Panel Decision for dispute CAC-ADREU-007237

Case number	CAC-ADREU-007237
Time of filing	2016-07-27 18:05:54
Domain names	praguepissup.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Wild East Travels ApS

Respondent

Organization	Private Individual

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 Respondent claims that there is a dispute between the corporation of which he is Director (UC) and the Complainant, which he accuses of having ousted the trade mark “Pissup” from that company (UC), by trying to register it in its own name, without permission, and breaking an allegedly existing contract between both companies (Complainant and UC).

FACTUAL BACKGROUND

According to the Complainant´s allegations, which were not disputed by the Respondent in his response:

1. Wild East Travels ApS (the "Complainant") is a limited liability company incorporated under Danish law.

2. Its main business is the marketing of travel products in Denmark, Sweden, Germany, France, United Kingdom and the Czech Republic, being Prague the most popular travel destination.

3. The Complainant is the owner, with previous registration in relation to the registration of the domain name in dispute, of several domain names in other registries which include the word "PISSUP", namely: "pissup.dk"; "pissup.com" and "praguepissup.com".

4. In addition, the Complainant is the owner of the application for the registration of the EU trade mark No. 015397706 ("Pissup + picture") and the registration application of the EU word trade mark No. 015397714 ("Pissup"), both filed at the EUIPO on 3 May 2016.

5. These applications for the registration of EU trade marks have not yet been either granted or refused. They are currently pending, waiting for a decision of the EUIPO (according to its website).

6. The Respondent (Mr. Neil Smith) is a Private Individual, resident in United Kingdom, who claims, but without providing any evidence or sign of prove, the following facts:

6.1. The Respondent claims to be the director of the company Universal Consulting Ltd,

6.2. Company Universal Consulting Ltd is the real owner of the trademark "Pissup",

6.3. Trademark “Pissup” allegedly owned by the company Universal Consulting Ltd was just licensed to the Complainant and to other related company, the "Custom Tours GmbH".

7. The Complainant did not respond to the Respondent´s allegations.

A. COMPLAINANT

8. The Complainant claims that he is the owner of several domain names, namely, "Pissup.com" and "Praguepissup.com", which include the word "Pissup".

9. The Complainant furthermore contends that the Complainant applied for the registration of two European Union trade marks, which also include the referred word "Pissup",

10. These facts are previous to the registration, by the Respondent, of the domain name in dispute "praguepissup.eu". Its registration occurred only on 22 May 2016 (cf. EURid Whois).

11. Therefore, in the Complainant's opinion, the domain name in dispute would be identical or confusingly similar with his above referred domain names and also with the application of the two European Union trade marks, whose request evidences he attached with his initial application, and all of these would benefit from anteriority.

12. On the other hand, the Respondent would not have any legitimate interest in the domain name under dispute "because there is no evidence that, prior to the dispute, Respondent used the domain name or a name corresponding to the domain name in connection with the offering of goods or services."

13. Besides, the Respondent allegedly informed the Complainant that the current usage of the domain name in dispute (the mention in the respective website of a "warning for customers of Pissup.com stag holidays") will cease definitely if the Complainant enters into an agreement with the Respondent giving him "a lot more money that he is entitled to."

14. Hence, the Respondent had registered the domain name in dispute in bad faith, since he is using it, in the Complainant's opinion, only to spread false and incorrect information to the Complainant's costumers, which harms his business by giving the wrong impression that, in the future, the Complainant will not be able to fulfil his obligations with the Costumers.

15. According to the Complainant the main purpose of the Respondent is to disrupt the professional activities of a competitor, namely the Complainant.

B. RESPONDENT

16. The Respondent, a Private Individual, claims, fundamentally, that he is the Director of a company named "Universal Consulting Ltd" (UC), that would allegedly be "the holder of the trademark 'Pissup'", but does not indicate in which jurisdiction(s) (which country or countries) that trade mark would be protected in his favour, and does not present a sole evidence (or sign of evidence) of that allegation.

17. This being said, the Complainant ("Wild East Travels ApS") would be a mere license holder of this supposed "Pissup brand", belonging to Universal Consulting Ltd, but no copy of the license agreement was attached with the response.

18. The Respondent also claims that there is a dispute between the corporation of which he is Director (UC) and the Complainant, which he accuses of having ousted the trade mark "Pissup" from that company (UC), by trying to register it in its own name, without permission, and breaking an allegedly existing contract between both companies (Complainant and UC).

19. This plea should be issued by UC (a third party in relation to the present case) against the Complainant during the summer of 2016.

20. The Respondent, a Private Individual, claims, at last, to be acting in the interest of third parties (which means, the "customers of the Pissup brand" and the Company of which he is a Director) and in defence of the value of the brand Pissup itself,

21. Having, allegedly, obtained, by an e-mail of 14 July 2016 (that, again, he did not attach to his response), the acceptance of the Complainant to the essential of the terms that are currently being showed in the praguepissup.eu website.

22. The Complainant websites, however, do not mention this potential plea, whose comeback can, in the Respondent's opinion, harm both the legitimate interests of the respective customers and the goodwill of the Pissup brand itself.

23. The Complainant did not respond to these claims from the Respondent, which cannot be taken as meaning an acceptance of them, especially considering the fact that additional comments or submission of materials are not mentioned in the ADR Rules under these particular circumstances.

DISCUSSION AND FINDINGS

24. The decision must be taken by the Panel based on the evidence presented by the Parties or, at least, based in a prima facie case established by the Complainant.

25. Proving the facts compete, usually, to the one who claims them. Cf. Art. B (7) of the ADR Rules.

26. ".eu ADR is a tool designed for cases of speculative and abusive registrations. It is not applicable for any .eu domain name problem."

27. The revocation – and the possible ownership transfer – of a ccTLD ".eu" could, in this case, be based on its speculative or abusive use or registration, according to Art. 22 of Regulation (EC) No. 874/2004 of 28 April 2004.

28. The registration or the use of a domain name can be considered as speculative or as abusive when it is identical or confusingly similar to a name in respect of which a right is recognized or established with anteriority by national or Community law, such as the rights mentioned in Art. 10 (1) of Regulation (EC) No. 874/2004.

29. Besides that, the domain name in dispute must have been registered by its holder without rights or legitimate interest in the name or registered or being used in bad faith (cf. Art. 21 (1) of Regulation (EC) No. 874/2004).

30. According to the criteria established by this European Regulation, to which the Panel is bound to, the revocation of a domain name based on its speculative or abusive nature can only take place if the Complainant claims and proves that he is the owner of a name identical or confusingly similar with the disputed domain name, which is protected by a prior right in accordance to Art. 10 (1) of Regulation (EC) No. 874/2004.

31. In this case, the only "prior rights" that the Complainant claims in his initial application regarding the name "Pissup" are its several domain names, which include the mentioned expression, and the applications of the European Union trademarks No. 015397706 and No. 015397714.

32. However, the domain names registered in other registries do not establish any rights to the correspondent name and they are not, therefore, considered as "prior rights" in the sense of Art. 10 (1) of Regulation (EC) No. 874/2004, to be able to constitute an obstacle to its registration on the .eu Registry by third parties (cf. .eu Case No. 1375, "rabbin.eu" and .eu Case No. 3032, "seghorn.eu").

33. As stated, for instance, by BETTINGER / WADDELL, Domain Name Law and Practice, 2nd Edition, 2015, p. 1482, "Ownership of a similar, previously-registered domain name is not sufficient basis for establishing rights under .eu Policy."

34. The same can be said regarding a mere application for registration of a Community trade mark (currently, European Union trade mark), since this request can either be accepted or refused.

35. Indeed, the right to the EU trade mark can only be acquired through its registration, and not by it simple request. Art. 6 European Union trade mark Regulation (Council Regulation (EC) No. 207/2009 as amended by Parliament and Council Regulation (EU) 2015/2424) states: "A European Union trade mark shall be obtained by registration".

36. And Art. 9b, 1 of this Regulation states now that "The rights conferred by an EU trade mark shall prevail against third parties from the date of publication of the registration of the trade mark."

37. In the case of the EU trade marks applications for "Pissup" this publication had not occurred before the Complaint was filed. Therefore, as yet, the Complainant has no rights in it and although it is confusingly similar to the disputed domain name, it is not a sufficient basis for a claim under paragraph B.1 (b) (10) A of the ADR Rules (cf. .eu Case No. 1387 "biomark.eu").

38. Which means that a simple request for an EU trade mark does not constitute a valid prior right in accordance to Art. 10 (1) of Regulation No. 874/2004, which refers, in this case, specifically, to the "registered (....) community trademarks", not mentioning mere trademark applications.

39. These applications cannot, for this reasons, lead to the claiming of Art. 21 (1) of Regulation (EC) No. 874/2004 and, eventually, to the revocation of a ccTLD .eu registered later, which proves to be identical or confusingly similar with any of those EU trade mark applications.

40. As a matter of fact, the Complainant does not claim the ownership of any previous valid rights regarding the expression "Pissup", in

which, according to the established in the Regulation (EC) No. 874/2004 and in the ADR Rules adopted by EURid, a request of revocation or transfer of ownership of the disputed domain name "praguepissup.eu" could be sustained.

41. Hence, there is no interest or utility in the verification of the existence of the other legal requisites mentioned in Art. 21 (1) of Regulation (EC) No. 874/2004, that would be essential for the current case proceedings, which are: the lack of legitimate interest in the name and/or the bad faith of the Respondent, regarding the use or the registration of the name Pissup.

42. In conclusion: since the Complainant did not allege or prove to be the owner of any valid prior right, in the sense of Art. 10 (1) of Regulation (EC) No. 874/2004, it's not verified the existence of the first of the essentials requisites of Art. 21 (1) of the above mentioned Regulation, in order to be possible to declare the revocation of the domain name in dispute. This is the reason why, being the Panel forced to sustain its decisions under the Regulation (EC) No. 874/2004 and under the ADR Rules, the present Complaint must, necessarily, be denied.

DECISION

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

the Complaint is Denied.

PANELISTS

Name	Manuel Felipe Oehen Mendes

DATE OF PANEL DECISION 2016-07-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: praguepissup.eu

II. Country of the Complainant: Denmark, country of the Respondent: Great Britain (UK).

III. Date of registration of the domain name: 22 May 2016.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No. 874/2004) on which the Panel based its decision: None. The Complainant did not claim any valid prior rights regarding the name in dispute ("Pissup") that may be considered relevant under this legislation.

V. Response submitted: Yes.

VI. N/A

VII. N/A

VIII. N/A

IX. Other substantial facts the Panel considered relevant: The previous domain names and the mere applications for registration of European Union trade marks, claimed by the Complainant to justify his complain, are not rights about names which could be included among the ones predicted in Art. 10 (1) Regulation (EC) No. 874/2004 and in which the Panel could base a decision in favour of the Complainant.

X. Dispute Result: Complaint denied.

XI. Procedural factors the Panel considers relevant: None.

XII. N/A