Panel Decision for dispute CAC-ADREU-007249

Case number	CAC-ADREU-007249
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Domain names	prisjakt.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Schibsted ASA

Respondent

Organization	2 U Import AB

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 has not been made aware of any other pending or decided legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a limited liability company seated in Oslo, Norway.

The Respondent is a limited liability company seated in Alingsås, Sweden.

On August 15, 2013 the Respondent registered the disputed domain name <prisjakt.eu> through eNom Registrar, under which it operates a website for online searches.

On June 9, 2016 the Complainant submitted the Complaint in the subject ADR proceedings.

On June 22, 2016 the Complainant was notified about the formal deficiencies in the Complaint, invited to correct said deficiencies and file the amended Complaint within seven (7) days as of receiving the same notification.

On June 29, 2016 the Complainant submitted the amended Complaint.

On July 04, 2016 the Respondent submitted the Response to the Complaint.

Following the selection of panelist and filing of the panelist's Statement of Acceptance and Declaration of Impartiality and Independence, on July 12, 2016, the Czech Arbitration Court notified the Parties about the appointment of the panel and the projected decision date.

The Case was transmitted to the Panel for rendering the decision. The Panel considers itself properly constituted.

On July 14, 2016 the Respondent submitted a Challenge of Panelist within the prescribed deadline. This form was empty and contained no arguments. On July 19, 2016 the Respondent informed the Court that the challenge was submitted by mistake.

A. COMPLAINANT

The Complainant asserts that:

-The Complainant is a Norwegian limited liability company active in the media market.

-The Complainant is the owner of Scandinavia's largest newspaper Aftonbladet.
-Since 2006, the Complainant has through their subsidiary Schibsted Tillväxtmedier AB, owned and managed the site prisjakt.nu Sweden's largest site for comparing the price of goods and services.

-The Complainant is the alleged holder of the following trademarks:

(i) Mark: Prisjakt; Territory: SE; Application no.: 2009-07328; Class: 35; Application date: September 25 , 2009;
(ii) Mark: PRISJAKT; Territory: SE; Application no: 2016-01827; Class: 9,35,38,42; Application date: March 10, 2016; Mark: PRISJAKT; Territory: NO; Application no: 201603601; Class: 9,35,38,42; Application date: 10-03-2016; Mark: Prisjakt; Kunnskap før kjøp; Territory: NO; Application no: 201005935; Class: 35,38,41; Application date: June 03, 2010.

-The Complainant owns the rights over the wording Prisjakt. The domain name prisjakt.eu is identical to the Complainant's domain prisjakt.nu and the prior rights mentioned above. The addition of a top-level domain, for example ".eu", is irrelevant for the assessment of confusing similarity between a trademark and the domain names.

-The Respondent does not have any rights over the trademark Prisjakt, nor is the Respondent a licensee of the Complainant. The Complainant has not given the Respondent any permission to register the trademark as a domain name.

-Controls made on the website of the disputed domain name at http://prisjakt.eu/ has concluded that the site is used to conduct business that competes with the Complainant's business.

-The Complainant has the exclusive right to use the mark Prisjakt for price comparisons as can be seen by the registered rights above. The usage of the domain name prisjakt.eu strongly suggests that the domain name was registered with the mark Prisjakt in mind and in order to make a profit from misleading consumers searching for information about the Complainant's business.

-There is no evidence that the Respondent has been commonly known by the domain name or is making a legitimate non-commercial or fair use of the domain name. Considering all of the above, it is obvious that the Respondent has no right or legitimate interest in respect of the disputed domain name prisjakt.eu, which is the subject of the Complaint.

-The Complainant's trademarks were registered well before the Respondent became the owner of the domain name prisjakt.eu.

-The Respondent was well aware of the Complainant's trademarks and business when registering the domain name. The Complainant was using the Prisjakt trademark at the domain name prisjakt.nu as early as 2006, which means that they were using the trademark for at least 7 years before the domain prisjakt.eu was registered. In addition, the fact that the website of the disputed domain name includes the same sort of business as the Complainant's website prisjakt.se implies knowledge of the Complainant's trademarks and business.

-The domain prisjakt.eu is identical to the Complainant's rights and their website prisjakt.nu. The Respondent is trying to take advantage of the Prisjakt trademark in order to draw traffic to its website. Therefore, the Complainant considers that the website has been registered to commercially profit from the likelihood of confusion between the trademark and the domain name.

-A cease and desist letter was sent to the Respondent by the Complainant on March 03, 2016 without receiving any answer.

-All of the above mentioned circumstances strongly suggest that the disputed domain name has been registered and used in bad faith by the Respondent.

-The complaint requests that the domain is transferred to the Complainant.

B. RESPONDENT

The Respondent asserts that:

-The Respondent is a small company with two employees that mainly import mobile protection and sell the same in their online shop.

-The Respondent is the registrant of the domain prisjakt.eu since August 15, 2013.

- The Respondent uses the domain name prisjakt.eu to have a site where a quick search on deals (for an example mobile phones) is offered. At the same time, the Respondent's own shop with protection for mobile phones is promoted. Furthermore, the Respondent is earning a few kroner on AdSense ads.

-The Respondent does not compare prices like the Complainant does on prisjakt.nu.

-The Respondent never had any plan to compete with prisjakt.nu.

-The Complainant cannot have a patent to the Swedish words "pris" and "jakt", which translated to English means "price" and "hunt", or Pricehunt in one word.

-The Respondent also runs a few more sites with news and deals with Google Custom Search (such as http://datamarknad.se/; http://mobilmarknad.se/)

-The Complainant claims that the Respondent did not answer to the Complainant, although the Respondent answered every time.

-The Respondent offered to sell the domain to the Complainant for 50,000 SEK.

-The Respondent has saved all the email correspondence with the Complainant (in Swedish), and they can submit a copy of the same to the Panel if the same documentation would be of the interest.

-The Respondent's offer to sell the domain name still stands.

DISCUSSION AND FINDINGS

1. A DOMAIN NAME IDENTICAL OR CONFUSINGLY SIMILAR TO A NAME IN RESPECT OF WHICH A RIGHT IS RECOGNIZED

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the Response, Regulation (EC) No. 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain ("Regulation"), Commission Regulation (EC) No. 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and principles governing the registration ("Commission Regulation"), .eu Alternative Dispute Resolution Rules of the Czech Arbitration Court ("ADR Rules"), Supplemental ADR Rules of the Czech Arbitration Court ("Supplemental Rules") and other applicable substantive law, pursuant to Article 10 (1) of the Commission Regulation.

Article 22(1) of the Commission Regulation provides that any party may initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21 of the same regulation. In Article 21(1) of the Commission Regulation it is stated that 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 recognized 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.

Articles 21(2) and 21(3) set out a number of circumstances which, without limitation, may be effective to demonstrate the existence of the legitimate interest within the meaning of Article 21(1)(a), as well as of bad faith within the meaning of Article 21(1)(b)of the Commission Regulation. The ADR Rules contain similar rules that reflect the above stated rules from the Commission Regulation.

According to the Commission Regulation, ADR Rules and previous practice established in .eu ADR proceedings (see relevant decisions in cases CAC 06457, CAC 6516, CAC04478), the burden of proof is on the side of the Complainant, i.e. the Complainant must establish the existence of the aforementioned requirements envisaged in Article 21(1) of the Commission Regulation. The standard of proof in the majority view of .eu ADR Panels and in this Panel's view, is that an assertion is to be proven on the balance of probabilities (more likely to be true than not). With regard to legitimate interest within the meaning of Article 21(1)(a), the majority view, with which this Panel concurs, is that the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to a respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If a respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied the requirement set out in Article 21(1)(a) of the Commission Regulation. If a respondent does come forward with some allegations or evidence of relevant rights or legitimate interest, the panel then weighs all the evidence, with the burden of proof always remaining on a complainant.

1. Identical or confusingly similar

The first requirement under Article 21(1) of the Commission Regulation is to establish whether the disputed domain name is identical or confusingly similar to a name in respect of which the Complainant has the right recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1) of the Commission Regulation ("Prior rights").

Under Article 10(1) of the Commission Regulation, Prior rights shall be understood to include, inter alia, 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, family names, and distinctive titles of protected literary and artistic works.

In line with Article B1(b)(9) of the ADR Rules, the Complainant is explicitly required to specify names in respect of which a right is recognized or established by the national law of a Member State and/or Community law. For each such name, describe exactly the type of right(s) claimed, specify the law or law(s) as well as the conditions under which the right is recognized and/or established.

Furthermore, Article B1(b)(16), the Complainant must annex any documentary or other evidence, including any evidence concerning the rights upon which the Complaint relies, together with a schedule indexing such evidence.

Although the ADR Rules, other than the aforementioned, do not contain more detailed provisions about said documentary and other evidence, this Panel holds that Sections 11 – 17 of the Sunrise Rules, i.e. EU Registration Policy and the Terms and Conditions for Domain Name Applications made during the Phased Registration Period issued by EURid („Sunrise Rules") could serve as indicator of the type of documentary and other evidence which could have been used to establish the existence of the Complainant's Prior rights.

As a matter of establishing essential factual relations in this case the Panel will proceed now to assessing the level of similarity of the domain names in dispute. When comparing the domain names prisjakt.eu and prisjakt.nu, it is difficult to escape the conclusion that that the two domain names are identical and Panel accepts the Complainant's assertions in that sense. Both domains consist of the word "prisjakt" that in turn is composed of two generic words denoting "price" and "hunt" in Swedish language. In relation to the extension .eu and .nu, it has to be affirmed that these domain name suffixes do not have any distinctive character and therefore cannot contribute to making a substantial difference between the domain names prisjakt.eu and prisjakt.nu. Considering the fact that the domains are identical, there is undoubtedly a high risk of confusion among consumers and in the market in general. The Panel also acknowledges the evidence demonstrating that the Complainant's website hosted at the domain prisjakt.nu is a well visited and well recognized web site keeping the 39th position of the most visited web sites in Sweden.

In the subject ADR proceeding, the Complainant claims prior rights on the basis of trademarks. The first issue with that claim is that Complainant is not the owner of the alleged trademark rights he invokes nor do they provide evidence of their title and standing to this proceeding. The owner is the Complainant's alleged subsidiary Schibsted Tillväxtmedier AB, which allegedly also owns and manages the site prisjakt.nu. However, absence of underlying evidence for these assertions is not the only shortcoming in the chain of titles that Complainant failed to establish.

According to the findings of the Panel the Complainant not only failed to present evidence related to the title of those rights, but there are legal deficiencies related to the rights themselves. Namely, the trademark application no. 2009-07328 filed with the Swedish IP Office (PRV) was refused as well as the trademark application no. 201005935 filed with the Norwegian IP Office (NIPO). With regard to the Swedish trademark application 2016-01827 and the Norwegian trademark application 201603601 that are currently pending, it should be emphasized that not only did they not mature into granted trademark rights, but in addition the applications were filed on March 10, 2016 and as such cannot be considered prior rights even if they would be granted in the future. Furthermore, according to the findings of the Panel, the applicant of all the mentioned trademarks and trademark applications is Swedish company Prisjakt Sverige AB and not the Complainant or its alleged subsidiary Schibsted Tillväxtmedier AB. Again, no chain of title to the invoked rights has been demonstrated to the Panel.

Further in relation to establishing prior rights, no evidence was filed in support of the existence and ownership over any valid prior rights, i.e. registered trademarks, unregistered trademarks, or trademark applications. Other than the previously mentioned claims and assertions, the Complainant failed to prove the ownership of the domain name prisjakt.nu, directly or through its subsidiary Schibsted Tillväxtmedier AB. In other words, according to the findings of the Panel, the Complainant did not produce any proof that demonstrates the connection between Schibsted Tillväxtmedier AB and/or Prisjakt Sverige AB as the rightful owner of the refused and pending trademark applications.

Thus, in contravention to the provision of Article 14 of the Commission Regulation (EC) No 874/2004 (as amended) the Complainant failed to demonstrate by documentary evidence in the Complaint, Amended Complaint or any Annexes to the same, the exact type/nature of the Prior right claimed (e.g. whether name Prisjakt it invokes is a registered national or community trademark,

unregistered trademark, trade name, business identifier etc.). Although the Complainant, in its cease and desist letter dated March 07, 2016 does mention company name Prisjakt Sverige AB, a company allegedly registered in Sweden on August 20, 2004 there is no claim to this right as a basis for the Complaint, nor is there any verifiable documentary evidence produced in support of these assertions in spite of the possible strength of that particular argument. Consequently, the Panel was not able to consider this potential claim.

Accordingly, the Complainant failed to establish legal basis under any law(s) and conditions under which such right would be recognized and/or established by the national law of a Member State and/or Community law (which the Complainant, as stated earlier, is explicitly required to do under Article B1(b)(9) of the ADR Rules). The Complainant also failed to annex any documentary or other evidence which would confirm existence of such Prior rights under the national law of a Member State and/or Community law (the Complainant is explicitly required to annex such evidence under Article B1(b)(9) of the ADR Rules). The Complainant failed to do so, even after the Czech Arbitration Court explicitly notified the Complainant about said deficiencies in the Complaint by means of the Notification of Deficiencies in Complaint of June 22, 2016 and invited the Complainant to remedy the same in the amended Complaint. The Complaint was amended on June 29, 2016 without providing further verifiable documentary evidence in the above sense.

In such circumstances, this Panel finds that the Complainant failed to prove the existence of its Prior right(s). Therefore, this Panel finds the Complainant did not prove the first requirement envisaged under Article 21(1) of the Commission Regulation, i.e. that the disputed domain name is identical or confusingly similar to a name in respect of which the Complainant has the right recognized or established by national and/or Community law.

In this Panel's view, and as elaborated above, the Complainant had sufficient time an opportunity to specify the exact type/nature of the Prior right claimed; to identify the law(s) and conditions under which such right would be recognized and/or established by the national law of a Member State and/or Community law; as well as to annex documentary or other evidence which would confirm existence of such Prior rights under the national law of a Member State and/or Community law. However, the Complainant failed to do so within the provided time frame. For that reason, this Panel did not find it necessary to exercise its right from Article B8 of the ADR Rules Article and invite the Complainant to do so once again.

2. RIGHTS OR LEGITIMATE INTEREST / BAD FAITH

Having in mind the above said, it is not necessary for this Panel to proceed further to examine whether the Respondent has any rights or legitimate interest in the disputed domain name or whether the disputed domain name has been registered and/or used in bad faith. Consequently, although the content of the Response was examined the Panel will not proceed to discuss it on the merit.

It is also not necessary for this Panel to examine whether the Complainant meets the eligibility criteria set out in Article B11(b) of the ADR Rules, which is all in line with the previous practice established in .eu ADR Proceedings (see relevant decisions in cases CAC 03024, CAC 04478, CAC 05534, CAC 06343).

The Panel shall, therefore and in accordance with the above, proceed directly to deciding the present case.

DECISION

For all the foregoing reasons, in accordance with Article B12(b) of the ADR Rules, the Panel orders that

the Complaint is Denied.

PANELISTS

Name	**VUKMIR & ASSOCIATES, Mladen Vukmir**

DATE OF PANEL DECISION 2016-07-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <prisjakt.eu>

II. Country of the Complainant: Norway; country of the Respondent: Sweden

III. Date of registration of the domain name: August 15, 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: the Complainant failed to proof in the Complaint or any annexes to the same, the existence of the Prior right claimed. The Complainant also failed to annex any documentary or other evidence that would confirm the ownership structure of its affiliated companies.
V. Response submitted: Yes
VI. Domain name/s is/are neither identical nor confusingly similar to the protected right/s of the Complainant (as stated earlier, the Complainant failed to prove in the Complaint or any annexes to the same, the existence of the prior right and the ownership structure of its affiliated companies (domain name holder, trademark applicant).
VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Not necessary to examine
VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Not necessary to examine
IX. Other substantial facts the Panel considers relevant: None
X. Dispute Result: Complaint denied
XI. Procedural factors the Panel considers relevant: None