does not confirm rights to the letters "CEM". The mark "Centre for Evaluation and Monitoring" confers no rights in the mark "CEM".

The Respondent clearly has an interest in the disputed domain name as it supplies Children's Educational Material for the 11 plus via a number of sites. "Children's Educational Material" is an internationally recognised phrase. The use of the term by the Respondent does not refer to the Complainant and the Respondent has gone to great lengths to ensure there is no association including clear disclaimers and a click box for users to confirm they understand that there is no association.

The Complainant has provided no evidence that the Respondent has a tendency of inventing expressions to conveniently fit this acronym.

Since the acronym has been used by the Respondent for a number of years, it clearly has unregistered rights and legitimate interests in the name and a valid reason to use it in the disputed domain name.

It is inappropriate to consider the UDRP and Nominet decisions. The disputed domain name has been used in a completely different manner to the use of the domain names involved in those cases.

There is no evidence of actual confusion.

This claim is in relation to a one page site and only this page can be considered. The page is non-commercial. It does not sell products and has no paid for advertising or pay per click revenue. It merely presents users two options depending on where a user intended to visit. This prevents any claim of initial interest confusion. If a user enters the site seeking the Complainant, there is a clear link which a user can see to take them to the Complainant's site. A visitor would not see any services offered by the Respondent. It could not be

confused in to thinking they were at a site of the Complainant. The fact is there can be no confusion or damage. There is no indication on the page that the disputed domain name is associated with the Complainant. Even the linked site at <11plus.eu> has clear disclaimers on every page. There is no similarity between the respective sites. The Complainant's logos have never appeared on any site operated by the Respondent.

There is no indication on the page that the disputed domain name is associated with either the Complainant's own site at www.cem.org or even the Respondent's linked site at www.<11plus.eu>

The likelihood of a user navigating to the disputed domain name is rare because a user is more likely to type <cem11plus.co.uk> or <cem11plus.com> and these domains were transferred to the Complainant, at which point the Complainant took the Respondent's traffic. All search engines place Complainant's site above the website at the disputed domain name.

If a search engine such as Google renders results with the term "CEM" that do not belong to the Complainant, then this would not cause initial interest confusion as the user has an option to decide whether to visit the site. The user decides what to click.

The Complainant does not sell anything via its site or to the public. There can be no loss.

The Respondent does not provide any practice material to the public at the one-page website at the disputed domain name, only via other sites which do not include the "CEM" acronym, including <11plus.eu>.

The Complainant wants to close down the Respondent's site as this undermines the Complainant's false claims that its tests are resistant to preparation. Contrary to the Complainant's claims, its tests are easy to prepare for.

The Complainant offers no evidence in support of its groundless claims that the Respondent attempted to find confidential content on the Complainant's tests, which it is impossible to do, or that it infringed the Complainant's copyright. The Respondent is legally entitled to encourage individuals to use entrance test opportunities held in schools in areas outside of their home catchments as 'mock' tests.

The Respondent rejects the claim that it will use the disputed domain name for a campaign of deliberately disrupting and damaging the Complainant's business. If the Respondent is claimed to attempt to profit from the Complainant's reputation, then why would it seek to destroy it?

The disputed domain name has not been registered or used in bad faith. It has never even been used criticized the Complainant. The page at the disputed domain name represents the fairest way to use the domain name until the validity of the CEM mark is established. The Complainant has not established how this simple page harms it.

The disputed domain name has never been offered for sale to the Complainant and the Complainant has no legitimate use for it.

The disputed domain name was not registered primarily to disrupt the business of a competitor. The Complainant and Respondent are not competitors.

The single page does not intend to attract users for commercial gain by creating a likelihood of confusion as to source or affiliation.

A domain name that is registered before a trade mark right has been established cannot be found to have been registered in bad faith. The domain names <cem11plus.co.uk> and <cem11plus.com> were registered before the Complainant had filed for the "CEM" trade mark. The filing only occurred after the Respondent pointed out that the Complainant did not own the "CEM" trade mark. For this reason, the Nominet and UDRP decisions were wrong in law.

Most of the Complainant's arguments relate not to the disputed domain name, but to other domain names. The Complainant consistently makes false allegations with no supporting evidence. The Complaint is an abuse of the administrative proceeding and constitutes reverse domain name hijacking.

DISCUSSION AND FINDINGS

Introduction

Under Article 21(1) of Regulation (EC) 874/2004 ("the Regulation"), the disputed domain name is subject to revocation if it 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 interests in the name or

(b) has been registered or is being used in bad faith.

Rights

The Complainant must first establish a right that "is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1)".

Article 10(1) of the Regulation refers to: "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…".

The Complainant relies on the three UK registered trade marks mentioned above. These clearly qualify as rights under Article 10(A).

The Complainant also relies on unregistered rights but, as the Respondent rightly points out, it has produced no supporting evidence. The Panel therefore makes no findings as to unregistered rights.

The disputed domain name is confusingly similar to the Complainant's trade mark no. 2654219 for "CEM". The disputed domain name consists of the Complainant's mark together with the descriptive term "11plus". Paragraph III(5) of the Overview of CAC panel views on several questions of the alternative dispute resolution for .eu domain name disputes ("CAC Overview") sets out the consensus panel view that domain names which include a name for which a right is recognized or established by national and/or Community law combined with descriptive or generic terms are confusingly similar to that name, especially in situation where the descriptive or generic terms describe the goods and/or services or the right holder. That is the case here. The term "11plus" describes the examination in respect of which the Complainant provides services.

In the Panel's view, the disputed domain name is also confusingly similar to the Complainant's trade mark No. 2620085, a figurative mark consisting of the word "CEM" with "Centre for Evaluation & Monitoring" adjacent to it in very small font plus a small star logo." The latter text and the logo are subsidiary to the word "CEM" in large font, which dominates the mark.

The Respondent claims that the term "CEM" is "generic" because it is in widespread use, especially as an acronym by other organisations. However, the only role of the Panel at this stage is assess whether the Complainant possesses a relevant right and, if so, whether the disputed domain name is identical or confusingly similar to the name comprised in that right. It is not the Panel's job to assess the validity of the Complainant's trade marks - notwithstanding that the Respondent has filed an invalidity application with the IPO in relation to one of them. The Panel would just add that the Respondent seems to misunderstand the concept of "generic" as there is no suggestion that "CEM" has become an accepted and recognised description of a class of goods or services. It seems to the Panel that the term is entirely capable of functioning as a trade mark, notwithstanding that others may be using the same acronym in respect of other goods or services.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to a name in respect of which the Complainant possesses a right recognized or established by national and/or Community law.

Lack of Rights or Legitimate Interests.

Under Article 21(1) of the Regulation (a) lack of rights or legitimate interests and (b) registration or use in bad faith are alternative requirements. For reasons explained below, the Panel considers that the disputed domain name has been registered and used in bad faith and so there is no need to separately address lack of rights or legitimate interests.

Bad Faith

The Panel is not convinced by the Respondent's claim that he was unaware of the Complainant when he first started using the acronym "CEM" given the Complainant's key role in the industry in which the Respondent operates. The Respondent does not in fact dispute the Complainant's longstanding use of "CEM" though he does claim that this was as part of the name "CEM Centre". But even the latter name is dominated by the distinctive term "CEM".

The key issue is whether the Respondent's selection of the term "CEM" was motivated by the Complainant's use of that term (irrespective of whether it was reflected in a registered trade mark) or whether, as the Respondent claims, it was selected as an acronym for "Children's Educational Material" conceived independently of the Complainant.

The Complainant has asserted that the Respondent only invoked the alleged connection of “CEM” and “Children’s Educational Material” for the first time in the recent Nominet / NAF cases. Despite the Respondent’s claim to have been using “CEM” for a number of years, he has not countered by supplying evidence showing historical use by him of “CEM” in reference to “Children’s Educational Material”. Whereas the Respondent’s current website contains extensive reference to this term.

The Panel is therefore unconvinced that the Respondent’s selection of “CEM”, whether originally or on incorporation in the disputed domain name, was as an acronym for “Children’s Educational Material”. (In reaching this conclusion, the Panel has not taken account of the Complainant’s claims that the Respondent has a “tendency” of inventing different expressions to conveniently fit this acronym as the Complainant has provided no such evidence.)

The Respondent says that it is inappropriate for Panel to consider the Nominet and NAF decisions. The Panel disagrees. In domain arbitration systems such as .eu ADR, the UDRP, Nominet’s DRS etc., it is standard practice for panels to have regard to other arbitration decisions when considering potential patterns of conduct / misconduct by parties to the case before it. The Nominet and NAF decisions involved both parties in this case and effectively the same domain name (i.e. apart from the suffix). Of course the Panel will make up its own mind on the evidence before it in this case but it is entitled to take those other decisions into account. And so the Panel takes note of the fact that, in concluding that the respective domain names were abusive / bad faith registrations, both panellists found that the Respondent had selected “CEM” in a domain name by reference to the Complainant’s use of that term and rejected his claims otherwise.

The Panel also notes that the disputed domain name was registered after the Nominet decision had been issued and at a time when the NAF decision was pending. The disputed domain name has since been used to link to another website of the Respondent which is substantially similar to the websites formerly at the two domain names which were transferred to the Complainant as a consequence of those cases. This timing gives the impression that the purpose of registration of the disputed domain name was to attempt to evade the effects of those rulings and to enable the Respondent to carry on the same business using what is effectively the same domain name as before.

Furthermore the Panel considers that the disputed domain name is liable to create “initial interest confusion”. The Respondent argues strongly against this but most of his claims are directed to the fact that users arriving at the site will not be confused because they are offered a clear and obvious choice between a link to the Respondent’s site and to the Complainant’s own site. This misses the point that initial interest confusion is specifically concerned with deception of users arising before the user reaches the site. While any confusion may be dispelled once the user reaches the site, the site operator is likely to benefit unfairly from at least some of that traffic.

The Respondent seeks to distinguish between the single, allegedly non commercial, webpage at the disputed domain name and his other site, which is linked to from that page (i.e., together with the Complainant’s site). However, the gateway page and the Respondent’s linked revenue-generating site cannot be considered in isolation from each other as the purpose of the link is obviously to drive traffic to the revenue-generating site.

The Respondent says that if a search engine such as Google renders results with the term “CEM” that do not belong to the Complainant, then this would not cause initial interest confusion as the user has an option to decide whether to click on the link to visit the site. But this overlooks the fact that, if the user does click, it is likely to be because he/she (wrongly) assumes from the use of “CEM” in the domain name that the search result will lead to the Complainant’s site. This is a classic example of initial interest confusion. Whether or not the Complainant is “harmed”, it is sufficient that the Respondent has obtained an unfair advantage by its use of the Complainant’s mark in the disputed domain name – which it would in this case given the likelihood that some of the users would click through to the Respondent’s revenue-generating site.

Taking all of the above matters into account, the Panel concludes on balance that the disputed domain name has been registered and/or used in bad faith. (It is not necessary to specifically apply the factors listed in Article 21(3) of the Regulation as these are non-exhaustive examples of bad faith. See paragraph V(8) of the CAC Overview.)

Finally, there is number of claims which the Panel has disregarded.

The Respondent complains that the Complainant has taken no action in relation to two other domain names which are similar to the disputed domain name. But there may be any number of reasons why the Complainant has chosen not to pursue those domain names, assuming it is even aware of them, and it has difficult to see how this fact, of itself, can have any bearing on the present case.

The Respondent also claims that the Complainant is seeking to close down the Respondent’s site because he has challenged the Complainant’s claims that its tests are resistant to preparation. However, this is unsupported by evidence and in any case it is not a

matter on which the Panel is qualified to comment. The Panel therefore disregards this assertion.

Nor has the Panel placed any weight whatever on various assertions by the Complainant as to alleged misconduct by the Respondent including alleged infringement of copyright and alleged attempts to uncover confidential information regarding the Complainant. There is no evidence in support of these claims either.

Remedy

The Complainant seeks transfer of the disputed domain name.

Article 22(11) of the Regulation states that the Panel shall decide that the domain name shall be revoked if it finds that the domain name is speculative or abusive as defined in Article 21. Article 22(11) further provides that the domain name shall be transferred to the Complainant if the Complainant applies for the domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) 733/2002.

Those general eligibility criteria are:

1. an undertaking having its registered office, central administration or principal place within the European Community;

2. organisations established within the European Community without prejudice to the application of national law; or

3. natural persons resident within the European Community.

The Complainant satisfies the eligibility criteria as it is an organisation established in the UK.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name CEM11PLUS be transferred to the Complainant.

PANELISTS

Name	**Adam Taylor**

DATE OF PANEL DECISION 2014-07-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: cem11plus.eu

II. Country of the Complainant: UK, country of the Respondent: UK

III. Date of registration of the domain name: 16 December 2013

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 the UK, reg. No. 2654219, for the term "CEM", filed on 8 February 2013, registered on 2 August 2013 in respect of goods and services in classes 41 and 42.
2. combined/figurative trademark registered in the UK, reg. No. 2620085, for the term "CEM Centre for Evaluation & Monitoring", filed on 4 May 2012, registered on 2 November 2012 in respect of goods and services in classes 41 and 42.

V. Response submitted: Yes

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. Not addressed.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):

1. Yes
2. Why: Respondent selected disputed domain name by reference to the Complainant's mark and used it in a manner which is liable to create initial interest confusion.

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name.

XI. Procedural factors the Panel considers relevant: The Panel declined the Respondent's application to suspend the case pending the outcome of trade mark invalidity proceedings filed with UK trade marks registry.

XII. Is Complainant eligible? Yes