Panel Decision for dispute CAC-ADREU-007224

Case number	CAC-ADREU-007224
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Domain names	chausports.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	JD Sports Fashion Plc

Respondent

Name	Erika Gabler

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 which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, is the parent company of JD Sports Fashion (France) SAS which operates a chain of over 70 sports shops in France under the trademark “CHAUSPORT” as well as an online retail store via website <www.chausport.com>. The same company is also the proprietor of EU trademark “CHAUSPORT” (no. 008519977, registered on 22 February2010) in classes 9, 14, 18, 25, 28, 35 (“the Registered Trademark”).

Respondent has registered the domain <CHAUSPORTS.EU> („the Domain Name“) on 15 January 2016.

The Complainant has submitted the Complaint requesting transfer of the Domain Name.

The Respondent has not filed a Response.

A. COMPLAINANT

The Complainant submits that the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights – Paragraph B11(d)(1)(i) of the ADR Rules.

The Complainant submits that the dominant element of the Domain Name (disregarding the gTLD .EU, as is the normal practice of panels), is the name CHAUSPORTS. This name differs from the Registered Trademark by the addition of the final letter “s”. The Complainant submits that the name CHAUSPORTS is identical or confusingly similar to the trade mark CHAUSPORT as the difference between the marks is not sufficient to enable the average consumer to distinguish between them. The Registered Trademark (covers identical goods and services to those being advertised and offered for sale at the Domain Name. The Complainant, therefore, submits that the first condition of Article 21(1) of Commission Regulation EC) No. 874/2004 is satisfied.

The Complainant contends that the Respondent has not used the Domain Name in connection with the offering of goods or services or has made demonstrable preparation to do so. Further, or in the alternative, the Complainant also refers to the fact that the Respondent is not an undertaking, organisation or natural person that has been commonly known by the Domain Name. In Complainant’s opinion it is clear from the supporting evidence that the Respondent cannot have any legitimate right to claim any interests in the name CHAUSPORTS, given the use that is made of the Registered Trademark by the Complainant’s subsidiary. The Respondent is using the Domain Name with the intent of misleading consumers and/or harming the reputation enjoyed by the Complainant’s subsidiary which is a right that is recognised by EU law.

In addition, the Complainant submits that the Domain Name was registered or used in bad faith. Submitted evidence shows that the Registrant is advertising and offering for sale sports footwear, predominantly products bearing the well-known Adidas trade mark. This is likely to lead to disruption of the business of the Complainant's subsidiary under the CHAUSPORT trade mark. Consumers will believe that the website at the Domain Name is in some way connected with, associated with or related to the activities of the Complainant's subsidiary under the CHAUSPORT brand. There is no connection between the Complainant, its subsidiary or the Registrant. Consequently, the Complainant submits that the registration and use of the Domain Name has occurred primarily for the purpose of disrupting the professional activities of a competitor (Complainant and its group companies) or alternatively, for purpose of creating a likelihood of confusion with the name CHAUSPORT. The Complainant thus contends that the registration and use of the Disputed Domain Name is contrary to the provisions of either Article 21(3)(c) or Article 21(3)(d) of Commission Regulation (EC) No. 874/2004.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

In consideration of the Factual Background and the Parties' Contentions stated above, the Panel comes to the following conclusions:

Article 22 of the Regulation (EC) No. 874/2004 provides that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21. In accordance with Article 21 of the Regulation (EC) No. 874/2004, a registered domain name shall be subject to revocation where the 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 and where:
(a) it has been registered by its holder without rights or legitimate interest in the name; or
(b) it has been registered or used in bad faith.

Even though the Complainant does not hold the actual registration for the Registered Trademark, it is the parent company of JD Sports Fashion (France) SAS which is the proprietor of EU trademark "CHAUSPORT". Whilst there is no clear position among panels in ADR.eu matters as regards the right of a licensee or a related company (such as a subsidiary or parent to the registered holder of a trademark) to be considered to have rights in a trademark under the ADR, the practice of WIPO panels in UDRP matters is to recognise the right of such persons in the trademarks under dispute from the particular facts (although relevant evidence is always desirable).

The Panel is willing to infer the existence of an authorisation from JD Sports Fashion (France) SAS from the facts of the case for the Complainant to submit this Complaint and rely on the respective trademark rights in accordance with Article 21 of the Regulation (EC) No. 874/2004.

The Panel accepts that the Domain Name is confusingly similar to a name in respect of which the Complainant has rights recognised by the EU law by virtue of the Registered Trademark. To satisfy the threshold for confusing similarity, the relevant trademark would generally need to be recognisable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms. When comparing the Domain Name and the Registered Trademark, the gTLD .eu portion of the Domain Name should indeed be disregarded since it is a technical requirement of registration. Thus the only difference in the Registered Trademark and the Domain Name is the letter "s" in the end of the Domain Name while the rest is the same letter-by-letter (compare CHAUSPORT versus CHAUSPORTS). For the eye of an average consumer, these two words may even seem identical at first glance.

The Respondent has not filed a Response, and there is no evidence before the Panel of registration of the Domain Name in good faith or any legitimate interest of the Respondent in the Domain Name. According to Article 22(10) of the Regulation (EC) No. 874/2004, failure of any of the parties involved in an ADR proceeding to respond within the given deadlines may be considered grounds for accepting the claims of the other party. Further, Paragraph B10(a) of the ADR Rules states that in the event of a default, the Panel shall proceed to a decision and may consider the failure to comply as grounds to accept the claims of the other party. Under Paragraph B10(b) of the ADR Rules, unless otherwise provided, the Panel shall draw such inferences from a default as it considers appropriate. The Panel shall, under Paragraph B11(a) of the ADR Rules, decide a complaint on the basis of the statements and documents submitted and in accordance with the ADR Rules, the Supplemental ADR Rules and Regulations (EC) No. 733/2002 and No. 874/2004.

The Complainant's arguments as to the lack of legitimate interest are somewhat conflicting: in light of evidence (submitted by the Complainant itself) regarding Respondent having actually used the website associated with the Domain Name for advertising and offering for sale sports footwear it is unclear why the Complainant at the same time argues that the Respondent has not used the Domain Name for offering of goods. Thus the Panel is not convinced by the Complainant's arguments regarding lack of legitimate interest on the side of the Respondent.

The Complainant's arguments as to existence of bad faith on the side of the Respondent are more convincing. There is nothing on the face of the facts, statements and documents in this matter suggesting the Respondent has registered the Domain Name in good faith. There appears to be no use of the Domain Name other than the primary purpose of leading consumers to believe that the website at the Domain Name is in some way connected with, associated with or related to the activities of the Complainant's subsidiary under the true CHAUSPORT brand. Considering that there is no connection whatsoever between the Respondent and the Complainant and the Complainant's subsidiary, it shows that the Respondent's registration and use of the Domain Name arose purely from the wish to create confusion in consumers and thus deprive the trademark proprietor of traffic and revenues in return for its own commercial gain. This indicates existence of bad faith in the meaning of Article 21(3)(d) of Commission Regulation (EC) No. 874/2004.

Once a complainant makes out a prima facie case as to the lack of legitimate interest or the existence of bad faith, the burden shifts to the respondent in the matter to rebut the assertions (See Rotary International v. Strake Bohumil, CAC 4757; Security Center GmbH & Co. KG v. Zheng Qingying, CAC 2986). In the case at hand the Complainant has indeed made a prima facie case as to as to the existence of bad faith on the side of the Respondent. That Respondent has not discharged said burden here as it has failed to come forward with any justification for her selection and registration of the disputed Domain Name.

In light of the above, and in the absence of a Response or any evidence disputing bad faith registration of the Domain Name by the Respondent, the Panel finds that the Respondent has registered the Domain Name in bad faith.

Paragraph B11(b) of the ADR Rules states that if the complainant satisfies the general eligibility criteria (Article 4 (2) (b) of the Regulation (EC) No 733/2002), the domain name may be transferred to the Complainant. General eligibility criteria in this case mean that the complainant should be an undertaking having its registered office, central administration or principal place of business within the EU. The Complainant satisfies this criterion being a company with a registered address in the United Kingdom.

DECISION

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

the domain name CHAUSPORTS.EU be transferred to the Complainant.

PANELISTS

Name	**Triin Toomemets-Krasnitski**

DATE OF PANEL DECISION 2016-09-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: CHAUSPORTS.EU

II. Country of the Complainant: United Kingdom, country of the Respondent: Germany

III. Date of registration of the domain name: 15 January 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word EUTM "CHAUSPORT", reg. No. 008519977, for the term 1 September 2019, filed on 1 September 2009, registered on 22 February 2010 in respect of goods and services in classes 9, 14, 18, 25, 28, 35, 36.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Yes
2. Complainant has failed to make a clear prima facie case as to Respondent's lack of legitimate interests.

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

2. There appears to be no use of the Domain Name other than the primary purpose of leading consumers to believe that the website at the Domain Name is in some way connected with, associated with or related to the activities of the Complainant’s subsidiary under the true CHAUSPORT brand.

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: Even though the Complainant does not hold the actual registration for the EUTM "CHAUSPORT", it is the parent company of the actual trademark proprietor of EU trademark "CHAUSPORT". The Panel inferred the existence of an authorisation from the trademark proprietor from the facts in this case for the Complainant to submit the Complaint and rely on the respective trademark rights in accordance with Article 21 of the Regulation (EC) No. 874/2004.

XII. Is Complainant eligible? Yes