Panel Decision for dispute CAC-ADREU-006870

Case number	CAC-ADREU-006870
Time of filing	2014-12-15 18:29:55
Domain names	gestetner.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	NRG Manufacturing Limited

Respondent

Name	Peter Newton

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

None

FACTUAL BACKGROUND

The Complainant is a member of the Ricoh group, a major worldwide supplier of printers and copiers. The Complainant is the proprietor of registered trademarks for the word “GESTETNER”. These include Community trademark no. 2417160 for various goods and services in classes 2, 9, 16, 37, 41 and 42, including printers, printer inks and printing services, registered in 2003 pursuant to an application in 2001, and UK trademark no. 470048 for electrically driven duplicating machines and parts therefore, registered in 1926.

The disputed domain name was registered on 16 April 2014. It has been directed to a parking page which displays the name “buzzsolutions”.

The Respondent replied to a letter from the Complainant’s solicitors on 1 August 2014, stating: “I have just received your letter regarding my company ‘Gestetner Limited’. The company name was freely available at Companies House and I have incurred substantial start-up costs setting up the company. I also believe my company will not adversely affect Ricoh Europe PLC to any significant extent. If Ricoh Europe PLC are prepared to reimburse my start-up costs I would be prepared to change my company name.”

A. COMPLAINANT

The Complainant contends that the disputed domain name is identical to its registered trademarks for the word GESTETNER.

The Complainant alleges that the disputed domain name was registered in bad faith and submits that by using the disputed domain name, the Respondent is intentionally attempting to attract, for commercial gain, internet users to his web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

According to the Complainant, members of the public will inevitably be confused into thinking that the Respondent’s website is the official and/or an authorised website for GESTETNER products because the disputed domain name consists solely of the Complainant’s distinctive mark. The Complainant notes that the Respondent replied to a cease and desist letter using a logo as part of his email signature which read “gestetner / the art of printing”. The Complainant points out that GESTETNER is an unusual name and well-known for printing services long before the registration of the disputed domain name.

The Complainant further alleges that the disputed domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring it to the Complainant for valuable consideration in excess of its costs. The Complainant refers to the

Respondent's email to support this contention.

The Complainant also alleges that the Respondent registered the disputed domain name to prevent the Complainant from reflecting its "GESTETNER" mark in a corresponding Domain Name. The Complainant refers to the Respondent's registration of the domain name county-print.co.uk, similar to the name of a printing company, County Print Limited (which has been operating for 50 years), and its domain name, countyprint.com, where it has its website.

The Complainant confirms that it meets the general eligibility criteria for registering a .eu domain name and requests transfer.

B. RESPONDENT

The Respondent states that this is the first he has known about this proceeding. He points out that he obtained the disputed domain name which was freely available in the UK. He understands that the Complainant does not trade in the UK, and maintains that he cannot see the relevance of the dispute.

DISCUSSION AND FINDINGS

The panel finds that the disputed domain name is effectively identical to the Complainant's registered Community trademark no. 2417160 and UK trademark no. 470048 for the word "GESTETNER".

The panel further finds that the disputed domain name has been registered by the Respondent without any rights or legitimate interests. The Respondent has not identified any use of the domain name or any corresponding name in connection with the offering of goods or services or any preparations to do so. Nor has the Respondent suggested that he is commonly known by the domain name. Nor is he making any legitimate and non-commercial or fair use of the domain name without intent to mislead consumers or harm the reputation of the mark. Nor is there any indication in the file that the Respondent might have a right or legitimate interest in the domain name on any other basis.

The Complainant having established a prima facie case that the Respondent has no such right or interest, the burden shifts to the Respondent to controvert the allegation, particularly as any information as to his possession of such a right or interest would be within his own knowledge. Or to put it another way, it may be inferred from the absence of any such suggestion in response to the Complainant's case that the Respondent has no such right or interest.

The panel therefore finds that the condition in Article 21(1)(a) of Regulation 874/2004 is satisfied. This finding is sufficient to establish that the registration is speculative or abusive within the meaning of Article 21 and it is not strictly necessary to consider the further question of whether the disputed domain name was registered or is being used in bad faith.

However, on the basis of the material in the file, the panel further finds that the disputed domain name was registered in bad faith. In the panel's view, the circumstances indicate that the domain name was registered primarily for the purpose of sale to the Complainant or a connected company. There is no other rational explanation for the registration and it is supported by the Respondent's reply to the Complainant's solicitors' letter, even though this referred to a company, Gestetner Limited, apparently registered by the Respondent, rather than the domain name. The panel therefore finds that bad faith is demonstrated in accordance with Article 21(3)(a) of Regulation 874/2004.

In addition, the disputed domain name is a personal name and no demonstrable link exists between it and the Respondent. Although this point is not alleged by the Complainant, it appears to be incontrovertible on the material in the file. This provides a further basis for finding bad faith under Article 21(3)(e) of Regulation 874/2004.

The Complainant satisfies the general availability criteria set out in Article 4(2)(b) of Regulation 733/2002, since its registered office is in the EU, and it has requested transfer of the disputed domain name. Transfer should therefore be ordered in accordance with Article 22(11) of Regulation 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name GESTETNER be transferred to the Complainant

PANELISTS

Name	**Jonathan Turner**

DATE OF PANEL DECISION 2014-12-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: gestetner.eu

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

III. Date of registration of the domain name: 16 April 2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark registered in EU, reg. No. 2417160, filed on 17 October 2001, registered on 27 February 2003, and renewed for the term of 10 years on 17 October 2011, in respect of goods and services in classes 2, 9, 16, 37, 41 and 42
2. word trademark registered in UK, reg. No. 470048, filed on 25 May 1926, registered on 25 May 2006, and renewed on 6 February 2006 until 25 May 2016 in respect of goods and services in class 16.

V. Response submitted: Yes

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: No suggestion or evidence produced by Respondent in response to assertion by Complainant that he has none.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Registered for purpose of sale, Art 21(3)(a); personal name with no link to Respondent, Art 21(3)(e).

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