Panel Decision for dispute CAC-ADREU-007162

Case number	CAC-ADREU-007162
Time of filing	2016-05-23 14:20:50
Domain names	pfSense.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	Electric Sheep Fencing

Respondent

Organization	Halma Automatisering

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 proceeding regarding the disputed domain name.

FACTUAL BACKGROUND

Complainant 1 - Electric Sheep Fencing LLC (hereinafter “ESF” or “Complainant 1”) is a Texas limited liability company located in USA. ESF is the owner of trademark PFSENSE - International Reg. No. 1176766, registered on 28 August 2013. Complainant 1 has used the mark PFSENSE since at least as early as 2005. Complainant 1 registered its domain name “pfSense.org” in 2004.

Complainant 2 - Rubicon Communications LLC (hereinafter “Rubicon” or “Complainant 2”), a Texas limited liability company located in USA. Rubicon is the exclusive licensee of ESF with respect to the trademark and service mark “PFSENSE”. Complainant 2 is also a registered Norskreg. Utenlandsk foretak (Norwegian Registered Foreign Company or “NUF”), Registration No. 916 474 431.

Respondent - Halma Automatisering, Arjen Halma a Dutch company has in 2006 registered domain name pfsense.eu. At the time of filing the complaint and at the date of the decision, information about Parallels software is presented on website pfsense.eu.

A. COMPLAINANT

Complainant claims the domain name pfsense.eu is identical and/or confusingly similar to Complainant’s Mark PFSENSE (the Mark).

Furthermore, Complainant contends it has spent nearly ten years and a large amount of money promoting and advertising the PFSENSE mark and goods and services offered thereunder, not only in the United States, but worldwide.

The Mark is exclusively associated with Complainant’s goods and services, which include computer hardware and software, and “technical support services, namely, troubleshooting of computer software problems; maintenance of computer software and computer software development.

According to Complainant Respondent has no legitimate interests in the disputed domain name. Respondent is not affiliated with, sponsored by, or authorized by Complainant to use the PFSENSE mark. Respondent is using Complainant’s mark to generate revenue from third parties, who may believe that Respondent is authorized to use the PFSENSE mark, or is otherwise affiliated with or related to Complainant by virtue of the disputed domain name registered by Respondent.

Use of the disputed domain name for such competitive purposes is not a bona fide use of the disputed domain name, and is certainly not an authorized use of Complainant’s trademarks. Respondent is attracting Internet users to its website through the use of Complainant’s marks. Therefore, the use of the disputed domain name by Respondent is not bona fide.

Respondent is not known as “PfSense.” Nothing in Respondent’s WHOIS information implies that Respondent is “commonly known by” the disputed domain name. Respondent has no affiliation or relationship with Complainant. Respondent is not an authorized vendor or retailer of Complainant.

Respondent’s use of the disputed domain name is not in connection with any noncommercial or fair use. Respondent generates revenue by providing products and technical support services under the name “Parallels” in direct competition with Complainant. Respondent is using Complainant’s Mark to market and promote its own services, in a manner that is directly competitive with Complainant’s own services.

Finally, Complainant claims the disputed domain name was registered and is used in bad faith. Respondent’s registration of the disputed domain name to market and promote its own support services constitutes an unauthorized trading upon the goodwill and to Complainant’s registered trademarks in violation of Complainant’s rights.

Complainant was offering its goods and services under the PFSENSE trademark prior to Respondent’s acquisition of the disputed domain name. Complainant’s Mark has been registered in the United States and in other countries worldwide, thereby giving Respondent publicly available knowledge as to Complainant’s rights in that Mark. Further, Complainant registered its own domain name (pfSense.org) approximately two (2) years prior to Respondent’s registration of the disputed domain name at issue. Respondent therefore knew or should have known that it was not authorized to register or utilize the disputed domain name for its own commercial services. Further, Complainant’s attorney contacted Respondent regarding the disputed domain name, but Respondent ignored this communication and never bothered to respond, thereby indicating Respondent’s continued usage of the disputed domain name in bad faith.

Complainants seek transfer of the domain name to Complainant 2 - Rubicon Communications LLC.

B. RESPONDENT

Respondent claims that the fact that Respondent is an IT company is not enough to make the conclusion that it has a non bona fide use of the domain name.

Respondent admits that they don't use the name PFsense, in its company name and states that they have more domains which don't use Respondent's company name.

Regarding Complainant's statement that "No Legitimate Noncommercial or Fair Use is Made by Respondent", Respondent explains that the website presented at pfsense.eu is standard placeholder site of their Parallels Plesk hosting platform. Respondent don't make this page, it’s a standard Hello World site, which you get when you make a new hosting site. There is no website running on pfsense.eu, there is no info about the PFSense product on it, and there is nothing being sold on it by Respondent. It only contains a standard placeholder site.

Respondent points out that at the time Respondent registered the disputed domain name there was no trademark regarding the name “PFSENSE”.

Respondent states that it cares about open source software.

DISCUSSION AND FINDINGS

1. Procedural matters:

The Respondent challenged the appointment of a panelist, however the Respondent later explained that the challenge was filed as mistake. The Czech Arbitration Court decided on the challenge of panel candidates that the challenge made is groundless.

The Complainants filed additional response as non-standard communication in order to illustrate the deficiencies in the response. The Panel has reviewed the non-standard response and finds that no new statements were made in the additional response. Therefore the decision is based on the initial complaint.

2. Legal grounds for the decision:

According to the ADR Rules the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that
1) 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
2) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or
3) The domain name has been registered or is being used in bad faith.

The aforementioned ADR Rules are based on Article 21(1) of Regulation (EC) No. 874/2004 ("the Regulation"): "A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, 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."

3. Is domain name PFSENSE.EU 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?

Domain name PFSENSE.EU is identical to trade mark PFSENSE. Trade mark PFSENSE is registered international trademark of Complainant 1 with Reg. No. 1176766. International trade mark PFSENSE was not registered at the time of registering the domain name PFSENSE.EU but at the time of registering the disputed domain name Complainant 1 had already started to use term "PFSENSE" within the course of its business. Therefore disputed 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 Complainant 1 had already started to use that name before the registration of the disputed domain name. According to the wording of the Regulation and earlier .eu ADR panel decisions, it is not required that the trademark was registered before the domain name registration, it is sufficient that the mark is in full effect at the time of filing the complaint. Therefore even if the trademark was not registered at the time of domain name PFSENSE.EU registration, the Complainant 1 has relevant right arising from international trademark PFSENSE Reg. No. 1176766.
Complainant 2 is licensee of trade mark PFSENSE, having an exclusive world-wide license for the trade mark, thereby Complainant 2 has a right recognized or established by the national law of a Member State and/or Community law.

Therefore it must be decided whether the domain name has been registered by the Respondent without rights or legitimate interest in the name or whether the domain name has been registered or is being used in bad faith.

4. Has the domain name PFSENSE.EU been registered by the Respondent without rights or legitimate interest in the name?

According to the Regulation a legitimate interest may be demonstrated where:

(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;

(c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

Complainants have stated that Respondent has registered the domain name without rights or legitimate interest in the name.

In its response Respondent clearly declared that on the website www.pfsense.eu "there is no info about the PFSense product on it, and there is nothing being sold on it by us. It only contains a standard placeholder site." Respondent did not provide any information that it is preparing to use domain name PFSENSE.EU in connection with the offering of goods or services either. Therefore option (a) above is not

met.

In its response Respondent also stated that "we don't use the use the name PFsense, in our company name". Respondent did not provide any information that Respondent is commonly known by the domain name either. Therefore option (b) above is not met.

Regarding the possible legitimate and non-commercial or fair use of the domain name, the Respondent does not claim that it is making a legitimate and non-commercial or fair use of the domain name, Respondent just states that "there is no information on it". Therefore option (c) above is not met either.

Respondent has not given any information about its rights or legitimate interests in the name, therefore Panel has no possibility to assess whether such rights exist or whether such interests are legitimate, even in such interests are not expressly listed in the Regulation. Respondent merely explains that only a standard placeholder site is presented on the website www.pfsense.eu.

As Respondent does not provide any explanation which rights or legitimate interests it has in the name PFSENSE and as domain name PFSENSE.EU was registered already in 2006 and in 2016 still a standard placeholder site is presented on website www.pfsense.eu, the Panel decides that Respondent has no rights or legitimate interests in the name PFSENSE.

As the Panel finds that the Respondent has no rights or legitimate interests in the name PFSENSE, it is not necessary to further analyse whether the domain name PFSENSE.EU was registered or is being used in bad faith.

The Panel shall issue a decision granting the remedies requested under the Procedural Rules as it finds proven that 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 the domain name has been registered by the Respondent without rights or legitimate interest in the name

The remedy sought by the Complainants is transfer of the domain name pfsense.eu to Complainant 2. As the Complainant 2 has a registered office in Norway, it satisfies the general eligibility criteria for incorporation of .eu Regulations in the Agreement on the European Economic Area allows undertakings having their registered office, central administration or principal place of business in Iceland, Norway and Liechtenstein, organisations established in Iceland, Norway and Liechtenstein and residents in Iceland, Norway and Liechtenstein to register names under the .eu TLD.

DECISION

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

the domain name PFSENSE be transferred to the Complainant 2, to its Norskreg. Utenlandsk foretak (Norwegian Registered Foreign Company or “NUF”), Registration No. 916 474 431.

PANELISTS

Name	**Viive Naslund**

DATE OF PANEL DECISION 2016-05-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: PFSENSE.EU
II. Country of the Complainant 1: USA, Country of the Complainant 2: USA, Norway, country of the Respondent: Netherlands

III. Date of registration of the domain name: 7 April 2006

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. International trademark PFSENSE, reg. No. 1176766, registered on 28 August 2013 in respect of goods and services in class 9 with Designations under Madrid Protocol including European Union and Norway.

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):
1. No
2. Why: No rights or legitimate interests of the Respondent were provided in the response

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Not assessed
2. Why: Not assessed as it was already proven that Respondent has no rights or legitimate interests in the disputed domain name.

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: N/A

XII. Is Complainant eligible? Yes, Complainant 2 is eligible