Panel Decision for dispute CAC-ADREU-007238

Case number	**CAC-ADREU-007238**
Time of filing	**2016-08-23 00:36:06**
Domain names	**converse.eu**

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Organization	**Goallover Limited**

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 either pending or decided which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainants Converse Inc. and All Star C.V. (hereinafter called “the Complainants”) are the owners of the CONVERSE trademark and trade name. The Complainants states that the rights in the trademark and name are owned in the USA by Converse Inc. and in all other jurisdictions save Japan by All Star C.V. They state that the Converse brand has been in use since 1909.

The Complainants have provided details of trademark registrations for the Converse Mark throughout the world including inter alia the following registrations owned in the EU:

(I) Word EUTM “CONVERSE” No. 009591272, registered on 26 April 2011 in classes 9 and 14;

(II) Word EUTM “CONVERSE” No. 007600117, registered on 11 December 2009 in classes 16, 18, 25 and 35;

(III) Figurative EUTM No. 08630659, registered on 20 March 2014 in class 35.

Additional details have been provided of registrations in the US, the Benelux countries and in the United Kingdom.

The Complainants rely on the above trademark registrations as well as their common law rights arising from their long use of the name to sustain that the subject domain name converse.eu is confusingly similar to the Converse trademark, that the Respondent has no rights or legitimate interest in the subject domain name and that the Respondent is using the domain name in bad faith.

The Respondent has filed a response to the Complaint which contests the complaints as raised and which said response is detailed further below.

A. COMPLAINANT

The Complainant contends that the CONVERSE Mark has been in continuous use since 1909. As set out above it provides details the various trademark registrations including EU registrations. In relation to the disputed domain name it states as follows:

1. The subject domain name is confusingly similar to the Converse trademark and that where the subject domain name incorporates the entire trademark then a finding of confusing similarity is clear.

2. That the respondent has no rights or legitimate interest in the subject domain name. They have exhibited a screenshot of the converse.eu website which is presently not in use. On this basis they contend that they have established a prima facie case that the Respondent has no legitimate or lawful reason for using the Converse mark within the disputed domain name.

3. That the respondent has registered and is using the subject domain name in bad faith. They contend that the respondent has a prior history of registering domain names in order to prevent rights holders from registering those domain names and further contend that the respondents failure to make any active use of the subject domain name is evidence of bad faith. Lastly it contends that there is no legitimate use for the disputed domain name by the Respondent.

B. RESPONDENT

The Respondent has detailed its response to each of the complaints in turn. It makes the following contentions:

1. That the word “converse” is a plain English word which has multiple legitimate uses particularly related to the internet and the provision of online “conversation”.

2. That the Complainants have sought to expand their rights under EUIPO application number 014544837 which said application has been opposed.

3. That there is no likelihood of confusion between the Complainants brand and that of a website providing conversational tools.

4. That the original Respondent Goallover Limited has since been taken over by Leadscale Limited and therefore any claim that the Respondent has a history of infringement are not relevant given these events occurred prior to the transfer of ownership.

5. That Leadscale Limited may use the domain name for the provision of internet related services in the future and is actively monitoring the market for the right time to use the domain name for a service with no grounds for confusion with the Complainants brand.

DISCUSSION AND FINDINGS

The Panel has considered the relevant regulations as set out in Articles 21 and 22 of Regulation 874/2004 and as set out in Paragraph B11 of the ADR rules.

According to article B11(d)(1) of 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 the ADR proceeding that:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and; either
(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name or
(iii) the domain name has been registered or is being used in bad faith.

(i) Identical or Confusingly Similar

The Panel finds from the evidence submitted with the Complaint that the Complainants have established rights in relation to their registered trademarks and their common law rights. Evidence of registration of the trademarks were exhibited in the original complaint. Extensive evidence of usage of the brand name and trademark and advertising of same was exhibited in the complaint. Accordingly the Panel finds that the disputed domain name is identical to one in which the Complainants have rights for the disputed domain name incorporates the Complainants' trademarks in its entirety.

(ii) The domain has been registered by the Respondent without rights or legitimate interest in the name

Under the ADR Rules the burden of proof for the lack of rights and legitimate interests of the Respondent lies with the Complainant. The Complainants in this case have submitted that the Respondent is not currently using and has never used the subject domain name. Evidence of non use was submitted at an Exhibit of the original complaint in the form of a screenshot of a blank web page. The Complainants further submit that the Respondent has no legitimate or lawful reason for use of the disputed domain name.

The Respondent submits that the disputed domain name is a plain English word with a definition that fits perfectly with the provision of

services relating to the core Leadscale Limited activity. It further submits that a google search for the word “converse” returns over 247 million search results. The Panel does not feel the number of search results returned by the word in question bear any relevance to the dispute in hand and notes that all of the first page of search results relate to the Complainants brand name.

Having regard to paragraph B11(e) of the ADR Rules the Panel does not find that the Respondent has met any of the three thresholds set out therein namely:

1. The Respondent has not furnished evidence that prior to any notice of the dispute, it 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.
2. It has not been known by the domain name.
3. The Respondent has not furnished sufficient evidence to ground the claim that it has a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law.

(iii) The domain name has been registered or is being used in bad faith

The Panel has regard to paragraph B11(f)(2)(ii) of the ADR Rules regarding use of the domain name and circumstances that may be taken into consideration. In the present complaint it is clear that notwithstanding the Respondents submissions concerning potential future use there has been no evidence submitted by the Respondent that the disputed domain name is in active use or has been used within the past 2 years.

The Panel also has regard to paragraph B11(f)(2)(i) of the ADR Rules regarding the Respondents pattern of conduct in the past. It is noted that that the ownership and control of the Respondent company has since been transferred to Leadscale Limited. The Respondent therefore has submitted that past conduct is not relevant in this case. It is noted though that it is accepted that Goallover Limited did register domain names that should not have been registered to it and the Panel has noted CAC Case No. 01196 (Memorex.eu) which involved the same original Respondent and referred to some 132 .eu domain names registered by the Respondent.

The Panel accepts that the Respondent has registered the disputed domain name in bad faith and that the condition set forth under Article B11(d)(1)(iii) has been met.

Finally, it should be emphasized that the Complainant All Star C.V. satisfies the general eligibility criteria under Article 4(2)(b) of the Regulation No. 733/2002 given the fact that its principal office is located in the Netherlands.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name CONVERSE.EU be transferred to the Complainant All Star C.V.

PANELISTS

Name	**Duncan Grehan & Partners, Griffin Conor**

DATE OF PANEL DECISION 2016-08-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: converse.eu

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

III. Date of registration of the domain name: 07 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. Word CTM reg. No. 009591272 for the term 10 years, registered on 26 April 2011 in respect of goods and services in classes 09 and 14
2. Word CTM reg. No. 007600117 for the term 10 years, registered on 11 December 2009 in respect of goods and services in classes 16,18,25 and 35

3. Word trademark registered in UK, reg. No. 1486511, filed on 02 January 1992, registered on 14 May 1993 in respect of goods and services in classes 18
4. Word trademark registered in UK, reg. No. 1520038, filed on 24 November 1992, registered on 10 December 1993 in respect of goods and services in classes 25

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. The Respondent has not demonstrated sufficient legitimate interest in the disputed domain name

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Respondent has not shown any active use of the domain within the previous two years and its previous history is noted notwithstanding the transfer in ownership.

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