Panel Decision for dispute CAC-ADREU-007673

Case number	CAC-ADREU-007673
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Domain names	byron.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Smartwares Group

Respondent

Organization	OEEO NETWORKS 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

None of which the Panel is aware.

FACTUAL BACKGROUND

The Complainant describes itself as the “Smartwares Group” and gives an address in the Netherlands. It does not identify the company or companies that are said to make up that “Group”. Further the business or businesses in which any relevant company is engaged is not disclosed.

Nevertheless the Complainant relies upon a number of trade marks that online records record are registered by the Netherlands company Smartware Safety & Lighting B.V. Accordingly, I assume that this is the formal Complainant in these proceedings.

The trade marks relied upon by the Complainant are as follows:

1. International registration 932904, for the work mark BYRON, filed on 5 July 2007 in classes 6, 9 and 11, based upon an earlier United Kingdom registration and which has proceeded to registration in at least the EU.

2. International registration 938386, for a device mark that for the most part comprises the text “Byron” in stylised text combined with what appears to be a representation of the head of a lamp with a Union Flag design. That mark was filed on 11 July 2007 in classes 6, 9 and 11, is also based upon an earlier United Kingdom registration and has also proceeded to registration in at least the EU.

The disupted domain name <byron.eu> (the “Domain Name”) was registered on 7 April 2006.

The Respondent would appear to be a company registered in the United Kingdom that has been involved in five previous sets of .eu ADR proceedings as follows:

• Hans Beckhoff v Oeeo Networks Limited ADR Case No. 03565 (<ethercat.eu>)
• Mills Brothers B.V. v Oeeo Networks Limited ADR Case No. 04725 (<thesting.eu>)
• Noonan Services Group, Toman MacGinley v Oeeo Networks Limited, Michael Kopinski ADR Case No. 05578 (<noonan.eu>)
• Petróleo Brasileiro S/A - Petrobras, Petróleo Brasileiro S/A – Petrobras v Oeeo Networks Limited, Michael Kopinski ADR Case No. 06152 (<petrobas.eu>)
• Oystershell, naamloze vennootschap v Oeeo Networks Limited, Michael Kopinski ADR Case No. 07049 (<pixie.eu>)

The Respondent participated in some but not all of these proceedings but in all cases the Respondent was unsuccessful. In the most

recent of these (i.e. the <pixie.eu>), the Respondent contended that it had registered the domain name because it comprised an ordinary English word and then proceeded to use it in connection with a pay-per-click web page.

In contrast, in the present case the Domain Name would appear not to have been in active use for at least some time and does not resolve to any website at the date of this decision.

A. COMPLAINANT

The Complaint is extremely short. It is therefore, convenient to reproduce with minor corrections the substantive part of the Complaint in full. This reads as follows:

"The [D]omain [N]ame is identical to our [registered] brand name (Byron) in respect of which a right is recognized or established by the national law of a Member State and/or Community law. The brand in words and in images is in the European Union [registered] for us by the international brand registration procedure (see attachments).

The [D]omain [N]ame has been registered by the Respondent without rights or legitimate interest in the name; because the domain isn't used at the moment and has[n't] been for a long time."

B. RESPONDENT

No Response was filed in these proceedings.

DISCUSSION AND FINDINGS

WHAT NEEDS TO BE SHOWN

In order to succeed in its Complaint, the Complainant must show that the requirements of Article 21(1) of the Regulation have been complied with. That paragraph reads as follows:

"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 21(2) and (3) contain a list of examples of circumstances which may demonstrate the existence of a legitimate interest within the meaning of Article 21(1)(a) and of bad faith within the meaning of Article 21(1)(b), but these examples are non-exhaustive.

Paragraph B.10(a) of the ADR rules provides that:

"In the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party."

However, this does not mean that the Complainant is entitled to a default judgment in a case, such as this, where no Response is filed. As paragraph B.11(d) of the ADR Rules makes clear, it is for the Complainant to prove that the requirements of Article 21(1) of the Regulation are satisfied.

With this in mind I deal with each of the three constituent parts of Article 21(1) of the Regulation in turn:

IDENTICAL OR CONFUSINGLY SIMILAR DOMAIN NAME

The Complainant has demonstrated that it is the proprietor of an EU registered trade mark for the word mark "BYRON".

In the circumstances, it is clear that the Complainant has trade mark rights in a name that, save for the <.eu> suffix, is identical to the Domain Name. As a consequence it is clear that the Domain Name is at least confusingly similar to the Complainant's mark. The Complainant has, therefore, satisfied the requirements of the first paragraph of Article 21(1).

RIGHTS AND LEGITIMATE INTERESTS AND BAD FAITH

The Complainant does not advance any case based upon bad faith. That is not surprising given that any such contention would most likely fail. The Domain Name was registered before any registered right relied upon by the Complainant and there is no evidence filed in these proceedings that suggests that the Respondent was even aware of the Complainant's existence.

Further, there is simply no evidence that the Domain Name has been subsequently held or used in any way that sought to target the Complainant, let alone seek to take some unfair advantage of the Complainant's rights. In this respect, although the term "Byron" in the Domain Name is most likely to be understood as a name, to those familiar with English literature it most obviously brings to mind the romantic poet Lord Byron. It is also the name that has been adopted by at least one other business, being used by a UK based burger chain. This is not a term that can be said to solely and exclusively bring to mind the Complainant.

Instead, the Complainant merely asserts that the Respondent has no rights or legitimate interests in the Domain Name. In essence the Complainant contends that the Respondent has no interest in the Domain Name, because it has not being used for any business purposes. Accordingly, it as a rights holder maintains that it entitled to claim it instead. It may well be that "Byron" is actually being used as a trade mark by the Complainant, but this is not asserted let alone demonstrated by the Complainant, whose claim is simply based on the ownership of two trade marks.

To those familiar with the way that other domain name dispute resolution systems operate, including for example the UDRP from which the Regulation in large part took its inspiration, that a domain name can be acquired in such a manner and on such a basis may be a somewhat startling proposition. Nevertheless, for the reasons that I considered at length in Noonan Services Group, Toman MacGinley v Oeeo Networks Limited, Michael Kopinski ADR Case No. 05578 (<noonan.eu>), that does indeed to be the consequence of the way that the Regulation has been drafted.

In the <noonan.eu> case the domain name comprised a surname combined with the <.eu> suffix, as would also appear to be the case in the current proceedings. In contrast with the current proceedings in the <noonan.eu> case, the domain name was actively being used for a pay-per-click website.

Section 11 of the CAC .EU Overview 2.0 suggests that pay-per-click use does not provide a right or legitimate interest for that term for the purposes of the Regulation. However, this is subject to the qualification "especially if links lead to websites of the right holder’s competitors". Further the commentary in section 12 so far as "direct navigation" is concerned, suggests that matters may not be quite so straight forward, where a term is being used solely in connection with its descriptive meaning.

But regardless of to what extent pay-per-click use might provide a right or legitimate interest, in <noonan.eu> I held that use of a domain name comprising a surname for pay-per-click purposes was insufficient. Further, in the present case the Respondent does not claim such pay-per-click use and there is also the Complainant's undisputed contention that the Domain Name has not actively been used at least for some time.

Given this, I am satisfied that the Complainant has demonstrated that the Respondent has no right or legitimate interest in the Domain Name and that the Complainant has, therefore, satisfied paragraph of Article 21(1)(a) of the Regulation. That is sufficient for there to be a finding in the Complainant's favour.

REMEDY

The Complainant, having satisfied the requirements of the first paragraph of Article 21(1) and of Article 21(1)(a) is entitled to obtain revocation of the Domain Name.

Under Article 22(11) of the Regulation (mirrored in paragraph B11(b) of the ADR Rules) a panel may instead order the transfer of a disputed domain name to a successful complainant, but only where that complainant can also show that it satisfies at least one of the criteria for eligibility for a .eu TLD set out in Article 4(2)(b) of regulation (EC) No. 733/2002.

The first of those criteria is that the registrant is an: “undertaking having its registered office, central administration or principal place of business within the Community”. Here the Complainant, being a company based in the Netherlands satisfies this criterion. It is, therefore, entitled to an order that the Domain Name be transferred to it.

DECISION

For all the foregoing reasons, (i) the Panel is satisfied that the Complainant in these proceedings is Smartware Safety & Lighting B.V; and

(ii) in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Domain Name <BYRON.EU> be transferred to the Complainant.

PANELISTS

Name	**Matthew Stuart Harris**

DATE OF PANEL DECISION 2018-10-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Panel was satisfied that the Complainant in this case was Smartware Safety & Lighting B.V. being the owner of the rights relied upon.

The Complainant demonstrated that it had trade mark rights that included a word mark for the term "Byron" and the Domain Name comprised that term, combined with the <.eu> suffix. Accordingly the Complainant demonstrated that the Domain Name was identical or confusingly similar to that trade mark.

The Complainant's rights appeared to post date the Domain Name and there was no evidence before the Panel that the Domain name had been registered or subsequently held with the Complainant in mind. However, there had at least for some time been no active use of the Domain Name by the Respondent.

Accordingly, the Panel concluded that, notwithstanding that the Domain Name was likely to be understood as incorporating a surname with associations that were unrelated to the Complainant, the Respondent did not have any rights or legitimate interests in the Domain Name. This was sufficient to make a finding in favour of the Complainant in this case.

As the Complainant appeared to be a company based in the Netherlands, the Panel also concluded that it was appropriate to order transfer of the Domain Name to the Complainant.