Panel Decision for dispute CAC-ADREU-007489

Case number	CAC-ADREU-007489
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Domain names	harrywinston.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	Harry Winston, Inc.

Respondent

Name	Ana Piccio

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.

FACTUAL BACKGROUND

The Complainant, Harry Winston, Inc., is the owner of jewellery and wristwatch brand based in the United States. It is the subsidiary of the Swiss company The Swatch Group AG.

The Complainant is the owner of various trademarks registrations for the word mark HARRY WINSTON in the United States and the European Union including: (i) the European Union trademark number 006476634 registered on 17 September 2008; (ii) and the United States Patent and Trademark Office registration number 3355622, registered on 18 December 2007 (based on a first use in commerce in 1948).

The Respondent registered the <harrywinston.eu> domain name ("disputed domain name") on 16 September 2016.

On 9 February 2017, the Respondent sent an email to The Swatch Group AG stating the following: "We own the domain name www.harrywinston.eu and think it would be a great fit for your business!". In further correspondence between 17 to 24 February 2017, The Swatch Group AG on behalf of the Complainant advised the Respondent that the Respondent's ownership of the disputed domain name was infringing the Complainant's intellectual property rights and requested the transfer of the disputed domain name. The Respondent offered the transfer of the disputed domain name in exchange for an initial price EUR 3500, which was later reduced to EUR 2500 and EUR 1999.

On 2 May 2017, Harry Winston, Inc. filed its Complaint with the Czech Arbitration Court. The Complaint was later amended on 15 May 2017, seeking the transfer of the disputed domain name to the Complainant's parent company, The Swatch Group AG.

The amended Complaint, the Commencement of the ADR proceeding and the information on how to access to the online platform including the user name and the password of the Respondent were sent to the postal address of the Respondent stated in the Verification from EURid. The notification of this proceeding was deemed to have been delivered in accordance with the paragraph A2(e)(3) of the ADR Rules on June 5, 2017. The time-limit for submitting the Response therefore expired on July 17, 2017.

The Respondent's default was notified on 18 July 2017.

On 27 July 2017 and after receiving the Statement of Acceptance and Declaration of Impartiality the Czech Arbitration Court appointed David J.A. Cairns as a Single Member Panel. On 31 July 2017, the Case File was forwarded to the Panel.

The Panel entered the landing page associated to the disputed domain name on 7 August 2017. The landing page contained various sponsored links, including links to websites offering jewellery for sale. It also contained a statement that the disputed domain name was for sale.

A. COMPLAINANT

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's HARRY WINSTON trademark. The Complainant states that the .eu top level domain is irrelevant for this component of the test, and so the disputed domain name is identical to the Complainant's HARRY WINSTON trademark. The Complainant considers that the Internet users may be misled to think that the disputed domain name is endorsed, sponsored or affiliated with the Claimant's trademark.

The Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name. It states that there is no legitimate offering of goods or services as the disputed domain name is a pay-per-click website which diverts the users to other sites that are not associated to the Complainant's business and in some cases are owned by its competitors. It also states that the Respondent is not commonly known by the disputed domain name, and nor does it operate a business or organisation under the HARRY WINSTON name, nor own any trademark rights in the HARRY WINSTON name.

The Complainant further contends that the Respondent is not making a legitimate, non-commercial or fair use of the disputed domain name without intent for commercial gain. It states that the pay-per-click links are not used in a generic or descriptive meaning, as they redirect consumers to websites offering the sale of jewellery and other luxury items. The Complainant considers that the Respondent is using the website to confuse and mislead the Complainant's consumers, and to harm the HARRY WINSTON trademark.

The Complainant states that the Respondent registered the disputed domain name in bad faith for the following reasons: (i) the Respondent registered the disputed domain name with actual or constructive notice of the Complainant's rights through the existence of the Complainant's HARRY WINSTON trademark; (ii) the Respondent is obtaining commercial gain from the use of the disputed domain name by receiving compensation through the pay-per-click system; (iii) as owner of the disputed domain name, the Respondent is solely responsible of its content and usage; (iv) additional evidence of the Respondent's bad faith is seen in its attempts to sell the disputed domain name. The Complainant refers to the fact that the Respondent contacted the Complainant in order to sell the disputed domain name, and publicly advertises the sale of the disputed domain name on the website; and (v) the Complainant contends that the Respondent has already registered other domain names related to well-known trademarks. It states that this constitutes a pattern of behaviour, which is further evidence of the Respondent's bad faith.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

The European Commission Regulation (EC) Nº 874/2004 of 28 April 2004 (the "Regulation") provides for an ADR procedure in respect of allegedly speculative or abusive domain name registrations. Article 21 of the Regulation describes speculative and abusive registrations.

Article 21(1) states:

"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 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 interest in the name; or
(b) has been registered or is being used in bad faith."

Article 10(1) includes as 'prior rights', inter alia, the registered national and community trademarks.

The Panel is required to decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules (paragraph B.11(a) of the .eu Alternative Dispute Resolution Rules ("ADR Rules"). Paragraphs B.11(d), (e) and (f) of the ADR Rules state the same legal requirements set out in Articles 21(1), (2) and (3) of the Regulation.

A. The Complainant's Rights:
The Panel accepts that the Complainant is the owner of the trademark registrations for the word HARRY WINSTON referred to above,

and therefore has a right recognised and established by the EU law in the trademark HARRY WINSTON.

B. Identical or Confusingly Similar:
The Regulation and the ADR Rules require a comparison between the trademark in which the Claimant has rights (in this case, HARRY WINSTON) and the disputed domain name. The disputed domain name is formed by the personal name “Harry Winston” followed by the top level domain (“.eu”) suffix. For the purposes of this comparison the .eu suffix should be disregarded in accordance with the practice of .eu disputes panels.

On this basis, the Panel finds that the disputed domain name is identical with the Complainant’s HARRY WINSTON trademark.

C. Rights or Legitimate Interests:
The Panel notes the following circumstances in relation to any possible rights or legitimate interest of the Respondent in the disputed domain name: (i) there is no evidence before the Panel that the Respondent has any proprietary or contractual rights in any registered or common law trademark corresponding in whole or in part to the disputed domain name; (ii) the Respondent is not authorized or licensed by the Complainant to use the HARRY WINSTON trademark or to register and use the disputed domain name; (iii) The Complainant’s trademark rights substantially pre-date the Respondent’s registration of the disputed domain name; (iv) there is no evidence that the Respondent has been commonly known by the disputed domain name; (v) the Respondent has not submitted a Response or otherwise asserted any right or legitimate interest in the disputed domain name.

Article 21(2) of the Regulation provides a series of circumstances which may demonstrate that the Respondent has a legitimate interest in the disputed domain name.

Article 21(2)(a) provides that a legitimate interest exists when the holder of a domain name has used the domain name “in connection with the offering of goods or services or has made demonstrable preparation to do so”.

The Respondent has not used the disputed domain name to offer any goods or services of its own; rather it has used the disputed domain name to direct Internet users to the webpages of third party on-line retailers, where Internet users might purchase the goods and services of those retailers. The opportunistic presentation of a series of automated links, which Internet users arrive at by means of the deceptive use of the trademark of another, does not constitute the offering of a service within the meaning of Article 21(2)(a). In this regard, the Panel notes that the Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition (the “CAC .EU Overview 2.0”) states in Section IV.11 that the “use of a domain name to post parking pages or mere pay-per-click links does not of itself confer rights or legitimate interests, especially if links lead to websites of the right holder’s competitors.” For these reasons, the Panel considers that the Respondent cannot be considered to be making an offering of goods or services or to have made a demonstrable preparation to do so in accordance with Article 21(2)(a).

As for Article 21(2)(b), there is no evidence that the Respondent has been commonly known by the disputed domain name.

Lastly, Article 21(2)(c) refers to “a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.” The Respondent is making a commercial use of the disputed domain name to generate revenue from pay-per-click advertising. The Panel is also satisfied that the Respondent is intentionally misleading consumers who will associate the disputed domain name with the Complainant’s HARRY WINSTON trademark. Therefore, the Respondent has no rights or legitimate interests within the meaning of Article 21(2)(c).

For all of the above reasons, the Panel considers that the domain name has been registered by the Respondent without rights or legitimate interest in the name.

The Complainant further contends that the disputed domain name was registered or is being used in bad faith. However, the Panel is not required to decide this question as under the ADR Rules and the Regulation registration or use in bad faith is an alternative, and not additional, requirement to registration without rights or legitimate interest.

Accordingly, the Complainant has satisfied the substantive requirements of the ADR Rules and the Regulation. The Respondent’s registration is speculative or abusive, and the Complainant is entitled to the appropriate remedy in accordance with paragraph B.11(b) of the ADR Rules.

D. Remedy:
The Complainant in its Amended Complaint “requests a transfer of the <HarryWinston.eu> domain name to Complainant’s parent company, The Swatch Group AG, which is located at Seevorstadt 6, CH- 2501 Biel/Bienne, Switzerland.”

Article 22(11) of the Regulation provides that where the Panel finds that a registration is speculative or abusive then the registration of the domain name shall be revoked. It goes on to enable the Panel to order transfer "to the complainant, if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) Nº 733/2002."

It is clear that the only relief available under Article 22(11) is revocation or transfer to the complainant. Transfer to a third party at the complainant's request is not authorised. The Complainant is a United States corporation, and there is no evidence that it satisfies the general eligibility criteria itself.

Therefore, the Panel orders that the registration of the disputed domain name be 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 HARRYWINSTON.EU be revoked.

PANELISTS

Name	David Cairns

DATE OF PANEL DECISION 2017-07-31

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <harrywinston.eu>

II. Country of the Complainant: United States, country of the Respondent: Spain

III. Date of registration of the domain name: 16 September 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. trademark registered in the European Union, reg. No. 006476634, for the word HARRY WINSTON, filed on 30 November 2007, registered on 17 September 2008 in respect of goods and services in classes 14, 35 and 36.
2. trademark registered in the United States, reg. No. 3355622, for the word HARRY WINSTON, filed on 7 February 1992, registered on 19 January 1993 in respect of goods and services in class 14.

V. Response submitted: No

VI. Domain name is identical to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why:
- The opportunistic presentation of a series of automated links, which Internet users arrive at by means of the deceptive use of the trademark of another, does not constitute the offering of a service within the meaning of Article 21(2)(a).
- There is no evidence that the Respondent has been commonly known by the disputed domain name.
- The Respondent is making a commercial use of the disputed domain name to generate revenue from pay-per-click advertising, and is intentionally misleading consumers.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):

N/A

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: N/A

XII. If transfer to Complainant is Complainant eligible?