Panel Decision for dispute CAC-ADREU-006734

Case number	**CAC-ADREU-006734**
Time of filing	**2014-07-03 18:38:10**
Domain names	**swing4ireland.eu**

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Organization	**Eurekahosts**

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 disputed domain name.

FACTUAL BACKGROUND

1. The complainant is Symbios Solutions Ltd (the "Complainant"), a private limited company incorporated on 02 November 2001 with registered office in England, whose main activities include maintaining dating, alternative lifestyle and social websites for "swingers".

2. The Complainant trades as Symbios Group and is the operator inter alia of the website www.swing4ireland.com, created on 07 April 2005. The Complainant launched a website under that domain on 27 May 2005 and has been trading under the name SWING4IRELAND since that date. The Complainant is the owner of the Community Trade Mark SWING4IRELAND (EU009801705), which was registered in various international classes on 09 August 2011.

3. The respondent is Eurekahosts, an entity that appears to provide services including web design and web hosting, based in Northern Ireland. Eurekahosts is associated with Patrick Philip ("Mr Philip"), who is named as a co-respondent in the complaint. Mr Philip is also the named individual identified as registrant of the disputed domain name, while Eurekahosts is named as the registrant organisation. The Panel will refer to Eurekahosts and Mr Philip jointly as respondent (the "Respondent"). The Respondent registered the disputed domain name swing4ireland.eu (the ".eu Domain") on 06 April 2009.

4. The Complainant asserts that it created the domain at swing4ireland.com to expand its already successful UK business to Ireland and to set up a website mainly for Irish members. The Complainant adduces Google Analytics and website ranking data, as well as press cuttings for the period 2008 to 2014, to demonstrate that it has acquired substantial reputation and goodwill in the name SWING4IRELAND. The Complainant further adduces annual membership information for the years 2005 to 2014 and annual revenue figures for the years 2008 (when it started to charge for membership) to 2014 to establish the existence of goodwill in the name SWING4IRELAND.

5. The Complainant issued the complaint in the present ADR proceedings on 30 May 2014. A request for EURid verification was answered on 03 June 2014, confirming that the Respondent is the current registrant of the Domain Name. The Respondent was notified of the commencement of ADR proceedings on 04 June 2014. The Respondent submitted its response on the same day. The Panel was appointed on 10 June 2014 and the case file was transmitted to the Panel on 13 June 2014.

A. COMPLAINANT

6. The Complainant seeks a decision transferring the .eu Domain to the Complainant.

7. In its complaint, the Complainant identifies two other domains, swing4ireland.ie, registered in 2008, which it says copied the look and get-up of an earlier version of the Complainant's own website, including graphics; and swing4ireland.co.uk, of which the Complainant became aware in early 2009, and which redirects to the website at swing4ireland.ie. The Complainant's solicitors sent cease and desist letters in relation to both domains (albeit not to the Respondent) and the Complainant links both domains to the Respondent.

8. The Complainant submits that it enjoys rights in the name SWING4IRELAND both based on its Community trade mark registration for that name and because the use of that name as a trading name is protected as an unregistered trademark under the laws both of the Republic of Ireland and of Northern Ireland; it observes that the .eu Domain is identical with the name SWING4IRELAND.

9. The Complainant alleges that the Respondent lacks any right or legitimate interest in using the .eu Domain. The Complainant submits that it has no association with the Respondent and has not authorised or licensed the Respondent to use the name SWING4IRELAND.

10. The Complainant further alleges that the Respondent has used the .eu Domain and the Complainant's trade mark intentionally to disrupt the Complainant and/or to "attract, confuse and profit from internet users seeking the Complainant". The Complainant submits that there is no evidence that the Respondent has been commonly known by the name comprised in the .eu Domain; and that the Complainant asserts that the Respondent has not made any legitimate non-commercial or fair use of the .eu Domain – to the contrary, the Respondent is said to have made commercial use of the .eu Domain.

11. The Complainant further believes that the .eu Domain has been registered by the Respondent in bad faith. In support of that submission, the Complainant relies on the obfuscation by the Respondent and its connected entities in relation to the other SWING4IRELAND formative domains mentioned above.

12. The Complainant alleges that the Respondent intended inter alia to block the Complainant from reflecting its trade mark in the .eu Domain and has done so as part of a pattern of such conduct.

13. Furthermore, the Complainant alleges that the Respondent registered the .eu Domain for the purpose of interfering with or disrupting the business of the Complainant by diverting business away from the Complainant and that the .eu Domain is a scheme adopted by the Respondent to confuse, attract and profit from internet users searching for the Complainant's business. In support of this allegation, the Complainant relies on the fact that the Respondent has never claimed that it did not have the Complainant and its business in mind when registering the .eu Domain. Furthermore, the combination and style of words and the numeral "4" in the name "SWING4IRELAND" is not obvious and could not have been conceived independently by the Respondent.

14. The Complainant points to a number of similarities between the website at swing4ireland.ie, with which it says the Respondent is connected, and an earlier version of the Complainant's website, as evidence of copying by the Respondent.

B. RESPONDENT

15. The Respondent's Response to the Complaint states:

"I only register domain names on behalf of people on this domain name www.swing4ireland.eu as I use the name Eurekahosts and to be honest this domain name means NOTHING to me now if Symbios wanted this domain name all they had to do was have the decency to email me directly and ask if they could purchase it to cover my cost of registering it and re-registering it.

So let me make this very clear if the people at symbios want this domain name be man enough to email me and ask for it. No need to act the bully boy

That's all I have to say".

DISCUSSION AND FINDINGS

General

16. The Panel has reviewed and considered the complaint and the response in detail.

17. In order to succeed, the Complainant must show, in accordance with Article 21.1 of Commission Regulation EC 874/2004 (the "Regulation") and Paragraph B.11(d)(1) of the ADR Rules that:

(a) the disputed domain name is identical with 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

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

(c) the domain name has been registered or is being used in bad faith.

18. If the Complainant succeeds in this respect, in order to obtain a transfer of the .eu Domain, Article 22.11 of the Regulation further requires that the Complainant applies for the .eu Domain and satisfies the eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

Is the domain name identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or Community law?

19. The Complainant's CTM registration for the mark SWING4IRELAND is established and protected by Community Law. Although the mark was registered on 09 August 2011, well after the date on which the .eu Domain was registered, the wording of Article 21(1) of the Regulation makes no specific reference to whether the right acquired by the trade mark registration needs to pre-date registration of the .eu Domain. The majority view in relevant decisions of the Czech Arbitration Court has been that it is sufficient if the trade mark is in full effect at the time of the complaint (see, for example, case 5379 NORDIC NATURALS).

20. Article 21(1) of the Regulation, in conjunction with Article 10(1) of the Regulation, in principle also recognises unregistered trade marks, trade names, business identifiers and company names as possible 'prior rights'. By contrast, prior domain name registrations do not benefit from such recognition. The Complainant asserts that its unregistered trade mark rights in the name SWING4IRELAND are protected under the laws of the Republic of Ireland and Northern Ireland and are therefore recognised or established by national and/or Community law. The Complainant does not however provide any further detail as to the basis, circumstances and conditions on or under which that protection arises according to national law and does not explain why such protection would apply here for the benefit of the Complainant; given, in particular, that much of the evidence as to goodwill and reputation adduced by the Complainant post-dates the registration of the .eu Domain, such submissions would have been appropriate. However, since the Complainant has established the existence of a registered trade mark right in the name SWING4IRELAND, the Panel is not in this instance required to make any findings or decision as to the existence of unregistered rights in the trade name SWING4IRELAND.

21. The .eu Domain is furthermore identical with the Complainant's registered trade mark SWING4IRELAND.

Has the domain name been registered by the Respondent without rights or legitimate interest in the name?

22. The burden of proof lies on the Complainant in the first instance to establish at least prima facie that the Respondent lacks rights or legitimate interest in the domain name. On doing so, the burden of proof shifts to the Respondent. If the Respondent fails to demonstrate evidence of rights or legitimate interest, it is deemed to have none (see, for example, case 04440 SKINSTORE).

23. Based on a review of the circumstances referred to in Article 21.2 of the Regulation and paragraph B.11(e) of the ADR Rules, the Panel accepts the Complainant's submission that the .eu Domain was registered by the Respondent at least prima facie without rights or legitimate interest in the name. While the Complainant's submissions are somewhat tenuous in some respects and appear to be concerned principally with the domain swing4ireland.ie, rather than with the .eu Domain, the following factors point in the Panel's view to a lack of such rights or legitimate interest:

a. The Respondent has not been licensed or otherwise authorised by the Complainant to use the mark SWING4IRELAND, or to register the .eu Domain.
b. The Respondent is not known by the name SWING4IRELAND.
c. The Respondent’s name, Eurekahosts, suggests that it is a domain development company and not in the business of providing dating and social website services; indeed, it states effectively that it registered the domain "on behalf of people".
d. Finally, the Respondent cannot be said to make legitimate and non-commercial or fair use of the Domain Name without intent to mislead consumers or harm the Complainant's trade marks and trade name.

24. The Panel's conclusion that the Respondent lacks legitimate rights or interests in the disputed domain name is further reinforced by the fact that the Respondent has failed to show any such rights or legitimate interest in the .eu Domain and only submitted a cursory and unsubstantiated response to the complaint. Indeed, the Respondent states that "… this domain name means NOTHING to me [now] …".

Has the domain name been registered or used in bad faith?

25. Having established that the .eu Domain has been registered by the Respondent without rights or legitimate interest in the name, it is not necessary for the Complainant to show, or for the Panel to make a decision, that the Respondent registered or is using the .eu Domain in bad faith. However, the fact that the Complainant ran a successful business from the domain swing4ireland.com since 2005, and the Respondent used the identical trade name when registering the .eu Domain, may be regarded as an indication that the Respondent must have been aware of the Complainant's rights in the name SWING4IRELAND and acted in bad faith.

26. The Complainant is a private limited company registered in England and satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2202.

DECISION

27. For all the foregoing reasons, in accordance with paragraph B.12(b) of the ADR Rules, the Panel orders that the disputed domain name swing4ireland.eu be transferred to the Complainant.

PANELISTS

Name	**Gregor Kleinknecht, LLM MCIArb**

DATE OF PANEL DECISION 2014-07-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant (an English registered company) seeks the transfer of the disputed domain name swing4ireland.eu (registered on 06 April 2009) to itself. The Respondent (an entity based in Northern Ireland) submitted only a cursory and unsubstantiated response. The Complainant adduced evidence of prior rights in the form of the Community trade mark SWING4IRELAND. The Complainant established that the disputed domain name is identical with the registered trade mark SWING4IRELAND owned by the Complainant. The Panel found that the Respondent has no rights or legitimate interest in the disputed domain name. In view of that finding, the Panel did not need to consider whether the Respondent also acted in bad faith but noted that there was some evidence supporting that view. Since the Complainant fulfilled the general eligibility criteria, the Complainant was entitled to a transfer of the disputed domain name.