Panel Decision for dispute CAC-ADREU-007828

Case number	CAC-ADREU-007828
Time of filing	2020-01-12 01:54:11
Domain names	hidemyass.eu

Case administrator

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

Complainant

Organization	

Respondent

Organization	TAAL Communications LTD

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 is unaware of any other legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a private limited company incorporated in the United Kingdom on March 30, 2010. It is the registrant of numerous HIDE MY ASS trademarks for software products and software relating to virtual private network ("VPN"), including UK word trademark no. UK00002593092 for goods and services in classes 9, 38, 42 with priority from August 31, 2011 and EU word trademark no. 010786754 for goods and services in the same classes with priority from April 4, 2012. VPN provided by the Complainant allows Internet users to surf the web anonymously and securely by creating an encrypted tunnel that connects the user´s computer to the Internet, Wi-Fi hotspots and other networks. HideMyAss VPN was created in 2005. It has more than 10 million subscribers and more than 400 million users from all over the world. The Complainant's website is at "www.hidemyass.com".

The disputed domain name <hidemyass.eu> was registered on November 1, 2019. Prior to the Complaint being filed, it resolved to a website that appeared designed for the sale and distribution of VPN, displaying the titles “VPN”, “Why VPN”, “Home”, “Take a Tour” and “FAQ and Contact” but no content was shown after clicking on those titles. The remaining content was in pseudolatinic language (so called Lorem ipsum), a placeholder text commonly used to demonstrate the visual form of a document without meaningful content. Following the filing of the Complaint, the domain name no longer resolves to a website.

A. COMPLAINANT

The disputed domain name is identical or confusingly similar to the name “HIDE MY ASS” in respect of which the rights of the Complainant are recognized and established under European Union law.

The Respondent has no right or legitimate interests in respect of the disputed domain name. There is no evidence to suggest that the Respondent has been commonly known by the disputed domain name; has traded under “HIDEMYASS” before the beginning of this dispute; owns any identical or similar trademark; or used any identical or similar brand before the registration of the disputed domain name. The Complainant did not grant the Respondent any licence or authorization to register or use the disputed domain name. Hence the use of the Complainant’s trademark on the Respondent's website represents illegal unauthorized conduct of the Respondent.

The Respondent has sought to create a false impression of association with the Complainant, which does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name and cannot establish a legitimate interest.

As the disputed domain name is not actively used it can be argued that the disputed domain name is in passive holding of the

Respondent, presumably preparing for illicit distribution of the Complainant´s HideMyAss VPN or other competing VPN. In the case no D2018-1111 (FXCM Global Services LLC v. WhoisGuard Protected, Whoisguard Inc. / Jenny Sohia) which can be fully applied to this case, it was held that mere passive holding does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The domain name has been registered and is being used in bad faith. The Respondent was clearly aware of the Complainant´s trademarks before the registration of the domain name. This is supported by the fact that under the disputed domain name the Respondent plans to offer competing or identical VPN service for sale. The circumstances indicate that the disputed domain name was intentionally used to attract Internet users, for commercial gain to the Respondent´s website by creating a likelihood of confusion with a name "HIDEMYASS" in which a right is recognised and established by national and European Union law.

B. RESPONDENT

The Response, in full, is as follows:

Hello,
Prior to registering domain name hidemyass.eu I contacted hidemyass.com and I have a receipt of email.

TAAL Telecom

Nov 1, 15:01 CET

Hello,

We are interested in reselling your services, do you offer a panel where
we can buy in bulk and resell! Also we would registered domain name
hidemyass.eu so we can perform such business. Can we do such business!

Regards

Managing Director <http://www.taaltelecom.com>

Managing Director

TAAL Communications LTD

I received this response

Thanks for contacting HMA support.

Your email (#1641502) has been received, and one of our support agents will respond as soon as possible.

To add additional comments, or to update your request, just hit reply to this email or click the link below:
https://support.hidemyass.com/hc/requests/1641502

I never got a response and link above does not lead to any information

Having written above comments, I downloaded a generic VPN template for hidemyass.eu and was hoping to receive a response from support at HMA which never happened so I did not pursue any further. I was hoping to do business with HMA based on good faith and resell their services if possible because I am extremely knowledgable in VPN technology.

Having said all of this, I will abide by any findings or requirement and thus I will delete the domain name if you advise me to do so.

Regards,
Tony Mayasi
Taal Communications LTD

C. Complainant's Reply

By way of reply to the Response, which the Panel has taken into consideration, the Complainant says:

The Response implies that the Respondent was aware of the Complainant and its HydeMyAss VPN business at the time of the registration of the disputed domain name and registered the domain with intention to resell the Complainant´s service.

The Respondent did not prove any rights or legitimate interest in HIDE MY ASS.

The statements in the Response are not evidenced in any way and the Complainant cannot confirm the reception of such e-mail. Even if the Respondent send the e-mail, this cannot exclude bad faith on the Respondent´s side. It is very probable that the Respondent will resell the Complainant´s service also without the Complainant´s authorization, using the Complainant´s trademark for illegal distribution of HideMyAss VPN service. Otherwise, the Respondent would only register the disputed domain after receiving the Complainant´s confirmation regarding the resale of VPN service. The Complainant is therefore of the opinion that the disputed domain name was registered and is used in bad faith.

The fact that the disputed domain name has become inactive after the submission of the Complaint does not prevent a finding of bad faith use under the Policy.

DISCUSSION AND FINDINGS

Article 22 of Regulation (EC) No. 874/2004 provides that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21, which provides that a registered domain name shall be subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or EU law and where:
(a) it has been registered by its holder without rights or legitimate interest in the name; or
(b) it has been registered or used in bad faith.

The Panel is satisfied that the disputed domain name is identical to a name in respect of which the Complainant has rights recognised by EU law by virtue of its UK and Community Trade Marks "HIDE MY ASS", the ".eu" extension being inconsequential for the purpose of this determination (see CAC case No. 00283, <lastminute.eu>).

As to whether the Respondent has rights or legitimate interests in the disputed domain name, the Panel notes that the disputed domain name was registered several years after the Complainant registered its trademark.

The Complainant has provided evidence that the HIDE MY ASS mark is distinctive and widely known. The Complainant's assertions are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain name.

The Response clearly shows that the disputed domain name was chosen with the Complainant's trademark in mind and that the Respondent, in sending the email to the Complainant on the same day as it registered the disputed domain name, was aware that the Complainant's permission would be required for the Respondent to resell the Complainant's VPN services. Since no such permission has been granted, it follows that the Respondent has no rights or legitimate interests in respect of the disputed domain name, which is therefore speculative. See CAC .EU Overview 2.0, IV.5 and see Noonan Services Group v. OEEO NETWORKS LIMITED, CAC 5578.

It is unnecessary to consider the question of bad faith registration or use.

Since the Complainant, based in the United Kingdom, is an undertaking that is established in the Union, the Complainant is eligible to register the domain name under the registration provisions of Article 20 of Regulation (EU) 2019/517.

DECISION

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

PANELISTS

Name	**Mr Alan Lawrence Limbury**

DATE OF PANEL DECISION 2020-01-10

Summary

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ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <hidemyass.eu>.

II. Country of the Complainant: United Kingdom, country of the Respondent: Cyprus.

III. Date of registration of the domain name: 1 November 2019.

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 HIDE MY ASS registered in the UK, reg. No. UK00002593092, for the term of 10 years, filed on 31 August 2011, registered on February 12, 2012 in respect of goods and services in classes 9, 38, 42.
2. word trademark HIDE MY ASS registered in the EU, reg. No. 010786754, for the term of 10 years, filed on April 4, 2012, registered on October 3, 2012 in respect of goods and services in classes 9, 38, 42.

V. Response submitted: Yes

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 disputed domain name was registered several years after the registration of the Complainant's HIDE MY ASS trademarks. The Complainant asserts that it has not authorized the Respondent to register or use the disputed domain name. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain name. The Response shows that the Respondent was aware of the Complainant's trademark when registering the disputed domain name and that the Complainant's permission would be required for the Respondent to resell the Complainant's VPN services. Since no such permission has been granted, it follows that the Respondent has no rights or legitimate interests in respect of the disputed domain name, which is therefore speculative.

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

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

X. Dispute Result: Transfer of the disputed domain name to the Complainant.

XI. Procedural factors the Panel considers relevant: None.

XII. Is Complainant eligible? Yes.