Panel Decision for dispute CAC-ADREU-007240

Case number	CAC-ADREU-007240
Time of filing	2016-10-06 13:44:03
Domain names	GOTINDER.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization

Respondent

Name	Margret Eagle

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

None.

FACTUAL BACKGROUND

The Complainant, a US corporation, has offered online and mobile dating services under the name “Tinder” since 2012. Its website is at <www.gotinder.com>.

The Complainant’s mobile dating application (“App”) has been downloaded by an estimated 50 million users in some 200 countries. Around 60% of the Complainant’s users are outside North America.

The Complainant owns US trade mark no. 4,479,131 for “TINDER” filed 2 August 2012, in international class 9.

The disputed domain name was registered on 16 February 2014.

The disputed domain name was used for a website which prominently displayed a large graphic consisting of a stylised “tinder” logo, the phrases “Tinder is the fun way to connect with new and interesting people around you” and “Join Tinder Now!” and an outline of a mobile phone with a graphical representation of a dating application. Clicking on the “Join Tinder Now!” button redirected users to a different website, known as <AdultFriendFinder.com>.

The Complainant sent a cease and desist letter to the Respondent by email on 18 May 2016. The Respondent did not respond.

A. COMPLAINANT

Here is a summary of the Complainant’s submissions:

The Complainant spends substantial sums each year to advertise and promote its online dating services and its App. And as a result of its extensive marketing efforts and its continuous use of the “Tinder” mark since 2012, the Complainant has developed substantial rights and goodwill therein.

The disputed domain name is confusingly similar to the Complainant’s trade mark, which it wholly incorporates.

The Respondent lacks rights and legitimate interests in the disputed domain name.

The Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services. Instead, it has

been used to deceive users and misappropriate the Complainant's goodwill.

The Respondent cannot demonstrate a legitimate non-commercial or fair use of the disputed domain name. The Respondent was out for commercial gain.

The Respondent deliberately set out to pass itself off as the Complainant and therefore cannot be said to be commonly known by the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered with actual notice of the Complainant's trade mark rights. The Complainant has used its mark for dating services for some two years before the disputed domain name was registered.

The Respondent has used the Complainant's mark for a website which purports to enable users to join the Complainant's online dating services. Therefore, the Respondent clearly intended to misappropriate the Complainant's mark in order to mislead users into thinking that the Respondent was associated with the Complainant.

Shortly after receiving the Complainant's cease and desist letter, the Respondent changed the registrant email associated with the disputed domain name and attempted to change the registrar. Such evasive action is further evidence of bad faith.

The Complainant seeks revocation of the disputed domain name.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

Introduction

Under Article 21(1) of Regulation (EC) 874/2004 ("the Regulation"), the disputed domain name is subject to revocation if it 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 interests in the name or (b) has been registered or is being used in bad faith.

Rights

The Complainant must first establish a right that "is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1)".

Article 10(1) of the Regulation refers to "prior rights" which are said to include "registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names […]".

The Complainant relies on a US-registered trade mark. Previous panels have taken different approaches as to whether trade marks registered outside the EU can be considered as "prior rights" under Article 10 (1). See, e.g., cases AuntMinnie.com, Ms. Maury Morse v. Jeffrey Leichter, CAC No. 1580, <auntminnie.eu> and PICMG Europe, Eelco van der Wal v. Barbara Baldwin, CAC No. 4478, <picmg.eu>. However, it is unnecessary to reach any conclusion on this point because, although the evidence is somewhat thin and not country-specific, the Panel concludes that the Complainant has narrowly established unregistered trade mark rights for the term "Tinder" within the EU based on its uncontested evidence of enormous worldwide fame, including outside North America. In that regard it should be noted that several European countries, including Denmark, Malta, and the UK, recognize unregistered "common law" rights and numerous Panels have in the past have held that unregistered rights can be the basis of a valid claim, see among others cases HS Automatic v. Zenghui Fuhechan & Zheng Qingying, CAC 5301, <hsajet.eu> and Zoologisk Have v. Name Battery Limited, CAC No. 3942, <copenhagenzoo.eu>.

The disputed domain name is confusingly similar to the Complainant's "Tinder" trade mark as it differs only by addition of the descriptive word "go".

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to a name in respect of which the Complainant possesses a right recognised or established by national and/or EU law.

Lack of Rights or Legitimate Interests.

Under Article 21(1) of the Regulation (a) lack of rights or legitimate interests and (b) registration or use in bad faith are alternative requirements. For reasons explained below, the Panel considers that the disputed domain name has been registered and used in bad faith and so there is no need to separately address lack of rights or legitimate interests.

Bad Faith

The Panel is satisfied that the disputed domain name has been registered and used in bad faith.

The disputed domain name was clearly registered with the Complainant very much in mind. Not only does it reflect the exact variation of the Complainant's trade mark found in the name of the Complainant's own website <www.gotinder.com>, the disputed domain name has been used for a website which plainly set out to impersonate the Complainant and to divert traffic to a third party adult dating website.

Accordingly, the disputed domain name has been intentionally used to create a likelihood of confusion in accordance with Article 21(3)(d) of the Regulation.

Finally, the Panel notes that the Complainant has its seat in the USA. As such the Complainant has not fulfilled the general eligibility criteria of Article 4(2)(b) of Regulation (EC) No. 733/2002. The disputed domain name, which would otherwise have been transferred to the Complainant, is therefore revoked in accordance with remedies sought by the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name GOTINDER.EU be revoked

PANELISTS

Name	**Adam Taylor**

DATE OF PANEL DECISION 2016-10-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: gotinder.eu

II. Country of the Complainant: US, country of the Respondent: France

III. Date of registration of the domain name: 16 February 2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: unregistered trade mark.

V. Response submitted: No

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004): Not considered.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Use of domain name for a website impersonating the Complainant and diverting traffic to a third party website.

IX. Other substantial facts the Panel considers relevant: None.

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

XI. Procedural factors the Panel considers relevant: None.