Panel Decision for dispute CAC-ADREU-006934

Case number	CAC-ADREU-006934
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Domain names	fitnessworld.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Name	Markus Jank

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

There was a Language Trial pursuant to Article A.3 of the ADR Rules in relation to this proceeding. The Language Trial Decision dated March 3, 2015 decided that the language of this proceeding shall be English.

There are no other relevant legal proceedings.

FACTUAL BACKGROUND

The Complainant is a Danish public company providing fitness services in Denmark. It also has a business presence in Poland.

The Complainant is the owner of the Danish trademark registration No VR 2006 00127 for the word mark FITNESS WORLD, registered on January 6, 2006 in classes 25, 28 and 41. There is also an international registration for the FITNESS WORLD trademark under the Madrid Agreement.

The Complainant is the owner of the <fitnessworld.dk> domain name first registered on January 14, 2005, and which has been its main domain address since that time.

The Respondent registered the <fitnessworld.eu> domain name (“disputed domain name”) on May 18, 2013.

The disputed domain name was offered for sale at Golem Domain Aftermarket shortly after registration. The Panel entered the disputed domain name in his web browser on July 29, 2015 and the disputed domain name was still offered for sale on this date. The landing page states: “fitnessworld.eu is for sale! Buying this domain means full control and ownership” and identifying a price of €2.999.00.

On May 28, 2015 the Complainant filed its Complaint, seeking the transfer of the disputed domain name. The Respondent filed its response on July 3, 2015.

On July 13 2015, the Parties were notified of the appointment of Dr. David J. A. Cairns as single panelist. The file was transmitted to the Panel on July 16, 2015

A. COMPLAINANT

The Complainant states that its rights to the name ‘Fitness World’ are recognized by the Danish and European law, and these rights existed prior to the registration of the disputed domain name.
Specifically, the Complainant alleges rights in its company name (Fitness World), trade name (Fitness World), business identifier (fitnessworld.dk) and registered national and community FITNESS WORLD word trademarks. Therefore, the Complainant asserts that it

is a holder of prior rights within the meaning of Articles 10(1) and 21(1) of the Regulation Nº 874/2004.

The Complainant submits the disputed domain name is identical with the Complainant's Danish and community FITNESS WORLD marks, as well as the Complainant's company name, trade name and business identifiers, which are protected under Danish law.

The Complainant states that it has been confirmed by the Court of Justice of the European Union in the judgment that two signs should be considered identical where all elements of one sign are represented in another sign or, viewed as a whole, the differences are so insignificant that they may go unnoticed by an average consumer (see: judgment of 20/03/2003, C-291/00, 'LTJ Diffusion' paras 50-54).

The Complainant submits that the same applies to merging otherwise identical words into one string of letters for technical reasons in domain name naming systems. Therefore the <fitnessworld.eu> domain name is identical to the FITNESS WORLD trademark and by analogy to the company name, trade name and business identifiers of the Complainant.

The Complainant also claims the disputed domain name is confusingly similar to the community trademark 'common sense FITNESS WORLD' as it is similar to the most distinctive part of this mark, being the words 'Fitness World'.

The Complainant also states that the Respondent has registered the disputed domain name without rights and legitimate interest in the name. It states that Art. 21.2 of Regulation Nº 874/2004 lists three situations that may demonstrate the existence of legitimate interest of the Respondent. The Complainant states that none of them applies to this case.

First the Complainant states that there is no proof that the Respondent took any steps to make use of the domain name in connection with offering goods or services. Immediately after the registration the Respondent parked that domain name at Golem Domain Aftermarket and offered it for sale, initially for 2745 EUR. The domain name has remained offered for sale since that time. The Complainant contacted Golem regarding the purchase of the disputed domain name. In the correspondence a Golem team member quoted the Respondent that the domain name was "purchased regarding a project." The Complainant say this is highly doubtful as the Respondent never purchased the domain name, but registered it and put the disputed domain name on sale immediately.

Secondly, the Complainant states that the Respondent Markus Jank is not in any way associated with the 'Fitness World' name. The Complainant states that its searches have not identified any possible links between the Respondent and the name 'Fitness World'. In particular, trademark and google searches reveal no connection between the Respondent and the phrase 'fitness world'.

Thirdly, the Complainant states that there is no evidence that the Respondent makes a legitimate and non-commercial or fair use of the domain name. In fact, the evidence attached shows that the sole purpose of registering the domain was to resell it at high price. The Complainant alleges that other domain name cases demonstrate that the Respondent has a direct commercial purpose of reselling domain names.

The Complainant also submits that the Respondent registered the disputed domain name in bad faith in terms of Article 21(3)(a) of Regulation Nº 874/2004 because the Respondent registered the domain name in order to put it on sale, as well as in terms of Article 21(3)(b)(ii) because Markus Jank has never used <fitnessworld.eu> in connection with any offering of goods or services, and further he has also never shown any preparation to make such usage. The Complainant also alleges that the registration of the disputed domain name prevents the Complainant from reflecting its name in the domain name.

The Complainant requests that the disputed domain name <fitnessworld.eu> be transferred to the Complainant

B. RESPONDENT

The Respondent states that the disputed domain name is "a 100% generic keyword (fitness + world) which we purchased in 2013 for company/project use." He states that the Complaint is a domain name hijack after the Respondent rejected the Complainant's offer to purchase the domain name at golem.eu

The Respondent states that it has never heard of or had any contact with the Complainant, and to demonstrate that the disputed domain name is generic refers to the 847.000 google results for 'fitnessworld'. The Respondent says that in each European country there are different companies using 'fitnessworld', because it is a generic expression comprising the two words 'fitness' and 'world'. The Respondent denies bad faith and confirms that he is the owner of the disputed domain name.

DISCUSSION AND FINDINGS

Commission Regulation (EC) Nº 874/2004 of 28 April 2004 ("the Regulation") provides for an ADR procedure in respect of allegedly

speculative or abusive domain name registrations. Article 21 of the Regulation describes speculative and abusive registrations. Article 21(1) states that a registered domain name is 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 10(1) defines 'prior rights' and includes registered national and community trademarks.

Article 21(2) sets out various circumstances that may demonstrate that the Respondent has a legitimate interest in the domain name. Article 21(3) elaborates circumstances that may demonstrate registration or use of a domain name in bad faith.

The Panel is required to decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules (paragraph B.11(a) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules")). Paragraphs B.11(d),(e) and (f) of the ADR Rules repeat the legal requirements of Articles 21(1), (2) and (3) of the Regulation.

A. The Complainant's Rights:
The Panel finds that the Complainant is the owner of the trademark registrations for FITNESS WORLD referred to above, and therefore has a right recognised and established by national and community law in the trademark FITNESS WORLD.

B. Identical or Confusingly Similar:
The disputed domain name incorporates the two words comprising the FITNESS WORLD trademark. There are only two differences from the Complainant's trademark: (i) the disputed domain name is a single word 'fitnessworld' and not two separate words; and (ii) the dispute domain name includes the top level domain suffix ('eu'). However these differences exist for purely functional reasons and so are not considered for the purposes of a comparison with a trademark. This is well established in domain name practice; see, for example, Patricia Ann Romance Peterson, Romance Productions Ltd. v. Network Operations Center/Alberta Hot Rods, WIPO Case No. D2006-1431 (January 3, 2007), where it is stated: "Clearly a trademark does not usually include a URL prefix (here, "www"), or a top-level domain name suffix (here, '.com') that are functional elements of a domain name, and the comparison required for the first element of the Policy must exclude these elements. These elements are incapable of performing any distinctive function, and it is well-established that they should not be considered in making this determination (see Segway LLC v. Chris Hoffman, WIPO Case No. D2005-0023 (February 25, 2005), D. Ronaldo de Assis Moreira v. Eladio García Quintas, WIPO Case No. D2006-0524 (July 14, 2006) and LDLC.COM v. LaPorte Holdings, WIPO Case No. D2005-0687 (August 8, 2005)). Further, a domain name cannot contain separate words, which must of necessity be compressed to a single word or be joined by a hyphen or hyphens. Accordingly, there is no significance in the fact that the Complainants' trademark comprises two words that are compressed together in the disputed domain name."

This reasoning is reinforced by the Court of Justice of the European Union decision in Case C-291/00 LTJ Diffusion SA v Sadas Vertbaudet SA referred to by the Complainant where the Court states at paragraph 54: "[…] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer." By analogy, the differences between the FITNESS WORLD trademark and the disputed domain name are insignificant for being purely functional and therefore can be disregarded.

The Respondent alleges that the disputed domain name is generic, and refers to the large number of results generated by a google search on the words comprising the disputed domain name. A term is ´generic' when its principal significance is to indicate the product or service itself, rather than any particular provider. 'Fitness world' is not generic as it does not refer to any service in general, and the Panel is satisfied that it acts as a trademark and refers to the Complainant's services.

It is true that 'fitness' and 'world' are both common descriptive words, and the descriptiveness of its components may undermine its distinctiveness as a trademark, but FITNESS WORLD has been accepted for registration as a word mark, and the Complainant has demonstrated its rights to this expression under the Regulation. The large number of google search results for 'fitness' and 'world' only demonstrates that these are common descriptive terms, and not that their use in combination is generic. The Respondent merely alleges, without evidence, that there are other European users of 'fitnessworld', and without details the significance of this circumstance, if any, cannot be considered.

For these reasons, the Panel concludes that the disputed domain name is identical to the Complainant's FITNESS WORLD trademark registrations.

C. Rights or Legitimate Interest:
The Panel notes the following circumstances in relation to any possible rights or legitimate interest of the Respondent in the disputed domain name: (i) there is no evidence before the Panel that the Respondent has any proprietary or contractual rights in any registered or common law trademark corresponding in whole or in part to the disputed domain name; (ii) the Respondent is not authorized or licensed by the Complainant to use the WORLD FITNESS trademark or to register and use the disputed domain name; (iii) The Complainant's trademark rights substantially pre-date the Respondent's registration of the disputed domain name; (iv) there is no suggestion that the Respondent has been commonly known by the disputed domain name.

The Respondent alleges that the disputed domain name was purchased for 'company/project use'. However, no details have been provided of these alleged corporate or project uses, and specifically there is no evidence of any preparations to use the disputed domain name in relation to the offering of any goods or services. There is no evidence of any use other than offering the domain name for sale. The Panel therefore concludes that the disputed domain name was purchased for the commercial purpose of resale.

The Respondent also alleges that the Complaint is an effort at reverse domain name hijacking as the Complainant failed in its effort to buy the dispute domain name. A trademark owner may have many reasons to contact a registrant about a possible sale of the domain name, but this does not affects its rights in subsequent proceedings where, as in the present case, it can demonstrate it holds prior rights within the meaning of the Regulation.

Article 21(2) of the Regulation and paragraph B.11(e) of the ADR Rules provide a list of three circumstances, any of which is sufficient to demonstrate that the Respondent has rights or a legitimate interest in the disputed domain name. There is no evidence before the Panel of the existence of any of these circumstances in the present case.

Accordingly, the Panel concludes that the Respondent registered the disputed domain name without any rights or legitimate interest in the name.

The Complainant further contends that the disputed domain name was registered or is being used in bad faith. However, the Panel is not required to decide this question as under the ADR Rules and the Regulation registration or use in bad faith is an alternative, and not additional, requirement to registration without rights or legitimate interest.

Accordingly, the Complainant has satisfied the substantive requirements of the ADR Rules and the Regulation. The Respondent's registration is speculative or abusive, and the Complainant is entitled to the appropriate remedy in accordance with paragraph B.11(b) of the ADR Rules

D. Remedy:
The Complainant has submitted evidence that it is incorporated pursuant to Danish law with its registered office in Gentofte. Therefore the Panel finds that the Complainant satisfies the general eligibility criteria for registration of a .eu TLD set out in paragraph 4(2)(b) of Regulation (EC) Nº 733/2002 of the European Parliament and of the Council of 22 April 2002.

Therefore, the requirements for the requested transfer of the domain name to the Complainant are satisfied.

DECISION

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

PANELISTS

Name	David Cairns

DATE OF PANEL DECISION 2015-07-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <fitnessworld.eu>

II. Country of the Complainant: Denmark; country of the Respondent: Austria

III. Date of registration of the domain name: 18 May 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. FITNESS WORLD word trademark registered in Denmark reg. No. VR 2006 00127 for the term of 10 years filed on 10 October 2005 registered on 6 January 2006 in respect of goods and services in classes [25, 28 and 41.

V. Response submitted: Yes

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
No

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
Not considered

IX. Other substantial facts the Panel considers relevant:

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

XI. Procedural factors the Panel considers relevant:

XII. [If transfer to Complainant] Is Complainant eligible? Yes