Panel Decision for dispute CAC-ADREU-007258

Case number	CAC-ADREU-007258
Time of filing	2016-10-05 16:02:19
Domain names	codeproject.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	

Respondent

Name	Przemysław Malak

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant in this proceeding is CodeProject Solutions Inc. The submitted evidence in the case before the Panel demonstrates that the Complainant is the owner of the following registered trademarks:

THE CODE PROJECT, Canadian trademark with registration number TMA742221, filing date March 25, 2008 and registration date June 18, 2009.

THE CODE PROJECT, US trademark with trademark number 3727225, filing date August 21, 2008 and registration date December 22, 2009.

CODEPROJECT, US trademark with registration number 4144576, filing date August 12, 2009 and registration date March 6, 2012.

CODEPROJECT, Canadian trademark with registration number TMA794924, filing date August 6, 2009 and registration date April 6, 2011.

CODEPROJECT (device), European Union trademark with registration number 012860318, filing date May 8, 2014 and registration date September 22, 2014.

CODEPROJECT, European Union trademark with registration number 012856472, filing date May 7, 2014 and registration date September 24, 2014.

CODE PROJECT (device), Canadian trademark with registration number TMA916804, filing date November 1, 2012 and registration date October 13, 2015.

CODEPROJECT SOLUTIONS (device), Canadian trademark with registration number TMA929464, filing date November 1, 2012 and registration date February 19, 2016.

The Respondent in this proceeding is Przemyslaw Malak. On August 27, 2010 the Respondent registered the disputed domain name <codeproject.eu>.

The Czech Arbitration Court ("CAC") acknowledged receipt of the Complainant's Complaint (filed on July 1, 2016) regarding the disputed domain name on July 8, 2016. The formal date of the commencement of the ADR proceeding is July 20, 2016. On September 7, 2016, CAC acknowledged receipt of the Respondent's Response filed on September 5, 2016. On September 21, 2016 the Complainant filed a late supplemental filing. Pursuant to paragraph 8 of the ADR Rules, the Panel may admit, in its sole discretion, further statements or documents from either of the Parties. In that regard, supplemental fillings can be accepted only under specific circumstances.

Considering that both parties already submitted statements and evidence, the Panel has decided that it would be inappropriate to admit the Complainant's non-standard communication on the basis that it is presented too late in the ADR process without any good reason and there do not appear to be any exceptional circumstances that would justify delaying the issue of a decision.

A. COMPLAINANT

The Complainant is a company incorporated under the laws of Canada. The Complainant was established on April 1, 2004. On November 10, 1999 the Complainant registered the domain name <codeproject.com>. The Complainant's website is one of the world's largest English spoken communities for software developers with over 12 million members. In 2015, the Complainant's website was visited over 50 million times.

The Complainant has a number of trademark registrations consisting of variations of "Code Project".

The Respondent registered as a member of the Complainant's community on May 28, 2008. When creating his profile, the Respondent accepted to comply with the Complainant's "Terms of Service" which, among other things, stated that CODEPROJECT is a trademark belonging to the Complainant.

On August 27, 2010, the Respondent registered the disputed domain name and five days later, on September 1, 2010, the Respondent registered the Polish company name CODEPROJECT PRZEMYSŁAW MALAK.

On the website to which the disputed domain name resolves, the Respondent offers services as application development for Android, iOS and Windows Phone as well as hardware, desktop and website applications. At the end of 2014, the Respondent's website changed from light grey to orange, which is the main colour of the Complainant's website.

The Respondent's website is not well known. It has a Google PageRank of 0/10.

In November 2013, the Complainant discovered that the Respondent has registered the disputed domain name. In May 2014 the Complainant applied for trademark registrations for CODEPROJECT within the European Union. On October 13, 2014, the Complainant sent a cease and desist letter to the Respondent and requested that the Respondent would change his company name and transfer the disputed domain name to the Complainant. The Respondent did not comply with the Complainant's request but did not rule out the possibility resolving the case amicably. On March 10, 2015, the Complainant proposed that the Respondent would transfer the disputed domain name and that the Complainant would assist the Respondent with registering a new domain name as long as the costs would not exceed USD $1 000. In addition, the Complainant would provide a link to the Respondent's new website. The Respondent rejected the Complainant's proposal.

The disputed domain name is identical to the Complainant's European trademark registration number 012856472 and confusingly similar to the European trademark registration number 012860318. The fact that the disputed domain name predates the Complainant's trademark registrations is of no relevance as it is sufficient that the Complainant has rights in a mark at the time of filing the Complaint.

The Complainant maintains that it was the holder of a right even before the above mentioned trademark registrations as a result of the Polish unfair competition Act which recognises and provides protection to priority rights, such as trade names and unregistered rights.

The Respondent has no right or legitimate interest in the disputed domain name, primarily since the Respondent is not well-known by the disputed domain name and secondly, the Respondent is not making a non-commercial or fair use of the disputed domain name without intent to mislead consumers. Since the second-level of the disputed domain name is identical to the second-level of the Complainant's domain name, the risk of confusion is extremely high. The risk of confusion increases even more when looking at the website's contents. Both websites target IT consultants and software developers and both websites are in English. Furthermore, an orange colour scheme can be found on both websites. Internet users may believe that the Respondent's website is established by the Complainant.

As mentioned above, when the Respondent registered the disputed domain name, the Respondent was aware of the Complainant and the Complainant's trademark because the Respondent was a registered member of the Complainant's community. As a member, the

Respondent accepted the Complainant's "Terms of Service" and by registering the disputed domain name the Respondent not only acted in bad faith but also in violation of the "Terms of Service".

By using the term "codeproject" as a domain name for a website offering software development services, the Respondent has intentionally intended to create confusion, because "codeproject" is well-known among IT-consultants and software developers around the world.

B. RESPONDENT

The Respondent conducts business as a sole entrepreneur under the name CODEPROJECT PRZEMYSŁAW MALAK. The Respondent registered the business activity on September 1, 2010. According to the "Central Register and Information of Economic Activity of Classification of Activities" the main business activity of the Respondent is software development.

As part of the Respondent's plan to start the business activity, the Respondent registered the disputed domain name on August 27, 2010. The main purpose of the website, to which the disputed domain name resolves, is to market the Respondent's software developing services and to generate clients. The Respondent's website targets entrepreneurs and natural persons who are not professionals in software development. The Respondent's website has no forum and no possibility to create any kind of personal profile. The website displays the contact details of the Respondent. Despite the above, the website does not generate any large amount of internet traffic nor does it generate many clients.

The Complainant's website, on the other hand, is a platform dedicated to software developers who exchange experiences and ideas in a forum. The Complainant's website targets IT professionals and not internet users who are browsing the internet to find a software developer.

The Complainant has stated that it has several trademarks. The trademarks registered in Canada and USA are not protected under Polish or European law. The Complainant's European trademarks did not exist when the Respondent registered the disputed domain name in 2010 as they were registered four years later in 2014.

The Respondent claims that none of the requirements stipulated in article 9 of the "Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark" are satisfied and consequently there is no infringement of the Complainant's trademark under EU law.

Since the Respondent's business name is the same as the disputed domain name, the Respondent has a legitimate interest in the disputed domain name.

The Respondent did not register the disputed domain name in bad faith. The aim has never been to attract internet users, for commercial gain, to the Respondent's website by creating a likelihood of confusion. The websites are not competing and do not target the same users. It would be pointless for the Respondent to attract other IT professionals to the website.

DISCUSSION AND FINDINGS

The Complainant must, in accordance with Article 21.1 of Commission regulation (EC) No. 874/2004 and Paragraph B 11 (d)(1) of the ADR Rules, demonstrate that the domain name <codeproject.eu> is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognized or established by the national law of a member state and/or Community law and either (a) the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name; or (b) the domain name has been registered or is being used in bad faith.

The Panel notes that the Respondent's registration of the disputed domain name predates the priority date of the Complainant's registered EU trademarks. However, in order to comply with the requirements of Article 21.1 of Commission regulation (EC) No. 874/2004 and the ADR Rules it is not necessary to provide evidence of a "prior right" but it is sufficient to prove a right "recognized or established by national and/or Community law". Consequently, the registration of a domain name before the Complainant acquires trademark rights in the name does not in itself prevent a finding of identity or confusing similarity. It is sufficient that the Complainant has rights in the mark at the time when the Complaint is made.

The Complainant is, according to the submitted evidence, the owner of the trademark CODEPROJECT. The disputed domain name <codeproject.eu> contains the Complainant's registered trademark CODEPROJECT in its entirety.

Having the above in mind, it is the opinion of the Panel that the disputed domain name <codeproject.eu > is identical to the trademark of

the Complainant which is recognized within the meaning of Paragraph B.11(d)(1) of the ADR Rules.

It has been argued by the Complainant that the disputed domain name has been registered by the Respondent without rights or legitimate interest to the name. On the other hand, the Respondent has submitted evidence indicating that the Respondent conducts business as a sole entrepreneur under the registered name CODEPROJECT PRZEMYSŁAW MALAK. The disputed domain name <codeproject.eu> consists of the term "codeproject" which is part of the Respondent's company name. The Respondent has been using the disputed domain name commercially to market software developing services offered by the Respondent.

Thus, in the light of the above, the Respondent has invoked circumstances which demonstrate rights or legitimate interests in respect of the disputed domain name in accordance with the requirements of Article 21.2 of Commission regulation (EC) No. 874/2004 and Paragraphs B11(d)(1)(ii) and B11(e)(2) of the ADR Rules. Based on the evaluation of all the evidence presented, the Panel finds that the Respondent has successfully demonstrated rights or legitimate interest to the domain name for the purposes of Paragraph B11(d)(1)(ii) of the Rules.

The third element to be considered under Paragraph B11(d)(1)(iii) of the Rules is whether the disputed domain name has been registered or is being used in bad faith. Bearing in mind that it is only necessary for a Complainant to succeed on either the second element under Paragraph B11(d)(1)(ii) or the third element under Paragraph B11(d)(1)(iii), it is still technically possible for a Complainant to succeed even if a Respondent has been found to have rights or legitimate interests.

Although there is no evidence demonstrating that the Complainant owned a right recognized or established by the national law of a member state and/or EU law at the time when the Respondent registered the disputed domain name, there are exceptional circumstances in the case that cannot be disregarded when it comes to the third element under Paragraph B11(d)(1)(iii).

The Respondent's registration of the disputed domain name predates the registration of the EU trademark rights relied upon by the Complainant. Typically, it is extremely difficult to establish bad faith in circumstances where a Respondent's registration of a disputed domain name predates the registration of a trademark right. However, according to the Overview of CAC panel views, bad faith can, in certain instances, be found if the Respondent has registered the disputed domain name in anticipation that the Complainant would wish to secure the disputed domain name. According to the decision Jager & Polacek GmbH v. Redtube, CAC 5892 <redtube.eu>, bad faith may be present if the term, although not protected by a registered trademark, has been used by the Complainant in a trademark sense (i.e. in a non-descriptive and non-generic sense to refer to the origin of the relevant services) and the Respondent was aware of such use and the Respondent sought by reason of the registration to take unfair advantage of that non-descriptive and non-generic term.

The evidence in this particular case indicates that the Respondent, prior to registering the disputed domain name, entered an agreement with the Complainant in order to become a member of the Complainant's forum at <www.codeproject.com> and accepted to comply with the "Terms of Service" which explicitly stated that CODEPROJECT is a trademark of the Complainant. Although CODEPROJECT was not registered as a EU trademark at the time, the circumstance that the Respondent accepted the Complainant's "Terms of Service", suggests that the Respondent was clearly aware that the Complainant used the term CODEPROJECT as a trademark in a trademark sense when registering and using the disputed domain name. The fact that the Respondent had this knowledge when registering the disputed domain name cannot be ignored and the panel is satisfied that the Respondent would never have registered the disputed domain name had it not been for the fact that the Respondent knew that it was used as a trademark by the Complainant. In addition to being aware of the Complainant's use of the term in a trademark sense, the Respondent created a website with an orange colour scheme similar to the one used on the Complainant's website. Thus, the evidence in the case indicates that the aim of the Respondent's domain name registration was to take advantage of any possible confusion between the disputed domain name and any potential rights of the Complainant.

Consequently, in the circumstances of this particular case, on the balance of probabilities, the Panel concludes that the Complainant has succeeded in proving that the disputed domain name was registered and used in bad faith for the purposes of Paragraph B11(d)(1)(iii) of the Rules.

The Panel notes that the Complainant has its seat in Canada. 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.

DECISION

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

PANELISTS

Name	Johan Carl Sjöbeck

DATE OF PANEL DECISION 2016-10-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: codeproject.eu

II. Country of the Complainant: Canada, country of the Respondent: Poland

III. Date of registration of the domain name: 27 August 2010

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Word trademark registered in EU, reg. No. 012856472, for the term CODEPROJECT, filed on 7 May 2014, registered on 24 September 2014 in respect of goods and services in classes 9, 35, 38, 41 and 42.
2. Figurative trademark registered in EU, reg. No. 012860318, for the term CODEPROJECT, filed on 8 May 2014, registered on 22 September 2014 in respect of goods and services in classes 9, 35, 38, 41 and 42.

V. Response submitted: Yes

VI. Domain name is identical 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. Why:The disputed domain name consists of a term which is part of the Respondent's company name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Prior to registering the disputed domain name, the Respondent entered an agreement with the Complainant in order to become a member of the Complainant's forum and accepted to comply with the "Terms of Service" which explicitly stated that CODEPROJECT is a trademark of the Complainant. Although CODEPROJECT was not registered as a EU trademark at the time, the circumstance that the Respondent accepted the Complainant's "Terms of Service", suggests that the Respondent was clearly aware that the Complainant used the term as a trademark in a trademark sense when registering and using the disputed domain name. The evidence in the case indicated that the aim of the Respondent's domain name registration was to take advantage of any possible confusion between the disputed domain name and any potential rights of the Complainant.

IX. Other substantial facts the Panel considers relevant: The Respondent created a commercial website with an orange colour scheme similar to the one used on the Complainant's website.

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

XI. Procedural factors the Panel considers relevant:

XII. Is Complainant eligible? No