Panel Decision for dispute CAC-ADREU-001196

Case number	CAC-ADREU-001196
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Domain names	memorex.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Memorex Products Europe Limited

Respondent

Organization / Name	Goallover Limited, Robin Caller

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 not aware of any other legal proceedings in relation to the disputed domain name <memorex.eu>.

FACTUAL BACKGROUND

The Complainant is a company registered in the United Kingdom. It is the licensee of the Community Trademark registrations no. 2201242 and 162073 MEMOREX registered in Classes 09, 37 and 42 of the International classification of products and services under the Nice Agreement. The licensor of the Complainant's relevant trademark rights is its parent company Memorex International, Inc. in the United States. The complainant is a fully owned subsidiary of Memorex International, Inc., which is the proprietor of extensive number of registered MEMOREX trademarks globally.

The Respondent is a company registered in the United Kingdom. It is the proprietor of the Benelux trademark no. 784641 MEMO REX, registered on 21 December 2005 for "Holmium" in Class 01 of the Nice Agreement.

The Respondent applied for the domain name <memorex.eu> (hereinafter "the Disputed Domain Name") during the first part of the phased registration period, i.e. the Sunrise I period, on 22 December 2005. The Respondent based its application on the said registered trademark MEMO REX, which is a prior right in the meaning of Commission Regulation (EC) Nr. 874/2004, of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration.

The Disputed Domain Name was registered for the Respondent on 28 March 2006. It is currently used by the Respondent to provide assorted human memory related information. In addition to that the web site that the Disputed Domain Name points to also provides links to, inter alia, commercial web sites of various DVD and CD manufacturers and/or advertisers.

As set forth in Article 12 (2) of the Commission Regulation (EC) 874/2004, licensees of registered Community trademarks were eligible to apply for corresponding .eu domain names during the first part of the phased registration period, i.e. the Sunrise I period. The Complainant exercised its aforementioned right as a licensee and applied for the domain name during the said period, on 31 January 2006, but at that time the Respondent had already filed an earlier application.

As the Complainant has its registered office within the European Community and is a licensee of registered Community trademarks, it satisfies the general eligibility criteria for registration of .eu domain names as set forth in the Commission Regulations (EC) 733/2002 and (EC) 874/2004.

The Complainant has sought transfer of the Disputed Domain Name by initiating ADR proceedings.

A. COMPLAINANT

The Complainant makes the following contentions:

The Complainant seeks a transfer of the Disputed Domain Name <memorex.eu> from the Respondent in accordance with Paragraph B11 (b) the .eu Alternative Dispute Resolution Rules (hereinafter "the ADR Rules").

The Complainant contends that it has rights in the name MEMOREX under Community law and that the Disputed Domain Name is identical to the MEMOREX trademarks, satisfying Paragraph B11 (d) (1) (i) of the ADR Rules.

The Complainant contends that the Respondent has registered the Disputed Domain Name without rights or legitimate interest in the name in accordance with Paragraph B 11 (d) (1) (ii) of the ADR Rules and points to the fact that the Respondent's trademark MEMO REX was registered the day before its application for <memorex.eu>, which serves to indicate that the Disputed Domain Name was registered specifically for the purpose of obtaining a .eu domain name in order to profit from the financial benefits that such a registration would entail, instead of protecting a genuine prior right.

The Complainant also points out that the Respondent is not authorized or licensed to use the Complainant's trademarks nor is the Respondent in any way affiliated with the Complainant and submits that as a result, the Respondent is not such a legitimate and genuine holder of a prior right, which should be afforded protection during the Sunrise Period.

The Complainant contends further that due to the longstanding use and advertising of the MEMOREX brand in the United Kingdom and in the rest of Europe since the year 1998 it is inconceivable that the Respondent would have been unaware of the Complainant's rights prior to its registration of the Disputed Domain Name and could not have chosen it accidentally.

The Complainant submits that the Disputed Domain Name has been registered or is being used by the Respondent in bad faith in accordance with Paragraph B 11 (d) (1) (iii) of the ADR Rules. Complainant contends that the Respondent has engaged in a pattern of conduct in preventing the right holders from reflecting their rights in domain names and has used the Disputed Domain Name to confuse internet users and to attract them to obtain commercial gain to the website to which the Disputed Domain Name is pointing.

The Complainant also contends that the Disputed Domain Name points to a webpage which contains sponsored links, directing internet users to websites selling, inter alia, products of Complainant's competitors. Complainant points out that the Respondent is unable to assert that he is making a legitimate and non-commercial or fair use of the domain name without intent to mislead the consumers or harm the reputation of the name MEMOREX.

As a conclusion the Complainant finally submits that all three elements listed in Paragraph b 11 (d) (1) of the ADR Rules are satisfied and thereby requests the transfer of the Disputed Domain Name.

B. RESPONDENT

The Respondent's makes the following contentions:

The Respondent contends that it holds recognized prior rights to the trademark MEMO REX and that the application for the Disputed Domain Name as well as use of the said domain name was made in good faith.

The Respondent contends that the website to which the Disputed Domain Name is pointing is entitled "MR MEMO REX", with a sub line "THE MEMORY KING", and focuses on the human memory. Also, "Ads by Google" advertisements reflect the matter. Respondent also contends that it is legitimate for them to register a domain name, which is identical to their trademark MEMO REX, registered by the Benelux trademark office, and the proximity of the trademark registration of the dates between the trademark and Disputed Domain Name registration is irrelevant.

The Respondent goes on to contend that the trademark MEMO REX is descriptive and denotes an imaginary or fictional "King of Memory".

The Respondent contends further that the website to which the Disputed Domain Name pointed was parked by EuroDNS, and that they were not aware of the "sponsored links" page it contained.

The Respondent finally contends that it has, prior to any notice of the dispute, used the domain name in connection with offering of goods or services and that the Respondent has prior rights to promote a website under the identity MEMO REX, as it is the proprietor of a trademark MEMO REX in the Benelux countries. Further, the Respondent contends that it is making a legitimate and commercial as well

as fair use of the Disputed Domain Name, without confusing consumers or harming the reputation of any name in which a right is recognized or established by National and Community law. The Respondent also contends that the references to other domain name registrations owned by the Respondent are irrelevant to this dispute in addition to that the domain name registered by the Respondent are all descriptive and generic terms.

DISCUSSION AND FINDINGS

The Panel has considered the requirements of domain name transfer under Articles 20 and 21 of the Commission Regulation (EC) No 874/2004 and in accordance with the Paragraphs B 11 (d), (e) and (f) of the ADR Rules.

The Panel shall issue a decision granting a transfer only in the event that the first requirement under Article 21 (1) and Paragraph B 11 (d) (1) (i) is fulfilled. In addition, either the second requirement under Article 21 (1) (a) and Paragraph B 11 (d) (1) (ii) or alternatively the third requirement under Article 21 (1) (b) and Paragraph B 11 (d) (1) (iii), if not both found to be present in the case, needs to be fulfilled.

The first requirement is that the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law. The Panel finds as follows:

- The Disputed Domain Name is <memorex.eu>. Memorex International, Inc. is the owner of the Community Trademark Registrations no. 002201242 MEMOREX and no. 000162073 MEMOREX. Memorex International Inc has, as evidenced by the Complainant, licensed the use of the trademark registrations to the Complainant.

- The Disputed Domain Name is identical to the trademark to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law.

The second (alternative) requirement is that the domain name has been registered by the Respondent without rights or legitimate interest in the name. The Panel finds as follows:

- The Respondent is the owner of the Benelux Trademark registration no. 784641 MEMO REX.
It is set forth in Article 11 of Commission Regulation (EC) 874/2003, that spaces contained in prior rights can either be eliminated or replaced with a hyphen in a domain name which the prior right is claimed for under Sunrise periods in the phased registration. Thus, the Respondent’s underlying trademark registration MEMO REX can serve as a prior right for the domain name <memorex.eu>.

- Based on the foregoing the Panel considers that the Respondent has not registered the domain name entirely without any right or legitimate interest in the name.

- Having said the above, the Panel would nevertheless wish to draw attention to the fact that the Respondent’s underlying trademark registration has been applied for and has been registered for “Holmium” under Class 01 of the Nice Agreement, and the said registration confers exclusive rights for holmium related goods. The Respondent, however, is not using the domain name in connection with offering of holmium related goods and there is no evidence of the Respondent’s intention to do so. The Panel will revert to the said finding when evaluating whether the Disputed Domain Name has been registered or used in bad faith.

The third (alternative) requirement is that the domain name has been registered or is being used in bad faith. The Panel finds as follows:

- The Complainant’s trademark MEMOREX is, based on the evidence provided by the Complainant, commonly known to the public in the UK, if not even well-known amongst the relevant British public. Given the commonly known nature of the mark, the Respondent cannot have been unaware of the MEMOREX trademark and the existence of the prior rights of the Complainant and/or its parent company in the US.

- The Respondent has registered altogether 140 Benelux trademarks during the Sunrise periods and has applied for 132 corresponding .eu domain names based on a prior right granted by the said Benelux registrations. The said registrations include, in addition to MEMO REX, trademarks such as MENS HEALTH, DIE SEL and ESPN, which are all commonly known, if not well-known trademarks within the European Community. Spaces between the letters in the trademarks registered by the Respondent do not alter this fact.

- The intention beneath the Commission Regulations (EC) 733/2002 and (EC) 874/2004, as is apparent from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names, which correspond to their proprietary rights. The intention has not been to allow for speculative and abusive domain name registrations based on such trademark rights, which are not based on genuine and bona fide need for an exclusive right, but instead to prevent any such speculative and abusive registrations.

- It is particularly clear that in circumstances in which the domain name registration applied for during the Sunrise periods has been based on trademark registrations registered for such goods the Respondent is not using neither the trademark nor the domain name for, it is not a question of a legitimate and genuine prior right. Even though the Panel is of the opinion that quickly acquired trademark registrations can serve as a fully valid basis for a domain name registration applied for during the Sunrise periods, this should only concern situations in which the Registrant is bona fide using or intents to use the trademark for the goods and/or services covered by his registration. In this particular case the Respondent has registered the trademark MEMO REX for "Holmium", but is not using the trademark MEMO REX or the Disputed Domain Name in any offering of such goods. Further, there is no evidence of the Respondent's intention to do so. Therefore the Panel finds that the Disputed Domain Name has been registered in bad faith in accordance with the Article 21 (1) (b) of the Commission Regulation (EC) 874/2004.

- Further, since the Respondent must have been well aware of the MEMOREX brand, it is evident that the Respondent has registered the Disputed Domain Name in order to prevent the holder of the corresponding trademark registrations from reflecting the name in a corresponding domain name. Judging by the volume of the Respondent's domain name registrations and the number of such registrations which directly call into mind a commonly known or well-known trademark, the Panel considers that the Respondent may well be considered to have engaged in a pattern of such conduct as meant in Article 21(3) (b) (i) of the Commission Regulation (EC) 874/2004. However, considering that the Panel already found other actions by the Respondent to fulfill the criteria of bad faith pursuant to Article 21 (1) (b), it is irrelevant with respect to the decision in this particular case whether a pattern of such conduct as meant in Article 21(3) (b) (i) can eventually be demonstrated in this case.

DECISION

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

PANELISTS

Name	**Sanna Aspola**

DATE OF PANEL DECISION 2006-07-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is a company registered in the United Kingdom. It is the licensee of the Community Trademark registrations no. 2201242 and 162073 MEMOREX. The Respondent is a company registered in the United Kingdom. It is the proprietor of the Benelux trademark no. 784641 MEMO REX, registered on 21 December 2005 for "Holmium" in Class 01. The Respondent applied for the Disputed Domain Name <memorex.eu> during the first part of the phased registration period, i.e. the Sunrise I period, on 22 December 2005. The Complainant applied for the Disputed Domain Name during the same Sunrise I period, on 31 January 2006, but at that time the Respondent had already filed an earlier application. The Disputed Domain Name was registered for the Respondent on 28 March 2006.

The Panel made the following discussions and findings:

The Disputed Domain Name is identical to the trademark to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law.

The Respondent's underlying trademark registration MEMO REX can serve as a prior right for the domain name <memorex.eu> and based on that the Respondent has not registered the domain name entirely without any right or legitimate interest in the name. However, the mere existence of the Respondent's prior right does not entirely qualify it as a genuine legitimate right as meant in the Commission Regulations (EC) 733/2002 and (EC) 874/2004.

The intention behind the Commission Regulations (EC) 733/2002 and (EC) 874/2004, as is apparent from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names, which correspond to their proprietary rights. The intention has not been to allow for speculative and abusive domain name registrations based on such trademark rights, which are not based on genuine and bona fide need for an exclusive right, but instead the intention has been to prevent any such speculative and abusive registrations.

Therefore, even though quickly acquired trademark registrations can serve as a fully valid basis for a domain name registration applied for during the Sunrise periods, this should only concern situations in which the Registrant is bona fide using or intents to use the

trademark for the goods and services covered by his registration. In this particular case the Respondent has registered the trademark MEMO REX for “Holmium”, but is not using the trademark MEMO REX or the Disputed Domain Name in any offering of such goods. Further, there is no evidence of the Respondent’s intention to do so.

The Complainant’s trademark MEMOREX is, based on the evidence provided by the Complainant, commonly known to the public in the UK. Given the commonly known nature of the mark, the Respondent cannot have been unaware of the MEMOREX trademark and the existence of the prior rights of the Complainant and/or its parent company in the United States. Therefore the Panel finds that the Disputed Domain Name has been registered in bad faith in accordance with the Article 21 (1) (b) of the Commission Regulation (EC) 874/2004.

For all the foregoing reasons, the Panel orders the Disputed Domain Name <memorex.eu> to be transferred to the Complainant.